

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: August 6, 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_  
Trademark Trial and Appeal Board

\_\_\_\_\_  
In re Elena Potoupa

\_\_\_\_\_  
Serial No. 78770813

Sergei Orel of Law Office of Sergei Orel for Elena Potoupa.

Marcie R Frum Milone, Trademark Examining Attorney, Law  
Office 116 (Michael W Baird, Managing Attorney).

\_\_\_\_\_  
Before Walters, Zervas and Taylor, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Elena Potoupa has filed an application to register the  
standard character mark WOW PRINTABLE COUPONS on the  
Principal Register for the services shown below.<sup>1</sup>

**Services:** "Promoting the goods and services of others  
by dissemination of printable discount and rebate  
coupons over the Internet and distributing and  
offering discount and rebate coupons of others for use  
by the public in the purchase of various consumer  
products, retail items, groceries, food items, dining  
and restaurant services, travel services, over the

\_\_\_\_\_  
<sup>1</sup> Serial No. 78770813, filed December 10, 2005, based on use of the mark  
in commerce, alleging first use and use in commerce as of November 16,  
2005.

Internet; advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information of third parties by offering such parties' printable discount and rebate coupons through the Internet and by providing hypertext links to the web sites of third parties; advertising, including promotion relating to the sale of articles and services for third parties by the transmission of advertising material and the dissemination of advertising messages and advertising banners on the Internet, computer networks and on a website," in International Class 35.

The application includes a disclaimer of PRINTABLE COUPONS apart from the mark as a whole.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the standard character mark WOW! MARKETING, the subject mark of two registrations for the services shown below, that, if used on or in connection with applicant's services,<sup>2</sup> it would be likely to cause confusion or mistake or to deceive.

**Registration No. 3072360** [registered March 28, 2006]  
**Services:** "Preparing advertisements for others; dissemination of advertising for others via an online electronic communications network; dissemination of advertising matter; promoting the goods and services of others via an online electronic communications network; and business marketing consulting services," in International Class 35; and "Computer services, namely, creating, designing and maintaining web sites for others; and hosting web sites of others," in International Class 42.

**Registration No. 3095057** [registered May 23, 2006]  
**Services:** "Advertising and marketing services," in International Class 35

---

<sup>2</sup> Both cited registrations include a disclaimer of MARKETING apart from the mark as a whole, and both registrations are owned by Freedom Colorado Information, Inc.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.<sup>3</sup>

As a preliminary matter, applicant submitted evidence with her request for reconsideration, which was filed along with her notice of appeal. In the denial of the request for reconsideration and in her brief, the examining attorney objected to this evidence as untimely because it was filed "after the filing of an appeal." The rule to which the examining attorney refers, 37 CFR §2.142(d), states the following:

(d) 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.

*See also In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). However, the examining attorney apparently either failed to read the final sentence in this rule, which permits introduction of evidence upon suspension of the appeal and remand, or misunderstood the section to permit submission of evidence only by the examining attorney. In

---

<sup>3</sup> Applicant's co-pending application for the design mark WOW COUPONS, Serial No. 78772938, was similarly refused registration under Section 2(d) and the refusal was affirmed by the Board on September 3, 2008.

this case, the Board suspended the application and remanded the request for reconsideration to the examining attorney for examination. Thus, the evidence submitted with the request for reconsideration is proper, and the examining attorney could have responded with additional evidence before returning the case to the Board to resume the appeal. The examining attorney's objection is overruled and the evidence has been considered.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re*

*Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We consider, first, the services involved in this case, and we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Further, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner*

*Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney contends the services are identical to the extent that applicant's identified services are encompassed by registrant's identified services; and that the trade channels and classes of purchasers are the same. She contends that the cited registrations encompass all advertising and marketing services and "dissemination of advertising matter"; that the services recited in the cited registrations encompass the services specifically identified by applicant; that, even if the services are not identical, they are closely related because they promote the goods and services of third-parties; and that, as such, applicant's and registrant's services are directed to the same purchasers, especially those purchasers seeking to reach online consumers.

Applicant contends that the services are different because applicant's focus "is on offering and promoting discount and rebate coupons of others on the Internet, namely, of printable coupons of other parties on applicant's website [[www.wowprintablecoupons.com](http://www.wowprintablecoupons.com)], while the WOW! MARKETING marks are registered in respect of advertising and marketing services mainly." (Brief, p. 5.)

Applicant also contends that she can find no use of the registered marks on the Internet and, thus, there will be no

confusion between applicant's and registrant's marks in the marketplace.

We agree with the examining attorney that the services involved herein are essentially the same. Cited registration no. 3095057 recites "advertising and marketing services," which is very broad and clearly encompasses the type of advertising and promotional services recited in the application. Additionally, advertising services for third parties via the Internet, the services described in cited registration no. 3072360, also encompass applicant's promotional services for others via the Internet using discount and rebate coupons. Therefore, applicant's and registrant's services are, in part, identical.

Applicant's argument that it is unaware of any use of the registered marks on the Internet is unavailing because this allegation is essentially a collateral attack on the validity of the cited registrations, which is permissible only in the context of a cancellation proceeding, not in an ex parte appeal.

Applicant's services are rendered primarily via the Internet and some of the services recited in registration no. 3072360 are similarly limited. However, the remaining services recited in registration no. 3072360 and all of the services recited in registration no. 3095057 are not so limited and, thus, we presume these services would be

rendered in all ordinary trade channels for such services. The application and the registrations are not limited as to classes of purchasers, so we presume that these services are offered to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In other words, applicant's and registrant's channels of trade and classes of purchasers are overlapping, if not identical.

We turn, next, to a determination of whether applicant's mark and the registered marks, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. Furthermore, although the marks at issue must be considered in their entireties, 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. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The examining attorney contends that the marks have highly similar commercial impressions; that both marks have



the same first term WOW, which she argues is the dominant portion of each mark, stating that applicant "simply deletes the generic material from the registered marks, MARKETING, and adds the descriptive wording, COUPONS." (Brief, unnumbered p. 12.)

Applicant contends that the marks are visually and phonetically different, noting the specific differences in the marks, such as the exclamation mark in the registered mark and the different numbers of words and letters in the marks. Applicant argues that, while WOW may be the dominant portion in the cited registration, the examining attorney improperly dissected applicant's mark and the term PRINTABLE COUPONS is the dominant portion in its mark, noting that the disclaimer of this term indicates that that it is "somewhat suggestive."

The mark in the cited registrations, WOW! MARKETING, consists of two words, the first word is an exclamation, "WOW," that appears to be arbitrary in connection with the recited services or, at least, it is not merely descriptive thereof. The second word in the mark is the merely descriptive word MARKETING. Clearly, the word WOW is the dominant portion of this mark and its dominance is emphasized by the exclamation mark following it.

Applicant's mark also consists of two words in the same format as the registered mark, i.e., it has the identical

first word, WOW, followed by a merely descriptive term, PRINTABLE COUPONS. Contrary to applicant's contentions, we find that the term PRINTABLE COUPONS is merely descriptive of the primary object of applicant's services, i.e., to make available to consumers third-party "printable coupons." We likewise find that WOW is the dominant portion of applicant's mark because, as with the registered mark, it appears to be arbitrary in connection with the recited services or, at least, it is not merely descriptive thereof, and it is the first word in the mark. Applicant's arguments about the differences in the specific details of the respective marks are of no significance because, as previously stated, our analysis is not a side-by-side comparison of the marks; rather, 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). Therefore, we find that the marks are substantially similar.

The third-party registrations submitted by applicant do not compel a different result in this case. The registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, and cannot aid applicant in its effort to register another mark which so resembles a registered mark as to be likely to

cause confusion. *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973); and *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967). Further, the services in the third-party registrations submitted with the brief vary widely, even within International Class 35; the marks include additional matter different from the case before us; and each case must be decided on its merits. Finally, even if we had found that the cited registered mark is weak, which we have not, even weak marks are entitled to protection.

We conclude that, in view of the similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the same or overlapping services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

*Decision:* The refusal under Section 2(d) of the Act is affirmed.