

This Opinion is Not a
Precedent of the TTAB

Mailed: March 25, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Hy-Vee, Inc.

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Serial No. 86105555

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Timothy J. Zarley of Zarley Law Firm PLC,
for Hy-Vee, Inc.

Lyndsey Kuykendall, Trademark Examining Attorney, Law Office 102,
Mitchell Front, Managing Attorney.

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Before Bucher, Taylor and Gorowitz,
Administrative Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Hy-Vee, Inc. (“Applicant”) seeks registration on the Principal Register of the
stylized mark

**DIGITAL
COUPONS**

(the wording Digital Coupons disclaimed) for, as amended:

consumer coupons downloaded from a global computer
network, namely, digital coupons with barcodes which can
be scanned onto a [sic] stored value cards; downloadable

mobile application for users to review products and services and to award points whereby mobile application users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or services in Class 9; and

an interactive web site featuring technology for users to review products and services and to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or services in Class 42.¹

The Trademark Examining Attorney has refused registration of Applicant's mark under Trademark Action Section 2(d), 15 U.S.C. § 1052(d), on the ground that Applicant's mark as used on or in connection with the identified goods and services is likely to cause confusion under Trademark Act Section 2(d), with the mark in Registration No. 3914513,



(the wording Digital Coupons disclaimed), for:

An interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or

¹ Application Serial No. 86105555 was filed on October 30, 2013, based upon Applicant's allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act as to both classes of goods and services. The application includes the following description: "The mark consists of the words Digital Coupons in a stylized font. Digital appears on the first line and Coupons appear on the next line. The first occurrence of the "i" in digital and the "u" in coupons are represented by an artistic impression of a computer mouse connecting cord." Color is not claimed as a feature of the mark.

service provided by web site sponsors; Promoting the sale of goods and services of others through electronic couponing, promotions and discounts in Class 35.²

After the Examining Attorney made the refusal final, Applicant appealed to this Board.

We reverse.

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of 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.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key considerations are the similarities between the marks and the similarities between the goods. *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.”).

We first consider the similarity or dissimilarity of the goods and services. It is settled that the question of likelihood of confusion must be determined based on an analysis of the goods and services recited in Applicant’s application vis-à-vis the services recited in the cited registration and we cannot read limitations into those goods. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110

² Registered February 1, 2011, and claiming May 1, 2010 as the date of first use of the mark and May 28, 2010 as the date of first use of the mark in commerce. The registration includes the following description: “The mark consists of the capital letters "DQ" with the words "DIGITAL QPONS" centered below.”

USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Press Inc.*, 281 F.3d 1261, 62 USPQ 2d 1001 (Fed. Cir 2002); *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). If the application and registration describe the goods and services broadly, and there is no limitation as to the nature, type, channels of trade or class of purchasers, it is presumed that the registration encompasses all goods of the type described, and that they move in all channels of trade normal for these goods, and that they are available to all classes of purchasers for the described goods. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992).

With these principles in mind, we compare Applicant's "consumer coupons downloaded from a global computer network, namely, digital coupons with barcodes which can be scanned onto a stored value cards; downloadable mobile application for users to review products and services and to award points whereby mobile application users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or services" and "interactive web site featuring technology for users to review products and services and to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons, rebates, discounts or special offerings on goods and/or services" with Registrant's "interactive web site for users to review and rate internet content, people, companies, products and/or services utilizing a software application to award points whereby web site users are eligible to exchange points earned for promotional items consisting of coupons,

rebates, discounts or special offerings on goods and/or service provided by web site sponsors; Promoting the sale of goods and services of others through electronic couponing, promotions and discounts.” Although the language is not exact, both Applicant’s goods and services and Registrant’s services, as identified in the respective identifications, are essentially the same and may be used interchangeably by the same people to promote the goods and services of others, because both Applicant and Registrant use website technology to review and evaluate products and services and both websites can be used to generate coupons based on an awards program. We thus find them to be legally identical. To the extent that Applicant also provides its services by way of a mobile application, we note that the Examining Attorney has made of record web pages from various companies providing the same goods and/or services by means of both the content provides’ websites (e.g., www.cnn.com, www.coupons.com and www.ibotta.com) as well as through mobile applications available through Apple’s iTunes store. While we cannot say that these examples evidence the behavior of a “majority” of companies as the Examining Attorney would have us believe, they nonetheless show the provision of the same services by a single entity via both a website and a mobile application. We thus find Applicant’s mobile application related to the services provided by Registrant via the Internet.

Further, we must presume with respect to the legally identical services that they will be offered in the same channels of trade and will be purchased by the same classes of purchasers, i.e., ordinary consumers, and that the related services will be

offered in some of the same channels of trade, and will be bought by some of the same purchasers. See *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968); *Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

We find unpersuasive Applicant's argument that its services are unrelated to those of Registrant because its mark covers services that are "directed at both a website and mobile application" and are limited to the review and rating of products and/or services, while the Registrant's services are "directed at a website for reviewing and rating any number of things a sponsor may want evaluated." Simply because Registrant's services are more comprehensive in that they are not limited by subject matter or, similarly, because Applicant's services are additionally directed to mobile applications, does not obviate the fact that, as noted above, both Applicant's and Registrant's services perform overlapping functions, namely, the promotion of goods and services of others via the Internet by way of offering coupons and discounts in exchange for product and/or service reviews.

Accordingly, we find that the *du Pont* factors of the similarity of the goods and services, and the similarity of the channels of trade, favor a finding of likelihood of confusion.

Despite this finding, however, we find that confusion is not likely because of the



fundamental differences between
Applicant's mark (shown at left)



and the cited mark (shown at right). In comparing the marks, we recognize that test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted). While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. *See In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, as our principal reviewing court has observed, “[t]hat a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.” *See In re National Data Corp.*, 224 USPQ at 751.


Here, the obvious similarity between the two marks is that they share the term DIGITAL COUPONS or the phonetic equivalent DIGITAL QPONS. However, DIGITAL COUPONS (QPONS) has descriptive, if not generic, significance with respect to the goods and services in both the application and cited registration. Given that significance, it is more likely that consumers will equate the term with the respectively identified goods and services than with the source of those goods and services. With particular regard to the cited registered mark, the stylized

letters DQ play a dominant role because they appear significantly larger and prominently above the smaller font-sized and descriptive element DIGITAL QPONS. Because DQ visually dominates Registrant's mark, it is the part of the mark that will most likely be impressed upon the minds of consumers. The Examining Attorney's unsupported statement that the letters comprise a "stylized acronym" and "would be read in conjunction with the wording that is displayed beneath it" is unavailing. We also find the "mouse" design element (which replaces the first letter "T" and the letter "U" in Applicant's mark) is dissimilar enough from Registrant's mark to distinguish Applicant's goods and services Registrant's.

Given these prominent visual distinctions, we find the respective marks create substantially different commercial impressions.

In making this finding, we are mindful of the Examining Attorney's argument that the words DIGITAL COUPONS are the dominant features in Applicant's mark because the literal portion of a word and design mark generally makes the greatest impact on a prospective customer, and her further argument that, because of the similarity of the words DIGITAL COUPONS and, its phonetic equivalent DIGITAL QPONS, the marks are confusingly similar. While it is often true that the words in a composite word and design mark are considered to be dominant, that is not always the case. The Board addressed a very similar situation in *In re Covalinski*, 113 USPQ2d 1166, 1168 (TTAB 2014), and noted:

In *Viterra*, the Federal Circuit acknowledged this general rule while affirming a Board decision that found the

dominant portion of the registered mark  was

the literal portion (X-SEED) rather than the stylized letter “X” alone, *see* 101 USPQ2d at 1911; but it also found no inconsistency between the Board’s *Viterra* decision and its earlier decision in *In re White Rock Distilleries, Inc.*, 92 USPQ2d 1282, 1284 (TTAB 2009), wherein the Board found no likelihood of confusion between applicant’s standard character mark VOLTA for caffeine-infused vodka and the cited mark (shown below) for wines, due to the prominent design in the registered mark:



We also acknowledge that “when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines.” *In re Covalinski*, 113 USPQ2d at 1169; *In re Might Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010) (internal citations omitted). However, we find that given the highly descriptive or generic meaning of the term DIGITAL COUPONS (QPONS), Applicant’s mark is so different from the cited registered mark than even when used in connection with in-part identical services, there is no likelihood of confusion.

In conclusion, we find the first *du Pont* factor, the differences between the marks, outweighs the other factors. *See Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459, 1460-61 (Fed. Cir. 1998) (Federal Circuit affirmed Board finding of no likelihood of confusion between mark CRYSTAL CREEK for wine and marks CRISTAL for wine and CRISTAL CHAMPAGNE for champagne, where Board relied solely on dissimilarity of marks);

Kellogg Co. v. Pack'em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single *du Pont* factor may not be dispositive”).

Decision: The refusal to register Applicant’s mark  is reversed.