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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

RE/MAX International Inc.
v.
Somraj Singh

Opposition No. 91175272
to application Serial No. 78800579
filed on January 26, 2006

John R. Posthumus of Greenberg Taurig, LLP for RE/MAX
International, Inc.

Olumide K. Obayemi, Esq. for Somraj Singh.

Before Seeherman, Walters and Bergsman, Administrative
Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Somraj Singh ("applicant") filed an intent-to-use
application for the mark SAVEMAX REALTY and design, shown
below, for "real estate brokerage" services, in Class 36.



Applicant disclaimed the exclusive right to use the word "realty."

RE/MAX International, Inc. ("opposer") filed a notice of opposition against the registration of applicant's mark on the ground of priority of use and likelihood of confusion pursuant to Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).¹ Specifically, opposer alleged that it is the owner of eight federally-registered RE/MAX marks, including REMAX, in typed drawing form, for, *inter alia*, real estate brokerage services, that its RE/MAX marks are famous, and that applicant's mark is likely to cause confusion with opposer's RE/MAX marks.

Applicant denied the essential allegations in the notice of opposition.

The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b). In addition, opposer introduced the following testimony and evidence:

1. The testimony deposition of Vincent J. Tracey, opposer's President, with attached exhibits;

¹ Opposer also alleged that applicant's mark creates a false suggestion of a connection with opposer and it dilutes the distinctive nature of opposer's trademarks. However, because opposer did not argue the issue of dilution or a false suggestion of a connection in its brief, we consider those claims to have been waived.

2. The discovery deposition of applicant with attached exhibits;²

3. Notices of reliance introducing photocopies of opposer's pleaded registrations issued by the U.S. Patent and Trademark Office showing the current status of the registrations and the title of the registrations in opposer's name;

4. A notice of reliance on applicant's responses to opposer's first set of interrogatories; and,

5. A notice of reliance on applicant's responses to opposer's requests for admission.

Applicant did not introduce any testimony or evidence.

Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

² Opposer filed applicant's discovery deposition as an attachment to its brief. Trademark Rule 2.120(j)(3)(i) provides that a discovery deposition may be made of record by the propounding party through a notice of reliance filed during its testimony period. Applicant's discovery deposition was not timely filed, nor was it introduced through a notice of reliance. However, because applicant did not object to the introduction of his discovery deposition and, in fact, treated it as being of record, we consider the admission of applicant's discovery deposition to have been stipulated into the record by the parties.

Priority

Because opposer's pleaded registration are of record, Section 2(d) priority is not an issue in this case as to the marks and the services covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

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 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of opposer's RE/MAX marks.

This *du Pont* factor requires us to consider the fame of opposer's of marks. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Finally, because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

The following testimony establishes that opposer's RE/MAX marks are famous for purposes of analyzing likelihood of confusion:

1. Opposer has 4,315 RE/MAX offices in the United States;³
2. Opposer has 80,000 RE/MAX sales associates in the United States;⁴
3. Opposer has a 16% market share;⁵
4. Since Opposer launched its REMAX.com website in March 2006, the website has listed 3.9 million properties generating 3.3 million leads for its sales associates.⁶ and,
5. Opposer has extensively advertised its RE/MAX real estate services. For example, in 2007, opposer spent approximately \$50 million for advertising in the United States encompassing television, radio and print.⁷ However, when all the advertising by opposer's sales associates in regional and local offices is considered, opposer spent approximately \$1 billion on advertising in 2007.⁸ That means that in 2007, approximately 47% of the paid

³ Tracey Dep., p. 34.

⁴ Tracey Dep., p. 35.

⁵ Tracey Dep., p. 39

⁶ Tracey Dep., p. 50

⁷ Tracey Dep., p. 89.

⁸ Tracey Dep., p. 110.

advertising in the real estate field in the United States was by opposer. In 2006, opposer's advertising was approximately 48% of the real estate advertising in the United States.⁹ Another way of analyzing the effectiveness of opposer's advertising is that in 2007, opposer's advertising made 14 billion "impressions" on people between the ages of 25-54, the prime buying public.¹⁰

In view of the foregoing, we find that opposer's RE/MAX marks are famous for purposes of analyzing likelihood of confusion.

B. The similarity or dissimilarity and nature of the services at issue.

Opposer has registered REMAX, in typed drawing form,¹¹ and RE/MAX and design, shown below,¹² both for real estate brokerage services.



Applicant is seeking to register his SAVEMAX REALTY and design mark for real estate brokerage services.

Accordingly, the services are identical.

⁹ Tracey Dep., pp. 91.

¹⁰ Tracey Dep., pp. 92-93.

¹¹ Registration No. 2106387, issued October 21, 1997; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

¹² Registration No. 2119607, issued December 9, 1997; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

C. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers.

Because we have found that the parties' services are identical, we must presume that the channels of trade and classes of purchasers are the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part (sic) identical and in-part (sic) 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").

d. The similarity of the marks in their entirety in terms of appearance, sound, meaning, and connotation.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567. In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 9 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1988). In comparing the marks, we

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are mindful that where, as here, the services are identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the goods and services.

Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Real Estate One, Inc. v. Real Estate 100 Enterprises Corporation*, 212 USPQ 957, 959 (TTAB 1981); *ECI Division of E-Systems, Inc. v. Environmental Communications Incorporated*, 207 USPQ 443, 449 (TTAB 1980).

While the marks must be compared in their entireties, in analyzing the similarity or dissimilarity of two marks, there is nothing improper in stating that for rational reasons, more or less weight has been given to a particular feature of a mark. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). This is an important principle in analyzing the similarities of the marks at issue because the only similarity between applicant's mark and opposer's marks is the suffix "max" in SAVEMAX and REMAX. "Max" is an abbreviation for the descriptive or highly suggestive word "maximum."¹³

¹³ Webster's New Collegiate Dictionary, p. 710 (1977); The American Heritage Dictionary: 2nd College Edition, p. 774 (1976). As a general rule, the Board may take judicial notice of dictionary evidence. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

Accordingly, when we consider the marks in their entireties, we are of the opinion that they differ substantially in appearance, sound, meaning and commercial impression.

Opposer contends that because the marks "share the prominent use of the suffix 'MAX'" they are similar in meaning and commercial impression.¹⁴ Opposer's President, Vincent Tracey, testified that RE/MAX means "the maximum in real estate" to broker/owners and sales associates¹⁵ and that to consumers it means the most experienced people in real estate.¹⁶ However, applicant testified that he selected the term SAVEMAX to convey the commercial impression that consumers "can save maximum money through [applicant's] brokerage company."¹⁷ While both parties' adopted their marks to connote a "maximum" quality, their marks emphasize different qualities (*i.e.*, the maximum in real estate and experience vs. maximum savings). While there is no testimony in the record to corroborate how consumers actually perceive the marks, we find that the testimony of Mr. Tracey and applicant illustrate that the meanings and commercial impressions of the marks are different. *See Mead Johnson & Company v. Peter Eckes*, 195 USPQ187, 191 (TTAB 1977) (while the parties may have adopted

¹⁴ Applicant's Brief, p. 17-19.

¹⁵ Tracey Dep., p. 31.

¹⁶ Tracey Dep., p. 32.

¹⁷ Singh Dep., p. 35.

the "cal" or "kal" suffix to connote low caloric content, and while opposer may have priority of use and may have achieved notoriety, "this cannot preclude others engaged in marketing competitive, related, or similar goods from adopting and registering marks projecting a similar suggestion if they are otherwise readily distinguishable in sound and appearance"). *See also Stouffer Corporation v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1900, 1903 (TTAB 1986) (LEAN LIVING for chicken, crepes, lasagna and enchiladas is not similar to LEAN CUISINE for frozen entrees because the only similarity between the marks is the suggestive word "lean"). The marks are also obviously different in appearance and pronunciation because of the differences in the initial portions of the marks.

We do not agree with opposer's argument that the dominant portion of applicant's mark is the suffix "max."¹⁸ To the extent that consumers would place more emphasis on one part of applicant's mark, we believe that they would be more likely to put that emphasis on the word "save" because it is the first part of the word portion of the mark.

Presto Products Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"). *See also Palm Bay Imports Inc.*

¹⁸ Opposer's Reply Brief, pp. 6-7.

v. Veuve Clicquot Ponsardin, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word).

Finally, although Mr. Tracey testified that “whenever you see ‘Max,’ anything related to real estate, everybody thinks of RE/MAX first,”¹⁹ we note that opposer has not pleaded, nor has it argued, that it is the owner of a “family” of “max” service marks. In other words, opposer does not contend that it is the owner of a group of different marks having a “max” suffix that have been used in such a way that consumers would recognize all the different “max” marks used in connection with real estate marks with opposer. See *J & J Snack Foods Corp. v. McDonald’s Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). In fact, according to the record, opposer is the owner of eight federally-registered RE/MAX marks in the real estate field. Therefore, the issue before us is essentially whether SAVEMAX REALTY and design is confusingly similar to opposer’s RE/MAX marks.

¹⁹ Tracey Dep., p. 118.

In view of the foregoing, we find that the marks are not similar in terms of their appearance, sound, meaning or commercial impression.

E. Bad faith.

Opposer contends that applicant acted in bad faith when he selected his SAVEMAX service mark because applicant was aware of the RE/MAX marks, applicant did not conduct a trademark search, and applicant did not proffer advice of counsel as a defense.²⁰ Furthermore, opposer argues that applicant intended that his SAVEMAX mark have the same meaning and commercial impression as opposer's marks because applicant used the abbreviation "max," rather than the full word "maximum."²¹

Because of the differences in the marks, the points relied upon by opposer do not support the premise that applicant acted in bad faith. There is no requirement that an applicant obtain a trademark search before adopting a mark. Further, even if applicant had been aware of opposer's mark, the marks are so different that no bad faith can be attributed to applicant as a result of his decision to proceed with the mark SAVEMAX REALTY and design. Based on the record before us, applicant's knowledge of opposer's marks and failure to conduct a trademark search do not

²⁰ Opposer's Brief, pp. 21-22; Opposer's Reply Brief, p. 9.

²¹ Opposer's Brief, p. 19.

constitute a sufficient basis for us to infer that applicant acted in bad faith.

F. Balancing the factors.

Because applicant's SAVEMAX REALTY and design mark is so different from opposer's RE/MAX marks, we find that there is no likelihood of confusion by the contemporary use of the marks. We reach this conclusion despite the fame of opposer's RE/MAX marks, the fact that the services rendered by the parties are identical and the presumption that the services are rendered in the same channels of trade and to the same classes of consumers. In other words, the dissimilarity of the marks simply outweighs the other factors. See *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142, 1145 (Fed. Cir. 1991). See also *Stouffer Corporation v. Health Valley Natural Foods Inc.*, 1 USPQ2d 1906 ("while the fame of opposer's mark and the identity of the parties' goods and their channels of trade tend to favor opposer's case, we are not persuaded that these circumstances are sufficient to refuse registration to applicant in view of our finding that LEAN CUISINE and LEAN LIVING, applied to the goods herein are not confusingly similar in sound, appearance or commercial impression").

Decision: The opposition is dismissed with prejudice.