

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

Mailed: July 28, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Autobytel Inc.  
v.  
Auto By Rent, Inc.

\_\_\_\_\_  
Opposition No. 91180067  
to Application No. 78936614

Steven J. Nataupsky, Michael K. Friedland, Tirzah Abe Lowe  
and Lauren Keller Katzenellenbogen of Knobbe, Martens, Olson  
& Bear, LLP for Autobytel Inc.

Joseph L. Johnson and James H. Jeffries of Lathrop & Gage,  
for Auto by Rent, Inc.

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Before Bucher, Ritchie, and Lykos, Administrative Trademark  
Judges.

Opinion by Ritchie, Administrative Trademark Judge:

Autobytel Inc. ("opposer") filed an opposition to the  
application of Auto by Rent, Inc. ("applicant") to register  
the mark AUTO BY RENT, as shown below, for "automobile  
dealerships," in International Class 35:<sup>1</sup>

<sup>1</sup> Application Serial No. 78936614, filed July 25, 2006, under Section  
1(a) of the Trademark Act, 15 U.S.C. §1051(a), alleging dates of first  
use and first use in commerce on July 1, 2004, and disclaiming the  
exclusive right to use the term "AUTO" apart from the mark as shown.

# **Auto by Rent**

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered mark

## **AUTO-BY-TEL**

as to be likely to cause confusion, under Section 2(d) of the Trademark Act. The mark is registered for "electronic billboard advertising in the field of automobile and truck sales and leasing; computerized data base management in the field of automobile and truck sales and leasing; independent sales representative services in the field of automobiles and truck sales and leasing; shopper's guide information in the field of automobile and truck sales and leasing; and referrals in the field of automobile and truck sales and leasing" in International Class 35; "delivery of messages by electronic transmission in the field of automobile and truck sales and leasing; and electronic transmission of data and documents via computer terminals in the field of automobile and truck sales and leasing," in International Class 38; and "computerized on-line ordering of automobiles and trucks via

telephone," in International Class 42.<sup>2</sup> Opposer also pleaded likelihood of confusion with other previously registered marks, including AUTOBYTEL, AUTOBYTEL.COM and design, AUTOBYTEL NETWORK, and AUTOBYTEL CONNECT.<sup>3</sup> (Notice at Para. 1). Opposer further pleaded dilution of "the distinctive quality of Opposer's famous marks." (*Id.* at Para. 25).

Applicant, in his answer, denied the salient allegations of the claims.

### **The Record**

The record consists of the pleadings; the file of the involved application; and the following:

1. Opposer's notice of reliance, making of record, among other things:

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<sup>2</sup> Registration No. 2028377. Sections 8 and 15 affidavits accepted and acknowledged. Renewed.

<sup>3</sup> In its trial brief, opposer contends that it offers its vehicle sale services in connection with its "family" of marks. As admonished in the Board's February 18, 2010 order denying opposer's motion for summary judgment, however, opposer did not specifically plead ownership of a "family" of marks in its notice of opposition, nor did opposer plead a particular characteristic common to each of its pleaded marks. We have therefore not considered this argument. We would further note that besides not properly pleading ownership of a family of marks, opposer has certainly not proven the common characteristics of a family of marks. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). Nevertheless, we also note that applicant, in its trial brief, proceeded with its defense based on an analysis of each of the pleaded marks individually. We likewise proceed with this decision on the basis of the individually pleaded marks. To the extent that applicant may have objected to opposer's not having proceeded on such basis in opposer's brief, applicant's objection is waived. Meanwhile, we further note that we do not accept as amended pleadings (nor were we asked to) the additional, unpleaded marks added by opposer in its Notice of Reliance and mentioned in opposer's (but not applicant's) brief. We proceed only on the individual marks pleaded in the original notice of opposition, which continues to be the operative notice in this proceeding.

- a. Status and title copies of opposer's Registrations Nos. 2028377, 2247035, 2407767, 2759537, 2861329, 2954836, 3024275 and 3330365.<sup>4</sup>
  - b. Certain of applicant's responses to opposer's first set of requests for admissions and opposer's first set of interrogatories.
2. Opposer's testimony depositions of:
    - a. Mr. Mark Garms, Opposer's Executive Vice-President and Chief Operating Officer, dated April 9, 2010;
    - b. Garms deposition dated April 23, 2010; and
    - c. Garms deposition dated October 27, 2010.<sup>5</sup>
  3. Applicant's notice of reliance, making of record, among other things:
    - a. A printout of third-party Registration No. 78403814, for Auto-By-Owner.
    - b. Printed publications; specifically Internet printouts showing a website controlled by opposer.

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<sup>4</sup>As stated above, opposer did not plead all of these registrations. We consider in our analysis, as did applicant in its trial brief, only those registrations which opposer pleaded in its notice of opposition.

<sup>5</sup> At the onset of the October 27 Garms deposition, applicant entered a standing objection to the entire deposition as improper rebuttal testimony, given that applicant had submitted no "evidence concerning Autobyte's mark or business." (Oct. 27 Garms depo. at 198). This objection might have been sustained and the October 27 Garms deposition stricken from the record had applicant properly preserved the objection in its trial brief. However, applicant instead stipulated the October 27 Garms deposition into the record along with the prior two depositions as "evidence of record" which "applicant relies upon." (App's brief at 6). Accordingly, we deem the objection to be waived.

c. Excerpts from applicant's answers to opposer's first set of interrogatories, for purposes of completing the record in accordance with Trademark Rule 2.120(j)(5).

#### **Standing and Priority**

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made of record its pleaded registrations for AUTO-BY-TEL, AUTOBYTEL, and others. This establishes opposer's standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). In view of opposer's ownership of these valid and subsisting registrations, there is no issue regarding opposer's priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

#### **Likelihood of Confusion**

Our determination under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & 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). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence.

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). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein. The relevant *du Pont* factors in the proceeding now before us are discussed below.

For our analysis of likelihood of confusion, we have focused solely on Registration No. 2028377 pleaded by opposer, since it covers the most relevant mark and the most relevant services. If we find a likelihood of confusion with applicant's services vis-à-vis this mark, then the analysis will be moot as to opposer's other pleaded marks. Likewise, if we do not, then we would not find it for the others.

Fame

Opposer claims that its marks, including AUTO-BY-TEL, "have won substantial fame and recognition." (oppr's brief at 11). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). A famous mark is one "with extensive public recognition and renown." *Id.* See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005).

In determining whether a mark is famous, we may consider relevant factors such as sales and revenue. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2s 1811, 1817 (TTAB 2005). Opposer's witness, Mr. Garms, in his April 9, 2010 deposition, submitted evidence of opposer's Form 10K to the Securities and Exchange Commission, for the fiscal year ended December 31, 2003 (Exhibit 5), as well as for the Fiscal year ended December 31, 2009 (Exhibit 38). The evidence shows revenues down from about \$90 million in 2003 to about \$52 million in 2009, with marketing expenses also down from about \$50 million in 2003 to about \$10 million in 2009. (Garms April

9 depo., Ex. 5 and 38). Opposer's "overview" statement in the 2009 10K described the flat sales and revenue as being due to "the recession" and the "bankruptcy reorganizations" being experienced by major car manufacturers Chrysler and General Motors, impacting automobile dealerships, and, in turn, referral services such as that run by opposer. *Id.*

Opposer's evidence also shows advertisements in magazines as diverse as *Time* magazine, *Parents* magazine, and *Working Women*, in the 1999 time frame, as well as an advertisement in *Automotive News* in 1999 "announcing that Autobytel had won the award for providing the best service - best online buying service according to *J.D. Power*." (Garms April 9 depo. at 92, and Ex. 9). The evidence further shows articles in the *Wall Street Journal*, the *Economist*, *USA Today*, *Better Homes & Gardens*, and other media, from the 1997-2000 timeframe. *Id.*, Ex. 12-15. Opposer advertised its "autobytel.com" website via commercials during the Superbowl in 1997 and 1998. *Id.* at 72 and 73.

Opposer offered evidence that it was ranked "#2" of "Top-Ranked Online Vehicle-Buying Services "in *Consumers Digest* in 2000. *Id.* at 438. Opposer also offered evidence that *Forbes* stated in a 2000 article, "Autobytel now accounts for nearly 50% of online car sales." *Id.* at 440. Similarly, *Ward's Dealer Business: Online Exclusive* in 2001 stated "Autobytel.com generates more vehicle sales online

than any other web site according to *J.D. Power and Associates' 2001 New Autosshop.com Study.*"

There are two problems with the various evidence of fame offered by opposer.<sup>6</sup> First, much of the "fame" is based on sales and revenue from its website, or websites. It is unclear how much fame would be attributed to any particular mark. Second, and more importantly, the vast bulk of evidence of fame is over a decade old, relating back to when the concept of an online car dealership referral service was new and newsworthy. One might draw the inference from the evidence offered by opposer that since the late-1990s, the media has not been covering opposer's business and services in the news nearly to the extent of the early heyday. With this record, and given the heavy burden of proving fame, we cannot find that opposer has satisfied that burden. Rather, we see what appear to be flat sales and decreasing market exposure over the past decade with the result of, what appears to be, if anything, declining renown. Indeed, opposer's own witness, Mr. Garms, described the results of a 2010 consumer results survey (on the confidential record) in less-than-positive terms, and certainly less than 2003 levels. (Garms April 23 depo. at

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<sup>6</sup>Applicant made a "hearsay" objection to some of the evidence, such as the Forbes article. The objection is overruled inasmuch as we do not consider the evidence for the truth of the matter but rather for the effect on the consuming public.

177). Accordingly, we find this *du Pont* factor to be neutral.

#### The Marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). In comparing the marks, we are mindful that 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 impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Opposer's mark, although not registered as a standard character mark, contains very little in the way of

stylization. It is effectively comprised of the words "AUTO-BY-TEL."

### **AUTO-BY-TEL**

Applicant's mark is written in a different, more stylized font, but also consists basically of just words, "Auto by Rent."



**Auto by Rent**

Accordingly, both marks have the same first two words, "AUTO\_\_BY\_\_," with only the third word differing. They both give the same commercial impression of a method of obtaining an automobile. Since they both consist of the same number of words and syllables, they have the same flow, and - despite their differing last words - they do not sound significantly different.

Consumers may easily believe that applicant's mark is simply another in a series offered by applicant, "AUTO\_\_BY\_\_," with applicant now offering in addition to "AUTO-BY-TEL," also "Auto by Rent."<sup>7</sup> This is particularly true where, as here, applicant has only been able to point to one third-party registration sharing the common term,

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<sup>7</sup>In this regard, we note that despite repeated mention by the dissent of the single state of Missouri, applicant seeks a nationwide registration.

"AUTO\_\_BY\_\_."<sup>8</sup> As our precedent dictates, duplicating the first part of a registered trademark may be found to result in a likelihood of consumer confusion. *See Cola-Cola Bottling Co. v. Joseph E. Seagrams & Sons, Inc.*, 526 F.2d 556 188 USPQ 105 (CCPA 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (CCPA 1967) (THE LILLY and LILLI ANN);

Accordingly, we find the dissimilarities of the marks to be outweighed by their similarities. This *du Pont* factor weighs in favor of finding a likelihood of consumer confusion.

#### The Services and Channels of Trade

It is well established that the goods and/or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods and/or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same source. *See Hilson*

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<sup>8</sup> Registration No. 3143022 for "Auto-By-Owner," for "advertising and marketing services, namely automotive marketing programs," in International Class 35.

*Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods and/or services, but rather whether there is a likelihood of confusion as to the source of the goods and/or services. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). The question of likelihood of confusion must be determined based on an analysis of the goods and/or services recited in applicant's application vis-à-vis the goods and/or services identified in opposer's pleaded registration(s). *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

Applicant seeks its registration for "automobile dealerships." Opposer's registration for AUTO-BY-TEL includes, among other things, Class 35 services for "electronic billboard advertising in the field of automobile and truck sales and leasing; computerized data base management in the field of automobile and truck sales and leasing; independent sales representative services in the field of automobiles and truck sales and leasing; shopper's guide information in the field of automobile and truck sales and leasing; and referrals in the field of automobile and truck sales and leasing."

It is axiomatic that we are bound by the stated recitation of services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) (“[t]he authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant’s goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.” [citations omitted]).<sup>9</sup>

It is apparent that at least some of the services identified by opposer are complementary to the “automobile dealerships” identified in the application. For example, “referrals in the field of automobile and truck sales and leasing” clearly indicates opposer’s business of making referrals to those who sell and lease automobiles, *i.e.*, automobile dealerships. This relationship is also supported by testimony and exhibits in the record. “Field salespeople

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<sup>9</sup>Despite the discussion by the dissent, we understand the term “automobile dealerships” to broadly encompass both new and used cars. That applicant may *currently* have a particular business model, such as offering rent-to-own vehicles rather than only new or only used vehicles, is not, and cannot be, part of our analysis. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d, *supra*, at 1787; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (directing the Board to “compare the services described in [applicant’s] application with the goods and services described in [opposer’s] registrations”); *In re Iolo Technologies, LLC*, 95 USPQ2d 1498 (TTAB 2010 (finding likelihood of confusion based on the identifications)).

are individuals that are located throughout the country in major market areas that are selling and managing dealer relationships." (Garms April 9 depo. at 10). "The largest amount of revenue that we have currently comes from our new car - what we call our new car retail leads. And retail means we're selling it directly to the dealer and we have a direct relationship with the dealer." *Id.* at 17. "We connect consumers to dealerships" *Id.* at 9; *See also Id.* Ex. 9, 12, 14, 15, 17. We have no question but that the services identified by applicant are complementary and related to those identified by the pleaded registration for AUTO-BY-TEL.<sup>10</sup>

In this regard, neither parties' recitation of services is limited in its channels of trade.<sup>11</sup> Accordingly, basing our analysis solely on the recitations, as we must, there is nothing to stop opposer from offering "referrals" to applicant's "automobile dealerships" as well as others. We must therefore presume that the services of applicant and opposer may be sold in the same channels of trade to the

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<sup>10</sup> The dissent seems to indicate that the term "automobile dealerships" may mean the franchising or selling of automobile dealerships, rather than the selling and leasing of vehicles. That is not our understanding of applicant's recitation, nor does applicant argue it. *See appl's brief at 13* ("Applicant's services are 'automobile dealership,' [sic] a specific type of retail establishment selling directly to consumers.")

<sup>11</sup> We discuss here the relevant services as discussed above, focusing, for example, on "referrals in the field of automobile and truck sales and leasing." We need not discuss every service in every class in the pleaded registration (or registrations), since it is only necessary that one identified service be related in order for us to find a likelihood

same classes of purchasers. Therefore, these *du Pont* factors also weigh in opposer's favor.

#### Consumer Sophistication

Opposer urges us to consider consumer sophistication. In this regard, as with the other *du Pont* factors, we are bound by the parties' respective identifications of goods or services. *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 16 USPQ2d at 1787. We have no doubt that opposer's various services, including its "referrals in the field of automobile and truck sales and leasing," could be sold to unsophisticated consumers, trolling the Internet. It is not clear to what extent the conditions of sale or purchasers of applicant's services may or may not be more sophisticated. Nevertheless, applicant concedes this factor, concluding in this section of its trial brief that "the conditions under which potential auto purchasers interact with opposer and applicant reduce the likelihood of confusion as to the source of the parties' services." (appl's brief at 22). We find this *du Pont* factor to be neutral.

#### Balancing the Factors

Considering all of the evidence of record as it pertains to the relevant *du Pont* factors, we conclude that

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of confusion with the application. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

the marks are similar and the services are complementary and related, and are likely to be marketed through the same channels of trade to all manner of consumers. Accordingly, we find a likelihood of confusion between opposer's mark

### **AUTO-BY-TEL**

for the services as pleaded, including "referrals in the field of automobile and truck sales and leasing," and applicant's mark



for "automobile dealerships."<sup>12</sup>

### **Dilution by Blurring**

Opposer contends that applicants' mark will dilute its famous AUTOBYTEL and other pleaded marks under Trademark Act § 43(c), 15 U.S.C. § 1125(c), by blurring their distinctiveness. Dilution by blurring is an "association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark," 15 U.S.C. §1125(c)(2)(B), and may be found "regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury," 15 U.S.C. §1125(c)(1).

"When an application to register a mark is challenged on grounds of dilution, we look to three elements: (1) whether the opposer's mark is famous; (2) whether the opposer's mark became famous prior to the date of the application to register the applicant's mark; and (3) whether the applicant's mark is likely to blur the distinctiveness of the opposer's famous mark." *National Pork v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479, 1494-5 (TTAB 2010).

Fame of Opposer's AUTOBYTEL Mark

We first turn to the factor of fame. A mark is defined under §1125(c)(2)(A) as "famous" for dilution purposes -

... if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

(i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties.

(ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark.

(iii) The extent of actual recognition of the mark.

(iv) Whether the mark was registered under the Act of March 3, 1881, or the

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<sup>12</sup> As discussed above, since we find a likelihood of confusion as to this mark, we need not consider the likelihood of confusion claim as to opposer's other pleaded marks.

Act of February 20, 1905, or on the principal register.

We discussed above in the "Likelihood of Confusion" section opposer's evidence of fame. As we noted therein, any renown that opposer may have experienced at one time has appeared to have significantly diminished since the late 1990s. Furthermore, it is unclear from opposer's evidence what "fame" may be attributed to any particular mark or to opposer's business in general. Overall, we simply cannot find sufficient evidence of fame, and certainly not enough to satisfy the high level needed for a plaintiff to prove dilution. Accordingly, we find in favor of applicant on opposer's claim of dilution by blurring.

**Decision:** The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.

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Bucher, Administrative Trademark Judge, concurring in part and dissenting in part:

I concur with the majority that we must dismiss the opposition based upon opposer's claim of dilution by blurring. However, I would also dismiss the opposition based upon opposer's failure to demonstrate a likelihood of confusion.

In denying opposer's motion for summary judgment earlier in this proceeding, we pointed out genuine disputes of material fact as to, *inter alia*, the similarity of the marks, the relatedness of the services and the respective channels of trade, as well as the degree of fame, if any, of opposer's mark.

The majority has correctly found that this record fails to show that opposer's **AUTO-BY-TEL** mark is well-known for purposes of likelihood of confusion. Similarly, as did the earlier panel, the majority above points out the fallacies of opposer's persistent use of the "family of marks" argument during this litigation.

Hence, I agree with the black-letter law cited by the majority, *supra*, that the likelihood of confusion case herein basically turns on the cumulative effects of the similarities/dissimilarities in the marks and the relationship of the services. However, I respectfully disagree with the manner in which the majority treated the evidence of record bearing on these two critical *du Pont* factors.

### ***Relationship of the services***

Applicant applied for services simply recited as "automobile dealerships."<sup>13</sup> The application file shows that

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<sup>13</sup> As correctly noted by opposer, applicant's online appeal is heavily targeted to other used car dealerships across the country,

applicant operates four lots of used cars in southwestern Missouri. By definition, used car dealers do not sell new cars. Opposer acknowledges that applicant serves the rent-to-own market of persons having bad credit and no money for a down-payment. Under applicant's business model, for at least two years after driving the car off the lot, the renter will make weekly payment, in person, to applicant. Presumably, consumers consigned to the rent-to-own car market in this small region of the country represent the total population of folks targeted by applicant, and this relevant market succinctly defines the trade channel of applicant's services.

By contrast, opposer is a nationwide automotive marketing services company that helps franchised dealerships to sell new automobiles. In fact, opposer's evidence, as quoted by the majority, *supra*, shows that the majority of opposer's revenue comes from its new car retail leads. Furthermore, on several occasions, the majority discusses opposer's recited service of "referrals in the field of automobile and truck sales and leasing." The service of referring prospective buyers of new automobiles to automobile dealerships in a particular region is a service

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urging them to purchase "Auto-by-Rent" franchises from applicant. If, perchance, this is what applicant means by "automobile dealerships," the services and trade channels would be quite different from that presumed by all members of this Board panel, namely, that rent-to-buy car consumers are indeed the primary target of applicant's services.

for the benefit of the dealers. In fact, consistent with this focus on serving the interest of the new automobile dealerships with whom opposer has contracted, opposer's [www.autobytel.com](http://www.autobytel.com) website does not provide potential consumers with much in the way of narrative descriptors, in-depth information, critical reviews by experts or even consumers' opinions about various models of new cars - features that have made other third-party websites such as [www.edmunds.com](http://www.edmunds.com) and [www.cars.com](http://www.cars.com)<sup>14</sup> popular and useful.

Hence, the record shows that opposer is directing its marketing services primarily to new car dealerships nationwide, with some collateral benefits for prospective buyers of new automobiles. By contrast, applicant is directing its rent-to-own used cars to marginal customers in rural Missouri - with clear designs on adding franchisees from the ranks of independent, used car dealers around the county. Closely related services? I think not -- even if applicant is presumed to be operating nationwide.

### ***Similarity of the Marks***

To me, opposer's **AUTO-BY-TEL** mark has a different appearance from applicant's **Auto by Rent** mark. "-Tel does not look at all like "Rent." Applicant's hand-drawn

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<sup>14</sup> Not to be confused with opposer's own [www.car.com](http://www.car.com) website, which seems designed, like applicant's [www.autobyrent.com](http://www.autobyrent.com) website, to reach prospective purchasers with bad, or no, credit.

designation having prominent "stylized streaks" is more reminiscent of the fins on a 1959 Cadillac Eldorado than something suggesting the creative efforts of a web-savvy merchant. The two marks, endings in "-Tel" and "Rent," are jarringly different aurally. Both the suffix "-Tel" and the final word, "Rent," provide a window into the respective services, and hence, they impart very different connotations. Consistent with opposer's fifteen-plus years of history, the "-TEL" suffix has over the years variously suggested television, telephone or telecom. By contrast, applicant's mark ends with the word "RENT" - a quite logical choice for its "rent-to-own" car services. Accordingly, even if the respective services were found to be more closely related than I have contended is true in the actual marketplace (when discussing the second *du Pont* factor above), given the different commercial impressions created by the respective marks, I would be comfortable finding that in this case, this single *du Pont* factor - the dissimilarity of the marks - should be dispositive of the likelihood of confusion issue. *See Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

I agree with applicant that "Auto-by" is suggestive for both of these respective services. Furthermore, comparing the marks in their entirety as to appearance, sound, connotation and commercial impression, I would argue that in

the actual marketplace (as reflected in this record), a buyer of a new car getting one-time, online leads from an "automobile-by-telecom" website expects something quite different than does a struggling Missourian who hopes to snag a deal on a used "automobile by renting to own" that comes packaged with two-years worth of weekly, face-to-face contacts with a used car dealer.

In conclusion, while the majority correctly denies opposer a family of marks in **AUTO-BY-TEL** under the ninth *du Pont* factor, their analysis of the similarity of the marks under the first *du Pont* factor seems to reward opposer with a much larger family, namely "**AUTO-BY.**" On this record, I would argue that such a result grants opposer a much greater scope of protection than that to which it is entitled.