

THIS OPINION
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Chase

Serial No. 78551005

Jeffrey A. Sadowski of Howard & Howard Attorneys, P.C. for
Darin Chase.

Lee-Anne Berns, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Seeherman, Grendel and Walsh, Administrative
Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

Darin Chase (Applicant) has filed an application to
register the mark HOMESITE MORTGAGE in standard characters
on the Principal Register for services identified as
"mortgage lending services" in International Class 36.¹
Applicant has disclaimed "MORTGAGE." The Examining

¹ Application Serial No. 78551005, filed January 20, 2005, based
on Applicant's bona fide intention to use the mark in commerce
under 15 U.S.C. § 1051(b)(1).

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Attorney² has finally refused registration under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), based on a likelihood of confusion between Applicant's mark and the marks in the following registrations:

Registration No. 2406834 for the mark HOMESITE in standard characters for "insurance services in the field of property, casualty, and homeowners insurance, namely, underwriting, claims administration, claims processing and risk management services";

Registration No. 2416450 for the mark HOMESITE HOME INSURANCE in standard characters for "insurance services in the field of property, casualty and homeowners insurance, namely, underwriting, claims administration and claims processing and risk management services" with "HOME INSURANCE" disclaimed;

Registration No. 2456050 for the mark shown here:



for "insurance services in the field of property, casualty and homeowners insurance, namely, underwriting, claims administration and claims processing and risk management services";

Registration No. 2513119 for the mark HOMESITE INDEMNITY in standard characters for "insurance services in the field of property, casualty and homeowners insurance, namely, underwriting, claims administration and claims processing and risk management services" with "INDEMNITY" disclaimed;

² A different examining attorney was responsible for the application until the filing of the appeal brief.

Registration No. 2530278 for the mark HOMESITE INSURANCE in standard characters for "insurance services in the field of property, casualty and homeowners insurance, namely, underwriting, claims administration and claims processing and risk management services" with "INSURANCE" disclaimed;

Registration No. 2932580 for the mark HOMESITE RENTERS EXPRESS in standard characters for "insurance services in the field of property, casualty, homeowners and renters insurance, namely underwriting, claims administration, claims processing and risk management services" with "RENTERS EXPRESS" disclaimed; and

Registration No. 2173292 for the mark HOMESITE in standard characters for "on-line database inquiry and posting services in the field of real estate, namely, dissemination of advertising for others in the field of real estate via on-line wide area, global computer networks, providing on-line sites and home pages."

Homesite Group Incorporated (registrant) owns all of the cited registrations, and each of the cited registrations is active. Applicant has appealed. Applicant and the Examining Attorney have filed briefs and presented arguments during a hearing in the case on October 11, 2007. We affirm the refusal as to each of the cited registrations, except Registration No. 2173292.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of

the applicant, to cause confusion..." 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the services of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The 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."). Below we will consider each of the factors as to which Applicant or the Examining Attorney presented arguments or evidence.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

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. As the Court of Appeals for the Federal Circuit observed, "...in

articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant argued in his briefs and at oral argument that his mark differs from the cited marks when the marks are viewed in their entirety because the inclusion of "MORTGAGE" in his mark effectively distinguishes his mark from each of the cited marks and because "HOMESITE" is weak. For example, Applicant states:

Here, the Examining Attorney has purposely chosen to lop off the "mortgage" portion of the Applicant's mark and conducted her analysis solely on the basis of the "homesite" portion of the Applicant's mark in comparison to the "homesite" portions of the cited registrations. This is clearly improper. The analysis should have been conducted on the basis of the whole mark... Taking this type of "dissected" examination to the extreme, the Examining Attorney could take a single syllable, or perhaps even a single letter, and declare "similarity" and thus likelihood of confusion between two or more competing marks.

Applicant's Reply Brief at 2-3.

Applicant argues further that the disclaimed term "MORTGAGE" in his mark and the disclaimed terms in the cited marks are of critical significance, if not dominant, in the comparison of the marks. Applicant states,

Just because a word has been disclaimed does not necessarily mean that it cannot be the dominant portion of the mark... In this instance, the word "mortgage" in the Applicant's mark (as well as the disclaimed portions of the Registrant's marks) convey a great deal of information to the ordinary consumer that would create a strong commercial impression thereupon.

Id. at 4.

The Examining Attorney disagrees, arguing that the marks, when viewed in their entirety, are similar because HOMESITE is the dominant element in Applicant's mark and in each of the marks in the cited registrations.

Applicant repeatedly cites the *National Data* decision in support of his position; the Examining Attorney also relies on *National Data*. In that case the Court of Appeals for the Federal Circuit affirmed a refusal to register the mark THE CASH MANAGEMENT EXCHANGE for "computerized cash management services" based on a prior registration for the mark CASH MANAGEMENT ACCOUNT for "financial services involving the use of plastic credit cards by the card holders for loans to card holders from their brokerage equity account." *In re National Data Corp.*, 224 USPQ at

749. We find the Examining Attorney's arguments, including her application of *National Data* to the facts of this case, persuasive. On the other hand, we find Applicant's arguments, in particular those based on *National Data*, unconvincing.

We conclude that HOMESITE is the dominant element in Applicant's mark as well as in each of the cited marks. In fact, HOMESITE is the only distinctive word element in Applicant's mark and in each of the cited marks. Moreover, in two of the cited registrations HOMESITE is the only element. There is no serious dispute that the term MORTGAGE in Applicant's mark, which Applicant disclaimed, is generic and not distinctive as applied to Applicant's "mortgage lending services." Likewise, there is no serious dispute that each of the additional terms in the cited marks, HOME INSURANCE, INDEMNITY, INSURANCE and RENTERS EXPRESS, each disclaimed, are likewise generic or descriptive and not distinctive as applied to the identified services. As such, the word elements in addition to HOMESITE in Applicant's mark and each of the cited marks are insufficient to distinguish the marks.

Applicant appears to miss the fundamental point of the analysis in *National Data*. We readily concede, as Applicant argues, that the additional disclaimed terms in

each of the marks convey significant information. However, the information relates to the nature of the identified services, not the source of the services. It is HOMESITE in each of the marks, Applicant's as well as the cited marks, which identifies the source of the services in each instance. And, it is the source identifying element or elements which are dominant and most important in determining likelihood of confusion. Therefore, we conclude that HOMESITE is the dominant word element in Applicant's mark and in each of the cited marks.

Also, in the case of the mark in Registration No. 2456050 which includes the word HOMESITE and a design element, here too it is the word element, HOMESITE, which is dominant. In *re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). In *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987), the Board stated, "Thus, if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985)."

We also find Applicant's attempt to show that HOMESITE is weak unconvincing. To support that contention Applicant submitted a copy of a dictionary definition of "homesite" as

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"a location of or suitable for a home" and copies of three third-party registrations: Registration No. 2730270 for the mark HOMESITEPRO for "providing online computer database in the field of building plans, building contents, building owner information, models, warranties and policies"; Registration No. 2557977 for the mark MYHOMESITE for "providing an online computer database in the field of building plans, building contents, building owner information, models, warranties and policies," both owned by a single entity; and Registration No. 2784319 for the mark LOTSMOREHOMESITES.COM for "providing information in the field of real estate in the nature of a website featuring tours of residential and commercial real estate." We find this evidence insufficient in quality and quantity to establish that "HOMESITE" is weak as used in Applicant's mark or any of the cited marks. There are significant differences between the marks and the goods and services identified in these registrations and the application and registrations at issue here. Also, even if "homesite" has a suggestive meaning here, as the dictionary entry may indicate, it is entitled to protection. *Hollister v. Ident A Pet, Inc.*, 193 USPQ 439, 442 (TTAB 1976). This is especially so here where HOMESITE is the only distinctive word element in the marks at issue.

Accordingly, when we consider Applicant's mark and the cited marks in their entireties, we conclude that Applicant's mark is highly similar to each of the cited marks in appearance, sound, connotation and commercial impression.

The Services

The services in the application and cited registrations need not be identical to find a likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). *See also On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the services and the channels of trade for the services, we must consider the services as identified in the application and registrations. *See Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The 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.") See also *Paula Payne Products v. Johnson Publishing Co.*, 177 USPQ at 77 ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Also, the proper inquiry is not whether the services themselves could be confused, but rather whether the source of the services could be confused. *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

Here again, Applicant argues strenuously that his services are distinct from the services in the cited registrations. Applicant states, "The only possible similarity between HOMESITE MORTGAGE and the cited marks is the fact that the services are somewhat related to real estate. Such a broad relationship is insufficient to create a likelihood of confusion." Applicant's Brief at 7. Applicant argues further,

Listing services and property management services are very different from mortgage lending services, which requires that a provider have an

extensive financial background and understanding. Mortgage lending is also very different from insurance services. Both services are independently regulated by the government, and providers of each service have to meet certain separate certification requirements. Additionally, buyers purchase insurance and mortgages for extremely different reasons.

Id. at 8.

The Examining Attorney argues that the services in the application and the cited registrations are related and submitted several use-based, third-party registrations for marks which have been registered for both Applicant's services and the services in the cited registrations, including the following:

Registration No. 1801075 which identifies, among other services, "mortgage lending services... insurance administration services... property insurance underwriting services, casualty insurance underwriting services, insurance brokerage services";

Registration No. 1804767 which identifies, among other services, "financial services; namely, mortgage lending... and insurance agency and brokerage services in the field of mortgage protection, fire, disability and homeowners insurance";

Registration No. 2316911 which identifies, among other services, "personal lines insurance underwriting services, namely... homeowner's and umbrella insurance coverage... mortgage lending services...";

Registration No. 2545847 which identifies, among other services "mortgage lending services and insurance services, namely, brokerage, consultation, and underwriting in the fields of

mortgage financing for purchase loans, refinance loans, and equity loans, and homeowners insurance, home warranty insurance..."; and

Registration No. 2863176 which identifies, among other services, "insurance services, namely, providing insurance and annuity brokerage and underwriting services in the field of... property insurance... insurance agencies, insurance consultation and brokerage in the fields life, property and casualty... financial services, namely, mortgage lending, and mortgage financing...."

These registrations, and the others submitted by the Examining Attorney, indicate that the financial and insurance services in the application and the cited registrations are of a type which may emanate from the same source. *In re TSI Brands Inc.*, 67 USPQ2d 1657, 1659 (TTAB 2002); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

We find Applicant's arguments regarding the services unpersuasive. Contrary to Applicant's arguments, there is substantially more to the relationship between his services and the services identified in the cited registrations than the mere fact that they are all "somewhat related to real estate." In fact, Applicant's services and the services identified in the cited registrations, with the exception of Registration No. 2173292, are all financial services related to real estate. Furthermore, as the evidence

indicates, Applicant's mortgage lending services and insurance services, are the types of services which may emanate from the same source.

Accordingly, based on the evidence the Examining Attorney provided, we conclude that Applicant's services and the services identified in the cited registrations, with the exception of Registration No. 2173292, are related.

Registration No. 2173292 covers "on-line database inquiry and posting services in the field of real estate, namely, dissemination of advertising for others in the field of real estate via on-line wide area, global computer networks, providing on-line sites and home pages." In the absence of evidence establishing that these services are related to mortgage lending services, we conclude that these services are not related to Applicant's services. Consequently, we find that the Office has not established a likelihood of confusion based on Registration No. 2173292.

Other Factors

Applicant has also argued that there is no likelihood of confusion in this case based on a number of additional *du Pont* factors. Even though we find those arguments unpersuasive, we will address the principal arguments briefly.

Applicant argues that confusion is not likely because "the services associated with each respective mark are expensive, risky and complex." Applicant's Brief at 9. Applicant argues further, "Also, the prospective customers are generally very sophisticated, and prospective customers will necessarily exercise a great deal of care in determining the source of the services." *Id.* Applicant also argues, "No consumer, of even dubious sophistication, will be confused into patronizing a mortgage company when attempting to purchase insurance..." *Id.* at 10. Applicant caps these arguments by stating, "No doubt prospective customers will be acutely aware of the respective companies/sources that are providing these services, thereby eliminating any possibility of confusion." *Id.* at 11.

We readily acknowledge that potential customers for mortgage lending services and insurance services generally do not act on impulse but exercise a degree of care in the purchasing decision. On the other hand, the potential purchasers of these services include the general public with widely varying degrees of sophistication. In his arguments, Applicant places an undue burden on the purchaser. Applicant effectively presumes that, under the circumstances, potential purchasers will be able to

distinguish the source of the respective services even if they are offered under similar marks. This is contrary to logic and the law. Even sophisticated purchasers are not immune from trademark confusion. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983). Accordingly, we conclude that the circumstances surrounding the purchase of the services at issue here and the sophistication of the purchasers in no way diminish the likelihood of confusion in this case.

Applicant also points to an example of registrations owned by different parties for services including banking services and insurance services. The marks in question each include the word "CENTRAL" as an element. Applicant argues that we should permit registration of his mark based on that example. However, we must decide each case on its merits based on the record before us. Actions on prior applications based on different facts do not dictate the result in later cases. *See In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Accordingly, we reject this argument.

In similar fashion, Applicant cites to a number of cases, arguing that those dictate a reversal here. In particular, in both his briefs and in oral argument Applicant repeatedly cited *Allstate Insurance Co. v.*

Allstate Investment Corp., 210 F.Supp. 25, 136 USPQ 156 (W.D. La. 1962), as well as other cases originating in U.S. district courts. These cases involve infringement and other similar claims and, as such, have limited applicability to the registration issues before us here. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Suffice it to say that we have considered all of Applicant's arguments, including arguments based on these cases, and arguments not specifically discussed here, and found them unpersuasive.

Finally, based on our consideration of all evidence and arguments bearing on the *du Pont* factors we conclude that there is a likelihood of confusion between Applicant's mark and the marks in the cited registrations, with the exception of Registration No. 2173292. We conclude so principally because Applicant's HOMESITE MORTGAGE mark is highly similar to each of the cited marks and because Applicant's mortgage lending services are related to the insurance services identified in the cited registrations.

Decision: We affirm the refusal under Trademark Act Section 2(d).