

This Opinion is not a
Precedent of the TTAB

Mailed: August 22, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re VacationFutures Inc.
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Serial No. 86634983
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Matthew H. Swyers of The Trademark Company PLLC,
for VacationFutures Inc.

Seth A. Rappaport, Trademark Examining Attorney, Law Office 104,
Dayna Browne, Managing Attorney.

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Before Quinn, Kuczma and Lynch,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

VacationFutures Inc (“Applicant”) seeks registration on the Principal Register of
the mark RENTED.COM (in standard characters) for:

Computer services, namely, providing search platforms to
allow users to request content from and receive content to
a computer or mobile device in relation to real estate in
International Class 42.¹

¹ Application Serial No. 86634983 was filed on May 19, 2015, based upon Applicant’s
allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the
Trademark Act, 15 U.S.C. § 1051(b).

The Trademark Examining Attorney refused registration of Applicant’s mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), in view of the following three registrations owned by Rentpath, LLC:

Registration No.	Register	Mark	Services
2857033 ²	Supplemental	RENT.COM	Providing a web site guide at which owners and managers of residential real property promote their properties to prospective renters (International Class 35); Providing text and photographic information over the Internet concerning the availability, price, location and description of residential real property of others to prospective renters (Class 36)
4316046 ³	Principal		Providing a real estate website which allows owners and managers of residential real property to promote their housing and apartment properties through offering prospective tenants video walk throughs, property descriptions, text, price, location, maps and other information that would be influential to a prospective tenant in making a rental decision (Class 35); and

² Registered June 22, 2004; renewed.

³ Registered April 9, 2013. The mark consists of a stylized depiction of a house with a shadow behind it and the wording “RENT.COM” presented in stylized font. The house is situated above “.COM”. “RENT.COM” is disclaimed.

			<p>Providing real estate rental information online, namely, providing text and photographic information over the Internet concerning the availability, price, location and description of residential real property of others to prospective renters; Providing an on-line searchable interactive website featuring information in the field of real estate, namely, providing a website where prospective renters search for residential real property to rent; Providing a website with real estate rental listings where users may post or respond to</p>
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			<p>advertisements seeking roommates attached to those listings (Class 36)</p>
4341226 ⁴	Principal		<p>Providing real estate rental information online, namely, providing text and photographic information over the Internet concerning the availability, price, location and description of residential real property of others to prospective renters; Providing an on-line searchable interactive website featuring information in the field of real estate, namely, providing a website where prospective renters search for residential real property to rent; Providing a website with real estate rental listings where users may post or respond to advertisements seeking roommates attached to those listings (Class 36); Providing on-line electronic bulletin boards for transmission of messages among computer users concerning residential real property to rent in Class 38;</p>

⁴ Registration 4341226 issued on May 28, 2013. The mark consists of a stylized depiction of a house with a shadow behind it. To the right of the design is the wording “RENT.COM” presented in stylized font. “RENT.COM” is disclaimed.

			computer services in the nature of customized web pages featuring user-defined information (Class 42)
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Additionally, registration of Applicant’s mark was refused under § 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), on the ground that the mark is merely descriptive of the identified services.

After the Trademark Examining Attorney made the refusals final, Applicant appealed to this Board. For the reasons set forth below, we affirm the refusals to register.

I. Preliminary Matter

Applicant’s Brief did not address the § 2(e)(1) refusal, which was addressed by the Trademark Examining Attorney. Applicant argued only against the refusal based on likelihood of confusion under § 2(d). Nor did Applicant file a reply brief, despite the fact that the Examining Attorney’s brief addressed the refusals under both §§ 2(d) and 2(e)(1). However, it is still the USPTO’s burden to show that registration should be refused pursuant to §2(e)(1). *See In re Chengdu AOBI Info. Tech. Co.*, 111 USPQ2d 2080, 2082 (TTAB 2011).

II. Likelihood of Confusion Under § 2(d)

Our determination under § 2(d) of the Trademark Act 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 Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services at issue. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We carefully considered all of the evidence of record and arguments as they pertain to the relevant *du Pont* factors (including any evidence and arguments not specifically discussed in this opinion). To the extent that any other *du Pont* factors for which no evidence or argument were presented may nonetheless be applicable, we treat them as neutral.

A. Similarity of the Marks

It is well settled that marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F. 3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014) (citing *In re 1st USA Realty Prof’ls, Inc.*,

84 USPQ2d 1581, 1586 (TTAB 2007)); *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988).

Applicant's mark is RENTED.COM while Registrant's marks either consist entirely of the wording RENT.COM, or the dominant word portion of the mark is RENT.COM. The Examining Attorney submitted the definition of "rented" as "used by someone who pays rent to the owner"⁵ to support the close relationship in meaning between "rent" and "rented." Thus, Applicant's mark is highly similar to Registrant's mark or to the dominant portion of Registrant's marks, with respect to sound, appearance and commercial impression.

Marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *American Optical Corp. v. Siemens Aktiengesellschaft*, 213 USPQ 510 (TTAB 1982) (AOT for medical X-ray machinery held likely to be confused with AO for heart-lung machines, oxygen exchange equipment, catheters, cardiac resuscitation instruments and the like).

⁵ See Office Action of 9/1/2015, p. 50, MacMillan Dictionary, <http://www.macmillan.com/dictionary/american/rented#rented> 3.

For Registrant's composite marks containing both words and a design, the "RENT.COM" word portion may be considered the dominant and most significant feature of the marks because it is more likely to be impressed upon a purchaser's memory and to be used when requesting the services. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); see *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983)). Thus, although Applicant's and Registrant's marks must be compared in their entirety, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where, as in this case, the word portions of Registrant's Principal registrations have been disclaimed. *In re Viterra Inc.*, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In addition, in the ultimate determination of similarity of the marks, the Board must consider the RENT.COM marks in their entirety, including the disclaimed portion. See *In re Viterra Inc.*, 101 USPQ2d at 1911 citing *Giant Food*, 218 USPQ at 395 ("[I]t is well settled that the disclaimed material still forms a part of the mark and cannot be ignored in determining likelihood of confusion.").

Furthermore, the wording "rent" is the first syllable in Applicant's mark and is the first word in Registrant's marks. Consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay*

Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ2d at 1692; *Presto Prods., Inc. v. Nice-Pak Prods., 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” when making purchasing decisions). This is especially so when the second syllable in Applicant’s marks is merely “-ed,” indicating the past tense of the shared word “rent” in the marks.

Additionally, the rest of Applicant’s mark consists of the non-source identifying generic top-level (gTLD) domain “.com” which is also found at the end of Registrant’s marks. The inclusion of “.COM” located at the end of both Applicant’s mark and Registrant’s marks contributes to the similar look and sound of the marks.

Applicant contends that Applicant’s mark and Registrant’s marks are not confusingly similar because they differ in appearance, noting that two of Registrant’s marks contain stylization and design elements that distinguish them from Applicant’s mark. However, Applicant’s mark is in standard character form. A mark in standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterra Inc.*, 101 USPQ2d at 1909; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010). Thus, Applicant would have the right to use its mark in any stylization, including stylization that is identical or similar to the stylization utilized in Registrant’s marks. As to the house designs set forth in Registration Nos. 4,316,046 and 4,341,226 owned by Registrant, they merely

reinforce the rental of residential real property services offered by Registrant, and thus do not distinguish the marks from Applicant's.

Applicant also argues that a likelihood of confusion does not exist in this case because Registrant's marks are weak. However, marks deemed "weak" or merely descriptive are still entitled to protection against the registration by a subsequent user of a similar mark for closely related goods and/or services. *See In re Colonial Stores, Inc.*, 216 USPQ 793, 795 (TTAB 1982) ("even weak marks are entitled to protection against registration of similar marks"). This protection extends to Registrant's mark that is registered on the Supplemental Register. *See, e.g., In re Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 340 (CCPA 1978); *In re Hunke & Jochheim*, 185 USPQ 188, 189 (TTAB 1975).

When comparing marks, the test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. *Midwestern Pet Foods, Inc. v. Societe des Produits Nestle S.A.*, 685 F.3d 1046, 103 USPQ2d 1435, 1440 (Fed. Cir. 2012); *In re Davia*, 110 USPQ2d at 1813. The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1049 (TTAB 2014); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

Considering all of the above, the marks are sufficiently similar to cause a likelihood of confusion under § 2(d) of the Trademark Act if the same or similar services are rendered thereunder.

B. Similarity of Services

We turn now to the *du Pont* factor involving the relatedness of the parties' services and keep in mind that it is not necessary that the respective services be similar or competitive to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some manner, or that the circumstances surrounding their marketing of the services are such that they would be likely to 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 originated from the same producer. *See In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Davia*, 110 USPQ2d at 1816-17; *In re Accelerate s.a.l.*, 101 USPQ2d 2047, 2050 (TTAB 2012); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993).

The evidence submitted by the Examining Attorney consisting of websites of entities that provide the types of services offered by Applicant and Registrant establish that the same entity commonly markets and provides the relevant services under the same mark, and that the relevant services are sold or provided through the same trade channels and to the same classes of consumers in the same fields of use:

- Zillow provides search platforms allowing users to request content from and receive content in relation to real estate. Zillow also provides a real estate website which allows owners and managers of residential real

property to promote their housing and apartment properties and an online searchable interactive website featuring information in the field of real estate, where prospective renters search for residential real property to rent. (Office Action of 09/01/2015, pp. 16-28)

- Realtor.com provides search platforms allowing users to request content from and receive content in relation to real estate while also providing the Registrant's services in the nature of a real estate website that allows users to search for information about real estate and find information about real estate. Realtor.com also promotes housing and apartment properties for sale and for rent. (Office Action of 09/01/2015, pp. 29-32)
- PropertyShark.com provides a search platform allowing users to search for property information, property maps, property values, and property photos for commercial and residential real estate properties. (Office Action of 09/01/2015, pp. 33-35; Final Office Action of 11/06/2015, pp. 60-62)
- Trulia provides a search platform that allows users to search for property information, property maps, property values, and property photos for residential real estate properties. Trulia also promotes housing and apartment properties for sale and for rent. (Final Office Action of 11/06/2015, pp. 21-27)
- HomeFinder.com provides search platforms to allow users to request content from and receive content in relation to real estate while also providing the registrant's services in the nature of a real estate website that allows users to search for information about real estate and find information about real estate. Realtor.com also promotes housing and apartment properties for sale and for rent. (Office Action of 09/01/2015, pp. 44-46; Final Office Action of 11/06/2015, pp. 21-23)

Evidence obtained from the Internet may be used to support a determination under § 2(d) that the services are related. *See, e.g., In re Paper Doll Promotions, Inc.*, 84 USPQ2d 1660, 1668 (TTAB 2007). Thus, we find Applicant's and Registrant's services related for likelihood of confusion purposes. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1202-03 (TTAB 2009); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271-72 (TTAB 2009).

Further, generally, the greater degree of similarity between the applied-for mark and the registered mark, the lesser the degree of similarity between the services of the respective parties that is required to support a finding of likelihood of confusion. *In re Davey Prods. Pty Ltd.*, 92 USPQ2d at 1202; *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). Therefore, with the contemporaneous use of highly similar marks, consumers are likely to conclude that the services are related and originate from the same source.

Upon consideration of this factor, we find that Applicant's use of RENTED.COM for "providing search platforms to allow users to request content from and receive content to a computer or mobile device in relation to real estate" is likely to cause confusion with Registrant's RENT.COM marks for "... providing text and photographic information over the Internet concerning the availability, price, location and description of residential real property of others to prospective renters; ... providing a website where prospective renters search for residential real property to rent."

III. Descriptiveness Under § 2(e)(1)

Matter that "merely describes" the services on or in connection with which it is used is not registrable on the Principal Register. A mark is considered merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the specified goods or services. *See In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) (APPLE PIE held merely descriptive of potpourri); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986) (BED &

BREAKFAST REGISTRY held merely descriptive of lodging reservations services); *In re Fat Boys Water Sports LLC*, 118 USPQ2d 1511, 1514 (TTAB 2016) (HOUSEBOAT BLOB descriptive of inflatable float mattresses and pads for recreational use).

Additionally, it is not necessary that a term describe all of the purposes, functions, characteristics or features of a service to be considered merely descriptive; it is enough if the term describes one significant function, attribute or property of the services. *See In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004) (“A mark may be merely descriptive even if it does not describe the ‘full scope and extent’ of the applicant’s goods or services,” *citing In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001)); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1332 (TTAB 2014); *In re ICE Futures U.S. Inc.*, 85 USPQ2d 1664, 1665 (TTAB 2008).

The Examining Attorney submitted Internet evidence from various websites⁶ showing that the terms “rent,” “rental” or “rented,” are commonly used by entities providing services identical or similar to Applicant’s services to describe to consumers that the services feature information about rented real estate properties or real estate properties that are available for rent, including:

- Realtor.com uses the heading RENTAL PROPERTIES to describe the types of properties that users can search for using their search platform. (Final Office Action of 11/06/2015, pp. 66-68)

⁶ See Office Action of 9/1/2015 and Final Action of 11/6/2015.

- Rentals.com provides a website where users can search for rental properties. The website states that Rentals.com is “[y]our online source for rental homes, apartments and houses for rent!” The website also states that “Rentals.com makes it quick and easy for tenants to search for rental homes.” (Final Office Action of 11/06/2015, pp. 69-72)
- MyNewPlace uses the heading HOMES FOR RENT to describe the types of properties that users can find using their search platform. (Final Office Action of 11/06/2015, pp. 73-74)
- Homes.com uses the heading SEARCH HOUSES FOR RENT IN MARYLAND to describe the function or feature of the search platform on their website. (Final Office Action of 11/06/2015, pp. 82-83)

Applicant’s services provide search platforms that allow users to request content from and receive through a computer or mobile device content in relation to real estate properties that have been rented or are available for rent. Thus, Applicant’s applied-for mark is merely descriptive of the identified services.

As to the generic top-level domain (gTLD) “.COM” contained in the mark, the non-source identifying gTLD “.com” merely indicates an internet address for use by commercial, for-profit organizations. *See, e.g., In re 1800Matters.com IP LLC*, 586 F.3d 1359, 92 USPQ2d 1682, 1685 (Fed. Cir. 2009); *In re Hotels.com, L.P.*, 573 F.3d 1300, 91 USPQ2d 1532, 1535 (Fed. Cir. 2009). As a general rule, the addition of a gTLD to otherwise unregistrable wording (*i.e.*, merely descriptive or generic) does not add source-indicating significance except in “unique” or “exceptional” circumstances. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372-74 (Fed. Cir. 2004). While the attachment of a gTLD to the other descriptive portion of a mark could enhance the prospects of registrability for the mark as a whole, as in for example, TENNIS.NET, which produces a witty double entendre relating to tennis

nets, gTLDs will most often not add any source-identifying function to a mark. *In re Oppedahl & Larson*, 71 USPQ2d at 1373. Thus, adding “.com” to an otherwise unregistrable mark typically does not render the mark registrable. *See In re Oppedahl & Larson LLP*, 71 USPQ2d 1374; *In re Steelbuilding.com*, 415 F.3d 1293, 75 UPSQ2d 1420, 1422 (Fed. Cir. 2005) (“Only in rare instances will the addition of a [g]TLD indicator to a descriptive term operate to create a distinctive mark.”).

Here, no such exceptional circumstances exist. The “RENTED” portion of the applied-for mark is unregistrable by itself, and the addition of the “.COM” gTLD does not create a witty double entendre or add any other significance capable of identifying source or acquiring distinctiveness. Thus, when they are combined, the wording and the gTLD retain their usual meanings. If each component retains its descriptive significance in relation to the services, the combination results in a composite that is itself descriptive. *See, e.g., In re Petroglyph Games Inc.*, 91 USPQ2d 1332, 1341 (TTAB 2009) (BATTLECAM merely descriptive for computer game software); *In re Putman Publ’g Co.*, 39 USPQ2d 2021, 2022 (TTAB 1996) (FOOD & BEVERAGE ON-LINE merely descriptive of a news and information service for the food processing industry).

Decision: The refusals to register Applicant’s mark RENTED.COM under Sections 2(d) and 2(e)(1) of the Trademark Act are affirmed.