

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: November 20, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Roost Living LLC

—
Serial No. 88186224

Wade J. Savoy of Patent GC LLC,
for Roost Living LLC.

Patty Evanko, Trademark Examining Attorney, Law Office 119,
Brett J. Golden, Managing Attorney.

—
Before Wellington, Adlin and Lebow,
Administrative Trademark Judges.

Opinion by Lebow, Administrative Trademark Judge:

Applicant, Roost Living LLC, applied to register the mark ROOSTUP, in standard characters, on the Principal Register for “roommate vetting, matching, and referral services,” in International Class 35, and “rental of real estate; rental of apartments; rental of real estate featuring residential co-living housing; rental of furnished and equipped apartments; rental of real estate featuring furnished and equipped residential co-living housing; real estate management services,” in International

Class 36.¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, when used in connection with the identified services, so resembles the registered marks listed below, owned by different entities, as to be likely to cause confusion:

ROOST, in standard characters, for "Real estate services, namely, rental of short-term furnished apartments," in International Class 36, and "Hotel services; providing temporary housing accommodations; residential hotel services," in International Class 43;²

RENTAL ROOST, in standard characters, for "Providing an interactive website matching potential individual renters with rental properties based on needs and preferences regarding lifestyle, amenities, location, and budget with rental properties available for rent from others," in International Class 35;³ and



for "Real estate brokerage excluding the rental of short-term furnished apartments," in International Class 36;⁴

When the refusal was made final, Applicant filed a request for reconsideration, which was denied. Applicant then filed an appeal. The appeal is fully briefed.

We reverse the refusal.

I. Applicable Law

The fundamental purpose of Trademark Act § 2(d) is to prevent confusion as to source, and to protect registrants from damage caused by registration of confusingly

¹ Application Serial No. 88186224 was filed on November 8, 2018 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging first use dates of August 1, 2017.

² Registration No. 4637862, registered November 11, 2014; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

³ Registration No. 5066654, registered October 25, 2016.

⁴ Registration No. 5288744, registered September 19, 2017.

similar marks. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 224 USPQ 327, 331 (1985). Our analysis is based on all of the probative evidence of record. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (“*DuPont*”). In making our determination, we consider each *DuPont* factor for which there is evidence and argument. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019). Varying weights may be assigned to each *DuPont* factor depending on the evidence presented. *See Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993) (“[T]he various evidentiary factors may play more or less weighty roles in any particular determination”).

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

A. Similarity of the Services

We begin our analysis under the second *DuPont* factor, which considers the “similarity or dissimilarity and nature of the goods or services as described in an application or registration.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d

1047, 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). It is “not necessary that the [services] be identical or even competitive to support a finding of a likelihood of confusion.” *Coach Servs. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven, Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)). “[L]ikelihood of confusion can be found ‘if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.’” *Id.*

The Examining Attorney asserts that Applicant’s services are identical in part to the services in the ROOST and RENTAL ROOST registrations.⁵ “Specifically, the applicant’s Class 35 services and the services in Reg. No. 5066654 both include roommate matching services, and the applicant’s Class 36 services and Reg. No. 4637862 both include real estate rental services.”⁶

We agree that the ROOST registration’s “rental of short-term furnished apartments” services are encompassed by Applicant’s “rental of real estate,” “rental of apartments,” and “rental of furnished and equipped apartments” services, and therefore are legally identical in part. However, contrary to the Examining Attorney’s contention, the RENTAL ROOST registration’s services of “providing a website matching potential individual renters **with** rental properties” are not identical in part to Applicant’s roommate matching services. The former matches renters with

⁵ 9 TTABVUE 10 (Examining Attorney’s Brief).

⁶ *Id.*

properties, while the latter matches roommates. Nevertheless, they are similar, since the same consumers would use both types of services.

The Examining Attorney also asserts that Applicant's real estate rental services are related to the real estate brokerage services in the  registration because such services "commonly emanate from the same source."⁷ In support, she provided a printout from that registrant's website showing its "use of the mark in connection with real estate rental services, in addition to [its] real estate brokerage services," as well as nine use-based third-party registrations covering both types of services.⁸ While third-party registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, such registrations that individually cover a number of different items and are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from a single source. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Applicant does not dispute or address the alleged similarity between its services and those of the cited registrations.

Further to the third-party registration evidence provided by the Examining

⁷ *Id.*

⁸ February 14, 2019 Office Action, TSDR 14-50.



Attorney, we agree that the registration's "real estate brokerage excluding the rental of short-term furnished apartments" services are related to Applicant's real estate and apartment rental services. The second *DuPont* factor thus weighs in favor of finding likelihood of confusion, and especially so in the case of the cited ROOST registration.

B. Similarity of Trade Channels

The third *DuPont* factor considers "the similarity or dissimilarity of established, likely-to-continue trade channels." *In re Detroit Athletic Co.*, 128 USPQ2d at 1051 (quoting *DuPont*, 177 USPQ at 567). Neither the Examining Attorney nor Applicant provided evidence and argument regarding trade channels. However, in the case of the ROOST registration, because the services are identical in part, we must also presume that the trade channels and classes of purchasers are identical for such services. *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the [services] are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion). As



to the RENTAL ROOST and registrations, although there is no evidence specifically addressing this point, obviously some of the people that need housing also need roommates, and they would be expected to sometimes search for

both at the same time. The fourth *DuPont* factor thus weighs in favor of finding likelihood of confusion.

C. Weakness of the Common Element ROOST

We turn now to the sixth *DuPont* factor, which considers the number and nature of similar marks in use for similar services, *DuPont*, 177 USPQ at 567, the main focus of Applicant's argument on appeal. In determining the strength of a mark, we consider both its inherent strength, based on the nature of the mark itself, and, if there is evidence in the record of marketplace recognition of the mark, its commercial strength. See *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014) (citing *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) ("A mark's strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning.)"); *Top Tobacco, L.P. v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1171-72 (TTAB 2011) (the strength of a mark is determined by assessing its inherent strength and its commercial strength).

Applicant challenges both the conceptual strength and the commercial strength of the cited marks. With respect to the conceptual strength of the word "roost," Applicant relies on a dictionary definition of "ROOST" as meaning "a place for sitting, resting, or lodging," which it argues "connotes the comfort and security of a home" and is conceptually weak because it is "highly suggestive of the services in the three prior registrations."⁹ The Examining Attorney does not discuss the definition of

⁹ 7 TTABVUE 5-6 (Applicant's Brief). Applicant provided an excerpt and link to that definition from dictionary.com (based on The Random House Unabridged Dictionary) in its

ROOST provided by Applicant, or the conceptual weakness of that term in relation to real estate-related services.

Applicant also points to coexistence of the marks in the cited registrations with each other, plus a fourth mark, SHELTER + ROOST, in third-party registration No. 4850441 for real estate-related services,¹⁰ to show that the mark is conceptually weak.¹¹ The Examining Attorney brushes aside that argument because the cited registrations “were presumably allowed to co-exist due to the slight differences in the nature of [their] services,” and the fourth registration “was not cited against the applicant.”¹² However, we may use third-party registrations like a dictionary. *See Institut Nat’l Des Appellations D’Origine v. Vintners Int’l Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations show the sense in which a word is used in ordinary parlance and that a particular term has descriptive significance as applied to certain goods or services); *Gen. Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1972) (“Although the registrations are not

brief and requests that the Board to take judicial notice of it. The Examining Attorney did not object to the request While the record should be complete upon filing of the appeal, Trademark Rule 2.142(d), 37 C.F.R. § 2.142(d), the Board may take judicial notice of dictionary definitions from online sources when the definitions themselves are derived from dictionaries that exist in printed form or have regular fixed editions, and we do so here. *See In re White Jasmine LLC*, 106 USPQ2d 1385, 1392 n.23 (TTAB 2013); *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006); (<https://www.dictionary.com/browse/roost?s=t>, accessed on November 17, 2020).

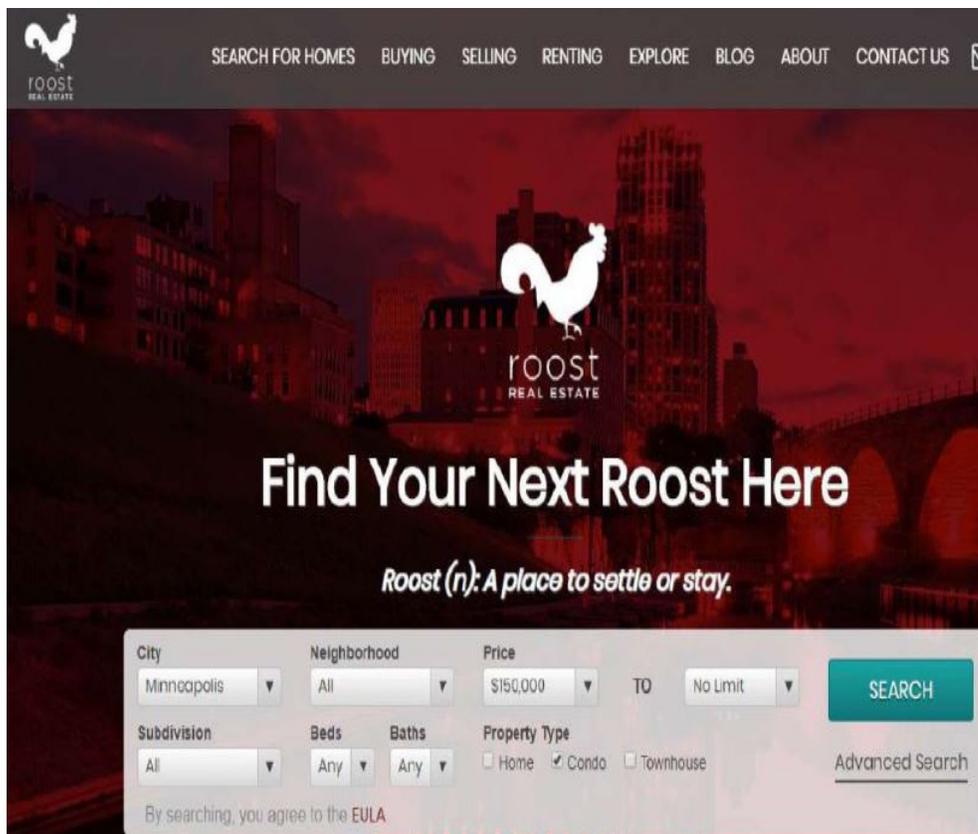
¹⁰ Registration No. 4850441, which registered November 10, 2015, identifies “Real estate services, namely, acquisition, rental, brokerage, leasing, management and valuation of real property, commercial property, offices and office space.” Applicant’s August 12, 2019 Response to Office Action, TSDR 35-36.

¹¹ 7 TTABVUE 4-5 (Applicant’s Brief).

¹² 9 TTABVUE 12-13 (Examining Attorney’s Brief).

evidence of use, the registrations show the sense in which the term is employed in the marketplace, similar to a dictionary definition.”).

Based on the dictionary evidence, which is corroborated by the four registered marks, we agree with Applicant that in the context of real estate services such as those identified in the registrations, the word “ROOST” is highly suggestive and thus conceptually quite weak. In addition, one of the third-party websites discussed below that Applicant relies on to demonstrate commercial weakness also shows how real estate services providers use the ROOST, as well as its importance to the industry by including its definition:¹³



¹³ August 12, 2019 Response to Office Action, TSDR 20.

Applicant asserts that it “submitted a substantial number of third-party uses of marks containing ‘roost’ for various real estate services and closely related services,”¹⁴ Based on that evidence, Applicant argues that ROOST is not just conceptually but also commercially weak because “consumers are educated to distinguish between different marks on the basis of ‘minute distinctions,” citing *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339 (Fed. Cir. 2015).¹⁵ “The third-party uses of record include ROOST DC, ROOST, THE ROOST GROUP, ROOST REAL ESTATE CO., QUAL ROOST, two different ROOSTs, four different ROOST REALTYs, and three different ROOST REAL ESTATEs.” across the country for “services that are identical to or closed related to the services claimed in the three cited registrations, including real estate brokerage services, furnished apartment rental, short term rentals, and online apartment finding services.”¹⁶ Excerpts from the thirteen third-party webpages Applicant provided are shown below.



(roostrealty.com – Atlanta, GA)¹⁷

¹⁴ 7 TTABVUE 4 (Applicant’s Brief).

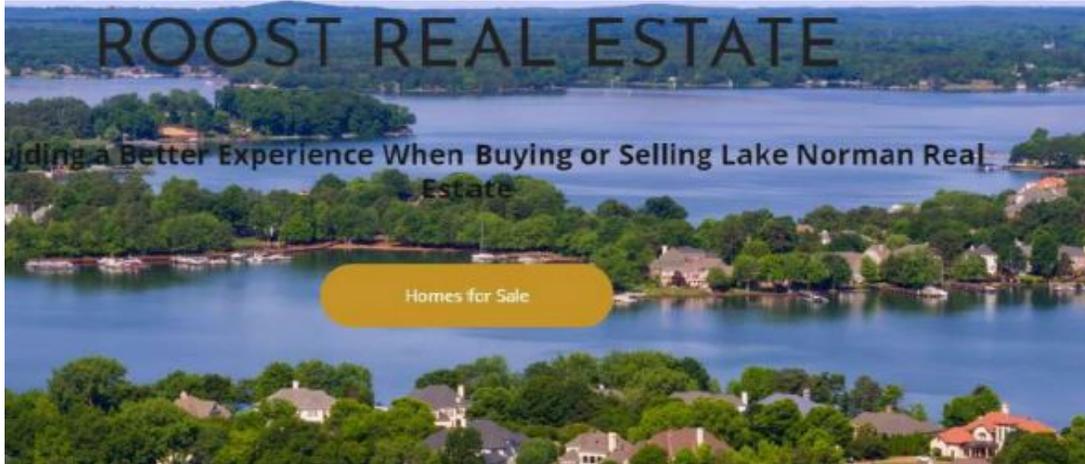
¹⁵ *Id.* (Applicant’s Brief).

¹⁶ *Id.* at 5.

¹⁷ *Id.* at 21.



[Home](#) [Buy](#) [Sell](#) [Explore](#) [Blog](#) [Contact](#) [Online Reviews](#) [Leave Us A Review](#) [Meet Our People](#)



(roostrealestate.com – Charlotte, NC)¹⁸

[Real Estate](#) > [Florida](#) > [Naples](#) > [Quail Roost](#)

Quail Roost Condo

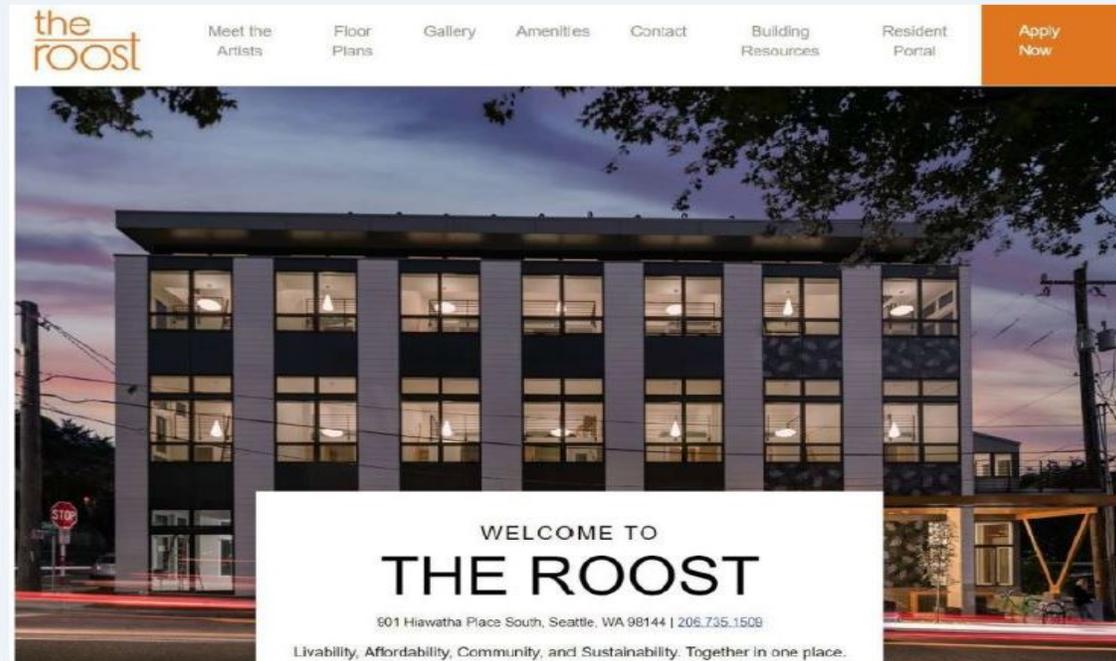
Quail Roost is a community of [condos in Naples Florida](#) offering an assortment of beautiful styles, varying sizes and affordable prices to choose from. **Quail Roost condos for sale** range in square footage from around 1,512 square feet to over 1,652 square feet and in price from approximately \$85,000 to \$144,500 while having an average homeowners association fee of about \$629 per month. Listed below is all Quail Roost real estate for sale in Naples by BEX Realty as well as all other real estate Brokers who participate in the local MLS. No matter what your wants or needs, we are confident that you will find your dream condo in Quail Roost or one of many other great Naples communities. Please reach out to one of our over 200 expert Realtors® if you have any questions or would like assistance seeing any Quail Roost condos for Sale.

Quail Roost Condos for Sale

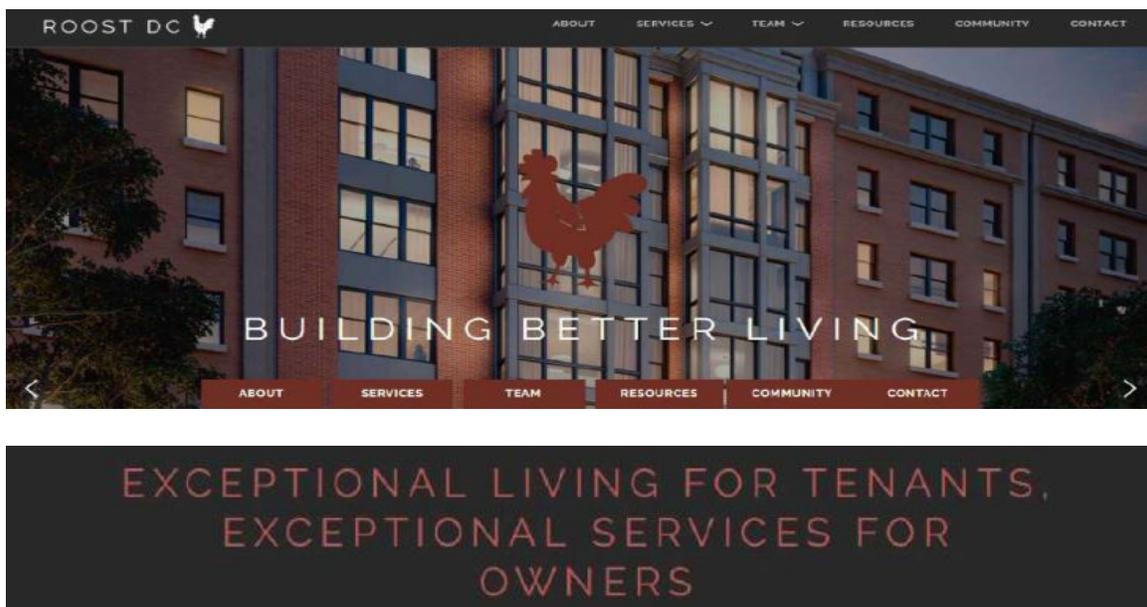
(bestrealty.com – Naples, FL)¹⁹

¹⁸ August 12, 2019 Response to Office Action, TSDR 18. Applicant also provided the webpage of another website that uses the same logo shown above in Mooresville, NC, *id.* at 22, and another that appears to identify the same company operating in Mooresville and other cities in the Lake Norman area of North Carolina, *id.* at 27, so we do not list them here as separate uses.

¹⁹ *Id.* at 31.



(theroostlofts.com – Seattle, WA; “Apply button,” in combination with the Registrant Portal” indicates the provision of real estate services)²⁰



(roost-dc.com – Washington, DC; indicating services for tenant, i.e., renters, and owners)²¹

²⁰ *Id.* at 11-12.

²¹ *Id.* at 13-17.

The screenshot shows the Roost website's feature list. At the top left is the Roost logo. Navigation links include 'Homes', 'Why Roost', 'Purposeful Colliving', and 'Owners'. A green 'Apply Today' button is in the top right. The features are arranged in a grid of eight boxes:

- Private Bedroom:** Your own private bedroom with a double bed, closet, desk+chair (Standard+ Room) or side table (Cozy Room).
- Linens + Towels:** Fresh washed bedding and a new towel await your arrival on your crisply made bed and comfy mattress.
- Fully Furnished:** A home you'd be proud to call your own – beautiful shared spaces you'll love to hang out, work, and live in.
- Weekly Cleaning:** Who's taking out the garbage? Bathroom duty? Kitchen cleaning? We are. A common spaces, every wee
- Dream Kitchen:** For the everyday and never cook, enjoy high-end modern appliances, stocked pots, pans, dishware, and utensils.
- Monthly Hangouts:** Dinners, board games, day trips, and more, we'll plan and host so you can hang with Roosters from across the city.
- Always Stocked:** Never run out of toilet paper, paper towels, soaps, salt, pepper, or olive oil. We've got all the basics covered.
- 6-Month Min. Stay:** Your mid-term home for a project/program, 1-year home for settling in the city, or forever home. Welcome.

Below the features is a section titled '\$ All Inclusive Value' with the text: 'Utilities, WiFi, Netflix, supplies, cleaning, Sunday dinners and more, all included in your monthly rent. [\\$600+/month cheaper than a studio.](#)'

(homeisroost.com – “monthly rent” indicated at bottom)²²

The screenshot shows the Roost Real Estate search interface. At the top is the Roost logo and navigation links: 'SEARCH FOR HOMES', 'BUYING', 'SELLING', 'RENTING', 'EXPLORE', 'BLOG', 'ABOUT', 'CONTACT US'. The main banner features a cityscape at night with the Roost logo and the text 'Find Your Next Roost Here' and 'Roost (n): A place to settle or stay.' Below the banner is a search form with the following fields:

- City: Minneapolis
- Neighborhood: All
- Price: \$150,000 TO No Limit
- Subdivision: All
- Beds: Any
- Baths: Any
- Property Type: Home Condo Townhouse

A 'SEARCH' button is on the right, and an 'Advanced Search' link is below it. A note at the bottom of the form reads: 'By searching, you agree to the EULA'.

(roostminneapolis.com – Minneapolis, MN)²³

²² *Id.* at 19.

²³ *Id.* at 20.



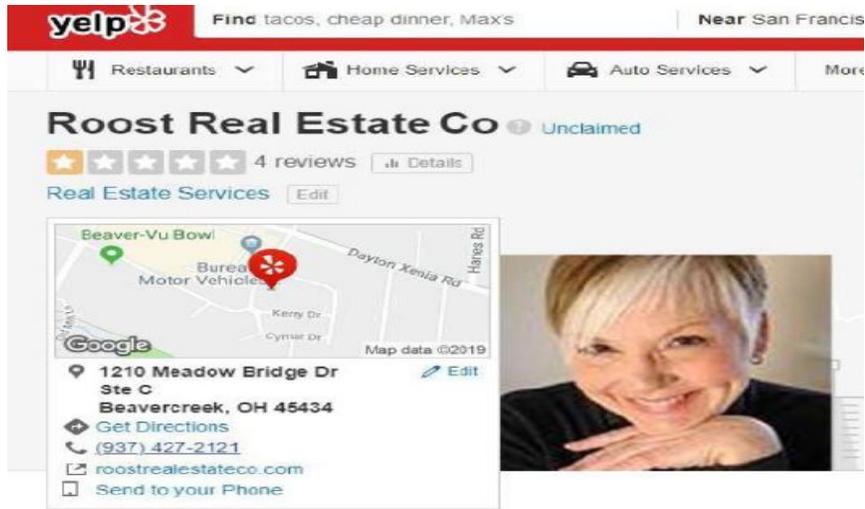
(roostathome.com)²⁴



(findmyroost.com – Tampa Bay, FL)²⁵

²⁴ *Id.* at 23.

²⁵ *Id.* at 25-26.



(yelp.com – Beaver Creek, OH)²⁶



(ttrsir.com – Chevy Chase, MD; indicating “roost” as a place for “family to gather to eat, sleep, nurture and support each other”)²⁷

²⁶ *Id.* at 29.

²⁷ *Id.* at 28.



THE ROOST

Seguin



Karen

- 🏠 **Entire guesthouse**
4 guests 1 bedroom 2 beds 1 bath
- 🌟 **Karen is a Superhost**
Superhosts are experienced, highly rated hosts who are committed to providing great stays for guests.
- 📍 **Great location**
100% of recent guests gave the location a 5-star rating.
- 🧼 **Sparkling clean**
17 recent guests said this place was sparkling clean.

(airbnb.com – Seguin, Texas)²⁸



HOME SELL BUY NEIGHBORHOODS BLOG ABOUT TESTIMONIALS



CALL NOW

The home of your dreams, the lifestyle you crave.

(Madison, WI)²⁹

²⁸ *Id.* at 30

²⁹ *Id.* at 32-24.

The third-party evidence provided by Applicant shows fairly widespread use of the term “ROOST” in connection with the provision of real estate services (including real estate brokerage and short term rentals) by at least thirteen different entities (in the States of Washington, North Carolina, Minnesota, Georgia, Maryland, Texas, Ohio, Florida, Wisconsin, and in the District of Columbia), which is strong evidence that the mark is commercially weak. Several of the third-party references also corroborate the dictionary and registration evidence that shows the term ROOST is conceptually weak. For example, one of the Roost realties (roostrealty.com) invites consumers to “Come Home to Roost.”³⁰ Another Roost Realty (roostathome.com) shows a picture of an owl “roosting.”³¹ A third, Roost Real Estate, encourages consumers to “Find Your Next Roost Here” and prominently displays a definition for the term: “Roost (n): a place to settle or stay.”³²

The Examining Attorney acknowledges that “[e]vidence of widespread third-party use of similar marks with similar services ‘is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection’ in that industry or field,” citing *Palm Bay Imports, Inc. v. Veuve Cliquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005).³³ She rejects Applicant’s evidence, however, because the cited registrations “are for slightly different services” that were “presumably allowed to co-exist due to the slight

³⁰ August 12, 2019 Response to Office Action, TSDR 21.

³¹ *Id.* at 23.

³² *Id.*

³³ 9 TTABVUE 11 (Examining Attorney’s Brief).

differences in the nature of [their] services,”³⁴ and because “the third party uses referenced by the applicant are not even registered marks.”³⁵ “Unlike the mark in [*Juice Generation*],” she argues, “the evidence does not support that the real estate industry is ‘saturated’ with use of the word ROOST. Given the limited uses of the term ROOST in unregistered marks, and the existence of only one registered mark [SHELTER + ROOST] other than the cited marks, this situation does not warrant limiting the scope of the registered marks.”³⁶

We cannot presume, as the Examining Attorney does, that the cited registrations were allowed to coexist simply because of their “slightly different services.” Nor can we ignore the evidence of what we find to be significant third-party use of ROOST for realty/rental services because there is no evidence that the marks are registered; that is not a basis for discounting that evidence. Thirteen distinct uses of the same term for the same services is persuasive on this record and proves that the mark is both conceptually and commercially weak. While we agree with the Examining Attorney that the record of third-party use in this case is more modest than in *Jack Wolfskin* and *Juice Generation*, the evidence of weakness need not be as extensive as in either of those cases for us to find confusion unlikely.

Based on the totality of the evidence, including the dictionary definition and fairly extensive use of the same term to mean the same thing in connection with the same

³⁴ *Id.* at 10, 12-13.

³⁵ *Id.* at 12.

³⁶ *Id.* at 13.

or highly similar services in various cities, we find that the shared word ROOST is weak in that it directly suggests the type of services provided, while the third-party uses show consumer exposure to third-party use of the term on similar services. Overall, this weakness leads us to the conclusion that marks containing the word ROOST used in connection with real estate services are capable of co-existing without confusion where “the remaining portions of the mark may be sufficient to distinguish the marks as a whole from one another.” *Promark v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1244 (TTAB 2015). The sixth *DuPont* factor thus weighs heavily against a finding of likelihood of confusion.

D. Similarity or Dissimilarity of the Marks

Against the backdrop of the mark’s conceptual and commercial weakness, we turn now to the first *DuPont* factor, which considers the “similarities or dissimilarities of the marks in their entirety as to appearance, sound, connotation and commercial impression.” *In re Detroit Athletic Co.*, 128 USPQ2d at 1051 (Fed. Cir. 2018) (quoting *DuPont*, 177 USPQ at 567). The test is not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the goods offered under the respective marks is likely to result. *See Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (citing *Coach Servs.*, 101 USPQ2d at 1721). Our focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Neutrogena Corp. v. Bristol-Myers Co.*, 410 F.2d 1391, 161 USPQ 687, 688 (CCPA 1969) (many consumers

“may have but dim recollections from having previously seen or heard one or the other of the involved marks.”); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1740 (TTAB 2014).

The Examining Attorney argues that Applicant’s mark ROOSTUP “is confusingly similar to the registered mark ROOST because it incorporates the registered mark in its entirety.” In particular, “[t]he addition of the term UP to the applicant’s mark does not overcome the likelihood of confusion with the mark ROOST, because the marks are identical in part.”³⁷ The Examining Attorney argues that Applicant’s ROOSTUP mark “is also confusingly similar to the registered marks RENTAL ROOST and ROOST REAL ESTATE CO. because the dominant feature of [those marks] is ROOST.”³⁸ In support of the latter comparison, she cites *Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) for the proposition that “matter that is descriptive or generic for a party’s goods and/or services is typically less significant or less dominant in relation to other wording in the mark.”³⁹ She contends that “the additional terms RENTAL and REAL ESTATE CO. are generic in relation to the registrants’ real estate services. Accordingly, the dominant feature of each of these marks is ROOST.”

We agree with the Examining Attorney that the wording ROOST is dominant in

³⁷ 9 TTABVUE 7-8 (Examining Attorney’s Brief).

³⁸ *Id.* at 8.

³⁹ *Id.*



the cited registrations. “REAL ESTATE CO.” (disclaimed) in  is descriptive of a real estate company providing real estate services; “RENTAL” (disclaimed) in RENTAL ROOST is descriptive of a company that provides rental services; and ROOST is the only word in the remaining cited registrations. However, we also agree with Applicant that the “addition of the distinctive, arbitrary word ‘up’” in its mark to create a unitary term changes the overall appearance, sound, meaning, and commercial impression of its mark compared to the marks in the cited registrations. Apart from the difference in sound, the word UP in Applicant’s mark ROOSTUP results in a unitary term that seems to convey a different connotation and commercial impression than the cited marks.⁴⁰ “UP” in Applicant’s mark gives the impression of an action or result, as implied by similarly structured terms such as button-up, bust-up, buy-up, blowup, buildup, cover-up, cough up, , dress up, lead up, made-up, meetup, ramp up, sign up, and the like. There is no definition provided for ROOSTUP, but it seems to suggest a directive that one should find a place to stay or rest, rather than simply referring the place itself.

“Additions ... to marks may be sufficient to avoid a likelihood of confusion if: (1) the marks in their entirety convey significantly different commercial impressions;

⁴⁰ “A mark or portion of a mark is considered ‘unitary’ when it creates a commercial impression separate and apart from any unregistrable component.” TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) § 1213.05. “A unitary mark has certain observable characteristics. Specifically, its elements are inseparable. In a unitary mark, these observable characteristics must combine to show that the mark has a distinct meaning of its own independent of the meaning of its constituent elements. In other words, a unitary mark must create a single and distinct commercial impression.” *Dena Corp. v. Belvedere Int’l, Inc.*, 950 F.2d 1555, 1561, 21 USPQ2d 1047, 1052 (Fed. Cir. 1991).

or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” TMEP § 1207.01(b)(iii); *see e.g., Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1245, 73 USPQ2d 1350, 1356-57 (Fed. Cir. 2004) (reversing TTAB’s holding that contemporaneous use of THE RITZ KIDS for clothing items (including gloves) and RITZ for various kitchen textiles (including barbeque mitts) is likely to cause confusion, because, *inter alia*, THE RITZ KIDS creates a different commercial impression); *Cf. Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313 (TTAB 2005) (“house mark” case finding no likelihood of confusion between NORTON MCNAUGHTON ESSENTIALS and ESSENTIALS, both for women's clothing, because evidence established that the shared term ESSENTIALS was “highly suggestive”).

Taking into account the conceptual and commercial weakness of the word “roost” in relation to realty services and the differences imparted by the combination of “roost” and “up” as ROOSTUP, we find that Applicant’s mark is not sufficiently similar to the cited marks for consumers – who are exposed to multiple uses of the highly suggestive word ROOST for real estate and rental services – to be confused. Accordingly, the first *DuPont* factor weighs against a finding of likelihood of confusion.

II. Conclusion

In sum, notwithstanding the relatedness of the services, and the same trade channels in the ROOST registration, we find that confusion is not likely between

Applicant's mark ROOSTUP and the registered marks ROOST, RENTAL ROOST,



and because the marks are sufficiently dissimilar overall, given that the shared wording “roost” is quite weak when used in connection with realty and rental services, both conceptually and commercially. The first and sixth *DuPont* factors, accordingly, are dispositive in this case. *See e.g., Kellogg Co. v. Pack'em Enters.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991) (“We know of no reason why, in a particular case, a single du Pont factor may not be dispositive. ... ‘each [of the thirteen factors] may from case to case play a dominant role.’”).

Decision: The refusal to register is reversed.