

5/31/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
JQ

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Windermere Services Company**

Serial No. 75/615,300

Patrick Michael Dwyer for applicant.

Susan Leslie DuBois, Trademark Examining Attorney, Law
Office 111 (Craig Taylor, Managing Attorney).

Before Cissel, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Windermere Services
Company to register the mark shown below

for, as amended, "real property brokerage and property

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management services."¹

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when used in connection with applicant's services, so resembles the previously registered mark shown below

("MORTGAGE" disclaimed) for "real estate financing and mortgage loan services to commercial and residential customers"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Applicant and the Examining Attorney filed briefs.³ An oral hearing was not requested.

¹ Application Serial No. 75/615,300, filed January 4, 1999, alleging dates of first use of October 21, 1990. The original recitation of services included "mortgage loan origination and mortgage lending services," but these services were deleted from the application after the Section 2(d) refusal was made. Applicant's attention is directed to the Board's order dated November 8, 2000 (footnote 1) regarding applicant's true and correct corporate name. In the event that applicant ultimately prevails in any appeal filed, the appropriate documents should be recorded in the Assignment Branch of the Office so that a registration would issue in the correct name.

² Registration No. 1,523,768, issued February 7, 1989; combined Sections 8 and 15 affidavit filed.

³ For the reason set forth by applicant, its request to accept the reply brief as timely filed is granted. The reply brief has been considered in reaching our decision.

The Examining Attorney maintains that that the dominant portion of the cited mark is the term "PREMIER," which is identical to applicant's mark. In addition, the design features of the marks, according to the Examining Attorney, are not sufficient to distinguish the marks. Thus, the Examining Attorney contends that the marks in their entireties are similar. As to the services, the Examining Attorney asserts that real property brokerage and management services are related to mortgage financing services. In connection with this assertion, the Examining Attorney submitted excerpts retrieved from the NEXIS database showing that the same entities offer both of the types of services involved herein.

Applicant argues that the Examining Attorney has failed to meet the required burden of proof in that no evidence has been offered in support of the refusal. While acknowledging that both marks contain the word "premier," applicant contends that the marks are otherwise dissimilar in their entireties, pointing to alleged differences in sound, appearance and meaning. Applicant also states that the services are not similar, and that the services require "careful, sophisticated purchasing analysis and decisions by relatively mature buyers." (brief, p. 14) Applicant further alleges that there has been no actual confusion

between the two marks over a period spanning at least five years.⁴

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first turn to consider the marks. Applicant's mark, PREMIER in stylized script, and registrant's mark, PREMIER MORTGAGE and design, are similar in sound and appearance. Further, the marks are similar in meaning, both being laudatorily suggestive of superiority.⁵ In comparing the marks, the term "PREMIER" clearly is the

⁴ Applicant also alleges that the cited mark is no longer in use. (brief, pp. 14-15). The present ex parte proceeding is not the proper forum for such a challenge. These allegations constitute an impermissible collateral attack on the validity of the cited registration and must be disregarded. See: In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997). Accordingly, no consideration has been given to them.

⁵ In this connection, we take judicial notice of the dictionary definition of the term "premier:" "first in position, rank or importance." *Webster's Third New International Dictionary* (unabridged ed. 1993).

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dominant portion of registrant's mark. This portion is identical to the entirety of applicant's mark. The term "PREMIER" would be the portion most likely to be remembered by consumers and used by them in calling for the services. See: In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). Although we have considered the marks in their entireties, "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 [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." Id. at 751.

In the present case, the term "MORTGAGE" in registrant's mark is generic as used in connection with mortgage loan services. Although we have considered this disclaimed portion in comparing the marks, this generic term does not distinguish the marks in any meaningful way. Further, the stylization of applicant's mark and the design features of registrant's mark do not sufficiently distinguish the marks. In addition, despite the

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suggestiveness of the term "premier," the record is devoid of evidence of any third-party uses or registrations of the same or similar marks for similar types of services to those involved herein.

In sum, the general overall commercial impressions engendered by the marks are quite similar. It is the general overall commercial impressions engendered by the marks that must determine, due to the fallibility of memory and the consequent lack of perfect recall, whether confusion as to source or sponsorship is likely. In re United States Distributors, Inc., 229 USPQ 237, 239 (TTAB 1986).

With respect to the similarity between applicant's "real property brokerage and property management services" and registrant's "real estate financing and mortgage loan services to commercial and residential customers," it is not necessary that the services be identical or even competitive in nature in order to support a finding of likelihood of confusion. It is sufficient that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under circumstances that would give rise, because of the marks used in connection therewith, to the mistaken belief that the services originate from or are in some way

associated with the same source. In re International Telephone and Telegraph Corp., 197 USPQ 910 (TTAB 1978).

Applicant, although arguing that the services are different (but also acknowledging, however, that the services are "sometimes offered in the same channels of trade" (reply brief, 3, n. 3)), has offered no evidence in support thereof. Indeed, the NEXIS excerpts relied upon by the Examining Attorney show that there are numerous entities that render real property brokerage and property management services as well as real estate financing and mortgage loan services. We find that applicant's and registrant's services are highly related and complementary, and would be offered in the same channels of trade to the same classes of purchasers. See: Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992)[registrant renders real estate brokerage and mortgage brokerage services]; Freedom Savings and Loan Association v. Way, 757 F.2d 1176, 226 USPQ 123 (11th Cir. 1985)[real estate sales and real estate finance are highly complementary services]; and In re United California Brokers, Inc., 222 USPQ 361 (TTAB 1984)[applicant offers brokerage services in field of real estate and mortgages and loans].

We acknowledge that services of the type rendered by applicant and registrant may involve careful and discriminating purchases. Nonetheless, real estate brokerage services and real estate financing services are offered to a wide range of consumers, many of whom are not likely to be sophisticated in the buying and financing of real estate, much less capable of distinguishing between the sources of these related services rendered under these two similar marks.

Lastly, contrary to the gist of one of applicant's arguments, to the extent that any of the points argued by applicant cast doubt on our ultimate conclusion on the issue of likelihood of confusion, we resolve that doubt, as we must, in favor of the prior registrant. In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988); and In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

We conclude that consumers familiar with registrant's real estate financing and mortgage loan services rendered under the mark PREMIER MORTGAGE and design would be likely to believe, upon encountering applicant's mark PREMIER in stylized script for real estate brokerage and property management services, that the services originated with or

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were somehow associated with or sponsored by the same entity.

Decision: The refusal to register is affirmed.