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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Bargain Network, Inc.

Serial No. 78326415

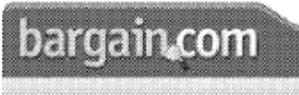
Peter F. Weinberg of Gibson, Dunn & Crutcher for Bargain Network, Inc.

Nelson B. Snyder III, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

Before Hohein, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Bargain Network, Inc. (applicant) has filed an application to register the following mark,

The logo for "bargain.com" is displayed in a stylized, lowercase font. The text is white and set against a dark, rectangular background with a slight gradient and a drop shadow effect.

on the Principal Register for "computerized on-line retail store services in the field of automobiles; providing information in the field of auctions; providing information about automobiles for sale by means of the Internet" in

International Class 35, and "computerized on-line real estate listing; providing information in the field of real estate home purchasing" in International Class 36.¹

The examining attorney has required that applicant disclaim the wording BARGAIN.COM, on the ground that it is merely descriptive of applicant's services, and, pursuant to Trademark Act Section 6, has issued a final refusal of registration pending applicant's submission of such disclaimer. 15 U.S.C. §1056.

In addition, the examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's BARGAIN.COM design mark, when used in connection with its recited services of computerized on-line retail store services in the field of automobiles and providing information about automobiles for sale by means of the Internet, in International Class 35, so resembles the registered mark BARGAIN for "leasing and renting of automobiles and other

¹ Application Serial No. 78326415, filed November 11, 2003, alleging October, 2001 as the date of first use and first use in commerce, describing the mark as consisting "of the words BARGAIN and COM with a magnifying glass between them that resembles a period," and making no claim as to color or to the border surrounding the words and magnifying glass.

vehicles" in International Class 39,² as to be likely to cause confusion, mistake or deception.

When the refusals were made final, applicant appealed.³ Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusals to register.

Refusal Based on Disclaimer Requirement

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6. Merely descriptive terms are unregistrable, Trademark Act Section 2(e)(1), and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (C.C.P.A. 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

² Registration No. 1659131, issued October 1, 1991, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed.

³ The final refusal included two other requirements, specifically, (1) that applicant submit the filing fee to cover the second class of services resulting from the amendment of the recitation of services, and (2) that applicant submit a new drawing of the mark. Subsequent to filing the appeal, applicant submitted the required fee, which has been acknowledged and accepted by the examining attorney, and the examining attorney has withdrawn the drawing requirement.

"A mark is merely descriptive if it 'consist[s] merely of words descriptive of the qualities, ingredients or characteristics of' the goods or services related to the mark." In re Oppendahl & Larson LLP, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir., 2004), quoting, Estate of P.D. Beckwith, Inc. v. Commissioner, 252 U.S. 538, 543 (1920). See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003). The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find a mark merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Venutire Lending Associates, 226 USPQ 285 (TTAB 1985). Further, it is well-established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the goods or services for which registration is sought, the context in

which the mark is used, and the impact that it is likely to make on the average purchaser of such goods or services. In re Abcor Dev. Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney argues that the wording in applicant's mark consists of the "merely descriptive term BARGAIN combined with the top-level domain (TLD) .COM." Office action p. 4 (May 18, 2004). Specifically, he argues that the TLD .COM fails to function as a source indicator, will be perceived by prospective customers as part of an Internet address, and merely indicates that the user of the name is a commercial entity. Office action p. 4 (May 18, 2004). He concludes that the proposed mark "merely identifies a characteristic or feature of the identified services, namely, that they feature goods/real estate and information about goods/real estate 'offered or acquired at prices advantageous to the buyer' and are available via a commercial Internet address." Brief p. 9. The examining attorney provided the following definition of .COM:

Abbreviation: commercial organization (in Internet addresses)

The American Heritage Dictionary of the English Language (4th ed. 2000).

We also take judicial notice of the following definition of the term TLD:⁴

"(Top -Level-Domain) The highest level domain category in the Internet domain naming system. There are two types: the generic top-level domains, such as .com, .org, and .net and the country codes, such as .ca, .uk and .jp."

McGraw Hill Computer Desktop Encyclopedia 977 (9th ed. 2001).

The TLD .COM generally serves no source-indicating function and in this case, at a minimum, "describes a significant feature of applicant's services, namely the Internet commerce connection." In re Steelbuilding.com, 415 F.3d 1293, 1300, 75 USPQ2d 1420, 1424 (Fed. Cir. 2005).

Turning to the word BARGAIN, the examining attorney submitted the following dictionary definition:

3. Something offered or acquired at a price advantageous to the buyer.

The American Heritage Dictionary of the English Language (4th ed. 2000).

In addition, the examining attorney submitted an excerpt from applicant's website wherein applicant states that a consumer can "Find the best bargains from thousands of auctions...Save thousands of dollars" and is the "place

⁴ University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594, 596 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions).

for great bargains on motors and homes," and excerpts of articles from a variety of newspapers retrieved from www.lexis.com wherein "bargain" is used descriptively in connection with real estate services. See, e.g., "...horror fave about the real-estate bargain..." USA Today p. 2D (October 26, 2004); "...how great a real estate bargain." Des Moines Register p. 1E (October 22, 2004); "...For those looking for real estate bargains..." The New York Post, p. NaN (September 11, 2004); and "...and they think Valley real estate is a bargain..." Fresno Bee p. E1 (August 8, 2004).

Finally, the examining attorney has submitted several third-party registrations and one of applicant's prior registrations where the term "bargain," is disclaimed, registered under Section 2(f), or registered on the Supplemental Register. See, e.g., Registration No. 2798268 (BIG LOTS THE WORLD'S BEST BARGAIN PLACE for retail department store services; "World's Best Bargain Place" disclaimed); No. 2588124 (BARGAIN ALLEY for retail store services; "Bargain" disclaimed); No. 2838993 (BLUE BARGAINS for retail outlets and shops in the field of industrial supplies and equipment; "Bargains" disclaimed); No. 2815445 (BARGAIN NETWORK and design, which is applicant's prior registration for computer services, namely, providing

search engines for obtaining data on a global computer network; "Bargain Network" disclaimed); No. 2891048 (BARGAIN BLITZ for retail store services; "Bargain" disclaimed); No. 2755805 (BARGAIN BUGGIES for automobile rental; registered under Section 2(f)); No. 2754554 (BARGAINS FOR THE HOME! for retail store services featuring a variety of goods; Supplemental Register); and No. 2545462 (BARGAIN SHUTTERS for retail sales services featuring window treatments; Supplemental Register). Conversely, in support of its position, applicant submitted a listing from the Trademark Electronic Search System (TESS) of third-party registrations that include the term "Bargain" in marks where it has not been disclaimed.⁵ See, e.g., Registration No. 2707304 (BARGAIN CALL for prepaid telephone calling cards); and No. 1583109 (BARGAIN TOWN for retail department store services).⁶

⁵ We note the examining attorney's objection, presented for the first time in his brief, to this listing. However, inasmuch as applicant presented this listing in its response to an Office action and the examining attorney not only did not object at that time but also argued against the registrations contained in the list on the merits, the objection is considered to have been waived and this listing has been considered.

⁶ The majority of applicant's examples of third-party registrations have the word "bargain" combined as one word with another term or as part of a unitary slogan or phrase where a disclaimer requirement is not applicable. See, e.g., Registration No. 2638707 (SECRETBARGAINS for newsletters in the field of discount travel).

The third-party registrations do not conclusively establish that the term "bargain" is descriptive for the recited services.⁷ However, when we consider the dictionary definition of the word "bargain," the example of applicant's own descriptive use of that word, and use of "bargain" in the newspaper articles, we find that the word BARGAIN is descriptive of a significant feature or characteristic of the services, namely, that applicant offers goods at advantageous or bargain prices. BARGAIN, as applied to the identified services, is analogous to laudatory terms used to tout the quality of the product. In re Boston Beer Co. L.P., 47 USPQ2d 1914 (TTAB 1998), aff'd 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) ("THE BEST BEER IN AMERICA" immediately conveys to prospective purchasers that applicant claims its beer is superior to other beers in this country). See also In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001) (THE ULTIMATE BIKE RACK found to be merely descriptive and therefore subject to disclaimer). Thus, applicant's argument that the word BARGAIN is suggestive because it

⁷ In general, third-party registrations are not particularly probative inasmuch as prior decisions of other examining attorneys are not binding upon the Office and the Board must decide each case on its own facts and record. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); In re International Taste Inc., 53 USPQ2d 1604 (TTAB 2000); In re Consolidated Foods Corp., 200 USPQ 477 (TTAB 1978).

"simply denotes a generally positive quality" (brief p. 10) is unpersuasive.

Here, the combination of the specific term BARGAIN and the TLD .COM, does not create any double entendre, incongruity, or any other basis upon which we can find the composite any more registrable than its separate elements. In re Microsoft Corp., 68 USPQ2d 1195 (TTAB 2003); see also In re Martin Container Inc., 65 USPQ2d 1058 (TTAB 2002).

In this case, we are persuaded that BARGAIN.COM when used in connection with the recited services in both International Classes would immediately inform the potential users of a significant aspect of those services, i.e., that they will find, in applicant's words, "great bargains on motors and homes." Excerpt from applicant's website, Exhibit to Office action (May 18, 2004). Nothing requires the exercise of imagination, cogitation, mental processing or gathering of further information in order for prospective users of applicant's services to perceive readily the merely descriptive significance of the term BARGAIN.COM as it pertains to applicant's services.

Refusal Based on Likelihood of Confusion Under Section 2(d)

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative

facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In traversing the refusal, applicant "concedes the subject mark and the mark in the cited registration are very similar." Brief p. 2. Moreover, the record supports such a finding. Applicant's mark incorporates the entirety of registrant's mark and is distinguished only by the addition of the TLD .COM and the design element. Thus, the marks are similar in sound. In addition, the connotation of the marks is the same inasmuch as the common element BARGAIN has the same meaning when used in connection with the recited services i.e., "something offered or acquired at a price advantageous to the buyer." The addition of .COM merely informs the consumer that the services are available on the Internet. The addition of .COM, under

these circumstances, does not create a sufficiently different commercial impression to distinguish applicant's mark from the cited mark due to the similarity in sound and connotation. In addition, the wording BARGAIN.COM dominates over the design feature in applicant's mark and it is the wording BARGAIN.COM that customers will remember and use in calling for or searching for the services. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). It is well settled that the proper test in determining likelihood of confusion is not on a side-by-side comparison of the marks, rather, the determination must be based on the recollection of the purchasers, who normally retain a general rather than specific impression of the many trademarks encountered. See *Spoons Restaurants Inc. v. Morrison, Inc.*, 23 USPQ2d 1735 (TTAB 1991). Thus, while applicant's design presents some differences in appearance, the difference in appearance resulting from the design element in applicant's mark does not outweigh the similarities. Therefore, the factor of the similarity of the marks favors a finding of likelihood of confusion.

Applicant focuses its argument on the respective services and the scope of protection to be accorded to the mark in the cited registration. With regard to the services, applicant argues that the services here do not

overlap because there is "no evidence that the owner of the cited registration provides any service other than those presented in the registration" and "applicant's services are not for the renting of automobiles, and the registrant's services are not for anything other than renting (and leasing) automobiles."⁸ Brief p. 9. Applicant concludes that the examining attorney incorrectly reasoned that "because some sources both sell and rent cars, all do" and that the examining attorney "should not expand the registration to include services that go far beyond what it actually recites." Id.

The problem with applicant's logic is that the question is not whether registrant and applicant actually provide the same services, but rather whether the services are related or of such a nature that, if identified by similar marks, consumers would mistakenly believe the services emanate from the same source. It is well settled that goods or services need not be similar or competitive in nature to support a finding of likelihood of confusion. The question is not whether purchasers can differentiate the goods or services themselves, but rather whether

⁸ We note applicant's argument that the refusal does not apply to the services recited as "providing information in the field of auctions" in International Class 35. Applicant is advised that a finding of likelihood of confusion as to any of the services

purchasers are likely to confuse the source of the goods or services. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). Further, we must consider the cited registrant's goods or services as they are described in the registration and we cannot read limitations into those goods. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002); and *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1987).

The examining attorney has presented evidence of third-party use-based registrations showing that entities have registered a single mark for both leasing and rental, and sales. See, for example, Registration Nos. 2900159 (leasing of pre-owned automobiles and automobile dealerships and wholesale distributorships featuring pre-owned automobiles); No. 2783890 (automobile dealerships in the field of new and used vehicles, and leasing of new and used vehicles); and No. 2766528 (new and used automobile dealership services; automotive repair, maintenance and cleaning services; automobile leasing and rentals). Third-party registrations which individually cover a number of

recited in an International Class prevents registration for the entire Class.

different items, and which are based on use in commerce, serve to suggest that the listed services or goods are of a type which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993). In addition, the examining attorney submitted excerpts from third-party websites showing the provision of both automobile leasing, sales and information from one source. See, e.g., "...we are a family of businesses which includes sales and leasing..." www.KRPerformance-Chevy.com; and "So whether you're renting a car or thinking about buying one, here you will find everything you need to know" www.Hertz.com. Applicant argues that the examining attorney's presentation of a few registrations is inadequate evidence because it does not "show that some significant percentage of registrations for either car sales services or car renting services are for both sales and renting." Reply Brief p. 2. However, applicant did not cite any cases for this proposition, nor do we find this to be a requirement. We find the Internet and third-party registrations submitted by the examining attorney to be sufficient to establish that applicant's services are related to and overlap with registrant's services.

If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type,

channels of trade or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all channels of trade normal for these goods or services, and that they are available to all classes of purchasers for the described goods or services. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). With regard to "leasing and renting of automobiles and other vehicles" as identified in Registration No. 1659131, because the recitation of services in the registration is not limited to any specific channels of trade, we presume an overlap in trade channels and that the services would be offered to all normal classes of purchasers.

In view of the above, the du Pont factors of the similarity of the services and the channels of trade favor a finding of likelihood of confusion as to the cited registration.

Finally, applicant argues that the subject mark and cited mark are weak terms because "bargain is widely used as a formative part of trademarks that are used to identify many different goods and services... [and] members of the public have been conditioned to understand that BARGAIN does not uniquely point to a single source." Brief p. 8. In support of this argument, applicant references the same

TESS listing of registrations discussed supra. Inasmuch as only one of the listed third-party registrations includes automobile sales, the list itself is of little probative value. That being said, weak marks are entitled to protection against registration by a subsequent applicant of the same or similar mark for the same or closely related goods or services. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974); and *Hollister Inc. v. IdentAPet, Inc.*, 193 USPQ 439 (TTAB 1976). Due to the highly similar nature of the marks and closely related services, the record in this case supports a finding of likelihood of confusion.

In conclusion, we find that because the marks are similar, the goods are the same and/or closely related, and the channels of trade are the same or overlapping, confusion is likely between applicant's mark and the cited registration.

Decision: The refusal to register under Section 2(d) of the Trademark Act as to the recited services in International Class 35 is affirmed.

The refusal to register under Section 6 of the Trademark Act as to the recited services in International Classes 35 and 36 based on applicant's failure to disclaim BARGAIN.COM is affirmed. However, if applicant submits the

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required disclaimer⁹ of BARGAIN.COM to the Board within thirty days, the decision as to the disclaimer requirement will be set aside, the disclaimer will be entered, and, in the event applicant does not appeal the refusal under Section 2(d), the application then shall proceed to publication in International Class 36 only. See Trademark Act Section 2.142(g), 37 C.F.R. §2.142(g).

⁹ The standardized printing format for the required disclaimer text is as follows: "No exclusive right to use BARGAIN.COM is claimed apart from the mark as shown." TMEP §1213.08(a)(4th ed. April 2005).