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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Real Estate USA, Inc.

Serial No. 78408332

James R. Uhlir of Christensen O'Connor Johnson Kindness
PLLC for Real Estate USA, Inc.

Woodrow N. Hartzog, Trademark Examining Attorney, Law
Office 113 (Odette Bonnet, Managing Attorney).¹

Before Seeherman, Quinn and Cataldo, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Real Estate USA, Inc. has appealed from the final
refusal of the Trademark Examining Attorney to register the
mark shown below for "real estate agency services."²

¹ This Examining Attorney did not examine the application. It appears that the application was assigned to him at the point that the appeal brief was to be prepared.

² Application Serial No. 78408332, filed April 26, 2004 and asserting first use and first use in commerce as early as October 17, 2003.

Applicant has disclaimed the words REAL ESTATE USA.

Applicant has described its mark as follows:

The mark consists of Applicant's mark comprises [sic] the outline of a house with a five-pointed star cut out of its middle portion. The five-pointed star cutout is then disposed below the house between the letters RE and USA. Curving banners reminiscent of the stripes of the United States flag extend outwardly from the house to the right and finally, the disclaimed words REAL ESTATE USA are positioned below the entire design.³



³ Applicant filed a request for reconsideration which included the proposed description set forth above, as well as a substitute drawing in order to comply with the Examining Attorney's requirement for a drawing showing a clear rendering of the mark. Although the file does not reveal an Office action addressing the request for reconsideration, Office records show that the substitute drawing and the amended description of the mark have been entered. Further, the Examining Attorney did not address either the description of the mark or the drawing in his brief. Accordingly, it appears that, although a formal Office action was not issued, the Examining Attorney accepted these amendments and maintained the refusal of registration based on Section 2(d) of the Act.

Registration has been refused pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark shown below, with the words REAL ESTATE and USA disclaimed, previously registered for "real estate agencies,"⁴ that, as used in connection with applicant's identified services, it is likely to cause confusion or mistake or to deceive. The registration includes the following description of the mark:

A half star with "USA" next to it and a stripe above the star with real estate [sic, should be "Real Estate"] above the stripe.



The appeal has been fully briefed. Applicant did not request an oral hearing.

We reverse the refusal of registration.

Before turning to the substantive ground for refusal, we note that the Examining Attorney has objected to the three exhibits submitted by applicant with its appeal

⁴ Registration No. 2569116, issued May 15, 2002.

brief. Exhibit 2 consists of listings of marks taken from the USPTO TESS database, and Exhibit 3 consists of a search summary retrieved by the Google search engine. We agree with the Examining Attorney that these exhibits are manifestly untimely, and they have not been considered. See Trademark Rule 2.142(d) (the record in the application should be complete prior to the filing of an appeal). Exhibit A, however, consists of the complete listing for "RE" taken from the website Acronym Finder (www.acronymfinder.com). The Examining Attorney had, during the course of examination, submitted one page from this source which listed 20 possible meanings of "RE." Applicant has submitted, as Exhibit A, all of the meanings (58) provided by this same source for the two letters. While, as noted, Trademark Rule 2.142(d) normally precludes the introduction of additional evidence with an appeal brief, here the Examining Attorney had previously made an excerpt of listings for "RE" of record. As the Court stated in *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818, 820 (Fed. Cir. 1986), in which the Examining Attorney had submitted excerpts of newspaper articles during examination, and the applicant sought to submit additional excerpts from the same articles with its brief,

"By citing only a portion of an article, that portion is not thereby insulated from the context from whence it came." Accordingly, Exhibit A has been considered.

This brings us to the substantive issue on appeal: whether applicant's use of its applied-for mark for real estate agency services is likely to cause confusion with the cited mark for real estate agencies. Our determination of this issue 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 Company, 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).

There is no dispute that applicant's and the registrant's identified services are legally identical. Both applicant and the Examining Attorney have directed their arguments largely to whether the marks are similar or dissimilar. The Examining Attorney, in asserting that the

marks are sufficiently similar such that confusion is likely, has correctly set forth a number of legal principles:

When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

In articulating reasons for reaching a conclusion on the issue of likelihood 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 a consideration of the marks in their entirety. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

If a mark 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. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

In determining whether marks are similar, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979).

It is in the application of these principles to the present situation that we take issue with the Examining

Attorney's position. The Examining Attorney asserts that "applicant has incorporated the entirety of the literal portion of the registrant's mark, "REAL ESTATE USA," into its own mark, rendering it confusingly similar to the registered mark." Brief, p. 4. Thus, the basis of the Examining Attorney's conclusion that the marks are confusingly similar is that both contain the words REAL ESTATE USA, even though these words are descriptive and exclusive rights to use them were disclaimed by both applicant and the registrant.

The Examining Attorney has asserted that the dominant element of the registered mark is REAL ESTATE USA, despite recognizing that these words have been disclaimed and also recognizing that disclaimed matter is normally less significant or less dominant. The Examining Attorney also asserts that the additional elements in applicant's mark, the design feature and the REUSA, are not sufficient to distinguish applicant's mark from the registrant's.

The primary difficulty we have with the Examining Attorney's position is that it gives too much weight to the presence in applicant's mark of the words REAL ESTATE USA. As the Examining Attorney recognized in requiring applicant to disclaim exclusive rights to these words, "it merely describes the nature of the services provided, namely real

estate agency services provided in the United States of America. The wording USA is merely geographically descriptive of the location of where the applicant's services are provided." Office action mailed November 24, 2004. Because these words are descriptive, consumers will look to other elements in applicant's mark to indicate the source of the services. And the other elements are prominently displayed. The mark includes a design element showing a house on curved striped lines reminiscent of a flag, and the letters REUSA, in which a star design is superimposed on the letters to visually separate RE from USA. The star design on these letters also appears to have been removed from the house design. The design element of the mark and the REUSA portion are each shown in larger size than the words REAL ESTATE USA, and the commercial impression is that REAL ESTATE USA is merely a descriptive term, indicating the services offered under the REUSA and House/Banner design mark. It is the latter elements that are the dominant portion of the mark.

In the cited mark, the words REAL ESTATE are the only literal portions. However, these words are clearly descriptive, and they have been disclaimed. We cannot consider, as used in this mark, that the words REAL ESTATE USA are the dominant portion of the mark. Rather, they

must be viewed as helping to create the overall appearance of the mark, with both the words and the design element having weight. Visually, applicant's mark differs significantly from the registered mark. In the cited mark, the words REAL ESTATE are shown separately from USA, on a different line separated by an actual line design, and with REAL ESTATE appearing in both capital and lower case letters, while USA is in all capital letters. While there is a partial star design in the registered mark, this half star has a very different look from the complete and "moved" star in applicant's mark. No one viewing the two marks would consider applicant to have simply appropriated the registered mark and added matter to it. On the contrary, visually they appear as two separate marks, and they convey very different commercial impressions.

Phonetically, obviously the cited mark will be pronounced as "Real Estate USA," and to the extent that the words "Real Estate USA" in applicant's mark will be pronounced, the phrase will be pronounced identically. But applicant's mark also has the letters REUSA, and whether they are pronounced as "R-E-U-S-A" or run together as "RE-U-SA," these letters result in the marks being pronounced differently. Further, because as used in applicant's mark the words REAL ESTATE USA are used in a descriptive manner,

and REUSA is shown much more prominently, it is likely that the REUSA portion will be articulated when referring to applicant's mark, while the descriptive phrase REAL ESTATE USA may not be said at all. More importantly, applicant has explained that it is the visual aspect of the marks that are likely to have more importance in the sale of real estate, where the marks are seen on "For Sale" signs in front of properties. Thus, any similarity in pronunciation takes on less significance in our consideration of the similarities of the marks.

We agree with the Examining Attorney that the connotation of the marks are similar to the extent that both refer to REAL ESTATE USA, and the curved stripes and the star design in applicant's mark, and the half star in the cited mark, suggest symbols of the United States flag. However, we do not agree that REUSA in applicant's mark would necessarily be seen as an abbreviation for "Real Estate USA." We acknowledge that the Acronym Finder lists RE as an abbreviation for "REAL ESTATE" but, as the letters appear in applicant's mark, we think that consumers are not likely to immediately recognize REUSA as being the same as "Real Estate USA." Hence, we do not think that the marks convey the same meaning. Moreover, even if the marks were considered to be the same on the connotation aspect of the

"sight, sound, meaning trilogy," similarity of connotation alone is generally not a sufficient basis on which to find likelihood of confusion when the meaning is highly suggestive or descriptive. See *In re Haddock*, 181 USPQ 796 (TTAB 1974) and cases cited therein. Thus, even if we were to find that applicant's mark, in its entirety, meant REAL ESTATE USA, the similarity in connotation of this descriptive term does not compel a finding that the marks are confusingly similar.

The Examining Attorney has argued that, even if the registered mark is considered a "weak" mark, "such marks are still entitled to protection against registration by a subsequent user of the same or similar marks for the same or closely related goods or services." Brief, p. 6. However, the question is whether applicant's mark is sufficiently similar. The degree of protection to be accorded the registered mark is circumscribed by its weakness. Therefore, since the registered mark consists of descriptive wording that is displayed in a particular manner, another mark would have to be virtually identical not only in the words but in their display to fall within the registration's scope of protection. Here, the only element that is the same in applicant's mark is the phrase REAL ESTATE USA. These words, as stated above, are merely

descriptive and were disclaimed by the registrant. To treat applicant's mark as "the same or similar" to the registered mark merely on the basis of these words would to give the cited registration a much greater scope of protection than it is entitled to have.

We also take issue with the Examining Attorney's reliance on those cases which found that "the mere addition of a term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d)." Brief, p. 6. Applicant has not merely added a term to the registrant's mark; rather, it has simply used a descriptive phrase in its mark that is also present in the registrant's mark. Registrant's mark is not REAL ESTATE USA per se; it is REAL ESTATE USA used as part of a design mark. In fact, the design portion of the registrant's mark and the manner in which the words are displayed must be considered a significant part of the mark, since the disclaimer of REAL ESTATE USA indicates that if the registrant had sought to register simply the words alone, such an application would have been rejected.

Moreover, there are exceptions to the principle which the Examining Attorney has set forth. An addition of a term to another's mark may avoid confusion if the marks

have different meanings or convey different commercial impressions. See, for example, Colgate-Palmolive Company v. Carter-Wallace, Inc., 167 USPQ 529 (CCPA 1970) (PEAK PERIOD for personal deodorants not likely to cause confusion with PEAK for dentifrice); Lever Brothers Company v. The Barcolene Company, 463 F.2d 1107, 174 USPQ 392 (CCPA 1972 (ALL CLEAR for household cleaner not likely to cause confusion with ALL for same goods)).

Secondly, the addition of a term may avoid confusion if the initial mark is highly suggestive. For example, although it is a general rule that the addition of a trade name or house mark to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion between them, there is an exception when the "product mark" of an applicant is in fact merely descriptive of the applicant's goods or services and as such would not be regarded by those who are in the market for such goods or services as an indication of the source thereof. In re C. F. Hathaway Company, 190 USPQ 343 (TTAB 1976). Here, of course, there is no question that the term in the registered mark that is also used by applicant is merely descriptive; in addition, the manner in which it is used in applicant's mark is as a descriptive term for

applicant's services, and consumers would therefore not regard it as an indication of the source of those services.

Although applicant and the Examining Attorney have confined their arguments to the du Pont factors of similarity/dissimilarity of the marks and the services, we also think one additional factor is applicable, namely, the conditions of purchase. While the consumers of real estate agency services are the general public, they are purchasers or sellers of homes. Because homes are a major investment for most people, the decision to choose a real estate agent is not likely to be made without care. Because of the clearly descriptive significance of the words REAL ESTATE USA, consumers are not likely to assume that all marks that contain these words would indicate a single source for the services or, put another way, simply because these words are found in two marks, consumers will not believe that the marks represent a common source on this basis alone.

Decision: The refusal of registration is reversed.