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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Ebates Shopping.com, Inc.

Serial No. 75915782

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Shopping.com, Inc.

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Before Grendel, Holtzman and Taylor, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Ebates Shopping.com, Inc.
(applicant) to register the mark EBATES (in standard character
format) for services ultimately identified as follows:¹

Dissemination of advertising for others in the nature
of providing online non-downloadable shopper's guides
to provide information about the goods and services
of others that can be purchased online from Applicant
only by its registered members, excluding purchases
by consumers of products and services directly from
the manufacturers and suppliers thereof at a

¹ Application Serial No. 75915782, filed February 9, 2000 based on an
allegation of a bona fide intention to use the mark in commerce.

predetermined discount selling price, in Class 35;
and

Administration of a member program that provides rebates for the online sale of products and services of participating businesses of others, excluding discounts and other promotions relating to e-commerce business to enable consumers to purchase said products and services directly from the manufacturers and suppliers thereof at a predetermined discount selling price, in Class 36.

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, when applied to applicant's services, so resembles the mark E-BATE PROGRAM in typed form ("Program" disclaimed) for the following services as to be likely to cause confusion.²

Promoting Internet related products and services of others by means of a preferred customer program featuring discounts and other promotions relating to e-commerce business to enable consumers to purchase said products and services directly from the manufacturers and suppliers thereof at a predetermined discount selling price, in Class 35.

When the refusal was made final, applicant appealed. Briefs have been filed.

Our determination under Section 2(d) is based on an analysis of all of the probative 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

² Registration No. 2733671, issued July 8, 2003.

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1973). In any likelihood of confusion analysis, however, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

In determining the similarity or dissimilarity of marks, we must consider the marks in their entirety in terms of sound, appearance, meaning and commercial impression. See *du Pont*, supra. See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The test under this *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). In addition, while marks must be compared in their entirety, "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 consideration of the marks in

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their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The marks as a whole are similar in sound and appearance. Applicant's entire mark is the term EBATES. The virtually identical term E-BATE is the dominant part of registrant's mark. While the disclaimed word PROGRAM is not ignored in the analysis, this word is descriptive if not generic for registrant's sales promotion program, and it is therefore less significant in creating the mark's commercial impression. See In re National Data Corp., supra. It is the term E-BATE which is aurally and visually the most significant portion of registrant's mark. The fact that EBATES is the plural form of E-BATE "does not amount to a material difference" in the marks. See In re Belgrade Shoe, 411 F.2d 1352, 162 USPQ 227, 227 (CCPA 1969). Further, the hyphen in registrant's mark would not be pronounced, and the terms EBATES and E-BATE would sound essentially the same when spoken. Neither of these features is likely to be remembered by purchasers when seeing or hearing these marks at different times.

There is no difference in meaning between the marks to distinguish them. As applicant states, and we agree, both marks suggest a rebate or discounted sales program. (Brief at 7.) To the extent that applicant is arguing that there is a meaningful difference between a "rebate" and a "discount," applicant is mistaken. These are very similar concepts. We take judicial of

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the definition of "rebate" as meaning, **1.** a return of part of a payment: a *tax rebate*. **2.** a deduction from a sum before payment; a discount: a *10% rebate*. The Penguin English Dictionary (2000).³ Thus, the meaning of the two terms is essentially the same. Further, the additional elements in registrant's mark do not create a meaning that is new or different than EBATES and they do not affect the commercial impression in any significant way.

It is true, as applicant argues, that merely because the two marks share a common word does not necessarily mean they are confusingly similar. However, it is generally held that the addition of descriptive matter to one of two otherwise confusingly similar marks will not serve to avoid a likelihood of confusion. See *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). See also, e.g., *Bellbrook Dairies, Inc. v. Hawthorn Melody Farms Dairy, Inc.*, 253 F.2d 431, 117 USPQ 213 (CCPA 1958); *In re The Clorox Company*, 198 USPQ 337 (C.C.P.A. 1978); and *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 USPQ2d 1154 (TTAB 1987). An exception may be found in those cases where the shared term is merely descriptive or has been frequently used by others for similar goods or services. See *In re Hunke & Jochheim*, 185

³ From the website www.credoreference.com. The Board may take judicial notice of dictionaries, including online dictionaries, which exist in printed format. See, e.g., *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002).

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USPQ 188 (TTAB 1975) and *Jean Patou, Inc. v. Jacqueline Cochran, Inc.*, 133 USPQ 242 (SDNY 1962), *aff'd*, 312 F.2d 125, 136 USPQ 236 (2nd Cir. 1963.). The exceptions do not apply here. The shared term may be suggestive, but it is not descriptive; and there is no evidence of third-party use or registration of the term.

We also point out that none of the cases relied on by applicant compel a finding that the marks in this case are not likely to cause confusion. For example, in *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238, 1239 (Fed. Cir. 1992), the Court, in its finding that VARGAS and VARGA GIRL (both for calendars) were not confusingly similar, specifically noted that "The appearance, sound, sight, and commercial impression of VARGA GIRL derives significant contribution from the component 'girl.'" Unlike that case, in the present case we have found that the added word PROGRAM does not contribute anything significant to the commercial impression of registrant's mark as a whole. The other cases cited by applicant are similarly distinguishable on their facts. Indeed, the Court in *Hearst* even "illustrate[d] the fact-dependency" of determining whether non-identical marks are sufficiently similar by listing cases falling on both sides.

We turn next to the services. The examining attorney argues that the respective services are related in that both applicant and registrant "are ultimately promoting other parties' goods to enable discounted shopping...by the participants"; and that

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"despite the fact that the services are conducted in slightly different manners, the objective of providing well priced goods is the same." Describing registrant's services as providing "Internet related promotional services which feature discounts and promotions for businesses," the examining attorney maintains that both applicant's and registrant's services are promotional or marketing type services which "are encountered by consumers in the same channels of trade or used by similar consumers in need of on-line advertising or marketing or similar promotional services."

Applicant argues that the services cannot be considered related merely because the services are offered in the same broad field; and that the "nature and means" of providing the respective services are different. As described by applicant, its services involve providing consumers with shoppers' guides and rebates for the purchase of third party goods and services online directly from applicant and the rebates are received after the purchase. In contrast, according to applicant, registrant's services are not online services but instead are "personal services"; registrant's services are directed to businesses; and they enable consumers to purchase the products and services directly from manufacturers and suppliers thereof at a predetermined discount selling price at the time of the purchase. Applicant contends that the examining attorney has misconstrued

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the phrase "Internet related" in registrant's recitation to refer to how registrant provides its services. Pointing to a printout from registrant's website, and relying on *In re Trackmobile Inc.*, 15 USPQ2d 1152 (TTAB 1990), as permitting applicant to consider extrinsic evidence to clarify this "ambiguous" wording, applicant argues that although registrant promotes "Internet related" products and services, applicant claims that registrant does not provide its services on the Internet, but instead offers the services through "personal appearances." Applicant concludes that the respective services are not related, and that the trade channels for the services are not the same. Applicant also contends that the purchasers for the services are not the same, arguing that registrant's customers are sophisticated business owners whereas applicant's customers are online shoppers seeking general consumer products.

Applicant is reminded that the question of likelihood of confusion must be decided on the basis of the services set forth in the application and registration, without limitations as to the actual nature of the services, their channels of trade and/or classes of purchasers that are not reflected therein. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464, 18 USPQ2d 1889 (Fed. Cir. 1991); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783 (Fed. Cir. 1990). Where the services in an application or registration

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are broadly described and there are no limitations as to their nature, channels of trade or classes of purchasers, it is presumed that the application or registration encompasses all services of the nature described, that the services move in all channels of trade that would be normal for such services and that the services would be purchased by all potential customers. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

We turn first to a comparison of registrant's services with the services in Class 36 of the application. These services, as identified, are not merely offered in the same broad field, as applicant contends. Instead, they are closely related, if not directly competitive, services. Both applicant and registrant are engaged in promoting the sale of online goods and services of others through programs that enable consumers to purchase the goods and services at a reduced price. The reduction in price takes the form of a "rebate" in applicant's promotional program and a "discount" in registrant's program. It is clear from the dictionary definitions noted earlier that a "rebate" is a form of a discount; and that both rebates and discounts may be given at the time of payment. In any event, applicant is drawing a hair-splitting distinction between the two terms. It is inconsequential whether the reduction in price is taken at the time of the sale or after the sale. The fact remains that the underlying services remain essentially the same.

For this reason, among others, the "discount" exclusion in applicant's recitation of services does not effectively differentiate the services. Furthermore, to the extent that applicant is arguing that, unlike registrant's program where purchases are made directly from the manufacturers and suppliers, applicant, in contrast, administers the program for its clients by selling the goods and services on their behalf, and its services exclude purchases made directly from manufacturers and suppliers, this argument is unpersuasive as well. While the differences in the way the incentives are provided and the manner in which the programs are operated may affect a customer's decision to select one sales promotion program over the other, such differences would not affect a customer's perception that the two programs are related.

There is no question that these very similar services would come to the attention of the same purchasers in the same channels of trade. The purchasers for registrant's promotional services are businesses and, in particular, "manufacturers" and "suppliers" who sell their goods and services over the Internet. Applicant's promotional services are similarly offered to business customers who sell their goods and services over the Internet. Applicant's recitation of services does not specify any particular class of online business customer, and accordingly applicant's customers are deemed to include manufacturers and

suppliers. See *Octocom*, supra. Thus, to the extent that both services are directed to manufacturers and suppliers who sell their goods and services over the Internet, the purchasers overlap. The restriction in applicant's recitation of services excludes discounts obtained directly from the manufacturers and suppliers. It does not exclude manufacturers and suppliers from the class of potential customers for applicant's services. Both applicant and registrant are competing for the same businesses. These businesses could approach either applicant or registrant for a sales promotion program.

As for the channels of trade, applicant states that its services are provided over the Internet. The registration, however, contains no limitations on the channels of trade. Therefore, we must presume that the channels of trade for applicant's and registrant's services are the same to the extent that they may both be offered and provided over the Internet. See *Octocom*, supra. A manufacturer or supplier in its search on the Internet for a company to devise a sales promotion program for its business may encounter both applicant's and registrant's services at the same time.

Applicant may not rely on registrant's website information to limit the scope of the registration either as to the nature of the services, or as to the particular channels of trade or

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classes of purchasers.⁴ Contrary to applicant's contention, *Trackmobile* does not apply here. There is no language in registrant's identification of services that requires clarification. See *In re Continental Graphics Corp.*, 52 USPQ2d 1374, 1376 (TTAB 1999). Furthermore, there is nothing in the identification to restrict registrant's promotional services to those that are conducted through "personal appearances."

Nevertheless, even if we considered this website evidence we would still find the services to be closely related, and the channels of trade as well as the purchasers to be the same. The web page shows that registrant is doing exactly what is stated in the recitation, promoting the sale of online goods and services of manufacturers and suppliers. It is not at all clear from the website information as applicant claims that the services are only offered through registrant's "in person" contacts with the online businesses. Further, the very fact that the extrinsic evidence consists of a web page describing registrant's services to potential customers shows that registrant's services are offered or conducted at least in part over the Internet. The evidence also shows that this is a "business to business" type service, that is, registrant is promoting the sale of said goods and services to other online businesses, and not to the general

⁴ We note that the website printout is dated March 1, 1999, and applicant apparently obtained the printout, not from registrant's website, but from the file of the cited registration.

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public. However, the primary purchasers for both applicant's and registrant's services remain the same, i.e., manufacturers and suppliers, and moreover there is no restriction as to the ultimate users of applicant's rebates. Such users could include online business purchasers as well as members of the general public.

In any event, regardless of whether registrant's business is conducted "in person" or whether the discounts are offered to business purchasers would not affect our determination that the services are related and that they would ultimately come to the attention of the same customers. The very same manufacturers and suppliers who previously engaged registrant under the E-BATE PROGRAM mark to promote their online goods and services to other businesses may also be selling or may decide to sell their goods and services to the general public, and they would then encounter applicant's sales promotion services under a highly similar mark.

We turn to a consideration of applicant's Class 35 services. These services involve "dissemination of advertising for others" in the nature of an online shopper's guide for consumers with information about the goods and services that consumers can purchase online from applicant. This advertising service is complementary to applicant's sales promotion program, and it is therefore likely to be rendered as part of registrant's sales promotion program as well. In addition, the examining attorney

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has submitted a number of use-based, third-party registrations showing, in each instance, a mark which is registered for the same or similar advertising and promotional services as those of the applicant and registrant in this case. Although third-party registrations are not evidence of use of the marks in commerce, they serve to suggest that the respective goods are of a type which may emanate from the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988). It seems clear that applicant's services are directed in part to the general public. However, the trade channels and purchasers for applicant's and registrant's services overlap to the extent that the advertising service itself is directed to the same manufacturers and suppliers that would purchase applicant's rebate sales program and registrant's discount sales program.

It is reasonable to assume that the purchasers of applicant's and registrant's advertising and promotional services would be more sophisticated and discriminating than the general public. However, even knowledgeable and careful purchasers can be confused as to source where, as here, very similar marks are used in connection with closely related, if not competitive, services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA

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1970) ("Human memories even of discriminating purchasers...are not infallible."). We find that the factors strongly favoring likelihood of confusion, including the similarities in the marks and the similarities in the services, outweigh the sophistication of the purchasers. See *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546, 14 USPQ2d 1840, 1841-42 (Fed. Cir. 1990) (similarities in marks and products overshadowed sophistication of purchasers and careful purchasing decision).

As a final matter, we note that applicant has submitted portions of the file history for the cited registration, arguing that a statement made by registrant during prosecution of its underlying application "is tantamount to an admission that [the marks herein] are not confusingly similar." In that application, registrant responded to the examining attorney's reference to three pending applications (now abandoned) as potential cites against registrant's application with the statement: "It is believed that the applicant's services under E-BATE PROGRAM are distinguishable from the services listed in the applications." Applicant reasons that the services in those pending applications are competitive with applicant's services herein, and that therefore, registrant's "admission" that there was no likelihood of confusion as to those applications is probative evidence that there is no likelihood of confusion in this case.

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Applicant's argument has no merit. Registrant is not a party to this proceeding, and therefore any asserted statements, arguments or admissions made by registrant in support of registration are not evidence in the case before us, and they have no bearing on our determination of whether the marks and services in this case are likely to cause confusion. See, e.g., *In re First Draft Inc.*, 76 USPQ2d 1183, 1187 (TTAB 2005). Even if registrant's statement were admissible and considered an admission of fact, it would not be binding. While an admission of fact may be considered as "illuminative of shade and tone in the total picture" confronting the Board, "[u]nder no circumstances may a party's opinion, earlier or current, relieve the decision maker of the burden of reaching his own ultimate conclusion on the entire record." *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 576 F.2d 926, 928, 198 USPQ 151, 154 (CCPA 1978).

In view of the foregoing, and because very similar marks are used in connection with very similar or closely related services, we find that confusion is likely.

Decision: The refusal to register based upon Section 2(d) of the Trademark Act is affirmed as to both classes.