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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Homefirst LLC

Serial No. 78294792
Serial No. 78294797

Julie A. Greenberg of Gifford, Krass, Groh, Sprinkle, Anderson & Citkowski, P.C. for Homefirst LLC.

Tricia Sonneborn, Trademark Examining Attorney, Law Office 110
(Chris A. F. Pedersen, Managing Attorney).

Before Hohein, Cataldo and Wellington, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Homefirst LLC has filed applications to register in standard character form on the Principal Register the marks "HOMEFIRST"¹ and "HOMEFIRST CERTIFIED"² for, in each instance, both "real estate management of residential communities" in International Class 36 and "land development and construction services, namely, planning, development and construction of residential communities" in International Class 37.

¹ Ser. No. 78294792, filed on September 2, 2003, which is based on an allegation of a bona fide intention to use the mark in commerce.

² Ser. No. 78294797, filed on September 2, 2003, which is based on an allegation of a bona fide intention to use the mark in commerce. The word "CERTIFIED" is disclaimed.

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Registration has been finally refused in each case under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's marks, when applied to its services, so resemble the mark "HOME FIRST AGENCY, INC." and design, as reproduced below,



which is registered on the Principal Register for "insurance agency services in the field of manufactured housing and providing extended warranty services to buyers of manufactured housing" in International Class 36,³ as to be likely to cause confusion, mistake or deception.

Applicant, in each case, has appealed and briefs have been filed. Because the issue of likelihood of confusion is substantially the same in each instance, the appeals are being treated in a single opinion. We affirm the refusal to register in each case.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. See, e.g., In re Majestic Distilling Co., 315 F.3d

³ Reg. No. 2,916,932, issued on January 1, 2005, which sets forth a date of first use anywhere and in commerce of September 2002. The words "Agency, Inc." are disclaimed.

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1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the services and the similarity of the marks.⁴

Turning first to consideration of the respective services, applicant notes in each of its initial briefs that such services are specifically different in that "the cited registrant provides homeowners insurance, and the applicant provides construction and real estate development services." Although acknowledging that "the Examiner may be correct in taking the position that these services *can*, in some instances, be 'related,' [by] using existing registrations as proof that some third parties engage in both fields" (italics in original), applicant asserts that "this expansive view of the field of registrant's services" is not commiserate with what applicant views as the weakness of registrant's mark, which applicant maintains is "entitled to only a narrow scope of protection." Applicant stresses that each of its marks "is for development of residential communities, and does not cover insurance services; [while the registrant's mark], in contrast, ... is for insurance agency services, and does not cover construction and development of residential communities." Thus, for applicant:

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the [services or] goods and differences in the marks."

The bottom line is that the registrant does not provide construction services under ... [its] mark, and ... is not entitled to expand the scope of its mark to services that it does not provide. In this case, the relationship between Applicant's construction and real estate development services and the cited registrant's insurance agency services are not close enough to conclude [that] confusion is likely, particularly in view of the substantial differences in the marks.

....

We agree with the Examining Attorney, however, that the respective services have been shown to be sufficiently related that, if offered under the same or similar marks, confusion would be likely as to the source or sponsorship thereof. As the Examining Attorney correctly points out in each of her briefs, it is well established that services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978); and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978). Furthermore, as the Examining Attorney also properly notes, it is well settled that the issue of likelihood of confusion is determined on the basis of the services as they are respectively identified in the particular application and the cited registration. See, e.g., Octocom Systems Inc. v. Houston

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Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

In view thereof, the Examining Attorney persuasively argues that (emphasis in original):

Here, applicant seeks registration of its proposed mark[s] for "real estate management of residential communities" and "land development and construction services, namely, planning, development and construction of residential communities." The registrant's mark is used in relation to "insurance agency services in the field of **manufactured housing** and providing extended warranty services to buyers of **manufactured housing**" (emphasis added). It is presumed that applicant's services cover all types of residential communities, including manufactured housing communities.

In fact, applicant has admitted this very important point. The examining attorney attached two website excerpts to her June 2, 2005 Office action that concerned a **manufactured home community**. The examining attorney inquired whether the website excerpts referred to applicant, and applicant confirmed that they did refer to applicant's **manufactured home community**. As such, the registrant's insurance and extended warranty services and applicant's real estate management and planning, development and construction services **all** concern **manufactured homes**.

....

Further, it is interesting to point out that applicant has not once mentioned that the cited registrant provides more than just

manufactured homeowners insurance under its mark HOME FIRST AGENCY, INC. The registrant also provides extended warranty services to buyers of **manufactured housing**. This service is not insignificant in solidifying the relatedness of the ... [respective] services and must not be overlooked. Rather, this service further establishes the relatedness of the services. A consumer familiar with the registrant's homeowners insurance and extended warranty services for buyers of **manufactured housing** would likely be confused and believe that applicant's planning, development, construction and management of residential **manufactured housing communities** emanate from a single source.

The website excerpts referred to by Examining Attorney state, in particular, that (emphasis in original):

We've raised the bar on manufactured home living

A **HomeFirst Certified Community** isn't just a place to live . . . it's a place to come alive.

In addition to exquisite homes constructed by some of the finest builders in the country, residents enjoy a lifestyle never before offered in a manufactured home community.

All communities include 24-hour on-site management, planned activities and exceptional recreational facilities.

Furthermore, although curiously not even mentioned in her briefs, the record reveals that as additional support for her position, the Examining Attorney has submitted in each case copies of several use-based third-party registrations for marks which are registered for, *inter alia*, services encompassing the same or similar services to those at issue herein in that they respectively include the following recitations of services: (i) "real estate management services" and "insurance agency ... services"; (ii) "real estate management ... services" and

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"insurance agency services"; (iii) "real estate management," "land development services, namely, planning and laying out of residential ... communities," "construction services, namely, planning, laying out and custom construction of residential ... communities" and "providing extended warranties on building construction materials and services relating thereto"; (iv) "real estate management/brokerage services," "real estate development or land development services, namely, planning and laying out of residential ... communities" and "insurance agencies in the fields ... of ... owners and contractors liability"; (v) "real estate development services, real estate management services" and "insurance agency services"; (vi) "real estate management" and "insurance agencies"; (vii) "management of residential real estate properties" and "insurance agency services in the fields of home, property and casualty, and life insurance"; (viii) "real estate management services" and "insurance agency ... services"; and (ix) "real estate management services" and "insurance agency [services]." Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have some probative value to the extent that they serve to suggest that the services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6, *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988).

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Applicant, by contrast, has notably offered no evidence to suggest that its services are not commercially related to those of the cited registrant.

Turning, therefore, to consideration of the marks at issue, applicant argues that when considered in their entirety, its marks are so dissimilar from registrant's mark in appearance, sound, connotation and commercial impression as to preclude any likelihood of confusion. Applicant observes, in particular, that unlike its "HOMEFIRST" and "HOMEFIRST CERTIFIED" marks, registrant's "HOME FIRST AGENCY, INC." and design mark features "a distinctive drawing of a roof over the words, and contains the important wording 'AGENCY, INC.' ... which itself highlights the differences in the respective services." Specifically, applicant maintains that, although disclaimed, the words "AGENCY, INC." in registrant's mark "actually assist the consumer in distinguishing the underlying services, and, if properly incorporated into the analysis, would ... eliminate the likelihood of confusion" inasmuch as "the term AGENCY connotes insurance services and does not have an obvious meaning in connection with home construction and real estate development services." Applicant also urges that "it is not insignificant that rather than providing exclusive rights to the typed words HOME FIRST, the [cited] registration is much more limited in scope, granting instead exclusive rights to the distinctive layout, in which the words are separated and placed under a roof creating the image of a house."

Applicant, in such regard, further contends that the Examining Attorney, by focusing only "on the element in common--

the word HOMEFIRST [or the term HOME FIRST]," has "made a flawed analysis under the well established anti-dissection rule of trademark law, [as] specifically set forth in ... *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992)," in that:

Under *Hearst*, any legitimate comparison in the instant matter[s] between the cited mark and Applicant's mark[s] must be based on more than a mere comparison of the wording HOMEFIRST [or HOME FIRST], for the reason that the commercial impression of each of the relevant marks derive[s], in significant part, from elements which were disregarded by the Examiner. By eliminating these distinctive, and prominent elements from consideration, the Examining Attorney has violated the controlling rule in *Hearst*.

In addition, applicant asserts that in treating its marks as being "confusingly similar to the cited mark, the Examining Attorney attributed too much strength to the cited mark when, "[i]n fact, the cited mark is comprised of extremely common elements, and as such is properly appreciated as a weak mark." As support for such assertion, applicant points to a "list of over five hundred insurance marks on the PTO database, all of which incorporate the descriptive term HOME in their marks," as well as "a separate list of over five hundred marks using the term FIRST for insurance services." According to applicant, "[w]ith hundreds of users all using these terms for their insurance services, it is unreasonable to presume that *any expectation exists in the consumers' minds that marks that incorporate these terms are related*" (italics in original). Instead, applicant insists, it "is well established that when a mark exists in a crowded field, such as the cited mark here, the public is presumed to be able to distinguish it from other marks

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that have only slight differences," citing *inter alia* King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974), and Sure-Fit Products Co. v. Saltzson Drapery Co., 254 F.2d 158, 117 USPQ 295 (CCPA 1958).

We concur with the Examining Attorney, however, that the marks at issue overall are so similar that confusion is likely. As the Examining Attorney properly observes in her briefs, "when determining whether there is a likelihood of confusion under Section 2(d), the question is not whether people will be confused by the marks, but rather whether the marks will confuse ... people into believing that the goods/services they identify emanate from the same source," citing *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 175 USPQ 558 (CCPA 1972). Thus, as the Examining Attorney also correctly notes:

For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall commercial impression. *Visual Information Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975); TMEP §1207.01(b).

See also, *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973), and *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981).

Moreover, as the Examining Attorney accurately notes, while the marks at issue must be considered in their entirety, including any generic or descriptive words therein, our principal

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reviewing court in *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985), has indicated that (footnotes omitted):

It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark. On the other hand, 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 [that] the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable.

That a particular feature is descriptive or generic with respect to the involved ... services is one commonly accepted rationale for giving less weight to a portion of a mark
....

Thus, because disclaimed matter is often descriptive or generic, the Examining Attorney properly observes that "[d]isclaimed matter is typically less significant or less dominant" as an element of a mark. Furthermore, she is also correct that "when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser's memory and to be used in calling for the goods or services," citing *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553 (TTAB 1987), and *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976).

With the above principles in mind, it is clear that the Examining Attorney, contrary to applicant's contention, has not improperly dissected the marks at issue. Rather, we agree with the Examining Attorney's analysis that, when considered in their entireties, the dominant and distinguishing portions of the marks

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"HOMEFIRST CERTIFIED" and "HOME FIRST AGENCY, INC." and design are, respectively, the terms "HOMEFIRST" and "HOME FIRST," which are in turn identical to and substantially the same as the mark "HOMEFIRST." As the Examining Attorney explained in her brief in connection with applicant's application to register the mark "HOMEFIRST CERTIFIED":

HOMEFIRST is the dominant portion of applicant's mark due to its being combined with the descriptive word CERTIFIED, which is entitled to less weight. Turning to the cited registration, it clearly consists of two very large words followed by two very small words. The large words are HOME FIRST, whereas the small words are AGENCY, INC.. It is quite obvious that the registrant wanted to draw a marked distinction between the dominant portion of its mark, HOME FIRST, and the not so dominant portion of its mark, AGENCY, INC.. Indeed, the registrant disclaimed the generic phrase AGENCY, INC..

Size matters in this case. When viewing the registrant's mark in its entirety, the eye is immediately drawn to the large print HOME FIRST and then to the small print AGENCY, INC. and stylized roof [design]. In this instance, based on applicant's positioning of the term HOMEFIRST and the registrant's large print HOME FIRST, the general recollection of the average purchaser is the term HOMEFIRST/HOME FIRST and not the distinguishing characteristics which may arise when the marks are subjected to a side-by-side comparison, such as the registrant's use of a space between HOME and FIRST, the use of generic/descriptive wording AGENCY INC. and CERTIFIED, or the stylized roof [design]. It is clear that the dominant portion of both marks is HOMEFIRST/HOME FIRST.

With respect to applicant's assertion that confusion is not likely because the cited mark is weak, we note that aside from the fact that mere lists of third-party registrations are ordinarily insufficient to make such registrations properly of

record,⁵ even if we accept applicant's assertion that the lists it has provided demonstrate that there are "over five hundred insurance marks on the PTO database, all of which incorporate the descriptive term HOME in their marks" and "over five hundred marks using the term FIRST for insurance services," it is well settled that third-party registrations are not evidence of what happens in the marketplace or that the purchasing public is familiar with the use of the marks which are the subjects thereof and has therefore learned to distinguish those marks by the differences therein. See, e.g., National Aeronautics & Space Administration v. Record Chemical Co., 185 USPQ 563, 567 (TTAB 1975). Such registrations therefore do not show that the subject marks are actually being used, much less that the extent of their use is and/or has been so great that customers have indeed become accustomed to encountering the marks in the marketplace and will differentiate among marks which incorporate the words "HOME" or "FIRST" by other matter or elements therein. See, e.g., Smith Brothers Manufacturing Co. v. Stone Manufacturing Co., 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973); and AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973), in which the court indicated that:

⁵ Mere lists of third-party registrations ordinarily are insufficient to make such registrations properly of record. The Board does not take judicial notice of third-party registrations, see, e.g., In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974), and thus the proper procedure for making information concerning third-party registrations of record is to submit either copies of the actual registrations or the electronic equivalents thereof, i.e., printouts of the registrations which have been taken from the U.S. Patent and Trademark Office's own computerized database. See, e.g., In re Consolidated Cigar Corp., 35 USPQ2d 1290, 1292 n. 3 (TTAB 1995); In re Smith &

[L]ittle weight is to be given such registrations in evaluating whether there is likelihood of confusion. The existence of these registrations is not evidence of what happens in the market place or that customers are familiar with them nor should the existence on the register of confusingly similar marks aid an applicant to register another likely to cause confusion, mistake or to deceive.

See also Olde Tyme Foods, Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) [third-party registrations "may not be given any weight" (emphasis in original) as to the strength of a mark]; and In re Hub Distributing, Inc., 218 USPQ 284, 285-86 (TTAB 1983). Applicant's contention, therefore, that "[w]ith hundreds of users all using these terms for their insurance services, it is unreasonable to presume that any expectation exists in the consumers' minds that marks that incorporate these terms are related" (italics in original) is simply without any evidentiary foundation.

Moreover, to the extent that applicant may be trying to rely upon its lists of various third-party registrations to show, like dictionary definitions, that the cited registrant's mark is weak in the sense that it must be considered highly suggestive of the associated services, that such registrations, like dictionary definitions, demonstrate that opposer's mark is weak in the sense that it is highly suggestive of its goods, see, e.g., Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693, 694-95 (CCPA 1976), the Examining Attorney persuasively states in each

Mehaffey, 31 USPQ2d 1531, 1532 n. 3 (TTAB 1994); and In re Melville Corp., 18 USPQ2d 1386, 1388 n. 2 (TTAB 1991).

of her briefs that, as to applicant's weak mark argument (*italics and underlining in originals*):

This argument fails on multiple levels, the most obvious of which is the fact that ... [the cited registrant's] mark[, like both of applicant's marks,] does not include *either* the term HOME or FIRST [alone]. Instead, the ... marks at issue contain both the terms HOME and FIRST. Not only that, but the marks at issue contain both the terms HOME and FIRST ... in the identical order. This suggestive term (HOMEFIRST/HOME FIRST) is found only three times in the entire [USPTO] X-Search database for all classes. It is revealing that applicant has applied for two of them and the [cited] registrant owns the third. Applicant's contention that the [cited registrant's] mark is weak because it contains either the word HOME or FIRST is simply unsupported by the current state of the register.

It is plain, therefore, that despite certain minor differences in the marks at issue in that one of applicant's marks contains the descriptive (and hence disclaimed) term "CERTIFIED" while the cited registrant's mark includes the generic (and consequently disclaimed) wording "AGENCY, INC.," along with a roof design element, which is suggestive, like the word "HOME," of the manufactured housing which its insurance agency and extended warranty services cover, overall such marks are substantially similar in appearance, sound, connotation and commercial impression in view of the fact that applicant's "HOMEFIRST" and "HOMEFIRST CERTIFIED" marks consist of or are dominated by the term "HOMEFIRST," which is essentially identical to the dominant and distinguishing "HOME FIRST" portion of the cited registrant's "HOME FIRST AGENCY, INC." and design mark. The respective marks are thus confusingly similar. See, e.g., In re Chatam

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International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946-48 (Fed. Cir. 2004).

We accordingly conclude that homeowners and prospective home buyers, who are familiar or acquainted with registrant's "HOME FIRST AGENCY, INC." and design mark for "insurance agency services in the field of manufactured housing and providing extended warranty services to buyers of manufactured housing," would be likely to believe, upon encountering applicant's substantially similar "HOMEFIRST" and "HOMEFIRST CERTIFIED" marks for, in each instance, "real estate management of residential communities" and "land development and construction services, namely, planning, development and construction of residential communities," that such closely related services emanate from, or are sponsored by or associated with, the same source. In particular, even though such customers may notice the differences in the marks at issue, they would still be likely to assume, for instance, that registrant's services are an adjunct to applicant's services since buyers of manufactured housing at a managed residential community planned, developed and constructed by applicant would have need of insurance agency services with respect to such housing as well as interest in purchasing extended warranty services therefor.

Decision: The refusal under Section 2(d) is affirmed in each application.