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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re MediaNews Group Interactive, Inc.

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Serial No. 78433038

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Sabrina C. Stavish of Sheridan Ross P.C. for MediaNews  
Group Interactive, Inc.

Jason Paul Blair, Trademark Examining Attorney, Law Office  
104 (Chris Doninger, Managing Attorney).

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Before Hohein, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

MediaNews Group Interactive, Inc. has filed an  
application to register the mark BAY HOMESITE (in standard  
character form) for services identified as:

real estate marketing services, namely, on-line  
services featuring real estate listings and virtual  
tours of residential and commercial real estate;  
providing a web site at which users can offer goods  
for sale and buy goods offered by others; providing  
a web site which features advertisements for the  
goods and services of others; providing information  
about automobiles for sale by means of the  
Internet; providing information about employers and

career opportunities by means of the Internet in International Class 35; and

providing information about real estate leasing by means of the Internet in International Class 36.<sup>1</sup>

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark so resembles the registered mark HOMESITE for "on-line database inquiry and posting services in the field of real estate, namely, dissemination of advertising for others in the field of real estate via on-line wide area, global computer networks, providing on-line sites and home pages" in International Class 35 and "real estate services, namely, real estate listing, property management and agency services" in International Class 36,<sup>2</sup> as to be likely to cause confusion, mistake or deception.

The examining attorney also has required that applicant disclaim the word BAY apart from the mark as shown, and refused registration of applicant's mark absent such a disclaimer. Section 6 of the Trademark Act.

When the refusals were made final, applicant appealed.

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<sup>1</sup> Application Serial No. 78433038, filed on June 10, 2004, based on an allegation of first use anywhere and in commerce on June 7, 2004 as to the services in both classes.

<sup>2</sup> Registration No. 2173292, issued on July 14, 1998; renewed.

Applicant and the examining attorney have filed briefs.<sup>3</sup>

Disclaimer Requirement

We turn first to the refusal based on applicant's failure to comply with the examining attorney's requirement for a disclaimer of the word BAY apart from the mark as shown.

The examining attorney may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 6 of the Trademark Act. Merely descriptive terms are unregistrable, Section 2(e)(1) of the Trademark Act, and therefore are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is a ground for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); and *In re Box Solutions Corp.*, 79 USPQ2d 1953 (TTAB 2006).

A term is merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith

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<sup>3</sup> We grant applicant's request in its brief that we take judicial notice of definitions from the online version of The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000) and the online Encarta World English Dictionary, North American Edition. The Board may take judicial notice of dictionary definitions, including online dictionaries that exist in printed format. In *re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006). Also, we may take judicial notice of information from the Encarta Dictionary, even though it is not available in printed format because it is a widely known reference work that is readily available online and in a CD-Rom format.

conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the term must immediately convey information as to the ingredients, qualities or characteristics of the goods or services with a "degree of particularity." See *In re TMS Corporation of the Americas*, 200 USPQ 57 (TTAB 1978); and *In re Entenmanns Inc.*, 15 USPQ2d 1750 (TTAB 1990), *aff'd*, unpub'd, Fed. Cir. February 13, 1991. It has long been acknowledged that there is a thin line between terms that are merely descriptive and those that are suggestive. See *in re Atavio Inc.*, 25 USPQ2d 1361 (TTAB 1992).

It is the examining attorney's position that the term BAY is merely descriptive of a characteristic of applicant's real estate marketing services in Class 35 and applicant's Class 36 services, i.e., providing information about real estate leasing by means of the Internet. Specifically, the examining attorney maintains that the term BAY conveys that such services "deal with real estate in an area close to a bay. In this specific case, the bay is San Francisco Bay, which features a body of water

partially closed by land but with a wide mouth affording access to the sea." (Brief, p. 7). The examining attorney points out that applicant's specimen, which consists of printouts downloaded from applicant's website "http://www.bayhomesite.com," includes references to "Real Estate for the Bay Area," "Rentals-Quick Search Location: San Francisco, East Bay, North Bay, South Bay," and "Bay Area Living." In support of the refusal in this regard, the examining attorney submitted a definition from The American Heritage Dictionary of the English Language (4<sup>th</sup> ed. 2000) wherein the word "bay" is defined, in relevant part, as "[a] body of water partially enclosed by land but with a wide mouth, affording access to the sea." Also, the examining attorney submitted a map downloaded from the Internet showing that San Francisco is located to the west of San Francisco Bay. The examining attorney also made of record printouts from third-party registrations of marks which include the word BAY, in which the word has been disclaimed. The registrations are as follows:

Registration No. 1399741 for the mark SAN FRANCISCO BAY STYLE PISANO and design for bakery goods (SAN FRANCISCO BAY STYLE disclaimed); Registration No. 2373616 for the mark BAY AREA 2000 for television programming and a continuing news show (BAY AREA disclaimed); Registration No. 2394041

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for the mark SF BAY NATURALS for balls for relieving stress (SF BAY disclaimed); Registration No. 2323682 for the mark BAY LINK and design for promoting the public awareness of the availability and importance of a network of ecological sites within the Chesapeake Bay watershed (BAY disclaimed); Registration No. 2410273 for the mark SF BAY NATURALS and design for various cosmetic preparations (SF BAY disclaimed); Registration No. 2452119 for the mark BAY CITIES BANK and design for banking and financial services (BAY CITIES BANK disclaimed); Registration No. 2559994 for the mark THE SAN FRANCISCO BAY S.F.L.V. for business management of resort hotels, casinos and theme parks (SAN FRANCISCO BAY disclaimed); Registration No. 2659062 for the mark CORNET BAY and design for food items (CORNET BAY disclaimed); Registration No. 2703227 for the mark THE CITY BY THE BAY, LAS VEGAS EXPERIENCE for business management of resort hotels, casinos and theme parks (THE CITY BY THE BAY disclaimed); and Registration No. 2686800 for the mark THE BIG BAY for promoting business and tourism (BAY disclaimed).

Applicant, in urging reversal of the refusal to register absent a disclaimer, has submitted the identical dictionary definition of the word "bay," and the first 40 hits from the results of a "Google" search of the word

"bay." Included among these hits are references not only to San Francisco Bay, but the Green Bay Packers and Tampa Bay Buccaneers football teams, Massachusetts Bay Transportation Authority, Chesapeake Bay Program, Mandalay Bay Resort and Casino, and Anchor Bay Entertainment. Applicant maintains that the definition and "hits" show that "bay" is a general term which may refer to any bay, and not just San Francisco Bay. Applicant argues that the term "bay" is at most suggestive of services offered near or related to an area with a bay.

Lastly, applicant submitted printouts of third-party registrations of marks which, while including the word BAY, such word has not been disclaimed. Applicant maintains that these registrations are all owned by entities whose addresses indicate that they are doing business in the San Francisco Bay area. The registrations are as follows: Registration No. 2928234 for the mark SANTA BY THE BAY for retail store services featuring Christmas decorations and other items; Registration No. 2467804 for the mark HEART OF THE BAY for chamber of commerce services; Registration No. 2389612 for the mark BAY TO BAY DISTRIBUTION for distributorship services; Registration No. 2815936 for the mark MONTEREY BAY HEATHER for wholesale nursery services; Registration No. 2323187 for the mark ARCADIA BAY for

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retail store services featuring food and beverages, and retail convenience store services; Registration No. 1639238 for the mark BAY ALARM COMPANY for burglar and security alarm monitoring; Registration No. 2875679 for the mark BAY ELITE REALTY for real estate brokerage services; Registration No. 2235360 for the mark BAY VIEW CREDIT for business and consumer services; Registration No. 1911751 for the mark BAY \$\$\$ NET for financial services; and Registration No. 1460838 for the mark HARBOR BAY for a community newspaper, financial management services, construction and repair services, telephone exchange services, transportation services, physical education services, and general health care services.

Considering all of the evidence and the arguments of the examining attorney and applicant, we find that it has not been established that the term BAY is merely descriptive of applicant's identified real estate services. Some degree of thought or imagination must be used to get from BAY to the idea that applicant's real estate services involve marketing and providing leasing information about real estate properties located in the San Francisco "bay area." That is, there is an element of incompleteness which we believe individuals encountering the term must interpret in order to arrive at the conclusion that

applicant markets and provides leasing information about real estate properties located in the "bay area." We note that only two of the third-party registrations relied upon by the examining attorney contain disclaimers of the term BAY per se; the other registrations contain disclaimers of more "complete" terms such as SAN FRANCISCO BAY STYLE; SF BAY; and BAY AREA. In short, we are not persuaded by the third-party registrations submitted by the examining attorney that BAY per se is merely descriptive of applicant's identified real estate services. Furthermore, we note that if there is any doubt about the merely descriptive character of a term, that doubt is resolved in applicant's favor.

In view of the foregoing, we find that the term BAY, when used in connection with applicant's identified real estate services, is not merely descriptive. We therefore reverse the examining attorney's requirement for a disclaimer of BAY as to both classes of services in the application, and we reverse the refusal to register the mark absent submission of such a disclaimer.

#### Likelihood of Confusion

We turn next to the Section 2(d) refusal. As previously indicated, applicant seeks registration of BAY HOMESITE for the following services:

real estate marketing services, namely, on-line services featuring real estate listings and virtual tours of residential and commercial real estate; providing a web site at which users can offer goods for sale and buy goods offered by others; providing a web site which features advertisements for the goods and services of others; providing information about automobiles for sale by means of the Internet; providing information about employers and career opportunities by means of the Internet in International Class 35; and

providing information about real estate leasing by means of the Internet in International Class 36.

The cited registration is for the mark HOMESITE for the following services:

on-line database inquiry and posting services in the field of real estate, namely, dissemination of advertising for others in the field of real estate via on-line wide area, global computer networks, providing on-line sites and home pages in International Class 35; and

real estate services, namely, real estate listing, property management and agency services" in International Class 36.

Our likelihood of confusion determination under Section 2(d) 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, however, 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).

We turn first to the du Pont factors of the similarity or dissimilarity of the services, trade channels and purchasers. Applicant does not dispute that its on-line real estate marketing services and services of providing information about real estate leasing by means of the Internet<sup>4</sup> are legally identical or otherwise closely related to registrant's on-line database inquiry and posting services in the field of real estate and real estate listing, property management and agency services.

Moreover, the channels of trade for such services overlap in that applicant's real estate marketing services are offered "on-line" and its information services are offered "by means of the Internet," and registrant's database inquiry and posting services are offered "on-line." Further, there are no limitations as to the channels of trade for registrant's real estate listing, property management and agency services, and we must

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<sup>4</sup> We note that the examining attorney confined his analysis to these particular services of applicant, and we therefore have done the same. Likelihood of confusion must be found if there is likely to be confusion with respect to any of applicant's services that come within the recitation of services in the cited registration. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981).

accordingly presume that such services move in all normal channels of trade for such services, including on-line/by means of the Internet. As to the classes of purchasers, because there are no limitations in applicant's recitation of services and registrant's recitation of services in this regard, we must accordingly presume that applicant's and registrant's services are marketed to all normal classes of purchasers for such services, including ordinary consumers. In re Elbaum, 211 USPQ 639 (TTAB 1981).

In sum, applicant's and registrant's services are identical or otherwise so closely related that, if offered under the same or similar marks, confusion as to the source of sponsorship thereof would be likely to occur.

With respect to the marks, we must consider whether applicant's mark and registrant's mark, when considered in their entireties, are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Although the marks must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Furthermore, the test 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 commercial impression 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).

Applicant's mark is BAY HOMESITE; the cited registered mark is HOMESITE. Applicant has essentially taken the entirety of the registered mark and added the word BAY to it. The additional word BAY in applicant's mark is insufficient to distinguish the mark from that of the registrant.

Applicant, in contending that the marks are not confusingly similar, asserts that the word HOMESITE is "descriptive if not generic, for a web site featuring homes" (Brief, p. 11); and that the word HOMESITE is so widely used in connection with real estate related services that the commonality of the term is an insufficient basis upon which to find that the marks are confusingly similar.

In support of its position, applicant submitted a dictionary definition from the Encarta Dictionary wherein

the word "homesite" is defined as "building site: a plot of land on which a new home can be or is constructed." In addition, applicant submitted the results of a search of a database of common law trademarks, "www.trademark.com," which revealed 66 businesses using "Homesite(s) or "Home site(s)" in their names," and the results of a search of an on-line telephone directory, "www.dexoline.com," which revealed several telephone listings for entities doing business in Texas, Pennsylvania, Virginia and Massachusetts using "Homesite(s)" or "Home site(s)" in business names.

Applicant's evidence does not compel a different result in determining the likelihood of confusion. First, applicant's contention that registrant's entire mark is descriptive constitutes an impermissible collateral attack on the cited registration. Such an attack will not be entertained in an ex parte appeal. See, e.g., *In re Peebles, Inc.*, 23 USPQ2d 1795 (TTAB 1992).

Furthermore, as the Federal Circuit has stated, "[t]he probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee*, supra at 1693. At best, the uses comprise evidence that the purchasing public could potentially be cognizant of third-party use of the term "Homesite." The record, however, is devoid of any evidence

of the purchasing public's awareness of such uses; nor is there any information as to, for example, how long the businesses have been operational or the extent of the public exposure to the businesses. Where the "record includes no evidence about the extent of [third-party] uses ... [t]he probative value of this evidence is thus minimal." *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1561 (Fed. Cir. 2001). A further problem with this evidence is that it is not readily apparent from some of the business names that such businesses are real estate related. For the foregoing reasons, we cannot conclude from the evidence that there is such significant use of "Homesite" marks or trade names that consumers are likely to make a distinction between registrant's mark and applicant's mark where the marks are used in connection with identical and otherwise closely related real estate related services.

Applicant also argues that registrant's HOMESITE mark is weak and therefore entitled to only a limited scope of protection because of the coexistence of five third-party registrations and an application for marks that contain the words "HOME" and "SITE" for real estate related services. The third-party registrations and application are of limited probative value for several reasons. Insofar as

the third-party registrations are concerned, as applicant acknowledges, such registrations are not evidence of use of the marks shown therein. Thus, the registrations are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. Furthermore, three of the registrations are owned by the same entity and cover online computer databases in the fields of building plans, home warranties and building insurance; services which are somewhat different from the services involved herein. Only one of the third-party registrations covers services of the type involved herein; the mark in that registration is THE SITE FOR HOMES which is somewhat different from HOMESITE. Insofar as the third-party application is concerned, such application has no probative value other than as evidence that the application was filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047 (TTAB 2002). Nevertheless, we note that even if marks which include the word HOMESITE are considered to be weak due to an assertedly high degree of suggestiveness conveyed by such term, even weak marks are entitled to protection where confusion is likely. Here, notwithstanding any alleged weakness in the term HOMESITE, the registered mark HOMESITE is still similar in sound,

appearance, connotation and commercial impression to applicant's mark BAY HOMESITE.

In conclusion, we find that because the marks are similar, the services are identical or otherwise closely related, and the channels of trade and purchasers overlap, confusion is likely between applicant's mark and the mark in the cited registration.

**Decision:** The refusal to register the services in both classes absent a disclaimer of BAY is reversed. The refusal to register the services in both classes under Section 2(d) of the Trademark Act is affirmed.