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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re University Federal Credit Union

Serial No. 78439822

Gail Taylor Russell of Taylor Russell & Russell, P.C. for
University Federal Credit Union

Mark Rademacher, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney)

Before Seeherman, Kuhlke and Walsh, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

University Federal Credit Union has appealed from the
final refusal of the Trademark Examining Attorney to
register MEMBERS HOME ADVISOR for "mortgage lending
services, namely providing residential loans to federally
chartered and state chartered credit unions members only."¹
Registration has been refused on two grounds: Pursuant to

¹ Application Serial No. 78439822, filed June 23, 2004, based on
Section 1(b) of the Trademark Act (intent-to-use).

Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant's mark is merely descriptive of its identified services; and pursuant to Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark HOMEADVISOR, previously registered for "providing information concerning real estate, real estate financing, real estate agents and the purchase, sale and rental of real estate, all via computer networks and global communication networks,"² that it is likely, if used in connection with applicant's identified services, to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed appeal briefs.

We affirm the refusals on both grounds.

We turn first to the refusal based on mere descriptiveness. A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term

² Registration No. 2548679, issued March 19, 2002.

need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered to be merely descriptive; rather, it is sufficient that the term describes one significant attribute, function or property of the goods or services. In re H.U.D.D.L.E., 216 USPQ 358 (TTAB 1982); In re MBAssociates, 180 USPQ 338 (TTAB 1973). Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with the goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use; that a term may have other meanings in different contexts is not controlling. In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979). Moreover, if the mark is descriptive of any of the goods or services for which registration is sought, it is proper to refuse registration as to the entire class. In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd without pub. op., 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989).

In support of his position that the mark is merely descriptive, the Examining Attorney has made of record dictionary definitions of the individual words,³ to wit:

Member: 3. One that belongs to a group or organization.

Home: 1. A place where one lives; residence
2. A structure or unit for domestic living.

Adviser or Advisor: 1. One that advises, such as a person or firm that offers official or professional advice to clients.

The Examining Attorney has also made of record pages from applicant's website. Under the general heading "Mortgages" is the statement "Traverse the maze of home loan products. We'll help you identify which is best for your situation." www.ufcu.org/learning/home/index/php?loc=menu. On another webpage, under the subheading "Mortgage loans, applicant states that:

Members' Home Advisor is the total UFCU solution. We are very concerned about your "home schooling", and have the following solutions, services and mortgage products available for you.

³ The definitions of "member" and "home" are taken from The American Heritage Concise Dictionary; the definition of "Adviser/advisor" is taken from The American Heritage Dictionary of the English Language.

The webpage goes on to list various activities involved in home purchase, and the advice that applicant offers, including:

Mortgages: "We have lots of products, but what matters is which one is right for you: your budget, your savings, your current income and debts and your future plans. On-line approval and education is one click away!

Refinancing: Refinancing your mortgage can be a smart way to reduce your monthly payments—if you have all the information. We will help you determine if refinancing is right for you.

In addition, the Examining Attorney has submitted a copy of a second application filed by applicant for MEMBERS HOME ADVISOR and design for "mortgage lending services, namely providing residential loans, loan refinancing, home equity loans and lines of credit to federally chartered and state chartered credit unions members only" in which applicant disclaimed the words MEMBERS HOME ADVISOR, an acknowledgement by applicant that it does not have exclusive rights to this phrase.⁴ The Examining Attorney has also pointed out that the registration for HOMEADVISOR that has been cited against applicant's application in connection with the refusal based on Section 2(d)

⁴ Application Serial No. 78516791.

(discussed infra) was registered pursuant to Section 2(f) of the Trademark Act, thus showing that the term HOMEADVISOR was found to be merely descriptive, and was so acknowledged by the registrant.

Finally, the Examining Attorney has pointed to applicant's own admission, repeated in both applicant's response to the first Office action and in its request for reconsideration, that:

... "home advisor" merely combines two common descriptive terms that relate to advice concerning homes. Applicant's mark further limits these descriptive terms to "members."⁵

Applicant's argument that its mark is not merely descriptive is essentially that "if a consumer or prospective consumer of Applicant's services was presented with the mark MEMBERS HOME ADVISOR, that consumer would not immediately conclude that the service to be provided under the mark are mortgage lending services." Brief, pp. 6-7. Applicant has asserted, in both its response to the first Office action and in its request for reconsideration, that MEMBERS HOME ADVISOR "might just as likely relate to advising furniture, appliance or other home furnishing

⁵ Applicant made this statement in arguing against the likelihood of confusion refusal. Nonetheless, it constitutes an admission by applicant that this portion of its mark is descriptive.

purchases at membership retail outlets such as COSTCO and SAM'S CLUB."

Applicant's position ignores the well-established principle, set forth above, that whether a mark is merely descriptive must be determined not in the abstract, but in relation to the identified services. In re Abcor Development Corp., supra, In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986). As noted, applicant has acknowledged that HOME ADVISOR combines two common descriptive terms that relate to advice regarding homes, and that when MEMBERS is added to these terms, it describes that the advice is limited to members. Applicant's website confirms that an integral element of its mortgage lending services is giving advice about, inter alia, home mortgages. See In re Reed Elsevier Properties Inc., 482 F.3d 1376, 82 USPQ2d 1378 (Fed. Cir. 2007), in which the Court affirmed the Board's finding that LAWYERS.COM was a generic term for information exchange concerning the law, legal news, and legal services because lawyers "are necessarily an integral part of the information exchange about legal services." Id., 82 USPQ2d at 1380. The Court also stated, citing In re Steelbuilding.com, 415 F.3d 1293, 75 USPQ2d 1420 (Fed. Cir. 2005), that it is appropriate for the Board to consider the applicant's website to understand

the meaning of the services for which registration is sought.

When the mark is viewed in connection with the identified services--mortgage lending services, namely providing residential loans to federally chartered and state chartered credit unions members only--it immediately and directly tells consumers the nature of the advice regarding homes that applicant provides, i.e., that a characteristic of its mortgage loan services is to provide advice directed to its members regarding mortgages for their residences or homes. Accordingly, we affirm the refusal of registration on the ground that applicant's mark is merely descriptive of its identified services.

This brings us to a consideration of the second ground for refusal, that applicant's mark MEMBERS HOME ADVISOR for "mortgage lending services, namely providing residential loans to federally chartered and state chartered credit unions members only" is likely to cause confusion with HOMEADVISOR for "providing information concerning real estate, real estate financing, real estate agents and the purchase, sale and rental of real estate, all via computer networks and global communication networks." 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 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).

Turning first to the services, we note that applicant originally applied to register its mark for "home buying services, namely providing members with extensive information and assistance in connection with the home buying purchase process; mortgage lending services, namely providing residential loans, loan refinancing, home equity loans and lines of credit." Applicant amended its identification after the Examining Attorney raised the issue of likelihood of confusion, presumably to remove from the identification those services that were the same as or very similar to the services in the cited registration. However, deleting identical or highly similar services is not necessarily sufficient to avoid a finding of likelihood of confusion. It is not necessary that the goods or

services of an applicant and registrant be similar or competitive, or even that they move in the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In this case, the Examining Attorney has submitted evidence of the relatedness of the services in the form of third-party registrations and both third-party websites and applicant's own website. With respect to the latter, under the general heading "Mortgage Loans" applicant has listed such subtopics as "Buying a Home," "Selling a Home," "Mortgages," and "Refinancing," and has described applicant as being "One Source for All Your Real Estate Needs." As noted in our discussion of the descriptiveness refusal, applicant states on its "Mortgage Loans" webpage that it is "concerned about your 'home schooling,'" and the various subtopics explain that applicant, in connection with "Buying a Home," "will refer you to a REALTOR® we know and trust who will guide you through the process" and, for

"Refinancing," "will help you determine if refinancing is right for you." Applicant's website shows that it provides information and advice about residential real estate generally, including real estate agents, real estate financing and the purchase and sale of real estate. See, the "Members' Home Advisor Pledge," which promises the buyer (consumer), inter alia, that applicant will "provide you with information that will help you evaluate both the home and the area" and "determine values in today's market and resale potential."

In addition, the third-party websites show that credit unions offer information on real estate financing as well as mortgage lending services. For example, the website for Provident Credit Union, www.providentcu.org, allows one to apply for a mortgage, and also makes available personal assistance by "Loan Advisors" who "answer any of your questions." The website advertises that a person can use the website, inter alia, to obtain information about making "financial decisions involved in purchasing or refinancing a home." The website for Nevada Federal Credit Union, www.nevadafederal.org, indicates that it offers home loans/mortgages, and also explains what the various types of home loans are, e.g., first mortgages and home equity loans.

Third-party registrations made of record by the Examining Attorney include No. 3024353 for MORTGAGE DELIVERY ONLINE for, inter alia, mortgage lending and for providing information, research, analysis and consultation in the field of real estate; and No. 2974937 for ONE PRICE PROMISE for, inter alia, mortgage brokerage services, real estate brokerage services, and providing information in the field of real estate by means of a global computer network.

Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783 (TTAB 1993).

We note that the number of third-party registrations submitted by the Examining Attorney is rather limited, particularly the registrations that are for the specific services that are the subject of applicant's application and the cited registration, as opposed to third-party registrations for real estate services generally, but which do not include mortgage lending services, such as Registration No. 3039975 for HOMEBUILDER.COM that includes, inter alia, providing information about mortgage lending rather than mortgage lending services per se. However, when the evidence is considered in its totality, we find

that the Office has met its burden of showing that services of the type identified in applicant's application and the cited registration can emanate from a single source.

In addition, the complementary nature of the services is obvious. Because mortgage lending services in the nature of residential loans are necessarily offered to and obtained by people who wish to buy a home, those same people will require information about real estate, including information about the purchase of real estate, real estate agents, and real estate financing. As a result, these individuals are likely to encounter both mortgage lending services and services providing information about real estate that is provided via computer networks.

Applicant has pointed out that its services are limited to members of federally chartered and state chartered credit unions. However, the cited registration is not limited as to the customers for the various real estate and real estate financing information provided by the registrant; thus, we must deem the registrant's customers to include members of chartered credit unions as well. Applicant has also asserted that, because the owner of the cited registration is Microsoft Corporation, and because Microsoft is a software company rather than a

financial institution, the information service provided by Microsoft is not the same as a mortgage lending service provided by a chartered financial institution. However, the determination of likelihood of confusion must be based on an analysis of the goods and/or services recited in an applicant's application and the goods and/or services identified in the cited registration, not on what the evidence shows the goods and/or services to be. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank, N.A.*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); *In re William Hodges & Co., Inc.*, 190 USPQ 47 (TTAB 1976). The owner of the cited registration is entitled to all the presumptions of Section 7(b) of the Trademark Act, including the registrant's exclusive right to use the registered mark in connection with the services specified in the certificate. Thus, we cannot read limitations into the registrant's rights based on applicant's statements about the nature of the registrant and its activities.

As noted, the Examining Attorney has submitted evidence that services of the type identified in applicant's application and the cited registration can emanate from a single source and be offered under a single mark. Accordingly, the du Pont factor of the similarity of the services favors a finding of likelihood of confusion.

With respect to the du Pont factor of the channels of trade, applicant argues that its mark will be encountered by a "distinct group of individuals, specifically federally and state chartered credit union members, who will be seeking mortgages directly from Applicant." Brief, p. 3. Applicant asserts that these individuals will rely on established relationships with their credit union, and "are just as likely to use their normal channels of trade to seek out mortgages from Applicant, including visiting a physical branch office of Applicant, telephoning Applicant and responding to brochures mailed to them," brief, p. 4, rather than searching for real estate information via a global communication network. The problem with applicant's argument is that mortgage lending services identified in applicant's application may be offered by means of computer and global communication networks, as the website evidence submitted by the Examining Attorney demonstrates. This is the same channel of trade of the services identified in the cited registration. Moreover, because both the applicant's and the cited registrant's identified services can both be offered to the same individuals, i.e., credit union members who use the registrant's services to obtain information about real estate financing and who also need a residential mortgage, such consumers are likely to believe, if these

services are offered under confusingly similar marks, that they emanate from or are sponsored by the same source. Thus, even if consumers are aware that the mortgage lending services offered under the mark MEMBERS HOME ADVISOR come from applicant, they are likely to believe, upon seeing the mark HOMEADVISOR in connection with information services about real estate financing, etc, rendered via computer and global communication networks, that these services have a single source.

The du Pont factor of the similarity of the channels of trade favors a likelihood of confusion.

This brings us to a consideration of the similarity of the marks. Applicant's mark is MEMBERS HOME ADVISOR; the cited registration is for HOMEADVISOR. Applicant has essentially taken the entirety of the registered mark and added the word MEMBERS to it. Although we note that HOMEADVISOR is run together in the cited mark, the two words that make up the mark, HOME and ADVISOR, are readily apparent. Thus, the HOME ADVISOR/HOMEADVISOR portions of the mark are identical in pronunciation and connotation, and virtually identical in appearance. The additional word MEMBERS in applicant's mark is insufficient to distinguish its mark from that of the registrant. MEMBERS is merely descriptive of the services, and customers would regard it

as a merely informational term indicating that the services are directed to or limited to members of credit unions. Thus, consumers who are familiar with the registered mark HOMEADVISOR, and see MEMBERS HOME ADVISOR used in connection with related services, would view the mark as a variation of the HOMEADVISOR mark, a variation that provides more specific information about the nature of the services, but still indicates the same source of the services as the HOMEADVISOR mark. Overall the marks are similar in appearance, pronunciation, connotation and commercial impression. This du Pont factor favors a finding of likelihood of confusion.

Although applicant has not raised this point as an argument in its brief, as we noted in our discussion of the refusal based on the ground of mere descriptiveness, the registrant's mark HOMEADVISOR was registered under the provisions of Section 2(f) of the Trademark Act, thus indicating that the words were merely descriptive when the mark was initially adopted. However, because the mark has acquired distinctiveness, we cannot say that the registration is entitled to only a limited scope of protection, as we would for a highly suggestive mark, or for words that are merely descriptive. Instead, we must give the registration the normal scope of protection to

which an ordinary mark is entitled, and therefore the addition of a descriptive term to the registered mark is not sufficient to distinguish applicant's mark from the registrant's.

We also think it appropriate to comment on the fact that applicant's co-pending application for MEMBERS HOME ADVISOR and design was approved for registration by another Examining Attorney despite the existence of the registration which has been cited against applicant's subject application. Applicant has not raised this point in its brief, and therefore may recognize that it does not have an effect on our decision. We do not know why the Examining Attorney allowed this application—perhaps the presence of a design and the manner in which the words are depicted in that mark were considered to be enough to distinguish it from the registrant's mark. In any event, we must consider the issue of likelihood of confusion based on the mark for which registration is sought and on the record before us, and another Examining Attorney's decision on a different application does not bind us in our determination herein. In re Nett Designs Inc., 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001)

Both applicant and the Examining Attorney have limited their arguments to the du Pont factors of the similarity of

the marks, the similarity of the services, and the similarity of trade channels. Because of this, and because no evidence has been submitted on other factors, we, too, have limited our discussion to these factors. To the extent that any other factors are applicable, we must treat them as neutral. In particular, there is no evidence regarding the care or sophistication of consumers of these services. However, because both applicant's and the registrant's services are rendered to ordinary consumers, we do not regard the consumers as having any particular sophistication. Further, although obtaining a mortgage is of great importance to consumers, it is the loan itself, rather than the party providing the loan, that is of importance. Thus, we do not consider individuals who would be the customers for applicant's services to exercise more than the usual degree of care in choosing the services.

Decision: The refusals of registration on the grounds of mere descriptiveness and likelihood of confusion are affirmed.