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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re U-Haul International, Inc.

Serial No. 78744869

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Alex Seong Keam, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Walters, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

U-Haul International, Inc. has filed an application to register the standard character mark U-HAUL CO-STAR on the Principal Register for "co-branding services in the nature of promoting the self-storage and do-it-yourself moving related goods and services of others by placing advertisements for others on the sides of do-it-yourself moving trucks," in International Class 35.¹

¹ Serial No. 78744869, filed November 1, 2005, based on use of the mark in commerce, alleging first use and use in commerce as of March 8, 2004.

The examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark COSTAR ADVERTISING, previously registered for "advertising services for others,"² that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the examining attorney have filed briefs. We affirm the refusal to register.

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. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in

² Registration No. 2964790 issued July 5, 2005. The registration includes a disclaimer of ADVERTISING apart from the mark as a whole.

the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

Considering, first, the services involved in this case, it is a general rule that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each party's goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein; and *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002).

The examining attorney contends that the services are closely related; that registrant's broadly worded recitation of services "may encompass co-branding services in the nature of promotional services in the applicant's field and may also feature advertising on the sides of trucks."

(brief, unnumbered p. 11.) In support of his position that advertising, co-branding and promotional services emanate from common sources, the examining attorney submitted excerpts from ten Internet websites to show that advertising services encompass many activities, including co-branding and promotion.

Applicant states that its "mark is used in a business-to-business setting by applicant to promote applicant's U-HAUL truck-side co-branding services, which are only available to providers of do-it-yourself moving and self-storage related services ... [whereas,] registrant's services involve a web-based, interactive advertising program promoting the 'unique features and advantages' of particular commercial real estate brokers." (Brief, p. 5.) Applicant argues that its mark is seen only by providers of self-storage and self-moving services, while registrant's mark is seen only by commercial real estate brokers. In support of its position that registrant's services are limited in the marketplace, applicant submitted an excerpt from registrant's Internet website, i.e., "the key to successfully marketing office or industrial space depends on how well you reach and inform commercial real estate brokers about your property's unique features and advantages" and "every business day, CoStar attracts the largest online audience of commercial brokers."

Applicant concedes that general advertising services and general co-branding services may be related, but argues that the services involved herein are different and do not intersect. Applicant's specimen of use is a brochure for its services and the brochure shows that applicant's services are clearly directed to businesses, i.e., "Jump Start Your Storage Business ... And Watch Your Profits S.O.A.R!"; and "Don't delay. Jump on this opportunity to boost your storage facility's exposure and income by Co-STARring your brand with the popular U-Haul brand and you'll smoke the competition."

Applicant's co-branding services consist of offering advertising space on the sides of its rental moving trucks/vehicles to do-it-yourself storage or moving businesses along side its own advertisements for its own truck/vehicle rental business. Applicant's cobranding services clearly fall within the penumbra of advertising services. Registrant's services are very broadly identified as "advertising services for others." Both applicant and registrant are offering advertising services to third-parties on their behalf. Thus, applicant's identified services are clearly encompassed by registrant's broadly identified services. We remind applicant that, regardless of any evidence showing the exact nature of registrant's services, we must determine the question of likelihood of

confusion based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Therefore, we must conclude that applicant's services are identical to a subset of registrant's identified services and, at least to the extent of this overlap, the class of purchasers and trade channels are the same.

We turn, next, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression. 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 overall commercial impressions that confusion as to the source of the goods or 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). Furthermore, although the marks at issue must be considered in their entirety, 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).

The examining attorney contends that U-HAUL CO-STAR and COSTAR are the dominant portions of the respective marks; that both marks contain the term COSTAR; that in registrant's mark, the term ADVERTISING is generic and, thus, COSTAR is the dominant portion of that mark; that the hyphen in applicant's mark, i.e., CO-STAR, is immaterial; and that U-HAUL does not adequately distinguish applicant's mark from the registered mark. The examining attorney states that the addition of the house mark U-HAUL to the dominant portion of the registered mark is more likely to add to a likelihood of confusion than to distinguish the marks, noting that the fame of applicant's house mark U-HAUL is likely to result in reverse confusion.

Applicant contends that, while the marks have some similarities, they have significantly different commercial impressions; and that any similarities are overshadowed by the first word in applicant's mark, U-HAUL, which applicant

contends is the dominant and famous portion of its mark and serves to distinguish the marks.³ Applicant argues that the marks have different connotations, stating that applicant's use of CO-STAR alludes to "a side-by-side movie star" and to its co-branding services; whereas, COSTAR in registrant's mark "has either no meaning or a completely arbitrary one for its interactive advertising services." (Brief, p. 2.)

Considering, first, the registered mark, COSTAR ADVERTISING, the word COSTAR is clearly the dominant portion of the mark because ADVERTISING is a generic term for the identified services and, on this record, COSTAR is an arbitrary word in connection with the identified services.

Considering, next, applicant's mark, U-HAUL CO-STAR, we note that the second term in applicant's mark is essentially identical to the first and dominant portion of the registered mark. We do not agree that the addition of the hyphen to CO-STAR in applicant's mark serves to distinguish it in either appearance or connotation from the word COSTAR in the registered mark.⁴ The hyphen merely breaks the word into its two syllables and is of such little significance that it is unlikely to be remembered when the marks are

³ Applicant states that the examining attorney does not challenge its claim of fame and that in another proceeding (*U-Haul International, Inc., v. Mendelovich*, No. 91381, April 17, 1997) the Board recognized that U-HAUL is a famous trademark.

⁴ Applicant's argument as to possible connotations of the CO portion of its mark is not supported by any evidence in the record and, as such, it is mere speculation.

viewed apart from each other and at different times. To the extent that the CO-STAR portion of applicant's mark has any connotation other than being an arbitrary word in connection with the identified services, it is more likely that the same connotation will pertain to the word COSTAR in the registered mark.

Applicant contends that the U-HAUL portion of its mark is famous and the examining attorney agrees. Therefore, we accept that fact for the purpose of this decision. However, as discussed *infra*, the fame of the U-HAUL portion of applicant's mark does not work in applicant's favor herein.

We agree with the examining attorney that the U-HAUL portion of the mark appears to be applicant's house mark. U-HAUL is clearly used as a house mark on the specimen; it is the distinguishing portion of applicant's trade name; and "U-Haul" is the term used to refer to applicant on the specimen. Also, as the mark appears on the specimen, the word U-HAUL is in its own oblong carrier in different colors from, and much smaller than, the CO-STAR portion of the mark, which is centrally and prominently displayed.⁵

⁵ There is no question that applicant's standard character mark can be portrayed in many different ways. We mention the manner of display of the mark on the specimen in connection with our finding that the U-HAUL portion of applicant's mark is its house mark.



Regarding the addition of a house mark to otherwise similar or identical marks, as stated in *New England Fish Company v. The Hervin Company*, 511 F.2d 562, 184 USPQ 817 (CCPA 1974), and similar cases, the Board assesses the effect of a house mark on the overall commercial impression of a mark on a case-by-case basis in determining likelihood of confusion. For example, in the more recent case of *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1316 (TTAB 2005), the Board found that although applicant's mark NORTON MCNAUGHTON ESSENTIALS incorporated the whole of opposer's mark ESSENTIALS, because ESSENTIALS "is a highly suggestive term ... under our case law, applicant's addition of its house mark ... suffices to distinguish the two marks when viewed in their entireties."

In *Knight Textile*, the critical factual issue was the strength or weakness of ESSENTIALS. However, in the case before us, both applicant's mark and the registered mark include the essentially identical term COSTAR and, unlike *Knight Textile*, this shared term has not been shown to have suggestive significance nor are the marks otherwise distinguishable but for the addition of applicant's house

mark and the addition of the disclaimed generic term ADVERTISING in the registered mark.⁶ Thus, the *Knight Textile* case is readily distinguishable from the case at hand. In fact, applicant has not submitted any evidence that the term COSTAR is suggestive, much less highly suggestive, such that the inclusion of applicant's house mark would create significant differences in the respective marks' appearance, pronunciation, meaning, and commercial impression. Nor has applicant submitted any evidence that the term COSTAR is used by others in the advertising field, of which co-branding services are a part, or that COSTAR has any specific meaning in that field. Therefore, we find that, in view of the apparently arbitrary nature of COSTAR in the overall advertising field, and in the encompassed co-branding field, and in the encompassed co-branding field, the addition of the house mark U-HAUL is not sufficient to distinguish these marks with essentially identical dominant terms. The marks U-HAUL CO-STAR and COSTAR ADVERTISING, considered in conjunction with the respective services are particularly similar in connotation and overall commercial impression. See *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning

⁶ As previously noted, we consider the generic term ADVERTISING to be of minimal significance in determining the overall commercial impression of the registered mark.

of the mark sought to be registered with a previously registered mark").

Moreover, in view of the fame of applicant's U-HAUL mark, consumers familiar with U-HAUL's services in general under its U-HAUL mark, as well as those familiar with its co-branding services in particular, under its U-HAUL CO-STAR mark, will, upon seeing registrant's mark COSTAR ADVERTISING in connection with registrant's identified advertising services, be likely to believe that the respective services emanate from the same or a related source. See *In re Hill-Behan Lumber Company*, 201 USPQ 246, 249-250 (TTAB 1978) (HILL-BEHAN'S LUMBER JACK for hardware and lumber yard services confusingly similar to stylized LUMBERJACK for finished lumber products); and *In re C.F. Hathaway Co.*, 190 USPQ 343 (TTAB 1976) (HATHAWAY GOLF CLASSIC for knitted sports shirts confusingly similar to GOLF CLASSIC for men's hats). Due to the fame of applicant's U-HAUL mark, the confusion is likely to be in the nature of reverse confusion. This is explained by the Court in *In re Shell Oil Co.*, 992 F.2d 1204, 1207, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993) as follows:

The term "reverse confusion" has been used to describe the situation where a significantly larger or prominent newcomer "saturates the market" with a trademark that is confusingly similar to that of a smaller, senior registrant for related goods or services. The junior user

does not seek to benefit from the goodwill of the senior user; however, the senior user may experience diminution or even loss of its mark's identity and goodwill due to extensive use of a confusingly similar mark by the junior user.

The avoidance of confusion between users of disparate size is not a new concept; however, the weighing of the relevant factors must take into account the confusion that may flow from extensive promotion of a similar or identical mark by a junior user. In considering likelihood of confusion as to the source of services that are not identical, or likelihood of confusion as to whether there is a relation between the source of the services, the extent of the registrant's and the newcomer's activities relating to the mark must be given weight appropriate to the circumstances.

*(citations omitted.)*⁷

When we consider the record and the relevant likelihood of confusion factors, and all of applicant's arguments relating thereto, including those arguments not specifically addressed herein, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, U-HAUL CO-STAR, and registrant's mark, COSTAR ADVERTISING, their contemporaneous use on the overlapping services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

⁷ In considering the likelihood that applicant, being the larger or more well-known party, will be able to saturate the market and overwhelm the registrant, it is also noteworthy that applicant claims a date of first use of its mark only weeks after the date recited in the cited registration. The substantially contemporaneous apparent adoption of the respective marks makes it even more likely that applicant's fame and market presence would overwhelm any association applicant may have established between its mark and its services in the few weeks prior to applicant's adoption of its mark.

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Decision: The refusal under Section 2(d) of the Act is affirmed.