

**THIS OPINION  
IS NOT A PRECEDENT OF  
THE TTAB**

Mailed: September 3, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Elena Potoupa

\_\_\_\_\_  
Serial No. 78772938

Sergei Orel of Law Office of Sergei Orel for Elena Potoupa.

Marcie R Frum Milone, Trademark Examining Attorney, Law  
Office 116 (Michael W Baird, Managing Attorney).

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Before Walters, Zervas and Taylor, Administrative Trademark  
Judges.

Opinion by Walters, Administrative Trademark Judge:

Elena Potoupa has filed an application to register the  
mark shown below on the Principal Register for the services,  
also shown below.<sup>1</sup>

**Mark:**

W\$W Coupons

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<sup>1</sup> Serial No. 78772938, filed December 14, 2005, based on use of the mark  
in commerce, alleging first use and use in commerce as of November 2004.

**Services:** "Promoting the goods and services of others by dissemination of printable discount and rebate coupons over the Internet and distributing and offering discount and rebate coupons of others for use by the public in the purchase of various consumer products, retail items, groceries, food items, dining and restaurant services, travel services, over the Internet; advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information of third parties by offering such parties' printable discount and rebate coupons through the Internet and by providing hypertext links to the web sites of third parties; advertising, including promotion relating to the sale of articles and services for third parties by the transmission of advertising material and the dissemination of advertising messages and advertising banners on the Internet, computer networks and on a website," in International Class 35.

**Disclaimer:** COUPONS

**Description of Mark:** "The mark consists of the wording WOW Coupons with the dollar sign inside the O in the word WOW. The color green appears in the circle forming the O in WOW and the color dark green appears in the letters W and W and the dollar sign in the first word and in the entire second word, COUPONS."

**Color claim:** "The color(s) green and dark green is/are claimed as a feature of the mark."

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 standard character mark WOW! MARKETING, previously registered for the services shown below, that, if used on or in connection with applicant's services,<sup>2</sup> it would be likely to cause confusion or mistake or to deceive.

**Registration No. 3072360** [registered March 28, 2006]

**Services:** "Preparing advertisements for others; dissemination of advertising for others via an online

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<sup>2</sup> Both cited registrations include a disclaimer of MARKETING apart from the mark as a whole, and both registrations are owned by Freedom Colorado Information, Inc.

electronic communications network; dissemination of advertising matter; promoting the goods and services of others via an online electronic communications network; and business marketing consulting services," in International Class 35; and "Computer services, namely, creating, designing and maintaining web sites for others; and hosting web sites of others," in International Class 42.

**Registration No. 3095057** [registered May 23, 2006]  
**Services:** "Advertising and marketing services," in International Class 35

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

As a preliminary matter, applicant submitted evidence with her brief and the examining attorney has objected thereto. We agree that this evidence is untimely, as all evidence must be submitted prior to appeal, and, therefore, we have not considered this evidence. *See*, 37 CFR 2.142(d); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994). Moreover, even if we were to consider this evidence, it would not change our decision in this case because the services in the third-party registrations submitted with the brief vary widely, even within International Class 35; the marks include additional matter different from the case before us; and each case must be decided on its merits. Finally, even if we were to consider this evidence and find that the cited registered mark is weak, even weak marks are entitled to protection.

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 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.

We consider, first, the services involved in this case, and we note that the question of likelihood of confusion must be determined 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). Further, 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 parties' 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 the services are identical; and that the trade channels and classes of purchasers are the same. She contends that the cited registrations encompass all advertising and marketing services and "dissemination of advertising matter"; that the services recited in the cited registrations encompass the services specifically identified by applicant; that, even if

the services are not identical, they are closely related because they promote the goods and services of third-parties; and that, as such, applicant's and registrant's services are directed to the same purchasers, especially those purchasers seeking to reach online consumers.

Applicant contends that she can find no use of the registered marks on the Internet and, thus, there will be no confusion between applicant's and registrant's marks in the marketplace.

We agree with the examining attorney that the services involved herein are essentially the same. Cited registration no. 3095057 recites "advertising and marketing services," which is very broad and clearly encompasses the type of advertising and promotional services recited in the application. Additionally, advertising services for third parties via the Internet, the services described in cited registration no. 3072360, also encompass applicant's promotional services for others via the Internet using discount and rebate coupons. Therefore, applicant's and registrant's services are, in part, identical. Applicant's argument that it is unaware of any use of the registered marks on the Internet is unavailing because this allegation is essentially a collateral attack on the validity of the cited registrations, which is permissible only in the

context of a cancellation proceeding, not in an ex parte appeal.

Applicant's services are rendered primarily via the Internet and some of the services recited in registration no. 3072360 are similarly limited. However, the remaining services recited in registration no. 3072360 and all of the services recited in registration no. 3095057 are not so limited and, thus, we presume these services would be rendered in all ordinary trade channels for such services. The application and the registrations are not limited as to classes of purchasers, so we presume that these services are offered to all normal classes of purchasers. *See In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). In other words, applicant's and registrant's channels of trade and classes of purchasers are overlapping, if not identical.

We turn, next, to a determination of whether applicant's mark and the registered marks, 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 the marks have highly similar commercial impressions and are not distinguished by the design element in applicant's mark. Both marks have the same first term WOW, which she argues is the dominant portion of each mark, stating that applicant "simply deletes the generic material from the registered marks, MARKETING, and adds the descriptive wording, COUPONS." (Brief, unnumbered p. 12.)

Applicant contends that the stylized lettering, design element, different wording and the color in its mark, as well as the exclamation mark in the registered mark, distinguish these marks.

The mark in both of the cited registrations, WOW! MARKETING, consists of two words, the first word is an exclamation, "WOW," that appears to be arbitrary in

connection with the recited services or, at least, it is not merely descriptive thereof. The second word in the mark is the merely descriptive word MARKETING. Clearly, the word WOW is the dominant portion of this mark and its dominance is emphasized by the exclamation mark following it.

Applicant's mark also consists of two words in the same format as the registered mark, i.e., it has the identical first word, WOW, followed by a merely descriptive word, COUPONS. The design element in applicant's mark consists of the phrase WOW COUPONS shown in a simple green font, with a "\$" appearing in the "O" in WOW. We likewise find that WOW is the dominant portion of applicant's mark because, as with the registered mark, it appears to be arbitrary in connection with the recited services or, at least, it is not merely descriptive thereof, and it is the first word in the mark. Moreover, the word WOW is emphasized in applicant's mark because it appears in all capital letters and contains the "\$" design element.

We also do not find the stylization of applicant's mark a distinguishing factor. The registered mark is in standard character format and, thus, registrant could conceivably display its mark in any lettering style, including that of the words WOW COUPONS in applicant's mark. 37 C.F.R. § 2.52(a); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988) (when registering mark in block letters,

registrant remains free to change the display of its mark at any time). See e.g., *Sunnen Products Co. v. Sunex Int'l Inc.*, 1 USPQ2d 1744 (TTAB 1987) (styling of letters is irrelevant to the issue of confusion where applicant seeks to register mark without any special form of lettering or design). When we consider the marks as a whole, we consider them to be more similar than dissimilar.

Therefore, we conclude that in view of the similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the same or overlapping services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

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