

THIS OPINION
IS NOT A PRECEDENT OF
THE T.T.A.B.

Mailed:
3/18/2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Buy Here Pay Here, USA, LLC

Serial No. 78951303

Alicia Brown Oliver of Chambliss, Bahner & Stophel, P.C.
for In re Buy Here Pay Here, USA, LLC

Kapil K. Bhanot, Trademark Examining Attorney, Law Office
108 (Andrew Lawrence, Managing Attorney).

Before Bucher, Bergsman, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

Buy Here Pay Here, USA, LLC filed an application to register the service mark BUY HERE PAY HERE USA and design, shown below, for "dealerships in the field of used automobiles," in international class 35 and for "financing relating to automobiles" in class 36.¹

¹ Application Serial No. 78951303, filed August 14, 2006, filed pursuant to Section 1(b) of the Trademark Act, 15 USC §1051(b), alleging a bona fide intent to use. On October 17, 2007, Applicant filed an Amendment to Allege Use filed pursuant to Section 1(c) claiming September 23, 2006 as its date of first use anywhere and October 13, 2006 as its date of first use in commerce. Applicant disclaimed the exclusive right to use "USA" apart from the mark as shown.



The Examining Attorney refused registration under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d), on the ground that Applicant's mark BUY HERE PAY HERE USA, when used in connection with the identified services, so resembles the registered service mark BEST BUY HERE PAY HERE, in standard character format, for "dealerships in the field of automobiles; providing information about automobiles for sale by means of the internet," as to be likely to cause confusion.²

Upon final refusal of registration, Applicant filed a timely appeal. Both Applicant and Examining Attorney filed briefs. For the reasons discussed herein, the Board affirms the final refusal to register.

Our determination of likelihood of confusion under Section 2(d) is based on an analysis of all of the relevant, probative facts in evidence. *In re E. I. du Pont*

² Registration No. 2942009, issued April 19, 2005.

Serial No. 78951303

de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, the two key considerations are the similarities between the marks and the similarities between the goods or, as here, the services. See *Federated Foods, Inc. v. Fort Howard Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks"). We consider each of the factors as to which Applicant or Examining Attorney presented arguments or evidence.

Similarity or dissimilarity of the marks

We consider and compare the appearance, sound, connotation and commercial impression of the marks in their entireties. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Where a mark consists of words as well as a design, the words are generally dominant because the words will be used to call for or refer to the services. *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581-82, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin's*

Serial No. 78951303

Miniatures Inc., 59 UPSQ2d 1593, 1596 (TTAB 2001); *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987). This is true of Applicant's mark, whose design merely highlights its services.

The mark in the cited registration is BEST BUY HERE PAY HERE. The word "best" is laudatory. It is an adjective that means "of the highest quality, excellence, or standing" or "the most advantageous, suitable or desirable."³ Accordingly, the leading word "best" in the registered mark is commercial puffery implying that registrant is rendering the *best* BUY HERE PAY HERE services. Under these circumstances, applicant's mark and the registered mark are virtually identical in appearance, sound, meaning, and commercial impression.

Applicant argues that "Buy Here Pay Here" is a weak source identifier, meaning simply a place where consumers can buy a car on installment without using an outside lender.⁴ A weak mark is still protectable however, and third party usage or infringement does not entitle Applicant to register a confusingly similar mark. See

³ The Random House Dictionary of the English Language Unabridged, p. 198 (2nd ed. 1987). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

⁴ The Examining Attorney chose not to give a 2(e)(1) rejection however.

Serial No. 78951303

Giant Food Inc. v. Roos and Mastacco, Inc., 218 USPQ 521 (TTAB 1982) (even owner of weak mark is entitled to protection from likelihood of confusion).

Similarity of the Services, Channels of Trade, and Classes of Consumers

The services covered by Applicant's and registrant's marks are also identical in part. Applicant is seeking registration for automobile dealerships and financing. Registrant's mark covers the former. Furthermore, Examining Attorney has produced probative evidence that automobile dealerships and financing are frequently advertised together, and apparently rendered by the same source. In addition, there are no limitations in either the registration and/or the application, and therefore we must presume that the services at issue will travel in all normal and usual channels of trade and be sold to all classes of consumers. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). In view of the foregoing, the services, channels of trade and classes of consumers are the same.

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists because the marks are quite similar, they are used on partially identical services,

Serial No. 78951303

they are likely to target the same consumers, and they are likely to be sold through the same channels of trade.

Decision: The refusal to register is affirmed.