

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
Feb. 9, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Century 21 Real Estate Corporation¹ and TM Acquisition
Corporation

v.

New Century Services Corporation

Opposition No. 91162629
to application Serial No. 75585493
filed on November 9, 1998

Ranjitsinh Mahida of Harvey Siskind LLP for Century 21 Real
Estate Corporation and TM Acquisition Corporation.

Randal D. Homburg for New Century Services Corporation.

Before Seeherman, Grendel and Mermelstein, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

¹ Century 21 Real Estate Corporation is one of the opposers named in the original notice of opposition (along with TM Acquisition Corporation). Opposers' later filings in this case have identified this opposer as "Century 21 Real Estate, LLC, successor in interest to Century 21 Real Estate Corporation." However, opposers have never filed a motion to substitute Century 21 Real Estate, LLC as party plaintiff in place of Century 21 Real Estate Corporation, and there is nothing in the record from which we might determine that a transfer of interest from Century 21 Real Estate Corporation to Century 21 Real Estate, LLC has occurred. In view thereof, Century 21 Real Estate Corporation shall remain the opposer of record herein (along with TM Acquisition Corporation). See Fed. R. Civ. P. 25(c); TBMP §512.01.

New Century Services Corporation, applicant herein, seeks registration on the Principal Register of the mark depicted below



for services recited in the application as "real estate management services, not including title-searching services," in Class 36.² Applicant has disclaimed the exclusive right to use SERVICES apart from the mark as shown.

Opposers Century 21 Real Estate Corporation and TM Acquisition Corporation filed a notice of opposition to registration of applicant's mark, asserting as grounds therefor a likelihood of confusion claim under Trademark Act Section 2(d), 15 U.S.C. §1052(d), and a dilution claim under Trademark Act Section 43(c), 15 U.S.C. §1125(c).³

² Serial No. 75585493, filed November 9, 1998. The application is based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a). April 17, 1996 is alleged in the application to be the date of first use of the mark, and June 20, 1997 is alleged to be the date of first use in commerce.

³ The notice of opposition also includes Section 2(a) claims of deceptiveness and false suggestion of a connection, but opposers have not presented evidence or argument with respect thereto. We deem opposers to have waived their pleaded Section 2(a) claims, and we shall give them no consideration.

Applicant answered the notice of opposition by admitting certain of opposers' allegations (as discussed *infra*) and denying the remaining allegations.⁴

The evidence of record in this case consists of the file of the opposed application; the pleadings herein; opposers' notices of reliance on their pleaded registrations, on certain of applicant's discovery responses, on portions of the discovery deposition of applicant's principal Thomas Torossian (submitted during opposers' rebuttal testimony period), on various NEXIS articles, and on various court documents and decisions in other cases in which opposers have been plaintiffs; the testimony depositions (and exhibits thereto) of opposers' witnesses Mary Berry (one of opposers' franchisees) and

⁴ Applicant also pleaded several affirmative defenses in its answer. The first is essentially applicant's further denials of opposers' likelihood of confusion claim, rather than a proper affirmative defense. The second affirmative defense alleges that opposer never notified applicant of any likelihood of confusion prior to publication of applicant's mark. To the extent that this is intended to be some sort of a laches or estoppel defense, it is without merit because such defenses are not available to an applicant in an opposition proceeding. See *National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424 (Fed. Cir. 1991). Applicant's third affirmative defense is that opposers filed their notice of opposition in bad faith and with the intention of harassing small businesses like applicant's. This defense likewise is without legal merit in this opposition proceeding. Finally, applicant alleges that "a simple disclaimer in Applicant's mark would cure" any likelihood of confusion or dilution, and applicant offers to submit such a disclaimer. Applicant does not specify what it proposes to disclaim (apart from the already-disclaimed SERVICES), but such a disclaimer, even if entered, would not dispose of opposers' pleaded claims. For these reasons, and because none of these defenses has been proven in any event, we have given applicant's "affirmative defenses" no consideration.

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Tanis Bolick (opposers' Vice President of Franchise Support); and the testimony deposition of applicant's principal Thomas Torossian (and exhibits thereto).

The case is fully briefed. For the reasons discussed below, we sustain opposers' Section 2(d) ground of opposition. In view thereof, we need not and do not reach opposers' dilution claim.

Initially, we must address an apparent misunderstanding on the part of applicant regarding the nature and purpose of this opposition proceeding. Contrary to applicant's arguments, the issue in this case is not whether the Board should "affirm" or "overturn" the decision of the Trademark Examining Attorney who approved applicant's mark for publication. That decision is not at issue in this inter partes proceeding. Rather, the issues to be determined in this proceeding are whether opposers have established that they will be damaged by registration of applicant's mark (i.e., whether opposers have established their standing to oppose), and whether they have established at least one statutory ground for opposition to registration of applicant's mark. See Trademark Act Section 13(a), 15 U.S.C. §1063(a). The Trademark Examining Attorney's ex parte decision to allow publication of applicant's mark for opposition is not relevant to our determination in this

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inter partes opposition proceeding, which must be made on the basis of the evidence the parties have made of record.

We turn now to the merits of this proceeding. Opposers have made of record status and title copies of numerous pleaded CENTURY 21 registrations.⁵ These include:

Reg. No. 1063488, of the mark **CENTURY 21** (in standard character format) for "real estate brokerage services";⁶

Reg. No. 1085039, of the mark **CENTURY 21** (in standard character form) for "rendering technical assistance to others in the establishment and/or operation of real estate brokerage businesses";⁷

Reg. No. 1304095, of the mark **CENTURY 21** (in standard character form) for "mortgage brokerage services and assisting lending institutions in the processing of loans";⁸

⁵ The registrations pleaded by and relied on by opposers in this case are owned by opposer TM Acquisition Corporation; opposer Century 21 Real Estate Corporation uses and licenses others to use the registered marks pursuant to authority granted by TM Acquisition Corporation. See Notice of Opposition at ¶ 2, admitted by applicant in its answer. Also, we note that opposers also made of record two registrations which we have not considered, i.e., Reg. No. 2131405, which was cancelled under Section 8 on February 8, 2006, and Reg. No. 1091541, which expired in February 1999.

⁶ Issued April 12, 1977; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

⁷ Issued February 7, 1978; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

⁸ Issued November 6, 1984; affidavits under Sections 8 and 15 accepted and acknowledged; renewed.

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Reg. No. 2178970, of the mark **CENTURY 21** (in standard character form) for "providing access to the interactive computer databases of others in the fields of real estate, insurance and mortgage services, via a global computer network";⁹

Reg. No. 1085040, of the mark depicted below,



for "real estate brokerage services";¹⁰

Reg. No. 1353229, of the mark depicted below,



for "providing technical assistance in the establishment and operation of businesses providing brokerage of real estate securities and related consulting services";¹¹

Reg. No. 1334686, of the mark **CENTURY 21 INVESTMENT CONNECTION** (INVESTMENT disclaimed), for "real estate brokerage services";¹²

⁹ Issued August 4, 1998; affidavits under Sections 8 and 15 accepted and acknowledged.

¹⁰ Issued February 7, 1978; Section 8 affidavit accepted; renewed.

¹¹ Issued August 6, 1985; affidavits under Sections 8 and 15 accepted and acknowledged.

¹² Issued May 7, 1985; affidavits under Sections 8 and 15 accepted and acknowledged.

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Reg. No. 2615437, of the mark **CENTURY 21 MORTGAGE**
(MORTGAGE disclaimed) for "mortgage banking services";¹³

Reg. No. 2633322, of the mark **CENTURY 21 MATURE MOVES,**
FOR "real estate brokerage services";¹⁴

Reg. No. 2633331, of the mark depicted below,

Century21
MatureMoves

for "real estate brokerage services";¹⁵

Reg. No. 1551266, of the mark **CENTURY 21 STAR** for "real
estate brokerage and leasing and mortgage banking services
for military personnel";¹⁶

Reg. No. 1526059, of the mark depicted below,



(MILITARY RELOCATION NETWORK disclaimed), for "relocation
services" and "real estate brokerage services";¹⁷

¹³ Issued September 3, 2002.

¹⁴ Issued October 8, 2002.

¹⁵ Issued October 8, 2002.

¹⁶ Issued August 8, 1989; affidavits under Sections 8 and 15
accepted and acknowledged.

¹⁷ Issued February 21, 1989; affidavits under Sections 8 and 15
accepted and acknowledged.

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Reg. No. 2656899, of the mark depicted below,



for "real estate brokerage services";¹⁸

Reg. No. 2158319, of the mark **CENTURY 21 COMMERCIAL INVESTMENT NETWORK** and design (COMMERCIAL INVESTMENT NETWORK disclaimed), for "real estate brokerage, management and leasing services, business brokerage services, and real estate investment consulting services";¹⁹ and

Reg. No. 2544997, of the mark depicted below,



for "real estate brokerage services."²⁰

Initially, we note that opposers contend that they own a family of CENTURY marks. We find that the record does not support such a claim, inasmuch as there is insufficient evidence to establish that opposer uses and advertises its various marks together in the manner of a family of marks. Mere ownership of the various marks, or registrations thereof, does not suffice to establish a family of marks. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d

¹⁸ Issued December 3, 2002.

¹⁹ Issued May 19, 1998; affidavits under Sections 8 and 15 accepted and acknowledged.

²⁰ Issued March 5, 2002.

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1460, 18 USPQ2d 1889 (Fed. Cir. 1991). Our decision therefore is not based on any such alleged family of marks. Instead, we shall base our analysis and decision on opposers' prior use and registration of its CENTURY 21 marks (summarized *supra*), including its CENTURY 21 standard character form marks, its CENTURY 21 design marks and its CENTURY 21 marks which also include other generic or descriptive wording. We need not and shall not consider or base our decision on those of opposers' registered marks which do not consist of or include the designation CENTURY 21.

Because opposers have properly made their pleaded registrations of record, we find that opposers have established their standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Moreover, because opposers' pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and goods and services covered by said registrations. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In any event, opposers have proven that their use of their CENTURY 21 marks predates applicant's date of first use.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & 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 Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The fifth *du Pont* evidentiary factor requires us to consider evidence of the fame of opposers' mark, and to give great weight to such evidence if it exists. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. Becton*, 214 F.3d 1322, 54 F.2d 1894 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

Fame of an opposer's mark or marks, if it exists, plays a "dominant role in the process of balancing the *DuPont* factors," *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1456 [sic - 1897], and "[f]amous marks thus enjoy a wide latitude of legal protection." *Id.* This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* Indeed, "[a] strong

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mark ... casts a long shadow which competitors must avoid." *Kenner Parker Toys*, 963 F.2d at 353, 22 USPQ2d at 1456. A famous mark is one "with extensive public recognition and renown." *Id.*

Bose Corp. v. QSC Audio Products Inc., *supra*, 63 USPQ2d at 1305.

In this case, we find that the evidence of record clearly establishes that opposers' CENTURY 21 marks are famous in the real estate field, for purposes of the fifth *du Pont* likelihood of confusion factor. First, we note that applicant, in ¶ 7 of its answer to the notice of opposition, expressly admitted opposers' allegation (at ¶ 24 of the notice of opposition) that "[f]or many years, the CENTURY 21 Marks have been widely used and extensively advertised in the United States and, therefore, these names and marks have become well known and famous as distinctive symbols of Opposers' goodwill."

Second, in addition to applicant's admission, we find that opposers have presented substantial evidence in support of their claim of fame. Opposers and their franchisees have used the CENTURY 21 mark since the founding of the company in 1971. (Bolick Depo. at 6.) Since 1971, opposers and their franchisees have spent over \$1 billion in advertising and promoting their services under the CENTURY 21 mark. (*Id.* at 22.) Opposers' and their franchisees' sales in 2004 totaled over \$1 billion, with 920,000 real estate

transactions closed in that year. (*Id.* at 11.)²¹ Opposers' and their franchisees' 2004 expenditures on advertising and promoting the mark totaled \$55 million. (*Id.* at 22.)

Century 21 is the number one real estate company in the world in terms of closed transactions and also in terms of numbers of offices and agents. (*Id.* at 11.) We note in this regard that applicant's counsel, during cross-examination of Ms. Bolick, stated as follows: "... I'm going to tell you that no doubt Century 21 is the biggest real estate company in the United States. I'll stipulate to that." (*Id.* at 52.)²² In a 2000 "Total Unaided Brand Awareness" survey, respondents were asked "Please tell me which real estate companies/any on-line or Internet real estate companies or services you have heard of." 55% of the respondents stated that they had heard of Century 21, a percentage which is over twenty points higher than the next

²¹ Sales of houses present a somewhat unusual situation in terms of evaluating sales figures with respect to the factor of fame, since homes may cost many millions of dollars, and therefore a large dollar figure for sales may not actually represent a large number of transactions. However, in this case opposers have presented evidence not only of the dollar amount of their sales, but the number of transactions. It is therefore clear that opposers' sales represent dealings with a large number of clients, purchasers and potential purchasers.

²² The determination of fame is dependent on recognition of the mark in the United States, and therefore the fact that Century 21 may be the number one real estate company in the world would be irrelevant if there were no evidence of the renown of the mark in the United States. Here, of course, we have such evidence, as well as applicant's stipulation that Century 21 is the biggest real estate company in the United States.

most-identified real estate company. (*Id.* at 40-42.) Opposers' website, CENTURY21.COM, is the second most-visited website in the real estate field, second only to REALTOR.COM. (*Id.* at 35-36.) Finally, the NEXIS evidence submitted by opposers via notice of reliance shows numerous unsolicited mentions in the press of opposers and their CENTURY 21 mark.

Based on all of this evidence,²³ including applicant's admission in its answer, we find that opposers' CENTURY 21 mark is a famous mark for purposes of the fifth *du Pont* factor. Such fame "plays a dominant role in the process of balancing the *du Pont* factors." *Recot Inc. v. Becton*, *supra*, 214 F.3d at 1327, 54 USPQ2d at 1897. Opposers' famous mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys*, *supra*, 963 F.2d at 353, 22 USPQ2d at 1456.

We turn next to the second *du Pont* factor, i.e., the similarity or dissimilarity of the parties' respective services. It is not necessary that the respective services be identical or even competitive in order to support a

²³ In finding fame, we have not relied on opposers' evidence, submitted via notice of reliance, of the numerous decisions in other litigation in which the fame of opposers' marks was found or discussed. The factual findings of those other tribunals are not actual evidence of fame which can be asserted by opposers in this case. We consider this evidence of and from other proceedings as establishing only that opposers have been vigilant in policing their marks.

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finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. It is sufficient that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

First, we note that applicant has not disputed or argued that its services are closely related, if not identical, to opposers' services. Indeed, in its brief applicant essentially concedes that opposers and applicant "may be in closely related fields of endeavor." (Brief at 6.

We find in any event that "real estate management services, not including title-searching services," the services recited in applicant's application, are identical

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in part, and otherwise similar and related to, the services rendered by opposers in connection with their CENTURY 21 marks. Applicant's recited services are identical to the real estate management services recited in opposer's Registration No. 2158319 (of the mark CENTURY 21 COMMERCIAL INVESTMENT NETWORK). The other services recited in opposers' various CENTURY 21 registrations, most notably opposers' "real estate brokerage services," are, as shown by the record, closely related to applicant's real estate management services.

In this regard, we note that in addition to the evidence of opposer's ownership of its registrations, opposers' witness Ms. Bolick testified that opposers use their CENTURY 21 marks in connection with a wide variety of real estate-related services, including real estate management services: "Q. And what types of real estate would Century 21 be involved in? A. Well, residential real estate, commercial real estate, property management ... relocation. All different aspects of real estate, quite frankly. Not much they're not involved in." (Bolick Depo. at 5.) Compare this to the testimony of applicant's principal Mr. Torossian, who stated that applicant is engaged in "property management, land acquisition for government right-of-way purposes and commercial and residential real estate as it pertains to purchase of

distressed properties and refurbishment for resale.”

(Torossian Testimony Depo. at 19.) He also testified that “[a]nything that has to do with real estate, New Century Services is involved.” (*Id.*) This testimony from both parties’ witnesses further demonstrates that real estate companies (like opposers’ and applicant’s) may engage in various activities involving real estate, including management and brokerage services, and that the parties’ services therefore are related for purposes of the second *du Pont* factor.

For these reasons, we find that applicant’s recited services are in part identical to and otherwise closely related to the services opposers render under their CENTURY 21 marks. The second *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Under the third *du Pont* factor (similarity or dissimilarity of trade channels), we find that applicant’s recited services and opposers’ services are rendered in similar trade channels and to similar classes of purchasers. There are no restrictions as to trade channels or classes of purchasers in the recitation of services in applicant’s application or in the recitations of services in opposers’ registrations. We therefore presume that the recited services are marketed in all normal trade channels for such services and to all normal classes of purchasers for such

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services. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). To the extent that applicant's recited "real estate management" services are identical to opposers' services, we find that the respective services are marketed in identical trade channels and to identical classes of purchasers. We also find that the trade channels and classes of purchasers for applicant's services are similar to the trade channels and classes of purchasers for opposers' various other real estate services. Applicant's "real estate management" customers could and would be the same as opposers' customers, which include both property owners (ordinary consumers who might purchase a home or a second home and then decide to rent it out, and would hire a company like applicant's to manage the property), and real estate professionals, as well as other professionals who deal with real estate, such as real estate lenders.

For these reasons, we find that the parties' respective trade channels and classes of purchasers are identical in part and otherwise closely related. The third *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor, i.e., the conditions of purchase, we find that the purchasers of opposers' and applicant's respective services, both real estate professionals and ordinary consumers, are likely to exercise

care in making their purchasing decisions. This factor weighs in applicant's favor in our likelihood of confusion analysis.

We turn next to the first *du Pont* factor, which requires us to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, 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 impression that confusion as to the source of the goods 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 Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases

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such as this, where the applicant's services are identical (at least in part) to the opposers' services, the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find as follows. First, we find that the dominant feature of opposers' CENTURY 21 marks and of applicant's NEW CENTURY SERVICES mark is the word CENTURY. *In re Chatam International Inc., supra; In re National Data Corp., supra.* CENTURY is an arbitrary term when used in connection with real estate services. The word NEW in applicant's mark and the number 21 in opposers' marks clearly modify, refer to and reinforce the dominant significance of the word CENTURY in the respective marks. Applicant has disclaimed the exclusive right to use the generic word SERVICES apart from the mark as shown; while we do not ignore this word, we find that it is entitled to little weight in our comparison of the marks.

In terms of appearance, we find that the marks look the same to the extent that they both include the word CENTURY. There are visual differences between the respective marks, including the presence of the horse-shoe design feature in

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applicant's mark, the presence of the word NEW in applicant's mark, the presence of the numeral 21 in opposers' marks, and the presence of different generic wording in applicant's mark and in some of opposers' marks. We find, however, that the marks are more similar than dissimilar in terms of appearance in view of the presence in both marks of the word CENTURY.

In terms of sound, we find again that the marks are identical to the extent that CENTURY would be pronounced in both marks. There are also some differences in pronunciation, inasmuch as applicant's mark includes the words NEW and SERVICES, while opposers' marks include the numeral 21 and/or additional generic wording. Again, however, we find that the marks are more similar than dissimilar in terms of sound due to the dominant presence of the word CENTURY in both marks.

We find the marks to be quite similar in connotation. The connotation of CENTURY 21 is "the 21st century." The 21st century also is and would be understood to be the "new century," inasmuch as we are only a few years into it. Thus, CENTURY 21 and NEW CENTURY mean essentially the same thing. The presence of the generic and disclaimed word SERVICES in applicant's mark and the presence of additional generic and disclaimed matter in some of opposers' CENTURY 21 marks do not detract from or negate the obvious

similarity in connotation between the respective marks. See *Kenner Parker Toys, supra*.

In terms of overall commercial impression, we find that the marks are similar rather than dissimilar. The dominant feature in the commercial impression of both marks is the word CENTURY, and even the word NEW in applicant's mark and the number 21 in opposers' marks give the marks highly similar if not essentially identical commercial impressions when the marks are considered as a whole. The presence of the horse-shoe design element in applicant's mark does not detract from or negate the similarity in the marks' overall commercial impressions.

Applicant's repeated argument that the marks can be distinguished when subjected to a side-by-side comparison misstates the test under the first *du Pont* factor. *Sealed Air Corp. v. Scott Paper Co. supra*. And even if we assume, *arguendo*, that purchasers will be able to view the marks on a side-by-side basis, we find that they still are likely to be confused as to the source of the services offered under the respective marks. Whatever the minor points of dissimilarity between the marks, we find that when the marks are viewed in their entirety, especially in terms of connotation and overall commercial impression, they are similar rather than dissimilar. We find that purchasers are

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likely to assume, based on the presence of the word CENTURY in both marks, that a source connection exists.

Moreover, as discussed above, we find that opposers' mark is famous and entitled to a broad scope of protection which newcomers like applicant must stay well away from, and we also find that applicant's services are in part identical to and otherwise closely related to opposers' services. Both of these findings under the fifth and second *du Pont* factors reduce the degree of similarity between the marks that is required to find likelihood of confusion upon balancing all of the *du Pont* factors.

For these reasons, we find that applicant's mark is confusingly similar to opposers' mark. The first *du Pont* factor accordingly weighs in favor of a finding of likelihood of confusion.

Applicant argues that there is no evidence of any instances of actual confusion between the parties' respective marks and services, and that the seventh *du Pont* factor therefore weighs in its favor. However, the record shows that applicant's use and advertising of its mark in connection with the services recited in the application have not been substantial, and certainly not so extensive that there has been a meaningful opportunity for any actual confusion to have occurred. Applicant is licensed to do real estate business only in Oklahoma. (Torossian Discovery

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Depo. at 17-19.) In the ten years from the founding of the company in 1995 through 2004, applicant's expenditures on advertising totaled only \$25,638. (Applicant's response to opposer's Interrogatory No. 5.) Applicant hasn't advertised in newspapers "for years," if ever. (Torossian Discovery Depo. at 145-46.) Applicant is now "dedicating over 90% of its business to the right-of-way acquisition" activities. (Applicant's response to opposer's Interrogatory No. 3.) Applicant's sole principal, Mr. Torossian, "has limited his practice to land acquisition and land management service for the Department of Transportation and a very occasional purchase of distressed or older property from an individual seller..." Applicant's concentration on attempting to obtain business from the Department of Transportation, along with its minimal advertising expenditures, go far to explain the apparent absence of actual confusion between applicant's mark and services and those of opposers'.

Under the eighth *du Pont* factor, such lack of opportunity for actual confusion to have occurred counters the lack of evidence of actual confusion, such that the seventh and eighth *du Pont* factors essentially cancel each other out in our likelihood of confusion analysis. Stated differently, we find that given the circumstances of applicant's limited use and advertising of its mark, the absence of actual confusion is not factually surprising or

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legally significant. See *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1663; *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992). In any event, the appropriate question is whether there is a likelihood of confusion, not whether confusion has actually occurred. While evidence of actual confusion would strongly support opposers' case, it does not necessarily follow that the lack of such evidence supports applicant's case, particularly where, as here, there has not been a significant opportunity for such confusion to have occurred. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein.

Having considered the evidence of record as it pertains to all of the *du Pont* factors, we conclude that opposers have established that a likelihood of confusion exists. The fourth *du Pont* factor, conditions of purchase, may favor applicant, but the evidence and our findings as to the other *du Pont* factors, including the similarity of the marks, the similarity of the services and the trade channels and classes of purchasers for such services, and, most significantly, the fame of opposers' mark, clearly weigh in opposers' favor. On balancing all of the *du Pont* factors, we conclude that a likelihood of confusion exists. To the extent that any doubts might exist as to the correctness of this conclusion (and we have none), we resolve such doubts

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against applicant. See *Century 21 Real Estate Corp., supra*; *Ava Enterprises Inc. v. Audio Boss USA Inc.*, 77 USPQ2d 1783 (TTAB 2006); and *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844 (TTAB 2004).

Because opposers have established their standing to oppose and their pleaded Section 2(d) ground of opposition, we find that they are entitled to prevail in this case.

Decision: The opposition is sustained.²⁴

²⁴ As noted above, we need not and do not reach opposers' dilution claim, nor its waived Section 2(a) claims.