

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

Mailed:
August 17, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Dollar Rent A Car, Inc.

v.

Interactive Financial Marketing Group, LLC

Opposition No. 91165095 to application
Serial No. 76591636 filed on May 11, 2004

and

Opposition No. 91165097 to application
Serial No. 76591637 filed on May 11, 2004

Samuel D. Littlepage and Jeffrey S. Molinoff of Dickinson
Wright PLLC for Dollar Rent A Car, Inc.

Matthew T. Kelly of Lanciano & Associates, L.L.C. for
Interactive Financial Marketing Group, LLC.

Before Walters, Drost and Zervas, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Interactive Financial Marketing Group, LLC,
seeks registration on the Principal Register of the mark
DOLLARDEALER (Serial No. 76591636) and the mark DOLLARMAX
(Serial No. 76591637) both in standard character form and

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both for "automobile loan and financing services" in International Class 36. In each application, applicant has claimed a bona fide intention to use the mark in commerce.

Opposer, Dollar Rent A Car, Inc., filed notices of opposition to registration of applicant's marks. In the notices of opposition, opposer pleaded ownership of the following four registrations:¹

Registration No. 0948360, registered December 5, 1972 and renewed, for the mark DOLLAR (in typed or standard character form) for "automobile vehicle renting and leasing services" in International Class 39;

Registration No. 1492628, registered June 14, 1988 and renewed, for the mark DOLLAR (in typed or standard character form) for "automotive vehicle renting and leasing services" in International Class 39;²

Registration No. 2182755, registered August 18, 1998 (Section 8 accepted and Section 15 acknowledged), for the mark DOLLAR and Design, i.e.,



for "retail and wholesale used automobile sales outlet services" in International Class 42; and

¹ Opposer erroneously states at p. 1 of its brief that opposer pleaded ownership of Registration No. 2170106 for the mark DOLLAR and Design in its notices of opposition. Registration No. 2170106 was not pleaded, and we do not consider the pleadings to have been amended to assert this registration pursuant to Fed. R. Civ. P. 15(b). See TBMP § 314 (2d ed. rev. 2004).

² The marks and the services are identical in Registration Nos. 0948360 and 1492628. There are differences in classification of the services and in the dates of use.

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Registration No. 2245294, registered May 18, 1999
(Section 8 accepted and Section 15 acknowledged),
for the mark DOLLAR and Design, i.e.,



lined for the colors blue, red and yellow, for
"retail and wholesale used automobile sales outlet
services" in International Class 35.³

Opposer alleges that applicant's marks so closely resembles
opposer's "Dollar" marks for automobile related services as
to be likely to cause confusion, mistake or deception in
violation of Section 2(d) of the Trademark Act, 15 U.S.C.
§ 1052(d).

Applicant has answered the notices of opposition by
denying the salient allegations thereof. The Board
consolidated the oppositions in an order dated August 25,
2005.

The record consists of the pleadings; the files of the
involved applications; and, pursuant to applicant's two
notices of reliance, a status and title copy of two of
opposer's registrations (Registration Nos. 0948360 and
2170106)⁴ and copies of registration records from the
Office's TESS database. Additionally, pursuant to a

³ Registration Nos. 2182755 and 2245294 identify identical
services but place them in different International Classes.

⁴ Opposer did not plead Registration No. 2170106 for the mark
DOLLAR (in typed of special character form) for "retail and
wholesale used automobile sales outlet services."

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stipulation between the parties allowing for the filing of testimony by declarations, opposer filed declarations with exhibits of the following persons:

Jeffrey Cerefice, Vice President of Dollar Thrifty Automotive Group, Inc. ("DTAG"), opposer's parent corporation;

Jerry Carlson, Director of Licensees for DTAG;

Michelle DiCarlo, a paralegal with opposer's law firm;

Fred Fleischner, Vice President of Advertising for DTAG; and

Rick Manfred, co-owner and Vice President of Cougar Investments, Inc. ("Cougar Investments"), one of opposer's licensees.

Opposer has filed its brief. Applicant did not submit any trial testimony or other evidence during his testimony period and has not filed a brief.

Priority

Opposer has submitted (i) a status and title copy of pleaded Registration No. 0948390 for the mark DOLLAR showing opposer as the owner of this subsisting registration; (ii) a copy of pleaded Registration Nos. 2182755 and 2245294 both for the mark DOLLAR and Design, as exhibits to Mr. Carlson's declaration; and (iii) a copy of pleaded Registration No. 1492628 for the mark DOLLAR, as an exhibit to Mr. Fleischner's deposition. Mr. Carlson has testified that opposer is the owner of Registration Nos. 2182755 and 2245294 and that they are valid; and Mr. Fleischner has

testified that opposer registered the mark which is the subject of Registration No. 1492628 and that the registration is valid. In view of this evidence, opposer has established priority, and Section 2(d) priority of use is not an issue in this case. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our 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 issue of likelihood of confusion. In *re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first consider the similarity and dissimilarity of the marks, determining whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée*

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En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Where marks have both a word and a design, such as in opposer's DOLLAR and Design marks, the general framework for analyzing such marks is that the literal portion, i.e., DOLLAR, is accorded greater weight because purchasers will use the words to request or refer to the services. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987).

Applicant's marks are compound terms composed of the terms DOLLAR and DEALER in one mark and DOLLAR and MAX in the other mark. The wording of opposer's pleaded marks and applicant's DOLLAR-formative marks differ only by applicant's addition of DEALER or MAX to DOLLAR. DOLLAR is the beginning portion of applicant's compound term marks and is a word by itself that would be pronounced separately and in the same manner as in opposer's marks. It also is the name of U.S. currency, a term which the relevant purchasing public, consisting of the public at large, articulates

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countless times during the course of a year. We therefore find that DOLLAR is the term in applicant's marks that is most likely to be impressed upon the minds of purchasers. The meaning of DOLLAR does not change when DEALER and MAX are added to DOLLAR. Also, due to the shared term DOLLAR, purchasers already familiar with opposer's marks would likely view applicant's marks as variations of opposer's marks, especially DOLLARMAX, which has the connotation of maximizing the value of one's dollar.⁵ Thus, we find that the marks are more similar in sound and meaning than dissimilar.

With respect to the commercial impressions of the marks, we find that because DOLLAR creates a separate impression from DEALER or MAX, see discussion supra, DOLLAR stands apart from DEALER or MAX and hence plays a significant role in forming the commercial impressions of applicant's marks. As DOLLAR is the only wording in opposer's marks, we find the commercial impressions of both parties' marks to be similar.

⁵ In this regard, we note that the record includes evidence that opposer has used marks which include DOLLAR and other terms. See opposer's web page and samples of advertising which are exhibits 16 and 17 to Mr. Fleischner's deposition respectively, showing use of marks such as DOLLAR EXPRESS, DOLLAR 4 BUSINESS and SILVER DOLLAR CLUB. See also *Humana, Inc. v. Humanomics, Inc.*, 3 USPQ2d 1696, 1700 (TTAB 1987) ("The fact that Humana has itself used variations of its house mark by adding matter to it, e.g., HUMANA CARE and HUMANA CARE PLUS, increases the likelihood that HUMANOMICS would be perceived as another variation.")

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Further, with respect to appearance, applicant's marks may be depicted in a manner so that they are highly similar to opposer's marks. Because applicant's marks are in typed form, applicant may use any reasonable stylization of lettering, including any stylization used by opposer. See, e.g., *Phillips Petroleum Co. v. C. J. Webb, Inc.* 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) (a mark registered in typed format is not limited to the depiction thereof in any special form); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585, 1588 (TTAB 1992) ("[a]s the Phillips Petroleum case makes clear, when [an] applicant seeks a typed or block letter registration of its word mark, then the Board must consider all reasonable manners in which ... [the word mark] could be depicted"). Applicant's marks may be depicted in a manner that highlights DOLLAR or that minimizes any impression created by DEALER or MAX. By emphasizing DOLLAR, and/or by depicting DOLLAR in the same lettering style used by opposer, applicant heightens the visual similarity between applicant's marks and opposer's marks. We add too that the design elements in those of opposer's marks which have design elements are largely geometric in nature; their contribution to the overall appearance of the marks is minor.

In view of the foregoing, we find the marks, when considered in their entirety, are similar in sound,

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meaning, appearance and commercial impression, and that the *du Pont* factor regarding the similarity of the marks weighs in favor of a likelihood of confusion.

Turning next to the *du Pont* factor regarding the similarity or dissimilarity of the services, we consider opposer's pleaded "retail and wholesale used automobile sales outlet services" and "automotive vehicle renting and leasing services," and applicant's "automobile loan and financing services." In connection with opposer's used automobile sales services, Mr. Carlson has explained that opposer licenses the DOLLAR mark for use in connection with five automobile dealerships in Seattle and Spokane, Washington, Coer D'Alene, Idaho and Arlington and Bedford, Texas. One of such dealerships is Cougar Investments, which has been a licensee of opposer since 1987. Cougar Investments sells used automobiles under the DOLLAR trademark.

It is well settled that services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the services are related in some manner or that the circumstances surrounding their marketing are 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

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are in some way associated with the same producer or that there is an association between the producers of the services. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Of course, many of the vehicles sold by opposer in its used automobile sales outlets are financed by purchasers. See Manfred Dec. ¶ 15 ("Automobiles, even used automobiles, are expensive. Most customers do not pay cash. They finance their purchases."). Opposer's evidence establishes that vehicle rental companies which sell used rental vehicles also offer financing services in connection with the sales of such vehicles. See Manfred Dec., ¶¶ 15 - 17; Cerefice Dec. ¶ 15; and DiCarlo Declaration, and exhibits attached thereto, especially:

thriftycarsales.com webpage - "We offer a wide range of financing options to help with any budget";

hertzcarsales.com webpage - "Hertz offers qualified buyers a choice of financing plans through a variety of outside institutions";

budgetcarsales.com webpage - "Does Budget Car Sales finance the cars they sell? Some locations offer on-the-spot financing. Some have national lender agreements that give you the opportunity to take advantage of some of the lowest rates in the industry. Some locations also offer financing options to those who have special credit needs or need to re-establish a ... credit rating";

avisnj.com webpage - "On the premise [sic] financing at competitive rates enables us to

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complete your purchase quickly with simple language contracts"; and

enterprisecarsales.com webpage - "To make driving home in an Enterprise vehicle as easy as possible, we gladly accept trade-ins and help used car buyers secure financing."

Opposer's evidence also establishes that automobile dealerships (which do not necessarily rent vehicles) also offer financing for vehicles they sell. See webpages from automobile dealerships submitted with DiCarlo Dec., i.e., exhibits 8 - 17 thereto. This evidence shows that the services are such that they would be encountered by the same persons in situations that would give rise, because of the similarity of the marks used thereon, to a mistaken belief that there is an association between the providers of the services. Hence, opposer has established prima facie that opposer's retail and wholesale used automobile sales outlet services and automobile loan and financing services are related. Furthermore, with regards to opposer's automotive vehicle leasing services, because purchasers may consider leasing a vehicle at the same time they consider whether to purchase *and finance* a vehicle, we find that opposer's automotive vehicle leasing services and automobile loan and financing services are related. This *du Pont* factor too weighs in opposer's favor in connection with such services.

We now consider the similarity or dissimilarity of the parties' trade channels. Inasmuch as there are no

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restrictions in either the applications or the registrations, we must assume that the services travel in all the normal channels of trade for such services. *Schieffelin & Co. v. Molson Companies Ltd.*, 9 USPQ2d 2069, 2073 (TTAB 1989) (“[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade”). In view of the relationship noted above between vehicle sales and financing, and vehicle leasing and financing, and because there are no restrictions in the parties' identifications of services, we find that the parties' trade channels for such services overlap. The *du Pont* factor regarding trade channels thus is resolved in opposer's favor.

With respect to the *du Pont* factor regarding the fame of the prior mark, opposer contends on p. 16 of its brief that its DOLLAR mark is “a very well-known (and perhaps famous) mark” used in connection with its automobile related services such as vehicle renting and leasing services and automobile dealership services.

The fame of a plaintiff's mark, when fame is shown in the record, is an important factor because a famous mark deserves a broad scope of protection. A plaintiff is obligated to clearly prove the fame of its mark. *Blue Man*

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Productions, Inc. v. Tarmann, 75 USPQ2d 1811 (TTAB 2005).

To the extent that opposer contends that its mark is famous, we are not persuaded on this record. Opposer has offered no evidence of its marketing expenditures or market share in the automobile rental or leasing fields or in the automobile sales field. It has not offered any sales figures regarding its vehicle sales business, and only sells vehicles at five locations. Thus, there is insufficient evidence upon which to conclude that the mark is famous for either its rental, leasing or sales businesses. The evidence does support, however, that applicant's mark is a strong mark in connection with automobile rentals. Mr. Fleischner has stated in his declaration that opposer has suburban and on-airport rental locations in most major cities in the United States; that opposer has 105 locations in airports in the United States; that opposer is the sixth largest rental car company of the eight nationally branded rental car companies in the United States; and that as of December 31, 2004, opposer had generated rental revenues of over \$870,000,000 from company operated stores alone. This factor therefore weighs in opposer's favor to the extent that we consider opposer's rental car services, and is otherwise neutral with respect to opposer's remaining services which it has asserted in the notices of opposition.

Opposer, in addressing the *du Pont* factor regarding the number and nature of similar marks in use on similar goods, has pointed out in its brief that the "trial record is devoid of any evidence of third-party uses of 'Dollar' marks for any vehicle-related goods or services." Brief at p. 17. While it is typically an applicant in an opposition proceeding that would make a showing of third-party use and our applicant has not filed any testimony or other evidence in this proceeding, applicant is correct - the record before us does not show any third-party uses of DOLLAR. Because we must base our decision on the record before us, we resolve this factor in opposer's favor to the extent that the scope of protection accorded to opposer's marks is not reduced.

Opposer has argued in connection with the *du Pont* factor regarding the conditions under which sales are made that "there is no evidence that potential purchasers of the services rendered by the parties exercise an elevated level of care." Brief at p. 16. This is true, but there is no evidence as to what the standard of care is for any of the services involved in this proceeding. Of course, as opposer has noted, automobiles tend to be expensive for many consumers. However, there is no evidence that the cost of the vehicle enters into the purchaser's decision in deciding which financing company to use as opposed to the terms and rates that the financing company offers to the purchaser.

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Thus, we disagree with opposer that this factor weighs in favor of a finding of likelihood of confusion but rather find this factor to be neutral.

Thus, in view of the similarities between the marks, the relationship between the services, the overlapping trade channels, and our finding that opposer's mark is a strong mark in connection with vehicle rental services, we conclude that applicant's marks, when use in connection with the services recited in applicant's applications, are likely to cause confusion with opposer's pleaded marks used on automotive vehicle renting and leasing services and retail and wholesale used automobile sales outlet services.

DECISION: Both oppositions are sustained on the basis of likelihood of confusion under Section 2(d) and registration to applicant of both of its marks is refused.