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AUG 4, 98

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sprint Communications Company L.P.
v.
X*Press Information Services, Ltd.

Opposition No. 97,710
to application Serial No. 74/450,288
filed on October 25, 1993

Robert D. Hovey of Hovey, Williams, Timmons & Collins for
Sprint Communications Company L.P.

Scott M. Burt of Jones, Day, Reavis & Pogue for X-PRESS
Information Services, Ltd.

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

The above-referenced application seeks registration on
the Principal Register of the mark "MPEG CHANNEL" for
"hardware and software for use in transmitting, compressing,
decompressing, and storing audio, video, and animation in
digital form for communications systems," in Class 9, and
for "communication services, namely transmitting of full
motion video, audio and animation that has compressed or

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decompressed under MPEG (moving pictures experts group) standards for use related to cable transmission systems," in Class 38. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods and services. At the suggestion of the Examining Attorney, applicant disclaimed exclusive rights to "MPEG" apart from the mark as shown.

Following publication of the mark in the Official Gazette, a timely notice of opposition was filed by Sprint Communications Company L.P., hereinafter referred to as "Sprint." As grounds for opposition, Sprint asserted that it had prior use of the mark "SPRINT MEETING CHANNEL" in connection with videoconferencing services and products; that it owned an application to register its mark (which subsequently matured into Reg. No. 1,918,365, issued on the Principal Register on September 12, 1995, for "videoconferencing services"); and that applicant's mark, if used in connection with the goods and services set forth in the application, would so resemble opposer's mark that confusion would be likely.

A trial was conducted in accordance with the Trademark Rules of Practice. Opposer took the testimony of Patrice Dougherty, its "Senior Intellectual Property Analyst," and made of record her testimony and the exhibits introduced in

connection with it. Applicant did not attend her deposition, nor did applicant take any testimony or introduce any evidence of its own. Both parties filed briefs, but no oral hearing before the Board was requested.

In view of the fact that the application is based on applicant's stated intention to use the mark it seeks to register, priority is not an issue in this proceeding. The sole issue is whether confusion would be likely if applicant were to use its mark in connection with the goods and services set forth in the application in view of opposer's prior use of its "SPRINT MEETING CHANNEL" mark in connection with Sprint's videoconferencing services.

We note that in its brief, opposer argues priority and likelihood of confusion with regard to the mark "MEETING CHANNEL," without the "SPRINT" prefix, but this ground for opposition was not pleaded. The testimony and exhibits do indicate that Sprint's predecessor in interest, U.S. Telecom, used the words "MEETING CHANNEL" in connection with the promotion of its videoconferencing services several years before Sprint bought Telecom out and began using "SPRINT MEETING CHANNEL" as its own mark for these services in 1990, but the issue of likelihood of confusion with the mark "MEETING CHANNEL," without the word "SPRINT" preceding it, was not pleaded, not tried, and not proved. In any event, the testimony shows that the mark "MEETING CHANNEL"

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is not being used by opposer, so whatever rights opposer's predecessor may have established in that mark must be considered to have been abandoned in favor of the new mark, "SPRINT MEETING CHANNEL."

Based on careful consideration of the rather limited record before us in this case, we find that opposer has not met its burden of establishing that confusion would be likely if applicant were to use "MPEG CHANNEL" in connection with the goods and services set forth in the application.

While our analysis of the issue of likelihood of confusion typically involves several of the factors identified by the predecessor to our primary reviewing court in *E.I. Dupont de Nemours & Co.*, 476 F.2d 1565, 177 USPQ 563 (CCPA 1973), in the case at hand, we have no evidence or testimony on many of the thirteen factors, and applicant has made concessions as to several others, such as the relatedness of the goods and services of the parties. Applicant's position can be summarized as arguing that these two marks are just too dissimilar to be likely to cause confusion, even if the goods and services are closely related. We agree.

Although applicant does not cite it, this case is very similar to the situation found in *Kellogg Co. v. Pack 'Em Enterprises, Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). In that case, the Court held that even where the

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goods are closely related, if the marks are not similar, confusion will not be likely. The marks in that case were "FROOT LOOPS," on one hand, and "FROOTEE ICE" and design, on the other. Both marks were used on food products. Since that decision, we have repeatedly held that where the marks are not similar, that fact can be dispositive, even if all the other factors which are considered in the traditional likelihood of confusion analysis cut in favor of finding confusion to be likely.

In the instant case, the situation is the same. The fact that opposer's mark is not similar to applicant's mark mandates a finding that confusion is not likely.

Opposer argues that the dominant portions of the marks are the same term, the one word common to both marks, "CHANNEL." Opposer reaches this conclusion by noting that the descriptive designation "MPEG" has been disclaimed in the opposed application, and by reasoning that when this Board reversed the requirement of the Examining Attorney that Sprint had to disclaim the words "MEETING CHANNEL" in its application to register "SPRINT MEETING CHANNEL," the word "CHANNEL" was specifically held not to be merely descriptive of videoconferencing services.

We are not persuaded by opposer's arguments in this regard. "CHANNEL" is not the dominant portion of either of the two marks at issue here. Notwithstanding opposer's

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arguments to the contrary, even though "MPEG" has a descriptive meaning in connection with applicant's goods and services, and "CHANNEL" has what this Board held to be a suggestive connotation in connection with videoconferencing services, these facts do not logically lead to the conclusion that the term "CHANNEL" dominates either mark. To the contrary, opposer's well known mark "SPRINT" is the dominant portion of opposer's pleaded mark. The suggestive component "MEETING CHANNEL" has much less significance than the distinctive mark "SPRINT." As to applicant's mark "MPEG CHANNEL," even if we assume that prospective purchasers are aware that "MPEG" stands for the Moving Pictures Expert Group, it has not been demonstrated that either component of the combination of this term with "CHANNEL" would have more source-indicating significance than the other. "CHANNEL" is not the dominant portion of either applicant's mark or opposer's mark, and opposer's entire argument that confusion is likely between the two marks is based on this erroneous conclusion.

Simply put, we have no reason to think that these two marks would be confused. They neither look alike, sound alike, nor have similar meanings. The only thing they have in common is the suggestive word "CHANNEL," which is not the dominant portion of either mark.

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Because the marks in their entireties are not similar, confusion is not likely. Accordingly, the opposition is dismissed, and applicant will be issued a registration in due course.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial & Appeal Board