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JULY 15, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re USAir, Inc.

Serial No. 74/705,433

Elliott I. Pollock of Pollock, Vande Sande & Priddy,
R.L.L.P. for USAir, Inc.

Gary R. Thayer, Trademark Examining Attorney, Law Office
103 (Michael Szoke, Managing Attorney).

Before Cissel, Hohein and Bucher, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

USAir, Inc., a Delaware corporation, has filed an
application for registration of the mark "PRIORITY
TRAVELWORKS" for "computer software for accessing a
reservation system to book and pay for airline flights,
rental cars and hotel accommodations."¹

¹ Serial No. 74/705,433, in International Class 9, filed July
18, 1995, based upon an allegation of a *bona fide* intention to
use the mark in commerce. An Amendment to Allege Use under 37
C.F.R. §2.76 was filed on January 19, 1996, claiming first use on
October 17, 1995.

The Trademark Examining Attorney issued a final refusal to register based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark "PRIORITY TRAVELWORKS," when used on its software for making reservations online, so resembles the registered mark, "TRAVEL WORKS" -- which is registered² for "travel agency" services, with the word "Travel" disclaimed apart from the mark as shown -- as to be likely to cause confusion, or to cause mistake, or to deceive

Applicant has appealed the final refusal to register. Briefs have been filed, but applicant did not request an oral hearing. We affirm the refusal to register.

In the course of rendering this decision, we have followed the guidance of In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973), that sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

Under the first du Pont factor, we examine the similarities or differences in sound, appearance, meaning and overall commercial impression of the two marks. As the Trademark Examining Attorney points out, applicant has

² Registration No. 1,868,625, issued to Travel Words, Ltd., an Arizona corporation, on December 20, 1994. The registration sets forth dates of first use of March 30, 1989.

added the word "PRIORITY" to the registered mark, "TRAVEL WORKS," which applicant changed only by deleting the space between the word "travel" and the word "works."

Applicant focuses on the number and nature of similar marks allegedly used on similar goods and services. Based upon the results of various trademark and trade name search reports, applicant argues that the terms "Travel Works" (two words) and "Travelworks" (the compound formulation) are extremely weak in the field of travel agencies. Applicant has identified from these computerized search reports as many as fifty travel-related businesses throughout the U.S. whose names include some variation on this designation (e.g., data from state trademark registrations and listings of common law trademarks and trade names). Hence, applicant concludes that consumers are forced to look to other indicia, such as arbitrary elements elsewhere in these composite marks, to distinguish among the various sources of "Travel Works" travel-related goods and services.

However, search reports are of no probative value in connection with a question of likelihood of confusion in the absence of evidence of actual use of those marks. Their appearance in these search results does not prove that they are in use. Unless applicant establishes that

the third-party marks shown in these computerized search results are being used, there is no way an assessment can be made as to what, if any, impact those marks may have made in the marketplace. See Seabrook Foods, Inc. v. Bar-Well Foods, Limited, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977). In addition, it is not clear from the trade names extracted from larger computerized databases whether those names are even applied to goods or services. Furthermore, there are arguable differences between the exact goods or services indicated in the state registers of trademarks and service marks, and applicant's goods or registrant's services. Thus, even if there were proof of use in the fifty entries highlighted by applicant, any actual uses on dissimilar goods or services in unrelated fields would be irrelevant. See Sheller-Globe Corporation v. Scott Paper Company, 204 USPQ 329 (TTAB 1979) and Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989).

As to the significance of the word "PRIORITY" in applicant's mark, the Trademark Examining Attorney argues that it is a highly suggestive term. He contends that consumers acquainted with registrant may conclude that "PRIORITY TRAVELWORKS" is "... a higher echelon ('priority') of services..." having its source with registrant.

By contrast, applicant maintains that the relevant consumers have a prior relationship with applicant. As a major domestic airline, applicant asserts that it has well-established frequent traveler programs known as "Priority Gold" and "Priority Gold Plus." Applicant argues that its customers know that the word "PRIORITY" in the airline travel context has a strong source-indicating significance.

In assessing whether there is a likelihood of confusion, we agree with applicant's contention that the respective marks must be compared in their entireties. When one party has "merely added" additional matter to a registered mark, there is not an inflexible rule that the marks must be found to be similar. However, in this case, when we consider the ordinary English meaning of the word in conjunction with applicant's goods, "priority" would likely be understood to refer to preferential treatment accorded to one's best customers.³ Accordingly, in the context of making travel arrangements, the word "PRIORITY" as used in applicant's mark must be viewed as a highly suggestive term -- not a wholly arbitrary word.

³ We take judicial notice of an entry from *The American Heritage Dictionary of the English Language* (1976): "PRIORITY: precedence, especially established by order of importance or urgency."

We turn next to the second du Pont factor, the relationship between applicant's software and registrant's travel agency services. The Trademark Examining Attorney contends that applicant's goods are inextricably related to their intended function -- making online travel reservations. He then argues that making one's own travel reservations online is an activity increasingly indistinguishable from the services traditionally provided by one's local, storefront travel agent.

By contrast, applicant argues that its products are not services, but goods -- computer software -- used by savvy consumers who want to avoid having to purchase the services provided by traditional travel agents. Applicant points out, as summarized below, the factual differences in the two ways consumers today can make a reservation for an airline flight, hotel room or car rental.

First, the software approach: is available 24-hours a day; is unaffected by the relative size of agent's commissions (on competing airlines, hotels, etc.); is capable of maintaining personal itineraries over a long period of time; has a personal travel portfolio that saves, and then makes available to vendors, lots of travel-related information not routinely saved or shared by one's agent; permits the consumer to book reservations directly without

human intervention; enables the busy traveler to go online and make instantaneous changes; and will be used only by people comfortable with this type of technology.

By contrast, the traditional travel agency: is available only on certain days, and usually from nine AM to five PM; may well be biased by the agent's schedule of commissions; does not save every client's itinerary over a period of months or years; does not routinely maintain or load one's personal data into a vendor's reservation system; requires the traveler to go through a human intermediary; may not be able to react as quickly to cancelled flight, etc.; and finally, of course, the traditional store-front travel agent may well be the only choice for persons without access to online technology.

Furthermore, applicant argues that the hundreds of businesses advertising their travel agency services online are not the traditional travel agencies being threatened by the recent explosion of online competition. Specifically, applicant argues that the owners of the third-party federal registrations supplied for the record by the Trademark Examining Attorney (as well as those listed elsewhere in the record, especially in an article excerpted from The New York Times) are not travel agents. Rather, applicant argues that the companies providing travel reservations

online, like applicant itself, are airlines, software manufacturers, and others. By contrast, the Trademark Examining Attorney argues that traditional travel agencies are flocking to the Web to advertise their services, to provide online reservations for hotels, cruises, rental cars, airline flights, and the like.

It appears from the record that in order to remain competitive (or perhaps even to stay in business), traditional travel agencies are rapidly expanding their services into cyberspace. Furthermore, whether travel-related services are provided over the telephone, on the Internet or in person, and whether the services originate with a traditional travel agency, an Internet service provider or a national carrier, these goods and services are indeed competitive.

As to channels of trade and the class of consumers to which its goods are marketed, applicant argues that its software is available only to a limited, special group of consumers, e.g., members of applicant's "Priority Gold" frequent traveler programs. Hence, unlike the contentions of the Trademark Examining Attorney, applicant argues that its software is not available for purchase by everyone.

However, we must decide the question of likelihood of confusion based upon the goods and services as they are

specified in the instant application for registration, and the existing registration of Travel Words, Ltd., rather than upon what applicant's submissions during this *ex parte* prosecution show the goods and/or services to be. See Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) and CBS, Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). Applicant lists its goods broadly as computer software for accessing a reservation system to book and pay for airline flights, rental cars and hotel accommodations. When done in person rather than online, much of the service one expects from a travel agent involves reserving and paying for airline flights, rental cars and hotel accommodations. The close relationship of these goods and services is therefore apparent.

Moreover, even if applicant had restricted its identification of goods to limit its customers to applicant's frequent flier program participants, this subgroup of consumers could well include those who may also avail themselves of registrant's travel agency services. Hence, there would still be an overlap in consumers.⁴

⁴ As to the fourth du Pont factor (i.e., the buyers to whom sales are made), we also conclude that not all of applicant's frequent travelers can be assumed to be sophisticated purchasers.

In conclusion, after examining all the relevant du Pont factors, we find that there is a likelihood of confusion in the instant case. Specifically, our finding is based upon the overall similarity of the marks, the competitive nature of the goods and services, the overlap in consumers, and the fact that these consumers are ordinary travelers who are not necessarily sophisticated purchasers of these goods and services.

Decision: The refusal to register is affirmed.

R. F. Cissel

G. D. Hohein

D. E. Bucher

Administrative Trademark
Judges, Trademark Trial and
Appeal Board