

03/29/01

**THIS DISPOSITION  
IS NOT CITABLE AS PRECEDENT  
OF THE T.T.A.B.**

Paper No. 13  
HWR

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

In re Trailer Bridge, Inc.

---

Serial No. 75/324,564

---

Steven J. Elleman of Thompson Hine & Flory LLP for Trailer  
Bridge, Inc.

Gina Hayes, Trademark Examining Attorney, Law Office 104  
(Sidney Moskowitz, Managing Attorney).

---

Before Hanak, Wendel and Bottorff, Administrative Trademark  
Judges.

Opinion by Wendel, Administrative Trademark Judge:

Trailer Bridge, Inc. has filed an application to  
register the mark TB (typed drawing) for "ocean  
transportation of goods between and among ports in the  
mainland United States and Puerto Rico and other locations,  
and freight transportation by truck within the United  
States."<sup>1</sup>

---

<sup>1</sup> Serial No. 75/324,564, filed July 15, 1997, claiming first use  
dates of September 1, 1995.

Registration has been finally refused under Section 2(d) of the Trademark Act on the ground of likelihood of confusion with the mark TB GROUP and design, as depicted below, which is registered for "handling, storage and distribution via air, land and sea of fashion merchandise and fast moving consumer goods of all types."<sup>2</sup>

The requirement that applicant submit acceptable specimens has also been made final. The refusal of registration has been appealed and both applicant and the Examining Attorney have filed briefs. An oral hearing was not requested.

Section 2(d) Refusal

We make our determination of likelihood of confusion on the basis of those of the *du Pont*<sup>3</sup> factors which are relevant in view of the evidence of record. Two key considerations in any analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the goods or services with which the marks

---

<sup>2</sup> Registration No. 1,793,895, issued September 21, 1993, Section 8 & 15 affidavits accepted and acknowledged, respectively. A disclaimer has been made of the word GROUP.

<sup>3</sup> In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

**Ser No.** 75/324,564

are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the respective marks, we are guided by the well established principle that although the marks must be considered in their entireties, there is nothing improper, under appropriate circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Moreover, although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that consumers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). In addition, it is the word portion of a mark, rather than the design features, unless particularly distinctive, that is more likely to be remembered and relied upon by purchasers in referring to the goods and thus it is the word portion that will be accorded more weight in determining the similarity of the involved marks. See *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192 (TTAB 1994).

We agree with the Examining Attorney that the letters TB dominate registrant's mark. There are obvious differences in the appearance and sound of the marks as a whole, as pointed out by applicant, as a result of the additional presence of the word GROUP in the registered mark. Nonetheless, we are convinced that potential customers would look to the letters TB as the indicator of source, rather than the descriptive word GROUP, which has been disclaimed by registrant. Moreover, simply upon viewing the two marks, there is no meaning which customers would readily attach to the letters TB, so as to distinguish between applicant's and registrant's uses of the same letters. See *Alberto-Culver Co. v. F.D.C. Wholesale Corp.*, 16 USPQ2d 1507 (TTAB 1990). The overall commercial impressions created by the marks TB and TB GROUP are highly similar.<sup>4</sup>

Although applicant also points to the design elements in the registered mark as a distinguishing feature, we do

---

<sup>4</sup> Applicant's reference in its brief to numerous third-party registrations for marks containing TB can be given little weight. While the Examining Attorney failed to object to the evidence as being either untimely or improperly presented, the mere reference to third-party marks, without any indication of the goods or services for which they are registered, can have minimal impact on the strength to be accorded to registrant's mark. In addition, many of the citations are for applications, which can given no weight as even demonstrating the existence of these marks.

**Ser No.** 75/324,564

not consider these design features so distinctive that customers would be likely to rely upon and refer to services of the nature involved here in terms of the design, rather than the letters TB. Furthermore, since applicant is seeking to register its mark in a typed drawing, applicant is free to adopt any format it desires to display its mark, including a design very similar to that of registrant. See *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983); *INB National Bank v. Metrohost Inc.*, 22 USPQ2d 1585 (TTAB 1992). In attempting to visualize possible forms of applicant's mark, we can certainly look to the original specimens of record in which the letters TB are also intertwined, although not in the specific form of registrant's design. See *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). All in all, the design features of registrant's mark cannot be relied upon to obviate the similarity of overall commercial impressions created by the marks.

Turning to the services involved, we note that as a general principle, the issue of likelihood of confusion must be determined on the basis of the services as identified in the application and in the cited registration(s). *Canadian Imperial Bank of Commerce v.*

Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Registrant's services include the "distribution" by "land and sea" of "fashion merchandise and fast moving consumer goods of all types." Applicant's services cover "ocean transportation of goods" and "freight transportation by truck." Despite applicant's attempt to distinguish between the services in terms of the actual means of carrying out these transportation services and the specific goods involved, the fact remains that the services of applicant, as identified in the application, are covered by the services identified in the registration. We fail to see how "distribution by sea" differs from "ocean transportation" or "distribution by land" from "transportation by truck." In like manner, the "goods" and "freight" of applicant, even though including additional goods, must necessarily encompass the specific "fashion merchandise and fast moving consumer goods" of registrant. Whether or not applicant performs other consolidation services, and whether or not registrant owns its own ocean vehicles is immaterial to the determination of registrability, which must be based solely on the services as identified in the application and registration. As such, the services must be viewed as closely related, if not identical.

Applicant further raises the factor of sophisticated purchasers, arguing that its services are provided to professionals who are well acquainted with applicant's type of services and thus less likely to be confused as to source. Applicant also notes that the services of both applicant and registrant are relatively costly and accordingly would be selected with care. We cannot give much weight to this factor, however, since even sophistication and care of this nature cannot preclude a likelihood of confusion when the marks are as similar as the present TB marks and the services with which they are being used as virtually identical, as identified. See *Towers v. Advent Software Inc.*, 17 USPQ2d 1471 (TTAB 1990).

Finally, applicant argues that that it is not aware of a single instance of actual confusion to date. We would simply note that little weight can be given to this factor because we have no information as to the geographic overlap of markets and accordingly the potential for confusion. See *In re National Novice Hockey League, Inc.*, 222 USPQ 638 (TTAB 1984).

Accordingly, upon weighing all the relevant *du Pont* factors, we find a likelihood of confusion to exist with the contemporaneous use by applicant of its TB mark for the transportation services as identified herein and the use by

registrant of its TB GROUP and design mark for the recited services.

Substitute Specimen Requirement

In the final refusal, the Examining Attorney also made final the requirement that applicant submit substitute specimens, the present specimens being unacceptable. Applicant had stated in its previous response that "applicant acknowledges the request [for specimens] and will submit specimens upon indication of registrable subject matter." In its appeal brief applicant again states that "upon a finding that applicant's mark is not confusingly similar to the cited mark, applicant will submit new specimens and the application can proceed to publication." (Brief p.8).

The Examining Attorney, in her brief,<sup>5</sup> takes issue with applicant's piecemeal prosecution of the application, citing In re Big Daddy's Lounges Inc., 200 USPQ 371 (TTAB 1978), and maintains that registration should also be refused on the basis of applicant's failure to timely respond to the specimen requirement. While noting that applicant's failure to fully respond to the requirement for acceptable specimens could have resulted in abandonment of

---

<sup>5</sup> We note that the application was assigned to a different Examining Attorney for the preparation of the brief.

the application, she points out that the application was not abandoned but rather the requirement was made final.

Applicant, in its reply brief, contends that the Examining Attorney is essentially arguing that the application is abandoned for failure to file acceptable specimens and that she should be estopped from raising this issue at this time. Applicant argues that its prior response was a bona fide attempt to advance examination of the application and that it should now be afforded an opportunity to comply with the outstanding requirement. Applicant has submitted substitute specimens with the reply, which it requests be entered.

We find it clear that the Examining Attorney is not arguing that the application had been, in effect, abandoned. She simply points out that this was an option which the prior Examining Attorney could have followed. Instead her position is that the requirement was made final and thus stands as a bar to registration.

Furthermore, we agree that under the Big Daddy's Lounges case, the requirement can and should be affirmed in view of applicant's failure to timely respond to the requirement and applicant need not be afforded an opportunity at this point to submit substitute specimens. Although in that case the applicant was allowed additional

Ser No. 75/324,564

time to comply with the outstanding requirement, this "leeway" was permitted solely because of the practice in effect at the time. The Board specifically noted that

in the future, an application must be in condition for allowance save for the issue on appeal and failure to do so could result in judgment against the applicant for failure to comply with the Examiner's requirement. Leave, on this level, for a further opportunity to comply with ... the Examiner's requirements will ordinarily not be granted.  
200 USPQ at fn.3.

In accordance therewith, the refusal to register for failure to comply with the requirement for acceptable specimens will be upheld. Applicant's present proffer of substitute specimens is deemed untimely.

Decision: The refusals to register both under Section 2(d) and for failure to comply with the requirement for acceptable specimens are affirmed.

**Ser No.** 75/324,564