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**THIS DISPOSITION
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Paper No. 16
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Reed Business Information Limited

Serial No. 75/558,110

Stanley C. Macel, III of Connolly Bove Lodge & Hutz LLP for
Reed Business Information Limited.

John Dwyer, Trademark Examining Attorney, Law Office 103
(Michael Hamilton, Managing Attorney).

Before Cissel, Chapman and Rogers, Administrative Trademark
Judges.

Opinion by Chapman, Administrative Trademark Judge:

Reed Business Information Limited (an English limited
company) has filed an application to register the mark ATI
on the Principal Register for goods and services
identified, as amended, as follows:

International Class 9

"multimedia software recorded on CD-
ROMs relating to the air [transport]
industry featuring information and
statistics on air lines and air line
performance, manufacturers of airplane
components, jobs in the air transport
industry, finance in the air transport
industry, airports, and flight routes;
electronic publications recorded on CD-

ROMs, namely, books, magazines, newspapers, newsletters, business reports, all relating to the air transport industry and featuring information and statistics on air lines and air line performance, manufacturers of airplane components, jobs in the air transport industry, finance in the air transport industry, airports, and flight routes";

International Class 35

"advertising agency services, namely, promoting the services of the air transportation industry through the distribution of printed, audio and visual promotional materials, and by rendering sales promotion advice; business information relating to air transportation"; and

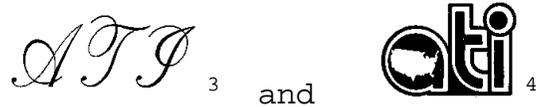
International Class 39

"air travel information services; providing an on-line computer database in the field of air transportation." ¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of three prior registered marks owned by two different entities--(1) ATI for "cargo and chartered air transportation" in International Class 39, currently owned through assignment, by Air Transport International LLC (a

¹ Application Serial No. 75/558,110, filed September 25, 1998. The application is based on applicant's assertion of a bona fide intention to use the mark in commerce. In response to an inquiry from the Examining Attorney, applicant stated that the letters ATI stand for "Air Transport Intelligence"; and that the letters have no significance in the relevant air transport industry other than as applicant's trademark and service mark.

limited liability company of Nevada, located in Arkansas)²; and (2) the two marks shown below



both for "touring and travel agency services" in International Class 39, both currently owned by the original registrant, AmericanTours International Inc. (a California corporation).

In the first Office action, the Examining Attorney had also cited two additional marks--(1) the mark ATI for "electronic navigation and operation system for vehicles, namely instrument, distribution and control panel and wire harness therefore [sic]" in International Class 9, currently owned by the original registrant, Advanced Technology, Inc. (an Indiana corporation)⁵; and (2) the mark shown below

² Registration No. 2,112,289, issued November 11, 1997. The claimed date of first use is January 1, 1988.

³ Registration No. 1,359,726, issued September 10, 1985, Section 8 accepted, Section 15 acknowledged. The claimed date of first use is August 15, 1977. The registration includes the following statement: "The mark consists of the letters 'ATI' in stylized format."

⁴ Registration No. 1,359,727, issued September 10, 1985, Section 8 accepted, Section 15 acknowledged. The claimed date of first use is August 15, 1977. The registration includes the following statement: "The mark consists of the letters 'ATI' and a silhouette design somewhat similar to that of the United States."

⁵ Registration No. 2,052,372, issued April 15, 1997. The claimed date of first use is 1990.



for "business management consultation rendered to new technology-based businesses" in International Class 35, currently owned by the original registrant, Arizona Technology Incubator, aka ATI (an Arizona corporation).⁶

The Examining Attorney withdrew these two cited registrations following applicant's response to the first Office action.

The Examining Attorney contends that applicant's mark, if and when used in connection with its International Class 39 services, would so resemble all three of the previously registered marks in International Class 39 as to be likely to cause confusion, mistake or deception.

Applicant has appealed the final refusal to register. Briefs have been filed, but an oral hearing was not requested.

⁶ Registration No. 1,791,850, issued September 7, 1993, Section 8 accepted, Section 15 acknowledged. The claimed date of first use is January 1, 1992. The words "Arizona Technology Incubator" are disclaimed. The registration includes the following statement: "The lining is a feature of the mark and does not indicate color."

First, we clarify that in his brief the Examining Attorney specifically references applicant's International Class 39 services ("air travel information services; providing an on-line computer database in the field of air transportation"); and he states that "[t]he sole issue on appeal is whether applicant's mark, when used on or in connection with the identified services, so resembles the marks in Registration Nos. 2112289, 1359726 and 1359727, as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act §2(d)." Although the application also includes goods in International Class 9 and services in International Class 35, it is clear from the Examining Attorney's brief that the refusal to register applies only to applicant's International Class 39 services. Thus, that is the only issue before this Board.

Second, we address an evidentiary matter, specifically, the Examining Attorney's statement in his brief (footnote 3) that applicant submitted the complete USPTO files of the three cited registrations "in an attempt to limit the scope of the registrants' identified services" and the Examining Attorney's assertion (in the same footnote) that the "Board must disregard the exhibits submitted by the applicant." It is true, as argued by the Examining Attorney, that in determining the question of

registrability, the Board is constrained to consider the goods and/or services as identified in the registration(s), without restrictions or limitations not reflected therein. See *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). However, we do not agree that we must disregard the entire file histories for all purposes. We have considered them only as discussed herein.

We reverse the refusal to register. In reaching this conclusion, we have followed the guidance of the court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning first to the refusal to register based on the two stylized design marks owned by AmericanTours International Inc., for "touring and travel agency services," we consider the two cited marks and applicant's mark in their entireties as to appearance, sound, connotation and commercial impression. Because these two cited registered marks are (i) a stylized letter mark and (ii) a stylized letter mark with a design, as compared to applicant's typed letter mark, the degree of stylization affects the overall visual impact of the involved marks.⁷

⁷ The Examining Attorney argued both that this case involves letter marks, and, at the same time, that the design mark

The Court of Appeals for the Federal Circuit addressed this type of situation in *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990) as follows:

There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. ...

...[T]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.

...[E]ven if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.

As stated by McCarthy at 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:33 (4th ed. 2000):

For similar design or letter marks, similarity of appearance is usually controlling, for such marks are

consists of a word and a design with the word being the portion more likely utilized by consumers in requesting the services. In this case, the involved marks are letter marks, not word marks.

incapable of being pronounced or of conveying any inherent meaning, as do word marks. For such marks, the stylized lettering may be sufficient to prevent a likelihood of confusion.
(Citations omitted)

Registrant's marks are (i) a highly stylized presentation of the letters ATI and (ii) a very different highly stylized combination of the letters ATI and a design of the United States; whereas applicant's mark is simply a typed drawing of the letters ATI. We agree with applicant that these marks, when considered in their entireties, are different in appearance and create different commercial impressions.

We consider next the similarity or the dissimilarity of the services, as described in the application and these two cited registrations, and the similarity or dissimilarity of the trade channels and purchasers. The Examining Attorney asserts that services need not be identical or even directly competitive to support a finding of likelihood of confusion; that the Office must consider the services as identified in the involved application and registrations; that because there is no limitation in applicant's identification of services ("air travel information services; providing an on-line computer database in the field of air transportation"), applicant's

services could include providing information on touring and travel agency information; that while applicant's database information is limited to "providing an on-line computer database," this registrant's services are not so limited; and that applicant's services are related to this cited registrant's services, resulting in a likelihood of confusion by consumers as to the source of these services.

The respective identifications of services show that this cited registrant is a travel agency, whereas applicant provides and promotes news and information about the air transport industry. The fact that the registrant travel agency provides its clients with flight schedules (as well as rail schedules and other means of transportation) does not establish that travel agency services and providing air travel information in the field of air transportation via an on-line computer database are related. In fact, in overcoming a registration cited against both of its then-pending applications, this registrant successfully argued that travel agency services are totally different from and move in different channels of trade to totally different classes of purchasers than "aircraft brokerage services," "repair and maintenance of aircraft for others," "leasing

and chartering of aircraft," and "educational services, namely, pilot training."⁸

The Examining Attorney's submission of several third-party registrations to show that the same entity has registered a single mark for both travel agency services as well as air travel information services is not persuasive of a different conclusion. Some of the third-party registrations do not actually include both types of services, but rather are for services identified as "travel agency services, namely,..." (see, e.g., Registration Nos. 2,285,378 and 2,290,193). Moreover, most of the third-party registrations either issued to airlines, such as Northwest Airlines and Thai Airways, and are essentially house marks, or issued to on-line travel agencies, such as TheTrip.com, Inc. and Laughing Buddha Travels, Ltd. We agree with applicant that this evidence does not equate an on-line service which distributes information about the air transportation business with travel agencies.

⁸ Registration No. 1,176,492, issued November 3, 1981, to Air Transport, Inc. for the mark shown below



This registration was cancelled under Section 8 of the **Trademark Act in 1988.**

In this case, applicant's services, as identified, are limited to the air transportation industry. In addition, applicant has provided information brochures and advertisements about its own services as requested by the Examining Attorney, all of which clearly show that applicant provides information about the air transport industry, including, for example, statistics on airlines and airline performance, manufacturers of airplane components, jobs in the air transport industry, and financing in the industry. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Based on the dissimilarities of the appearance and commercial impressions of the marks, and the unrelated nature of travel agency services and air transport information services, we cannot find on this record that likelihood of confusion has been shown.

Turning next to the cited registered mark ATI (Registration No. 2,112,289) for "cargo and chartered air transportation," clearly this mark and applicant's mark are identical letter marks.

With regard to these services vis-a-vis applicant's services, the Examining Attorney contends that applicant's identification of services is unlimited as to the nature of

the air travel information and thus it could include cargo and chartered air transportation information; that neither party's channels of trade are specifically limited; and that although applicant's database is limited to being offered only "on-line," the registrant's services are not limited and thus could be offered on-line. From this, the Examining Attorney concludes that these services are related.

Looking, as we must, at the services as identified, we cannot find on this record that the these services are closely related, especially in light of applicant's evidence indicating precisely what it does, which is offer intelligence or information about the air transport business, whereas this cited registrant offers cargo and chartered air transportation. A purchaser seeking to charter airplanes for either passengers or freight is not necessarily the same as the purchaser seeking to obtain information (via a computer on-line database) about the air transport industry. To the extent such purchasers may overlap, they will exercise reasonable care in purchasing either the chartered plane service or the information about the air transport industry. The fact that a party may offer its services (or goods) for sale on-line does not automatically make all goods and services offered on-line

related in the context of the du Pont factors. Moreover, as applicant points out, both the travel agency and the cargo charter airline have co-existed for over ten years apparently without confusion caused by the marks.

Based on the dissimilarities of cargo and air charter services and air transport information services, as well as the conditions of sale and the care of purchasers, we cannot find on this record that likelihood of confusion has been shown.

We point out that we have reached this decision involving three cited registrations based on the ex parte record herein. We express no view on what the Board might find in the context of an inter partes proceeding with a different record.

Decision: The refusal to register under Section 2(d) is reversed.