

5/11/01

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

Paper No. 10
TEH

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **Expeditors International of Washington, Inc.**

Serial No. 75/583,455

Faye L. Tomlinson of Christensen O'Connor Johnson Kindness PLLC
for **Expeditors International of Washington, Inc.**

Howard Smiga, Trademark Examining Attorney, Law Office 102
(Thomas V. Shaw, Managing Attorney).

Before Cissel, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

Expeditors International of Washington, Inc. (applicant) has
appealed from the final refusal of the Trademark Examining
Attorney to register the following mark for "computer software
for use by businesses in performing transactions in the field of
import and export trade" in Class 9 and "business consultation
services relating to the importing and exporting of goods,

government trade regulations, in compliance with government import and export regulations" in Class 35.¹



Registration has been refused under Section 2(d) of the Trademark Act on the ground that applicant's mark so resembles the registered mark WINTRADE for "computer software and data bases for use in document processing and facilitating work flow in the fields of international business and financial transactions"² as to be likely to cause confusion.

When the refusal was made final, applicant appealed. Both applicant and the Examining Attorney filed briefs. An oral hearing was not requested.

In any likelihood of confusion analysis, we look to the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand and those of

¹ Application Serial No. 75/583,455, filed November 5, 1998, alleging a bona fide intention to use the mark in commerce.

² Registration No. 2,114,712 issued November 18, 1997.

record, including the similarity of the marks and the relatedness of the goods or services.

The Examining Attorney argues that applicant's mark TRADEWIN and registrant's mark WINTRADE are similar in sound, appearance and meaning. Noting that applicant's mark is essentially a transposition of the registrant's mark, the Examining Attorney claims that the transposition does not change the overall commercial impression the mark conveys. The Examining Attorney argues that registrant's broadly worded identification of its goods as software relating to document processing and facilitating work flow in the fields of international business and financial transactions "would certainly encompass the applicant's more specific [goods and services]..." and that the goods and services "are clearly utilized for the same or [related] purposes, are used in the same environment and are purchased by the same class of consumers."

Applicant, while admitting that one mark is a transposition of the other, argues that the transposition does change the commercial impression the mark creates. Applicant also contends that the respective goods and services are not related, and that in fact, the description of registrant's goods is vague and unclear. It is applicant's position that registrant's goods are limited to the field of financial transactions "as they relate to international business" and that, in considering the "realities

of the marketplace," computer software for financial transactions in international business and computer software for importing and exporting goods "are very different." Applicant further maintains that the channels of trade and classes of purchasers for the respective products and services are different, and moreover, that the purchasers for both applicant's and registrant's goods and services are professional buyers who are less likely to be confused than ordinary consumers would be.

The identification of goods in the cited registration is not a model of precision and makes it difficult to determine the exact nature of the registrant's goods. Contrary to applicant's assertions, however, we find that registrant's software is not restricted to financial transactions "as they relate to international business." We find instead that registrant's goods do include computer software which facilitates document processing and work flow in international business and financial transactions and that these transactions could include import/export transactions. We note, however, that the customers for the respective products would be sophisticated professionals who are knowledgeable about the products they are purchasing and who would exercise a high degree of care in their purchasing decisions. See *Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992).

Moreover, the marks used to identify the respective goods and services are not similar. Applicant's mark TRADEWIN and design is a transposition of the two words in the registered mark WINTRADE. However, marks must be viewed in their entirety in determining likelihood of confusion. We find that these marks, when considered in their entirety, are different in sound, convey different meanings and create distinctly different commercial impressions. Registrant's mark WINTRADE consists of the two words WIN and TRADE, which, when combined in that order, retain their individual meanings and suggest, in relation to registrant's goods, a successful or winning trade, perhaps in an international stock or other financial market.

However, applicant's mark TRADEWIN and design creates a very different commercial impression. The reverse order of the words not only changes the form of the mark, but changes its character and meaning. When spoken, applicant's mark is virtually the phonetic equivalent of "trade wind," a familiar term which conjures an image of tropical breezes. The design in applicant's mark, suggesting a flag blowing in the wind, reinforces this image. Thus, while the term TRADEWIN alludes to the trade or the import-export activity associated with the goods and services themselves, it also evokes the entirely different commercial impression of peaceful beaches and tropical islands far from any commercial activity, clearly a different commercial impression

Ser. No. 75/583,455

than that conveyed by registrant's mark WINTRADE. See, e.g., In re Akzona Incorporated, 218 USPQ 94 (TTAB 1983).

When we consider the differences in the marks and the sophistication of the respective purchasers, we find that confusion is not likely.

Decision: The refusal to register is reversed.