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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re **IBERIA, Lineas Aereas de Espana, S.A.**

Serial No. 75/743,430

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de Espana, S.A.**

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(**Craig Taylor**, Managing Attorney).

Before **Simms, Hohein** and **Holtzman**, Administrative Trademark
Judges.

Opinion by **Hohein**, Administrative Trademark Judge:

IBERIA, Lineas Aereas de Espana, S.A. has filed an
application to register the mark "BUSINESS INTERCONTINENTAL"



Ser. No. 75/743,430

and design, as reproduced below,
for "airline transport services, namely, transportation of
passengers and goods by air" in International Class 39 and
"baggage handling inspections for airlines" in International
Class 42."¹

Registration has been finally refused under Section
2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground
that applicant's mark, when applied to its services, so
resembles the mark "INTER-CONTINENTAL," which is registered
for "stenographic and typing services; conference center
services, namely, arranging and planning meetings for others;
management and staffing of hotels, restaurants and conference
centers for others; and consultation services in construction,
operation and management of hotels, restaurants and conference
centers" in International Class 35, "development and
organization of tour travel and packages for hotel guests;
travel agency services; limousine transportation services;
[and] parking garage services" in International Class 39,
"entertainment services; namely, sponsoring musical
performances, and providing in-room movies to hotel guests;
[and] health club services" in International Class 41 and

¹ Ser. No. 75/743,430, filed on July 6, 1999, which is based upon
both an allegation of a bona fide intention to use the mark in
commerce and ownership of Spanish Reg. No. 2177176/6, dated December
10, 1998, for such mark. The words "BUSINESS INTERCONTINENTAL" are
disclaimed.

"restaurant, bar and cocktail lounge services; concierge services; [and] planning and designing conference centers, hotels and meeting facilities for others" in International Class 42,² as to be likely to cause confusion, mistake or deception.

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

The determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity of the goods and/or services and the similarity or dissimilarity of the marks.³

² Reg. No. 1,635,689, issued on February 19, 1991, which for each class sets forth dates of first use anywhere and in commerce of January 1, 1948; renewed.

³ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and differences in the marks."

Turning first to consideration of the respective services, it is well settled that services need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same entity or provider. See, e.g., *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

In the present case, the Examining Attorney maintains in her brief that "the services identified in the application and registration are highly related." However, the focus of the Examining Attorney's arguments, both in her brief and in her final refusal, is on the asserted relatedness of the services set forth in the application to those listed in International Class 39 of the cited registration, namely, "development and organization of tour travel and packages for hotel guests; travel agency services; limousine transportation services; [and] parking garage services," and it is those

services to which the evidentiary record in this case pertains. Accordingly, and since on their face applicant's services are distinctly different in nature from the services recited in International Classes 35, 41 and 42 of registrant's registration, we find that there is no likelihood of confusion from the contemporaneous use, in connection with such services, of applicant's "BUSINESS INTERCONTINENTAL" and design mark and registrant's "INTER-CONTINENTAL" mark.

As to applicant's services and those listed in International Class 39 of registrant's registration, however, the Examining Attorney insists in her brief that, not only do such services "fall within the same general category," which she characterizes in her final refusal as being "travel related services that overlap within the relevant industry," but more importantly "the services are complementary and the conditions surrounding their marketing are such that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source." Although applicant, in particular, states in its initial brief that it "does not dispute that travel agents may arrange for the transportation of passengers and luggage by air," applicant asserts that registrant's "travel agency services are not so closely related ... [to applicant's baggage handling inspections for

airlines and] air transportation services" that contemporaneous use of the respective marks in connection therewith would be likely to cause confusion in the travel industry.

The Examining Attorney, in support of her position, relies upon definitions in the record from The American Heritage Dictionary of the English Language (3rd ed. 1992) which define a "travel agency" as "a business that attends to the details of transportation, itinerary, and accommodations for travelers" and an "airline" as "a business which provides a system of scheduled air transport." She also made of record and relies upon 15 use-based third-party registrations of marks which are registered for "air transportation of persons and cargo," "transportation of people by air," "transportation of passengers and cargo by air," "transport services rendered by air" or the like on the one hand and "making hotel reservations and accommodations for others," "hotel reservation services," "developing, arranging and making reservations of vacation and tour packages for others," "arranging travel tours" and, more generally, "travel agency services" or the like on the other. Although the third-party registrations are admittedly not evidence that the different marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the

extent that they serve to suggest that the services listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6.

In light of such evidence, we agree with the Examining Attorney that, at least with respect to applicant's "airline transport services, namely, transportation of passengers and goods by air," those services are sufficiently related to registrant's "development and organization of tour travel and packages for hotel guests" and its "travel agency services" that the airline traveling public would be likely to believe that, if sold under the same or substantially similar marks, the respective services share a common origin or affiliation. There is simply no proof, however, that the other services set forth in International Class 39 of registrant's registration, namely, its "limousine transportation services" and "parking garage services," would similarly be seen by the relevant purchasing public as complementary or otherwise closely related, in a commercial sense, to applicant's airline transport services. Such consumers would instead view those services as distinctly different in nature and thus would not be likely to assume

mistakenly that they originate from or are in some way associated with the same entity or provider.

The same is likewise true of applicant's services of "baggage handling inspections for airlines" and each of the services listed in International Class 39 of registrant's registration. On their face, the respective services are not only distinctly different in nature, but the former would be provided by applicant to other airlines and/or airport security operations rather than to the airline traveling public. Thus, even if such services were rendered under the identical or substantially similar marks, there would not be a likelihood of confusion.

This brings us to consideration of the marks at issue and, specifically, to the question of whether the contemporaneous use by applicant of its "BUSINESS INTERCONTINENTAL" and design mark for "airline transport services, namely, transportation of passengers and goods by air," is likely to cause confusion with registrant's "INTERCONTINENTAL" mark for the closely related services of "development and organization of tour travel and packages for hotel guests" and "travel agency services". The Examining Attorney urges, in this regard, that as to applicant's mark:

When a mark consists of a word portion and a design portion as in the proposed mark here, it has been determined that the word portion is more likely to be impressed upon

a purchaser's memory and to be used in calling for the goods or services. Thus, the literal portions are more dominant. *In re Appetitio Provisions Co. [Inc.]*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976).

The Examining Attorney further insists, in view thereof, that the commercial impressions of applicant's and registrant's marks "are highly similar," arguing that when considered in their entirety, "the dominant elements are nearly identical - i.e., the wording INTERCONTINENTAL and INTER-CONTINENTAL - and the marks are therefore likely to be confused. In particular, the Examining Attorney finds that, of the literal portion of applicant's mark, it is the word "INTERCONTINENTAL" which is the principal source-signifying element thereof and that the design element of such mark is insignificant because:

As acknowledged by the applicant in its response and brief, the term BUSINESS is descriptive of the services. In addition to referring to any commercial, industrial or professional dealing, the term also describes a class of service in that it describes the user of category of users--i.e., business class consumers. Hence, in this case, the term does nothing to distinguish the source of the proposed services and is afforded little weight. Here, the term BUSINESS merely sets out a class of consumers for which the services are targeted and tells consumers that the services are provided by a commercial enterprise as the plain meaning of the term conveys. Hence, the term BUSINESS does not sufficiently distinguish

the overall commercial impression ... because consumers are likely to believe that the proposed services are simply a business class version of the registrant's services. Therefore, in this case, the public will not attribute source indicating significance to the term BUSINESS, despite its position in the mark. [Citations omitted.] As such, the INTERCONTINENTAL element has more significance in the overall commercial impression of the mark because its descriptive meaning is less obvious than the term BUSINESS.

Here, the term INTERCONTINENTAL is more significant as it is the only element likely to be retained or recollected by the average purchaser who normally retains a general rather than a specific impression of a trademark. The design [in applicant's mark] is simply a peripheral difference, as the services here will not be called for in the market place as the torch or shield. Moreover, consumers ... may not be able to sufficiently distinguish the design as a torch or shield and[,] thereby, indicate a single source. Therefore, the design does [not] alter or distinguish the commercial impression because the wording is more likely to be remembered and used when the ... [service] is used, ordered or discussed. [Citation omitted.] As such, because the dominant elements [of the marks at issue] are nearly identical in sound and meaning, the additional design element [in applicant's mark] does not negate the similarity. [Citation omitted.] Accordingly, when the proposed and registered marks are compared [overall], the terms INTERCONTINENTAL and INTERCONTINENTAL are nearly identical and only differ in form or appearance. Both terms convey the same meaning and sound the same. Therefore, consumers are likely to confuse the two as neither the design or additional term [BUSINESS in applicant's mark] creates a commercial impression separate and distinct from the registered mark.

Finally, with respect to applicant's contention that, as shown by the copies which it has made of record of ten third-party registrations for marks which consist of or include the word "INTERCONTINENTAL" or variants thereof, marks which are composed of such term are weak and thus are entitled to only a narrow scope of protection, the Examining Attorney maintains, among other things, that "the third-party registrations ... have little relevance to the applicant's position" that there is no likelihood of confusion. None of the third-party registrations, the Examining Attorney accurately observes, is for any of the services at issue in this appeal. The Examining Attorney, moreover, infers therefrom that because "there is no record evidence of other registered marks containing the wording 'INTERCONTINENTAL' for similar services [to those at issue herein], the descriptively weak element ['INTERCONTINENTAL'] is strong as applied to the travel-related services here."

We agree with applicant, however, that when considered in their entirety, its "BUSINESS INTERCONTINENTAL" and design mark is sufficiently distinguishable from registrant's "INTER-CONTINENTAL" mark that confusion is not likely. As applicant persuasively points out, and as essentially acknowledged by the Examining Attorney ("the term BUSINESS merely sets out a class of

consumers for which the services are targeted"), "the phrase BUSINESS INTERCONTINENTAL" has a connotation linked with ... air transport services" in that "[c]onsumers will recognize the phrase as referring to a class of service on an airline such as Applicant" because "[i]t sounds like other premium classes of airline travel such as BUSINESS FIRST or BUSINESS PLUS." Applicant's mark, furthermore, will not only be vocalized, as when reservations are made over the telephone, but when used in connection with its airline transport services, such as in printed advertising and on its website for scheduling and ticketing information, it will be seen in its entirety by consumers. Consequently, rather than being of little trademark significance solely because it is descriptive of business class services, the word "BUSINESS" is "the first and most prominent word in Applicant's mark," appearing in lettering which in size is several times larger, and hence far more visually striking, than the descriptive term "INTERCONTINENTAL," which appears immediately below such word. Plus, applicant's mark, unlike registrant's mark, prominently features a design element. Such element, regardless of whether it is characterized as a torch, shield or other kind of design, conspicuously distinguishes applicant's mark from that of the registrant.

Thus, as applicant correctly points out, the only common portions of the respective marks lie in the words "INTERCONTINENTAL" and "INTER-CONTINENTAL." However, as the definition of record from The American Heritage Dictionary of the English Language (3rd ed. 1992) makes clear, the adjective "intercontinental" has a well recognized meaning of "1. Extending or taking place between or among continents 2. Having the capability of traveling from one continent to another: ... *an intercontinental airline.*" Therefore, like the word "BUSINESS," the word "INTERCONTINENTAL" in applicant's "BUSINESS INTERCONTINENTAL" and design mark is descriptive of its airline transport services, as applicant has conceded by its disclaimer thereof, and such word is highly suggestive of registrant's travel agency services and its services of development and organization of tour travel and packages for hotel guests. Consequently, as applicant properly notes in its initial brief, "terms such as INTERCONTINENTAL are weak and [are] given only a narrow scope of protection," with "even small differences in the marks ... [being] sufficient to make confusion not likely."

As pointed out in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958):

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy

the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Because, as noted previously, registrant's "INTER-CONTINENTAL" mark is highly suggestive of its travel agency services and its services of development and organization of tour travel and packages for hotel guests, and since the literal portion of applicant's "BUSINESS INTERCONTINENTAL" and design mark is descriptive of its airline transport services, namely, the transportation of passengers and goods by air, the overall differences in sound, appearance, connotation and commercial impression between the respective marks are sufficient to avoid a likelihood of confusion with respect to such closely related, but clearly not identical, services.

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