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Mailed: July 16, 2002

Paper No. 13  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re TCAST Communications, Incorporated

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Serial No. 75/530,086

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Richard T. Lyon of Lyon, Harr & Defrank, LLP for TCAST  
Communications, Incorporated.

Kathleen M. Vanston, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

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Before Hanak, Quinn and Chapman, Administrative Trademark  
Judges.

Opinion by Chapman, Administrative Trademark Judge:

TCAST Communications, Incorporated (a California  
corporation) has filed an application to register on the  
Principal Register the mark shown below



for "telecommunication services, namely domestic and international long distance telephone services" in International Class 38. The application was filed on August 3, 1998, based on applicant's claimed date of first use and first use in commerce of January 1996.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), in view of the following two prior registered marks owned by two different entities: (1) the mark shown below



for "cellular telephone roaming services" in International Class 38, (registered to GTE Telecommunication Services Incorporated and currently owned through change of name by TSI Telecommunications Services Inc., a Delaware corporation)<sup>1</sup>; and (2) the mark shown below



for "telephone, mobile telephone, video telephone, telephone headsets and accessories for the afore-mentioned, namely...[e.g., "batteries," "desk top battery charging

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<sup>1</sup> Registration No. 2,104,166, issued October 7, 1997.

stands," "bags and cases especially adapted for holding or carrying portable telephones and their accessories"]; radio pagers; computerized personal organizers; antennas; satellite transmitters and receivers for use in connection with mobile telephones and radio pagers; modems; computer keyboards; microprocessors for use in any of the aforementioned telecommunications equipment; computer programs for operating mobile telephones and pagers" in International Class 9, (registered to Orange Personal Communications Services Limited, a United Kingdom corporation).<sup>2</sup>

When the refusals were made final, applicant appealed. Briefs have been filed, but an oral hearing was not requested.

We affirm the refusals 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); and *In*

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<sup>2</sup> Registration No. 2,359,041, issued June 20, 2000.

re Azteca Restaurant Enterprises Inc., 50 USPQ2d 1209 (TTAB 1999).

We turn first to a consideration of applicant's services and one cited registrant's services and the other cited registrant's goods.

We find that applicant's services (long distance telephone services) are closely related to the cited registrant's services (cellular telephone roaming services) and the other cited registrant's goods (telephones, mobile phones). Applicant did not argue to the contrary.

Likewise applicant did not argue, and we do not find, any differences in the channels of trade or purchasers. We must presume, given the identifications, that the respective services and goods travel in the same channels of trade, and are purchased by the same class of purchasers. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Turning next to a consideration of the marks, we agree with applicant that the proper test for determining the similarities and dissimilarities of design marks ultimately comes down to the "eyeball test." This is explained at 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair

Competition, §23:25 (4th ed. 2000) as follows (footnote omitted):

Because a picture is worth a thousand words, there is little in the way of guidelines to determine that degree of visual similarity which will cause a likelihood of confusion of buyers. Obviously, for picture and design marks (as opposed to word marks), similarity of appearance is controlling. There is no point in launching into a long analysis of the judicial pros and cons regarding visual similarity of marks. Regarding visual similarity, all one can say is 'I know it when I see it.'

That is, the similarity of designs is determined by considering the overall impression created by the marks as a whole, rather than by simply comparing individual features of the marks.

The proper test in determining likelihood of confusion is not a side-by-side comparison of the marks, but rather must be based on the similarity of the general overall commercial impressions engendered by the involved marks. See *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980).

In this case, it is true that applicant's mark and either of the two cited design marks are not exactly the same. However, in comparing applicant's design mark with each of the previously registered design marks in their entireties [rather than by comparing individual features

(dark sphere and white sphere, two arrowheads or one arrowhead), and lines (thick or thin, varying in width or not)] we are of the opinion that the overall commercial impression created by applicant's mark when compared with each of the cited registered marks is similar. It is obvious that all three of these marks are circles with arrows. Despite the minor differences between applicant's mark as compared to each of the two cited registered marks, there is no doubt that the overall impression and perception of the marks is that of a circle and arrow, and would be so perceived by purchasers.

The differences are not likely to be recalled by purchasers seeing the marks at separate times. Under actual market conditions, consumers do not have the luxury of a side-by-side comparison of the marks; and further, we must consider the recollection of the average purchaser, who normally retains a general, rather than a specific, impression of the many trademarks encountered. Thus, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5,

1992); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467 (TTAB 1988).

To the extent that the circle and arrow design (in the three slightly differing formats) is suggestive with relation to long distance telephone services, cellular telephone roaming services, and telephones and mobile telephones, it is suggestive of the same thing, namely, that the telephones and/or telephone services are available and accessible (and presumably reliable) around the world.

Applicant's design mark is similar in appearance and commercial impression to each of the cited registered marks, such that when applicant's mark is used in connection with the services identified in applicant's application, consumers are likely to be confused. See Kangol Ltd. v. Kangaroo U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); In re Calgon Corp., 435 F.2d 596, 168 USPQ 278 (CCPA 1971); and Puma-Sportschufabrieken Rudolf Dassler KG v. Garan, Inc., 224 USPQ 1064 (TTAB 1984). Cf., e.g., Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corporation, 204 USPQ 945 (TTAB 1979).

**Decision:** The refusal to register under Section 2(d) is affirmed as to both registrations.