

9/6/02

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 12
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tele Danmark A/S

Serial No. 75/598,432

Peter D. Vogl of Penney & Edmonds LLP for Tele Danmark A/S.

Andrew J. Benzmilller, Trademark Examining Attorney, Law Office 116, (Meryl Hershkowitz, Managing Attorney).

Before Cissel, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On November 30, 1998, the above-referenced application was filed to register the mark "DUÉT" on the Principal Register for services which were subsequently identified by amendment as "telecommunications services, namely, personal and business communications services; telephone and telegraph communications services; communications services, namely, cellular telephone services, facsimile transmissions, radio and TV broadcasting, including through cable television,

Ser No. 75/598,432

broadcasting programs via a global computer network;
delivery of messages and pages by electronic transmission;
leasing of telecommunications apparatus, including
telephony apparatus," in Class 38. The basis for filing
this application was applicant's assertion that it
possessed a bona fide intention to use the mark in commerce
with these services.

In the first Office Action, the Examining Attorney
refused registration under Section 2(d) of the Lanham Act,
15 U.S.C. Section 1052(d), on the ground that if
applicant's mark were used in connection with the services
specified in the application, it so resembles the mark
"FAST PACKET DUET ADVANTAGE," which is registered¹ for
"telecommunications services, namely, the electronic
transmission of radio, voice, and data; switched multi-
megabit data service (SMDS); and exchange access frame
relay services (XA-FRS)," in Class 38, that confusion would
be likely. The Examining Attorney also cited two pending
applications as potential bars to registration, required
applicant to amend the recitation of services to be more
definite, and addressed several other informalities.

¹ Reg. No. 2,134,805, issued on the Principal Register on
February 3, 1998 to Bell Atlantic Network Services, Inc.; "FAST
PACKET" was disclaimed apart from the mark as a whole.

Ser No. 75/598,432

Applicant was asked to indicate whether the mark has any significance in the relevant trade or industry, any geographical significance, or any meaning in a foreign language.

Applicant responded to the first Office Action with argument against the refusal to register; argument with respect to the potential citations of the marks in the two prior-filed pending applications (noting that one had already been abandoned); amendment of the recitation of services; and a statement that the term sought to be registered "does not have any significance in the relevant trade or industry, or as applied to applicant's services."

A newly assigned Examining Attorney withdrew the reference to the remaining prior-filed application, but made final the refusal to register under Section 2(d) of the Act. Applicant filed a timely Notice of Appeal, along with a request for reconsideration. The appeal was instituted, but action on it was suspended and the application was remanded to the Examining Attorney for consideration of applicant's request for reconsideration. The application was then assigned to the Examining Attorney identified above, who accepted applicant's amended recitation of services, but maintained the final refusal to register.

Both applicant and the Examining Attorney filed briefs on appeal, and applicant filed a reply brief, but applicant did not request an oral hearing before the Board. Accordingly, we have resolved this appeal based on the written arguments and the application file.

In this connection, we note that applicant attached to its appeal brief printouts of Office records for several third-party registrations and an application filed by a third party. As the Examining Attorney points out, submission of this evidence was untimely under Trademark Rule 2.142(d). The Board has therefore not given this evidence any consideration. Applicant argues in its reply brief that a list of these registrations and the application was submitted with applicant's request for reconsideration without objection by the Examining Attorney, and that therefore the Board should deem the Examining Attorney to have waived any objection to the subsequent submission of the registrations and application. To the contrary, however, in that the Examining Attorney never mentioned or discussed these registrations and the application responsive to the reconsideration request, he clearly was not treating them as if they had been properly introduced into the record of this application. Nor can the Examining Attorney's failure to advise applicant of the

proper way to make the registrations and application of record be deemed to prejudice applicant, because the listing was submitted with applicant's request for reconsideration, and applicant therefore did not have a further opportunity to submit actual copies of the documents. In any event, as discussed below, even if we had considered the materials submitted for the first time with applicant's brief, our conclusion with respect to the issue of likelihood of confusion would not have been different.

The sole issue before us in this proceeding is whether confusion would be likely with the cited registered mark if applicant were to use the mark it seeks to register in connection with the services specified in the application, as amended. Based on careful consideration of the facts presented on this record in view of the relevant legal authority, we find that the refusal to register must be affirmed because the marks are similar and the services with which applicant intends to use its mark are in part the same as the services listed in the cited registration.

Turning first to the relationship between the services set forth in the application and those identified in the cited registration, we note that whether confusion is likely between these marks must be determined on the basis

of how the services are identified in the application and the registration, respectively, without limitations or restrictions that are not reflected therein. Toys "R" Us, Inc. v. Lamps R Us, 219 USPQ 340 (TTAB 1983). In the instant case, applicant's services include "personal and business communication services," "telephone communication services," "cellular telephone services," and "delivery of messages and pages by electronic transmission." These services are in part identical to the services recited in the registration as "telecommunication services, namely, electronic transmission of video, voice, and data."

Contrary to the arguments made by applicant, reference to the technical term "PACKET" in the registered mark does not limit the scope of the registration, nor does the fact that the registration identifies other services which appear to be more narrowly defined and technical. Simply put, registrant's services include telecommunication services such as transmission of voice and data. Applicant's services recited as "communications services," "telephone communications services" and "cellular telephone services" are encompassed within the terminology employed in the registration.

Notwithstanding applicant's argument to the contrary, this record does not support the conclusion that

applicant's services, as well as those of the registrant, are highly technical services which would not be used by ordinary consumers. To the contrary, the recitations of services in both the application and the cited registration are not restricted or limited as to the types of customers for whom the services are provided, so customers for both could accordingly include the same ordinary consumers.

Clearly, if similar marks were to be used to identify the sources of these overlapping telecommunications services, confusion would be likely.

We agree with the Examining Attorney that the word "DUET" is the dominant element in the cited registered mark. "FAST PACKET" is merely descriptive in connection with the services recited in the registration,² and "ADVANTAGE," as used in the registered mark, has a suggestive, laudatory significance in connection with the services set forth in the registration. As is typically the case, these descriptive or suggestive components of the registered mark have less significance in determining the overall commercial impression the mark engenders. Plainly,

² The record establishes that a packet is a bundle of data that consists of the data itself and certain control information, such as destination address, to be transmitted electronically, and the record includes definitions of "fast packet multiplexing" and "fast packet switching." In any event, as noted above, the registration disclaims the exclusive right to use "FAST PACKET"

the word "DUET" is the dominant element in the registered mark.

When we consider applicant's mark and the registered mark in their entireties, they are similar because the mark applicant seeks to register, "DUÉT," is almost identical to the dominant element in the cited registered mark, "DUET."

Applicant's arguments regarding distinctions between "DUET" and "DUÉT" are not persuasive that confusion between the marks in their entireties is not likely. The difference in the appearances of the two words is minimal, and it is well settled that because it is impossible to predict how different people will pronounce the same words, there is no single correct pronunciation. In re Mack, 197 USPQ 755 (TTAB 1977). Applicant argues that these two terms would be pronounced differently, but "DUET" is a readily understood word in the English language, and because of this, purchasers of these products are likely to pronounce "DUÉT" the same way they would pronounce the familiar word "DUET." Plainly, "DUET" and "DUÉT" can be pronounced identically.

Contrary to the statement applicant first made (responsive to the Examining Attorney's inquiry in the

apart from the mark as shown, and applicant does not dispute its descriptiveness.

first Office Action) to the effect that the term it seeks to register has no significance in the trade or in connection with applicant's services, applicant argues in its brief that "DUET" has "a commonly understood meaning" which is suggestive in connection with telecommunications services. As the Examining Attorney points out, however, applicant's argument in this regard is contradicted by its assertion, on the same page of its brief, that its mark is a "coined term." In any event, whatever suggestiveness "DUET" may have in connection with telecommunications services, the suggestion is the same in both applicant's mark and the cited registered mark, so applicant's assertions with regard to suggestiveness are not persuasive that confusion would not be likely.

Additionally, applicant argues that Office practice regarding registration and approval for publication of marks which include the term "DUET" demonstrates that the term is weak in trademark significance in connection with goods and services related to telecommunications, and that the cited registered mark is accordingly entitled to only a limited scope of protection. As the Examining Attorney points out, however, the evidence of record does not support this argument. As noted above, the materials submitted for the first time with applicant's appeal brief

have not been considered, but even if they had been, our conclusion that confusion would be likely would not have changed. Third-party applications and registrations are not evidence that the marks therein are in use, and hence they do not establish that the consuming public is so familiar with the use of the words common to them that they look to other elements in order to distinguish among them, so even if all the third-party application and registration information argued by applicant were properly of record in this appeal, it would not be persuasive of the conclusion that confusion would not be likely between the mark applicant seeks to register and the cited registered mark. In addition, it is well settled that the Board is not bound by determinations of registrability previously made by Examining Attorneys. In *re Nett Designs, Inc.*, 236 F.3d 139, 57 USPQ2d 1564 (Fed. Cir. 2001). These third-party registrations may be used to establish that the common element in the registered marks has a meaning or suggestive significance in the relevant trade, but, as noted above, we already have a basis for concluding that "DUET" is suggestive in this field, but the suggestion is the same in connection with both applicant's services and those recited in the cited registration.

If applicant's mark, "DUÉT," were to be used in connection with the same telecommunications services with which the registered mark, "FAST PACKET DUET ADVANTAGE," is used, confusion would be likely because applicant's mark is almost identical to the dominant component of the registered mark and conveys the same commercial impression as the cited mark. Applicant's mark would be likely to be perceived as a variant of the registered mark—perhaps as a shorthand version thereof.

As noted by the Examining Attorney, the fact that applicant's services are encompassed within the services of the registrant outweighs the relatively minor differences in the marks. The closer the relationship between the services, the less similar the marks must be in order to support a finding that confusion is likely. *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d 1698 (Fed. Cir. 1992). Moreover, if we were left with any doubts on the issue of likelihood confusion, such doubts would necessarily be resolved in favor of the prior user and registrant, and against applicant who, as a newcomer, had a duty to select a mark that would not be likely to cause confusion with the mark already use in the marketplace for these services. In *re Hyper Shoppes, (Ohio), Inc.*, 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

Ser No. 75/598,432

DECISION: The refusal to register under Section 2(d)
the Lanham Act is affirmed.