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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Dedicated Services, Inc.*

Serial No. 75/734,107

Soumit Roy, Keith E. Taber and Frank S. Vaden III of *Bracewell & Patterson, L.L.P.* for *Dedicated Services, Inc.*

Leigh A. Lowry, Trademark Examining Attorney, Law Office 109
(*Ronald R. Sussman*, Managing Attorney).

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

Opinion by *Hohein*, Administrative Trademark Judge:

Dedicated Services, Inc. has filed an application to register the mark "DEDICATED SERVICES, INC." for the "delivery of auto parts."¹

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the grounds

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that applicant's mark, when used in connection with its services, so resembles each of the following marks, which are owned by different registrants, as to be likely to cause confusion, mistake or deception: (i) the mark "DEDICATED TRANSPORT, INC." and design, as illustrated below,



for "freight transportation by truck for others";² and (ii) the mark "DEDICATED FLEET SERVICES" for "contracted freight delivery services, namely, transportation of goods and freight by land services."³

Applicant has appealed. Briefs have been filed,⁴ but an oral hearing was not requested. We affirm the refusal to register.

¹ Ser. No. 75/734,107, filed on June 22, 1999, which alleges a bona fide intention to use such mark in commerce. The terms "SERVICES, INC." are disclaimed.

² Reg. No. 2,138,185, issued on February 24, 1998, which sets forth a date of first use anywhere and in commerce of July 1988. The terms "TRANSPORT, INC." are disclaimed.

³ Reg. No. 2,263,877, issued on July 27, 1999, which is based upon Canadian Registration No. TMA452023, issued on December 15, 1995. The terms "FLEET SERVICES" are disclaimed.

⁴ With respect to the coexistence, by separate owners, of the two cited registrations, it is noted that applicant has not advanced in its brief its earlier contention, made in response to the initial Office Action, that "[t]hese two registered marks illustrate the fact that this is a relatively crowded field and that minor differences are

Our 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 of the goods and/or services and the similarity of the marks.⁵

Turning first to consideration of the respective services, we concur with the Examining Attorney that the services recited in applicant's application and those set forth in each of the cited registrations are identical in part and thus are provided in the same channels of trade to the same classes of customers. As the Examining Attorney correctly points out, it is well settled that services need not be identical or even competitive in nature in order to support a

sufficient to distinguish between marks acceptable for registration," given the fact that, "[i]f the two cited registrations are compared with each other, ... there are only minor differences between them in that both [marks] contain the term 'dedicated' and ... are used in association with land based freight transportation." As applicant now appears correctly to recognize, the issue for purposes of the refusal to register is the registrability of applicant's mark for its services vis-à-vis the mark for the services identified in each of the two cited registrations.

⁵ 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."

finding of likelihood of confusion. It is sufficient, instead, 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). Moreover, as the Examining Attorney properly observes, it is also well established that the issue of likelihood of confusion must be determined on the basis of the services as they are set forth in the involved application and each of the cited registrations. See, e.g., *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). Thus, where the services in the application at issue and in each of the cited registrations are broadly described as to their nature and type, it is presumed

that in scope the application and each such registration encompass not only all services of the nature and type described therein, but that the identified services move in all channels of trade which would be normal therefor and that they would be purchased by all potential buyers thereof. See, e.g., In re Elbaum, 211 USPQ 639, 640 (TTAB 1981).

Applicant acknowledges that in determining the relatedness of the services at issue, it is the identifications thereof as set forth in the respective application and registration(s) which are controlling. Applicant argues, however, that while its services "extend towards delivery of ... 'auto parts' in any manner, [such as by] truck, airfreight, railcar, etc." and are available to anyone requiring them, the services are not related to those of either of the two registrants because its services "are specifically focused to auto parts due to the specific knowledge and experience needed in their transportation." According to applicant:

The Appellant's services are not related or marketed in such manner that [they] would be encountered by the same person in situations that would create the incorrect assumption that the services originate from the same source. The Appellant's consumers are purchasing the Appellant's services for their experience in the transportation of auto parts and not their ability to transport freight. The nature of the services identified by the Appellant's mark and the [marks in the] cited Registration[s] are different and distinct from one another,

thereby, in holding these ... [services] related, with no actual evidence substantiating this assertion, the ... Examining Attorney is improperly adopting a *per se* rule as pertains to the services. The Applicant is unaware of any evidence linking the Applicant's services and those of the owner of the referenced Registrations.

However, as previously noted, applicant seeks registration of its "DEDICATED SERVICES, INC." mark for the "delivery of auto parts," while one of the cited registrations is for the mark "DEDICATED TRANSPORT, INC." and design for "freight transportation by truck for others" and the other is for the mark "DEDICATED FLEET SERVICES" for "contracted freight delivery services, namely, transportation of goods and freight by land services." As the Examining Attorney accurately observes (*emphasis in original*; footnote omitted):⁶

The registrant's recitation [of services, in each instance,] is very broad with no limitation as to what type of goods it transports and only limits its mode of

⁶ The Examining Attorney has requested in her brief that "the Board take judicial notice of the attached dictionary definition" of the word "deliver," which the accompanying copy of the pertinent pages from Merriam-Webster's Collegiate Dictionary (10th ed. 1993) shows is defined, in relevant part, as a verb meaning "**2 a** : to take and hand over to or leave for another : CONVEY <~ a package>" The same dictionary, we also note, lists "delivery" as a noun signifying "the act or manner of delivering something; also : something delivered." Inasmuch as the Board may properly take judicial notice of dictionary definitions, we grant the Examining Attorney's request and have considered the above definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 (TTAB 1981) at n. 7.

transport. It is presumed, therefore, that [in each case] the registrant can and does transport all types of goods, including auto parts, by truck [or by any other land method, respectively]. The applicant, on the other hand, limited its scope of [services by type of] goods but did not define its mode of transportation. It is presumed that the applicant can and will deliver auto parts by any mode of transport, including truck [or any other land method, respectively].

In this case, [in each instance] the applicant's services and the registrant's services are highly similar. The marks will each be associated with the transportation of goods. It is inherent in the service of delivering any good that it must also be transported. In fact, Merriam Webster's Collegiate Dictionary defines "deliver" as "to take and hand over to or leave for another." Likewise, it is inherent in the transportation of goods that they will be delivered.

Clearly, for the reasons expressed by the Examining Attorney, applicant's services of the "delivery of auto parts," whether transported by truck or by other land services, including railcar, are in each instance encompassed, in part, by the registrants' services of, on the one hand, "freight transportation by truck for others" and, on the other hand, "contracted freight delivery services, namely, transportation of goods and freight by land services." Moreover, contrary to applicant's assertion, "auto parts" plainly constitute a kind of "freight," which we judicially notice is defined by The American Heritage Dictionary of the English Language (4th ed. 2000) at

702 as connoting "1. Goods carried by vessel or vehicle, especially by a commercial carrier; cargo."⁷ In view thereof, the respective services would be provided, in significant part, through the same channels of trade to the same classes of customers. Thus, if applicant's and each of the cited registrants' services were to be rendered under the same or similar marks, confusion between the former and each of the latter as to the source or sponsorship of such services would be likely to occur.

Turning, therefore, to consideration of the respective marks, applicant argues that when considered in their

⁷ Applicant's reliance upon *Itel Corp. v. Ainslie*, 8 USPQ2d 1168, 1170 (TTAB 1998) for the proposition that, in every case, "it is improper to assume that goods and services are related due to a potential that the goods and services identified by the Registration may overlap with the goods and services identified in the [application for] the Appellant's mark" is misplaced. The Board, in finding that an opposer had failed to prove that the identification of its services as "brokerage services, namely, arranging lease agreements between capital equipment owners and users," was broad enough to encompass services which dealt in the goods, namely, telephones, of the applicant therein, took judicial notice that Webster's Third New International Dictionary (1976) defined "capital equipment" as "accumulated goods devoted to the production of other goods, facilities or goods utilized as factors of production." Id. In view thereof, the Board stated that "although there is no question that telephones are utilized in virtually every business enterprise, we do not believe, in the absence of evidence to the contrary, that they may be fairly encompassed in the term 'capital equipment', as used in the opposer's identification of services." Id. Thus, far from assuming that the respective services and goods were potentially related, the Board utilized the limited evidence available to find that, absent further proof, telephones were not items of capital equipment. Here, however, there can be no question that applicant's auto parts delivery services are an identical type, in part, of both freight transportation services by truck and contracted freight delivery

entireties, the mark "DEDICATED TRANSPORT, INC." and design "has no similarity to the Appellant's mark in appearance, sound, connotation and commercial impression" and that the same is true in the case of the mark "DEDICATED FLEET SERVICES." In particular, applicant observes that the "DEDICATED TRANSPORT, INC." and design mark "contains a design that appears to be a fanciful 'D'" which is "surrounded by" the phrase "DEDICATED TRANSPORT, INC." Consequently, applicant contends, such mark is sufficiently "different and distinct" from applicant's "DEDICATED SERVICES, INC." mark that, despite their sharing the term "DEDICATED," "there is no similarity" and, hence, no likelihood of confusion. Likewise, applicant asserts that the fact that its "DEDICATED SERVICES, INC." mark and the "DEDICATED FLEET SERVICES" mark "share [a] common term ... does not automatically lead to [a] finding of likelihood of confusion" because "the common term 'dedicated,' which is the basis of the ... refusal, is a merely descriptive term, when modifying the term 'fleet,' that describes the quality of service" The presence, therefore, of the word "DEDICATED" in such marks, applicant maintains, "is not a proper basis for a finding of a possible likelihood of confusion."

services, namely, transportation of goods and freight by land services.

The Examining Attorney, while correctly acknowledging that the marks at issue must be compared in their entireties, including any disclaimed matter, nevertheless also properly notes that our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark" 224 USPQ at 751.

Here, as the Examining Attorney points out, applicant has disclaimed the highly descriptive words "SERVICES, INC." in its "DEDICATED SERVICES, INC." mark and the highly descriptive words "TRANSPORT, INC." have been disclaimed with respect to the "DEDICATED TRANSPORT, INC." and design mark. Moreover, while the latter additionally features a styled letter "D," it also prominently displays the word "DEDICATED" in significantly larger lettering than the words "TRANSPORT, INC." Although, as stated in In re Electrolyte Laboratories Inc., 913 F.2d 930, 16

USPQ2d 1239, 1240 (Fed. Cir. 1990), "[t]here is no general rule as to whether letters or design will dominate in composite marks," application of the further principle that, when such marks are composed of word and design elements, it is the literal or word portion which is more likely to be impressed upon a customer's memory and to be used in calling for the services," see, e.g., In re Appetito Provisions Co. Inc., 3 USPQ2d 1553, 1554 (TTAB 1987), leads us to concur with the Examining Attorney that it is "the identical word 'DEDICATED' [which] plays the largest role in creating the commercial impression of each mark."

Accordingly, the minor differences imparted by the presence in the "DEDICATED TRANSPORT, INC." and design mark of the highly descriptive and subordinate term "TRANSPORT" and a styled letter "D" and by the inclusion in applicant's "DEDICATED SERVICES, INC." mark of the highly descriptive, if not generic, term "SERVICES" are not sufficient to distinguish such marks, given the shared source-signifying term "DEDICATED" and the prominent manner in which such term appears in the registered mark. Overall, far from there being no similarity as claimed by applicant, the marks are so substantially similar in sound, appearance, connotation and commercial impression that, when used in connection with services which are in part legally

identical, confusion as to the origin or affiliation of the services is likely to take place.

In much the same vein, applicant has disclaimed the highly descriptive words "SERVICES, INC." in its "DEDICATED SERVICES, INC." mark and the highly descriptive words "FLEET SERVICES" have been disclaimed in the case of the "DEDICATED FLEET SERVICES" mark. Furthermore, in light of the latter, applicant's contention that the word "DEDICATED" in the registered mark is a merely descriptive term when modifying the term "FLEET" amounts to an impermissible collateral attack on the validity of such registration since, in essence, it asserts that the entire mark is merely descriptive. See, e.g., In re National Data Corp., supra at 751 n. 8. In any event, we agree with the Examining Attorney that in the "DEDICATED FLEET SERVICES" mark, "[t]he term FLEET actually modifies SERVICES, as it describes what type of services the registrant provides."

Consequently, given the mere descriptiveness, as evidenced by the respective disclaimers, of the terms "SERVICES, INC." and "FLEET SERVICES," the Examining Attorney's argument is persuasive that:

The dominant portion of the Applicant's mark and the registrant's mark is the identical term DEDICATED. The term DEDICATED is suggestive in [its] relationship to transportation and delivery services. Therefore, the two marks DEDICATED SERVICES, INC. and DEDICATED FLEET

SERVICES are identical in dominant portion and highly similar in commercial impression.

When used in connection with services which are legally identical in part, confusion as to the source or sponsorship of the services is likely to occur.

Applicant maintains, nonetheless, that consideration must additionally be given to the sophistication of the customers for its services and those offered by the registrants in order to make a proper "determination of the possibility of a likelihood of confusion among the marks." Specifically, according to applicant:

The consumers of the [services rendered under the] Appellant's mark and [the marks of the] cited Registration[s] are not retail consumers, rather [they] are manufactures [sic], wholesalers, and dealerships who wish to transport their merchandise (specifically auto parts) to retailers. The Appellant's consumers are sophisticated and enter into contracts and relationships that involve a great quantity of money as well as in most circumstances a long period of time. The Appellant's consumers are not in the market for freight transportation, rather [they] are in the market for specifically auto parts transportation. These consumers when entering such contract[s] are very knowledgeable of the market, the entities within the market, and the practices of the market. Therefore, they are very knowledgeable of the entity in which they are entering the contract with and would not be confused with regard to the marks and their designation as to the origination of the services. The Appellant's consumers will exercise greater care and attention when purchasing ... the ... services and

therefore will be less likely to be confused as to the source of such services due to their sophistication. Therefore, the Applicant respectfully requests that the ... refusal to register the Appellant's mark be reversed.

While the Examining Attorney points out that "applicant has not limited its channels of trade [and classes of customers] to only include 'manufacturers, wholesalers, and dealerships'," the absence of such a restriction is immaterial inasmuch as it is obvious that automobile manufacturers, auto parts wholesalers and automobile and auto parts dealerships would be the primary customers for applicant's "delivery of auto parts" services. Likewise, such customers would be a significant portion of the consumers of the registrants' services of "freight transportation by truck for others" and "contracted freight delivery services, namely, transportation of goods and freight by land services," given the legal identity, in part, of such services and applicant's services. Nevertheless, even assuming that, in view of the specific knowledge and experience needed in the transport and delivery of auto parts, the respective services would be purchased only after careful consideration, it is well settled that, as the Examining Attorney correctly notes, the fact that customers may exercise deliberation in choosing such services "does not necessarily preclude their mistaking one [service mark or]

trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983).

We accordingly conclude that consumers and potential customers, who are familiar or acquainted with the mark "DEDICATED TRANSPORT, INC. and design for the services of "freight transportation by truck for others" and/or the mark "DEDICATED FLEET SERVICES for "contracted freight delivery services, namely, transportation of goods and freight by land services," would be likely to believe, upon encountering the mark "DEDICATED SERVICES, INC." for the services of the "delivery of auto parts," that as to legally identical services involving the transportation and delivery of auto parts, such services emanate from, or are sponsored by or associated with, the same source. In particular, even sophisticated and discriminating purchasers could reasonably believe, notwithstanding minor differences in the respective marks, that the "DEDICATED SERVICES, INC." auto parts delivery services rendered by applicant are a new or specialized service from the same entity which provides the "DEDICATED TRANSPORT, INC." and design freight transportation by truck services or the

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"DEDICATED FLEET SERVICES" contracted delivery services of transporting goods or freight by land services.

Decision: The refusals under Section 2(d) are affirmed.