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CEW

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Charter Communications Holding Company, LLC

Serial No. 76/044,706

Bingham B. Leverich and Kathleen T. Gallagher-Duff of
Covington & Burling for Charter Communications Holding
Company, LLC.

Ronald McMorrow, Trademark Examining Attorney, Law Office
105 (Thomas G. Howell, Managing Attorney).

Before Cissel, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Charter Communications Holding Company, LLC has
filed an application to register the mark CHARTER MEDIA
on the Principal Register for "providing and placing

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television advertising for others, and producing infomercials, on cable television stations.”¹

The trademark examining attorney has issued a final refusal to register under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant’s mark so resembles the mark shown below, previously registered for “preparing and placing advertising for others; business management; business information,” in International Class 35, and “publication of pamphlets, booklets, newsletters, etc.” in International Class 41,² that, when applicant’s mark is used on or in connection with applicant’s goods, it would be likely to cause confusion or mistake or to deceive.

¹ Serial No. 76/044,706, in International Class 35, filed May 9, 2000, based on use in commerce, alleging first use and first use in commerce as of July 1, 1999. The application includes a disclaimer of “MEDIA” apart from the mark as a whole. The original identification of services in the application was “preparing advertisements for others; providing and placing television advertising for others; and producing infomercials.” This was amended, following the initial refusal under Section 2(d), by deleting “preparing advertisements for others.” Along with its brief in this appeal, applicant requested a remand to the examining attorney to consider a further amendment to the identification of services, as noted above, which was accepted by the examining attorney.

² Registration No. 2,078,733 issued July 15, 1997, to Charter Management Services, Inc. The registration includes a disclaimer of “GROUP” apart from the mark as a whole.



Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We reverse the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

In determining whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation and

commercial impression, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. Although the marks at issue must be considered in their entireties, it is well settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

Regarding the services involved in this case, we note that the question of likelihood of confusion must be determined based on an analysis of the goods or services recited in applicant's application vis-à-vis the goods or services recited in the registration, rather than what the evidence shows the goods or services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The*

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Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

The examining attorney contends that confusion is likely because the marks are similar; the word portion of the registered mark is dominant; the term "charter" is the dominant word portion of both marks; the term "group" in the registered mark is "a generic entity designator that has no source identifying significance"; and the term "media" is "generic when used in connection with applicant's services." Regarding the respective services, the examining attorney contends that while applicant's services are quite specific, its services are entirely encompassed within registrant's broadly identified services. The examining attorney did not submit any evidence in connection with the Section 2(d) refusal.

Applicant contends that the marks, considered in their entirety, are sufficiently different to avoid likelihood of confusion; that applicant's mark is a member of applicant's "family of 'charter' marks that identifies cable television, communications and related services"; and that its "charter" marks are frequently used together and in connection with its corporate design mark. Applicant states that it is the nation's fourth

largest provider of broadband services, providing services to over seven million customers in forty states; and that cable television advertising is expensive and is purchased by knowledgeable purchasers after careful consideration. Finally, applicant argues that the registered mark is a weak mark entitled to only a narrow scope of protection.

In support of its position, applicant submitted, *inter alia*, copies of several other registered "charter" marks owned by applicant; numerous excerpts from what appear to be third-party Internet web sites that use the phrase "charter advertising" or "charter advertiser" to refer to a certain level of advertising service bought or offered, or use the term "charter" as part of a trade name in relation to advertising; copies of third-party pending applications to register marks that include the term "charter" for various services; and the declaration of Marcy A. Lifton, applicant's vice president, describing applicant and its services.

We agree with the examining attorney that, while applicant has narrowly specified its services as "providing and placing television advertising for others, and producing infomercials, on cable television stations," these services are encompassed by registrant's

very broadly identified services of "preparing and placing advertising for others." Thus, we must assume that applicant's services and the same services encompassed within registrant's recitation of services are the same and that these services are offered through the same channels of trade to the same class of purchasers.

However, we must also consider the facts, established in the record, that such services are expensive; and that the relevant purchasers are likely to be knowledgeable about such services and will take care in their purchase thereof. These factors weigh against any likelihood of confusion.

Further, applicant has submitted significant evidence of third-party use of the term "charter" in the field of advertising, indicating that "charter" is a weak, and not entirely arbitrary, term in this field.

Finally, we consider the marks and note that, while both marks contain the identical term "charter," there are obvious differences between the marks, considered in their entireties.³ Moreover, the evidence indicates that

³ We make no finding regarding the renown of applicant's mark, its possible use in connection with applicant's corporate mark, or whether applicant has demonstrated that it has a family of "charter" marks. These points are not relevant to our consideration of the differences or

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"charter" is relatively weak and the examining attorney has provided no evidence in support of his contentions that it is the dominant portion of both marks. Because of the established weakness in the term "charter," and the other obvious differences between the marks, we find that the overall commercial impressions of the marks are not similar.

Therefore, even though the services set forth in the application are encompassed within those recited in the registration, the marks have different commercial impressions and the services are expensive and purchased with care by knowledgeable purchasers. On balance, we find insufficient support for the examining attorney's finding that confusion is likely.

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

similarities between the specific marks and services involved in this appeal.