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Paper No. 15
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tele Danmark A/S

Serial No. 75/598,434

Colleen M. Keegan of Pennie & Edmonds LLP for Tele Danmark A/S.

Andrew J. Benzmilller, 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, applicant filed the above-
referenced application to register the mark shown below



for what 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, 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 the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with the services recited in the application.

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; switch to multi-

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

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. 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, and an amendment to the recitation of services.

A newly assigned Examining Attorney suspended action pending the resolution of one of the prior-filed pending applications.

Applicant subsequently provided additional responses to the Examining Attorney's refusal and requirements, arguing that confusion with the second registered mark is not likely, amending the recitation of services, and stating that the term "DUET" does not have any significance in the relevant trade or industry, or as applied to the

applicant's services, nor does it have geographic significance or meaning in a foreign language.

Next, the third Examining Attorney assigned to this application withdrew the marks in the two pending applications as potential bars to registration, but issued a final refusal under Section 2(d) based on the cited registered mark. She supplemented the final refusal by submitting copies of a number of third-party registrations wherein the services recited encompass both the services set forth in this application and the services set forth in the registration cited as a bar.

Applicant filed a request for reconsideration, followed by a timely Notice of Appeal. 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.

Responsive to the request for reconsideration, she maintained the refusal to register. The Board then resumed action on the appeal, both applicant and the Examining Attorney identified above filed briefs, and applicant filed a reply brief. No oral hearing before the Board was requested. Accordingly, we have resolved this appeal based on the written arguments of applicant and the Examining Attorney and the application file.

In this connection, we note that applicant included in its brief a listing of three registrations and two applications, all of which are alleged to be owned by third parties, wherein the marks include the term "DUET" or a variation thereof. Applicant argues that this listing establishes that the term is weak in connection with telecommunications services, and therefore that confusion is not likely in the case at hand.

As the Examining Attorney points out, however, the two listed applications were subsequently abandoned and consequently the marks therein never registered, and the three listed registrations were never properly made of record by applicant. Moreover, even if copies of these registrations had been made of record, they would not have been persuasive of the contention that confusion would not be likely in the instant case. Third-party registrations are not evidence of the use of the marks therein, so they could not have been considered to have established that the consuming public is so familiar with such marks that other elements in them serve to allow purchasers to differentiate among them.

The 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 in 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 "telecommunications 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 the transmission of voice and data. Applicant's services cited as "communication services," "telephone communication 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 source of these overlapping telecommunications services, confusion would be likely.

Turning then to a comparison of the marks, 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, 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 mark have less significance in determining the overall commercial impression the mark engenders. Plainly, the word "DUET" is the dominant element in the registered mark.

It is well settled that 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 on the issue of likelihood of confusion rests on a comparison of the marks in their entireties. In re National Data Corp., 224 USPQ 749 (Fed. Cir. 1985). The mark applicant seeks to register has as its dominant element the dominant term in the registered mark. When we consider applicant's mark and the cited registered mark in their entireties, they create similar commercial impressions.

Applicant's arguments regarding distinctions between "DUET" and the term as used in its mark with an accent over the letter "E" are not persuasive that confusion between the marks is not likely. The difference in appearance

between the two words is minimal. 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, even if purchasers were to notice the accent over the letter "E" in the word as it appears in the mark applicant seeks to register, such people are likely to pronounce the word in applicant's mark the same way they would pronounce the familiar word "DUET." In re Mack, 197 USPQ 755 (TTAB 1977). Whatever suggestiveness this word 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.

Applicant also argues that confusion would not be likely because of the design elements in the mark applicant seeks to register. Ordinarily, when a word is combined with graphic design elements in a mark, it is the word that is likely to be impressed upon the memories of purchasers. In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987). This is particularly so in the instant case, where the literal component of applicant's mark is prominently displayed in the center of the circle design, and the graphic representations of telephones are highly suggestive

of applicant's telecommunication services. Although it cannot be disputed that applicant's mark does include these design features which are not present in the cited registered mark, the two marks are nonetheless similar because the dominant In re Mack, 197 USPQ 755 (TTAB 1977) In re Mack, 197 USPQ 755 (TTAB 1977) In re Mack, 197 USPQ 755 (TTAB 1977) element in applicant's mark is the centrally displayed word, and that word is almost identical to the dominant element in the cited registered mark. This is the term which is likely to be used in referring to or recommending the services of either applicant or the owner of the cited registration. In view of the nature of the services rendered by these businesses, such references are likely to be made orally, in which case the two terms would be indistinguishable.

As noted by the Examining Attorney, the fact that applicant's services are encompassed within the services of the registrant outweighs the differences between 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 of confusion, such doubts would necessarily

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be resolved in favor of the registrant as the prior user, and against applicant, who, as a newcomer, had a duty to select a mark that would not be likely to cause confusion with a mark already in use in the marketplace for these services. In re Hyper Shoppes, (Ohio), Inc., 837 F.2d 643, 6 USPQ2d 1025 (Fed. Cir. 1988).

In summary, because the dominant term in the cited registered mark is almost identical to the dominant element in the mark applicant seeks to register, the use of these two marks in connection with the same services would be likely to cause confusion.

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