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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Qwest Communications International, Inc.
v.
AT&T Corporation

Opposition No. 91122617
against Serial No. 76006001

Opposition No. 91122620
against Serial No. 76006002

Opposition No. 91124190
against Serial No. 76006000

Opposition No. 91124392
against Serial No. 76006003

David E. Sipiora of Townsend and Townsend and Crew, LLP for Qwest Communications International, Inc.

Francine Miller of Donovan & Yee LLP for AT&T Corporation.

Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

On March 21, 2000, AT&T Corporation filed four separate intent-to-use applications for the mark CONQUEST,

seeking registration on the Principal Register for goods identified, as filed, as follows:

> "pre-paid telephone calling cards magnetically encoded" in International Class 9; [1] and
>
> "non-magnetic telephone calling cards" in International Class 16;[2]

and for services recited, as filed, as follows:

> "telecommunications calling card services" in International Class 36;[3] and
>
> "delivery of message by electronic transmission; electronic transmission of data and documents via computer terminals; electronic transmission of facsimile communications and data featuring encryption and decryption; electronic transmission of messages and data; electronic transmission of video; facsimile transmission" in International Class 38.[4]

This is a consolidated proceeding in which Qwest Communications International, Inc. seeks to prevent the

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[1] Application Serial No. 76006001 was filed on March 21, 2000.

[2] Application Serial No. 76006002 was filed on March 21, 2000. Although applicant timely filed a response to Opposition No. 91122620 as well as a response to the Board's notice of default, neither was timely entered into the proceeding record. While the Board's order entering judgment and its notice of default were vacated, United States Patent & Trademark Office records still incorrectly show this application as abandoned after an *inter partes* decision.

[3] Application Serial No. 76006000 was filed on March 21, 2000.

[4] Application Serial No. 76006003 was filed on March 21, 2000.

registration of this mark for these goods and services on the ground of priority and likelihood of confusion.

Qwest Communications International, Inc. alleges that it owns multiple federal registrations incorporating therein its distinctive QWEST mark, including the following five[5] registrations:

REGISTRATION NO. 2472094	**QWEST ADVANTAGE**
for "prepaid telephone calling cards, magnetically encoded" in International Class 9;[6]	
REGISTRATION NO. 1979485	**QWEST COMMUNICATIONS**
for "telecommunication services, namely the electronic transmission of voice, data, and messages" in International Class 38;[7]	
REGISTRATION NO. 1966694	**QWEST**
for "telecommunication services, namely the electronic transmission of voice, data, and messages" in International Class 38;[8]	

[5] A sixth registration, Registration No. 2075826 for the mark QWEST CONNECTIONS for "long distance telephone calling card services" in International Class 36, was still in force at the time of opposer's filing of its notice of reliance (March 2002). However, this registration was subsequently cancelled (i.e., during April 2004) under Section 8 of the Act.

[6] Registration No. 2472094 issued on July 24, 2001 alleging a date of first use in commerce of at least as early as June 30, 1998.

[7] Registration No. 1979485 issued on June 11, 1996 alleging a date of first use in commerce of at least as early as June 23, 1992; Section 8 affidavit accepted.

[8] Registration No. 1966694 issued on April 9, 1996 alleging a date of first use in commerce of at least as early as October 30, 1985; Section 8 affidavit accepted.

REGISTRATION NO. 2430761 **QWEST EXPRESS**

for "telecommunications services, namely, telephone communications services; electronic transmission of voice, video, messages and data; providing access to a fiber-optic telecommunications network; providing multiple user access to a global computer network; video teleconferencing services," in International Class 38;[9] and

REGISTRATION NO. 2210992 Qwest

for "telecommunication services, namely, long distance telephone services, and electronic transmission of voice, data and messages," in International Class 38.[10]

all the above goods and services being identical, if not closely related, to those of applicant; that opposer commenced use of the mark QWEST on telephone calling cards and telecommunication services such as long distance telephone services and the electronic transmission of voice, data and messages prior to the filing date of applicant's applications; that opposer's registered marks have become well known as identifying opposer as the source of telephone calling cards and telecommunication services; and that applicant's mark, if used in connection with its

[9] Registration No. 2430761 issued on February 27, 2001 alleging a date of first use in commerce of at least as early as June 30, 1998.

[10] Registration No. 2210992 issued on December 15, 1998 alleging a date of first use in commerce of at least as early as October 6, 1997; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

goods and services, would so resemble opposer's previously used and registered marks as to be likely to cause confusion, to cause mistake, or to deceive.

AT&T Corporation has denied each of the salient allegations contained in the notices of opposition.

The record includes the pleadings; the files of applicant's four involved applications; opposer's notice of reliance filed February 15, 2002, with Exhibits H, I and J; opposer's supplemental notice of reliance filed March 5, 2002, with Exhibits 1 through 6; and notices of reliance as to Opposition Nos. 91124190 and 91124392, that include applicant's responses to opposer's first set of interrogatories. AT&T Corporation took no testimony and offered no evidence during its testimony period. Both parties filed briefs on the case but neither party requested an oral hearing.

First, we note that with regard to the threshold inquiry of opposer's standing in these proceedings, opposer has clearly demonstrated that it is a competitor of applicant in the field of telephone calling cards and telecommunication services.

With regard to the issue of priority in relation to the goods and services set forth in opposer's pleaded

registrations, to the extent that opposer owns valid and subsisting registrations of its pleaded marks, the issue of priority does not arise. *See King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974); and *Carl Karcher Enterprises Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Thus, the only remaining issue before the Board is likelihood of confusion. Our determination of likelihood of confusion must be based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the relatedness of the goods and services as listed in the cited registrations and in the instant applications. Applicant has recited services in International Class 38 including the electronic transmission of messages and data. This is identical to the dominant services recited in opposer's cited registrations. Although opposer's registration for the mark QWEST CONNECTIONS used in connection with telephone calling card services has been cancelled under Section 8 of the Act, it still has a registration for the mark QWEST

ADVANTAGE for prepaid, encoded telephone calling cards in International Class 9. Accordingly, we find that applicant's goods and services are closely related, if not identical, to registrant's goods and services. At such time as applicant were to use these marks on the identified goods and recited services, the parties' respective goods and services would be presumed to travel through the same channels of trade to the same classes of ordinary consumers.

We turn next to the *du Pont* factor focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound and connotation.

Applicant argues that CONQUEST differs significantly in appearance, pronunciation and connotation from the marks on which opposer bases its opposition, namely, QWEST, QWEST COMMUNICATIONS, QWEST EXPRESS and QWEST ADVANTAGE.

As to appearance, applicant's mark, CONQUEST, is a two-syllable word with the leading syllable being "CON-." QWEST is a one-syllable word spelled with the letter "W" rather than the letter "U." When applicant's two-syllable, CONQUEST mark is compared with opposer's composite marks containing the word QWEST, we note that each comprises three or more syllables, with QWEST being the sole or

leading word in the mark. When compared in their entireties, we find that CONQUEST is dissimilar from QWEST, QWEST COMMUNICATIONS, QWEST EXPRESS and QWEST ADVANTAGE[11] in overall appearance.

As to sound, the emphasis in the word CONQUEST will likely be on the first syllable. In each of the cited marks, the QWEST sound would draw the emphasis when the marks are spoken. As noted above, the sound of the word CONQUEST is decided different than the sound of opposer's QWEST, QWEST COMMUNICATIONS, QWEST EXPRESS and QWEST ADVANTAGE marks.

We cannot be sure what different connotations prospective consumers may draw from opposer's house mark, QWEST. It is possible some will make an association with opposer's position as the local telephone service provider in the western states, and will see the term as "Q-west." For these consumers, applicant's CONQUEST mark would have a very different connotation from opposer's marks. However, as argued by applicant, even for the consumers who view QWEST as if it were the word "quest," the word "quest" has the connotation of "seeking," "pursuit" or "search."

[11] We note in particular that as to the goods in International Class 9 (pre-paid, encoded telephone calling cards), the marks would be CONQUEST versus QUEST ADVANTAGE.

Applicant contends that by contrast, the word "conquest" has the connotation of conquering or being victorious.[12] We agree that the respective parties' marks have different connotations.

Accordingly, after comparing the respective parties' marks as to appearance, sound and connotation, we conclude that the marks are dissimilar in their overall commercial impressions.

As to the strength of opposer's QWEST marks, it does appear as if the term is arbitrary, and hence is considered to be inherently distinctive. However, although opposer attempts to rely upon court cases saying that its QUEST house mark is famous, there is no evidence in the record as to the volume of sales or advertising, the length of use, etc. Hence, we cannot make a determination on the renown of opposer's marks in the field of telephone calling cards and telecommunication services. Moreover, there is no evidence in the record shedding any light on the question of the number and nature of any similar marks in use on similar goods and/or services. Accordingly, as to the strength of opposer's marks, the *du Pont* factors focusing

[12] Applicant cites to Webster's Ninth New Collegiate Dictionary, Merriam-Webster, Inc., 1986.

on fame of opposer's marks, and the use of similar marks by third parties, must be viewed as neutral factors in our final determination of likelihood of confusion.

In conclusion, after weighing all the relevant *du Pont* factors, although the goods and services herein are closely related or identical, we find it determinative that the respective marks create quite different overall commercial impressions. Hence, we find that opposer, as plaintiff in these actions, has not shown by a preponderance of the evidence that there is a likelihood of confusion herein.

Decision: The oppositions are dismissed and the applications will be forwarded for the issuance of the respective notices of allowance.