Hearing: Paper No. 30
May 25, 2000 BAC

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB JUNE 27, 00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SkyTel Corp.
v.
Vehicle Access Corporation, Incorporated

Opposition No. 106,611
to application Serial No. 75/089,963
filed on April 17, 1996

Laurence R. Hefter and Lisa Peller London of Finnegan, Henderson, Farabow, Garrett & Dunner for SkyTel Corp.

Marc A. Bergsman of Dickinson Wright PLLC for Vehicle Access Corporation, Incorporated.

Before Simms, Walters and Chapman, Administrative Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

An application has been filed by Vehicle Access Corporation, Incorporated to register on the Principal Register the mark shown below

for "vehicle anti-theft systems comprising cellular telephones, pagers, two way pagers, and satellite signal

processors” in International Class 12. The application is based on applicant’s assertion of a bona fide intention to use the mark in commerce.

SkyTel Corp. has opposed the application, alleging that it is “a leading provider of information, paging, messaging, and data communication services in the United States”; that opposer has used and continues to use “a large family of marks that include the prefix ‘SKY’ to identify its goods and services” (which include paging and messaging services, providing news, financial and other information to paging service subscribers, paging and messaging receivers, and computer software for the wireless sending and receiving of data via radio waves); that opposer owns fourteen registrations for and common law rights to various ‘SKY’ prefix marks (e.g., SKYTEL, SKYTALK, SKYPAGER, SKYNEWS, SKYQUOTE, SKYMAIL); that opposer’s additional nine pending applications for various ‘SKY’ prefix marks for paging and messaging services, computer software and communication services evidence the continuing development of opposer’s family of marks (e.g., SKYTEL 2-WAY, SKYTEL ACCESS, SKYFINDER, SKYTEL MESSENGER, SKYWRITER); and that, applicant's mark, if used on or in connection with its identified goods, would so resemble opposer's mark and name SKYTEL, opposer’s “SKY” prefix marks, and opposer’s family

of “SKY” marks, as to be likely to cause confusion, mistake or deception.

Applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; opposer’s notice of reliance on status and title copies of eighteen registrations owned by opposer; opposer’s notice of reliance on applicant’s responses to opposer’s first set of interrogatories; the testimony, with exhibits, of Kerry McKelvey, opposer’s vice president of marketing[1]; the testimony, with one exhibit, of Harvey Carmel, a co-founder of applicant corporation[2]; and applicant’s notice of reliance on approximately 100 third-party registrations which include the word “SKY.”

Both parties filed briefs on the case, and were represented at an oral hearing held before this Board on May 25, 2000.[3]

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[1] Exhibit 9 to the McKelvey testimony (opposer’s media plan) was marked confidential during the deposition. Although it was not filed under seal, the Board will use discretion in referring to this exhibit.

[2] The entire deposition transcript of Harvey Carmel and the exhibit attached thereto (the exhibit is in the nature of a “business plan” per applicant’s attorney, p. 8, Carmel dep.) were submitted under seal as “confidential.” However, in the briefs on the case, both parties specifically referred to various portions of the Carmel transcript. Thus, the parties have waived “confidentiality” as to those matters referred to in the briefs. Inasmuch as the record is clear that confidentiality was intended, the Board will use discretion in referring to this evidence.

[3] Opposer attached to its reply brief a photocopy of the final Board decision (which is marked “not citable as precedent”) in

In this case opposer has filed status and title copies of the following sixteen[4] registrations owned by opposer[5]:

SKYPAGER for "paging and messaging receivers" in Class 9;[6]

SKYPAGER for "paging services utilizing satellite transmissions, provided in participating cities" in Class 38;[7]

Opposition No. 99,073 (SkyTel Corp. v. Moorer Technologies). Applicant objected thereto at the oral hearing. The objection is well taken. See General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, footnote 9 (TTAB 1992).

[4] As noted earlier herein, opposer's notice of reliance included status and title copies of eighteen registrations. However, the records of the Patent and Trademark Office indicate that both Registration No. 1,727,267 for the mark SKYGATE for "computer software for sending and receiving data via radio waves," and Registration No. 1,738,659 for the mark SKYTALK PLUS for "paging services utilizing satellite transmissions, provided in participating cities" have been cancelled pursuant to Section 8 on May 3, 1999 and June 14, 1999, respectively. Further, the records of this Office show that the Patent and Trademark Office has accepted registrant's Section 8 affidavit for Registration No. 1,755,044 for the mark SKYTEL for "paging and messaging receivers."

When a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the Patent and Trademark Office. See TBMP §703.02(a), at page 700-10, and the cases cited therein. The Board hereby takes judicial notice of the cancelled status of Registration Nos. 1,727,267 and 1,738,659, and the valid and subsisting status of Registration No. 1,755,044.

[5] The status and title copies submitted by opposer consist of the fourteen registrations pleaded by opposer (two of which have been cancelled) and four of the pleaded applications which have since matured into registrations (SKYTEL 2-WAY, SKYTEL ACCESS, SKYTEL MESSENGER and SKYWRITER).

[6] Reg. No. 1,488,238, issued May 17, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is April 1987.

[7] Reg. No. 1,505,191, issued September 20, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is April 1987.

SKYTALK for "paging services utilizing satellite transmissions, provided in participating cities" in Class 38;[8]

SKYWORD for "paging services utilizing satellite transmissions, provided in participating cities" in Class 38;[9]

SKYTEL for "paging and messaging receivers" in Class 9;[10]

SKYSTREAM for "pagers" in Class 9 and "paging services" in Class 38;[11]

SKYQUOTE for "information services, namely, providing information regarding commodities futures and similar financial information" in Class 36;[12]

SKYNEWS for "information services, namely, providing news and information to subscribers of paging and messaging services via their pagers" in Class 42;[13]

SKYCARD for "paging and messaging receivers" in Class 9;[14]

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[8] Reg. No. 1,517,492, issued December 20, 1988, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is March 30, 1988.

[9] Reg. No. 1,592,384, issued April 17, 1990, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is June 1, 1989.

[10] Reg. No. 1,775,044, issued June 8, 1993, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed date of first use is September 1989.

[11] Reg. No. 1,787,286, issued August 10, 1993. Although this registration has not been formally cancelled under Section 8, there is no record of a Section 8 affidavit being filed at this Office. The claimed date of first use is June 1, 1992.

[12] Reg. No. 1,829,968, issued April 5, 1994. Although this registration has not been formally cancelled under Section 8, there is no record of a Section 8 affidavit being filed at this Office. The claimed date of first use is October 28, 1993.

[13] Reg. No. 1,849,652, issued August 9, 1994. The claimed date of first use is August 16, 1993.

[14] Reg. No. 1,890,437, issued April 18, 1995. The claimed date of first use is September 20, 1994.

SKYTEL for "paging services provided in participating cities which utilize satellite transmissions" in Class 38;[15]

SKYMAIL for "paging services" in Class 38;[16]

SKYWORD ACCESS for "computer software, namely, software that allows data and information to be transmitted between personal computers and paging and messaging receivers" in Class 9;[17]

SKYTEL 2-WAY for "paging and messaging services" in Class 38;[18]

SKYTEL ACCESS for "computer software which enables a user to transmit messages from a personal computer to a pager" in Class 9;[19]

SKYTEL MESSENGER for "computer software and peripheral equipment which enables a user to transmit data from a wireless computer" in Class 9;[20] and

SKYWRITER for "communications services, namely, reception and transmission of data to and from a wireless messaging receiver" in Class 38.[21]

Opposer is a leader in the field of providing paging and messaging services, from simpler numeric pagers (offered

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[15] Reg. No. 1,892,366, issued May 2, 1995. The claimed date of first use is September 1, 1989.
[16] Reg. No. 1,900,112, issued June 13, 1995. The claimed date of first use is August 1, 1994.
[17] Reg. No. 2,011,638, issued October 29, 1996. The claimed date of first use is June 1992.
[18] Reg. No. 2,074,254, issued June 24, 1997. The claimed date of first use is July 1995. The term "2-way" is disclaimed.
[19] Reg. No. 2,111,125, issued November 4, 1997. The claimed date of first use is September 1995. The term "access" is disclaimed.
[20] Reg. No. 2,120,589, issued December 9, 1997. The claimed date of first use is September 1995.
[21] Reg. No. 2,131,296, issued January 20, 1998. The claimed date of first use is June 1996.

under, inter alia, the marks SKYTEL and SKYPAGER) to the more complex alphanumeric (offered under, inter alia, the mark SKYWORD) and/or interactive two-way pagers (offered under, inter alia, the mark SKYWRITER). In addition, opposer develops computer software for those services. Subscribers to opposer's core services may also subscribe to the news services (offered under, inter alia, the mark SKYNEWS) and financial and other information services (offered under the mark SKYQUOTE) which deliver the latest information to a customer's pager. Opposer also offers a variety of other goods and services that enable customers to integrate the paging and messaging services with electronic mail, voice mail, fax machines, the Internet and office and home computers, all under various "SKY" prefix marks, e.g., SKYPAGER, SKYTEL, SKYWORD, SKYFAX, SKYCARD). In addition, opposer publishes a quarterly newsletter under the mark SKYLINE for its customers to advise them about opposer's new products and services and provide general information about opposer.

Opposer's core customer base is the frequent business traveler, but its target market is broad, encompassing males between the ages of 25 to 45. Opposer advertises in every major airline magazine, and on in-flight video and audio programs, as well as on billboards in airports. Opposer also places advertisements in other magazines and newspapers

including Fortune, Business Week, Travel & Leisure, Wall Street Journal, and USA Today; on cable television channels, such as CNN, ESPN, Comedy Central, Discovery channel, and History channel; on the Internet (e.g. Yahoo, Excite, Geocities); and on radio in the Chicago, Dallas, New York, Los Angeles, and Atlanta markets. Opposer spent $15 million dollars on advertising and promotion in 1997, and approximately $12.4 million for 1998.

Opposer sells its goods and services through a direct sales force of over 300 people nationwide, as well as through direct mail and telemarketing. Opposer's annual sales have increased from $126 million in 1992 to over $350 million in 1996, with the number of units in service growing from over 244,000 in 1992 to over 1,500,000 in 1998.

Kerry McKelvey, opposer's vice president of marketing, testified that SkyTel Corp. has specifically adopted a branding and marketing strategy which it utilizes from the selection of marks to the advertising and promotion thereof. The purpose of this strategy is to have consumers understand that opposer's various "SKY" prefix marks identify services and goods from a single source. In selecting names for new products or services opposer uses the prefix "SKY" familiar to their customers, and, generally, a descriptive suffix.

The record establishes that besides offering its main services of paging and messaging, opposer has contracted

through “re-sell agreements” with other paging companies (e.g., MCI, MetroCall, and PageNet) under which the other paging companies use opposer’s system to offer services other than paging (e.g., messaging) to consumers. Further, SkyTel Corp. is working with other companies to offer services in which opposer’s paging and messaging goods and services play an important role, such as to read utility meters through opposer’s messaging network; to monitor vending machines for inventory; and to monitor when courier service boxes or garbage containers are empty or full (thereby making pickup more efficient). Kerry McKelvey also testified that in the past SkyTel Corp. “had a significant development partnership” with a company called Prince (now Johnson Controls), involving “a vehicle monitoring system that would use the SkyTel network to monitor vehicles, unlock doors, provide directions, all those sorts of things. We’re still very much interested in working with Prince and continuing that, but are in a coverage build out process right now, so we’re still working in development as we build out coverage so we can affectively (sic) cover the vehicles as they travel around metropolitan areas and outside metro areas.” (McKelvey dep., p. 42).

Applicant corporation was formed by Harvey Carmel and his son, Brian Carmel, in order to manufacture a device “to limit access to vehicles to a specific time” (Carmel dep.,

p. 6). Harvey Carmel testified that the product will limit access through a controller which will receive a signal and shut down either the ignition or the fuel pump, and it could be controlled based on pagers, two-way radios, cellular telephones or satellite direct communication; and it is all still in the development phase. He further testified that the device is intended primarily for commercial vehicle fleet owners (e.g., plumbers, contractors), but "it can be used in a passenger car" (Carmel dep., p.17); and that marketing may be done through trade journals of the various industries which have fleets of commercial vehicles.[22] The mark SKYLOCK was selected because it "locks" the vehicle and the word "sky" was "to connote that it was happening remotely." (Carmel dep., p. 27). Mr. Carmel also testified he is familiar with the name SkyTel, and he knew of opposer as a paging service company; and that his son conducted a search of the mark SKYLOCK in the USPTO and found no mark SKYLOCK for goods or services relating to vehicle access.

Because 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

[22] We note that opposer's interrogatory No. 8 asked applicant to identify the classes or types of purchasers to whom applicant

(TTAB 1995). Moreover, the record establishes that applicant has not commenced use of its mark for the identified goods.

Thus, the sole issue before the Board is likelihood of confusion. Our determination of likelihood of confusion must be based on our 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 & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Based on the record before us in this case, we find that confusion is likely.

Turning first to a consideration of the parties' respective goods and services, it is well settled that goods and/or services need not be identical or even competitive to support a finding of likelihood of confusion, it being sufficient instead that the goods and services are related in some manner or that the circumstances surrounding their marketing are such that they would likely be encountered by the same persons under circumstances that could give rise to the mistaken belief that they emanate from or are associated with the same source. See In re Peebles Inc., 23 USPQ2d 1795 (TTAB 1992); and In re International Telephone and Telegraph Corporation, 197 USPQ 910 (TTAB 1978). The complementary/related nature of opposer's paging and

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intended to market these goods under this mark; and applicant

messaging services, and applicant's vehicle anti-theft system which could operate based on a paging system is obvious and cannot be ignored. See In re Martin's Famous Pastry Shoppe, Inc., 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

Further, it has been repeatedly held that, when evaluating the issue of likelihood of confusion in Board proceedings regarding the registrability of marks, the Board is constrained to compare the goods/services as identified in the application with the goods/services as identified in the registration(s). See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); and Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987).

Applicant refers throughout this case to its "vehicle access limitation and anti-theft deterrent system" or its "vehicle access limitation device." However, the goods on which applicant asserts a bona fide intention to use the mark are identified in the application as "vehicle anti-theft systems comprising cellular telephones, pagers, two way pagers, and satellite signal processors," and it is this identification of goods which this Board must consider. As described the identification is not limited in any way as to

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responded "to vehicle owners, renters, and leasers (sic)."

commercial or passenger vehicles, and thus it encompasses an anti-theft device for any vehicle. Obviously, there is also no restriction as to purchasers or trade channels. Therefore applicant's identification of goods encompasses anti-theft systems for all types of vehicles and sold through all normal channels of trade to all the usual purchasers. See Octocom Systems Inc. v. Houston Computer Services Inc., supra, at 1787; and The Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991).

Applicant's argument that its goods would be directed specifically to commercial fleet vehicle owners is irrelevant and unpersuasive in view of the identification of goods. Moreover, the record shows that applicant itself stated that its anti-theft system could be used in passenger cars (Carmel dep., p. 17, and applicant's answer to opposer's interrogatory No. 8).

Applicant's argument that it has not yet selected a type of controlling device (pager, two-way pager or radio, cellular telephone or satellite signal processor) to be used in its vehicle anti-theft system is also irrelevant in light of the inclusion of all of those possibilities within the goods as identified. In addition, Harvey Carmel testified that pagers remain a viable option (dep., p. 12).

Even if we assume, as argued by applicant, (i) that the parties' customers and potential customers will exercise

considerable care in selecting these goods and services, and (ii) that applicant's customers would be concerned about the reliability of applicant company, but not about which "backbone" system applicant uses to activate its vehicle anti-theft device, this does not mean that the consumers are immune from confusion as to the source of the goods offered by applicant and opposer. See Peopleware Systems, Inc. v. Peopleware, Inc., 226 USPQ 320 (TTAB 1985).

We find applicant's goods are related/complementary to opposer's paging and messaging services and associated goods; and that the parties' goods and services would be sold in similar channels of trade to the same purchasers.

Turning to a consideration of the marks, opposer has shown that it has used a family of marks consisting of the "SKY" prefix followed by a generic or descriptive or suggestive term, prior to applicant's filing date of April 17, 1996.[23] The Court of Appeals for the Federal Circuit has explained that recognition of a family of marks is "achieved when the pattern of usage of the common element is sufficient to be indicative of the origin of the family." See J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:61 (4th ed. 2000). We find that opposer's

prior use and promotion of its SKYTEL name and mark for paging and messaging services and for paging and messaging receivers is established; that opposer's use of its various "SKY" formative marks has been such that opposer has created a family of marks in the field of paging, messaging, and information and data communication and transmission with the "SKY" prefix in combination with generic or descriptive or suggestive words to form coined terms; and that opposer's various "SKY" marks are either arbitrary or suggestive. See International Diagnostics Technology, Inc. v. Miles Laboratories, Inc., 746 F.2d 798, 800, 223 USPQ 977, 978 (Fed. Cir. 1984); McDonald's Corp. v. McBagel's, Inc., 649 F. Supp. 1268, 1 USPQ2d 1761 (SDNY 1986); McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989); and Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988).

The record shows that opposer's "SKY" marks are selected and then advertised and promoted together in such a way that the relevant purchasing public associates not only the individual marks, but also the common characteristic of the family, with opposer. Opposer has shown extensive nationwide usage and promotion of various marks using the "SKY" formative on a range of products and services, often in promotional matter in association with its SkyTel

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[23] We note that opposer's mark SKYWRITER was first used in June

housemark. Opposer has spent a substantial sum on advertising expenditures.

Opposer has established that, as part of its family of marks, it uses numerous “SKY” prefix marks, such as SKYTEL, SKYTEL 2-WAY, SKYPAGER, SKYTALK, SKYWORD, and SKYMAIL, for paging and messaging services; that it also uses SKYTEL, SKYCARD and SKYPAGER for paging and messaging receivers; SKYSTREAM for pagers and paging services; SKYQUOTE and SKYNEWS for information services; and SKYWORD ACCESS and SKYTEL MESSENGER for computer software for transmitting data from computers. (In addition, opposer has used SKYWRITER for reception and transmission of data to and from a wireless messaging receiver since June 1996.)

Applicant’s mark, SKYLOCK, is similar in format to opposer’s various “SKY” formative marks, and the purchasing public upon seeing applicant’s mark would believe applicant’s goods are sponsored by or are associated with opposer.

Applicant does not argue that opposer’s marks are quite different in appearance or commercial impression, but rather that opposer’s family surname (“SKY”) is generic or descriptive of opposer’s goods and services, and that opposer’s various “SKY” marks are weak and entitled to only to a limited scope of protection. Applicant did not

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establish either that the “SKY” family surname is generic or descriptive or that opposer’s marks are weak and entitled to only a narrow scope of protection. Applicant’s only evidence in this regard was the submission of numerous third-party registrations of “SKY” prefix marks for goods/services in various fields. First, third-party registrations are of little weight in determining likelihood of confusion as they are not evidence of use of the marks shown therein and they are not proof that consumers are familiar with them so as to be accustomed to the existence of similar marks in the marketplace. See Conde Nast Publications, Inc. v. American Greetings Corp., 329 F.2d 1012, 141 USPQ 249 (CCPA 1964); and Smith Bros. Mfg. Co. v. Stone Mfg. Co., 476 F.2d 1004, 177 USPQ 462 (CCPA 1973).

Moreover, none of the third-party registrations relied upon by applicant are for either goods or services in the specific field of paging and messaging, or for vehicle anti-theft systems. Some examples of the goods and services covered in the third-party registrations are “transportation of passengers and goods by land and air; packaging articles for transportation by land and air; warehouse storage of packages; travel booking agencies...” (SKYSURFER based on Section 44 of the Trademark Act); “providing information regarding classic toys via a global computer network” (SKY SHOW based on use); “television broadcasting services”

(SKYWITNESS 9 based on use); “audio broadcasting, radio broadcasting, subscription television broadcasting, video broadcasting, data and voice signals by means of satellite, but expressly excluding paging and messaging services” and “entertainment in the form of musical concerts, educational services namely, providing conferences, demonstrations, and courses of instruction and teaching show with overriding Christian content distributed over satellite, television and radio” (SKY ANGEL based on use); and “information services, namely, providing information in the field of astronomy and related subjects to the public by computers and electronic means, interactive online news ands information services” (SKY ONLINE based on use).

While some of the third-party registrations cover goods or services which may be seen as more closely related to the goods and services involved herein than the examples given above,[24] nonetheless, there remains no evidence of use of such marks and/or understanding by the public of same, especially in light of opposer’s established family of “SKY” prefix marks. See Motorola, Inc. v. Griffiths Electronics, Inc., 317 F.2d 397, 137 USPQ 551 (CCPA 1963); Helene Curtis

[24] With regard to the third-party registrations deemed most relevant by applicant in its brief, opposer noted in footnote 2 of its reply brief that several of those registrations “are owned by SkyTel’s parent company, SkyTel Communications, Inc. (formerly known as Mobile Telecommunication Technology Inc.) or that company’s parent, MCIWorldCom...”; and that some others “are the subject of settlement and/or license agreements between SkyTel and the owner....”

Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989); and In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983).

If opposer's argument based upon its ownership of a family of marks failed, opposer also asserted that there is a likelihood of confusion between applicant's mark and opposer's specific marks, e.g., SKYTEL, SKYPAGER, SKYNEWS, SKYTALK, SKYFAX. Accordingly, in the interest of completeness, we review several of opposer's specific marks, in their entireties, and compare them with applicant's mark, as to appearance, sound, connotation and commercial impression.

Put simply, we agree with opposer that applicant's mark SKYLOCK has a strong similarity in sound and appearance to opposer's SKY marks such as SKYTEL, SKYPAGER, SKYTALK, SKYNEWS and SKYFAX. That is, applicant's mark follows the same pattern by combining the prefix SKY with a monosyllabic descriptive term ("lock") relative to the goods. Therefore, the parties' respective marks have similar connotations, leaving consumers with similar overall commercial impressions. The parties' respective marks, evaluated both as to opposer's entire family of marks, as well as to several of opposer's specific service marks are confusingly similar.

In summary, we have no doubt that if applicant uses its mark SKYLOCK on "vehicle anti-theft systems comprising cellular telephones, pagers, two-way pagers, and satellite signal processors," such use would be likely to cause confusion, mistake, or deception with opposer's marks, including its family of marks consisting of the "SKY" prefix combined with various generic or descriptive or suggestive terms used on opposer's various paging and messaging services.[25]

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. See In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

Decision: The opposition is sustained, and registration to applicant is refused.

R. L. Simms

C. E. Walters

[25] Our decision is not based on any finding as to whether opposer's marks are "famous" within the meaning of the case of In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973) because opposer stated in its reply brief (footnote 3) that "SkyTel has not argued in this case that its mark is famous." Further, opposer's attorney reiterated at the oral hearing that opposer was not claiming "fame," but rather was claiming that it owns a strong family of marks which are entitled to a broad scope of protection.

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial
and Appeal