

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: SK TELECOM CO. : BEFORE THE
 Trademark: CELLPLAN : TRADEMARK TRIAL
 Serial No: 78-101321 : AND
 Attorney: Andrew J. Park, Esq. : APPEAL BOARD
 Address: McKenna, Long & Aldridge, LLP : ON APPEAL
 1900 K Street, N.W.
 Washington, D.C. 20006

EXAMINING ATTORNEY'S APPEAL BRIEF

The applicant, SK Telecom Co., has appealed the trademark examining attorney's refusal to register the mark "**CELLPLAN**" on the ground that it is likely to cause confusion with U.S. Registration No. 2014985 "**CELLPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element)**" within the meaning of Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1052(d). The applicant also appealed the examining attorney's refusal to register the mark "**CELLPLAN**" on the ground that the mark is descriptive of one of the features of the goods. Upon reviewing the applicant's arguments that were submitted in the appeal brief and upon a final review of the evidence of record the examining attorney has reconsidered the 2(e)(1) refusal and hereby withdraws it. Therefore, the only refusal that remains outstanding is the 2(d) refusal. It is respectfully requested that the 2(d) refusal be affirmed.

STATEMENT OF FACTS

On January 7, 2002, SK Telecom Co. appealed the trademark examining attorney's refusal to register the mark "**CELLPLAN**" for computer software for transmission of electronic signals for

wireless telephone, computer programs for transmission of electronic signals for wireless telephone, computer operating programs, computers, sound wave telegraph sets, carrier relay equipment, pagers and communication servers for computer hardware, wireless telephone, telephone transmitters of electronic signals.

On April 30, 2002, the examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. Section 1052(d), on the ground that the applicant's mark was confusingly similar to the mark in U.S. Registration No. 2014985 for the mark CELLPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element).

CELLPLAN

CELLPLAN WIRELESS GLOBAL TECHNOLOGIES



(Applicant)

(Registrant)

Finally, the applicant was also issued a descriptive refusal based on 2(e)(1) of the Trademarks Act and a request to amend the identification of goods to read with greater specificity.

In a response filed on October 30, 2002, the applicant argued against the refusals under Section 2(d) and under section 2(e)(1), and amended its identification of goods to read with greater specificity.

On January 22nd, 2002, the examining attorney continued and made FINAL the refusals under Section 2(d) and under 2(e)(1).

On July 22, 2003 the applicant filed a notice of appeal and on September 22nd the applicant filed its appeal brief.

ISSUE

WHETHER THE REGISTRATION OF THE APPLICANT'S MARK, "CELLPLAN", FOR COMPUTER SOFTWARE USED FOR THE TRANSMISSION OF ELECTRONIC SIGNALS FOR WIRELESS TELEPHONE, COMPUTER PROGRAMS USED FOR THE TRANSMISSION OF ELECTRONIC SIGNALS FOR WIRELESS TELEPHONE, COMPUTER OPERATING PROGRAMS, COMPUTERS, SOUND WAVE TELEGRAPH SETS, CARRIER RELAY EQUIPMENT, PAGERS AND COMMUNICATION SERVERS FOR COMPUTER HARDWARE, WIRELESS TELEPHONE, TELEPHONE TRANSMITTERS OF ELECTRONICS SIGNALS IS LIKELY TO CAUSE CONFUSION WITH THE REGISTRANT'S MARK, "CELLPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element)," FOR TELECOMMUNICATIONS SERVICES, NAMELY INSTALLATION AND OPERATION OF POINT TO POINT RADIO SYSTEMS AND FOR DESIGN AND INSTALLATION OF COMPUTER SOFTWARE FOR USE IN TELECOMMUNICATIONS.

ARGUMENT

THE USE OF SIMILAR MARKS ON HIGHLY RELATED GOODS AND SERVICES IS LIKELY TO CREATE CONFUSION AMONG CONSUMERS AS TO SOURCE

Section 2(d) of the Trademark Act bars registration where a mark so resembles a registered mark, that it is likely, when applied to the goods and services, to cause confusion, or to cause mistake or deceive. TMEP section 1207.01. The Court in *In re E.I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), listed the principal factors to consider in determining whether there is a likelihood of confusion. Among these factors are the similarity of the marks as to appearance, sound, meaning and commercial impression and the similarity of the goods and services. The overriding concern is to prevent buyer confusion as to the source of the goods and services. *Miss Universe, Inc. v. Miss Teen U.S.A., Inc.*, 209 USPQ 698 (N.D. Ga. 1980).

Therefore, any doubt as to the existence of a likelihood of confusion must be resolved in favor of the registrant. *Lone Star Mfg. Co. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974).

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods and services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

A. The Marks are Very Similar and the dominant feature of the registrant's mark makes up the applicant's entire mark

The applicant seeks registration of the mark "**CELLPLAN.**" The mark in Registration No. 2014985 is "**CELLPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element).**"

In this case, the dominant feature or portion of the registrant's mark is the word "**CELLPLAN**", which is identical in appearance, sound and meaning with the applicant's mark. The examining attorney must look at the marks in their entireties under Section 2(d). Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of

confusion. *In re National Data Corp.*, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976). *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1988). TMEP §1207.01(b)(viii). “**CELLPLAN**” is intended as the dominant feature of the registered mark because of the manner in which the registrant displays the mark in large, bold letters that have been underlined. Therefore, the examining attorney reemphasized that the applicant and registrant’s marks are similar in appearance and in sound.

Accordingly, the mark “**CELLPLAN WIRELESS GLOBAL TECHNOLOGIES (and design element)**” is sufficiently similar to support a finding of likelihood of confusion.

The applicant disputes the examining attorney’s finding that the marks are sufficiently similar. The applicant argues that the design element of the registered mark coupled with the disclaimed word portion of the mark, “**WIRELESS GLOBAL TECHNOLOGIES**” and the stylization of the letters are sufficient to render the marks distinguishable from one another.

With respect to the design element of the mark, the Courts have consistently held that, when a mark consists of a word portion and a design portion, the word portion is more likely to be impressed upon a purchaser’s memory and to be used in calling for the goods or services. *In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987); *Amoco Oil Co. v. Amerco, Inc.*, 192 USPQ 729 (TTAB 1976). TMEP §1207.01(c)(ii). As for the applicant’s contention that the disclaimed part of the registrant’s mark is sufficient to render the mark distinguishable the examining attorney notes that while the examining attorney cannot ignore a disclaimed portion of a mark and must view marks in their entirety, one feature of a mark may be more significant

in creating a commercial impression. *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re El Torito Restaurants Inc.*, 9 USPQ2d 2002 (TTAB 1988); *In re Equitable Bancorporation*, 229 USPQ 709 (TTAB 1986). Disclaimed matter is typically less significant or less dominant. In this case, the most important part of the registrant's mark is the word "**CELLPLAN**", word which the consumers are likely to recall the registered mark by, and word which makes up the registrant's entire mark.

B. Applicant's Goods and Registrant's Services Are Closely Related

The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods and services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

In this case, the applicant's goods are closely related to the registrant's services because the applicant offers computer software used in the telecommunication industry and the registrant offers design and installation services of computer software for use in telecommunications. The relevant goods and services travel in the same channels of trade, namely the telecommunications industry, and may be encountered by the same purchasers under circumstances that could give

rise to the mistaken belief that the computer software used in connection with wireless telephones and the design and installation of computer software for use in telecommunications come from a single source. It is fairly common for telecom and other large companies to use both their main regular mark, e.g. AT&T in connection with goods and services but to also use their mark in combination with descriptive and/or generic terminology such as WIRELESS OR DIGITAL. Because consumers are familiar with the practice of teaming a house mark with other more descriptive wording they are also likely to believe that in this case, the applicant did the same, namely, that the applicant used its house mark in connection with generic matter and that now it is seeking to only register its house mark without the generic matter. Therefore, the consumers are likely to believe that the goods of the applicant and the services of the registrant come from a single source. Accordingly, the goods and services in this case are sufficiently related to support a finding of likelihood of confusion.

The applicant suggests that there is no likelihood of confusion in this case because there is no evidence to support a finding that cellular phones are related to the telecommunications field. At this point the examining attorney would like to ask the Board to take judicial notice of the fact that cellular phone is encompassed in the definition for telecommunications. Intellect: The

exercise of the mind: Modes of communication: Communications

telecommunication (noun)

telecommunication

teleinformatics

long-distance communication, telephony, telegraphy, radio or wireless telegraphy, Comsat™

signaling, semaphore, morse, signal

cable, cablegram, telegram, wire, facsimile or fax, electronic mail, message

bush telegraph, grapevine, rumor

radar, discovery

loran

telex, teleprinter, tape machine, ticker

teleconferencing

videoconferencing
intercom, walkie-talkie, beeper
microphone, megaphone
headset, hearing aid
telephone, radio telephone, cellular phone or telephone, cordless phone or telephone, car telephone, videophone
line, trunk line, party line, hot line
extension
telephone exchange, switchboard
telephone operator, operator, wireless operator, ham, telegrapher¹

The applicant also argues that the examining attorney's reliance on the applicant's website to show that the applicant offers goods and services related to cell phones is inappropriate and that one should only look at the claim of its services and not at the scope of the registrant's business activities. The examining attorney disagrees with the applicant's arguments and notes the following. Cellular phones are telephones. The telecommunication industry encompasses all types of telephones, corded, cordless, cellular or not cellular. With respect to applicant's arguments that the examining attorney should have not submitted excerpts from the applicant's website and that it should have only relied on the identification submitted in this application, the examining attorney notes the following. First and foremost, it was the applicant who, on its communication dated October 30th, 2002, directed the examining attorney to the applicant's website. Since the applicant made references to and provided a web page address in its communication it cannot now argue that the examining attorney cannot also make reference to the information found on the website in question. The applicant is involved in most aspects of the telecommunication industry. The telecommunication field includes a broad array of goods and services. Since the applicant is very involved and recognized as a leader in the telecommunications industry, it is reasonable for the consumers to believe that the services

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offered by the registrant are actually offered by the applicant. As such, it is warranted for the examining attorney to show that likelihood of confusion will take place because of the applicant's broad spectrum covered by its business undertakings, evidence that is generally found on the applicant's website.

The applicant's attorney argues that there is no likelihood of confusion because the applicant's and registrant's goods and services are dissimilar. Thus the applicant would have the Board find that there should be no finding of likelihood of confusion unless the goods and services are identical. The examining attorney disagrees with the applicant's argument and notes the following.

Although the goods and services are not identical, they are highly related in that they are all in the nature of goods and services featuring software that is used in the field of telecommunications. The goods and services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The examining attorney must consider any goods or services in the registrant's normal fields of expansion to determine whether the registrant's goods or services are related to the applicant's identified goods or services under Section 2(d). *In re General Motors Corp.*, 196 USPQ 574 (TTAB 1977).

The registrant's services are design and installation of computer software for use in telecommunications. The applicant's goods are computer software used in connection with telecommunication services. Because so many manufacturers of computer software also provide supporting services, consumers will perceive the design and installation of computer software for use in telecommunications as being in the applicant's normal channels of trade. The applicant's goods are in the registrant's field of expansion. The District Court in *Guinness United Distillers & Vintners B.V. v. Anheuser-Busch Inc.*, 64USPQ2d. 1039 (DC SNY 2002) at p. 1044, in determining whether likelihood of confusion could occur between the mark Johnnie Walker Red Label for scotch whiskey and the mark Red Label From Budweiser for beer, noted that a trademark protects not only use for the goods that the applicant applied for but also for the goods that "might naturally be supposed to come from him." In this case it is natural to infer that the registrant's services might come from the applicant since the applicant is so well known in the telecommunications industry and since the applicant offers such a broad spectrum of supporting goods and services in that field. Therefore, it is safe to conclude that it is reasonable for a consumer to believe that the registrant has expanded use of its mark to also include goods listed by the applicant under its mark.

Additionally, the examining attorney notes that neither party has limited its channels of trade, thus the software and the design and installation of software services may be sold by the registrant and by the applicant everywhere. Therefore, the examining attorney must assume that the registrant's services and the applicant's goods are sold everywhere that is normal for such items to be sold.

CONCLUSION

In the instant case, the similarities between the marks and the goods and services are so great as to create a likelihood of confusion. The examining attorney must resolve any doubt regarding a likelihood of confusion in favor of the prior registrant. *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir., 1988).

For the foregoing reasons, the examining attorney respectfully requests that the refusal to register on the basis of Section 2(d) of the Trademark Act of 1946 (as amended), 15 U.S.C. Section 1052(d), be affirmed.

Respectfully submitted,



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