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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Deutsche Telekom AG

Serial No. 78492246

Joan L. Long of Mayer Brown Rowe & Maw LLP for Deutsche Telekom AG.

Caroline E. Wood, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Quinn, Bucher and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Deutsche Telekom AG seeks registration on the Principal Register of the mark **T-Mobile news express** (*standard character format*) for services recited in the application, as amended, as follows:

"telecommunication and information technology services, namely, electric, digital, cellular and wireless transmission of voice, data, information images, signals and messages and transmission of voice, data, images, audio, video and information via telephone, television and global communication networks; providing telecommunications connections over a global communications network, electronic mail, voice mail and messaging services, namely, the recording and subsequent transmission of voice messages by telephone;

rental of telecommunications equipment, namely, equipment for electronic access to global telecommunications network, equipment for transmitting, receiving, recording and monitoring voice, data, information images, signals, messages comprised of data and word processors, and telecommunications hardware components and peripherals thereof for use in the telecommunications industry, and rental of equipment for transmitting, receiving, recording and monitoring computer programs for use in operating and accessing telecommunications systems; audio and video broadcasting; providing multiple-user dial-up and dedicated access to the internet; personal communications services; pager services; transmission and broadcast of audio and video programming; leasing of telecommunications equipment, components and systems; providing information via the telephone and the global communication networks in the field of telecommunications; consulting in the field of telecommunications; telecommunications consulting services, namely, technical project planning services related to telecommunications equipment" in International Class 38.¹

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register applicant's mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining

¹ Application Serial No. 78492246 was filed on September 30, 2004, based upon applicant's claim of priority under Section 44(d) of the Lanham Act based on its application of April 2, 2004 in the Federal Republic of Germany, application no. 30418518338, applicant's claim as a basis for registration the registration that resulted therefrom, namely, German Reg. No. 30418518, issued on April 22, 2004, as well as applicant's allegations of a *bona fide* intention to use the mark in commerce, under Section 1(b) of the Act. No claim is made to the words "news express" apart from the mark as shown.

Attorney asserts that applicant's mark, when used in connection with the recited services, so resembles the trademark **NEWSEXPRESS** (*in standard character format*) registered in connection with:

"electronic telecommunications services, namely, the electronic transmission of messages and data, including but not limited to news, information and current events" in International Class 38,²

as to be likely to cause confusion, to cause mistake or to deceive.

Applicant and the Trademark Examining Attorney have fully briefed the case. We reverse the refusal to register.

The Trademark Examining Attorney points out that applicant has simply taken registrant's nearly identical mark, **NEWSEXPRESS**, and added its **T-Mobile** house mark to it. She argues that applicant's doing this actually exacerbates the likelihood of confusion, rather than serving to distinguish the marks.

By contrast, in arguing for registrability, applicant contends that "the primary and prominent term is the Applicant's protected **T-Mobile** mark," while the only

² Registration No. 2481085 issued to MediaLinx Interactive, Limited Partnership on August 28, 2001 under Section 44(e) of the Act based on Canadian Reg. No. TMA516050, issued on September 2, 1999.

similarity to the mark in the cited registration is secondary and disclaimed matter within this composite, and hence, there is no likelihood of confusion.

Likelihood of Confusion

We turn, then, to the issue of likelihood of confusion. Our determination of likelihood of confusion is 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). See also In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The services

We turn first to the du Pont factor focused on the relationship of the services as recited in the application and cited registration.

The Trademark Examining Attorney argues that the respective services herein are identical. Certainly, both recite telecommunications services, including wireless or electronic transmission of messages and other information.

We agree with applicant that in a registration having a recitation of electronic transmission of messages and data in International Class 38, the Office cannot expand the scope of protected services to preclude entry by any other user having the same or similar mark into any of the broad fields connected to telecommunication services. The analysis required under the Lanham Act to determine likelihood of confusion requires more than just an automatic refusal when the parties offer services in the same general business area.

However, with the possible exception of applicant's consulting services and technical project planning services, we find that the balance of applicant's telecommunication and information technology services are in part identical to and otherwise closely related to registrant's recited

services. That is, in finding applicant's range of services related to registrant's services, we do not limit ourselves to the more narrow subset of applicant's lengthy recitation of International Class 38 services that were highlighted in the Trademark Examining Attorney's brief.

On the other hand, we deny applicant's request to narrow the recitation of services to avoid a likelihood of confusion:

" ... A fair reading of the Examiner's brief and the bolding of certain terms must be read that the perceived overlap is limited to those areas and not the other services not offered by the Registrant. As such, even if the marks were considered confusingly similar, which Applicant strongly denies they are, the services that do not overlap with the cited registration should proceed to registration."

(Applicant's reply brief, p. 6). We cannot entertain an alternative amendment to the recitation of services where the refusal is based upon a likelihood of confusion. During *ex parte* examination, applicant was necessarily faced with the option of amending the recitation of services as a strategy for avoiding the Section 2(d) refusal. However, applicant failed unequivocally to propose a precise limiting amendment, and consequently, the Trademark Examining Attorney has not had the opportunity to examine any such possible "limitation." Accordingly, this request is denied.

Channels of trade and classes of purchasers

We have found that applicant's services, as recited in the application, are in part identical to and otherwise closely related to the services recited in the cited registration. We also find that registrant's and applicant's respective services are marketed in the same trade channels and to the same classes of purchasers, i.e., in all normal trade channels and to all normal classes of purchasers for such services. Hence, on these two related du Pont factors -- the similarity of established, likely-to-continue trade channels and the conditions under which and buyers to whom sales will be made -- we find that the same classes of ordinary consumers would find these services offered through the same channels of trade, and hence, these two factors also favor the position of the Trademark Examining Attorney.

The marks

We turn then to the du Pont factor focusing on the similarities and dissimilarities of the marks, viewing both marks in their entirety, in terms of appearance, sound, connotation and commercial impression. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

The marks are alike to the extent that they both include the similar wording "news express" / NEWSEXPRESS. However, we find that applicant's mark, taken as a whole, is quite dissimilar from registrant's mark. In reaching this conclusion, we agree with applicant that the marks must be compared in their entireties - not dissected before making a comparison, as did the Trademark Examining Attorney:

As to sound, the "NEWS EXPRESS" and "NEWSEXPRESS" portions of the marks are phonetic equivalents. Similarity in sound alone is sufficient to find a likelihood of confusion... In this case, the NEWS EXPRESS portion of the applicant's mark sounds identical to the registrant's mark NEWSEXPRESS.

As to meaning, connotation, and commercial impression, the marks are nearly identical. ... Here, the NEWS EXPRESS portion of the applicant's mark is nearly identical to the registered mark, NEWSEXPRESS. Because the commercial impression created by the marks is the same, there is a likelihood of confusion.

(Trademark Examining Attorney's appeal brief, unnumbered pp. 5 - 6). Rather, as applicant argues throughout, the marks are dissimilar in terms of sight, sound and meaning to the extent that applicant's mark begins with the term **T-Mobile**, which would be perceived to be applicant's house mark. In terms of commercial impression, although the word NEWSEXPRESS is the entirety of the commercial impression created by registrant's mark, in applicant's mark, the words

"news express" contribute less to the composite mark's commercial impression than does the house mark **T-Mobile**. Significantly, for our analysis, this term is the first portion of applicant's composite mark. We also note that the Trademark Examining Attorney, in her office action of May 4, 2005, takes the position that "[t]his wording ["news express"] is merely descriptive of the applicant's services which appear to comprise providing telecommunications NEWS in an EXPRESS manner." Accordingly, we agree with applicant and the Trademark Examining Attorney that the wording "news express" is an extremely weak source-identifier as applied to these telecommunication services, especially within applicant's composite mark.

We agree with applicant that the basic issue presented in this case is whether applicant's coupling of the term "news express" with its house mark **T-Mobile** suffices to avoid likelihood of confusion between the applicant's **T-Mobile news express** mark and registrant's mark NEWSEXPRESS. We find that it does.

As argued by the Trademark Examining Attorney, there are decisions holding that the addition of a house mark to one of two otherwise similar marks may not be of itself sufficient to avoid a likelihood of confusion in trade. On

the other hand, it misstates the rule of these cases to conclude that the house mark can be disregarded in the likelihood of confusion analysis. Rather, " ... each case requires consideration of the effect of the entire mark including any term in addition to that which closely resembles the [cited] mark." See Rockwood Chocolate Co., Inc. v. Hoffman Candy Company, 152 USPQ 599 (CCPA 1967).

We agree with applicant that "news express" is highly suggestive as applied to the telecommunication services recited in applicant's application. Furthermore, applicant argues that there is a recognizable difference between the product mark portions of applicant's and registrant's respective marks, i.e., "news express" (two words) versus NEWSEXPRESS (one combined term). We find then, that under our case law, applicant's addition of its house mark suffices to distinguish the two marks when they are viewed in their entireties. That is, based on the evidence in this record, we find that purchasers are able to distinguish among various "news express" marks by looking to other elements of the marks. In this case, that other element is applicant's house mark, **T-Mobile**.

We find that this dissimilarity of the marks, under the first du Pont factor, simply outweighs the evidence as to

the other factors that favor the position of the Trademark Examining Attorney. See Knight Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313 (TTAB 2005) [Applicant's NORTON MCNAUGHTON ESSENTIALS trademark for women's clothing is not confusingly similar to opposer's registered ESSENTIALS mark for similar goods]. In the instant case, as in Knight Textile, the house mark is deemed to be the primary and most distinctive element of the composite mark.

Having considered the evidence of record as it pertains to the relevant du Pont factors, we find that confusion is unlikely to result from contemporaneous use of registrant's NEWSEXRESS mark and applicant's **T-Mobile news express** mark, even where the marks are used on closely related, if not identical services, marketed in the same trade channels and to the same classes of consumers.

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