

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re CDS Freight Holding Ltd.

Serial No. 85009182

J. Tucker Barr of Arnall Golden Gregory LLP for CDS Freight Holding Ltd.

Brian Pino, Trademark Examining Attorney, Law Office 114
(K. Margaret Le, Managing Attorney).

Before Grendel, Cataldo and Ritchie,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

CDS Freight Holding Ltd. filed an application to register in standard characters on the Principal Register the mark CAPITAL DISTRIBUTION SERVICES for the following services, as amended: "freight logistics management" in International Class 35.¹

¹ Application Serial No. 85009182 was filed on April 8, 2010 based upon applicant's assertion of February 13, 2008 as a date of first use of the mark in commerce in connection with the services. DISTRIBUTION SERVICES is disclaimed apart from the mark as shown.

Registration has been finally refused pursuant to Trademark Act §2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark so resembles the mark CAPITAL TRANSPORTATION SOLUTIONS (in standard characters) in Registration No. 3671504² for "transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, planning and scheduling shipments for users of transportation services" in International Class 35, as to be likely, if used on or in connection with the identified services, to cause confusion, to cause mistake, or to deceive. Applicant and the examining attorney have filed briefs on the issue under appeal, including applicant's reply brief.

Likelihood of Confusion

Our determination under Trademark Act §2(d) is based upon an 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 and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311,

² Issued on August 25, 2009 with a disclaimer of TRANSPORTATION SOLUTIONS.

65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999), and cases cited therein.

We review the relevant *du Pont* factors as they apply to this case.

The Services

We begin by comparing applicant's services with those of registrant. In making our determination under the second *du Pont* factor, we look to the services as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

In this case, applicant's services are identified as "freight logistics management" and registrant's services

are identified as "transportation logistics services, namely, arranging the transportation of goods for others; transportation logistics services, namely, planning and scheduling shipments for users of transportation services."

In support of the refusal to register, the examining attorney made of record copies of use-based, third-party registrations reciting the services identified in the involved application and cited registration. The following examples are illustrative:

Registration No. 3901988 for services including "Freight logistics management; Transportation logistics services, namely, arranging the transportation of goods for others; Transportation logistics services, namely, planning and scheduling shipments for users of transportation services;"

Registration No. 3802702 for services including "Freight logistics management; Transportation logistics services, namely, arranging the transportation of goods for others; Transportation logistics services, namely, planning and scheduling shipments for users of transportation services";

Registration No. 3798456 for services including "Freight logistics management; Transportation logistics services, namely, arranging the transportation of goods for others; Transportation logistics services, namely, planning and scheduling shipments for users of transportation services"; and

Registration No. 3854534 "Transportation logistics services, namely, arranging the transportation of goods for others; logistics services, namely, freight logistics management."

These registrations suggest, in general, that applicant's freight logistics management services are related to registrant's transportation logistics services. See *In re Infinity Broadcasting Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001). Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source. See, e.g., *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467, 1470 at n. 6 (TTAB 1988).

The examining attorney further made of record evidence from commercial Internet websites showing services of a type offered by both applicant and registrant under the same marks. These websites include dsi-tms.com, grissomandassociates.com, myshippingdesk.com, and tempologistik.com. Such evidence serves to demonstrate that third parties are using a single mark to identify applicant's types of services as well as those of registrant.

Based upon the evidence made of record by the examining attorney, we find that registrant's services are related to those provided by applicant.

Channels of Trade

Furthermore, inasmuch as neither applicant's nor registrant's recitation of services recites any limitations to any specific channels of trade, we presume an overlap and that the services would be offered in all ordinary trade channels for these services and to all normal classes of purchasers. See *In re Linkvest S.A.*, 24 USPQ2d 1716 (TTAB 1992). See also *Octocom Systems, Inc. v. Houston Computers Services Inc.*, *supra*. We note in addition that the Internet evidence made of record by the examining attorney supports a finding that applicant's types of services move in the same trade channels as services of the type identified in the cited registration.

Based upon the foregoing, both applicant's and registrant's services appear to move in the same channels of trade and be available to the same classes of potential consumers. See *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

The Marks

We now consider whether applicant's mark and registrant's mark are similar or dissimilar when viewed in

their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). It is a well-established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, 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 the ultimate conclusion rests on a consideration of the marks in their entireties. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, applicant's mark, CAPITAL DISTRIBUTION SERVICES, is similar to registrant's mark, CAPITAL TRANSPORTATION SOLUTIONS, in that both marks share the word CAPITAL as the leading and most distinctive feature thereof. The dissimilar wording, i.e. DISTRIBUTION SERVICES and TRANSPORTATION SOLUTIONS, is at best descriptive of the recited services and has been disclaimed in the respective marks.

With regard to CAPITAL, applicant made of record a list of 100 third-party applications and registrations from the United States Patent and Trademark Office's Trademark Electronic Search System (TESS) database displaying marks

containing the term CAPITAL along with additional wording. The listing provides only the marks, the serial numbers and registration numbers of the applications and registrations, and their status as live or dead. However, it is settled that a mere listing of third-party marks, without any accompanying indication of the goods and/or services associated therewith, has virtually no probative value. See TBMP § 1208.02 (3d ed. 2011), and the authorities cited therein. Further, the expired registrations and pending and abandoned applications are also of no value. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ2d 1307, 1309 (Fed. Cir. 1989) ("[A] cancelled registration does not provide constructive notice of anything"), and the applications show only that they have been filed. *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003). For that reason, the listing is not probative of the relative strength of the term CAPITAL as applied to the involved services.

Thus, the sole distinctive term in both marks is CAPITAL. Furthermore, we note that CAPITAL, the word which the marks share in common, is also the first word in the marks. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("...[it is] a matter of some importance since it is often the first part of a mark which

is most likely to be impressed upon the mind of a purchaser and remembered."). See also *Palm Bay Imports*, 73 USPQ2d at 1692 ("The presence of this strong distinctive term as the first word in both parties' marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of ROYALE.").

In addition, consumers are often known to use shortened forms of names and, particularly because in both marks the ensuing wording is merely descriptive of the services provided, it is highly likely that both applicant and registrant and their services are referred to as CAPITAL. Cf. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 219 (CCPA 1978) [Rich, J., concurring: "the users of language have a universal habit of shortening full names - from haste or laziness or just economy of words"]. As for the presence of DISTRIBUTION SERVICES and TRANSPORTATION SOLUTIONS in the marks, these descriptive terms follow the distinctive term CAPITAL and thus are less visually prominent. Consumers are likely to regard these terms as less important, and refer to the marks as CAPITAL. See *Big M. Inc. v. United States Shoe Corp.*, 228 USPQ 614, 616 (TTAB 1985) ("[W]e cannot ignore the propensity of consumers to often shorten trademarks.")

Viewing the marks in the involved application and cited registration as a whole, we find that the identity of the dominant feature thereof, namely, the word CAPITAL, in appearance, sound and meaning results in the marks conveying similar overall commercial impressions. In other words, we view the marks as variations of each other, but pointing to the same source. We note that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *See Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Sophistication of Consumers

Applicant argues that the involved services, by their very nature, would be purchased by sophisticated and careful consumers. However, even conceding that the recitations inherently suggest that the services will be purchased solely by sophisticated buyers, there is nothing in the record to support a finding that the services and

purchasing process are of such a nature that purchasers could distinguish such similar marks for closely related services. *See, e.g., Electronic Design & Sales, Inc. v. Electronic Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992) (record confirms that opposer's services are expensive and are purchased only by experienced corporate officials after significant study and contractual negotiation and that the evaluation process used in selecting applicant's products requires significant knowledge and scrutiny). Furthermore, as is frequently stated, even if consumers are knowledgeable in a particular field that does not necessarily mean that they are immune from source confusion where the marks and goods or services at issue are similar. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988).

Third-Party Application for CAPITAL-formative Mark

We address one final argument made by applicant. A third-party application for the mark CAPITAL CARGO³ was made of record by applicant in support of its position that if such mark may be registered over the mark in the cited registration, so should applicant's involved mark. While neither the application nor registration involved herein

³ Application Serial No. 85055575.

was cited as a bar to the registration of this third-party application, we simply are not bound by the decisions of examining attorneys. The Board must make its own findings of fact, and that duty may not be delegated by adopting the conclusions reached by an examining attorney. *In re Sunmarks, Inc.*, 32 USPQ2d 1470, 1472 (TTAB 1994); and *In re BankAmerica Corp.*, 231 USPQ 873, 876 (TTAB 1986).

Summary

Neither applicant nor the examining attorney has discussed any of the remaining *du Pont* factors. We note, nonetheless, that none seems to be applicable, inasmuch as we have no evidence with respect to them. Accordingly, we find the others to be neutral in our analysis.

In light of the foregoing, we conclude that consumers familiar with registrant's services sold under its above-referenced mark would be likely to believe, upon encountering applicant's services rendered under its mark that the services originated with or are associated with or sponsored by the same entity.

Lastly, to the extent that any of the points raised by applicant raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. See *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's*

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Famous Pastry Shoppe, Inc., 748 F.2d 165, 223 USPQ 1289
(Fed. Cir. 1984).

Decision: The refusal to register is affirmed.