

This Opinion is Not a
Precedent of the TTAB

Mailed: September 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In Re TriStar History and Preservation Inc.

Serial Nos. 86078454 and 86111943

Christopher M. DeBacker of the Law Office of Mark Brown LLC,
for TriStar History and Preservation Inc.

Caitlin Watts-FitzGerald, Trademark Examining Attorney, Law Office 111,
Robert L. Lorenzo, Managing Attorney.

Before Bucher, Lykos and Adlin,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

TriStar History and Preservation Inc. (“Applicant”) seeks registration of the two
marks shown below



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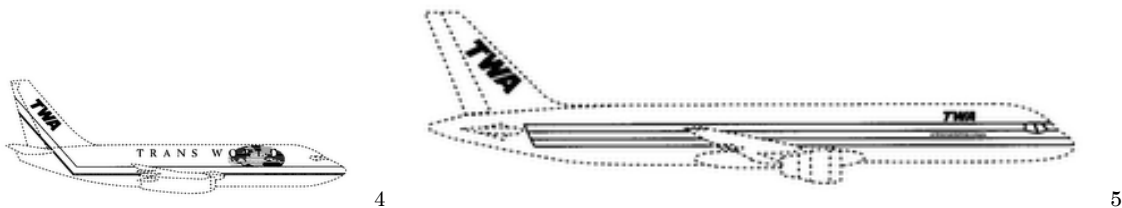


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¹ Application Serial No. 86078454, filed September 30, 2013, under Section 1(b) of the Trademark Act, based on an alleged intent to use the mark in commerce. The registration includes this description of the mark: “The mark consists of two overlapping globes with

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for “Air transportation of passengers and freight.” The Examining Attorney refused registration under Section 2(d) of the Act on the ground that Applicant’s marks so resemble four marks registered to American Airlines Inc. (“Registrant”) for various types of model airplanes that use of Applicant’s marks in connection with Applicant’s services is likely to cause confusion or mistake or to deceive. The cited American Airlines marks are TWA in typed form³ and the three marks shown below



meridians and parallels located in the space where the two globes overlap. The letters T, W, and A located in the center of the overlapping globes in a bold and italicized font.”

² Application Serial No. 86111943, filed November 6, 2013 under Section 1(b) of the Act.

³ Registration No. 2615260, issued September 3, 2002, for “toys, namely, model airplanes made of plastic and metal.” Renewed.

⁴ Registration No. 2736074, issued July 15, 2003, for “toys, namely model airplanes made of plastic, wood and metal.” Renewed. The registration includes this description of the mark: “The mark consists of the words ‘TRANS WORLD’ as well as a fanciful depiction of the world map appear on the sides of the airplane. The letters ‘TWA’ appear on the rear tale wing of the airplane. The belly of the airplane is blue with a red solid stripe appearing on top of the blue. The applicant is not claiming those portions of the drawing that appear in broken/dotted lines as part of the mark.” Color is not claimed as a feature of the mark.

⁵ Registration No. 2746294, issued August 5, 2003, for “Scale model airplanes.” Renewed. The registration includes this description of the mark: “The mark consists of three stripes of equal weight, positioned on both sides of the aircraft. The stripes are blue at the top, white in the middle and red at the bottom. In addition, the phrase ‘TWA’ is lined for the color red. and outlined in the color white and is positioned in the front and on both sides of the aircraft and on the tail of both sides of the aircraft. The drawing also consists of the phrase ‘AN AMERICAN AIRLINES COMPANY’. This phrase is blue except for the word ‘AMERICAN’ which is red. This phrase is located toward the front of the aircraft below the letters ‘TWA’ and above the blue, white and red stripes. The remaining body of the entire aircraft is polished silver.” Color is not claimed as a feature of the mark.



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After the refusals became final, Applicant appealed and Applicant and the Examining Attorney filed briefs.⁷

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”).

⁶ Registration No. 3038805, issued January 10, 2006, for “scale model airplanes” (sic). Section 8 Affidavit accepted, Section 15 Affidavit acknowledged. The registration includes this description of the mark: “The body, wings and engine of the plane are silver. There are three (3) stripes placed horizontally along the plane. The stripes are blue, white and red in descending order. The letters ‘T-W-A’ are red outlined in white.” Color is not claimed as a feature of the mark.

⁷ The Examining Attorney’s objection to the attachments to Applicant’s Appeal Brief is sustained and the materials have been given no consideration because they are untimely. Trademark Rule 2.142(d).

Turning first to the marks, we must compare them “in their entirety as to 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, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). That is, we may not dissect the marks into their various components. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985); *see also Franklin Mint Corp. v. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 233, 234 (CCPA 1981).

Applicant’s stylized TWA word mark is virtually identical to the cited mark TWA in typed format.⁸ Indeed, there is nothing distinctive about Applicant’s stylization, and in any event, because the cited mark is in typed form, it may be displayed in the same stylized format as Applicant’s mark. *See, e.g., In re Viterro*, 101 USPQ2d at 1909 (citations omitted). In other words, the marks look virtually identical, sound identical and convey identical meanings.

While Applicant’s other mark includes “two overlapping globes with meridians and parallels located in the space where the two globes overlap,” it also, quite prominently, includes “[t]he letters T, W, and A located in the center of the overlapping globes *in a bold and italicized font*” (emphasis supplied). It is settled that where, as here, a mark is comprised of a literal element and a design, such as Applicant’s TWA design mark, the literal element is normally accorded greater

⁸ There is no substantive difference between “standard character” marks and marks in “typed” form. *In re Viterro Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 n.2 (Fed. Cir. 2012) (“until 2003, ‘standard character’ marks formerly were known as ‘typed’ marks, but the preferred nomenclature was changed in 2003 to conform to the Madrid Protocol ... we do not see anything in the 2003 amendments that substantively alters our interpretation of the scope of such marks”).

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weight, because consumers are likely to remember and use the words, term or acronym to request the goods or services. *See id.* at 1911 (“the verbal portion of a word and design mark likely will be the dominant portion”); *see also, In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987) (holding that “if one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services” and “because applicant’s mark shares with registrant’s mark that element responsible for creating its overall commercial impression, the marks are confusingly similar”). The dominance of the initialism TWA in Applicant’s globe design mark is only reinforced by its appearance, as Applicant describes it, “in a bold and italicized font.” In short, Applicant’s globe design mark looks similar to TWA in typed form, sounds identical and conveys a highly similar meaning.

While Applicant’s marks are less similar to Registrant’s TWA design marks, the fact remains that TWA is the dominant element of not only Applicant’s globe design mark but also the cited marks in Registration Nos. 2746294 and 3038805, because the “three stripes” in each of these marks are not in any way distinctive and “TWA” appears twice in each of these marks. While the mark in Registration No. 2746294 also includes the phrase “AN AMERICAN AIRLINES COMPANY,” this phrase merely highlights the fact that TWA is the ongoing source of the model airplanes, and that it is part of American Airlines. As for the mark in Registration No. 2736074, the words “TRANS WORLD” do not meaningfully distinguish it from Applicant’s mark because this merely indicates what the TWA initialism stands for, and that TWA/Trans World Airlines is the source of the model airplanes, while the

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“world map” design is not distinguishing because Applicant’s design mark contains “two overlapping globes,” which are essentially a type of “world map.” In short, while there are more differences between Applicant’s marks and Registrant’s design marks than Registrant’s typed mark, Applicant’s marks and Registrant’s design marks are still more similar than different, in how they look and sound and in the meaning they convey.

Furthermore, given the close similarity between Applicant’s design mark and Registrant’s cited typed mark, and that Applicant’s stylized mark is virtually identical to the cited typed mark, this factor not only weighs heavily in favor of a finding of likelihood of confusion, but also reduces the degree of similarity between the goods and services that is required to support a finding of likelihood of confusion, at least with respect to Registrant’s typed mark. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1661 (TTAB 2002); and *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Turning to the goods and services and channels of trade, at first glance the only relationship between Applicant’s “air transportation of passengers and freight” and Registrant’s model airplanes is that both relate to aviation in some manner. However, the Examining Attorney has established that the relationship is deeper than that. Specifically, she introduced evidence that United Airlines, US Airways and American Airlines⁹ not only sell model airplanes, but do so on the same websites through which they also sell services including “air transportation of

⁹ We do not require evidence to recognize these as major, well-known airlines.

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passengers.” Furthermore, their model airplanes bear the same marks under which the airlines sell “air transportation of passengers.” The following webpages introduced by the Examining Attorney are either part of, or accessible directly through, the airlines’ websites which sell air transportation services:

http://unitedshop.summitmq.com/unitedshop/dept.asp?dept_id=11000 01/15/2014 03:35:24 PM


The screenshot displays the United Shop website interface. At the top, there is a navigation bar with links for Home, Login, My Account, Cart, FAQ, Contact Us, and Go to united.com. Below this is a search bar labeled "Keyword/Item #". The main navigation menu includes Model Airplanes, Travel, Apparel, Merchandise, Sale, and New Arrivals. The "Model Airplanes" section is currently selected, and the sort option is set to "Item Number".

The "Model Airplanes" section features a grid of product listings, each with an image of a model airplane, its name, scale, and price:

Model Airplane	Scale	Price
737-800 with Winglets	1/130 Scale	\$24.50
747-400 Business Class	1/144 Scale	\$198.00
747-400 Business Class	1/200 Scale	\$138.00
747-400 First Class		\$346.00
777-200 Business Class	1/144 Scale	\$184.00
777-200 Business Class	1/200 Scale	\$124.00
777-200 First Class		\$326.00
787-8 Business Class	1/144 Scale	\$198.00
787-8 Dreamliner Premium Economy	1/200 Scale	\$31.00
787-8 First Class	1/100 Scale	\$275.00

At the bottom of the page, there is a "Follow United" section with social media icons for Facebook and Twitter. To the right, there are logos for payment methods: MasterCard, Visa, American Express, and Discover. A link for "Security / Privacy Policy" is also present.

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MODELS
American Airlines
American Eagle
DC3
Gemini Jets
MUSEUM
SEASONAL
TECHNOLOGY ACCESSORIES
TOYS & GAMES
TRAVEL

Product Search
Use keywords to find the product you are looking for.
Go
☐ only in this category

NEW PRODUCTS!

Skymarks A319 1:150 Scale
\$38.00

14 products in this category, displaying products 1 to 14.

DESCRIPTION	PRICE	
 777-300 ER New Livery 032031 SkyMarks 777-300 ER with the new livery. Plastic 1:200 scale. Includes plastic base. Approximately 15 1/2" L x ... \$58.00	add to basket	
 AA 757-200 1/200 Scale Plastic 031170 757-200 plastic model with classic livery. 1:200 scale. Approximately 9"L x 7" W \$32.00	add to basket	
 Hot Wings AA 727 032003 Hot Wings AA 727 in classic livery. Die cast metal, approx 5" long. Includes connectable runway. \$8.99	add to basket	
 Hot Wings AA DC-10 032001 Hot Wings AA DC-10 in classic livery. Die cast metal, approx 5" long. Includes connectable runway. \$8.99	add to basket	
 Skymarks A319 1:150 Scale NEW! 032041 Airbus A319 plastic model by SkyMarks, 1:150 scale. Includes plastic base. Approximately 9 1/2" L x 9" W. INTEND... \$38.00	add to basket	
 TM 707 Astrojet 707-320 Astrojet 1:100 scale Handcrafted mahogany aircraft with hand painted graphics. Stand included. This item has a... \$175.00	add to basket	
 TM 737 w/winglets Classic 1:100 030104 737 with Winglets in the Classic livery. 1:100 Scale Handcrafted mahogany aircraft with hand painted graphics. S... \$225.00	add to basket	
 TM 757-200 Winglets Clas 1:100 030103 757-200 with Winglets in the Classic livery. 1:100 scale Handcrafted mahogany aircraft with hand painted graphics... \$225.00	add to basket	
 TM 767-300 Classic 1:100 Scale 030064 767-300 with the Classic livery. 1:100 Scale. 18" wingspan Handcrafted mahogany aircraft with hand painted graphi... \$225.00	add to basket	
 TM 777-200 Classic Livery 1:100 scale 030046 TM 777-200 Classic Livery 1:100 scale Handcrafted mahogany aircraft with hand painted graphics. Stand included.... \$250.00	add to basket	
 TM Convair 990 030053 AA Convair 1:100 Scale 17" long by 15" wingspan width Handcrafted mahogany aircraft with hand painted graphics. ... \$175.00	add to basket	
 TM MD80 Classic 1:100 Scale 030062 MD80 in the Classic livery. 1:100 Scale 17" long by 15" wingspan. Handcrafted mahogany aircraft with hand painted... \$195.00	add to basket	
 TM Spirit of St Louis 1:32 Spirit of St. Louis 1:32 scale Handcrafted mahogany aircraft with hand painted graphics. Stand included. This item has a... \$150.00	add to basket	
 TM Tri motor 1/48 Scale 030038 Ford AT-5C Tri motor. 1:48 Scale Handcrafted mahogany aircraft with hand painted graphics. Stand included. Th... \$165.00	add to basket	

Shopping Cart

0 items

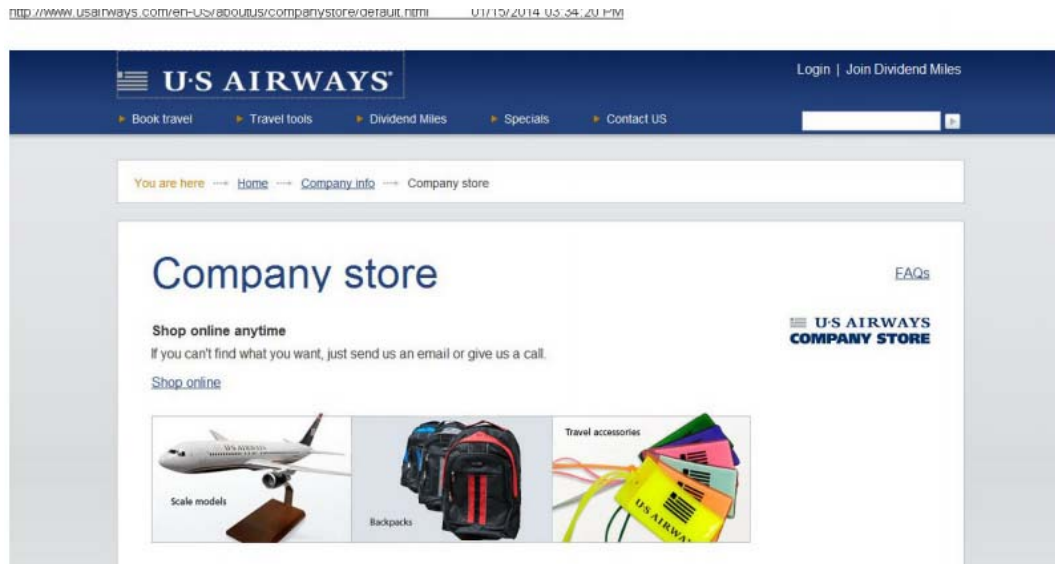
Customer Login

Username:

Password:

loginregister

forgot your password?



In many cases, a mere three examples of a relationship between the goods and services and channels of trade might not be particularly persuasive standing alone. However, we must account for the field and industry at issue, in this case aviation and airlines. We do not require evidence to know that by its nature, aviation is exceedingly difficult and expensive. Accordingly, the airline industry's barriers to entry are substantial, and in fact insurmountable for all but a few. We do not require evidence to know that there are a small number of major airlines. Therefore, the Examining Attorney's three examples of relatedness are more than sufficient in the oligopolistic airline industry.

Furthermore, we cannot ignore that Applicant's marks display TWA in what appears to be the exact same font and style as the "TWA" appearing on the tails of the airplanes comprising the designs in cited Registration Nos. 2736074, 2746294 and 3038805. Consumers aware that major airlines sell model planes and familiar with Registrant's cited marks will be likely, upon seeing that the TWA in Applicant's marks is presented in the same manner as the TWA on the tails of

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Registrant's design marks, to assume a connection between the sources of Applicant's services and Registrant's goods. *See Monogram Models, Inc. v. Ford Motor Company*, 176 USPQ 498 (TTAB 1972) (finding likelihood of confusion from use of same mark for full-sized automotive vehicles and scale model assembly kits for automobiles).

"Even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services." *Hewlett-Packard Co. v. Packard Press Inc.*, 227 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000) ("even if the goods in question are different from, and thus not related to, one another in kind, the same goods can be related in the mind of the consuming public as to the origin of the goods"). Here, the evidence establishes that the goods and services are related and move in the same channels of trade. These factors therefore also weigh in favor of a finding of likelihood of confusion.

Applicant argues that there is no likelihood of confusion between the goods and services because it is a

nonprofit entity with the intent to transport passengers and freight for the purposes of education and historical preservation. Thus, [Applicant's] audience, consumers of the services with which [Applicant's] mark is used, are those individuals and businesses interested in historical preservation of aircraft and the aircraft industry in the United States. [Applicant] will be intimately involved in interaction with its customers and participants, and there would be no source confusion involved with customers and participants who are using the [Applicant's] services.

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Applicant's Appeal Brief at 3. We are not persuaded. As the Examining Attorney points out, "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application, regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." *Octocom Systems, Inc. v. Houston Computers Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). In other words, we must base our decision on the "air transportation of passengers" services identified in the applications, which the evidence shows are offered on airline websites with model airplanes which bear the same mark.

Finally, Applicant argues that confusion is unlikely because the relevant consumers are sophisticated and careful. While we accept that consumers of air transportation will exercise at least some care, that is not enough to prevent confusion in this case, because the relevant consumers, *i.e.*, members of the general public, are also accustomed to airlines providing these services as well as model airplanes, and because Applicant's marks are so similar to the cited marks. In any event, even assuming that this factor weighs against a finding of likelihood of confusion, it is outweighed by the similarities between the marks, the relatedness of the goods and services and the overlapping channels of trade.

Conclusion

Applicant's marks and Registrant's typed mark are quite similar as their dominant, literal element is virtually identical, and there are more similarities than dissimilarities between Applicant's marks and Registrant's design marks.

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Furthermore, the goods and services identified in the applications and cited registrations are related and move in overlapping channels of trade.

Decision: The Section 2(d) refusals to register Applicant's marks are affirmed.