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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91201920
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**IN THE U.S. PATENT AND TRADEMARK OFFICE  
The Trademark Trial and Appeal Board**

Serial No. 85/219,849,  
For the mark CITIAIR and design,

Citigroup, Inc.,	:	
	:	
Opposer,	:	Opposition No. 91201920
	:	
vs.	:	Public Submission
	:	Trade Secret and
Citair, LLC,	:	Commercially Sensitive
	:	Information Redacted
Applicant.	:	

**TRIAL BRIEF OF APPLICANT CITIAIR, LLC**  
**(PUBLIC SUBMISSION - REDACTED)**

**TABLE OF CONTENTS**

TABLE OF AUTHORITIES.....iii

PRELIMINARY STATEMENT..... 1

THE RECORD BEFORE THE BOARD.....2

MOTION TO STRIKE EVIDENCE ..... 3

STATEMENT OF FACTS.....7

    A. CitiAir, LLC.....7

        1. Mr. Prakash Raj.....7

        2. The Founding of CitiAir Singapore and The Selection of the CitiAir  
           Trademark.....7

        3. Founding of CitiAir, LLC in the U.S.....9

        4. The CitiAir Mark.....10

        5. CitiAir’s Travel Services.....10

        6. CitiAir’s Advertising.....11

        7. CitiAir’s Channels of Trade.....13

        8. Absence of Actual Confusion.....14

    B. Citigroup Inc.....14

        1. Citibank Financial Institution.....14

        2. Citibank’s Financial Services.....14

        3. CitiBank’s Value Propositions for Its Financial Services.....15

        4. Travel Service Companies Are Not Citibank’s Competitors.....16

        5. Citibank Only Offers Traditional Banking Services to NRIs.....17

        6. Citibank’s Lack of Evidence of Fame.....18

        7. Citibank’s Advertising.....20

        8. Citibank’s Channels of Trade.....21

ARGUMENT.....23

I. REGISTRATION OF THE CITIAIR MARK WOULD NOT CREATE  
A LIKELIHOOD OF CONFUSION WITH CITIBANK’S CITED  
TRADEMARKS.....23

    A. THE MARKS CREATE SEPARATE AND DISTINCT  
    COMMERCIAL IMPRESSIONS.....23

B. CITIBANK’S ALLEGED “FAMILY OF MARKS” IS IRRELEVANT AS CITIBANK DOES NOT OFFER TRAVEL BOOKING AGENCY SERVICES.....	26
C. THERE IS NO OVERLAP IN THE SERVICES OF THE RESPECTIVE PARTIES.....	27
D. CITIBANK HAS FAILED TO ESTABLISH ITS MARK IS FAMOUS IN THIS CASE.....	32
E. THERE IS NO OVERLAP IN THE MARKETING OF THE RESPECTIVE MARKS.....	35
F. THERE IS NO OVERLAP IN THE PARTIES’ RESPECTIVE TRADE CHANNELS.....	40
G. THERE IS HAS BEEN NO ACTUAL CONFUSION IN THE MARKETPLACE.....	42
H. BALANCING OF <i>DU PONT</i> FACTORS.....	42
II. REGISTRATION OF THE CITIAIR APPLICATION IS NOT LIKELY TO DILUTE OPPOSER’S TRADEMARKS.....	44
A. CITIBANK HAS FAILED TO ESTABLISH THAT ITS TRADEMARKS ARE FAMOUS.....	45
B. WHETHER OPPOSER'S CITIBANK MARKS BECAME FAMOUS PRIOR TO APPLICANT'S.. DATE OF CONSTRUCTIVE USE OF ITS CITIAIR AND PLANE DESIGN MARK.....	46
C. WHETHER APPLICANT'S CITIAIR AND PLANE DESIGN MARK IS LIKELY TO CAUSE DILUTION BY BLURRING THE DISTINCTIVENESS OF OPPOSER'S CITIBANK MARKS.....	46
CONCLUSION.....	48
CERTIFICATE OF SERVICE .....	49

**TABLE OF AUTHORITIES**

**CASES**

	<u>Page(s)</u>
<i>Blansett Pharmaceutical Co. Inc. v. Carmrick Laboratories Inc.</i> , 25 USPQ2d 1473 (TTAB 1992).....	26
<i>Bose Corp. v. QSC Audio Products Inc.</i> , 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002).....	32
<i>Canadian Imperial Bank v. Wells Fargo Bank</i> , 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).....	27
<i>Central Soya Co., Inc. v. North American Plant Breeders</i> , 212 USPQ 37 (TTAB 1981).....	42
<i>Coach Services Inc. v. Triumph Learning LLC</i> , 96 USPQ2d 1600 (TTAB 2010).....	45
<i>Colgate-Palmolive Co. v. Carter-Wallace, Inc.</i> , 167 U.S.P.Q. 529 (C.C.P.A. 1970).....	24
<i>Cunningham v. Laser Golf Corp.</i> , 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).....	27
<i>Econo-Travel Motor Hotel Corp. v. Econ-O-tel of America, Inc.</i> , 199 USPQ 307 (TTAB 1978).....	26
<i>Flagstar Bank, FSB, vs. Freestar Bank, N.A.</i> , 687 F. Supp. 2d 811; 2009 U.S. Dist. LEXIS 106106 (D.C. Cen IL 2009).....	39
<i>FW Omnimedia Corp. et al. vs. Toyota Motor Sales, U.S.A., Inc.</i> , 2004 U.S. Dist. LEXIS 27464; 73 U.S.P.Q.2D (BNA) 1667 (D.C. Cen. D. CA 2004).....	39
<i>H.D. Lee Co. v. Maidenform Inc.</i> , 87 USPQ2d 1715 (TTAB 2008).....	23
<i>In re E. I. du Pont de Nemours &amp; Co.</i> , 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).....	23
<i>In re Majestic Distilling Company, Inc.</i> , 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).....	23
<i>In re Norfolk Wallpaper, Inc.</i> , 216 U.S.P.Q. 903 (T.T.A.B. 1983).....	24
<i>In re Texas Instruments, Inc.</i> , 193 U.S.P.Q. 678 (T.T.A.B. 1976).....	24

	<u>Page(s)</u>
<i>In re Vogue Tyre &amp; Rubber Co.</i> , 176 U.S.P.Q. 189 (T.T.A.B. 1972).....	24
<i>Interstate Brands Corp. v. Celestial Seasonings, Inc.</i> , 198 U.S.P.Q. 151 (C.C.P.A. 1978).....	24
<i>J&amp;J Snack Foods Corp. v. McDonald’s Corp.</i> , 18 U.S.P.Q. 2d 1889, 932 F.2d 1460 (Fed. Cir. 1991).....	26
<i>Kenner Parker Toys v. Rose Art Industries</i> , 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).....	32, 34-5, 45
<i>Lacoste Alligator S.A. v. Maxoly Inc.</i> , 91 USPQ2d 1594 (TTAB 2009).....	32
<i>Leading Jewelers Guild Inc. v. LJOW Holdings LLC</i> , 82 USPQ2d 1901 (TTAB 2007).....	32
<i>McGregor-Doniger, Inc. v. Drizzle Inc.</i> , 202 U.S.P.Q. 81 (2 <sup>nd</sup> Cir. 1979).....	24
<i>National Pork Board v. Supreme Lobster and Seafood Co.</i> , 96 USPQ2d 1479 (TTAB 2010).....	46
<i>Nike Inc. v. Maher</i> , 100 USPQ2d 1018 (TTAB 2011).....	46
<i>Ortiz-Lopez v. Sociedad Espanola de Auxilio Mutuo y Beneficiencia de Puerto Rico</i> , 248 F.3d 29 (1st Cir. 2001).....	5
<i>Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772</i> , 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).....	23
<i>Porta-Tool, Inc. v. DND Corp.</i> , 196 USPQ 643 (TTAB 1977).....	26
<i>Recot Inc. v. M.C. Becton</i> , 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).....	32
<i>The Sports Authority Michigan, Inc. v. The PC Authority, Inc.</i> , 2002 TTAB LEXIS 65; 63 U.S.P.Q.2D (BNA) 1782.....	42
<i>Toro Co. v. ToroHead Inc.</i> , 61 USPQ2d 1164 (TTAB 2001).....	45
<i>Yeti by Molly, Ltd. v. Deckers Outdoor Corp.</i> , 259 F.3d 1101 (9th Cir. 2001).....	4-5

STATUTES AND RULES

	<u>Page(s)</u>
15 U.S.C. § 1063.....	44
15 U.S.C. § 1125(c) .....	44-7
Fed R. Civ. P. 26(a).....	4
Fed R. Civ. P. 26(e)(1).....	4
Fed R. Civ. P. 37(c)(1).....	4

COMES NOW the Applicant, CitiAir, LLC (hereinafter “CitiAir”), by counsel, and respectfully submits its brief in opposition to the instant opposition proceeding instituted by Citigroup Inc. (hereinafter “Citibank”).

### **PRELIMINARY STATEMENT**

The instant matter comes before the Board on Citibank’s opposition to the registration of the CitiAir’s trademark for the term CITIAIR and design as displayed below (hereinafter “CitiAir Mark”):



The grounds for Citibank’s opposition are twofold: (1) registration of the CitiAir Mark would be likely to cause confusion with the registered trademarks owned and pleaded by Citibank and (2) registration of the CitiAir Mark would be likely to dilute the distinctiveness of Citibank’s pleaded registrations. CitiAir disputes these allegations.

As more fully set forth below, the *du Pont* factors weigh heavily in support of registration of the CitiAir Mark. The marks at issue create a separate and distinct commercial impression, especially among the relevant consuming public. The services of the parties are completely distinct. There is no overlap in marketing or trade channels and no evidence of actual confusion despite a duration of time during which actual confusion could have occurred.

In regard to dilution, Citibank has failed to carry its burden to establish that it is a famous mark and therefor entitled to such enhanced protection. Moreover, even assuming, *en arguendo*, the brand is

found to be famous, the evidence does not support a finding of a likelihood of dilution under the relevant act.

### **THE RECORD BEFORE THE BOARD**

The record before the Board includes the testimonial depositions of seven witnesses, six notices of reliances, as well as six pleaded federal trademark registrations of Citibank as set forth below:

#### **Trial Testimony**

<u>Witness</u>	<u>Title</u>	<u>Date</u>
1. Anne Moses, Esq.	Associate General Counsel, Citigroup	10/15/2012
2. Anthony Michellini	Director, Global Branding, Citigroup	10/16/2012
3. Mary Ann Villanueva	Director, Global Branding, Citigroup	10/16/2012
4. Asieh Nariman, Esq.	Vice President, Senior Counsel, Citigroup	10/16/2012
5. Mary Hines	Director, Head of ThankYou Rewards, Citigroup	10/23/2012
6. Jason Baum	Director, Head of Co-Brand Acquisitions, Citigroup	10/23/2012
7. Prakash Raj	Founder, CitiAir, LLC	12/13/2012

#### **Notices of Reliance**

<u>Submitting Party</u>	<u>Title</u>	<u>Filed</u>
Citibank	Opposer's Notice of Reliance	10/10/2012
Citibank	Opposer's Notice of Reliance – Confidential Information	10/10/2012
Citibank	Opposer's Amended and Supplemental Notice of Reliance	10/22/2012
Citibank	Opposer's Second Supplemental Notice of Reliance	10/31/2012
CitiAir	Applicant's First Notice of Reliance	12/28/2012
CitiAir	Applicant's Second Notice of Reliance – Confidential	12/28/2012

### **Citibank's Pledged Federal Trademark Registrations<sup>1</sup>**

<u>Trademark</u>	<u>U.S. Reg. No.</u>	<u>Registered</u>
CITIBANK	691,815	01/19/1960
CITI NEVER SLEEPS	1,104,470	10/17/1978
CITI	1,181,467	12/08/1981
CITIDIRECT	2,261,522	07/13/1999
CITIGROUP	2,406,753	11/21/2000
CITITRAVEL	2,954,363	05/24/2005

### **MOTION TO STRIKE EVIDENCE**

As a preliminary matter, CitiAir sets forth three motions to strike evidence offered by Citibank during the trial periods of this case. Based upon the following it is respectfully requested that the Board strike any and all evidence relating to evidence concerning advertising agencies used or employed by Citibank as having not been produced in discovery as well as striking Opposer's Exhibits 112 and 523 and any testimony thereon as lacking foundation and authenticity to be relied upon at the trial of this matter. Each matter is dealt with below in turn.

#### **1. Motion to Strike Reference to and Testimony Concerning Citibank Advertising Agencies**

During the discovery period of this matter CitiAir requested information concerning any advertising agencies Citibank used to market its goods and services. Specifically, on or about March 26, 2012 CitiAir served upon Citibank *Applicant's First Set of Interrogatories to Opposer*. Interrogatory 9 asked:

Identify all advertising agencies, public relations agencies or market research agencies that Opposer has used, participated with or cooperated with in advertising, marketing or promoting the goods/services identified in response to Interrogatory No. 3, and indicate the time period(s) during which such activities were conducted.

*Applicant's First Notice of Reliance*, Exhibit A, p. 9.

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<sup>1</sup> Citibank's pleaded registrations are made part of the record having been attached as exhibits to the initial *Notice of Opposition* pursuant to TBMP § 704.05(a).

On or about April 30, 2012 Citibank responded to CitiAir's interrogatories. However, rather than provide a response to interrogatory 9, Citibank lodged an objection providing no substantive response thereto. *Id.*

[REDACTED]

Under Rule 37(c)(1) of the Federal Rules of Civil Procedure, a party is generally precluded from using evidence not disclosed as required under Rule 26(e)(1).<sup>3</sup> Rule 37 provides that “[i]f a party fails to provide information . . . as required by Rule 26(a) or (e), the party is not allowed to use that information . . . to supply evidence on a motion, at a hearing, or at trial, unless the failure was substantially justified or harmless.” Fed. R. Civ. P. 37(c)(1). The burden of demonstrating that the failure is substantially justified or harmless falls on the offending party. *See Yeti by Molly, Ltd. v. Deckers Outdoor Corp.* 259 F.3d 1101, 1107 (9th Cir. 2001).

As noted by the Ninth Circuit in *Yeti*, Rule 37 is intended to provide a strong inducement for disclosure, and a “self-executing” and “automatic” sanction for the failure to produce material during the discovery process. *Id.* at 1106 (citing Fed. R. Civ. P. 37 advisory committee's note (1993) and noting

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<sup>2</sup> Counsel for CitiAir further renewed its motion at the close of Ms. Nariman's direct examination specifically referencing and reading into the record the discovery answer at issue and Citibank's failure to provide the evidence requested during the discovery period. (Nariman Tr. at 40:3-25; 41:1-15)

<sup>3</sup> Rule 26(e)(1) of the Federal Rules of Civil Procedure provides that litigants have a continuing duty to supplement or correct all interrogatory responses and requests for production if their prior responses are either incomplete or incorrect. Fed. R. Civ. P. 26(e)(1).

“particularly wide latitude” given to district courts to exclude evidence under this provision). “Courts have upheld the striking of such evidence even when the litigant’s entire cause of action or defense has been precluded.” *Id.* (citing *Ortiz-Lopez v. Sociedad Espanola de Auxilio Mutuo y Beneficiencia de Puerto Rico*, 248 F.3d 29, 35 (1st Cir. 2001)). Nor is it necessary to show willful intent on the part of the offending party; exclusion is an appropriate remedy in the absence of bad faith or an explicit court order. *See Yeti*, 259 F.3d at 1106.

Here the parties engaged in an extensive discovery process. Citibank produced over 13,000 pages of documents in this matter. Yet at no time prior to its trial testimony period did Citibank produce any evidence concerning advertising agencies as requested in CitiAir’s interrogatories.

Notwithstanding the same, Citibank surprised CitiAir at the testimonial deposition of Ms. Nariman by suddenly having the witness testify to the existence of an alleged advertising agency which had not been identified during discovery even though such information should have been provided in direct response to a properly propounded interrogatory.

CitiAir was denied the opportunity to properly prepare for the deposition of Ms. Nariman and the cross-examination of this witness by Citibank’s actions. Citibank had ample opportunity to disclose this information and to supplement its discovery responses but chose instead not to do so. Accordingly, the Board should strike any reference of record to advertising agencies provided by Citibank during the trial period of this matter pursuant to Fed. R. Civ. P. 37.

## **2. Motion to Strike Opposer’s Exhibit 112**

During his trial testimony Mr. Raj Opposer, by counsel, cross-examined Mr. Raj using Opposer’s Exhibit 112, a purported a screen capture from the website eknazar.com. (Raj Tr. at 63: 13-25; 64: 2-25; 65:2-4)

The exhibit was not produced by CitiAir nor authenticated by Mr. Raj. Citigroup sought to illicit testimony from Mr. Raj concerning an alleged search of the term “CitiAir” on the website eknazar.com and how it could purportedly produce a result that brought up Citibank’s pay-per-click advertising. (Raj

Tr. at 63: 13-25; 64: 2-25; 65:2-4) However, as Mr. Raj was not the person who had conducted the search, he could not verify the authenticity of the document, the alleged conditions under which the search took place, or the veracity of the results.

Ms. Nariman, Citibank's own witness, also testified as to Opposer's Exhibit 112. (Nariman Tr. at 18: 7-25) On cross-examination Ms. Nariman conceded that she did not run the search and did not know how keyword advertising specifically works or why a specific ad would be brought up during specific or broad target advertising. (Nariman Tr. at 42: 1-7; 43: 10-25; 44:1-25) Having now established that she could not authenticate the document nor the manner in which it was created counsel for CitiAir placed his formal objection on the record to the entry of this evidence on the record. (Nariman Tr. at 42: 9-25; 43: 1-8)

As such, CitiAir, by counsel, respectfully moves the Board for an order excluding Opposer's Exhibit 112 and any testimony thereon as lacking the proper foundation and authenticity.

### **3. Motion to Strike Opposer's Exhibit 523**

During the course of Mr. Baum's testimony Citibank attempted to introduce Opposer's Exhibit 523. Originally Exhibit 523 was offered as a press release issued by Citibank concerning the purported co-branding of Citibank and American Airlines credit cards. However, on cross examination, Mr. Baum conceded that the document was not, in fact, a press release issued by Citibank but rather an article written by a third-party about the alleged press release. (Baum Tr. at 53:7-24) Moreover, he conceded that he himself had not even printed or provided the article from the Lexis/Nexis database. (Baum Tr. at 53:25; 54:1-2)

At that time counsel for CitiAir lodged his objection to Opposer's Exhibit 523 on the grounds that Mr. Baum could not authenticate the document nor was he competent to testify to the contents of the same. The objection, based upon the record, is now timely renewed for the Board's consideration.

As such, CitiAir, by counsel, respectfully moves the Board for an order excluding Opposer's Exhibit 523 and any testimony thereon as lacking the proper foundation and authenticity to establish probative evidence at the trial of this matter.

## **STATEMENT OF FACTS**

### **A. CitiAir, LLC**

#### **1. Mr. Prakash Raj**

Mr. Prakash Raj (hereinafter "Mr. Raj") was born in India on December 13, 1972. (Raj Tr. at 7:15-24). He was raised in India and spent the first 24 years of his life in therein. (Raj Tr. at 6:20-24; 8:11-12; 9:4) He received his Bachelor of Engineering from an Indian University located in Madurai Kamaraj. *Id.*

In 1996 he moved to Singapore to pursue his Masters in Engineering at the National University of Singapore. (Raj Tr. at 6:20-22; 7:4-6; 8:11-15) In 2002 he completed his Masters degree. (Raj Tr. at 8:14-18) From 2002 through 2004 he remained in Singapore to work until, in 2004, he moved to the U.S. for the first time to work for a now former employer. *Id.* From 2004 until 2007 Mr. Raj worked for various employers spending time in both the U.S. and Singapore. (Raj Tr. at 9:11-14)

Since 2007 Mr. Raj has resided continuously in the U.S. and, specifically, the Northeast section of the U.S. (Raj Tr. at 9:17-20) From 2007 until 2008 he resided in Dartmouth, Massachusetts and in November 2008 he moved to Albany, New York where he currently resides. (Raj Tr. 9:21-24) Today he is a citizen of Singapore working legally in the U.S. by and through a work visa sponsored by his current employer GlobalFoundries. (Raj Tr. at 7:9-14; 8:15)

#### **2. The Founding of CitiAir Singapore and The Selection of the CitiAir Trademark**

In 1998, while residing in Singapore, Mr. Raj was involved with a travel company by the name of Serangoon Air Travel. (Raj Tr. 10:4-13) At this time Mr. Raj and three other individuals decided to form a spinoff company from Serangoon Air Travel for the purpose of creating an "indianized" travel company

to market cheap air tickets to Indian workers working in Singapore for travel back to their native India.

(Raj Tr. 11:8-19)

In this regard, Mr. Raj and his partners set out to create a name for the Singapore company that would evoke a connotation of godliness to their target customer market (hereinafter “CitiAir Singapore”).

(Raj Tr. 12:15-25; 13:1-25) In regard to the selection of the name, Mr. Raj testified:

Q: ... And ultimately, you all settled on CitiAir?

A: Yes.

Q: Why?

A: Like the name is like us – as I mentioned earlier, like we sell mostly for people in India or Indian origin who want to go back to India, and we want to make it more related to Indianized.

Like culturally, we are more religious or Yoga kind of people. Like it’s called like all the gods’ names. Like with in front name, like mister, when we call ourselves mister, they put like a city ...

Q: And so this is the connotation that the term city has there?

A: Yeah. In front, they will put like city, so it’s – it’s a god name...

...

A: It’s like enlightenment...

Q: So that’s why you picked the term Citi?

A: Yes.

Q: How about Air?

A: Air, we sell air services, so –

...

A: Natural fit.

(Raj Tr. 13:6-25; 14:1-11; 57:6-19)

Of note, at the time of the selection of the CitiAir name in Singapore, Mr. Raj had never heard of any financial institutions utilizing the prefix CITI. (Raj Tr. 14: 15-25) The first time Mr. Raj, and by

extension CitiAir, became aware of the existence of the Opposer was on the filing of the instant opposition proceeding. (Raj Tr. 25:2-11)

Since its founding in 1998 CitiAir Singapore has been in business since 1998 to the present and continuing. (Raj Tr. 15: 1-10).

**3. Founding of CitiAir, LLC in the U.S.**

As mentioned above, in 2007, nine years after founding CitiAir Singapore, Mr. Raj moved permanently to the U.S. (Raj Tr. at 9:17-20) In 2009, Mr. Raj and his partners from CitiAir Singapore decided to found CitiAir, LLC in the U.S., the applicant in the instant proceeding (Raj Tr. 16:4-12) The corporate entity was created in March of 2009 with the sale of air tickets commencing in June of 2009. (Raj Tr. 18: 14-17)

CitiAir was founded for the same purpose as CitiAir Singapore, to provide "...cheap air tickets to India." (Raj Tr. 17:14-17) Of note, in 2009 when Mr. Raj and his partners decided to bring the CitiAir Singapore concept to the U.S. by and through CitiAir Mr. Raj had still not heard of the Citibank. (Raj Tr. at 20:12-16)

In 2011 the ownership of CitiAir changed from the CitiAir Singapore partners to simply Mr. Raj, his wife Nusha Selvam ("Mrs. Selvam"), and their two children. (Raj Tr. at 16:17-25; 17:1-10)

Since the founding of CitiAir, LLC in 2009 the company, and its name, have been in continuous use in the U.S. providing travel services. (Raj. Tr. at 21:22-25;21: 2) [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

#### **4. The CitiAir Mark**

The Application at issue deals not with the term CITIAIR alone but rather as used in connection with the logo depicted below:



The logo at issue was created by a designer in Singapore in December of 2010. (Raj Tr. 21:18-25) Shortly after the creation thereof, CitiAir began using the CitiAir Mark in 2010 in the U.S. (Raj Tr. 21:25; 22:2-6) The trademark at issue has been in continuous use in the U.S. by CitiAir since December 2010 to the present and continuing. (Raj Tr. 22:25; 23:2-4) Specifically, the logo has been used on and continues to be used on CitiAir's websites, business cards, as well as banner advertisements promoting its travel services. (Raj Tr. 23:5-25)

#### **5. CitiAir's Travel Services**

CitiAir provides travel booking agency services in the nature of the sale of airline tickets. (Raj Tr. 25:12-15) Mr. Raj is a registered travel agent. (Raj Tr. at 65:17-18) As Mr. Raj stated in regard to the services offered in connection with the logo:

A: 99.9 percent, we are offering tickets to – air tickets to India, to India from U.S....

Q: Any other locations?

A: No.

(Raj Tr. at 24:11-15)

CitiAir does not provide banking, financial, or credit card services whatsoever. (Raj Tr. 25:16-22)

[REDACTED]

[REDACTED]

## 6. CitiAir's Advertising

CitiAir's advertising is limited to targeting cost-conscious Indian consumers who are seeking cheap airfare to and from India from the U.S. (Raj Tr. at 41:3-25; 42:2-25) This message is branded throughout CitiAir's limited advertising modes including, but not limited to, prominently across their websites. (Raj Tr. at 43:4-7)

Initially CitiAir's marketing efforts were limited to the distribution of business cards in Indian stores, Indian grocery stores and Indian festivals. (Raj Tr. at 19:13-25; 20:2-5)

Concerning the festivals, almost since the founding of CitiAir and continuing to the present CitiAir has promoted its travel booking agency services by and through attendance at Indian cultural festivals in the U.S. (Raj Tr. at 35:7-25; 36:1-25; 37:1-25; 38:1-22) Presently, CitiAir attends approximately 12 to 15 festivals per year. (Raj Tr. at 37:6-22) In 2011 CitiAir attended roughly 10 festivals but in 2009 the number was just two or three. (Raj Tr. at 37:6-22)

The festivals have music, dance, food and opportunities for vendors like CitiAir to sell their goods and services. (Raj Tr. at 36:16-21) When attending these festivals CitiAir displays its travel booking agency services by and through the operation of booths at these festivals. (Raj Tr. at 35:16-24) At the booths Mr. Raj personally hands out his business cards to prospective customers advertising CitiAir's travel booking agency services and engages with the customers on a one-on-one level explaining to them about CitiAir's business model and how they can provide air fares to and from India at such cheap rates. (Raj Tr. at 36:22-25; 37:2-5)

These Indian festivals are specifically aimed at Indian communities namely, those that speak a particular language from any part of India such as Telugu or Tamil. (Raj Tr. at 38:13-23)

CitiAir attends these Indian festivals in the Northeast of the U.S., especially in Boston, Albany, and New Jersey. (Raj Tr. at 35: 16-24) CitiAir has never attended such festivals outside of the Northeast of the U.S. (Raj Tr. at 36: 3-5)

Mr. Raj has never encountered any instances of customer confusion as between CitiAir and Citibank while attending these festivals. (Raj Tr. at 37:23-25; 38:2) Moreover, no one at any of these festivals has ever asked if CitiAir provides financial or banking services. (Raj Tr. at 38:3-5) Lastly, Mr. Raj, and by extension CitiAir, has never seen any promotional materials or representatives at these festivals from the Citibank. (Raj Tr. at 38:6-12) Specifically, Mr. Raj testified:

Q: When, if ever, have you seen anyone from Citigroup at any of these festivals?

A: Till this moment, I haven't seen anyone.

Q: Have you ever seen any Citigroup promotional materials at the festivals that you've attended?

A: None. Hundred percent zero.

(Raj Tr. at 38:6-12)(*emphasis added*)

At one time CitiAir posted an ad on Craigslist for its services. (Raj Tr. at 26:5-20) Aside from the one posting, however, CitiAir does not advertise on Craigslist. (Raj Tr. at 26:5-20)

CitiAir also markets its services by and through several websites, namely, CitiAir.net, CitiAir.org, myCitiAir.com, CitiAirTravel.com, and CitiAirTravel.net. (Raj Tr. at 20:6-11) The primary websites are citiairtravel.com and citiair.net. (Raj Tr. 27:19-23) Citiair.net has been live since May or June of 2009. (Raj Tr. 28: 4-8)

CitiAir currently advertises on search engine sites directed towards the Indian population. Specifically, CitiAir advertises on Sulekha.com as well as Eknazar.com which are akin to online yellow pages for the Indian population. (Raj Tr. at 26:21-25; 27:2-4) These advertisements started in 2009 or 2010 and continue to be used today. (Raj Tr. 27:5-12)

CitiAir also markets its services by and through direct opt-in e-mail marketing for its existing customers. (Raj Tr. at 39:23-25; 40:2-8) Specifically, CitiAir sends email blasts to their existing customer base that have elected to opt-in to CitiAir's email marketing lists. (Raj Tr. at 40:9-11) These blasts are sent roughly once per week and involve super sales or great deals on air fares to India. (Raj Tr.

40:17-24) Of note, CitiAir does not purchase lists of email addresses of non-customers. (Raj Tr. at 40:12-16) CitiAir has been using email marketing since December of 2011. (Raj Tr. at 57:22-24)

CitiAir does not sponsor athletic venues. (Raj Tr. at 44: 8-10) CitiAir does not advertise on television. (Raj Tr. at 44:11-14) CitiAir does not advertise in papers. (Raj Tr. at 44:15-17) CitiAir does not advertise by direct mailings. (Raj Tr. at 44:18-19) CitiAir does not advertise in airports. (Raj Tr. at 44:20-22)

## **7. CitiAir's Channels of Trade**

In 2009, when CitiAir was founded and began business, customers of CitiAir would call CitiAir's toll-free number or an agent for CitiAir's direct number to purchase airline tickets. (Raj Tr. at 29:5-8) Tickets were purchased exclusively over the phone. (Raj Tr. at 19:5-12) The airline tickets would then be delivered to customers electronically via email. (Raj Tr. at 29:9-13) This exclusive channel of trade continued until July 4, 2012. (Raj Tr. at 29:14-19)

CitiAir's online presence was originally relegated to passive websites through which CitiAir's services were marketed but could not be purchased. (Raj Tr. at 28: 9-25) However, on July 4, 2012 CitiAir launched a new website located at *citiairtravel.com*. (Raj Tr. at 29:14-19) The new website incorporates a travel booking engine wherein consumers may purchase airline tickets directly online. (Raj Tr. at 29:20-25; 30:2)

Customers of CitiAir can pay by and through credit cards, check deposits, or bank transfers. (Raj Tr. at 39: 11-15) CitiAir does not offer any form of rewards program. (Raj Tr. at 39: 16-18) As such, customers cannot purchase air tickets through *citiairtravel.com* by and through the use of points or awards points. (Raj Tr. at 39:16-22)

The site also includes the phone number(s) for CitiAir so consumers can check prices on the website but call CitiAir directly to complete transactions. (Raj Tr. at 29:25; 30:2-9) *See also* Exhibit 2 to Raj Trial Deposition. Finally, CitiAir's websites are open to the public and not merely to members or persons having an account with CitiAir. (Raj Tr. at 34: 24-25; 35: 2-6)

CitiAir does not maintain a physical location at which consumers can go to purchase its services. (Raj Tr. at 44: 3-7)

## **8. Absence of Actual Confusion**

There are no known instances of actual confusion between CitiAir and Citibank. (Raj Tr. at 49:20-23) *See also Applicant's First Notice of Reliance* at Exhibit A, p. 20.

## **B. Citibank**

### **1. Citibank Financial Institution**

Citibank was originally chartered June 16, 1812 under the banking laws of the New York State. (Moses Tr. at Ex. 183, OPP001509) Citibank's original name was "City Bank of New York". (Moses Tr. at Ex. 183, OPP001509) In July 1865 Citibank converted its state charter to a national charter and changed its name to The National City Bank of New York. (Moses Tr. at Ex. 183, OPP001509) In March of 1974 the company was renamed Citicorp. (Moses Tr. at Ex. 183, OPP001511) Its current organizational structure is that of a Delaware corporation having been formed in 1998 following the business combination of Travelers Group, Inc. and Citicorp. (Moses Tr. at Ex. 183, OPP001508)

### **2. Citibank's Financial Services**

Citibank offers a wide variety of financial services. As the pleaded registrations attest, Citibank primarily offers financial services in the nature of extending consumer and industrial loans to others, credit card servicing and the purchasing and servicing of consumer receivables associated therewith, commercial lending, servicing loans and extensions of credit, real estate lending, mortgage financing and mortgage servicing, investment advisory and financial advisory services as well as providing venture capital to others. *See Notice of Opposition* at Exhibits A - B. *See also Applicant's First Notice of Reliance* at Exhibit A, p. 8.

Of note, Citibank does not retain any registered trademarks for travel agency services. (Moses Tr. at 112:10-115) Further, Citibank only retains one trademark that references the word travel in the trademark registration. (Moses Tr. at 112:16-25; 113:1-13) In that regard, the services actually recited in that regard are for a benefits program offered by a credit card company to certain cardholders and not for

travel services. (Moses Tr. at 113:14-25) The trademark is U.S. Reg. No. 2,954,363 used in connection with the mark CITITRAVEL. *Id.* As provided in the federal registration, CITITRAVEL is registered in connection with the following services:

Benefits Programs Offered To Credit Card Holders, Namely, Promoting The Goods And Services Of Others Through Special Promotions, Sponsorships And Discounts For Travel, Hotel, Restaurant, Parking And Automobile Rentals;

Benefits Programs Offered To Credit Card Holders, Namely, Travel Planning Services In The Nature Of Making Reservations And Bookings For Transportation; and

Benefits Programs Offered To Credit Card Holders, Namely, Travel Planning Services In The Nature Of Making Reservations And Booking For Temporary Lodging

U.S. Reg. No. 2,954,363, attached in Exhibit B to Citibank's *Notice of Opposition*.

CITITRAVEL has been in use since 1986. (Moses Tr. at 85:2-9) The mark is licensed to a third-party vendor, Trilegiant Corporation, to fulfill the services under the trademark. (Moses Tr. at 85:10-18) The services offered under the CITITRAVEL mark are only offered for a fee. (Moses Tr. at 114:1-3) Moreover, any advertising materials of record in this matter concerning the CITITRAVEL program only go to members of the program itself. (Moses Tr. at 114:4-9) In short, the services used in connection with CITITRAVEL are a value proposition for Citibank's core banking and credit card services.

### **3. CitiBank's Value Propositions for Its Financial Services**

Citibank's sets forth in their *Trial Brief* they have, historically, offered "numerous travel-related services." (*Trial Brief of Opposer Citigroup, Inc.* at 30) However most, if not all, of these services are not services at all but rather value propositions for Citibank's core financial products and services.

As Ms. Hines testified, a value proposition is "a way of describing the features and benefits of a card." (Hines Tr. at 60:25; 61:1-3) It is the benefits Citibank offers to a cardholder. (Baum Tr. at 54: 14-18) It is what the consumer gets for what you are selling. (Hines Tr. at 61:7-8) It is what entices the consumer to use your services. (Hines Tr. at 61:9-14) The purpose of a value proposition is to market a company's services to consumers and retain them as customers. (Hines Tr. 61:15-18)

In regard to travel themes used in connection with the provision and advertisement of certain credit cards provided by Citibank, Ms. Villanueva conceded “Our value proposition to our consumers is the possibility of travel...” (Villanueva Tr. at 73: 2-3) This fact was corroborated by Mr. Baum. Specifically, he confirmed that free checked bags, priority boarding, double sky miles, and even additional travel miles are all merely value propositions of Citibank’s credit card services. (Baum Tr. at 54:14-25; 55:1-12)

Concerning Citibank’s ThankYou rewards program, the aim of a credit card rewards program is to satisfy the value proposition to entice consumers in diverse market segments to use Citibank’s core services. (Hines Tr. at 63:4-10) As such, the rewards program is designed to meet the needs of different customer segments so that they, the consumers, will utilize Citibank’s core services, namely banking and credit card services. (Hines Tr. at 63: 19-25; 64:1-2)

Many Citibank cardholders receive concierge services as part of their credit card services. But that too is merely a further value proposition for the core credit card business. Specifically, the value proposition is the provision of concierge services to entice card holders to use their Citi-branded cards to a greater degree. (Hines Tr. at 90: 8-25) The concierge service is not travel-specific. (Hines Tr. at 91: 8-15) Rather, it is, as it is named, a concierge service provided to cardholders as a value proposition to entice greater card usage in the nature of having access to a service that will fulfill any wish a cardholder may have. (Hines Tr. at 91:8-25; 92: 1-16) Of note, the concierge service is only provided to Citibank card holders. (Villanueva Tr. at 85:19-25)

#### **4. Travel Service Companies Are Not Citibank’s Competitors**

Citibank relies upon its partnerships with American Airlines and other travel services companies in an effort to bridge the divide between its financial services and CitiAir’s travel booking agency services. In doing so, however, they admit that they do not consider travel services to be related to their own services.

As set forth by Ms. Hines, it is not a good marketing practice to talk about or highlight competitors on your website. (Hines Tr. at 68: 22-24) [REDACTED]



(Nariman Tr. at 7:24-25; 8:1-3) Citibank exclusively offers banking services to NRIs as they desire only to market to them their core business service, banking. (Nariman Tr. at 17:23-25; 18: 1-2)

Ms. Nariman confirmed that Citibank only offers banking services to NRIs in the U.S. on cross-examination. (Nariman Tr. at 45:13-25; 46:1-4) Moreover, the fact that Citibank services offered to NRIs are relegated to banking services was corroborated by Ms. Moses. (Moses Tr. at 101: 12-16)

## **6. Citibank's Lack of Evidence of Fame**

During the trial testimony Citibank called several witnesses in an attempt to establish the fame and public awareness of its brand.

As a threshold issue, Citibank did not offer any evidence of consumer awareness of their trademarks in the general marketplace. (Michelini Tr. at 39: 21-24) Moreover, Ms. Moses testified that she was not aware of any brand tracking studies by Citibank for their brand awareness in the travel services industry. (Moses Tr. at 127:1-5) Rather, the only brand awareness studies submitted into evidence by Citibank in this matter were relegated to Citibank's brand awareness in the financial services industry. (Michelini Tr. at 39: 21-24)(*emphasis added*)

In regard to the evidence submitted, awareness refers to the degree to which the public knows of a brand. (Michelini Tr. at 6:15-21) Unaided brand awareness is a measure of a consumer's recognition of a brand, often limited to a specific industry, without being shown a list of brands to assist in their brand recognition. (Michelini Tr. at 37:3-19) Total or aided brand awareness is a measure of consumer awareness when they are asked whether they are aware of a brand when presented with brand names in a given industry. (Michelini Tr. at 37:20-25; 38:1-19)

Citibank called several witnesses who testified that the CITI brand is either iconic or famous. Specifically, Ms. Villanueva and Mr. Michelini testified that Citibank's brand is "iconic." (Villanueva Tr. at 13:16-21) (Michelini Tr. at 9:8-10) Ms. Moses testified unequivocally that she considers the Citibank brand to be famous. (Moses Tr. at 42: 12-22)

Mr. Michelini and Ms. Moses further defined iconic and famous, respectively. Specifically, Mr. Michelini defined an "iconic brand" stating:

Q: Are you familiar with the term “iconic brand”?

A: Yes.

Q: What does that mean?

A: We utilize that term to refer to brands that are well known, that are national brands that might informally be called household names that enjoy awareness levels that are, you know, **the large majority of the people are aware of the brand** and would refer to those as iconic – iconic brands”

(Michelini Tr. at 8:10-20)(*emphasis added*) On direct, Mr. Michelini testified that the CITI brand is iconic because, in his words, “the large *majority* of the people nationally are aware of the brand.”

(Michelini Tr. at 10:2-7)(*emphasis added*)

Upon cross-examination Ms. Moses clarified that she believed fame to be defined as widely recognized by the general public for the services offered. (Moses Tr. at 122:14-22) In regard to her perception of “widely recognized,” Ms. Moses added that “...widely recognized to me would mean recognized by a **large percentage of the population of the U.S.**” (Moses Tr. at 122:18-22) When asked to assign a numerical value to “large percentage”, **Ms. Moses confirmed that it would have to be at least 40 percent of the population.** (Moses Tr. at 122:23-25; 123:1-6)(*emphasis added*)

[REDACTED]

### **7. Citibank's Advertising**

In addition to the marketing discussed more fully in Citibank's *Trial Brief of Opposer*, Citibank markets its services by and through the sponsorship of CitiField, the New York Met's Baseball Stadium

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4 [REDACTED]

5 [REDACTED]

6 [REDACTED]

7 [REDACTED]

and the 2012 London Olympics. (Villanueva Tr. at 16:17-25; 17:16-25; 18: 1-7)(Moses Tr. at 45:7-12)  
Citibank also promotes its brand by and through sponsorships of the Citi Open for the World Tennis Association, the Citi Performing Arts Center in Boston, as well as Citi Pond in New York City's Bryant Park. (Moses Tr. at 45:15-23) Citibank is also a sponsor of the U.S. Olympic and Paralympic teams. (Moses Tr. at 45:24-25)

[REDACTED]

[REDACTED] Citibank uses dioramas or multimedia displays in these airports to promote their credit card services. (Baum Tr. at 26:12-25)

[REDACTED]

**8. Citibank's Channels of Trade**

Citibank has roughly one thousand branch locations within the U.S. (Villanueva Tr. at 33:16-18)  
Citibank also retains an ATM network in which it is partnered with 7-Eleven stores to provide ATM services in approximately 6000 locations in addition to Citibank's branch locations referenced above. (Villanueva Tr. at 33: 16-25) *See also Applicant's First Notice of Reliance* at Exhibit A, p. 9-10.

The Citibank ThankYou Rewards program was introduced about seven years ago and is exclusively designed to create a more robust redemption option as a value proposition for Citibank credit card holders. (Villanueva Tr. at 18:24-25; 19:1-6) Their travel-themed advertising is merely an extension of this value proposition. It is an enabler. (Villanueva Tr. 52:13) The Citibank credit card is an enabler for customers “whether they want to travel or go out to restaurants, purchase gifts.” (Villanueva Tr. at 52:13-16) Specifically, it is a two-fold value proposition as Ms. Villanueva testified:

Q: Now, the travel theme ... how does this relate to the credit card business?

A: It's two-fold. One, which is that you can redeem points in order to earn travel for free. And the second piece is that it's [Citibank's credit card] accepted widely and you can use it in your travels, the credit card itself, for purchases.

(Villanueva Tr. at 51:12-20)

In order to use Citibank's ThankYou Rewards website a consumer would need to be a Citibank customer. (Hines Tr. at 70: 5-16; 72: 3-18) Specifically, they need to be a customer and have set up an online account allowing them to access the “travel center” of Citibank's ThankYou Rewards website by and through logging in using their user name and password. (Hines Tr. at 73: 5-16)

Citibank's ThankYou Rewards' customer-only website is akin to an online department store whereby Citibank cardholders, and Citibank cardholders alone, can redeem their accumulated credit card points to purchase various goods and services through Citibank's online catalog. (Hines Tr. 74: 6-25; 75:1-12)

## ARGUMENT

### I. REGISTRATION OF THE CITIAIR MARK WOULD NOT CREATE A LIKELIHOOD OF CONFUSION WITH CITIBANK'S CITED TRADEMARKS

Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The Board's decision is based upon a determination under Section 2(d) on an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"). *See also In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). These factors are discussed below.

#### A. THE MARKS CREATE SEPARATE AND DISTINCT COMMERCIAL IMPRESSIONS

First, we turn to the *du Pont* likelihood of confusion factor regarding the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "[T]he test 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 so that confusion as to the source of the goods offered under the respective marks is likely to result." *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008).

Although the pleaded registrations are composed of or include the prefix CITI the overall commercial impression presented by CitiAir's Mark is sufficient to eliminate any potential for a likelihood of confusion.

Specifically, Citibank has relied upon the following marks to establish its claims in this matter: CITIBANK (U.S. Reg. No. 691,815); CITI NEVER SLEEPS (U.S. Reg. No. 1,104,470); CITI (U.S. Reg. No. 1,181,467); CITIDIRECT (U.S. Reg. No. 2,261,522); CITIGROUP (U.S. Reg. No. 2,406,753); and CITITRAVEL (U.S. Reg. No. 2,954,363).

As a threshold issue, it cannot be denied that the prefix CITI appears in all of the pleaded registrations as well as the word portion of CitiAir's Mark. However, as stated by the Second Circuit, partial similarity between marks can never alone be decisive of likelihood of confusion. *McGregor-Doniger, Inc. v. Drizzle Inc.*, 202 U.S.P.Q. 81, 89 (2<sup>nd</sup> Cir. 1979). Thus, in holding the mark "DRIZZLE" for women's overcoats was not likely to cause confusion with "DRIZZLER" for golf jackets, the Court of Appeals for the Second Circuit stated:

First, even close similarity between two marks is not dispositive of the issue of likelihood of confusion. Similarity in and of itself is not the acid test. Whether the similarity is likely to provoke confusion is the crucial question.

*McGregor-Doniger*, 202 U.S.P.Q. at 89. See also *In re Norfolk Wallpaper, Inc.*, 216 U.S.P.Q. 903 (T.T.A.B. 1983)("THE NORFOLK PLAN" for installation of wallpaper and retail wallpaper store services does not so resemble "NORFOLK" for interior and exterior ready-made paint and varnishes, and thinners for paint and varnishes that confusion is likely); *Interstate Brands Corp. v. Celestial Seasonings, Inc.*, 198 U.S.P.Q. 151 (C.C.P.A. 1978)("RED ZINGER") for herb tea not likely to cause confusion with "ZINGERS" for cakes); *In re Texas Instruments, Inc.*, 193 U.S.P.Q. 678 (T.T.A.B. 1976)(no likelihood of confusion between "COPPER CLAD" for copper-coated carbon electrodes for electric arc cutting and gouging and "COPPERCLAD & Design" for composite metal wire for use in electric conductors); *In re Vogue Tyre & Rubber Co.*, 176 U.S.P.Q. 189 (T.T.A.B. 1972)(no confusing similarity between "CUSTOM BUILT & Design" for goods including storage batteries and "CUSTOM BUILT" for tires); and *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 167 U.S.P.Q. 529 (C.C.P.A. 1970)("PEAK PERIOD" for personal deodorant does not so resemble "PEAK" for a dentifrice that confusion is likely).

Turning to the connotations created by the marks at issue, CITIBANK creates a feeling of banking and financial services that is evoked in consumers viewing this mark. The CITI NEVER SLEEPS evokes a feeling of security and trust engendered from a financial services corporation that is available for their clientele 24 hours a day, seven days a week. CITIDIRECT engenders a look and feel of direct access to Citibank's financial products while CITIGROUP is conjures up the feeling of financial

services provided by more than one entity. Lastly, CITI connotes that which it sounds like, that of a city while CITITRAVEL gives the look and feel of travel perhaps within a city.

Applicant's mark, however, consists of a stylized design that evokes the connotation of air flight and not financial services, 24/7 business, direct access, or even inner city travel. When a consumer views CitiAir's mark they think of airplanes, flights, and destinations far and abroad.

Further aiding the distinction in connotations of the respective marks, one must recall that the CitiAir Mark is marketed to persons of Indian decent and, as the uncontested testimony establishes, was specifically selected to evoke a connotation of godliness to CitiAir's target consumer market. (Raj Tr. 12:15-25; 13:1-25) As set forth above:

Q: ... And ultimately, you all settled on CitiAir?

A: Yes.

Q: Why?

A: Like the name is like us – as I mentioned earlier, like we sell mostly for people in India or Indian origin who want to go back to India, and we want to make it more related to Indianized.

Like culturally, we are more religious or Yoga kind of people. Like it's called like all the gods' names. Like with in front name, like mister, when we call ourselves mister, they put like a city ...

Q: And so this is the connotation that the term city has there?

A: Yeah. In front, they will put like city, so it's – it's a god name...

...

A: It's like enlightenment...

Q: So that's why you picked the term Citi?

A: Yes.

Q: How about Air?

A: Air, we sell air services, so –

...

A: Natural fit.

(Raj Tr. 13:6-25; 14:1-11; 57:6-19)

Accordingly, prospective target consumers, upon encountering CitiAir's mark CITIAR and the design, are likely to perceive the mark as enlightened or godly air service as apart from any of the connotations likely associated with Citibank's cited registrations.

In sum, in addition to the differences in sound and appearance, CitiAir's design mark is significantly different in connotation and overall commercial impression from Citibank's cited registrations. Citibank's cited marks are likely to be perceived as being related to financial services, 24/7 business, direct access, or possibly inner city travel whereas CitiAir's design mark is perceived as enlightened or godly air ticketing services.

As such, it is respectfully submitted that this *du Pont* factor weighs against a finding of a likelihood of confusion.

**B. CITIBANK'S ALLEGED "FAMILY OF MARKS" IS IRRELEVANT AS CITIBANK DOES NOT OFFER TRAVEL BOOKING AGENCY SERVICES**

The "family of marks" doctrine has applicability in those situations where, prior to a defendant's first use of its challenged mark containing a particular feature, the plaintiff had established a family of marks characterized by that feature, so that the defendant's subsequent use of its mark containing the feature for goods or services which are similar or related to plaintiff's will cause the relevant purchasing public to assume that defendant's mark is yet another member of the plaintiff's family. *See J&J Snack Foods Corp. v. McDonald's Corp.*, 18 U.S.P.Q. 2d 1889, 932 F.2d 1460, 1463 (Fed. Cir. 1991); *Blansett Pharmaceutical Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ2d 1473 (TTAB 1992); *Econo-Travel Motor Hotel Corp. v. Econ-O-tel of America, Inc.*, 199 USPQ 307 (TTAB 1978); and *Porta-Tool, Inc. v. DND Corp.*, 196 USPQ 643 (TTAB 1977).

Citibank does not provide travel agency services. (Hines Tr. at 82:16-25; 83:1) As such, any "Family of Marks" alleged to exist by Citibank in this proceeding is relegated to its core financial services. Accordingly, any such family is irrelevant to the instant proceeding as Citibank's core services do not extend into the sphere of commerce occupied by CitiAir.

### C. THERE IS NO OVERLAP IN THE SERVICES OF THE RESPECTIVE PARTIES

In an inter partes proceeding before the Board, the issue of likelihood of confusion must be determined based on the goods recited in applicant's application vis-à-vis the goods identified in opposer's pleaded registration. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992).

As a threshold issue, it is noted that the cited registrations by Citibank are all relegated to the financial services industry. *See Notice of Opposition* at Exhibits A - B. As the pleaded registrations attest, Citibank primarily offers financial services in the nature of extending consumer and industrial loans to others, credit card servicing and the purchasing and servicing of consumer receivables associated therewith, commercial lending, servicing loans and extensions of credit, real estate lending, mortgage financing and mortgage servicing, investment advisory and financial advisory services as well as providing venture capital to others. *Id.*

Citibank does not retain any registered trademarks for travel agency services. (Moses Tr. at 112:10-115) Citibank only retains one trademark that references the word travel. (Moses Tr. at 112:16-25; 113:1-13) In that regard, the services actually recited in that regard are for a benefits program offered by the credit card company and not for travel services. (Moses Tr. at 113:14-19) That trademark is U.S. Reg. No. 2,954,363 used in connection with the mark CITITRAVEL. *Id.* As provided in the federal registration, CITITRAVEL is registered in connection with the following services:

Benefits Programs Offered To Credit Card Holders, Namely, Promoting The Goods And Services Of Others Through Special Promotions, Sponsorships And Discounts For Travel, Hotel, Restaurant, Parking And Automobile Rentals;

Benefits Programs Offered To Credit Card Holders, Namely, Travel Planning Services In The Nature Of Making Reservations And Bookings For Transportation; and

Benefits Programs Offered To Credit Card Holders, Namely, Travel Planning Services In The Nature Of Making Reservations And Booking For Temporary Lodging

U.S. Reg. No. 2,954,363, attached in Exhibit B to Citibank's *Notice of Opposition*.

Accordingly, in the absence of any federal registration pertaining to travel booking agency or related services Citibank has attempted to build a bridge to span the divide between its financial services and CitiAir's services. In this regard, Citibank attempts to weave an elaborate web of value propositions and services offered by its cross-marketing partners in an effort to make it appear that they provide travel-related services. Upon close inspection, however, they do not.

Citibank's witnesses testified at length concerning "travel-related services" they allegedly offer to their existing customers. However, they universally concede that such benefits are truly value propositions to induce greater use of Citibank's core banking and credit card services.

For instance, in regard to travel themes used in connection with the provision and advertisement of certain credit cards provided by Citibank Ms. Villanueva conceded "Our value proposition to our consumers is the possibility of travel..." (Villanueva Tr. at 73: 2-3) As such, although Citibank submitted significant evidence of travel-themed advertising, the reality of those themes is that they are merely a value proposition to entice consumers into purchasing Citibank's core financial services.

In regard to evidence of purported travel benefits associated with certain Citibank credit cards, Mr. Baum testified that free checked bags, priority boarding, double sky miles, and even additional travel miles are all merely value propositions of Citibank's credit card services. (Baum Tr. at 54:14-25; 55:1-12) As such, although Citibank submitted evidence benefits of certain credit cards relating to travel, such benefits are merely value propositions to entice consumers into purchasing Citibank's core credit card services.

Likewise, in regard to Citibank's ThankYou rewards program, the purpose of that credit card rewards program is to satisfy the value proposition to entice consumers in diverse market segments to use Citibank's core financial services. (Hines Tr. at 63:4-10; 63: 19-25;64:1-2) As such, and again, it is merely a value proposition, or marketing, to entice greater use of Citibank's core financial services.

Finally, there was testimony regarding concierge services received by Citibank credit card holders. This too is merely a further value proposition for the core credit card business. Specifically, the value proposition is the provision of concierge services to entice card holders to use their Citi-branded

cards to a greater degree. (Hines Tr. at 90: 8-25) The concierge service is not travel-specific. (Hines Tr. at 91: 8-15) Rather, it is, as named, a concierge service provided to cardholders as a value proposition to entice greater card usage in the nature of having access to a service that will fulfill any wish a cardholder may have. (Hines Tr. at 91:8-25; 92: 1-16)

Accordingly, all of these submitted enticements to use Citibank's banking and credit cards services are not services in and of themselves but rather marketing tools, or value propositions, to sell more of Citibank's core financial services to existing and prospective customers.

To illustrate this point, however, let's assume, *en arguendo*, Citibank, by and through its concierge service or ThankYou Rewards program, offered travel services. If that were to be the case it would then be in direct conflict with the testimony provided concerning their marketing partners.

As set forth by Ms. Hines, it is not a good marketing practice to talk about or highlight competitors on your website. (Hines Tr. at 68: 22-24) [REDACTED]

[REDACTED] As such, other financial service providers such as Bank of America and Wells Fargo would not appear on Citibank's websites as they are competitors of Citibank. (Hines Tr at 68: 5-24)

However, other travel booking agency service providers such as Expedia.com, Travelocity.com, Priceline.com, and Orbitz are prominently featured on Citibank websites. (Hines Tr. at 69:7-25; 70:1-4)(Baum Tr. at 62:1-3) As such, it is clear from Citibank's own witnesses that (1) they would not feature competitors to their services on their website; (2) other travel services providers are featured on their website; accordingly (3) Citibank does not consider travel booking agency service companies to be competitors or providing the same or similar services that Citibank provides. (*emphasis added*)

Citibank also offered extensive testimony and evidence attempting to bridge the divide in services between its and CitiAir's services by and through its cross-marketing relationship with American Airlines. However, once again, this effort is frustrated by testimony which was set forth during the presentation of Citibank's own witnesses.

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

As such, although a relationship exists between Citibank and American Airlines, the relationship, at its core, is one of a cross-marketing opportunity. By virtue of the fact Citibank has formed this relationship with American Airlines it does not mean that American Airlines has become a global financial service provider and Citibank a travel services provider. It merely means that Citibank has formed a partnership with another large company to market its goods and services to American Airline's customers allowing American Airlines to market its goods and services to Citibank's existing customers. Such a relationship does not transform Citibank into a travel services company. [REDACTED]

[REDACTED]

[REDACTED]

Further complicating the position of Citibank in this regard is the testimony of their witness Ms. Hines. Ms. Hines offered that one has to be a licensed travel agent to book airline tickets for a third-party. (Hines Tr. at 82: 16-23) She then conceded that Citibank is not a licensed travel agent. (Hines Tr. at 82: 24-25; 83:1) As such, by Citibank's own admission they cannot book airline tickets for a third party.

Finally, no discussion concerning the lack of overlap between the services of the parties would be complete without mentioning Citibank's admitted limitations upon its service offerings to the U.S. NRI population, the exclusive target market of CitiAir.

As set forth by Citibank's Vice President and Senior Counsel, an NRI in the U.S. is only eligible for Citibank's banking products. (Nariman Tr. at 7: 17-24)(*emphasis added*) So even assuming, *en arguendo*, all of the evidence regarding value propositions and other matters concerning Citibank's credit card services set forth above, all is effectively rendered moot in regard to this matter as such services, by Citibank's own admission, are not provided to NRIs. Specifically, in the U.S. Citibank only offers banking products, meaning deposit accounts, checking accounts, and CDs to NRIs. (Nariman Tr. at 7:24-25; 8:1-3)(*emphasis added*) Citibank exclusively offers banking services to NRIs as they desire only to market to them their core business service, banking. (Nariman Tr. at 17:23-25; 18:1-2; 45:13-25; 46:1-4) (Moses Tr. at 101: 12-16)

Accordingly, even if we assume Citibank was able to begin bridging the divide between its financial services and CitiAir's travel booking agency services by and through the value propositions offered for their core financial services this entire bridge must fail insofar as it does not extend, by Citibank's own admissions, to NRIs.

In sum, the evidence strongly supports a finding that the services of the parties are not related. Citibank's value propositions to their customers and prospective customers may use travel and travel-related items to entice the same, but in the end the service provided as a result of the enticement is simply a core financial service.

Moreover, as Citibank's own witnesses testified, they would not promote the services of a competitor. As such, by and through the promotion of other travel service companies it is clear that, not only does Citibank not consider travel service companies to be competitors they also do not truly believe that they themselves provide travel services.

Finally, notwithstanding the above, in regard to the specific target demographic Citibank's Vice President conceded that the only services that can or are provided to NRIs are banking services.

As such, it is respectfully submitted that this *du Pont* factor strongly weighs against a finding of a likelihood of confusion.

#### **D. CITIBANK HAS FAILED TO ESTABLISH ITS MARK IS FAMOUS IN THIS CASE**

We now consider the next *du Pont* factor of fame of opposer's pleaded mark. A mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark. *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 353, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). *See also Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). This factor can play a dominant role in likelihood of confusion cases wherein the pleaded marks are established as famous. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Recot Inc.*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). However, because of the extreme deference accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting fame to clearly prove it. *Lacoste Alligator S.A. v. Maxoly Inc.*, 91 USPQ2d 1594, 1597 (TTAB 2009); *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007). Moreover, achieving fame for a mark in a marketplace where countless symbols clamor for public attention often requires a very distinct mark, enormous advertising investments, and a product of lasting value. *Kenner Parker*, 963 F.2d at 352, 22 USPQ2d at 1456.

In the instant case, Citibank sets forth a multi-part argument as to why its marks are famous in terms of an analysis under the likelihood of confusion standard. *See Trial Brief of Opposer* at 32. In short, Citigroup sets forth that its marks are famous because of the reach of its banking services, the popularity of its websites, the money spent on advertising, as well as media coverage of the company. *Id.* All of this, however, ignores the testimony as well as the four branding studies submitted by Citibank which fail to establish that Citibank's marks are famous among the general populace as defined by Citibank's own witnesses.

As set forth before, Mr. Michelini and Ms. Moses, Citibank's own witnesses, defined iconic and famous brands. Mr. Michelini testified:

Q: Are you familiar with the term "iconic brand"?

A: Yes.



[REDACTED]

[REDACTED]

For comparison, we note the evidence of record in the *Kenner Parker* case:

In the two- to seven-year-old age group, one in every two children currently owns a PLAY-DOH product. A survey showed that 60% of mothers named PLAY-DOH for modeling compound **without any prompting**. One witness characterized PLAY-DOH as a "piece of gold" which has lasted over thirty years as a successful toy -- a very unusual occurrence in the toy business.

*Kenner Parker*, 963 F.2d at 351, 22 USPQ2d at 1455.

We do not have a similar record in this case.

[REDACTED]

---

8 [REDACTED]  
9 [REDACTED]  
10 [REDACTED]

[REDACTED]

In sum, Citibank's own evidence fails to satisfy the threshold for fame articulated by its own witnesses as well as the applicable authorities cited herein. As such, it cannot be said that Citibank is famous per Ms. Moses's and Mr. Michelini's testimony itself.

As such, it is respectfully submitted that this *du Pont* factor strongly weighs against a finding of a likelihood of confusion.

**E. THERE IS NO OVERLAP IN THE MARKETING OF THE RESPECTIVE MARKS**

In regard to advertising, there is simply no overlap between the manners in which Citibank and CitiAir advertise their respective diverse services.

CitiAir's advertising is limited to targeting cost-conscious Indian consumers who are seeking cheap airfare to and from India from the U.S. (Raj Tr. at 41:3-25; 42:2-25) Initially CitiAir's marketing efforts were limited to the in-person distribution of business cards in Indian stores, Indian grocery stores and Indian festivals. (Raj Tr. at 19:13-25; 20:2-5)

In regard to the festivals, CitiAir promotes its services by and through attendance at Indian cultural festivals in the U.S. (Raj Tr. at 35:7-25; 36:1-25; 37:1-25; 38:1-22) These Indian festivals are specifically aimed at the Indian communities namely, those that speak a particular language from any part of India such as Telugu or Tamil. (Raj Tr. at 38:13-23)

Presently, CitiAir attends approximately 12 to 15 festivals per year. (Raj Tr. at 37:6-22) In 2011 CitiAir attended roughly 10 festivals and in 2009 just two or three. (Raj Tr. at 37:6-22) CitiAir attends

these Indian festivals in the Northeast of the U.S., especially in Boston, Albany, and New Jersey. (Raj Tr. at 35: 16-24) CitiAir has never attended such festivals outside of the Northeast of the U.S. (Raj Tr. at 36: 3-5)

As Mr. Raj testified, when attending these festivals CitiAir displays its travel services by and through the operation of booths at these festivals. (Raj Tr. at 35:16-24) At the booths Mr. Raj personally hands out his business cards to prospective customers advertising CitiAir's services and engages with the customers on a one-on-one level explaining to them about CitiAir's business model and how they can provide air fares to and from India at such a cheap rate. (Raj Tr. at 36:22-25; 37:2-5)

Mr. Raj, and by extension CitiAir, has never seen any promotional materials or representatives at these festivals from the Citibank. (Raj Tr. at 38:6-12) Specifically, Mr. Raj testified:

Q: When, if ever, have you seen anyone from Citigroup at any of these festivals?

A: Till this moment, I haven't seen anyone.

Q: Have you ever seen any Citigroup promotional materials at the festivals that you've attended?

A: None. Hundred percent zero.

(Raj Tr. at 38:6-12)(*emphasis added*) While at these Indian festivals no one has ever confused or even mentioned the Citibank to CitiAir. (Raj Tr. at 37:23-25; 38:2) Moreover, no one at any of these festivals has ever asked if CitiAir provides financial or banking services. (Raj Tr. at 38:3-5)

In contrast, in addition to the marketing discussed more fully in the *Trial Brief of the Opposer*, Citibank markets its services by and through the sponsorship of CitiField, the New York Met's Baseball Stadium and the 2012 London Olympics. (Villanueva Tr. at 16:17-25; 17:16-25; 18: 1-7)(Moses Tr. at 45:7-12) Citibank also promotes its brand by and through sponsorships of the Citi Open for the World Tennis Association, the Citi Performing Arts Center in Boston, as well as Citi Pond in New York City's Bryant Park. (Moses Tr. at 45:15-23) Citibank is also a sponsor of the U.S. Olympic and Paralympic teams. (Moses Tr. at 45:24-25)

In regard to the NRI segment mentioned above, Citibank markets its banking services to NRIs by and through print media, radio, television, flyers in their branch locations, mailers, and open houses at their branch locations. (Nariman Tr. at 11:7-25; 12:1-3; 23: 7-19 Opp. Ex. 121) As such, there is no overlap in the manner the respective parties specifically market to the NRI population of the U.S.

[REDACTED]

CitiAir does not sponsor athletic venues. (Raj Tr. at 44: 8-10) CitiAir does not advertise on television. (Raj Tr. at 44:11-14) CitiAir does not advertise in papers. (Raj Tr. at 44:15-17) CitiAir does not advertise by direct mailings. (Raj Tr. at 44:18-19) CitiAir does not advertise in airports. (Raj Tr. at 44:20-22)

[REDACTED]

CitiAir advertises on search engine sites directed towards the Indian population. Specifically, CitiAir advertises on Sulekha.com as well as Eknazar.com which are akin to online yellow pages for the Indian population. (Raj Tr. at 26:21-25; 27:2-4) These advertisements started in 2009 or 2010 and continue to be used today. (Raj Tr. 27:5-12)

Of note, Citibank cross examined Mr. Raj on this point and on an un-authenticated search purportedly run on Eknazar.com which is the subject of a *Motion to Strike Opposers Exhibit 112* set forth in the preamble of the brief. However, notwithstanding this pending motion, CitiAir would be remiss if it did not point out the inconsistencies in oddities surrounding this one piece of evidence.

Citibank first learned of CitiAir's use of banner advertisements on Sulekha.com as well as Eknazar.com during the discovery deposition of Mr. Raj. During his trial deposition he was presented with a screen shot of Eknazar.com which purported to show that Citigroup's pay-per-click advertising appeared on the same website as CitiAir's banner advertising. However, the Exhibit was never authenticated by an individual who could attest to its veracity. Mr. Raj did not run the search on the site that purportedly brought up the Citibank ad. Nor did Citibank ever call a witness to authenticate or explain how its ads were placed on this site.

Rather, Opposer's Exhibit 112 merely shows, on its face, that when the term "CITIAIR" is searched on Eknazar.com Citibank's advertisements appear thereon as well. If that is the case, it would appear that Citibank intentionally created this evidence in an effort to create some evidence of an overlap in marketing channels. That much cannot be in doubt by virtue of how pay-per-click advertising works.

Specifically, Mr. Raj explained that pay-per-click advertising involves having your ads appear when persons search for specific keywords or terms. (Raj Tr. at 69: 13-25; 69: 2-25; 70: 2-16) In this regard, the only way that Citibank's advertisements are appearing on eknazar.com when the keyword "CitiAir" is searched as displayed in the search field is if Citibank themselves are wrongfully bidding on the keyword CitiAir, the Applicant's trademark. (Raj Tr. at 69: 13-25; 69: 2-25; 70: 2-16) In short, they are intentionally creating the very overlap of which they complain exists.



establishing that those websites are marketed in a similar fashion or to an overlapping segment of the population.

As such, it is respectfully submitted that this *du Pont* factor strongly weighs against finding a likelihood of confusion.

**F. THERE IS NO OVERLAP IN THE PARTIES' RESPECTIVE TRADE CHANNELS**

As a threshold issue, Citibank argues that there is an overlap in the channels of trade because “obviously” travel services are often offered through “bricks and mortar” locations and Mr. Raj testified that someday CitiAir may open locations in parts of the U.S.. However, the reality is that today, as we decide upon this case, CitiAir does not maintain a single physical location at which consumers can go to purchase its services. (Raj Tr. at 44: 3-7)

In contrast, Citibank has about one thousand branch locations within the U.S. (Villanueva Tr. at 33:16-18) Citibank also retains an ATM network in which it is partnered with 7-Eleven stores to provide ATM services in approximately 6000 locations in addition to Citibank’s branch locations referenced above. (Villanueva Tr. at 33: 16-25)

As such, while Citibank maintains a robust “bricks and mortar” channel of trade through which consumers may receive its services CitiAir maintains no such physical presence.

Next, Citibank argues that both they and CitiAir provide their services through websites including, but not limited to, travel booking services. While it is true that both parties maintain websites wherein customers may receive their respective services, there are significant distinctions between the provision of said services through these websites.

CitiAir’s online presence was originally relegated to passive websites through which CitiAir’s services were marketed but could not be purchased. (Raj Tr. at 28: 9-25) However, on July 4, 2012 CitiAir launched a new website located at *citiairtravel.com*. (Raj Tr. at 29:14-19) This new website incorporates an online booking engine wherein consumers may purchase airline tickets directly online. (Raj Tr. at 29:20-25; 30:2)

In contrast, in order to use Citibank’s ThankYou Rewards website, and by extension any of the value proposition catalog of goods and services, a consumer must already need to be a Citibank customer. (Hines Tr. at 70: 5-16; 72: 3-18) Specifically, they need to be a customer and have set up an online account allowing them to access the “travel center” of Citibank’s ThankYou Rewards website by and through logging in using their user name and password. (Hines Tr. at 73: 5-16)

Citibank’s ThankYou Rewards customer-only website is akin to an online department store whereby Citibank cardholders, and Citibank cardholders alone, can redeem their accumulated credit card points to purchase various goods and services through Citibank’s online catalog. (Hines Tr. 74: 6-25; 75:1-12)

[REDACTED]

As such, while both CitiAir and Citibank provide services through their websites, the specific services upon which Citibank must rely to establish an overlap in channels of trade is missing an essential element: namely, it is closed and not available to the general public. While CitiAir’s services are generally provided online Citibank’s allegedly similar services’ channel of trade is primarily a value proposition to its existing credit card customers who can access the customer-only website once they have set up an online account through their ThankYou Rewards program.

In sum, there is simply no overlap in the channels of trade as between CitiAir and Citibank. Citibank retains a high “brick and mortar” presence as their fundamental channel of trade wherein CitiAir has no such presence. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

As such, it is respectfully submitted that this *du Pont* factor strongly weighs against a finding of a likelihood of confusion.

**G. THERE IS HAS BEEN NO ACTUAL CONFUSION IN THE MARKETPLACE**

In the instant matter there is no evidence of actual confusion despite co-existence in the marketplace since 2009. (Raj Tr. 18:14-17; 49:20-23) *See also Trial Brief of Opposer* at 33-4. *See also Applicant's First Notice of Reliance* at Exhibit A, p. 14. While Citibank attempts to minimize this factor, it is nonetheless relevant for the Board's determination. *See The Sports Authority Michigan, Inc. v. The PC Authority, Inc.*, 2002 TTAB LEXIS 65; 63 U.S.P.Q.2D (BNA) 1782 (holding the absence of actual confusion even where the opposing marks have co-existed for only a few years is a factor which favors an applicant in the registration of its mark.); *Central Soya Co., Inc. v. North American Plant Breeders*, 212 USPQ 37, 48 (TTAB 1981) ("the absence of actual confusion over a reasonable period of time might well suggest that the likelihood of confusion is only a remote possibility with little probability of occurring.")

As such, in the absence of any actual confusion whatsoever this *du Pont* factor weighs heavily against finding a likelihood of confusion.

**H. BALANCING OF DU PONT FACTORS**

In the instant case balancing the *du Pont* factors favors registration of CitiAir's Mark.

In regard to the similarity of the marks at issue, it cannot be denied that all of the marks contain the term CITI. But that is where any perceived similarities end. First, it cannot be said that Citibank retains any trademark that is identical to the applied for mark. As such, the best argument that Citibank can make is that the marks are somewhat similar.

But none of Citibank's pleaded registrations incorporate the term AIR. None of Citibank's pleaded registrations incorporate the likeness of an airplane. None of Citibank's registrations evoke a feeling of godliness or enlightenment.

Rather, Citibank's pleaded registrations conjure up images of a bank, 24/7 business services, and the like. CitiAir's trademark instantly evokes a look and feel of air flight. We are reminded that to the relevant consuming populace, namely NRIs, the CitiAir Mark connotes godliness or enlightenment, testimony that was not contested in this case.

Turning to the services of the respective parties it is clear that Citibank, a financial services company, is attempting to bridge the divide between its core banking and credit card services and "travel-related" services by and through cloaking themselves in their value propositions for those core financial services. [REDACTED]

[REDACTED] In the end, however, Citibank simply does not provide travel services. They are not a licensed travel agent. [REDACTED]

[REDACTED]

In terms of the alleged fame of their marks, Citibank failed to establish fame not only by not eclipsing their own standards, but by failing generally accepted standards such as those set forth in *Kenner Parker*.

In regard to marketing, there is simply no overlap. Citibank utilizes traditional marketing channels such as television, radio, [REDACTED] and print media to market its goods and services. CitiAir does not. CitiAir primarily markets its services by and through face-to-face attendance at Indian festivals. Although both parties maintain websites, in this day and age everyone has a website. And in the absence of any evidence setting forth that the websites are marketed to the same class of consumers or otherwise linked in some form merely having a passive website is not sufficient to establish an overlap of marketing channels.

Likewise there is no overlap in the trade channels of the parties. Citibank provides its services, in large part, through thousands of brick and mortar locations and ATMs. Citibank has no such stores or locations. The only possible overlap in trade channels vis-à-vis the provision of arguably like services is by and through the parties' respective websites. However, as the ThankYou Rewards section of the

website for Citibank is closed to only existing Citibank customers there is simply no overlap in these channels of trade.

Finally, the parties have co-existed for four years. In this time [REDACTED]

[REDACTED] and the use of the parties respective marks in connection therewith, there is not one scintilla of evidence that actual confusion has ever occurred.

In this regard, and based upon the extensively developed record in this case, it is respectfully submitted that all of the *du Pont* factors favor a finding of an absence of a likelihood of confusion, that the instant grounds for this opposition be denied, and that CitiAir's Mark be permitted to register on the Principal Register for the U.S. Patent and Trademark Office.

## **II. REGISTRATION OF THE CITIAIR AND PLANE DESIGN MARK IS NOT LIKELY TO DILUTE OPPOSER'S CITIBANK MARKS**

The Trademark Act provides a cause of action for the dilution of famous marks. Sections 13 and 43(c) of the Trademark Act, 15 U.S.C. §§ 1063 and 1125(c) provide as follows:

Subject to the principles of equity, the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.

Citibank contends that the CitiAir Mark will "blur" the distinctiveness of its cited registrations.

The Trademark Act defines dilution by blurring as follows:

"[D]ilution by blurring" is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.

Section 43(c)(2)(B) of the Trademark Act, 15 U.S.C. § 1125(c)(2)(B).

In deciding upon Citibank's dilution claim, we consider the following factors:

1. Whether Citibank's trademark(s) are famous;

2. Whether Citibank's trademark became famous prior to CitiAir's date of constructive use; and
3. Whether CitiAir's trademark is likely to cause dilution by blurring the distinctiveness of Citibank's trademark.

*See Coach Services Inc. v. Triumph Learning LLC*, 96 USPQ2d 1600 (TTAB 2010) (“Coach Services”). CitiAir now addresses the above factors in turn.

**A. CITIBANK HAS FAILED TO ESTABLISH THAT ITS TRADEMARKS ARE FAMOUS**

A mark is defined under §1125(c)(2)(A) as “famous” for dilution purposes — ... if it is widely recognized by the **general consuming public** of the U.S. as a designation of source of the goods or services of the mark's owner. In determining whether a mark possesses the requisite degree of recognition, the court may consider all relevant factors, including the following:

- (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties;
- (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark;
- (iii) The extent of actual recognition of the mark; and
- (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

Citibank has the burden of establishing that its trademarks have become famous, and that requirements for proving fame for purposes of dilution are “stringent.” *Coach Services*, supra, 96 USPQ2d at 1610, citing *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001)(“Toro”).

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

As such, it is submitted that Citibank has failed to submit evidence in this case sufficient to establish that its trademarks are widely recognized by the **general consuming public** of the U.S. as required by §1125(c)(2)(A). Accordingly, it is submitted that the remaining factors need not be addressed

as in the absence of proven fame Citigroup cannot establish that the registration of the CitiAir trademark would be likely to dilute its “famous” brand.

**B. WHETHER OPPOSER'S CITIBANK MARKS BECAME FAMOUS PRIOR TO APPLICANT'S DATE OF CONSTRUCTIVE USE OF ITS CITIAIR AND PLANE DESIGN MARK**

Although CitiAir contests the fact that Citibank has established fame in the instant matter, it acknowledges [REDACTED]

[REDACTED] As such, although based upon the evidence submitted CitiAir contends fame has not been established, CitiAir concedes that the evidence submitted predates CitiAir’s first use of the trademark at issue in the U.S.

**C. WHETHER APPLICANT'S CITIAIR AND PLANE DESIGN MARK IS LIKELY TO CAUSE DILUTION BY BLURRING THE DISTINCTIVENESS OF OPPOSER'S CITIBANK MARKS**

Dilution by blurring is an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark,” 15 U.S.C. § 1125(c)(2)(B), and may be found “regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury,” 15 U.S.C. § 1125(c)(1). Dilution by blurring occurs when a substantial percentage of consumers, upon seeing the junior party's use of a mark on its goods, are immediately reminded of the famous mark and associate the junior party's use with the owner of the famous mark, even if they do not believe that the goods come from the famous mark's owner. *See e.g., National Pork Board v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479 (TTAB 2010).

In addition, we must determine not only whether there is an ‘association’ arising from the similarity of the marks, but whether such association is likely to ‘impair’ the distinctiveness of the famous mark.” *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1023 (TTAB 2011)(“Nike v. Maher”). In determining whether a mark or trade name is likely to cause dilution by blurring, the Board may consider the following six non-exhaustive factors:

- (i) The degree of similarity between the mark or trade name and the famous mark;
- (ii) The degree of inherent or acquired distinctiveness of the famous mark;

- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark;
- (iv) The degree of recognition of the famous mark;
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark; and
- (vi) Any actual association between the mark or trade name and the famous mark.

15 U.S.C. § 1125(c)(2)(B)(i)-(vi).

In the instant case, as set forth under the *du Pont* factors analysis, the degree of similarity between the pleaded registrations and the applied-for mark is not substantial. Although the marks incorporate the prefix CITI there are significant differences in the overall commercial impression created by the distinct suffixes as well as the design of the instant mark and connotation of godliness or enlightenment engendered by CitiAir's Mark.

In regard to the degree of inherent or acquired distinctiveness of the alleged famous mark, Citibank was originally chartered as "City Bank of New York". (Moses Tr. at Ex. 183, OPP001509). As such, when the term CITY was originally used by the bank it was clearly in a descriptive sense. Later the name would be changed to CITI. However, as the Board is aware, an intentional misspelling of descriptive term does not, in and of itself, render the new term inherently distinctive. Has Citibank established acquired distinctiveness in the term CITI? Perhaps. Although if we examine the evidence of actual consumer recognition submitted in evidence on this point perhaps not.

In that context, it has been argued throughout this brief that Citibank has failed to establish significant consumer recognition of its brand [REDACTED]

[REDACTED] As such, Citibank should not be permitted to contend that their mark has significant awareness [REDACTED]

[REDACTED]

In regard to the intent of CitiAir, the uncontested testimony in this case establishes that the original company was founded in Singapore at a time when the founders had no knowledge whatsoever of Citibank. The intent was to adopt an indianized name for a travel company then offering flights to and

from India and Singapore. Years later, and still before having heard of Citibank, Mr. Raj set forth that he brought the concept of CitiAir to the U.S. to sell cheap airline tickets to and from the U.S. and India. As such, there is simply no evidence of record that the CitiAir Mark was adopted to create an association with Citibank.

Finally, as set forth above, there is simply no evidence of record of actual confusion or association between Citibank and CitiAir of record. None.

As such, it is respectfully submitted that Citibank has failed to establish that its brand is famous within the confines of the evidence of record in the case before the Board. Moreover, in balancing the factors it is clear that even if Citibank could be found to be “famous” by the Board there is simply not a likelihood of dilution under the factors enumerated above.

### **CONCLUSION**

WHEREFORE the Applicant, CitiAir, LLC, by counsel, respectfully requests that the Board deny the instant opposition proceeding and, for premises considered, permit the instant trademark application to register on the Principal Register of the U.S. Patent and Trademark Office.

Respectfully submitted this 17<sup>th</sup> day of May, 2013.

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