

THIS OPINION IS NOT A PRECEDENT OF THE TTAB
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Hearing held:
January 15, 2014

Mailed:
March 31, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Citigroup Inc.
v.
Citair, LLC

Opposition No. 91201920

Kenneth A. Plevan and Limor Robinson of Skadden, Arps, Slate, Meagher & Flom, LLP for Citigroup Inc.

Matthew H. Swyers of The Trademark Company for Citair, LLC.

Before Mermelstein,¹ Gorowitz and Masiello, Administrative Trademark Judges.

Opinion by Masiello, Administrative Trademark Judge:

Citair, LLC (“applicant”) filed an application² to register the mark set forth below for “travel booking agencies,” in International Class 39:

¹ Judge Grendel sat on the panel at the oral argument. He has since retired, and Judge Mermelstein has been substituted for him on this decision. The change in composition of the panel does not require a new oral argument. *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1560 (TTAB 2011); *see also In re Bose*, 772 F.2d 866, 227 USPQ 1, 4 (Fed. Cir. 1985).



² Application Serial No. 85219849, filed on January 18, 2011 on the basis of use of the mark in commerce, under Trademark Act § 1(a), 15 U.S.C. § 1051(a), claiming first use and first use in commerce on March 31, 2009.





The colors black, blue and gray are claimed as features of the mark.

Citigroup Inc. (“opposer”) opposed registration of the mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that applicant’s mark, as used in connection with applicant’s services, so resembles opposer’s previously used family of marks that incorporate the designation CITI (both registered and unregistered) as to be likely to cause confusion, mistake or deception. Opposer also alleged that applicant’s mark is likely to dilute the distinctiveness of opposer’s family of marks by blurring the source-identifying power of the family of marks “and of individual members of its family of CITI Marks.”³

Opposer has pleaded ownership of the following subsisting U.S. registrations:

Mark	International Class	Reg. No.
CITITRAVEL	35, 39, 43	2954363
CITIRAIL	36, 39	1651021
CITI	36	1181467
CITI	35, 36	3086206
	36, 41	3441460
	35, 36	2424088

³ Amended Notice of Opposition, *passim*. TTABVue # 5. Hereafter, all numbers designated with the # symbol indicate entry numbers in the Board’s online TTABVue docket system.

CITY NEVER SLEEPS	36	1104470
CITIBANK	36	0691815
	35	3622937
	36	2636299
CITIGROUP	36	2406753
CITI BONUS CASH CENTER	35	3419264
CITIBUSINESS	36	2263621
CITI CASHRETURNS	35, 36	3419395
CITIDIRECT	36	2261522
CITIDOLLARS	35, 36	3412382
CITI EXECUTIVE	35, 36	4036335
CITI FIELD	41, 43	3635724
CITI FORWARD	35, 36	3702463
CITIGOLD	36	1824600
CITIMANAGER	36, 38	2565005
CITI THANK YOU	36	3948111
CITI THANK YOU	35	3956034

Opposer has also pleaded ownership of common law rights in the service marks CITI SPECIALS, CITI CARDS, CITIBANK ONLINE, and the mark shown below:



Opposer alleges that it has used the marks CITI, CITI PLATINUM SELECT, and CITI DIVIDEND in connection with certain third-party marks, including Mastercard, Visa, American Express, and Hilton Honors. Finally, opposer alleges that it has used the following vanity telephone numbers in connection with its services:

1-800-321-CITI	1-800-ASK-CITI	1-888-ASK-CITI
1-888-CITIBANK	1-888-CITIGOLD	1-800-CITI-ATM
1-800-905-CITI	1-800-CITI-YES	1-800-441-CITI
1-800-336-CITI	1-800-328-CITI	1-800967-CITI
1-800-CITI-IRA.		

Applicant denied the salient allegations of the notice of opposition. The case has been fully briefed, an oral hearing was held on January 15, 2014.

I. The Record.

The record includes the pleadings and, by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the application file for the opposed mark. The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. Testimony deposition of Asieh Nariman, opposer's senior attorney, Non-Resident Indian Business, with attached exhibits. #48.
2. Testimony deposition of Anne Elaine Moses, opposer's Associate General Counsel, with attached exhibits. #42-44.

3. Testimony deposition of Mary Ann Villanueva, opposer's Director of Global Branding, with attached exhibits. #38.
4. Testimony deposition of Jason Baum, opposer's Head of cobranded acquisitions, with attached exhibits. #45.
5. Testimony deposition of Mary C. Hines, opposer's Head of Citi ThankYou Rewards, with attached exhibits. #46.
6. Testimony deposition of Anthony Michelini, opposer's Director of Global Branding, for strategy and research, with attached exhibits. #47.
7. Excerpts of the discovery deposition of Prakash Raj, applicant's principal, with select exhibits ("Raj Disc."). #16-17.

Opposer also submitted, under notices of reliance, copies of various printed publications (#18), printouts of web pages of itself and third parties (#12-13, 17), its annual reports for the years 2001 through 2011 (#19-27, 29-30),⁴ and printouts of information from the electronic database records of the Patent and Trademark Office showing the current status and title of all of its pleaded registrations except Reg. No. 3956034 for CITI THANK YOU in Class 35 (#17). Opposer also submitted title and status information regarding two unpleaded registrations of the mark CITIMILES (in standard character form and special form) (Reg. Nos. 1878857 and 1880842); and several expired or cancelled registrations (Reg. Nos. 1024861; 1380723; 1381750; and 1423239) (#17).

⁴ We have not considered those annual reports of opposer that were submitted solely by notice of reliance. Annual reports are generally not admissible under a notice reliance, unless they constitute "printed publications" under Trademark Rule 2.122(e). *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1717-18 (Fed. Cir. 2012); *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1929 (TTAB 2009); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1632 (TTAB 2007).

B. Applicant's Evidence.

1. Testimony deposition of Prakash Raj, applicant's principal, with attached exhibits ("Raj Test."). #34.
2. Select responses of opposer to applicant's first set of interrogatories. #32.
3. Excerpts of contracts, disclosed by opposer in response to discovery requests. #31.⁵

In this decision, depositions are identified by the last name of the deponent followed by page and line numbers, with the exception of the two Raj depositions, which will be referred to as "Raj Disc." and "Raj Test."

II. The parties.

A. Applicant.

Applicant is a Connecticut limited liability company founded in 2009 for the purpose of purveying inexpensive airline tickets for travel between the United States and India.⁶ Beginning in 1998, applicant's principal, Mr. Prakash Raj, had operated (with others) a business in Singapore called Serangoon Air Travel Private Limited, which did business in Singapore under the name CitiAir. The purpose of Serangoon was to sell air tickets to Indian workers for travel between Singapore and India. Serangoon still operates as a "consortium" in which Mr. Raj is a

⁵ Such materials may not be properly made of record under a notice of reliance. *See* 37 CFR § 2.120(j)(3)(ii) ("A party that has obtained documents from another party through disclosure or under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of § 2.122(e).") Applicant does not allege (and it does not appear to us) that these documents are either "printed publications" or "official records" under 37 CFR § 2.122(e). Accordingly, we have given no consideration to these disclosed documents of opposer.

⁶ Raj Test. 41:3-25.

partner,⁷ but it is otherwise not related to applicant. The current “owners” of applicant are Mr. Raj, his wife, and his two children.⁸ Mr. Raj operates applicant’s business from his home.⁹ Applicant has no employees other than Mr. Raj and his wife.¹⁰ The design form of the mark that applicant seeks to register was first used on a website of applicant in December, 2010, and on business cards and banner ads in 2011.¹¹

B. Opposer.

Opposer is a large financial services company whose predecessor in interest was founded in 1812 as a New York chartered bank.¹² The bank was named, at various times, City Bank, National City Bank, and First National City Bank. In 1976, the bank’s name was changed to Citibank, N.A.,¹³ although it had been called, informally, Citibank for some time prior thereto.¹⁴ An 1897 letter on bank stationery shows the bank’s cable address as CITIBANK.¹⁵ Opposer’s predecessor obtained a U.S. registration of the mark CITIBANK on January 19, 1960 (Reg. No. 0691815), and opposer now owns a substantial collection of U.S. registrations for marks that consist of or include the designation CITI.

⁷ Raj Disc. 18-19.

⁸ Raj Test. 17:4-7.

⁹ *Id.* 18:6-8.

¹⁰ Raj Disc. 16-18.

¹¹ Raj Test. 24:2-6.

¹² Moses 14:3-16.

¹³ Moses 16:24-17:5.

¹⁴ Moses 17:8-19.

¹⁵ Moses Exhibit 186.

III. Evidentiary matters.

A. Applicant moves to strike the testimony at page 30 of the Nariman deposition as it relates to advertising agencies used by opposer, on the ground that opposer refused to respond to an interrogatory¹⁶ requesting the identification of all advertising agencies involved in the marketing and promotion of opposer's goods and services. Applicant's brief at 3. Opposer responds that it properly objected to the interrogatory on grounds of overbreadth; and that applicant thereafter made no effort to resolve this discovery dispute or move to compel the requested discovery. Opposer's reply brief at 1-2. The motion to strike is denied.

B. Applicant moves to strike opposer's Exhibit 112, as presented at the Nariman deposition. Opposer has agreed to withdraw the exhibit.¹⁷ Accordingly, the Board has given no consideration to it.

C. Applicant moves to strike opposer's Exhibit 523 (see #18), on the ground that opposer originally "offered [it] as a press release" but, when it was presented to opposer's witness Jason Baum, he characterized it as a third-party news article and could not authenticate it. Opposer argues that it offered the document under its notice of reliance as a "newspaper article," implying that it requires no testimony to authenticate it. Opposer's notice of reliance does not refer to the item as a "newspaper article," but it does indicate that it is offered under 37 C.F.R. § 122(e), which provides for submission of "printed publications" under a notice of reliance. The item itself is a printout from the Lexis/Nexis database and is described on its

¹⁶ Interrogatory No. 9, at #32.

¹⁷ Opposer's reply brief at 2.

face as “Newstex Web Blogs ... Zacks Investment Research”; it bears the date May 16, 2012, but it does not bear a page number. Although this item is not clearly the electronic equivalent of a “printed” publication, it is, in its nature, a publication “available to the general public” and “of general circulation among members of the public”; as such, we deem it appropriate for submission under a notice of reliance without further authentication. The motion to strike is denied, and the exhibit will be admitted for what it shows on its face.

IV. Standing.

Opposer has properly made of record numerous pleaded registrations of service marks that consist of or include the designation CITI and has demonstrated its use of such marks. Opposer has thus shown that it is not a mere intermeddler and has established its standing to oppose registration of applicant’s mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

V. Priority.

In view of opposer’s ownership of valid and subsisting registrations of its pleaded marks, priority is not in issue with respect to the marks and services identified in those registrations. *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

VI. Likelihood of confusion.

Our determination of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

A. Family of marks.


Opposer alleges that there is a likelihood of confusion between applicant's mark and opposer's family of marks consisting of or including the designation CITI.

The Federal Circuit has defined a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be a recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

J & J Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991). The fact that opposer has used and registered numerous marks incorporating CITI is not in itself sufficient to establish the existence of a family of marks. Opposer must demonstrate that the marks, or a number of them, have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition of common ownership based upon a feature common to each mark. *See Eveready Battery Co. v. Green Planet Inc.*, 91 USPQ2d 1511, 1514 (TTAB 2009).

Opposer contends that it has made the requisite showing inasmuch as opposer “has employed its CITI Marks as a family of marks, in the sense that the ‘master’ mark CITI or another key family mark (e.g., CITIBANK) is used along with one or more CITI Marks in association with each other.”¹⁸

The record supports opposer’s contention. An internet advertisement of 2008 for opposer’s “global transaction services” displays, on a single page, the word marks CITI, CITIBANK, CITIMANAGER, CITIDIRECT, and the logo .¹⁹ A brochure from at least as early as 1999 for a product called the CITIGOLD account also displays (on its cover alone) the marks CITICORP, CITIBANK, CITICARD, and THE CITI NEVER SLEEPS. Inside the brochure are numerous additional references to the same marks, including a single paragraph that reads:

Full-service Citicard Banking Center locations (Citibank ATMs) are ideal for your ‘round-the-clock financial needs. Plus, CitiGold customers can get higher daily cash withdrawals at any Citicard Banking Center location.²⁰

A 1994 brochure for a credit card displays the marks CITIBANK and CITIMILES and refers to the product as the “Citibank CitiMiles Card.”²¹ A 1994 newspaper advertisement displays the marks IT’S YOUR CITI, CITIBANK, CITICARD, CITICORP, and THE CITI NEVER SLEEPS.²² A 2012 internet advertisement for

¹⁸ Opposer’s brief at 10.

¹⁹ Moses 30:6-16 and Exhibit 36. *See also* Exhibit 37 (similar advertisement of 2010).

²⁰ Moses 35:7-20 and Exhibit 39.

²¹ Moses 83:14-23 and Exhibit 188.

²² Moses 104:13-17 and Exhibit 575.

CITI commercial cards bears the CITI logo and the marks CITIBANK, CITIMANAGER, and CITIDIRECT.²³

We find that opposer has used and advertised numerous marks that incorporate the designation CITI in such a manner as to create common exposure and recognition of common ownership and has thereby demonstrated that it owns a family of marks.

B. The fame of opposer's family of marks.

Opposer maintains that its family of marks is famous. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992). Because of the extreme deference that we accord 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 that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

For purposes of a claim of likelihood of confusion, fame arises if a “significant portion of the relevant consuming public ... recognizes the mark as a source

²³ Moses 103:3-104:5 and Exhibit 66.

indicator.” *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed Cir. 2005). Fame for likelihood of confusion purposes may be measured indirectly by the volume of sales of the goods or services sold under the mark, advertising expenditures, and other factors such as length of time of use of the mark; widespread critical assessments; notice by independent sources of the products identified by the marks; and the general reputation of the products and services. *Bose Corp.*, 63 USPQ2d at 1308.

By the testimony of Mary Ann Villanueva, opposer entered into evidence its annual reports for the years 2008 through 2011. In the 2011 report’s discussion of North America Regional Consumer Banking (“NA RCB”), the report states:

At December 31, 2011, *NA RCB* had \$38.9 billion of retail banking loans and \$148.8 billion of deposits. In addition, *NA RCB* had 22.0 million Citi-branded credit card accounts, with \$75.9 billion in outstanding card loan balances.

The accompanying financial statements indicate, for 2011, \$10,367,000,000 of net interest revenue and \$3,247,000,000 of non-interest revenue. Opposer’s witness confirmed her belief that these reports were accurate and reliable, and stated that United States operations would represent upwards of 90% of the figures shown for North America.²⁴ Between 2009 and 2010, net interest revenue ranged between approximately \$5.2 and \$11.2 billion; and non-interest revenue ranged between approximately \$3.3 billion and \$3.5 billion.²⁵

²⁴ Villanueva 26:9-29:17 and Exhibit 564. (The exhibit is at #39.)

²⁵ Villanueva 30:3-33:10 and Exhibits 562 (#41) and 563 (#40).

In confidential testimony and submissions, opposer made of record information regarding its annual expenditures on CITI-branded advertising;²⁶ the number of direct mail pieces that are sent annually to existing credit card holders and non-card-holders;²⁷ the number of unique visitors to opposer's online portal that allows account-holders access to their account information;²⁸ the number of commercial entities that issue opposer's credit cards to their employees and the number of such issued cards.²⁹ All of these disclosed figures are extremely impressive.

As confidential submissions, opposer has made of record corporate image tracking research³⁰ performed in 1990 and 1995 relating to the CITIBANK brand. Each study shows extremely high total awareness of the brand and substantial degrees of familiarity with the brand and awareness of advertising.³¹ Opposer also submitted results of a 2011 survey relating to the CITI brand, indicating highly positive levels of awareness characterized as "familiar" and "very familiar"; a report

²⁶ Villanueva 45:6-16.

²⁷ Villanueva 36:2-15; 61-64 and Exhibit 103.

²⁸ Villanueva 66-67 and Exhibit 104.

²⁹ Moses 64:2-65:2; 67:2-3.

³⁰ The research materials discussed here were submitted as "business records of opposer." Anthony Michelini, opposer's Director of Global Branding, explained and interpreted the research reports at deposition. Although he did not perform the research himself, he testified that in his view the research was performed in accordance with industry standards (Michelini 11:8-11 etc.) and that his position involved supervising, contracting for, and interpreting the results of such studies. (Michelini 8:1-9.) Although applicant stated at deposition a vague objection to Mr. Michelini's "Continuing to give expert qualification as to the other witnesses" (Michelini 9:11-13), applicant did not object to the admission of the research reports, nor was any objection to their admission stated in applicant's brief.

³¹ Moses 58:19-59:25 and Exhibits 101 and 102; Michelini 12-15.

of awareness of CITI credit card services between 2008 and 2012, showing extremely high aided awareness; and a 2008 “BrandZ” report on brand awareness, prepared independently by MillwardBrown Optimor, indicating extremely high levels of aided (“total”) awareness of the CITIBANK brand between 2002 and 2007.³²

Applicant criticizes the probative value of the brand-tracking studies because they did not focus on “brand awareness in the travel services industry” but rather “were relegated to Citibank’s brand awareness in the financial services industry.”³³ It bears noting that the studies do not purport to show a relationship between opposer’s services and those of applicant; or the likelihood that the public would perceive a CITI- mark used in the travel industry to be related to opposer. Rather, they purport to demonstrate the levels of awareness of opposer’s brand among the public. The members of the public who were surveyed were not limited to the financial services industry. The individuals surveyed in the 1990 and 1995 research were “adults who participate in financial decisions.” In the 2011 and 2012 surveys, the subjects were “a random national sample of ... consumers (age 21+)....” Both target groups were sufficiently broad to include substantial overlap with the class of customers for travel services. Accordingly, we cannot agree with applicant’s contention that the surveys were too limited in scope, in view of the purpose for

³² Micheline 17-29 and Exhibits 96 and 99.

³³ Applicant’s brief at 18.

which they were designed and the purpose for which they are proffered in this proceeding.³⁴

Applicant also points out that the survey figures for “unaided awareness” of opposer’s brands³⁵ are not nearly as impressive as those for “aided” (or “total”) awareness.³⁶ This is, of course, true. Opposer pointed out, at oral argument, that the number of banks and other financial institutions in the U.S. market is very large. This is an apt point, as the crowded field greatly diminishes the likelihood that a particular institution would be included in a person’s answer to an unaided awareness question, making the test a very difficult one to pass. (This might not be the case in industries that include only a small number of competing companies.) Although opposer’s unaided awareness figures were very much smaller than its aided awareness figures, they do not, in our view, reflect poorly on opposer’s level of renown. Although the percentages are modest, they do nonetheless reflect a substantial level of public recognition.

Opposer has promoted its brand through sponsorship of various cultural events and activities. Opposer has sponsored the U.S. Olympic and Paralympic teams. It has sponsored some World Tennis Association tournaments under the mark Citi Open. It has given its name to the Citi Performing Arts Center in

³⁴ The record does not contain information regarding the individuals represented in the BrandZ data.

³⁵ Typical questions for testing unaided awareness, as illustrated in the 2011 and 2012 surveys, are “When you think about credit card brands or issuers, what are the credit card brands or issuers that come to mind?” and “When you think about financial service providers [i.e., banks, credit card brands and issuers, investment firms and brokerages], what are the financial service providers that come to mind?”

³⁶ Applicant’s brief at 19-20.

Boston; Citi Pond in Bryant Park, New York City; and CitiField, the stadium of the New York Mets baseball team, in connection with which it holds events called Citi Tuesdays.³⁷

Opposer has also submitted evidence of press notices indicative of a high degree of notoriety in the United States over a long period of time. A 1968 story in *Business Week* regarding corporate reorganizations at “the nation’s third largest bank” stated, “Citibank has always shown a distinct flair for doing things differently through all its long history.”³⁸ A lengthy 1981 profile of Citibank in *The New Yorker* stated, “Citibank strives to be, and to a marked extent is, the quintessential world money machine”; and “In the little world of banking, if such a world may be described as little, Citibank is identifiable as the coolest of characters.”³⁹ In 1983, *The New York Times Magazine* described Citicorp as “The world’s largest and most powerful banking organization.”⁴⁰ In 1987, *Fortune* referred to Citicorp as “that 30-foot python among U.S. banking companies” and “The pluperfect money center bank.”⁴¹ In 2004, *The New York Times* referred to Citigroup as “the biggest credit card company in the world” and referred to Citibank

³⁷ Moses 45:8-25; Villanueva 17:18-18:7; *see also* Villanueva 56:15-23 and Exhibit 166 (national television advertisement promoting Citi ThankYou credit card in connection with London Olympics).

³⁸ “Why Citibank is more than a bank,” *Business Week*, November 16, 1968, p. 78 ff., at 79.

³⁹ “The Money Machine,” *The New Yorker*, January 5, 1981, pp. 41-60, at 44.

⁴⁰ “Inside Citicorp: The changing world of banking,” *The New York Times Magazine*, May 29, 1983, p. 15.

⁴¹ “Citibank Wows the Consumer,” *Fortune*, June 8, 1982, pp. 48 ff., at 48.

as “a marquee name” in the field.⁴² *Financial Services Marketing* referred to Citibank as “a \$900 billion financial aircraft carrier, the largest banking company in the nation (with J.P. Morgan Chase and Bank of America plying its wake.”⁴³ *Business Wire* referred to “Citi’s leadership role in financial services and on the Internet.”⁴⁴ In 2008, *American Banker* reported that “Citigroup Inc. has landed the largest contract to date to issue government travel cards.”⁴⁵ In 2012, *The Washington Times* reported on Citibank’s use of Facebook, stating, “Citibank’s new rewards program tries to set itself apart....”⁴⁶

The evidence discussed above indicates extensive public recognition and renown of the CITI and CITIBANK brands. It also indicates that opposer has effectively promoted the CITI and CITIBANK brands in conjunction with other marks that incorporate the designation CITI. We therefore find that opposer has demonstrated that its family of marks is famous for purposes of an analysis of likelihood of confusion.

⁴² “Citigroup Says It Will Issue American Express Cards,” *The New York Times*, December 14, 2004, Section C, p. 1.

⁴³ “Living Richly at Citibank Means There’s More to Life Than Money,” *Financial Services Marketing*, March 20, 2001, p. 12.

⁴⁴ “Citi Cards Web Site Ranked #1 by Watchfire GomezPro; Citi Cards Site Top-Ranked for Fifth Consecutive Period,” *Business Wire*, March 22, 2004.

⁴⁵ “Citi Wins Contract To Issue Travel Cards For Defense,” *American Banker*, February 21, 2008, p. 6.

⁴⁶ “Citibank links card rewards to Facebook,” *The Washington Times*, January 4, 2012, Section A, p. 9.

C. The marks at issue.

We next consider the similarity or dissimilarity of the marks at issue in terms of appearance, sound, meaning, and overall commercial impression. We base our determination on a consideration of the marks in their entireties. *In re National 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 23, 234 (CCPA 1981). However, an analysis of individual aspects of the marks is a permissible part of our determination. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). We also bear in mind that we have found opposer's family of marks to be famous, and that a famous mark "casts a long shadow which competitors must avoid." *Bose v. QSC*, 63 USPQ2d at 1305). *See also Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("The Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark"). Famous marks are given a broad scope of protection "because of the tendency of the consuming public to associate a relatively unknown mark with one to which they have long been exposed if the mark bears any resemblance thereto." *R. J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 USPQ 856, 860 (TTAB 1978).

We note initially that applicant's mark encompasses the entirety of the mark CITI. Opposer owns four registrations of the mark CITI (two in standard character form and two in special form) and considers CITI to be the "master" mark of its

family of marks.⁴⁷ Applicant's mark differs from the mark CITI by virtue of the added component –AIR. However, in applicant's field of travel booking, in which air travel is a featured offering, the designation AIR has only very weak distinguishing power.

As was discussed above, opposer has demonstrated that it uses a family of marks which are built upon the common designation CITI. Opposer's witnesses contend that the protocol for developing marks for the family is to apply CITI as a prefix to a common word that is descriptive or generic for the services offered. *See* Moses 61:17-18 ("most frequently the terms that follow the Citi mark are descriptive...."); and 98:24-99:2 ("Most of the time the Citi mark as a prefix and then as a suffix something descriptive of the goods or services being offered." [*Sic*].) *See also* Villanueva 20:3-8 ("we do have part of the brand strategy and architecture that is developed by which the master brand is at the top of the house, lines of business are named Citi lines of business, and the products have a naming protocol that follow Citi plus product name.") This contention as to opposer's naming strategy is borne out by opposer's registrations, which demonstrate opposer's ownership of marks including CITIBANK, CITIGROUP, CITITRAVEL, CITIRAIL, CITIBUSINESS, CITI CASHRETURNS, and others that conform to the same format.

It is apparent that applicant's mark, too, conforms to the format of opposer's demonstrated family of marks. In the field of applicant's identified services, *i.e.*,

⁴⁷ Moses 20:14-24; Villanueva 19:25-20:11.

travel booking, the word “air” is at least highly descriptive of a type of transportation that may be booked for customers. Indeed, applicant has confirmed that “99.9 percent” of its service is to offer “air tickets.”⁴⁸ Accordingly, applicant’s mark closely resembles in its structure the marks in opposer’s family of marks.

It is true that the -AIR component of applicant’s mark causes it to differ somewhat in sound and meaning from the marks of opposer. However, we note that CITIAIR and CITITRAVEL are more similar in meaning than different, especially when we consider that -AIR clearly refers to air travel. In any event, the similarity of applicant’s mark to the structural aspects of opposer’s family of marks substantially diminishes the impact of any differences in sound or meaning. Thus, those accustomed to seeing opposer’s family of marks, which employs variations of the CITI mark in connection with a variety of services, would be likely to consider applicant’s mark — comprising CITI with a descriptive suffix — as an extension of opposer’s CITI family of marks.

We note applicant’s argument that the designation CITI-, as used in its mark, means “enlightened” or “godly” in the Tamil language.⁴⁹ However, there is no evidence of the extent to which persons in the United States marketplace would appreciate this meaning. Nor is there any reason why those who perceive this meaning in applicant’s mark would not also perceive it in opposer’s marks.

Finally, we note the design element of applicant’s mark, which depicts an airplane in flight within an incomplete oval. Applicant’s design element has limited

⁴⁸ Raj Test. 24:11-12.

⁴⁹ Applicant’s brief at 25-26.

ability to distinguish applicant's mark from opposer's marks. Customers would primarily use the word component of the mark, CITIAIR, in referring to and requesting applicant's services. Accordingly, we give greater weight to the word component than to the design. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1911 (Fed. Cir. 2012); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Further, in applicant's field, the image of the airplane is very highly suggestive of the air travel that applicant offers to arrange; and it confirms to customers who see the mark that the component -AIR does indeed refer to air travel. We note also that opposer has used airplane designs in connection with advertisements for the CITI AADVANTAGE program (co-branded with American Airlines);⁵⁰ and its CITIMILES credit card services.⁵¹

In view of the foregoing discussion, we find that the *du Pont* factor of the similarity or dissimilarity of the marks favors a finding of likelihood of confusion.

D. The parties' services.

We turn next to consider the similarity or dissimilarity of the services of the parties. Applicant seeks registration of its mark for "travel booking agencies." It was made clear in the record that applicant's services in the United States have consisted almost entirely of providing air travel tickets for travel between India and

⁵⁰ Baum 18:6-8, 53-55 and Exhibits 4 and 5.

⁵¹ Villanueva 70:19-72:6 and Exhibit 188 see also Moses 83:14-23.

the United States; however, as applicant appears to concede in its brief,⁵² we may not consider that limitation because it is not reflected in the identification of services in the application. *Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Among opposer's pleaded registrations, we note that opposer owns a registration of CITITRAVEL for:

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*;

Benefits programs offered to credit card holders, namely, *travel planning services in the nature of making reservations and booking for temporary lodging*.⁵³

Opposer also contends that its credit card services have numerous points of contact with travel services. For example, for 25 years opposer has issued a CITI AADVANTAGE credit card that is co-branded with American Airlines.⁵⁴ By using the credit card, the customer earns points or credits that can be redeemed for air travel on American Airlines.⁵⁵ Opposer also issues a CITIMILES credit card

⁵² *Id.* at 27.

⁵³ Reg. No. 2954363 (emphasis supplied).

⁵⁴ Moses 82:8-11. AADVANTAGE is a trademark of American Airlines.

⁵⁵ See Villanueva 50:15-21 and Exhibit 156 (2006 television advertisement for CITI AADVANTAGE credit card: "There's no substitute for a real vacation... so call now to apply for the Citi Advantage Card and you'll be on a fantastic vacation in no time. That's because every dollar you spend on purchases... earns you one American Airlines AAdvantage Mile with no blackout dates.")

through which users earn credits for use on a number of participating airlines; however, testimony indicates that that program may be winding down.⁵⁶ Opposer has also co-branded credit cards with Hilton Hotels (the CITI HILTON HHONORS card) and the internet-based travel service Expedia.⁵⁷ Most significantly, opposer's CITITRAVEL service offers its credit card customers discounts on airfare, hotels, and dining as a benefit of being a credit card customer.⁵⁸

Applicant points out that opposer is fundamentally a financial services company, not a travel services company; that the services identified in the CITITRAVEL registration and described in the foregoing paragraph are not travel services, but benefits programs offered by a credit card company as an inducement to existing bank customers to make greater use of opposer's core banking and credit card services; that such "value propositions" offered to existing customers are "not services in and of themselves but rather marketing tools ... to sell more of Citibank's core financial services."⁵⁹ Applicant appears to admit that there is a relationship between opposer and American Airlines, but argues that "the relationship, at its core, is one of a cross-marketing opportunity"; and that "Such a relationship does not transform Citibank into a travel services company."⁶⁰

Applicant's argument is not wholly persuasive. It is obvious that opposer is not a travel agent. However, opposer's cross-marketing efforts and its promotion of

⁵⁶ Moses 82:12-16; Villanueva 14:18-15:15.

⁵⁷ Moses 82:17-20.

⁵⁸ Moses 82:20-25.

⁵⁹ Applicant's brief at 27-29.

⁶⁰ *Id.* at 30.

its core services by means of “value propositions” involving travel have the effect of exposing customers to many of the CITI marks in contexts in which the customers enter into commercial transactions for travel services. The CITITRAVEL benefits program is administered by a third-party, but its use of the mark and other CITI designations inures to the benefit of opposer. *See* Moses 84-87 and Exhibit 23, which shows a brochure detailing the CITITRAVEL program and offering a wide array of travel services, including bookings for air travel, hotels, cruises and car rentals. The brochure states, “CitiTravel is a full-service travel agency, chock-full of money- and time-saving services.” The brochure includes a telephone number for making reservations: “Call 1-800-CITI-234 (1-800-248-4234) to make all your airline, hotel, car rental, tour and cruise reservations.” It also includes a “Specials Hotline” with the telephone number “1-800-647-CITI.” The back page of the brochure states, “CitiTravel is a registered service mark of Citicorp.” Opposer’s Director of Global Branding testified that, at the time of trial, the CITITRAVEL mark had been in use for 4 to 5 years.⁶¹

The record also includes extensive testimony regarding opposer’s credit card rewards program under the mark CITI THANKYOU, which is registered for “credit card services.”⁶² Under the CITI THANKYOU program, participants earn points for credit card use and banking activity, and the points can be redeemed for travel,

⁶¹ Villanueva 14:8-15.

⁶² Reg. No. 3948111. (Although opposer also pleaded ownership of Reg. No. 3956034 for the same mark, opposer did not file evidence of this registration’s status and title.)

merchandise, gift cards, and statement credits.⁶³ In confidential testimony, opposer disclosed that in recent years a substantial percentage of redemptions have been for airfare at an extremely substantial dollar value.⁶⁴ Opposer's witness described the "Citi ThankYou travel center" website as follows:

It looks very similar to any other online travel site. You input where you want to go, whether it is in a flight or a hotel, travel package or cruise, and it pulls up the options that are available. ... So it is very similar to going to any other online site. The only difference is you can use points.⁶⁵

On the redemption website, a booking may be made on any airline.⁶⁶ A 2011 television advertisement for the program emphasizes this feature, as well as other features relating to air travel.⁶⁷ A brochure for the CITI THANKYOU program states:

Let us reward you with the things you love.

Choose from an amazing collection of rewards –

...

Redeem your ThankYou Points for:

- Gift cards for your favorite stores
- Travel, from flights to hotels and more
- The latest electronics

⁶³ Hines 8:1-12.

⁶⁴ Hines 14:20-21 and 15:9-20.

⁶⁵ Hines 11:3-12 and Exhibit 84 (printout of redemption website).

⁶⁶ Hines 54:2-4.

⁶⁷ Exhibit 162 (storyboard) ("In addition to 50,000 ThankYou Points you also get a companion airline ticket on us, right away and another airline ticket every year after that.")

- Almost anything you want, with Your Wish Fulfilled⁶⁸

Besides the mark CITI THANKYOU, the brochure is branded with the marks CITI, CITI REWARDS, and CITIBANK, and makes reference to the designations CITIGOLD, CITI MOBILE, CITIPHONE BANKING, CITI PRIVATE BANK, 1-888-CITIBANK, CITIBUSINESS, and others.

The evidence of record establishes that opposer has used the registered mark CITITRAVEL in connection with “making reservations and bookings for transportation” (services identical to those identified in applicant’s application). Moreover, the evidence shows that the public has been exposed to many of the CITI marks in connection with a variety of travel-related services. Accordingly, we find a significant commercial relationship between opposer’s business and applicant’s identified services. The *du Pont* factor of the similarity or dissimilarity of the parties’ services favors a finding of likelihood of confusion.

E. Channels of trade; Marketing of the services.

Applicant, in its discussion of the manner in which it markets its services, endeavors to show a stark contrast between the simplicity of its marketing techniques and the elaborate and extensive marketing efforts of opposer. Applicant contends that it promotes its services by in-person distribution of business cards in Indian stores and Indian cultural festivals; through e-mail marketing; by advertising on search engine sites directed towards the Indian population; and

⁶⁸ Exhibit 83; *see* Hines 32:22-12.

through its own websites (including a website located at <citiairtravel.com> that “incorporates an online booking engine”).⁶⁹ Unlike opposer,

CitiAir does not sponsor athletic venues. CitiAir does not advertise on television. CitiAir does not advertise in papers. CitiAir does not advertise by direct mailings. CitiAir does not advertise in airports.

...

CitiAir does not purchase lists of email addresses of non-customers but only uses this form of advertising to existing customers who have opted-in to receive such emails....⁷⁰

Applicant also argues that it currently does not maintain any physical location at which consumers may purchase its services, unlike opposer, which maintains a thousand branch locations and ATMs in 6000 locations.⁷¹

In our analysis, we may not consider applicant’s likely trade channels to be as limited as applicant contends. Since applicant’s recitation of services contains no limitations as to channels of trade, we presume that applicant’s services move in all channels of trade normal for those services. *See Octocom*, 16 USPQ2d at 1787. Advertising in newspapers of general circulation, direct mailings, e-mail advertising not only to existing customers but to new prospects, and advertising on search engines of interest to the general public are all ordinary advertising channels for a travel booking service. Although applicant currently has no “brick and mortar” locations, applicant admits that it does have aspirations to establish such physical locations in “key hubs,” such as San Francisco, Dallas, Houston, Washington, D.C.,

⁶⁹ Applicant’s brief at 35-39; 40.

⁷⁰ Applicant’s brief at 37 (citations omitted).

⁷¹ *Id.* at 40.

New York, New Jersey.⁷² As opposer's extensive advertising program indicates that it has a presence in all of these channels, it is not unlikely that customers may be exposed to the marks of both parties.

Applicant points out that the credit card travel benefits of opposer are not available to the general public; rather, they are available only to existing customers of opposer:

[I]n 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. 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.⁷³

Applicant's characterization does not acknowledge the fact that non-customers of opposer would be reached by opposer's advertising and thereby be exposed to opposer's marks in connection with offers of travel-related services. The record shows that opposer maintains extremely large lists of "acquisitions" (or prospective customers) and that it advertises to them through extensive direct mail and email campaigns.⁷⁴ See Baum 19, Exhibits 4 and 5 (direct mail advertisements for CITI AADVANTAGE card, sent to prospects, advertising "ALL NEW TRAVEL BENEFITS"); Hines 28:11-29:8 and Exhibit 81 ("acquisition direct mail pieces" with many references to travel benefits); Hines 44:1-46:8 and Exhibit 87 ("acquisition site for the Citi Forward card" "where you apply for a Citi Forward card."); Hines

⁷² Raj Disc. 26-27.

⁷³ Applicant's brief at 41 (citations omitted).

⁷⁴ Villanueva 61-64 and Exhibit 103; Baum 19; Hines 19:12-22.

46:25-49:4 and Exhibit 89 (“the ThankYou Premier acquisition website,” with reference to redemption of points “for airfare through the ThankYou Travel Center.”)

Considering all of the foregoing, the ordinary and likely trade channels for “travel booking” services, as identified by applicant, overlap substantially with the trade channels through which opposer advertises its services. Accordingly, this *du Pont* factor favors a finding of likelihood of confusion.

F. Customers.

Applicant briefly points out that its services are targeted to “cost-conscious Indian consumers” who seek “cheap airfare” between India and the United States.⁷⁵ Assuming that this is true, it is nonetheless not a relevant factor in our analysis, because applicant’s identification of services is not limited to any particular class of customers. Since the scope of the registration applicant seeks is defined by its application (and not by applicant’s current activities), we must consider that applicant may offer its services to all ordinary customers for “travel booking agencies.” *Octocom*, 16 USPQ2d at 1787. In any event, opposer has submitted substantial evidence and testimony to show that persons of Indian nationality are an important component of opposer’s target customer base.⁷⁶

G. Absence of actual confusion.

Applicant points out that there is no evidence of actual confusion involving the parties’ marks, despite co-existence in the marketplace since 2009; and argues

⁷⁵ Applicant’s brief at 35.

⁷⁶ Nariman 10:22; 13:6-18; 14:3; and Exhibits 109-111.

that this factor should weigh against a finding of likelihood of confusion. Opposer argues in response that a lack of evidence of actual confusion is not surprising because opposer has been in operation a relatively short time, with modest revenues,⁷⁷ has been offering booking services on its website for less than a year,⁷⁸ and has no “brick and mortar” locations. We agree, and note also the limited extent of applicant’s marketing efforts, as discussed above in Section VI(E). *See In re Majestic Distilling Co., Inc.*, 65 USPQ2d at 1205 (“A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight, *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 964, 144 USPQ 435, 438 (CCPA 1965).”). Under the circumstances, we find the lack of evidence of actual confusion to be a neutral factor in our analysis of likelihood of confusion.

H. Extent of potential confusion.

Opposer, in its brief, argues with respect to a number of *du Pont* factors as to which applicant has not responded. Among these, we take particular note of opposer’s discussion of the extent of potential confusion. Opposer points out that its CITI-branded consumer credit card business alone has 22 million cardholders in North America, most of which are in the United States.⁷⁹ As we have noted, it is through its credit card operations that opposer is most involved in marketing travel-

⁷⁷ Raj Disc. 35.

⁷⁸ Raj Test. 29:17-30:9.

⁷⁹ Applicant’s brief at 38; *see Villanueva* 26:9-29:17 and Exhibit 564.

related services. We agree that the very large scope of opposer's business indicates an increased potential for any confusion to have a substantial – rather than a *de minimis* – impact. Accordingly, this *du Pont* factor weighs in favor of a finding of likelihood of confusion.

VII. Conclusion.

We have considered all of the evidence of record and all arguments of the parties relevant to the issues before us, including those not specifically discussed herein. Our analysis of the *du Pont* factors leads us to find that applicant's mark, as used in connection with the identified services, so closely resembles opposer's earlier used family of marks as to be likely to cause confusion, mistake or deception as to the source of applicant's services.

Decision: The opposition is sustained on the ground of likelihood of confusion and registration of applicant's mark is refused. In view of our decision, we do not reach opposer's claim of dilution.