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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Centennial Communications Corp.

Serial No. 76283603

Paul H. Kochanski of Lerner, David, Littenberg, Krumholz & Mentlik, LLP for Centennial Communications Corp.

Karen Bush, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

Before Hairston, Grendel and Rogers, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

Centennial Communications Corp. seeks registration on the Principal Register of the mark NAP OF THE CARIBBEAN (in standard character form) for services ultimately identified as "telecommunications services, namely, providing central connection points for telecommunication network carriers" in International Class 38.¹

¹ Application Serial No. 76283603 was filed on July 10, 2001, based upon applicant's assertion of its bona fide intent to use the mark in commerce.

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Registration has been finally refused under Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1), on the ground that, when used in connection with applicant's services, the mark is merely descriptive of them. Registration also has been finally refused under Trademark Act Section 2(d), 15 U.S.C. §1052(d), on the ground that applicant's mark, when used in connection with its services, so resembles the mark NAP OF THE AMERICAS, which is registered for, inter alia, "telecommunications services, namely, electronic voice messaging, namely, the recording and subsequent transmission of voice messages by telephone; electronic transmission of messages and data; electronic mail, telephone voice messaging, facsimile transmission services, long-distance telephone communication services, and providing multiple-user access to a global computer network; providing telecommunications connections to a global computer network for telecom hoteling; providing multiple-user access to a global computer information network; and consultation in the field of telecommunications, namely, telecommunication services relating to network access points" in International Class

38,² as to be likely to cause confusion.

Applicant has appealed, and briefs have been filed.

Refusal Under Trademark Act Section 2(e)(1)

The trademark examining attorney maintains that the mark NAP OF THE CARIBBEAN describes a feature, function or purpose of the identified services. Specifically, the examining attorney argues that:

In the present situation, the wording NAP OF THE CARIBBEAN used in relation to the services of "telecommunication services, namely, providing central connection points for telecommunications carriers" clearly describes a feature, function or purpose of those services. As seen from the previously submitted evidence and acronym dictionary excerpt, the term "NAP" stands for "network access points," and the term "CARIBBEAN" identifies a geographic location. The phrase NAP OF THE CARIBBEAN immediately describes a feature, function or purpose of the telecommunication services that [provide] central connection points for telecommunication network carriers. The central connection points are network access points located in the Caribbean; in other words the services are a NAP OF THE CARIBBEAN. (Brief, unnumbered p. 3).

In support of the refusal, the examining attorney submitted the results of a search of "nap" from the "Acronym Finder" online database, which indicates that NAP stands for, inter alia, "Network Access Point." In

² Registration No. 3214416 issued March 6, 2007 under Trademark Act Section 2(f); the term NAP is disclaimed. The registration also covers services in International Classes 39 and 42. However, the examining attorney's refusal of registration is not based on the services in either of these classes.

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addition, the examining attorney submitted a "Wikipedia" entry for the term "Caribbean" which indicates that it is a region of the Americas consisting of the Caribbean Sea, its islands and the surrounding coasts. Also, the examining attorney submitted four Internet printouts containing references to NAP and "Network Access Point." The following are excerpts from the printouts:

Terremark's flagship facility, the NAP of the Americas®, is one of the most significant telecommunications projects in the world. The Tier-IV facility was the first-purpose built, carrier-neutral Network Access Point and is the only facility of its kind specifically designed to link Latin America with the rest of the world.
www.terremark.com

Headline: Sprint International Joins NAP - Network Access Point - Of The Americas, LLC Consortium; Members Now Total 87
www.allbusiness.com

Headline: Dominican Government spurs the Network Access Point
President Leonel Fernandez issued a Special Power that creates the mechanism to develop the Network Access Point (NAP) of the Caribbean in Dominican Republic, a high technology project being built at a cost surpassing 40 million dollars.
www.DominicanToday.com

Headline: NAP of the Caribbean starts operating in Dominican cyber park
Santo Domingo - The first phase of the Network Access Point (NAP) of the Caribbean, an ambitious project in Santo Domingo Cyber Park, started to provide its services for Dominicans and foreigners.
www.DominicanToday.com

Applicant, in urging reversal of the refusal, contends that its mark as whole is not merely descriptive of the identified services, and that the examining attorney has improperly dissected its mark by focusing on the individual terms NAP and CARIBBEAN. Applicant argues that even these terms are not descriptive of telecommunication services because at best NAP describes a physical object and CARIBBEAN describes a physical location. Applicant also maintains that NAP OF THE CARIBBEAN creates a double entendre; that is, the term "nap" means a short sleep or period of relaxation and the term "Caribbean" means a destination with a reputation where one can go to unwind, or relax; and that when combined, the phrase NAP OF THE CARIBBEAN "connotes a laid-back, relaxed, easy-going type of impression." (Brief, p. 9).

A term is deemed to be merely descriptive of goods or services, within the meaning of Trademark Act Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's

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goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being use or intended to be used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Moreover, it is settled that "[t]he question is not whether someone presented with only the mark could guess what the goods or services are. Rather, the question is whether someone who knows what the goods or services are will understand the mark to convey information about them." *In re Tower Tech Inc.*, 64 USPQ2d 1314, 1316-17 (TTAB 2002); See also *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990); and *In re American Greetings Corporation*, 226 USPQ 365 (TTAB 1985). The "average" or "ordinary" purchaser is the class or classes of actual or

prospective customers of applicant's goods or services. In re Omaha National Corporation, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

We agree with the examining attorney that the mark sought to be registered is merely descriptive of the identified services. The acronym finder evidence shows that the letters NAP are an abbreviation or acronym for "network access point." The Internet excerpts show the same information. Applicant's identified telecommunications services of "providing central connection points for telecommunication network carriers" clearly encompass providing a network access point for telecommunication network carriers. Thus, the acronym NAP is and would be readily understood by relevant purchasers to be substantially synonymous with the merely descriptive term "network access point." Indeed, in the Internet excerpts made of record (two of which appear to reference applicant's services), the acronym NAP appears in close conjunction with, or as an obvious alternative to, the words "network access point." This matter of usage clearly demonstrates that relevant purchasers would readily understand and use the acronym NAP when referring to applicant's services of providing central connection points for telecommunication network carriers. We thus find that

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NAP has descriptive significance when used in connection with applicant's services. Furthermore, the term CARIBBEAN has geographic descriptive significance when used in connection with applicant's services in that it conveys that telecommunication network carriers would use applicant's services to link the Caribbean to other areas of the world.

We also find that the composite mark NAP OF THE CARIBBEAN is equally descriptive. The individual terms NAP and CARIBBEAN do not somehow lose their descriptive significance in the combination NAP OF THE CARIBBEAN. Rather, when used in connection with applicant's telecommunication services of providing central connection points for telecommunication network carriers, the mark NAP OF THE CARIBBEAN immediately describes a feature of such services, that is, providing a network access point for telecommunication network carriers to link the Caribbean to other parts of the world. The words "of the" actually reinforce the likelihood that the term NAP will be viewed as indicating something located in or associated with the Caribbean region. Thus, the combination of the terms does not alter the descriptive meanings of NAP or CARIBBEAN, but reinforces such meanings.

Applicant's argument that the term NAP has another meaning and, thus, the mark is a double entendre is not persuasive. It is well-settled that mere descriptiveness is determined in relation to the goods or services for which registration is sought. As indicated earlier, that a term may have a different meaning in a different context is not controlling. The fact that the word "nap" means a short sleep or period of relaxation is irrelevant in the context of applicant's particular services. Furthermore, in each of the double entendre cases cited by applicant, the secondary interpretations that make each expression a double entendre consist of an association that the public would make quite readily. In this case, we are not convinced that purchasers would readily associate a short sleep or period of relaxation with NAP OF THE CARIBBEAN. There is nothing of record to indicate that visitors to the Caribbean "nap" any more than visitors to other regions of the world, or that, even if the record did establish this point, that prospective purchasers of applicant's services would be aware of the purported practice. Thus, we find that applicant's mark is not analogous to the marks involved in the cases cited by applicant.

For the foregoing reasons, we find that NAP OF THE CARIBBEAN is merely descriptive of applicant's services of

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providing central connection points for telecommunication network carriers.

Refusal under Trademark Act Section 2(d)

Our determination under Trademark Act §2(d) is based upon an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *In re E.I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

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

We review the relevant du Pont factors as they apply to this case. We begin by comparing applicant's services with those of registrant. Applicant's services are identified as "telecommunications services, namely, providing central connection points for telecommunication network carriers." Registrant's services include "consultation in the field of telecommunications, namely, telecommunication services relating to network access points." Applicant does not dispute that its services encompass or are closely related to registrant's services. Moreover, in view of the closely related nature of the respective services, we find that they would be offered in the same or overlapping trade channels and to many of the same purchasers, i.e., telecommunication network carriers. Accordingly, the du Pont factors of the similarity of the goods, trade channels and classes of purchasers favor a finding of likelihood of confusion.

Under the du Pont factor relating to conditions of purchase, we find that from the identifications of applicant's and registrant's services, they are of a type which would be purchased by, or in consultation with, persons knowledgeable in the telecommunications field. However, the fact that purchasers would typically be knowledgeable does not mean that they would be entirely

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immune from confusion as to source or sponsorship.

Wincharger Corp. v. Rinco, Inc., 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). We find that this du Pont factor weighs slightly against a finding of likelihood of confusion.

We turn now to a comparison of applicant's and registrant's marks when viewed in their entirety in terms of appearance, sound, connotation and overall commercial impression. See Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). The test under this du Pont factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result.

In this case, the marks are similar to the extent that they begin with the wording NAP OF THE and end with a geographical term; CARIBBEAN in the case of applicant's mark, and AMERICAS in the case of registrant's mark. The fact that the marks begin with the identical wording is not insignificant. Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ["...[it is] a matter of

some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."]. See also *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, supra.

In terms of meaning, the marks also are similar in that both connote a network access point for telecommunication network carriers to link a specific geographic area to other parts of the world. Applicant argues that the marks have different connotations based on the double entendre created by NAP OF THE CARIBBEAN. However, as previously indicated, we are not persuaded that the mark creates a double entendre. We also note that the registered mark uses the plural AMERICAS, not AMERICA, so it will be perceived as connoting the entire Western Hemisphere, which includes the Caribbean region.³ In short, we find that when applicant's mark and registrant's mark are considered in their entirety, they have similar connotations.

³ We take judicial notice that the Western Hemisphere includes "the western part of the terrestrial globe, including North and South America, their islands, and the surrounding waters." Random House Dictionary (2009). See *University of Notre Dame du Lac v. J.C. Gourmet Foods Imports Co.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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Furthermore, when applicant's mark and registrant's mark are considered in their entireties, the marks engender sufficiently similar overall commercial impressions so that, if the involved closely related services were offered thereunder, confusion would be likely to occur among purchasers. That is, it is reasonable to conclude that purchasers familiar with registrant's mark will view NAP OF THE CARIBBEAN as identifying a more specialized telecommunication service from registrant which serves to link the Caribbean to other parts of the world.

The du Pont factor of the similarity of the marks therefore favors a finding of likelihood of confusion.

Applicant, in contending that the marks are not confusingly similar, asserts that registrant's mark is descriptive and, therefore, entitled to a limited scope of protection. This argument, however, constitutes a collateral attack upon the validity of the registered mark and as such can only be entertained in the context of a petition to cancel. Furthermore, the issuance of the cited registration under Section 2(f) of the Trademark Act indicates that the mark shown therein had become distinctive of the registrant's services in commerce prior to the issuance of the registration. Thus, we cannot say

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that registrant's mark is weak and, therefore, entitled to a limited scope of protection.

In addition, applicant argues that there are numerous marks that include NAP for services in the telecommunications field, and that the commonality of this term is an insufficient basis upon which to find that the marks are confusingly similar. Applicant lists in its brief on the case three third-party registrations for marks that include NAP. As the examining attorney notes, applicant did not properly make these registrations of record. See *In re Duofold, Inc.*, 184 USPQ 638, 640 (TTAB 1974) ["[T]he mere submission of a list of registrations is insufficient to make them of record"]. Nonetheless, inasmuch as the record shows that NAP stands for "network access point," and registrant has disclaimed any rights in the term, there is no question that NAP has descriptive significance as used in connection with registrant's services. This does not aid applicant, however, as the term has the same meaning in both marks, cannot be ignored in the likelihood of confusion analysis merely because it is disclaimed, and our finding that the marks are confusingly similar is not based solely on the commonality of the term NAP, but on the overall structure of the marks, and the overlapping geographic connotations.

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In view of the foregoing, we conclude that purchasers familiar with registrant's consultation services in the field of telecommunications, namely telecommunication services relating to network access points, offered under the mark NAP OF THE AMERICAS would be likely to believe, upon encountering applicant's closely related telecommunication services of providing central connection points for telecommunication network carriers offered under its mark NAP OF THE CARIBBEAN that the services originated with or are associated with or sponsored by the same entity.

Decision: The refusals to register under Trademark Act Sections 2(e)(1) and 2(d) are affirmed.