

To: DANIEL P. BURKE(dburke@dpburke.com)
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Attachments

United States Patent and Trademark Office (USPTO)

U.S. Application Serial No. 79261503

Mark: C CARWIZ

Correspondence Address:

DANIEL P. BURKE
DANIEL P. BURKE & ASSOCIATES, PLLC
99 BLAIR ROAD
OYSTER BAY NY 11771
UNITED STATES

Applicant: CARWIZ International d.o.o.

Reference/Docket No. 2040-5

Correspondence Email Address: dburke@dpburke.com

EXAMINING ATTORNEY'S APPEAL BRIEF

International Registration No. 1386717

Applicant has appealed to the Trademark Trial and Appeal Board (“Board”), the trademark examining attorney's final refusal to register the mark "C CARWIZ" in stylized form and featuring a design, for "transportation services for passengers by road, especially transport of travelers by car, hired car; vehicle rental; chauffeur driven vehicle hire services; chauffeur services; rental of private vehicles; rental of vehicle roof racks; rental of automobile trailers” in International Class 39 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), on the ground that a likelihood of confusion exists

between the applicant's mark and the following marks owned by the registrant: U.S. Registration No. 6585636 for the mark "WIZZ" (in standard character form) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services" in International Class 39; U.S. Registration No. 6044872 for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services"; U.S. Registration No. 6044873 for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services"; and U.S. Registration No. 6039631 for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services".

FACTS

On June 20, 2019, applicant applied to register the mark "C CARWIZ", in stylized form and featuring a design, for services identified as "commercial business management; vehicle fleet (business management of a-) (for others); sale services related to vehicles" in International Class 35 and "transport; transport services; road transport services for passengers, especially transport of travelers by car, hired car, motor buses, armed vehicles; guarded transportation; transport by private vehicles; vehicle rental; chauffeur driven vehicle hire services; chauffeur services; rental of private vehicles; rental of vehicle roof racks; rental of garages and parking places; rental of automobile trailers; vehicle parking and storage; providing information relating to transport; transport consultancy; transport brokerage" in International Class 39. On July 3, 2019, the examining attorney partially refused registration of applicant's mark under Trademark Act Section 2(d) because applicant's mark was considered confusingly similar to the mark found in U.S. Registration No. 4566526. In addition, the examining attorney required applicant to amend the identification of services, submit a description of the mark, and clarify the colors being claimed in the mark. Finally, the examining attorney also advised applicant that marks in prior-filed applications, i.e., U.S. Application Serial Nos. 87718371, 87719958, 87720095, 87720156 for the marks "WIZZ", "WIZZ" (plus design), "WIZZ" (plus design), and "WIZZ" (plus design), may present a bar to registration of the applied-for mark pursuant to Section 2(d) of the Trademark Act should the prior-filed applications mature to registration. In a response filed

January 23, 2020, applicant satisfied the amendment of identification of services requirement by amending its identification to "transportation services for passengers by road, especially transport of travelers by car, hired car; vehicle rental; chauffeur driven vehicle hire services; chauffeur services; rental of private vehicles; rental of vehicle roof racks; rental of automobile trailers" in International Class 39. Additionally, applicant satisfied the requirements to submit a description of the mark and clarify the colors being claimed in the mark. Subsequently, on February 22, 2020, the trademark examining attorney suspended action on the instant application due to the aforementioned prior-pending applications and maintained and continued the partial refusal of registration based upon a likelihood of confusion with the mark found in U.S. Registration No. 4566526. On March 24, 2022, due to applicant's amended identification, the trademark examining attorney withdrew the partial refusal of registration based upon a likelihood of confusion with the mark found in U.S. Registration No. 4566526. However, the aforementioned prior-pending applications had since matured to registration resulting in a refusal of registration under Trademark Act Section 2(d) because applicant's mark was considered confusingly similar to the marks "WIZZ", "WIZZ" (plus design), "WIZZ"(plus design), and "WIZZ" (plus design) found in U.S. Registration Nos. 6585636, 6044872, 6044873, and 6039631. In a response filed on September 25, 2022, applicant set forth reasons why the Section 2(d) refusal should be withdrawn. In an Office action dated November 5, 2022, the examining attorney made final the Section 2(d) refusal. In a request for reconsideration filed May 5, 2023, applicant reiterated its arguments against the Section 2(d) refusal. On May 27, 2023, the examining attorney denied the request for reconsideration as it related to the Section 2(d) refusal. On May 5, 2023, applicant filed a notice of appeal with the Trademark Trial and Appeal Board ("TTAB"). On July 26, 2023, applicant filed its appeal brief and on July 28, 2023, the TTAB forwarded the file to the examining attorney for her brief.

ISSUE

The sole issue on appeal is whether applicant's stylized mark "C CARWIZ" (plus design) so resembles the registered marks "WIZZ", "WIZZ" (plus design), "WIZZ" (plus design), and "WIZZ" (plus design), that when used in connection with the identified services, it is likely to cause confusion under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d).

ARGUMENTS

Applicant's mark is highly similar to the registrant's marks and, when combined with the relatedness of the associated services, is likely to cause confusion in consumers who are likely to mistakenly believe that the applicant's services and registrant's services emanate from the same source or are affiliated services from the same entity.

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and/or services of the parties. *See* 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and/or services. *See In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The 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.”); TMEP §1207.01.

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261,

1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

In this case, applicant's mark is "C CARWIZ" (in stylized form and featuring a design) for "transportation services for passengers by road, especially transport of travelers by car, hired car; vehicle rental; chauffeur driven vehicle hire services; chauffeur services; rental of private vehicles; rental of vehicle roof racks; rental of automobile trailers".

The registrant's marks are as follows:

Registration number 6585636 (Reg. No. '636) for the mark "WIZZ" (in standard character form) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services".

Registration number 6044872 (Reg. No. '872) for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services".

Registration number 6044873 (Reg. No. '873) for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services".

Registration number 6039631 (Reg. No. '631) for the mark "WIZZ" (in stylized form and featuring a design) for, in relevant part, "transport of passengers; car rental; providing information relating to car rental services".

A. The Parties' Marks Are Confusingly Similar

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). "Similarity in any one of these elements may be sufficient to find the marks confusingly similar." *In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

When comparing marks, "[t]he proper test is not a side-by-side comparison of the marks, but

instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Ox Paperboard, LLC*, 2020 USPQ2d 10878, at *4 (TTAB 2020) (citing *In re Bay State Brewing Co.*, 117 USPQ2d 1958, 1960 (TTAB 2016)); *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018); TMEP §1207.01(b); see *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014).

In this case, the applied-for mark and registered marks are similar in sound and appearance because they all feature highly similar wording, i.e., “WIZ” in the applied-for mark and “WIZZ” in the registered marks, distinguished by a single letter, namely, the additional letter “Z” in the registered marks. This spelling distinction, however, does not obviate the similarities between the parties’ marks. Specifically, the terms “WIZZ” and “WIZ” are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding that the compared marks are confusingly similar. *In re 1st USA Realty Prof’ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv). Moreover, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomms. & Elec. Ass’n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Applicant's additions of the letter "C" and wording "CAR" in the applied-for mark do not obviate the similarity between the compared marks. The placement of the additional letter "C" within a circular carrier, immediately preceding the term “CARWIZ” in the applied-for mark renders its meaning readily apparent, namely, an initial for the first letter in the wording “CARWIZ”. As such, the letter “C” merely serves to restate the wording “CAR” in the applied-for mark in abbreviated form. This restatement does not meaningfully distinguish the marks in terms of commercial impression because the term "CAR", which means "a vehicle moving on wheels" and appears in applicant’s identification, merely describes a feature of applicant’s car transportation, vehicle rental, and chauffeur

services. *See* Mar. 24, 2022, Office Action, TSDR p. 24. Matter that is descriptive of or generic for a party's goods and/or services is typically less significant or less dominant in relation to other wording in a mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)). Thus, the additional wording "C CAR" in the applied-for mark only restates and enhances the focus on the descriptive element in the applied-for mark. This wording, therefore, is less significant in terms of affecting the mark's commercial impression, and renders the wording "WIZ", i.e., the phonetic equivalent of the only wording in the registered marks, the more memorable portion of the applied-for mark. Consumers are thus even more likely to be confused as to the source of the parties' respective services in the instant matter because of the highly similar memorable wording shared in the marks of the respective parties.

Although both the applied-for mark and the registered marks in Reg. Nos. '872, '873, and '631 are all composites of stylized wording and designs, the word portion of the marks is more likely to indicate the origin of the services because it is that portion of marks that consumers use when referring to or requesting the services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar. *In re Viterra Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). Furthermore, in this case, the degree of stylization present in the parties' respective marks is not sufficiently striking, unique, or distinctive so as to create a commercial impression separate and apart from the more dominant wording component of the marks. Therefore, the word portion of the parties' respective marks dominates the design and stylization elements, rendering such elements less significant in terms of consumer recognition of the marks.

Additionally, the design feature in the applicant and registrant's respective marks consists of a shaded circle that has nothing in its individual appearance that resembles anything other than the commonly known geometric shape. Such common geometric shapes and background carriers are not sufficiently distinctive to create a commercial impression separate from the word marks with which

they are used and thus are not regarded as indicators of origin absent evidence of distinctiveness of the design alone, which applicant has not provided. *See In re Benetton Group S.p.A.*, 48 USPQ2d 1214, 1215-16 (TTAB 1998). Furthermore, as to the registrant's marks in Reg. Nos. '872, '873, and '631, the design element is not only a common geometric shape with lesser trademark significance, but also, when viewing the registered marks in their entirety, the design could visually conjure an exclamation point due to its placement directly under the letter "I" creating a highly similar resemblance to such punctuation. If consumers were to perceive the design in the registered marks as an exclamation point, punctuation such as quotation marks, hyphens, periods, commas, and exclamation marks, generally does not significantly alter the commercial impression of the mark. *See, e.g., In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007); *see also In re Promo Ink*, 78 USPQ2d 1301, 1305 (TTAB 2006). Thus, in total, all the additional wording, design and stylization features in the parties' respective marks provide insufficient commercial impression to prevent a finding of a likelihood of confusion.

In terms of overall commercial impression, when properly viewed in their entireties, the parties' marks are indeed sufficiently similar such that consumers would assume a connection between the parties. Specifically, in the applied-for mark, i.e., "CAR" and "WIZ" mean "a vehicle moving on wheels" and "a person who is very good at something." *See* Mar. 24, 2022, Office Action, TSDR pp. 24, 33. Additionally, as previously noted, in the applied-for mark the letter "C" within the non-distinctive background carrier design, immediately preceding the term "CARWIZ" renders it likely that consumers will perceive this letter as an initial for the first letter in the wording "CARWIZ" and thus merely serves to restate the wording "CAR" in abbreviated form. Additionally, as also previously noted, design elements in marks make a lesser impression on consumers than wording because they are less likely to be recalled and/or used to request the associated goods and/or services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, when taken together and applied to applicant's services, the applied-for mark "C CARWIZ" (plus design) conveys the impression of a person who is very good at something related to vehicles moving on wheels. Regarding the registrant's marks, the term "WIZZ" is not an actual term but instead an alternate spelling of the term "WIZ". Because the spelling and pronunciation of these terms is highly similar and identical, consumers will likely understand the registered marks' obvious reference. Further, because the design

element in the registered marks in Reg. Nos. '872, '873, and '631 all feature a circle that appears under the letter "I" in "WIZZ", it is likely to conjure an exclamation point and such punctuation generally does not significantly alter the commercial impression of the mark. *See, e.g., In re Litehouse, Inc.*, 82 USPQ2d 1471, 1474 (TTAB 2007); *see also In re Promo Ink*, 78 USPQ2d 1301, 1305 (TTAB 2006). However, because the design element in the registered marks still retains much of the visual resemblance of the letter "I", it does not preclude the likely consumer perception of the registered marks from being that of the term "WIZZ". Thus, when taken together and applied to the registrant's services, the registered marks "WIZZ", "WIZZ" (plus design), "WIZZ" (plus design), and "WIZZ" (plus design) all convey the impression of a person who is very good at something. Therefore, all the marks at issue convey a similar general commercial impression of transportation and vehicle-related services that relate to a person who is very good at something.

Finally, as discussed in more detail below, the services of the applicant and registrant are wholly encompassed by the other, similar in kind and/or closely related resulting in a requisite lesser degree of similarity between the marks to support a finding of likelihood of confusion. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987); *see Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 1242, 73 USPQ2d 1350, 1354 (Fed. Cir. 2004); TMEP §1207.01(b).

Accordingly, the marks at issue are confusingly similar in sound and appearance. In addition, the connotation and commercial impression of the marks are sufficiently similar such that consumers would be likely to assume a connection between the parties. Therefore, the marks are confusingly similar.

B. The Services of the Parties are Closely Related

Applicant's service are closely related to registrant's services because they are encompassed by the other and frequently provided in the marketplace by a single source under one mark. In this case, applicant's services are "transportation services for passengers by road, especially transport of travelers by car, hired car; vehicle rental; chauffeur driven vehicle hire services; chauffeur services; rental of private vehicles; rental of vehicle roof racks; rental of automobile trailers". For all four of its registrations, the registrant's services at issue have been expressly limited to "transport of passengers; car rental; providing information relating to car rental services".

Determining likelihood of confusion is based on the description of the goods and/or services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)).

In this case, the registrations use broad wording to describe "transport of passengers", which presumably encompasses all services of the type described, including applicant's more narrow "transportation services for passengers by road, especially transport of travelers by car, hired car". *See, e.g., Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *44 (TTAB 2022); *In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018); *Sw. Mgmt., Inc. v. Ocinomled, Ltd.*, 115 USPQ2d 1007, 1025 (TTAB 2015). The registrant's transport of passenger services are identified without any limitation and thus are broad enough to include applicant's transport of passenger services especially by road, car and hired car. Similarly, the application uses broad wording to describe "vehicle rental; rental of private vehicles", which presumably encompasses all services of the type described, including registrant's more narrowly identified "car rental" in all cited registrations. *See, e.g., In re Solid State Design Inc.*, 125 USPQ2d 1409, 1412-15 (TTAB 2018). A "car" is a type of "vehicle" and thus applicant's vehicle and private vehicle rental are broad enough to include registrant's specific type of vehicle rental, namely, car rental. *See* Mar. 24, 2022, Office Action, TSDR p. 24. Thus, these services of the applicant and registrant are legally identical. *See, e.g., In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1629 (TTAB 2018) (citing *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp., Inc.*, 648 F.2d 1335, 1336, 209 USPQ 986, 988 (C.C.P.A. 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *Baseball Am. Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004)).

Additionally, these services of the parties have no restrictions as to nature, type, channels of trade, or classes of purchasers and are "presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)); *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557, at *49.

The evidence of record also shows that the parties' services are closely related because they are frequently provided by a single source under the same mark. For example, in the Office Action of

March 24, 2022, evidence was attached from the brands BLUU, HERTZ, MPH CLUB, and EXPAT RIDE showing transportation, car rental, vehicle rental, rental of private vehicles and chauffeur services under the same marks. *See* Mar. 24, 2022, Office Action, TSDR pp. 22-23, 25-29, 31-32. Additional website evidence showing car rental, rental of automobile trailers, information relating to car rental services, rental of vehicle roof racks, and transportation services offered under the same marks was attached to the Final Office Action of November 5, 2022, from the brands HERTZ, UHAUL, BUDGET, and ENTERPRISE. *See* Nov. 5, 2022, Office Action, TSDR PDF pp. 13-40. Further, in the Denial of the Request for Reconsideration, more internet websites were attached to the May 27, 2023, Denial of the Request for Reconsideration, TSDR PDF pp. 20-78, showing that the identified services of the parties are related and that such services are featured under identical marks. This evidence included marks such as BEVERLY HILLS CAR RENTALS, CAPITAL EXOTICS, DDE CAR RENTAL, and SIXT. These website pages from entities offering private vehicle rental, chauffeur, car rental, and transportation of passengers services under the same mark further establish a prima facie case that the relevant services are legally and commercially related.

In its Brief, applicant makes no arguments regarding the highly related and essentially identical services at issue. The burden is on the applicant to show that consumers would have no reason whatsoever to conclude that the relevant services are related and applicant has not met that burden. The record therefore leaves no doubt that the services at issue are legally related.

C. Rebuttal of Applicant's Arguments

In sum, applicant argues that confusion is not likely in the instant matter because the registered marks are weak and entitled to a narrow scope of protection based upon applicant's evidence of third-party use and/or registrations for marks featuring the wording in the registered mark or variations thereof, applicant's claimed evidence of "coexisting" use of the applied-for mark and the registered mark in the marketplace, and because of distinctions in sound, appearance, meaning, and connotation due to visible and audible spelling, syllable, and word differences between the marks at issue.

1. Applicant's Evidence of Third-Party Marks and Marketplace Usage of Marks Containing the Terms WIZZ, WHIZZ, or WHIZ and Do Not Establish that the Registrant's Marks are Weak and Entitled to a Narrow Scope of Protection

Applicant argues that its submission of 6 examples of third-party uses of marks including the component "WIZZ" or "WHIZ" demonstrate such numerous and ubiquitous use that the term "WIZZ" in the cited registration is commercially weak and should not be afforded a broad scope of protection. *See Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015); *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1373-74, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005); TMEP §1207.01(d)(iii).

Evidence of third-party use falls under the sixth *du Pont* factor, which assesses the number and nature of similar marks in use on similar goods and/or services. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973). Considerable or ubiquitous evidence of third-party use of similar marks on similar goods and/or services can be relevant to show that consumers have become conditioned by encountering so many similar marks in the marketplace that they distinguish between them based on minute distinctions, such that the mark or component should be considered relatively weak and entitled to only a narrow scope of protection. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 1373-74, 116 USPQ2d 1129, 1136-37 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1338-39, 115 USPQ2d at 1674 (citing *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d at 1373, 73 USPQ2d at 1693); *In re Coors Brewing Co.*, 343 F.3d 1340, 1345, 68 USPQ2d 1059, 1062-63 (Fed. Cir. 2003).

However, evidence comprising only a small number of third-party uses of similar marks is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). The amount of evidence of third-party use provided by applicant in this case falls short of the "ubiquitous" or "considerable" use of similar marks found probative in the cases. *See In re i.am.symbolic, llc*, 866 F.3d at 1329, 123 USPQ2d at 1752 (citing *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d at 1374, 116 USPQ2d at 1136-37; *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1674). In this case, applicant's statement that 6 examples of third-party use equates to numerous and ubiquitous use is not supported by any evidence and does not become fact merely because applicant states as much. Six examples of third-party use is

not so numerous or pervasive such that consumers are constantly encountering the use of the term "WIZZ" in connection with the relevant services in the marketplace and conditioned to distinguish confusingly similar marks. Thus, applicant's evidence remains insufficient to establish that the registrant's mark is commercially weak and entitled to a narrow scope of protection.

Applicant, also argues that its submission of 3 third-party registrations for marks including the component "WHIZ" or "WIZZ" further establish that "WIZZ", the mark in the cited registration, is inherently or conceptually weak and should not be afforded a broad scope of protection. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, SLU*, 797 F.3d 1363, 1374, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1339, 115 USPQ2d 1671, 1675 (Fed. Cir. 2015); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (TTAB 2021) (quoting *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d 1043, 1057 (TTAB 2017)); TMEP §1207.01(d)(iii).

A large number of active use-based third-party registrations including the same or similar term or mark segment for the same or similar goods and/or services may be relevant to prove, in the same way dictionaries are used, that a term or mark segment has “a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak” and entitled to only a narrow scope of protection. *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New Millennium Sports, SLU*, 797 F.3d at 1374, 116 USPQ2d at 1136 (quoting *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d at 1339, 115 USPQ2d at 1675); *Sabhnani v. Mirage Brands, LLC*, 2021 USPQ2d 1241, at *22 (citing *Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1057). However, evidence comprising only a small number of active use-based third-party registrations including the same or similar component is generally entitled to little weight in determining the strength of a mark. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 1328-29, 123 USPQ2d 1744, 1751-52 (Fed. Cir. 2017); *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973). These few registrations are “not evidence of what happens in the marketplace or that customers are familiar with them.” *Sock It To Me, Inc. v. Aiping Fan*, 2020 USPQ2d 10611, at *9 (TTAB 2020) (quoting *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d at 1406, 177 USPQ at 269). Thus, the few use-based third-party registrations submitted by applicant are insufficient to establish that the mark or portion of the mark is inherently or conceptually weak.

Further, assessing conceptual strength is “based on the nature of the [component] itself,” that is, its level of distinctiveness in relation to the specified goods and/or services. *Bell’s Brewery, Inc. v. Innovation Brewing*, 125 USPQ2d 1340, 1345 (TTAB 2017) (citing *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014)). Evidence comprising third-party registrations of similar marks for different or unrelated goods and/or services has “no bearing on the strength of the term in the context relevant to this case.” *See Tao Licensing, LLC v. Bender Consulting Ltd.*, 125 USPQ2d at 1058 (citing *In re i.am.symbolic, llc*, 866 F.3d at 1328, 123 USPQ2d at 1751). These registrations appear to be for goods and/or services that are predominantly different from or unrelated to those identified in the cited registration and applicant’s application. Specifically, only U.S. Registration No. 5345746 for the mark "WHIZZRIDE" is for services in the same general "transportation" field as that of the services at issue in the instant matter. The remaining services in the other 2 listed registrations are parking space services and retail store services, neither of which are sufficiently related to the services at issue in this case. Thus, these third-party registrations submitted by applicant are still not probative on whether a portion or all of the registered mark is inherently or conceptually weak.

Applicant also argues that because the USPTO allowed for the registration of "PARKWHIZ", it would be somehow "unfair" to find a likelihood confusion in the instant case. However, when determining whether an applied-for mark is eligible for registration, each application must be considered on its own record. *In re Cordua Rests., Inc.*, 823 F.3d 594, 600, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016) (“[The Federal Circuit], like the Board, must evaluate the evidence in the present record to determine whether there is sufficient evidence”); *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174, 91 USPQ2d 1218, 1221 (Fed. Cir. 2009) (“Applicant’s allegations regarding similar marks are irrelevant because each application must be considered on its own merits.”); *see also In re Nett Designs, Inc.*, 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the [Trademark Trial and Appeal] Board or this court.”). Furthermore, prior decisions and actions of other trademark examining attorneys in applications for other marks have little evidentiary value and are simply not binding upon the USPTO or the Trademark Trial and Appeal Board. *See* TMEP §1207.01(d)(vi); *see also In re USA Warriors Ice Hockey Program, Inc.*, 122

USPQ2d 1790, 1793 n.10 (TTAB 2017).

2. Applicant's Claims and Evidence that is Extrinsic to the Relevant Identified Services and Pertains to the Coexistence of the Parties' Marks in the Marketplace Do Not Overcome a Likelihood of Confusion

Applicant argues that confusion is not likely in the instant matter because, based upon its review of and submitted evidence from the registrant's website supported by a declaration provided by applicant's attorney, consumers are "already introduced to both applicant's and registrant's marks as separate and distinct marks that are not related." *See* Applicant's Brief numbered p. 15. However, the relatedness determination of the services is based on the description of the goods and/or services in the application and registration at issue, not on extrinsic evidence of actual use. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1323, 110 USPQ2d 1157, 1162 (Fed. Cir. 2014) (quoting *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Thus, applicant's claims and conclusions regarding possible consumer introduction to the parties' at issue via the registrant's website are not germane to the likelihood of confusion determination. Moreover, affidavits and declarations of an applicant's attorneys are usually self-serving and entitled to little weight. *See In re David Crystal, Inc.*, 296 F.2d 771, 773, 132 USPQ 1, 2 (C.C.P.A. 1961); *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (TTAB 1987); *In re Cent. Counties Bank*, 209 USPQ 884, 888 (TTAB 1981); TMEP §1212.06(c).

Even assuming applicant's evidence is actually derived from the registrant's website and applicant's claims and evidence were relevant to the instant matter, there is nothing in the webpage screenshots submitted by applicant that indicate that the brand "C CARWIZ" is associated with a different source than the registrant. The fact that the registrant features car rental services via the brand "C CARWIZ" on its website, does not establish that the source for those services is distinct from the registrant itself. Given that the registrant's own car rental services under its other brand name, "WIZZAIR" are also included in the same list and section to access "C CARWIZ" on the webpage screenshots which applicant provides as evidence, consumers could reasonably believe that the registrant features more than one variation of its own "WIZZ" brand services via its website and that the car rental services offered under the "C CARWIZ" brand are one of those variations associated with

the registrant.

Ultimately, applicant's claims and evidence pertaining to whether applicant and registrant coexist in the marketplace in a manner that consumers are confronted with the parties' respective brands on a singular website are simply not germane to the likelihood of confusion determination. Rather, the likelihood of confusion determination is made based upon a comparison of the marks in their entireties for similarities in appearance, sound, connotation and commercial impression and upon the description of the goods and/or services stated in the application and registration at issue as to whether they are similar, commercially related or travel in the same trade channels, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The likelihood of confusion determination does not include an applicant's conjecture about whether consumers would believe that the cited registrant advertises its services.

3. Applicant's Mark and Registrant's Marks are Confusingly Similar in Sound Appearance, Connotation and Commercial Impression

Applicant argues that the marks are different in sound and appearance due to the apparent differences in terms, spelling, and syllables, namely, the presence of the wording "C CAR" in the three-syllable applied-for mark that audibly begins with a letter "C" versus the additional letter "Z" in the single syllable registered marks which, by contrast, audibly begins with the letter "W". These distinctions, however, do not obviate the similarity between the marks. Marks need not be identical in order for a likelihood of confusion to exist. Rather, marks may be confusingly similar in appearance where similar terms or phrases or similar parts of terms or phrases appear in the compared marks and create a similar overall commercial impression. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689, 690-91 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1495, 1 USPQ2d 1813, 1817 (Fed. Cir. 1987) (finding COMMCASH and COMMUNICASH confusingly similar); *In re Corning Glass Works*, 229 USPQ 65, 66 (TTAB 1985) (finding CONFIRM and CONFIRMCELLS confusingly similar); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983) (finding MILTRON and MILLTRONICS confusingly similar); TMEP §1207.01(b)(ii)-(iii). In this case, applicant merely adds the descriptive, if

not generic, wording "CAR" to wording that is essentially identical to the only wording in the registered marks. Applicant's focus on the presence of the term "CAR" in its mark as a distinguishing element is misapplied as this term is merely descriptive of a feature of its services and therefore less significant or less dominant in relation to other wording in [its] mark. *See Anheuser-Busch, LLC v. Innvopak Sys. Pty Ltd.*, 115 USPQ2d 1816, 1824-25 (TTAB 2015) (citing *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1342-43, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004)).

Moreover, marks with different numbers of syllables, pronunciation and/or appearance will cause confusion where they present a similar commercial impression. *See e.g., In re Detroit Athletic Co.*, ___ F3d ___, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (affirming TTAB's finding that the marks DETROIT ATHLETIC CO. and DETROIT ATHLETIC CLUB are nearly identical in terms of sound, appearance and commercial impression, and noting that, while "the words 'Co.' and 'Club' technically differentiate the marks, those words do little to alleviate the confusion that is likely to ensue"); *In re Chatam Int'l Inc.*, 380 F.3d 1340, 1343, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) ("Viewed in their entirety with non-dominant features appropriately discounted, the marks [GASPAR'S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical."). In this case, the more dominant wording of the marks, i.e., "WIZ" and "WIZZ" respectively, is strong, distinctive matter, especially when viewed in the context of the remaining less significant and/or descriptive wording, design and stylization elements in the parties' respective marks, i.e., "C CAR" in the applied-for mark and the design and stylization features in the applied-for mark and the registered marks for Reg. Nos. '872, '873, and '631. Thus, despite the superficial distinctions in syllables, spelling, and terms, the marks at issue remain essentially identical in their most prominent feature and confusingly similar in terms of overall commercial impression resulting in a greater likelihood of confusion.

Applicant argues that the marks do indeed have a different commercial impression as the applied-for mark "gives the impression of someone who is an expert, e.g., "wizard" in the field of cars [whereas] the registrant's marks give the impression of an object moving quickly or making a hissing sound.". *See Applicant's Brief* at numbered page 17. Applicant further states that the registrant's offering of airline transportation services and its website and company name, both of which contain the terms "Wizz" and "Air", support its claimed meaning of the registered mark. *See Applicant's Brief* at numbered pages 17. However, applicant's commercial impression analysis is unsupported by relevant

evidence and incomplete as it solely focuses on services offered by the registrant which the trademark examining attorney expressly excluded from the likelihood of confusion determination, i.e., "airline transportation services", and thus which are not at issue in the instant matter. Further, applicant provides no evidence that the commonly known or understood meaning of the term "WIZZ" when used in connection with the registrant's excluded airline transportation services is moving quickly, or that simply because the registrant offers airline transportation services and its company name and website feature the terms "WIZZ" and "AIR" establishes that consumers will perceive the term "WIZZ" to mean moving quickly. There is nothing in the webpage evidence submitted by applicant indicative of the wording "WIZZ" referring to moving quickly and instead, the webpages submitted by applicant do not illuminate any meaning for "WIZZ". Furthermore, dictionaries are generally a competent source for determining how the public perceives [a] mark in connection with [an] applicant's goods and/or services. *See In re N.C. Lottery*, 866 F.3d 1363, 1367-68, 123 USPQ2d 1707, 1709-10 (Fed. Cir. 2017); *In re Nett Designs, Inc.*, 236 F.3d 1339, 1341, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (citing *In re Bed & Breakfast Registry*, 791 F.2d 157, 160, 229 USPQ 818, 819 (Fed. Cir. 1986)); TMEP §1209.01(b). Thus, in this case, it is more likely that consumers will glean the connotation and commercial impression of "WIZZ", which is not a word, from the actual term with which it is identical in sound and highly visually similar in appearance, namely, "WIZ" in the applied-for mark.

Even assuming consumers would perceive the registered mark to convey applicant's stated meaning of "moving swiftly", applicant provides no explanation as to why consumers would fail to apply the same meaning to both marks given their phonetic and visual similarities. Moreover, the term "WIZ" in the applied-for mark is also defined as being synonymous with the term "whiz" which means "to move swiftly." *See* May 27, 2023, Denial of the Request for Reconsideration, TSDR PDF pp. 9-19. Applicant has provided no explanation as to why consumers would also not apply this meaning of the term "WIZ" in its mark and believe that the applied-for mark conveys the impression of a car moving quickly and that both marks convey a similar general impression of services that relate to vehicles moving quickly.

Finally, even to the extent that potential purchasers may realize the apparent differences between the marks, they could still reasonably assume, due to the overall similarities in sound,

appearance, connotation, and commercial impression in the respective marks, that applicant's services sold under the mark "C CARWIZ" constitute a new or additional service line from the same source as the services sold under registrant's "WIZZ" standard character and "WIZZ" plus design marks with which they are acquainted or familiar, or vice versa, and that applicant's mark is merely a variation of the registrant's mark. *See, e.g., SMS, Inc. v. Byn-Mar Inc.* 228 USPQ 219, 220 (TTAB 1985) (applicant's marks ALSO ANDREA and ANDREA SPORT were "likely to evoke an association by consumers with opposer's preexisting mark [ANDREA SIMONE] for its established line of clothing.").

Accordingly, when the marks are considered in light of all the factors discussed above, confusion as to the source is likely.

CONCLUSION

Therefore, because the marks of the parties share essentially identical more dominant wording and have confusingly similar overall commercial impressions coupled with the fact that the services of the parties are closely related as shown by the evidence in the record, consumers who encounter the marks "C CARWIZ" and "WIZZ", "WIZZ" (plus design), "WIZZ" (plus design), or "WIZZ" (plus design) for the relevant services are likely to confuse the source of the services. Moreover, applicant's failure to address the issue of the relatedness of the relevant services constitutes a concession on applicant's part that its services and the registrant's services are indeed related. It is again noted that, even if there were some doubt about likelihood of confusion in this case, the trademark examining attorney must resolve any doubt regarding a likelihood of confusion determination in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). Therefore, for the foregoing reasons, the trademark examining attorney respectfully requests that the refusal based on Section 2(d) of the Trademark Act be affirmed.

Respectfully submitted,

/Rhoda Nkojo/
Rhoda Nkojo
Examining Attorney
LO117--LAW OFFICE 117
(571) 272-8468
Rhoda.Nkojo@USPTO.GOV

/Cynthia Tripi/
Managing Attorney
Law Office 117

United States Patent and Trademark Office (USPTO)

USPTO OFFICIAL NOTICE

Examining attorney's appeal brief has issued
on September 22, 2023 for
U.S. Trademark Application Serial No. 79261503

A USPTO examining attorney has issued an appeal brief. Follow the steps below.

- (1) **[Read the appeal brief](#)**. This email is NOT the appeal brief.
- (2) **Submit reply brief within 20 days of September 22, 2023**, if you wish to do so. If submitted, a reply brief must be submitted using the **[Electronic System for Trademark Trials and Appeals \(ESTTA\)](#)** and received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the reply period.
- (3) **Direct questions** about the appeal proceeding to the Trademark Trial and Appeal Board at 571-272-8500 or **TTABInfo@uspto.gov**.