

This Opinion is not a
Precedent of the TTAB

Mailed: January 29, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Thomas Barnette

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Serial No. 87425197

Jackson MacDonald of Mac Legal LLC,
for Thomas Barnette

Daniel Donegan, Trademark Examining Attorney, Law Office 104,
Zachary Cromer, Managing Attorney.

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Before Mermelstein, Kuczma and Goodman,
Administrative Trademark Judges.

Opinion by Goodman, Administrative Trademark Judge:

Thomas Barnette (“Applicant”) seeks registration on the Principal Register of the
mark YOUR EDUCATIONAL TOUR, YOUR WAY (in standard characters) for

Organization of travel for educational purposes; Travel
agency services, namely, making reservations and
bookings for transportation for students and teachers
participating in educational travel tours; Travel guide and
travel information services relating to travel for
educational purposes in International Class 39.¹

¹ Application Serial No. 87425197 was filed on April 25, 2017, based upon use of the mark in
commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging January 16,
2017 as the date of first use and first use in commerce.

The Trademark Examining Attorney refused registration of Applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that



Applicant's mark so resembles the registered mark ("tour" disclaimed) for "chauffeur and transportation services for tours" in International Class 39 as to be likely to cause confusion.²

When the refusal was made final, Applicant appealed and requested reconsideration. After the Examining Attorney denied the request for reconsideration, the appeal was resumed. We affirm the refusal to register.

I. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*DuPont*"). *See also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. *See, e.g., In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

Page references to the application record refer to the online database of the USPTO's Trademark Status & Document Retrieval (TSDR) system. References to the briefs on appeal refer to the Board's TTABVUE docket system.

² Registration No. 5035611.

In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). These factors, and the other relevant *DuPont* factors now before us, are discussed below. *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1800 (Fed. Cir. 2018) (quoting *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1259 (Fed. Cir. 2010) (“Not all of the *DuPont* factors are relevant to every case, and only factors of significance to the particular mark need be considered.”)); *ProMark Brands Inc. v. GFA Brands, Inc.*, 114 USPQ2d 1232, 1242 (TTAB 2015) (“While we have considered each factor for which we have evidence, we focus our analysis on those factors we find to be relevant.”).

Applicant has argued that the marks are visually and aurally distinct and have different meanings and commercial impressions. Applicant contends on appeal that this *DuPont* factor alone is determinative of the issue of likelihood of confusion. Applicant does not address any other *DuPont* factors in his brief.

A. Similarities or Dissimilarities of the Services, Channels of Trade and Classes of Purchasers.

The second *DuPont* factor “considers ‘[t]he similarity or dissimilarity and nature of the goods or services as described in an application or registration,’” while the third *DuPont* factor considers “the similarity or dissimilarity of established, likely-to-continue trade channels.” *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018); (quoting *DuPont*, 177 USPQ at 567). We analyze these factors based on the identifications of goods or services in the application and the cited

registration. *Id.*; *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1161-63 (Fed. Cir. 2014). It is not necessary that the respective services be identical or even competitive in order to find that they are related. The respective services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that services emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Applicant’s services are “Organization of travel for educational purposes; Travel agency services, namely, making reservations and bookings for transportation for students and teachers participating in educational travel tours; Travel guide and travel information services relating to travel for educational purposes” while Registrant’s services are “chauffeur and transportation services for tours.”

To show relatedness, the Examining Attorney made of record copies of used-based third-party registrations showing that the same entity has adopted a single mark for organizing travel, providing travel guide and travel information services, providing travel agency services, namely, making reservations and bookings for transportation, and providing transportation services for tours. May 30, 2018 Office Action at TSDR 2-32. (Registration nos. 5054482, 5079501, 5127737, 5254288, 5299804, 5304652, 5406798, 5449720, 5449721, and 5478475).³

³ Some of these registrations are owned by the same entity (5449720, 5449721) and (5478475 and 5304652).

While third-party registrations are not evidence that the marks shown are in commercial use, or that the public is familiar with them, such registrations that individually cover a number of different services and are based on use in commerce may have some probative value to the extent that they serve to suggest that the listed services are of a type which may emanate from a single source. *See In re Aquamar, Inc.*, 115 USPQ2d 1122, 1126 n.5 (TTAB 2015); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993).

The Examining Attorney also submitted Internet website evidence to show that companies offering educational tour services, which include tour planning and tour guides, also offer transportation for tours. For example:

Burke Educational Travel provides “Educational Travel, Tours and Charter Bus Transportation” and states “call our tour planner to customize your own tour.” July 26, 2017 Office Action at TSDR 5, burkeeducationaltravel.com.

HTI, Haymarket Transportation Inc. offers charter bus transportation and tours, and trip/tour planning stating “[t]hree Services in One. ... You no longer have to [sic] a separate bus company, event planner, and tour guide – instead you can get all three services at Haymarket Transportation.” July 26, 2017 Office Action at TSDR 6; July 26, 2017 Office Action at TSDR 6, haymarkettrans.com.

Zohery Tours offers student educational tours, transportation services and various tours of the Washington D.C. area. It describes itself as “your on-call transportation service” and mentions that it has “30 years experience organizing tours in the nation’s capital.” May 30, 2018 Office Action at TSDR 36-38, Zohery.com.

Bailey Coach offers tour planning, tour escorts and transportation for educational field trips, private car and van transportation. May 30, 2018 Office Action at TSDR 45-47, baileycoach.com.

Fun Bus provides school field trips and taxi service. It custom designs every trip, provides travel planning for school field trips, and offers different size coaches in connection with the trips. May 30, 2018 Office Action at TSDR 48-49, funbus.com.

This evidence shows that companies that organize and offer educational tour services also offer transportation services for such tours. This evidence also supports a finding that the respective services are related and will be encountered by the same consumers under the same mark. *See, e.g., In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009).

Although Applicant's travel services are limited to the field of educational travel tours, they are not limited as to trade channels or classes of purchasers. Registrant's tour transportation services are not limited in any way as to field of use, channels of trade, or classes of purchasers and are broad enough to encompass the field of educational travel tours. We must presume that Applicant's services are offered in all normal trade channels in which the Registrant's services might move. *See In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981) (citing *Kalart Co., Inc. v. Camera-Mart, Inc.*, 258 F.2d 956, 119 USPQ 139, 140 (CCPA 1958)). As stated, Registrant's transportation services are not limited to any particular field, and may include tour services offered in connection with educational travel tours. The third-party website evidence submitted by the Examining Attorney and discussed above shows that transportation services and educational tours are offered in the same trade channels, and to the same classes of purchasers. Thus, Applicant's and Registrant's trade channels and classes of purchasers overlap. For these reasons, we find that the second and third *DuPont* factors weigh in favor of a finding of likelihood of confusion.

B. Similarity or Dissimilarity of the Marks

We must compare the marks in their entireties as to appearance, sound, connotation and commercial impression to determine the similarity or dissimilarity between them. *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1690 (Fed. Cir. 2005) (quoting *DuPont*, 177 USPQ at 567). The test under the first *DuPont* 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 goods offered under the respective marks is likely to result. *Coach Servs. Inc. v. Triumph Learning, LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)). Although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the overall commercial impression created by the mark. See *In re Chatam Int'l. Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004); *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark is YOUR EDUCATIONAL TOUR, YOUR WAY. Registrant's



Applicant contends that the marks are visually distinct. Applicant submits that the design elements in Registrant's mark are "visually distinctive and impactful" and Applicant's mark also has a "wholly distinct visual impression" because it does not contain any similar design elements.

Although the design of a sign, road, and city skyline are visually significant features of Registrant's mark, we find that the design elements nonetheless are entitled to somewhat lesser weight in assessing the mark's commercial impression. We find that the dominant source-indicating feature of the cited word and design mark is the wording TOUR YOUR WAY, for the following reasons.

In word and design marks such as Registrant's mark, the words are normally accorded greater weight because they are likely to make a greater impression upon purchasers, to be remembered by them, and to be used by them to request the services. *See In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908, 1911 (Fed. Cir. 2012) (citing *CBS Inc. v. Morrow*, 708 F. 2d 1579, 218 USPQ 198, 200 (Fed. Cir 1983)). Although the words are integrated into the sign portion of the design in Registrant's mark, the words are more visually prominent given their position and size in the design. Additionally, it is the word portion of Registrant's mark, not the design, that would be articulated when discussing or calling for the services.

In this case, Applicant has taken the dominant literal portion of the registered mark and added other matter to it, namely, a possessive pronoun YOUR, the term

EDUCATIONAL, and a comma. The question becomes whether this additional matter changes the overall commercial impression of Applicant's mark.

Applicant argues consumers will focus on and remember YOUR EDUCATIONAL as the first part of Applicant's mark and that these terms differ from the first terms in Registrant's mark. Applicant also argues that the comma in its mark is a visual cue to consumers that necessarily separates the mark into two phrases: YOUR EDUCATIONAL TOUR and YOUR WAY.

We find the marks are similar in sound and appearance as they both contain the same words TOUR YOUR WAY, in the same order. Although there is the addition of a comma between TOUR and YOUR WAY in Applicant's mark, which creates a slight pause when the mark is pronounced, this is subtle and not significant. *See TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 807.14(c) (Oct. 2018) ("Punctuation, such as quotation marks, hyphens, periods, commas, and exclamation marks, generally does not significantly alter the commercial impression of the mark.")*. *Cf. In re S. D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984) (separation of the two words of a mark with a conventional punctuation mark is not so distinctive to create a commercial impression separate and apart from the unregistrable components).

The term YOUR in Applicant's mark is a widely used possessive pronoun and has little source indicating significance. The combined terms YOUR EDUCATIONAL in Applicant's mark merely serve to provide additional information about the subject matter of the services, and describes that the service is personalized. While the

combined terms YOUR EDUCATIONAL distinguish Applicant's mark somewhat from the literal portion of the cited mark in appearance and sound, we find that these terms have less significance in creating the mark's commercial impression and are entitled to less weight in our likelihood of confusion determination. *See e.g., Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000) ("Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.") (quotation omitted); *In re Datapipe, Inc.*, 111 USPQ2d 1330 (TTAB 2014) (YOUR CLOUD merely descriptive in connection with the services).

Although there are differences in sound and appearance between Applicant's mark and the literal portion of Registrant's mark, those differences are outweighed by the similarities, particularly taking into account that the "marks 'must be considered . . . in light of the fallibility of human memory' and 'not on the basis of side-by-side comparison.'" *In re St. Helena Hosp.*, 774 F.3d 747, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014) (quoting *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977)).

Applicant argues that the marks differ in connotation and commercial impression, contending that Registrant's mark, which lacks the combined term YOUR EDUCATIONAL and a comma, also "lacks any similar connection to the consumers on a personal level, i.e., that it is specific to that particular consumer's educational tour." 7 TTABVue 6. Applicant also argues that the meanings of Applicant's and Registrant's marks differ because TOUR in his mark is used as a noun while TOUR

in Registrant's mark is used as a verb. Applicant submits that the meaning of TOUR in Applicant's mark is the consumer's personalized educational tour package, while the meaning of TOUR in Registrant's mark is the action of touring.

Both Applicant and the Examining Attorney have provided a definition of "tour" in their noun and verb forms: "(n) a : a journey for business, pleasure or education often involving a series of stops and ending at the starting point; also : something resembling such a tour" and "(v) 1 : to make a tour of." April 19, 2018 Response to Office Action at TSDR at 14, 17; May 30, 2018 Office Action at TSDR 34, MERRIAM-WEBSTER DICTIONARY, merriam-webster.com. The Examining attorney also provided a definition of "way:" "a : by a long distance : to a considerable degree or extent : FAR." May 30, 2018 Office Action at TSDR 35, MERRIAM-WEBSTER DICTIONARY, merriam-webster.com. We take judicial notice of the additional definition of "way"⁴ "b(2) : opportunity, capability, or fact of doing as one pleases //always manages to get her own way." MERRIAM-WEBSTER DICTIONARY, <https://www.merriam-webster.com/dictionary/way> (accessed December 12, 2019).

Additionally, Applicant argues that the marks convey entirely different impressions when considered in connection with the services. In particular, Applicant argues that TOUR YOUR WAY "conveys the idea of personalized transportation services in connection with the action of touring a certain area or site" while YOUR EDUCATIONAL TOUR, YOUR WAY, "conveys the idea of consumers' ability to plan

⁴ The Board may take judicial notice of online dictionary definitions that exist in print format. See *In re Red Bull GmbH*, 78 USPQ2d 1375, 1378 (TTAB 2006).

the exact educational journey they desire with the assistance of Applicant's planning an[d] organization services.”

As to connotation and commercial impression, the equivalent terms TOUR, YOUR WAY and TOUR YOUR WAY convey the same suggestion, thus, making them similar in terms of meaning and commercial impression.

In Applicant's, mark, consumers will interpret the possessive pronoun YOUR and the descriptive adjective EDUCATIONAL as modifiers that describe the type of personalized customized tours offered. These additional terms do not significantly change the meaning or commercial impression of Applicant's mark. Both Applicant's mark and the literal portion of Registrant's mark may be understood as offering a customized tour experience as directed by the consumer (i.e., making your educational journey the way you please versus making a journey the way you please).

We find that Applicant's mark and the literal portion of Registrant's mark are more similar than dissimilar in connotation and commercial impression.

Applicant also asserts that “it uses its YOUR EDUCATIONAL TOUR, YOUR WAY mark as a slogan in connection with its larger EA EDUCATIONAL ADVANTAGE TOURS brand and marks” which further distinguishes the marks. 7 TTABVUE 10. However, our assessment of likelihood of confusion is limited to the involved marks as depicted in the application and cited registration and does not take into account how Applicant may use its mark in the marketplace. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1186 (TTAB 2018). Additionally, any registration

that would issue to Applicant would not restrict him to use of his mark only in connection with his trade name or with his other marks.

In discussing Applicant's mark and the dominant portion of Registrant's mark, we recognize, of course, that the marks ultimately must be compared in their entireties. When this comparison is made, we find that the marks are similar in sound, appearance, meaning and commercial impression. Because of the similarities between the marks, Applicant's and Registrant's marks engender similar overall impressions. The presence of the design in Registrant's mark and the additional terms and punctuation in Applicant's mark are insufficient to distinguish the marks when they are used in connection with related services.

This *DuPont* factor favors a finding of likelihood of confusion.

II. Conclusion

We have considered all of the arguments and evidence of record, and all relevant *DuPont* factors. In view of the relatedness of the services, the overlapping trade channels and classes of purchasers, and the similarity of the marks, we conclude that confusion is likely to occur between Applicant's mark and Registrant's mark.

Decision: The refusal to register Applicant's mark YOUR EDUCATIONAL TOUR, YOUR WAY is affirmed.