

This Opinion is Not a
Precedent of the TTAB

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Beijing Da Mi Technology Co., Ltd.

Serial No. 87526203

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for Beijing Da Mi Technology Co., Ltd.

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Before Wellington, Shaw and Kuczma,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Beijing Da Mi Technology Co., Ltd. (“Applicant”) seeks registration on the Principal Register of the mark LINGO BUS for “Providing access to databases; Providing internet chatrooms; Providing on-line forums for transmission of messages

among computer users; Radio communications; all the aforesaid services related to language education” in International Class 38.¹


The Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on a likelihood of confusion with four registered marks owned by the same entity, including the standard character mark LINGO (Reg. No. 3218984)² for:

Telecommunications services, namely local, long distance, and international long distance telephony communications services; electronic voice, facsimile, data, video, image and information transmission via a global computer network and other computer networks; telephony and voice over Internet Protocol (VOIP) services; providing custom calling features, namely call forwarding, caller ID, caller ID blocking, three way calling, call waiting, call return, automatic busy-line redial, and do not disturb functionality; audio and video teleconferencing services; location independent personal communications services comprising mobile, voice, data and facsimile transmission services; providing telecommunications connections to worldwide global computer networks and other computer networks, in International Class 38.

After the Examining Attorney made the refusal final, Applicant filed a request for reconsideration and appealed. The request for reconsideration was denied by the Examining Attorney and the appeal has been briefed. For the reasons set forth below, we affirm the refusal to register.

¹ Application Serial No. 87526203 was filed under Section 1(b) of the Trademark Act based upon a bona fide intent to use the mark in commerce. The recitation of services was amended by Applicant in its request for reconsideration (4 TTABVUE).

² Registration No. 3218984 issued on March 13, 2007 and has been renewed. The other cited

registrations are:  (Reg. No. 3218986); LINGO (Reg. No. 3218984); LINGO WORLD MAX (Reg. No. 3802557); and LINGO UNWIRED (Reg. No. 3525312). For reasons explained *infra*, we base our decision solely on Reg. No. 3218984.

I. Likelihood of Confusion

The determination under Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*du Pont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the relatedness of the goods or services. *See In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”).

For purposes of our confusion analysis, we focus on the aforementioned cited registration for the standard character mark LINGO (Reg. No. 3218984) because it is the most relevant.³ If we find a likelihood of confusion as to this cited mark, we need not make a finding as to the other registered marks. Conversely, if we do not find that a likelihood of confusion exists as to the LINGO mark, we would not find it as to the other cited marks. *See Fiserv, Inc. v. Elec. Transaction Sys. Corp.*, 113 USPQ2d 1913, 1917 (TTAB 2015); *see also In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

³ This registration covers the same services as the other cited registrations and, unlike the other cited marks, the mark does not contain either additional wording or design elements.

A. Relatedness of the Services

We begin our analysis with the second *du Pont* factor by making a comparison of the services identified in Applicant's application vis-à-vis the services identified in the cited registration. We must make our determinations under these factors based on the services as they are recited in the registration and application. *See Octocom Systems Inc. v. Hous. Comput. Servs, Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods [or services] set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods [or services], the particular channels of trade or the class of purchasers to which sales of the goods [or services] are directed."); *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

At the outset, we address a key point of contention regarding the nature of Applicant's services and what is perhaps the crux or reason for this appeal. That is, Applicant argues that its "messaging and communications" services are "specifically related to language education."⁴ Indeed, in its reply brief, Applicant underlines and places in bold the wording "language education" and "language education-focused" numerous times to emphasize what it believes is the field or purpose of its services. Applicant also asserts that "none of the Examining Attorney's evidence even suggests

⁴ 12 TTABVUE 7.

the registrant's telephone-based call services are related to language education-focused messaging and telecommunications services.”⁵

The Examining Attorney, on the other hand, acknowledges Applicant's amendment to the recitation of services with its request for reconsideration – namely to include the language “all the aforesaid services related to language education” – but asserts that Applicant's services are nonetheless “closely related to the registrant's services” because they are still regarded as communications services.⁶ In response to Applicant's emphasis that Applicant's provision of chatrooms, online forums and radio communications services are only related to language education, the Examining Attorney points out that Registrant's telecommunications services are unrestricted and thus are “all broad enough to include services related to language education.”⁷ In support of the refusal, the Examining Attorney submitted several third-party registrations for the same marks in connection “the same services as those of the applicant and registrant.”⁸ The Examining Attorney also relies on printouts from the Verizon website showing the “offering radio communication services and telecommunications services under the same mark.”⁹

While we understand Applicant's arguments and may appreciate frustration should Applicant's services in actuality be language education services; however, the

⁵ *Id.*

⁶ 11 TTABVUE 11.

⁷ *Id.*, at 12.

⁸ *Id.*, referencing evidence attached to Office Action issue on November 2, 2018 (5 TTABVUE).

⁹ *Id.*, 5 TTABVUE 2-3 (printouts).

fact remains that Applicant's services are in Class 38 and are described in the application as essentially offering communications services to others – specifically by means of providing access to chatrooms, online forums or radio communications – albeit these services being “related to language education.” To be clear, the services in the application are not “language education” services.¹⁰ Rather, Applicant's amendment merely limits the area or field of its communications services.

With the above in mind, we find the record in this case supports a finding that the involved services are related. In particular, we note that Registrant's “electronic voice, facsimile, data, video, image and information transmission via a global computer network and other computer networks” services is broad enough to include Applicant's “providing internet chatrooms ... [and] on-line forums for transmission of messages among computer users,” even if Applicant's services relate only to language education. That is, we agree with the Examining Attorney's observation that Registrant's services unrestricted and users of its services may thus be involved in language education as well. The third-party registration evidence submitted by the Examining Attorney, as well as the Verizon website printouts, also help show that consumers may be accustomed to entities providing both telecommunications

¹⁰ Pursuant to Nice Agreement [the International Classification of Goods and Services for the Purposes of the Registration of Marks], the Class 41 heading describes services encompassed by this class to include: “Education; providing of training; entertainment; sporting and cultural activities.” The Class 38 heading, on the other hand, reads “telecommunications.” See TMEP § 1401.02(a) which sets forth the general remarks, class numbers, class headings, and explanatory notes for each international class. We hasten to add, however, that classification is purely an administrative matter; our analysis regarding the nature of Applicant's services and their relationship to Registrant's services is not based on their classification.

services, like Registrant, as well as services like those described in the application, including access to internet chatrooms, online databases, as well as providing radio communications.¹¹ See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993) (copies of use-based, third-party registrations may help establish that the services are of a type which may emanate from a single source).

In sum, we find Applicant's services are related to those in the cited registration. Accordingly, the *du Pont* factor of the relatedness of the services weighs in favor of finding a likelihood of confusion.

B. Similarity/Dissimilarity of the Marks

We now compare the marks "in their entirety as to appearance, sound, connotation and commercial impression." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). The test under this factor assesses not whether the marks can be distinguished in a side-by-side comparison, but rather whether their overall commercial impressions are so similar that confusion as to the source of the services offered under the respective marks is likely to result. *Coach Servs., Inc. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012); see also *San Fernando Electric Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd mem.*, 972 F.2d 1353 (Fed. Cir. 1992).

¹¹ 5 TTABVUE 6-41 (printouts from www.verizonwireless.com and copies of third-party registrations).

The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012); *Winnebago Indus., Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

Here, there is the obvious visual and aural similarity between the marks due to Applicant's mark, LINGO BUS, incorporating the registered mark, LINGO. The location of Registrant's mark as the lead word in Applicant's mark certainly emphasizes the similarity. *In re Detroit Athletic Co.*, 903 F.3d 1297, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding "the identity of the marks' two initial words is particularly significant because consumers typically notice those words first"); *Palm Bay Imps.*, 73 USPQ2d at 1692 ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word); *In re Integrated Embedded*, 120 USPQ2d 1504, 1513 (TTAB 2016) (noting that the dominance of BARR in the mark BARR GROUP is reinforced by its location as the first word in the mark); *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered").

In terms of connotation, the shared term LINGO may be understood as suggestive of the ability of users of the Applicant's and Registrant's communications services to communicate with others.¹² This shared suggestive meaning presents one more point of similarity between the marks.

Applicant, on the other hand, argues that "the addition of BUS completely changes the commercial impression of the marks" because it "connotes a public transportation vehicle."¹³ Applicant's concludes that when its mark is viewed in the context of "language education-focused messaging services, LINGO BUS connotes a bus full of passengers teaching each other new languages."¹⁴ We not persuaded, however, that the marks convey significantly different meanings. As discussed supra, Applicant's services are not construed as "language education-focused" services. Rather, Applicant's services are primarily communications services related to language education and, as such, the term LINGO is suggestive of the ability for consumers of these services to communicate with each other.

This is not to say we have, nor can we, ignore the relevance of the addition of the term BUS in Applicant's mark. The term is obviously not in the registered mark. Nonetheless, we ultimately find that Applicant's entire mark, LINGO BUS, remains overall more similar than not with Registrant's mark, LINGO.

¹² "Lingo" is defined as "Strange or incomprehensible language or speech: such as (a) foreign language ...; (b) the special vocabulary of a particular field of interest ...; (c) language characteristic of an individual ..." Merriam-Webster online dictionary (www.merriam-webster.com/dictionary); attached to Office Action issued on March 27, 2018, TSDR p. 2.

¹³ 12 TTABVUE 5.

¹⁴ *Id.*

In sum, the marks, LINGO BUS and LINGO, are very similar in appearance and sound, and they share a similar suggestive meaning. Applicant's addition of the term BUS is a point of difference between the marks, but this is outweighed by the aforementioned similarities. This factor weighs in favor of finding a likelihood of confusion.

C. Alleged Weakness of Cited Mark

Applicant has argued "the term LINGO is weak and diluted for telecommunications services due to the co-existence on the Principal Register of other LINGO marks for similar services" and that it "is therefore entitled to a narrow scope of protection." However, Applicant only submitted one registration and two applications for marks containing the term LINGO. Although there is no minimum number of third-party marks and evidence of third-party use of similar marks in connection with the same or similar services required to show weakness, we have no hesitation in finding that this showing by Applicant certainly does not suffice. *See, e.g., In re Inn at St. John's, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (four third-party registrations and no third-party uses are "a far cry from the large quantum of evidence of third-party use and third-party registrations ... to be significant").¹⁵

Accordingly, we find no commercial weakness with respect to Registrant's LINGO mark.

¹⁵ As the Examining Attorney points out, the two applications were owned by the same party and have since been abandoned.

D. Conclusion

We have carefully considered all arguments and the evidence of record. Here, we find confusion is likely in view of the overall similarity between Applicant's LINGO BUS mark and Registrant's LINGO mark, and that both marks will be used in connection with related communications services.

Decision: The refusal to register Applicant's mark under Section 2(d) is affirmed.