

THIS DISPOSITION IS NOT
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OF THE TTAB

Mailed: August 19, 2004
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Koleaseco, Inc.

Serial No. 76422636

Jeffrey S. Kapteyn of Price, Heneveld, Cooper, DeWitt &
Litton for Koleaseco, Inc.

Jeri Fickes, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Simms, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Koleaseco, Inc., a Michigan corporation, has appealed
from the final refusal of the Trademark Examining Attorney
to register the mark EXCELLENCE IN ACTION for the
transportation of freight by truck.¹ Applicant and the
Examining Attorney have submitted briefs but no oral
hearing was requested.

¹ Serial No. 76422636, filed June 19, 2002, based upon an
allegation of applicant's bona fide intention to use the mark in
commerce.

We affirm.

The Examining Attorney has refused registration under Section 2(d) of the Act, 15 USC §1052(d), on the basis of Registration No. 2,078,935, issued July 15, 1997, Section 8 affidavit accepted, for the mark EXCELLENCE IN MOTION for freight transportation services by truck. The Examining Attorney argues that the respective marks--EXCELLENCE IN ACTION and EXCELLENCE IN MOTION--have parallel construction and are very similar in meaning and commercial impression. The Examining Attorney notes that both marks begin with the same two words, and that "ACTION" and "MOTION" are "potential synonyms" (brief, p. 2) which convey similar meanings and end in the syllable "-TION." Further, each mark has six syllables with only one syllable being different. Because the similarities in the marks outweigh their dissimilarities, and because the services are identical, the Examining Attorney contends that confusion is likely.

Applicant, on the other hand, argues that the marks are dissimilar, the cited mark is weak and the purchasers are sophisticated. With respect to the marks, applicant contends that they are not similar in sound or appearance and do not have similar meanings or connotations. It is also applicant's position that the registered mark is "very

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weak" because of various third-party registrations for marks with the word "EXCELLENCE" in combination with other terms, for trucking services. For example, applicant notes the third-party registrations of the marks EXPERIENCE THE EXCELLENCE for freight transportation services (Registration No. 1,585,093); EXHIBITING EXCELLENCE for truck transportation and storage of trade show exhibits (Registration 2,163,345); and DEDICATED TO EXCELLENCE for freight transportation services by truck and trailer (Registration No. 2,385,243). Accordingly, applicant contends that the cited mark is entitled to a very narrow range of protection.

Finally, applicant argues that the purchasers of these services are sophisticated because they will be reasonably prudent users of such services. Applicant's attorney contends that those who contract for freight transportation services are generally larger organizations which use a significant degree of care in selecting trucking services. Considerations include routing, delivery schedules, size and weight of the shipments, on-time delivery rates, etc. Also, applicant's attorney maintains that these services are relatively costly.

In reply, the Examining Attorney argues that applicant has not presented any evidence that consumers of freight

trucking services have greater sophistication than the normal consumer. Also, concerning the weakness of the cited mark, the Examining Attorney maintains that the evidence, at best, shows dilution of only one common term--the word "EXCELLENCE." Further, she contends that even weak marks are entitled to protection sufficient to prevent likelihood of confusion.

Our determination of this issue is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Concerning first the services, we note that they are identical. We must assume, for our purposes, therefore, that these services would be offered through the same channels of trade to the same classes of potential purchasers. In this regard, while applicant has argued

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that the purchasers of freight transportation services would be sophisticated, applicant has offered no evidence with respect to this issue. Moreover, because the identifications are unrestricted as to potential purchasers, these services could be offered to all classes of purchasers, including relatively small businesses, such as mom-and-pop operations, which may not be as sophisticated. It is also possible that even ordinary consumers may contact applicant or registrant to transport items by truck. Moreover, the fact that some purchasers of these services may be knowledgeable or discriminating consumers who may be expected to exercise greater care in their selection of applicant's services "does not necessarily preclude their mistaking one trademark for another" or demonstrate that they otherwise would be entirely immune from confusion as to source or sponsorship when highly similar marks are used on identical services. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *In re Total Quality Group Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999); and *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988). Relative sophistication does not mean that the purchasers are experts at noticing slight differences between trademarks

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or service marks and remembering those differences when purchasing services.

Turning next to the respective marks--EXCELLENCE IN ACTION and EXCELLENCE IN MOTION--as our principal reviewing court, the U.S. Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Moreover, the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon a side-by-side comparison, but rather whether the marks, as they are used in connection with the registrant's and applicant's services, so resemble one another as to be likely to cause confusion. Under actual marketing conditions, potential purchasers do not necessarily have the opportunity to make side-by-side comparisons between marks. *Puma-Sportschuhfabriken Rudolf Dassler KG v. Roller Derby Skate Corporation*, 206 USPQ 255 (TTAB 1980). The proper emphasis is, therefore, on the recollection of the average customer, and the correct legal test requires us to consider the fallibility of human memory. The average purchaser normally retains a general,

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rather than a specific, impression of trademarks. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), aff'd unpub'd (Fed. Cir. June 5, 1992); and *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981).

Here, the two marks, while slightly different in sound, differ only by the next-to-last syllable, and have virtually identical meanings or connotations. They are also very similar in appearance. As the Examining Attorney has noted, they share parallel construction. As applied to identical services, we believe that confusion is very likely among potential purchasers.

Applicant has argued that the cited mark is a weak one entitled to only a narrow scope of protection. We agree that the word "EXCELLENCE" in the registered mark is a laudatory word signifying the superlative nature of the registrant's services. However, the respective marks must be compared in their entireties, and when so compared, the similarities outweigh the differences, even considering that the first word in each mark is a laudatory one. Also, "even weak marks are entitled to protection against registration of similar marks" for identical goods or services. *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB

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1982). See also *In re The Clorox Co.*, 578 F.2d 305, 198 USPQ 337, 341 (CCPA 1978)(ERASE for a laundry soil and stain remover held confusingly similar to STAIN ERASER, registered on the Supplemental Register, for a stain remover). Moreover, the third-party registrations which applicant has pointed to are not as similar to the cited registered mark as is applicant's mark.

While we have no doubt in this case, if there were any doubt on the question of likelihood of confusion, it must be resolved against the newcomer as the newcomer has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Decision: The refusal of registration is affirmed.