

THIS DECISION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
June 27, 2007

Mailed:  
January 3, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Conference America, Inc.

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Serial No. 76618253

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Theodore A. Breiner of Breiner & Breiner, L.L.C., for  
Conference America, Inc.

Kathleen M. Vanston, Trademark Examining Attorney, Law  
Office 103 (Michael Hamilton, Managing Attorney).

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Before Bucher, Rogers and Cataldo,  
Administrative Trademark Judges.

Opinion by Rogers, Administrative Trademark Judge:

Conference America, Inc. (applicant), has applied to register FIVE STAR CONFERENCING, in standard-character form, on the Principal Register for "communication services, namely teleconferencing, video teleconferencing, data teleconferencing and Internet conferencing, excluding cellular telephone communication services" in International Class 38. Applicant asserted both first use anywhere and first use of the mark in commerce on October 12, 2004. Applicant has disclaimed "conferencing."

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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 the mark in Registration No. 2230528, shown below, for "cellular telephone communication services," in International Class 38.



The cited registration issued March 9, 1999 (more than five years prior to the October 27, 2004 filing date of applicant's application), and lists November 2, 1997 as the date of first use of the registered mark, and first use of that mark in commerce. The registration includes a disclaimer of exclusive rights in the term "wireless" and a statement that "The lining is a feature of the mark and does not indicate color." The Office has accepted an affidavit under Section 8 of the Trademark Act filed to maintain the registration and a Section 15 affidavit has been acknowledged.

The examining attorney has asserted that FIVE STAR is the dominant element of the involved marks and that these marks yield similar commercial impressions. In addition,

the examining attorney argues that the involved services are related because they "are often provided by the same entity" (brief, unnumbered p. 5), and it would therefore "be reasonable for prospective purchasers to assume that the services of registrant and applicant emanate from the same source" (brief, unnumbered p. 6).

In support of its application, applicant asserts that the "use of identical, even dominant, words" in two marks "does not automatically mean that the two marks are similar." (Brief, pp. 8-9.) Further, notwithstanding the disclaimed portions of the respective marks, applicant contends the marks must be considered in their entireties and "sound different, are spelled different and create different commercial impressions ... one indicating a conferencing service and the other indicating a wireless telephone service." (Brief, pp. 10-11.) In addition, applicant also contends, in essence, that "FIVE STAR" is a weak designation because of frequent use as a laudatory term and should not be accorded a broad scope of protection. Further, applicant contends the involved services are different, travel in different channels of trade and are purchased only by consumers exercising reasonable care. Finally, applicant contends that it developed its mark independently of registrant's mark and

there has been no actual confusion for the two years prior to the declaration provided by applicant's president.

To support the contention that "FIVE STAR" has a laudatory connotation and must be considered weak in connection with the involved services, applicant relies on a definition of "five-star" as "of first class or quality"<sup>1</sup> and on the asserted existence of certain third-party applications and registrations that include the term. As for the latter, applicant asserts the existence of 378 "trademarks using the words 'five star' for various goods and services" (brief, p. 13), and provided as support for the assertion a printout from USPTO records.<sup>2</sup> However, the two-page printout lists only 49 application serial numbers and one registration number, i.e., the printout lists only the first 50 records of the asserted 378 that exist within USPTO records. Though applicant has not introduced copies of any of the third-party registrations or applications, the examining attorney did not object to the introduction of the list, which we have considered.<sup>3</sup> Its probative

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<sup>1</sup> The web-based dictionary definition was introduced with applicant's request for reconsideration of the final refusal.

<sup>2</sup> The printout accompanied the response to the initial refusal of registration and has been resubmitted unchanged twice more.

<sup>3</sup> Compare *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002) and *In re 1st USA Realty Professionals Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007).

value, however, is lacking. First, applicant has offered no evidence to establish use of any of these marks in commerce. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005) ("The probative value of third-party trademarks depends entirely upon their usage."); see also, *AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268, 269 (CCPA 1973). Second, because 49 of the marks are the subjects of applications it is entirely possible that these 49 are the subjects of intent to use applications and involve no use at all. See *Zappia-Paradiso, S.A. v. Cojeva Inc.*, 144 USPQ 101 (TTAB 1964) (evidence of applications is evidence only of their filing, even if published). Third, the list does not include the goods or services or any other information for any of the marks and is not therefore probative evidence whether the term FIVE STAR or FIVE-STAR is laudatory for any of the involved services.

In regard to the involved services, applicant contends that they "are completely different" (brief, p. 11), that registrant's cellular telephone communication services "are generally purchased by individuals" (brief, p. 12) while applicant's teleconferencing services "are generally purchased by businesses which hold meetings by

teleconferencing" (id.), and the services are not subject to impulse purchasing. To support these contentions, applicant relies on the declaration of its president, and a reprint of information regarding registrant's services. We address this evidence below, in our analysis of likelihood of confusion.

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion ... ." The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors we must consider in determining likelihood of confusion when evidence relevant to any listed factor is of record. Nonetheless, our analysis may focus "on dispositive factors, such as similarity of the marks and relatedness of the goods." See *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001). Here, as is often the case, the crucial factors are the similarity of the marks and the related nature of the services of the applicant and registrant. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 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.").

It is a well established principle that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, while the marks are compared in their entireties, including descriptive or disclaimed portions thereof, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). "That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark...."

Id.

In this case, we find the term FIVE STAR in each mark to be dominant. In the cited registered mark, it is larger and bolder than the term WIRELESS and its dominance is reinforced by the five star design component. FIVE STAR is also dominant in applicant's mark because the term comes first and because the term CONFERENCING is generic for the

identified conferencing services and would not be seen by prospective users of applicant's services as a source indicating element of the composite mark. Accordingly, we find the marks to create such similar overall commercial impressions that if the marks are used on related services confusion will be likely. See *In re Sarkli, Ltd.*, 721 F.2d 353, 220 USPQ 111, 113 (Fed. Cir. 1983) ("the PTO may reject an application ex parte solely because of similarity in meaning of the mark sought to be registered with a previously registered mark"); see also, *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983). Further, given the dearth of probative evidence supporting applicant's contention the term FIVE STAR is laudatory and should be accorded a narrow scope of protection, we must accord the cited registered mark the same scope of protection as we would any presumptively distinctive mark.

As for the involved services, there is no real dispute that registrant's services are limited to cellular telephone services and applicant provides various types of conferencing services and we accept for our analysis that such services are different.<sup>4</sup> However, notwithstanding the

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<sup>4</sup> During the oral hearing held for this appeal, in response to a question from the panel, the examining attorney stated that she

language in applicant's identification "excluding cellular telephone communication services," we note that applicant's identification includes teleconferencing. We take judicial notice of the following definition of "teleconferencing":<sup>5</sup>

(1) Video teleconferencing, or videoconferencing, is having a TV conference with several people at the same time. It is provided by inhouse cameras and monitors or in a public conferencing center.

...

(2) Audio teleconferencing is having a telephone conversation with several people at the same time. It is provided by a conference function on a PBX or multiline telephone or by the telephone companies.

(3) Computer teleconferencing is having a simultaneous conference with several people at the same time at their computers. It is provided by software in a host computer or BBS.

The Computer Glossary p. 394 (7th ed. 1995)

Based on this definition, the "teleconferencing" element of applicant's services must be read to include telephone conferencing, especially in light of the separate listing for video teleconferencing. And we must consider applicant's teleconferencing to include all types of telephone conferencing, including a conference that might involve a participant using a cellular telephone. In that

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would not read registrant's identification in an expansive manner so as to include conferencing services. Nor have we.

<sup>5</sup> The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

sense, then, applicant's and registrant's services must be considered as complementary. In addition, the examining attorney has put into the record evidence regarding marks registered for both cellular telephone services and various conferencing services, including teleconferencing services. Such registrations, as the examining attorney correctly asserts, are probative evidence that consumers may expect such services to be available from a single source. See *In re Infinity Broadcasting Corporation*, 60 USPQ2d 1214, 1217-1218 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-1786 (TTAB 1993); *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988). Moreover, the examining attorney has also put in the record reprints from web pages of various entities showing that they offer both types of services, and that they may be offered to both consumers and businesses.

For our likelihood of confusion analysis, it is sufficient that the respective services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re*

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*Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

We find the examining attorney's evidence persuasive that the involved services are related. We are not persuaded otherwise by the declaration of applicant's president, especially his contention that applicant's type of services would only be offered to businesses and cellular telephone services would only be offered to individuals. While applicant has attempted to establish that the cited registrant's services are only offered to individuals by placing in the record reprints of information (a brochure, it appears) regarding such services, applicant cannot artificially restrict the services listed in the cited registration. See *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764-65 (TTAB 1986) (An applicant may not restrict the scope of its goods or services and/or the scope of the goods or services covered in a cited registration by argument or extrinsic evidence.). See also, *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977) (A registrant's rights "are not to be tied

into its current business practices, which may change at any time").

In short, we find the involved services related for the purpose of assessing likelihood of confusion. Further, and contrary to applicant's argument, there is no basis upon which to restrict the channels of trade or classes of consumers for the involved services. Nor do we find persuasive applicant's argument that prospective consumers of the involved services would always be sophisticated and always exercise a reasonable degree of care. The use of cellular telephone services is ubiquitous and we must consider users of such services to include consumers of varying degrees of sophistication. Even if we assume consumers of the involved services are universally sophisticated and would exercise care in purchasing decisions, such consumers are not necessarily immune to source confusion. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers...are not infallible.").

Applicant's remaining arguments are, essentially, that it adopted its mark in good faith and there is no evidence of actual confusion. Neither argument is persuasive that

there is no likelihood of confusion. Good faith adoption or lack of any intent to trade on another's mark will not avoid a finding of likelihood of confusion; put another way, while evidence of bad faith adoption can harm a party's position, good faith adoption is expected and does not necessarily aid the party's position. See *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889, 1891 (Fed. Cir. 1991) and *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1640 (TTAB 1988). And as to the absence of evidence of likelihood of confusion, there is no evidence whether conditions of actual use are such that there would have been opportunities for such incidents to arise. See *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003) ("The lack of evidence of actual confusion carries little weight ... especially in an *ex parte* context.") (internal citation omitted).

**Decision:** The refusal to register applicant's mark under Section 2(d) of the Trademark Act is affirmed.