

This Opinion is Not a  
Precedent of the TTAB

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**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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**On Request for Reconsideration**

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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) 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

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cellular telephone communication services" in International Class 38. Applicant disclaimed exclusive rights to the word "conferencing."

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 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."



On appeal, after briefing and oral arguments, we affirmed the final refusal of registration. Applicant now seeks reconsideration of that refusal, essentially arguing that this panel made errors in fact finding and in applying the law to the issue on appeal. Though applicant has only subdivided its request for reconsideration into two main sections ("Differences of the Trademarks" and "Differences

of the Services") we have examined the request carefully to discern in it specific assertions of error, and we conclude that applicant contends the panel erred in:

Finding that the FIVE STAR element of the cited registered mark, which is also an element of applicant's mark, is presumptively distinctive;<sup>1</sup>

According the mark in the cited registration a broad scope of protection;

Giving "no weight to the fact that 378 applications or registrations use the word FIVE STAR as part of the trademark," thereby confirming that it "is a descriptive and laudatory name" (Request for reconsideration, p. 4);

Finding that the telephone conferencing services included within the scope of applicant's services and the cellular telephone services of the registrant are complementary;

Failing to accord the declaration evidence of applicant's president appropriate weight; and

Relying on evidence introduced by the examining attorney that third parties offer both conferencing services and cellular telephone services.

Not surprisingly, applicant has concluded that "there is no likelihood of confusion among an appreciable number of prudent purchasers" (emphasis by applicant) and we should therefore reconsider our decision and reverse the refusal of registration.

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<sup>1</sup> "It should not be in dispute (unless one has been living under a rock) that the name FIVE STAR is used as a laudatory term." Request for reconsideration, p. 3 (footnote omitted).

***Focus on, and Distinctiveness of, FIVE STAR***

As we explained in the decision applicant seeks to overcome, the Federal Circuit has explained that "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark" and the descriptiveness of a particular feature is "one commonly accepted rationale" for giving less weight to the descriptive feature. *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Thus, we see no error in our decision to focus on the common "five star" elements of the involved marks and do not believe such focus resulted from impermissible dissection of the marks.

In addition, we see no error in acknowledging that the term WIRELESS is the subject of a disclaimer in the cited registration, but concluding nonetheless that the cited registrant's mark is "presumptively distinctive." The registration is on the Principal Register and does not rely on a claim of acquired distinctiveness, and must therefore be considered inherently distinctive. See Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b) and its presumption that the registration is valid. See also, *Lane Capital Mgmt., Inc. v. Lane Capital Mgmt., Inc.*, 192 F.3d 337, 52 USPQ2d 1094, 1098 (2d Cir. 1999) ("Registration by the PTO

without proof of secondary meaning creates the presumption that the mark is more than merely descriptive and, thus, that the mark is inherently distinctive."). Applicant may be willing to engage in an impermissible collateral attack on the registration by arguing that it FIVE STAR "is a descriptive and laudatory name." (Request for reconsideration, p. 4.) It would be error, however, for this panel to join the attack and to deny the mark in the cited registration the presumption of validity that accompanies registration on the Principal Register, and the presumptive distinctiveness resulting from its registration on the Principal Register without proof of secondary meaning.

***Scope of Protection for the Cited Registration***

Contrary to applicant's suggestion, we did not accord the registered mark an unnecessarily broad scope of protection. We would, to be sure, accord a mark shown to be particularly distinctive or famous a broad scope of protection. See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992) ("Famous or strong marks enjoy a wide latitude of legal protection."), *cert. denied*, 113 S.Ct. 181 (1992). In our decision, however, we accorded the cited registration only an average scope of protection ("we must accord the

cited registered mark the same scope of protection as we would any presumptively distinctive mark"). While applicant clearly believes even that is too broad, we cannot restrict the scope of protection that a mark is due under the statute except upon an appropriate showing.

***Other Marks Including the Term FIVE STAR***

We detailed in our earlier decision the deficiencies in the evidence proffered by applicant in its attempt to narrow the scope of protection afforded the mark in the cited registration. In particular, we noted that applicant had not actually provided evidence of use of FIVE STAR in the marks in 378 applications or registrations. Our decision cited to governing precedents from the Federal Circuit and its predecessor the Court of Customs and Patent Appeals. Here is another such citation (with emphasis in the original): "[I]n the absence of any evidence showing the extent of use of any of such marks or whether any of them are now in use, they [the third-party registrations] provide no basis for saying that the marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion." *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973). Clearly, the guidance on this issue

is unequivocal. Applicant may be willing to ignore these precedents, but we are not.

Moreover, we noted that the information provided by applicant was for only 49 applications and one registration, not 378 applications and registrations, and did not associate any of the 50 marks with particular goods or services. Even if we could accept applicant's mere listing of these 50 marks as probative evidence, the evidence was offered to show weakness of FIVE STAR and the strength or weakness of the term depends on its context of use, including the goods or services. There may very well be significant evidence of weakness of FIVE STAR for the involved services, but applicant did not make any such evidence of record.

***Asserted Laudatory Nature of FIVE STAR***

In essence, the three above-discussed allegations of error stem from applicant's conclusion that we unreasonably refuse to acknowledge the laudatory nature of the term FIVE STAR. We appreciate that applicant is essentially contending that "stars" are utilized in rating schemes and that more stars are better. However, we also recognize that not all such "star" rating systems employ the same number of stars. There is nothing in the record to establish either than the involved services are typically

rated on a star system, or that, if they are, a five star scale is employed. For reasons already discussed, applicant cannot collaterally attack the registered mark and we cannot deny it its presumptive distinctiveness. Even if we were dealing with the question in the proper forum, i.e., a petition for cancellation brought by applicant against the cited registration, we would still need evidence establishing that use of FIVE STAR for the involved services would be perceived as use of a laudatory rating.<sup>2</sup>

***Complementary Nature of Services; Common Sources for Services***

In our decision on applicant's appeal, we provided two alternative bases for finding the involved services related for likelihood of confusion purposes. One of those, and a rationale with which applicant disagrees, is that the involved services are complementary. This is not an unusual basis for finding goods and/or services to be related. See *Synergistic International LLC v. Korman*, 402 F.Supp.2d 651, 77 USPQ2d 1599, 1605 (E.D. Va. 2005) ("it is

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<sup>2</sup> The theoretical possibility of applicant challenging the cited registration in a cancellation proceeding is, however, just that, as the cited registration was more than five years old prior to the filing of applicant's application. Accordingly, the registration would not be subject to a claim that the mark is a laudatory descriptive term.

well cited law that 'complementary products, or services, are particularly vulnerable to confusion.'" ) *citing Communications Satellite Corp. v. COMCET, Inc.*, 429 F.2d 1245, 166 USPQ 353, 358 (4th Cir. 1970).

In *American Express Co. v. American Express Limousine Service Ltd.*, 772 F.Supp. 729, 21 USPQ2d 1009 (E.D.N.Y. 1991), the plaintiff was involved in financial and travel-related services and defendant provided car service in the tri-state area around New York City. The court noted that plaintiff's services involved making reservations for defendant's services and plaintiff's "charge card may be used for such services"; and the court concluded, "Although the service offered by defendants is not identical to those offered by plaintiff, they are in fact closely related, complementary services." *Id.* at 1012. *See also, Visa Internat'l Serv. Assoc. v. Visa Hotel Group, Inc.*, 561 F.Supp. 984, 218 USPQ 261, 268 (D.Nev. 1983) ("Although these financial and hotel services are different and noncompetitive, they exist as complementary products in the same general industry, i.e., the travel and entertainment industry, and they are definitely related"), and *In re Code Consultants Inc.*, 60 USPQ2d 1699 (TTAB 2001) (although the Board found "obvious differences" between the involved

services, it concluded it was "clear that there is a complementary relationship").

We see no error in our finding that cellular telephone services and telephone conferencing services that can be used in conjunction, are complementary, especially in view of the alternative basis for finding the services related, i.e., that there are entities that offer both types of services. See *Communications Satellite Corp.*, *supra*, 166 USPQ at 358: "A reasonable person may well believe that Comcet's communications computers come from a source related to Comsat's communications services. The possibility of confusion is increased because there are firms, such as RCA, that manufacture computers and also offer communications services."

As explained in our decision, the examining attorney introduced two types of evidence demonstrating that applicant's services and those of the cited registrant can emanate from the same source: registrations showing registration of a single mark for both services, and reprints of web pages showing a single entity offering both services. Thus, applicant's assertion in its request for reconsideration (p. 5) that "there is no evidence of record to establish that the parties' services are related," is an unreasonable characterization of the record.

Although applicant then retreats somewhat from this assertion and acknowledges (p. 7) "the fact that certain third parties, e.g., MCI, offer both cellular telephone communication services and conferencing services," applicant apparently considers the third party registrations and web page evidence to establish only that "certain merchants sell a broad range of goods and services," and asserts that this is insufficient to find the involved services related. Applicant then goes on to discuss two cases in which the Board found no likelihood of confusion, but both cases involved goods entirely different from the services involved in the case at hand. Applicant does not specifically challenge any of the examining attorney's evidence or the case law cited by the Board explaining the value of such evidence. Applicant's discussion of the prior decisions it chooses to highlight does not establish error in our weighing of the evidence of record, for "it is well established that each case involving a trademark (or service mark) stands on its own facts, and prior decisions are of little value." *In re Quik-Print Copy Shop, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 n. 8 (C.C.P.A. 1980), citing *Star Watch Case Co. v. Gebruder Junghans, A.G.*, 267 F.2d 950, 122 USPQ 370 (1959).

***Applicant's Declaration Evidence***

Although applicant has not discussed the evidence of the examining attorney, except in the single referenced acknowledgement noted above, applicant faults the Board for not according proper weight to the declaration of its president. Specifically, applicant contends (p. 7, n. 10), "There is no evidence to dispute the declaration evidence of applicant, that applicant's services are purchased by different consumers and travel in different channels of trade." Applicant also contends (p. 9), the Board did not consider the declaration evidence on channels of trade, the expensive nature of the involved services, and the degree of care exercised by consumers.

In our decision on applicant's appeal, we specifically acknowledged the assertion of applicant's president that the involved services are marketed to distinct classes of consumers. We also addressed applicant's contentions, albeit without acknowledging that applicant's president made specific assertions to support those contentions, regarding channels of trade and sophistication of purchasers, applicant's adoption of its mark, and the asserted absence of actual confusion. The Board generally will not consider, or will give little weight to, arguments unsupported by any evidence in the record. Because we

addressed each of the arguments applicant made based on the declaration of its president, it should have been clear to applicant that the declaration was considered in its entirety, even when we did not specifically acknowledge the declaration as the source of support for the argument.

However, we also explained that it was impermissible for applicant to artificially restrict the services in the cited registration, how the services are offered, or their classes of consumers. The point is not whether applicant's president believes his statements on these points to be true, or even whether they are true. Rather, the point is that it is impermissible under applicable case law, which this Board is bound to follow, for applicant to graft onto the cited registration restrictions that do not exist in the registration's recitation of services as to classes of consumers or channels of trade. We note again that a registrant's rights "are not to be tied into its current business practices, which may change at any time." See *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 2 (CCPA 1977).

As for the assertedly expensive nature of the involved services and asserted degree of care that consumers exercise in reaching their purchasing decisions, our decision on applicant's appeal not only expressed some

doubt regarding these contentions, but went on to assume that they were true. Nonetheless, even when assumed to be true, we could not conclude that there would be no likelihood of confusion. We remain convinced there was no error in reaching that conclusion. See *Communications Satellite Corp., supra*, 166 USPQ at 358: "[T]he expertise of purchasers does not always assure the absence of confusion. ... Even buyers of specialized equipment may assume that related corporations are the source of noncompetitive goods." The Board is duty-bound to reach its own decisions on cases that come before it. That a panel of the Board reaches a different conclusion than an individual who has provided evidence through a declaration does not mean the declaration was not considered, it only means the Board has reached a different conclusion.

**Decision:** The request for reconsideration is denied and the decision affirming the refusal of registration stands as issued.