

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

December 11, 2006

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Black

Serial No. 78456723

David M. Silverman and Brian J. Hurh of Cole, Raywid & Braverman, L.L.P. for Amy Black.

Michael Tanner, Trademark Examining Attorney, Law Office 117 (Loretta Beck, Managing Attorney).

Before Hairston, Holtzman and Walsh, Administrative Trademark Judges.

Opinion by Walsh, Administrative Trademark Judge:

On July 26, 2004, Amy Black (Applicant) filed an intent-to-use application to register HELLO WORLD in standard-character form on the Principal Register for services now identified as "electronic transmission of live, prerecorded and interactive pictures, video, text and audio over a global computer network; electronic store-and-forward messaging" in International Class 38.¹

¹ The application, as filed, also covered services in International Classes 35 and 41. Applicant filed and the Office granted a request to divide with respect to the services in those classes. The refusal on appeal is limited to Class 38.

The Examining Attorney has 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 HELLO WORLD COMMUNICATIONS in standard-character form, registered for "rental of telephones" in International Class 38² (Reg. No. 2152084). The registration, which issued on April 21, 1998, is active. The registration claims first use of the mark anywhere in March of 1991 and first use of the mark in commerce in September of 1991. The registration includes a disclaimer of "WORLD COMMUNICATIONS."

Applicant responded and argued against the refusal. The Examining Attorney made the refusal final and Applicant appealed. Both Applicant and the Examining Attorney have filed briefs. We affirm.

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..." Id. 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 may consider

² The registration covers services in International Class 41 also, but the Examining Attorney limited the refusal to International Class 38.

in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods 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 [services] and differences in the marks."). Below we will discuss all factors as to which Applicant or the Examining Attorney argued or presented evidence.

The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of both marks. Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

As to the marks, Applicant argues, "... the two marks at issue actually have a different connotation and convey a different commercial impression, as demonstrated by the disclaimer of WORLD COMMUNICATIONS in the Registered Mark... Potential customers see Applicant's mark as HELLO WORLD where 'WORLD' is used as noun (sic), while they are likely to view that word in Registrant's mark as an adjective

modifying 'COMMUNICATIONS.'" On the other hand, the Examining Attorney argues that the inclusion of "COMMUNICATIONS" in the registered mark is insufficient to distinguish the marks.

We agree with the Examining Attorney. Applicant's reliance on the disclaimer is misplaced. The existence of the disclaimer has no bearing on how relevant purchasers will perceive the registered mark; we must assume that the relevant public would have no knowledge of this entry in the cited registration. Norton Co. v. Talbert, 202 USPQ 542, 544 (TTAB 1979). Cf. Marriott Corp. v. Fairmont Foods Co., 171 USPQ 58, 63 (TTAB 1971). We likewise reject Applicant's argument that the use of WORLD as a noun in her mark versus the use of WORLD as an adjective in the registered mark will have a significant impact on the perception of the marks.

It is significant that both marks begin with HELLO WORLD. Presto Products, Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered."). Here it is of particular importance because the phrase HELLO WORLD is more than the mere sum of its parts. It is a phrase which resonates with a

particular meaning, namely, a bold declaration of introduction. Cf. In re Thomas, 79 USPQ 1021, 1025 (TTAB 2006). Applicant's unsupported assertion that this significance will be lost in the registered mark is not persuasive.

Rather, we find the Examining Attorney's argument persuasive -- that is, that the inclusion of the highly descriptive or even generic term "COMMUNICATIONS" in the registered mark fails to distinguish the marks. Cf. M2 Software Inc. v. M2 Communications Inc., 450 F.3d 1378, 78 USPQ2d 1944, 1948 (Fed. Cir. 2006). It is more likely that relevant purchasers will perceive the registered mark with a recognition of the phrase "HELLO WORLD" rather than in the manner Applicant suggests with "HELLO" standing alone and with "WORLD" as a descriptive modifier of "COMMUNICATIONS." Accordingly, we conclude that HELLO WORLD is applicant's entire mark and that HELLO WORLD is the dominant element in the mark in the cited registration.

We have also considered and rejected Applicant's other arguments related to the marks. First, Applicant points out that a company with which she was formerly associated, Hellonetwork.com, Inc., had previously applied to register HELLO WORLD, that the application was approved, published for opposition and not opposed, and that the application

was finally abandoned due to the failure to file a statement of use. Applicant argues that the Office did not refuse registration in the previous application even though the HELLO WORLD COMMUNICATIONS registration was in effect at the time, and therefore, that it is improper to refuse registration here on that basis. We find this argument unpersuasive. This Board has generally rejected the premise that evidence that similar marks previously "coexisted" on the register precludes a refusal which is otherwise proper. See Mattel, Inc. v. Funline Merchandise Co., Inc., __ USPQ2d __, Cancellation No. 92040128 (TTAB, November 7 2006). See also In re Wilson, 57 USPQ2d 1863, 1871 (TTAB 2001). Furthermore, we must consider the refusal before us on the merits without regard to actions taken by examining attorneys in other applications. In re Nett Designs, Inc., 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); See also In re Sunmarks Inc., 32 USPQ2d 1470, 1472 (TTAB 1994). Also, even active third-party applications have no probative value other than as evidence that the applications were filed. In re Phillips-Van Heusen Corp., 63 USPQ2d 1047, 1049 n.4 (TTAB 2002).

In similar fashion, Applicant also refers to three registrations for marks which consist entirely of or include HELLO WORLD. Applicant argues that these

registrations and the cited registration coexisted at one time, and that the refusal here is not consistent with the actions taken on those applications/registrations.

Applicant also suggests that this demonstrates that the registered mark is weak, and as such, entitled to a narrow scope of protection.

Only one of the marks Applicant references is the subject of an active registration - Reg. No. 2081449 for the mark HELLO WORLD PUBLICATIONS for a "series of nonfictions books regarding computer programming." As to the referenced cancelled or expired registrations, such registrations ordinarily have no evidentiary weight. Cf. Mattel, Inc. v. Funline Merchandise Co., Inc., supra at 9-10. As to the one active registration, the goods in that registration appear to be distinguishable from the services of Applicant and registrant at issue here. More importantly, as noted above, we are not bound by decisions by examining attorneys in prior applications; we must consider the record in the case before us. In re Nett Designs, Inc., 57 USPQ2d at 1566. Accordingly, the prior registrations of record of marks which include HELLO WORLD do not dictate a course of action here, nor do they demonstrate that the registered mark is weak.

Applicant also relies on registrations for marks which include either "HELLO" or "WORLD," but not both terms, in an attempt to demonstrate that the registered mark here is weak.³ The registrations which Applicant has made of record have little probative value because the marks differ markedly from the two marks at issue here in that they do not include the entire phrase "HELLO WORLD." Furthermore, third-party registrations are entitled to little weight on the question of likelihood of confusion. See, e.g., In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). Such registrations are not evidence that the marks are in use nor that the public is familiar with them. See, e.g., AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Therefore, we have no basis to conclude that the cited registered mark is weak - though it may be somewhat suggestive - or otherwise not entitled to the same scope of protection accorded any registered mark.

³ In presenting this argument Applicant also refers to certain search results indicating specified numbers of registrations for marks which include either "HELLO" or "WORLD," in general, and in International Class 38, in particular. Applicant did not provide records for all of the enumerated registrations. The numbers alone from search results have no probative value and have not been considered. Cf. In re Duofold Inc., 184 USPQ 638, 640 (TTAB 1974).

Accordingly, we conclude that the marks HELLO WORLD and HELLO WORLD COMMUNICATIONS are similar in appearance, sound, connotation and commercial impression.

The Services

With respect to the services, Applicant identifies her services as "electronic transmission of live, prerecorded and interactive pictures, video, text and audio over a global computer network; electronic store-and-forward messaging" in International Class 38. The services in the cited registration are simply identified as "rental of telephones" also in International Class 38.

The services need not be identical to find that the services are related under Section 2(d) of the Trademark Act. The services need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the services originate from the same source. On-Line Careline Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the services and the channels of trade for the services, we must consider the services as identified in the application and registration, as Applicant acknowledges. CBS Inc. v. Morrow, 708 F.2d

1579, 218 USPQ 198, 199 (Fed. Cir. 1983); In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Also, the proper inquiry is not whether the services could be confused, but rather whether the source of the services could be confused. Safety-Kleen Corp. v. Dresser Indus., Inc., 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); In re Rexel, Inc., 223 USPQ 830, 831 (TTAB 1984).

Applicant argues that her services differ from those in the cited registration. In an attempt to distinguish her services from "rental of telephones" Applicant states, "What the Examiner ignores is that Applicant's services do not involve telephones at all, since they are provided over 'a global computer network,' i.e., the Internet. In the same way that such services do not involve telephones (rented or otherwise), the Registrant's telephone rental services are unlikely to include Applicant's Internet-based transmission services." On the other hand, the Examining Attorney argues that the services of Applicant and registrant are related, stating, "The widespread existence of telephone rental and data transmission services offered from a single source undermines the applicant's contention that these services are not related in the mind of the consuming public. As the evidence of record overwhelmingly

demonstrates, the respective services while somewhat different do emanate from a single source."

The Examining Attorney has provided evidence in support of his position that the services of Applicant and registrant are related, including used-based, third-party registrations showing registration of the same mark for both types of services in International Class 38. The following registrations are representative of the registrations of record:

Reg. No. 2103018 for the mark PHONE GURU for "telecommunication services, namely, rental of telecommunication equipment, providing telecommunications connections to a global computer network ... personal communication services, telephone communication services, and cellular telephone services; and data transmission services, namely, electronic transmission of data via computer terminals, facsimile transmission services, and voice-on-demand transmission services";

Reg. No. 2356719 for the mark UNICEL for "cellular telephone services; paging services; telecommunications services, namely, personal communication services; mobile radio communication; wireless digital messaging services; wireless voice mail services; voice mail services; audio teleconferencing; telecommunications gateway services; outcall notification services; electronic transmission of messages, voice and data; delivery of messages by electronic transmission; electronic store-and-forward messaging; rental of telecommunication equipment";

Reg. No. 2508628 for the mark SHOWKIT.COM for "electronic mail services; electronic storage of data and messages; electronic store-and-forward messaging; electronic transmission of data via computer terminals; rental of telecommunications equipment; and personal and business communications services";

Reg. No. 2609056 for the mark NEW ULM TELECOM and Design for "delivery of messages by electronic transmission ... electronic mail services; electronic store-and-forward messaging; electronic transmission of data and documents via computer terminals; electronic voice messaging, namely, the recording, storage and subsequent transmission of voice messages by telephone ... providing multiple-user access to a global computer information network; providing telecommunications connections to a global computer network; rental of telecommunication equipment ... telecommunications services, namely, personal communication services; telephone communication services; telephone voice messaging services; and voice mail services";

Reg. No. 2875235 for the mark WEBSPHERE for "telecommunications services, namely, electronic transmission of data and documents by computer terminals and computer-aided transmission of data; telephone, telex, facsimile, telegram, and message storage, retrieval and transmission services; services for the transmission of data and of information by electronic, computer, telecopier, television, radio, electronic mail, laser beam, or communication satellite means; rental of communications, facsimile, teleconferencing, and video conferencing apparatus and instruments";

Reg. No. 2854501 for the mark TAP INTO THE NETWORK for "communication services, namely electronic mail services and electronic transmission of data and documents via computer terminals; facsimile transmission services; rental of telephone, facsimile, or modems; video teleconferencing"; and

Reg. No. 2842929 for the mark 1-800-RIDE-QWEST for "telecommunications services; namely, ... electronic transmission of voice, data, video and messages; providing access to a fiber optic telecommunications network; providing access to a global information network; wireless communications services, namely wireless digital messaging services, wireless voice mail services, and wireless data transfer services; leasing and rental of telecommunications equipment; video transmission over telecommunications network,

namely vdsl (video digital subscriber line); dsl (digital subscriber line) services; frame relay services; atm (asynchronous transfer mode) services; ip telephony services; private line services; virtual private network services, namely, virtual private data network services, virtual private network access services, and virtual private voice network services; paging services; public telephone services; and video teleconferencing services."

Applicant essentially posits that the rental of telephones exists in a separate world or marketplace apart from online services, that is, services rendered over computer networks. The evidence of record illustrates quite the opposite. In fact, the third-party registrations, as well as the evidence from web pages provided by the Examining Attorney, demonstrate that a wide range of services involving telephone services, including rental of telephones, and computer network services may emanate from the same source. Furthermore, the evidence indicates that telephone services, including rental of telephones, and various online services are integrated. For example, many of the third-party registrations include both rental of telecommunications equipment, or telephones, and various types of electronic and/or voice messaging services.

In comparing the services of applicant and registrant, as identified in the application and cited registration, the most obvious relationship appears to exist between the

registrant's "rental of telephones" and Applicant's "electronic store-and-forward messaging" services. However, it is also apparent that the remainder of Applicant's services are related to registrant's services in a marketplace where the offer of multiple, integrated services, including telephone and other types of communications services, prevails.

In Applicant's attempt to draw a distinction between the services, Applicant fails to acknowledge the close functional relationship between her services and those in the cited registration. For example, basic telephone service is essentially a service which enables people to communicate with one another over distances. The online messaging service applicant identifies serves the very same function.

Also, the stark distinction applicant attempts to draw between telephones and online services is artificial. In fact, telephone services can be rendered over computer networks, including the Internet, telephones can be used to transmit and receive text messages and content in other forms, and telephones can be used to access computer networks, again including the Internet. Thus, we reject Applicant's broad, unsupported assertion that, "the Internet is not a telecommunications network." (Emphasis

in original.) The definition of "telecommunications" in the Dictionary of Data & Telecommunications (1999) states: "1. Meaningful wired/cabled or wireless transmission and receipt of signals over distance. 2. Broadcast, telegraph, and computer network communications frequently with a 'give-and-take' quality or by choice of the receiving party, carried through a variety of media, including wires, fibers, air, etc..."⁴

Furthermore, "rental of telephones" is not limited in any way. It may include wire, cellular or satellite or any other specific type of phone. Also, the "rental of telephones" is necessarily related to a communications service. The rental of a telephone without the ability to use it to communicate would serve no purpose.

Furthermore, we reject Applicant's attempt to limit the scope of the registrant's services through extraneous evidence. See In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986) (extrinsic evidence and argument suggesting trade-channel restrictions not specified in application rejected). Applicant asks us to consider evidence she offered allegedly related to the registrant's

⁴ We take judicial notice of this dictionary definition under University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

actual business. She states, "Thus, it is apparent that Registrant's telephone rental business is ancillary to its primary business, which relates to video productions." Applicant then suggests that the registrant renders its "rental of telephones" service only in conjunction with video productions. Applicant also argues that we should look to the identification of services in other classes in the cited registration and construe "rental of telephones" in view of those identifications which relate to the video production business. It would be improper to use either extraneous evidence or identifications in other classes to limit the scope of the plain language in International Class 38 in the cited registration. Id. We must construe "rental of telephones" to include any services the language encompasses and to include all ordinary channels of trade for such services. In re Melville Corp., 18 USPQ2d at 1388.

We also reject Applicant's argument that this is a case of holding goods or services related merely because they are offered over the Internet citing Sports Authority Michigan Inc. v. PC Authority Inc., 63 USPQ2d 1782 (TTAB 2002) and other cases. The record here establishes that the services of Applicant and registrant are related in a

functional sense and that they may emanate from the same source under the same mark.

Accordingly, we conclude that the services of Applicant and registrant are related and that the services of Applicant and registrant could travel through the same or overlapping channels of trade.

Other Factors

Applicant argues briefly that there has been no actual confusion between her mark and the mark of the registrant. We do not consider this factor to be significant in this case. First, there is no evidence of the extent to which the services of Applicant and registrant have been offered in the same territory such that there would have been an opportunity for actual confusion. More importantly, in an ex parte proceeding, "uncorroborated statements of no known instances of actual confusion are of little evidentiary value." In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003). See also In re Kangaroos U.S.A., 223 USPQ 1025, 1026-27 (TTAB 1984).

In her reply brief Applicant also apparently argues that the purchasers of the registrant's services are sophisticated and therefore less likely to be confused. Here too the argument rests on the assumption that the purchasers of registrant's "rental of telephones" service

are limited to "sophisticated purchasers of video production equipment and services." As we indicated above, we cannot and do not assume that registrant's channels of trade are so limited. Based on the identifications of services in both the application and registration we assume that the purchasers for both could include the general public. Furthermore, even sophisticated purchasers are not immune from trademark confusion. In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983). Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion.

Conclusion

In conclusion, after considering all evidence of record in this case bearing on the du Pont factors, we conclude that there is a likelihood of confusion between Applicant's mark and the mark in the cited registration. We conclude so principally due to the similarity of the marks and the fact that the services of Applicant and registrant are related and could travel through the same or overlapping trade channels to the same purchasers.

Decision: We affirm the refusal to register Applicant's mark under Section 2(d) of the Trademark Act.