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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re VagueProtocol, Ltd.

Serial No. 78461638

Arnold S. Weintraub of The Weintraub Group, P.L.C. for
VagueProtocol, Ltd.

Wendy B. Goodman, Trademark Examining Attorney, Law Office
109 (Dan Vavonese, Managing Attorney).

Before Drost, Kuhlke, and Bergsman, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 4, 2004, VagueProtocol, Ltd. (applicant)
applied to register the mark MOBILTICKET (in standard
character form) on the Principal Register for services
ultimately identified as "electronic transmission of data
to a merchant in the nature of a machine readable code or
display representing a transaction receipt which is
displayed on a mobile device display screen" in Class 38.
Serial No. 78461638. The application contains an

allegation of applicant's bona fide intention to use the mark in commerce.

The examining attorney has finally refused registration of the application on two grounds. First, the examining attorney has refused to register applicant's mark on the ground that the term MOBILTICKET is merely descriptive of applicant's services. 15 U.S.C. § 1052(e)(1).

Second, the examining attorney has also refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because she determined that it is likely to cause confusion, to cause mistake, or to deceive as a result of three registrations owned by the same party (Deutsche Telekom AG), and all for the identical mark, MOBILETICKET (typed or standard character drawing) for the following goods and services:

I.
Registration No. 2908484
Issued: December 7, 2004
Class: 9
For: Electric, electronic, optical, measuring, signaling, controlling and teaching apparatus and instruments, all for use with telecommunications, namely, apparatus for producing sound, images or data; blank magnetic and optical data carriers; data processors; computers, namely, microcomputers, minicomputers, computer central processors, computer monitors, computer keyboards, computer terminals, computer memories, computer laser printers, computer impact printers, computer dot matrix printers, computers and instructional manuals sold as a unit;

computer interface apparatus, namely, computer interface boards, computer mouse and mouse pad, computer peripherals and parts thereof; computer software for use in operating telecommunications and business management systems and related instruction manuals sold as a unit; computer software programs, for financial accounting, for the provision of online information services in the field of news, sports, entertainment, culture, business and finance, weather and travel, network management, computer proxy, for controlling access and alarm monitoring of homes, apartments, buildings and other properties, billing analysis, network access control and for creating and maintaining firewalls; computer software programs for accessing a global computer network and interactive computer communications networks; optical fibers sold as a component of fiber optical cables; fiber optic cables; optical scanners; optical character readers; optical blank discs; optical glass for signal transmission; optic transmitters for radio and telephone; optic receivers for telephone, audio, video; optical signal processors; optical attenuators; optical amplifiers; optical character recognition apparatus, for use in the telecommunications field, and parts thereof; telecommunication audio, video and data communications systems, namely, digital and analogue signal transmitters, receivers and converters for use with telephone, audio, video; radio and telephone transmitters; communication receivers and servers for telephone, audio, video; telephone answering machines; teleprompters; facsimile machine; electronic mail apparatus for electronic exchange of data images and messages; electrical wire; electrical wire connectors; integrated circuits; printed circuits; electric circuits; circuit breakers; printed circuit boards; circuit connectors; electrical controllers; electrical converters; electrical conductors; electrical fuses; electric luminescent display panels; electrical switch plates; electric plugs; electric coils; antennas; electrical cables; computer cables; computer chips; silicon chips; chronographs for use as specialized time recording apparatus; computer buffers; blank computer discs; blank computer floppy disks; computer hard discs; acoustic conduits; electrical conduits; fiber optic conduits and parts thereof; compact disc players; audio and video tape recorders; audio and videotape

players; audio and videocassette recorders; audio and videocassette players; blank audio and videotapes, cassettes, discs and microfiche; audio and video tapes, cassettes, discs and microfiche featuring information concerning telecommunications, and concerning personal and business management systems; audio and video recordings in the field of telecommunications, information technology and safety; television and television peripheral equipment, namely, cameras, remote control units for interactive and non-interactive use; video monitors; automatic vending machines and timing mechanisms therefor and parts thereof; machine readable, magnetically encoded cards, namely, prepaid telephone calling cards and credit cards; blank smart cards; magnetic coded card readers; data processors and readers; word processors; microprocessors; electronic encryption units; demagnetizers for magnetic tapes and parts thereof; lasers not for medical use; light emitting diodes; light emitting diode displays; computer, data and video networking and conferencing equipment, namely, teleconferencing equipment and audiovisual teaching equipment in the nature of overhead film; photographic and slide projectors; projection screens; computer based information display equipment, namely, computers which display information on an overhead screen; Teletypewriters and parts thereof, namely, caller identification boxes, dialing assemblies, telephone units, audio operated relays, audio/video signal and optical filters, protectors and automatic signaling and control equipment, telemeters, wireless and cellular telephones, and radio pagers; intercoms; portable computer devices, namely, laptops, handheld and pocket computers, wireless fax machines; personal communications equipment, namely, personal digital assistants; calculators and related peripherals; satellite processors, satellite and satellite communication earth stations both stationary and moveable; computer game programs for children and adults; video and computer game cartridges; audio and video recordings in the field of news, sports, entertainment, culture, business and finance, weather and travel; prerecorded compact discs, audiocassette tapes, videocassette tapes, digital audiotapes and digital video discs featuring musical, variety, news and comedy shows

II.

Registration No. 2914551
Issued: December 28, 2004
Class: 42

For: Computer programming services for others; rental of software and hardware for online access; data encryption services, namely, administration of digital keys and/or digital certificates; application service provider, namely, hosting computer software applications for others, hosting of digital content on the internet; hosting the websites of others on a computer server for a global computer network; computer services, namely creating indexes of information available on computer networks; consulting and design services in the field of information technology, computer programming and global communication networks; installation, maintenance and repair of computer software; technical project planning services related to telecommunications equipment; providing entertainment information and general information at the specific request and [sic] end-users by means of telephone or global communications networks

III.

Registration No. 2962135
Issued: June 14, 2005
Class: 38

For: Telecommunications and information technology services, namely electric, digital, cellular and wireless transmission of voice, data, information, images, signals and messages and transmission of voice, data, images, audio, video and information via telephone, television and global communication networks; providing telecommunications connections over a global communications network, electronic mail, voice mail and messaging services, namely, the recording and storage and subsequent transmission of voice messages by telephone; audio and video teleconferencing, rental of telecommunications equipment, namely, equipment for electronic access to global telecommunications network, equipment for transmitting, receiving, recording and monitoring voice, data, information, images, signals, messages, comprised of data and word processors, and telecommunications hardware and software including components and peripherals thereof for use in the

telecommunications industry, and rental of equipment for transmitting, receiving, recording and monitoring computer programs for use in operating and accessing telecommunications systems; audio and video broadcasting featuring entertainment in the nature of live visual and audio performances, and musical, variety, news and comedy shows; providing access to computer information networks; personal communications services; pager services; electronic mail services; transmission and broadcast of audio and video programming; providing multiple-user access to a global communication network; leasing telecommunications equipment, components, systems and supplies

After the examining attorney made the refusals to register final, this appeal followed.¹

Descriptiveness

We will start our analysis by addressing the descriptiveness refusal. A mark is merely descriptive if it immediately conveys "knowledge of a quality, feature, function, or characteristics of the goods or services." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007). *See also In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987); and *In re Quik-Print Copy Shops, Inc.*, 616 F.2d 523, 205 USPQ 505, 507 (CCPA 1980). To be "merely descriptive," a term need only describe a single significant quality or property of the goods. *Gyulay*, 3 USPQ2d at 1009 (Fed. Cir. 1987);

¹ On July 31, 2007, the board affirmed the examining attorney's refusal to register applicant's mark MOBILTICKETING under Section 2(d) and (e) for the same services. Serial No. 78431149.

Meehanite Metal Corp. v. International Nickel Co., 262 F.2d 806, 120 USPQ 293, 294 (CCPA 1959). Descriptiveness of a mark is not considered in the abstract, but in relation to the particular goods or services for which registration is sought. *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978).

The examining attorney's argument concerning the descriptiveness of the term MOBILTICKET is based on evidence from the internet and NEXIS that shows that the term "mobile ticket" and "mobile ticketing" are terms commonly used to refer to tickets that are transmitted to cell phones.

Scottish mobile marketing firm Mobiqa operated a **mobile ticketing** system for the band Grinspoon at Sydney's Metro Theatre last year. More than half the attendees at the two sold-out Australia shows opted for the **mobile ticket** instead of the paper version - 35% of whom later redeemed the **mobile ticket** for a discount off the band's CD. *Billboard*, February 25, 2006.

McCallum also said that O2 would be using **mobile ticketing** as a central plank of its plans for The O2 and the new name for the Millennium Dome, which is due to reopen in 2007 as an entertainment complex. He revealed that the operator has already sold over 5,000 **mobile tickets** for this year's Wireless festival and pointed to this as an indication of the popularity of the ticketing medium in the future. *New Media Age*, March 9, 2006.

The IT-3000 terminal shall be deployed within Deutsche Bahn to optimize the **mobile ticket** sales in the trains as well as the ticket control in the long distance and

suburban traffic and renew the previous equipment generation.

Total Telecom, March 9, 2006.

Radio ads invited listeners to text a shortcode to receive a **mobile ticket** in the form of a code. The two-for-one offer promoted the new Rita: Queen of Speed ride in May and June.

Revolution, December 2005.

By texting a number, consumers receive a **mobile ticket** in the form of a bar code, to be scanned on arrival.

ASAP, November 30, 2005.

ACS Solutions ... Details: Supply the city's transportation authority, by the end of 2008, with 1,100 automatic ticket-vending machines and 500 **mobile ticketing** devices.

TechNews, January 26, 2006.

Mobile ticketing to enable the secure download of tickets and manage them. Mobile payment to enable the secure execution of payments.

eWeek.com

Verizon is using a pre-Grammy Awards Fugees concert as a pilot program for **mobile ticketing**. The operator sent select subscribers a text message inviting them to the free concert taking place Feb. 5 in Hollywood. Those responding received a multimedia message containing a bar code that can be scanned at a special entrance to the venue in lieu of a paper ticket.

Billboard, February 11, 2006.

The ringing success of cell phones threatens to change box office sales, with companies around the world adding **mobile tickets** to their customer options.

Variety, October 4-10, 2004.

Nexus trials **mobile ticket**

Metro operator Nexus is planning to allow customers to purchase tickets using their mobile phones.

www.serco.com.

Mobile Ticket Purchases to Spur M-Commerce Growth:

The ability to purchase tickets for events using

mobile phones will help the mobile commerce (m-commerce) market grow dramatically in coming years.
<http://informationweek.mobilepipeline.com>.

About **Mobile Ticketing**

Mobile ticketing is a method of purchasing a fare to ride the aircoach, the proof of purchase being shown on your mobile telephone's display.

Please scan your mobile telephone over machine on bus or enter the code on the keypad. The machine will then print out a ticket that your need to show to the driver in order to board the bus. Keep the ticket for inspection.

www.aircoarch.ie.²

Mobile Ticketing

This new form of m-commerce service is using mobile technology and existing barcode scanning to provide mobile phone users with **mobile tickets** and therefore better serve customers' needs. **Mobile ticketing** simply makes your mobile phone the ticket.

www.gavitec.com

Mobile Ticketing

Mobile Ticketing provides a quick, easy way for event promoters to connect with their mobile audience in a secure and convenient environment. Consumers order tickets using their mobile phones and the charge appears on their credit card, debit card, or mobile phone bill. **Mobile Ticketing** is perfectly suited for a wide range of activities including cinemas, sporting events, ski resorts, and concerts.

www.moremagic.com

Mobile Ticketing

Mobile ticketing makes paper tickets superfluous. It offers entrepreneurs an additional channel for the placement of orders, payment, distribution and verification of tickets. **Mobile ticketing** by Emexus is applicable for all possible tickets, ranging from

² To the extent that some of the websites or articles are from English language, foreign sources, they may nonetheless be relevant to determine if the mark is merely descriptive. *Bayer Aktiengesellschaft*, 82 USPQ2d at 1835 ("Information originating on foreign websites or in foreign news publications that are accessible to the United States public may be relevant to discern United States consumer impression of a proposed mark").

transport tickets, entrance passes and hotel vouchers. Waiting times at ticket machines are history and queues for access control shortened because ticket verification and registration is simplified.
www.emexus.com

Solutions > **Mobile Ticketing**

... Of course, a list of fare permutations can be worked out with a small booklet, but for the average transport operator, printing a booklet for every vendor for every route would be a costly exercise. And the vendor, flicking through the booklet to find the right fares and then allocate a ticket to each passenger before they get off without paying is unlikely to happen.

Now it is clear why transport operators have chosen TouchStar's updateable, power saving, robust, portable TouchPC computers and printers to take the strain. A few passes of the touchscreen are enough to have an accurately priced ticket heading out. Throw in a credit/debit card reader and a comprehensive ticketing service can be put into action.
www.touchpc.com

A **mobile ticketing** service, TicketTXT allows moviegoers to purchase cinema tickets 24/7 using only their cellphones.

BusinessWorld, March 9, 2006.

According to Juniper research, **mobile ticketing** (used for ordering tickets for public transportation, car parking, events, etc.) and mobile retail services will assist the global mobile commerce market by generating more than \$63 billion worth of revenue by 2010.

VARBusiness, March 6, 2006.

In response to this evidence of the descriptiveness of the term Mobile Ticket, applicant argues:

The term "Mobile Ticket" seems to have gained some use as a phrase meaning an electronically transmitted "ticket" for an event such as a concert or a sporting event which is then scanned to permit an attendee to gain entrance into the event. This is distinguishable from an electronically displayed receipt. The word "ticket" does **not** describe nor is it a receipt.

Brief at unnumbered p. 4.

We begin by noting that the term "Mobile Ticket" and "Mobile Ticketing" are commonly used to describe a more recent option for event goers to order tickets by using their mobile phones. The information needed to enter the event is transmitted to the consumer's mobile phone. The consumer then displays this information in order to gain entry into the event. In effect, "mobile ticketing" or "mobile tickets" eliminate the need for a consumer to carry paper tickets because the consumer's mobile phone contains all the necessary information.

Applicant's mark is a slight misspelling of the commonly used term "Mobile Ticket." Applicant merely eliminates the "e" in mobile and the space between the words. The elimination of the space would not normally change the meaning of the term. *Abcor* (GASBADGE at least merely descriptive for "gas monitoring badges"); *Cummins Engine Co. v. Continental Motors Corp.*, 359 F.2d 892, 149 USPQ 559 (CCPA 1966) (TURBODIESEL generic for a type of engine); *In re Orleans Wines, Ltd.*, 196 USPQ 516 (TTAB 1977) (BREADSPRED descriptive for jams and jellies that would be a spread for bread); *In re Perkin-Elmer Corp.*, 174

USPQ 57 (TTAB 1972) (LASERGAGE merely descriptive for interferometers utilizing lasers).

Furthermore, the absence of the "e" in mobile is also not significant. It has long been held that such slight misspellings do not overcome evidence of descriptiveness.

The word, therefore is descriptive, not indicative of the origin or ownership of the goods; and being of that quality, we cannot admit that it loses such quality and becomes arbitrary by being misspelled. Bad orthography has not yet become so rare or so easily detected as to make a word the arbitrary sign of something else than its conventional meaning...

Standard Paint Co. v. Trinidad Asphalt Mfg. Co., 220 U.S. 446, 455 (1911). See also *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938) (NU-ENAMEL; NU held equivalent of "new"); *In re Quik-Print Copy Shops*, 616 F.2d 523, 205 USPQ 505, 507 n.9 (CCPA 1980) (QUIK-PRINT held descriptive; "There is no legally significant difference here between 'quik' and 'quick'"). Similarly here, the slight differences between Mobilticket and Mobile Ticket do not result in the marks having different meanings. MOBILTICKET will be understood by many, if not most, consumers as simply being a slight misspelling of Mobile Ticket.

Concerning applicant's argument that a "ticket" does not describe nor is it a receipt, we note that the examining attorney submitted a definition of "ticket" as "a

paper slip or card indicating that its holder has paid or is entitled to a specific service, right, or consideration." See Office Action dated July 25, 2005, attachment. A "receipt" is defined as "a written acknowledgement of having received a specified amount of money, goods, etc." *The Random House Dictionary of the English Language (unabridged)* (2d ed. 1987).³ A ticket indicates that the "holder has paid" for a specific service" while a receipt is a "written acknowledgement of having received" a specific good or service. In effect, the definitions of "ticket" and "receipt" overlap. Indeed, a phrase such as "Your ticket is your receipt" shows the relationship between the terms "ticket" and "receipt." Therefore, the fact that applicant refers to a transmission receipt rather than a ticket does not mean that the term "Mobilticket" is not merely descriptive.

Applicant's identification of services also indicates that the information is transmitted to the merchant but this appears to simply be an alternative method of delivery of information for "mobile tickets." For example, ACS Solutions supplies "the city's transportation authority, by

³ We take judicial notice of this definition. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

the end of 2008, with 1,100 automatic ticket-vending machines and 500 mobile ticketing devices." *TechNews*, January 26, 2006 (emphasis added). TouchStar, at its webpage entitled "Solutions > Mobile Ticketing" discusses "why transport operators have chosen TouchStar's updateable, power saving, robust, portable TouchPC computers and printers to take the strain. A few presses of the touchscreen are enough to have an accurately priced ticket feeding out." www.touchpc.com. The evidence suggests that there is nothing incongruous about a mobile ticketing scheme in which the merchant receives the transmission information. Therefore, this fact would not make the term MOBILTICKET, when used in association with applicant's services, suggestive.

We, therefore, affirm the examining attorney's refusal to register on the ground that applicant's mark MOBILTICKET is merely descriptive for the identified services.

Likelihood of Confusion

Next, we turn to the question of whether there is a likelihood of confusion. We consider this issue by applying the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); and *Recot*,

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Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The first factor that we will consider is whether the marks, in their entireties, are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005). Applicant's mark is MOBILTICKET and registrant's marks are MOBILETICKET. Neither mark includes a design or any stylization. Regarding the terms MOBILTICKET and MOBILETICKET, we find that they are very similar, if not almost identical. The only difference is the fact that applicant spells the term "Mobile" without the "e" at the end of the word before it is joined with the term "Ticket." Applicant's misspelling of mobile is a very minor difference. Because both marks eliminate the space between the words, many consumers are unlikely to study the mark closely enough to even notice the missing "e." Those that

do notice the difference are hardly likely to attribute much, if any, significance to its absence. We add that there "is no correct pronunciation of a trademark, and it obviously is not possible for a trademark owner to control how purchasers will vocalize its mark." *Centraz Industries Inc. v. Spartan Chemical Co.*, 77 USPQ2d 1698, 1701 (TTAB 2006). Therefore, it is unlikely that the marks would be pronounced differently by most purchasers. In this case, we agree with the district court that held that: "Most people would pronounce 'Mobil' and 'mobile' identically." *Mobil Oil Corporation v. Mobile Mechanics, Inc.*, 192 USPQ 744, 747 (D. Conn. 1976). While the marks are not identical, they nonetheless appear and sound very similar, if not almost identical.

Regarding the meanings and commercial impressions of the terms, they are virtually indistinguishable. To most consumers, their meanings would be identical, a "mobile ticket" and their commercial impressions are likewise virtually the same. When we compare the marks in their entireties, we conclude that they are at least very similar in appearance, sound, meaning, and commercial impression.

The next factor we consider is whether the goods and/or services are related. We must consider the goods as they are identified in the identifications in the

application and registrations. *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods"). Here, applicant's services involve the transmission of electronic data that is displayed on a mobile device display screen. A mobile phone with a display screen would be a mobile device that would be used in association with applicant's identified services.

Registrant's goods and services include:

Class 9 - portable computer devices, namely, laptops, handheld and pocket computers, wireless fax machines; personal communications equipment, namely, personal digital assistants; optical character readers; and optical character recognition apparatus, for use in the telecommunications field, and parts thereof; telecommunication audio, video and data communications systems, namely, digital and analogue signal transmitters; receivers and converters for use with telephone, audio, video; radio and telephone transmitters; and cellular telephones;

Class 38 - Telecommunications and information technology services, namely electric, digital, cellular and

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wireless transmission of voice, data, information, images, signals and messages and transmission of voice, data, images, audio, video and information via telephone, television and global communication networks and rental of telecommunications equipment, namely, equipment for electronic access to global telecommunications network, equipment for transmitting, receiving, recording and monitoring voice, data, information, images, signals, messages, comprised of data and word processors, and telecommunications hardware and software including components and peripherals thereof for use in the telecommunications industry; and

Class 42 - Providing entertainment information and general information at the specific request of end-users by means of telephone or global communications networks.

These goods involve devices that would be used in association with receiving electronic transmission of data so that the same consumers would be exposed to applicant's and registrant's marks on the goods and services. These consumers are likely to assume that there is a relationship between these goods and services. In addition, the examining attorney submitted copies of registrations to show that the same entity is the source of goods such as telephones and wireless communications services. See,

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e.g., Registration No. 3066575 (cellular telephones and wireless telecommunications services for voice and data cellular services); No. 2958412 (cellular telephones, mobile data receivers and transmitters and handheld units for the wireless receipt of voice and data and telecommunications services); No. 3060968 (telephones and transmission of audio and video via electronic communications networks); and No. 3030154 (electronic components designed for transmission of medical data via wireless and Internet and transmitting medical telemetry information via wireless and Internet). Also, applicant's services are related to registrant's services of providing entertainment and general information at the specific request of end-users by means of telephone or global communications networks inasmuch as both identifications encompass services that facilitate transactions in the entertainment industry. For example, registrant's services involve transmission of entertainment information by telephone, which could include providing information about the same events that applicant's services are transmitting receipts. Registrant's telecommunications services that involve the wireless transmission of data and information would overlap with applicant's electronic transmission of data that is displayed on a mobile display screen.

[It] has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services.

In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

See also Time Warner Entertainment Co. v. Jones, 65 USPQ2d 1650, 1661 (TTAB 2002).

Applicant also argues that: "It is of criticality that the cited registrations are based upon CTM applications and registrations... This, in essence, precludes adoption and utilization of marks, in the United States, by other applicants where they offer services or goods which are clearly distinguishable from the actual goods or services provided by the CTM-based registrant." Brief at unnumbered p. 6. Applicant goes on to argue that:

Adding to the perplexity of the instant situation is that the apparent licensee of the cited marks is T-Mobile USA, a United States entity. As such, the registrations hardly deserve the extra protection afforded the preclusive effect of Deutsche Telecom's [sic] CTM-based trademark registrations should not apply herein, rather, because of the US affiliate being the actual user of the marks, such registrations should be restricted to actual use, as required of other US-based businesses.

Brief at unnumbered pp. 6-7.

In response to applicant's argument that registrant's marks should be limited to actual use, the Court of Appeals for the Federal Circuit has made it clear that we must consider the goods or services as they are described in the identification of goods and services and that it is not proper to attack a registration in an ex parte proceeding by claiming that the mark has not been used on all the goods or services.

Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a prima facie presumption of validity may be rebutted. See *Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present ex parte proceeding is not the proper forum for such a challenge. *Id.* ("One seeking cancellation must rebut [the prima facie] presumption by a preponderance of the evidence."); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); TMEP Section 1207.01(c)(v) (1993); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* Section 23.24[1] [c] (3d ed. 1996). In fact, *Cosmetically Yours* held that "it is not open to an applicant to prove abandonment of [a] registered mark" in an ex parte registration proceeding; thus, the "appellant's argument ... that [a registrant] no longer uses the registered mark ... must be disregarded." 424 F.2d at 1387, 165 USPQ at 517; cf. *In re Calgon Corp.*, 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971) (applicant's argument that its use antedated a registered mark was effectively an improper collateral attack on the validity of the registration, which should have been made in formal cancellation proceedings).

Dixie claims that it is not arguing that the DELTA mark has been abandoned, only that it has not been used for restaurant services, so there is

no likelihood of confusion. However, unless it establishes abandonment, the registration is valid, and we must give effect to its identification of services. *Cosmetically Yours*, 424 F.2d at 1387, 165 USPQ at 517 ("As long as the registration relied upon ... remains uncanceled, it is treated as valid and entitled to the statutory presumptions.").

In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997).

Therefore, we will not limit our consideration of the cited registrations to the areas of registrant's actual use even if there were conclusive evidence of the actual extent of registrant's use.⁴ Furthermore, even if registrant had licensed its registrations to a United States entity, this would not change the case law that requires the board to consider the goods as they are set out in the identification of goods. Applicant's cited case, *Karsten Mfg. Co. v. Editoy AG*, 79 USPQ2d 1783 (TTAB 2006), held that an application claiming Section 44(d) and (e) filing bases was not invalid even if it was assigned to a United States entity, provided the application was subsequently amended to substitute a Section 1 basis. It does not support applicant's argument that we should limit our consideration of the identification of goods to the goods

⁴ Inasmuch as this is an ex parte proceeding where the registrant does not participate, it is not even clear how we would could accurately determine the "actual use" of a entity who is not able to present evidence of its own use.

actually used. As we indicated in the footnote, this would be inappropriate in an ex parte proceeding.

When we consider the relevant *du Pont* factors, including the fact that the marks are similar and the goods and services are related, we conclude that there is a likelihood of confusion in this case.

We add that even if the cited mark is weak, "weak marks are entitled to protection against registration of similar marks, especially identical ones, for related goods and services." *In re Colonial Stores*, 216 USPQ 793, 795 (TTAB 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).

Decision: The refusals to register the mark MOBILTICKET on the grounds of mere descriptiveness and likelihood of confusion are affirmed.