

**THIS OPINION IS NOT A
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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re World Internet Inc.

Serial No. 78555483

D. Robert Silber of D. Robert Silber, P.A. for World
Internet Inc.

Evelyn Bradley, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Bucher, Grendel and Taylor, Administrative Trademark
Judges.

Opinion by Bucher, Administrative Trademark Judge:

World Internet Inc. seeks registration on the Principal
Register of the mark **WORLD INTERNET SUMMIT** (*in standard
character format*) for services recited in the application, as
amended, as follows:

"educational services, namely, conducting
seminars in the field of Internet marketing"
in International Class 41.¹

This case is now before the Board on appeal from the
final refusals of the Trademark Examining Attorney to

¹ Application Serial No. 78555483 was filed on January 27, 2005 based upon applicant's allegation of first use anywhere at least as early as December 1, 2002 and use in commerce at least as early as May 2, 2003. No claim is made to the word "Summit" apart from the mark as shown.

register this designation based upon Sections 2(d) and 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(d) and § 1052(e)(1).

The Trademark Examining Attorney asserts that applicant's mark, when used in connection with the recited services, so resembles the marks in the following three registrations owned by the same party as to be likely to cause confusion, to cause mistake or to deceive:

INTERNET SUMMIT	for "arranging trade show exhibitions, expositions and conferences in the field of on-line information service" in International Class 35; ²
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INTERNET WEB SUMMIT	for "arranging and conducting trade show exhibitions, expositions and conferences in the field of on-line information services" in International Class 35; ³ and
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GLOBAL INTERNET SUMMIT	for "arranging and conducting trade shows, exhibitions, expositions and conferences in the field of information technology" in International Class 35; and "providing a website on a global computer network featuring information related to the field of information technology" in International Class 42. ⁴
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² Registration No. 2373085 issued to International Data Group, Inc. on August 1, 2000 based upon an application filed on April 26, 1995 claiming first use anywhere and first use in commerce at least as early as April 28, 1999; Section 8 affidavit (six-year) accepted. No claim is made to the word "Internet" apart from the mark as shown.

³ Registration No. 2475979 issued to International Data Group, Inc. on August 7, 2001 based upon an application filed on April 26, 1995 claiming first use anywhere and first use in commerce at least as early as January 26, 2001. No claim is made to the term "Internet Web" apart from the mark as shown.

⁴ Registration No. 2508817 issued to Standard Media International on November 20, 2001 based upon an application filed on January 7, 2000 based upon claims of first use anywhere and

The Trademark Examining Attorney also asserts that applicant's mark is merely descriptive when considered in relation to applicant's recited services, i.e., that the term "World Internet Summit" immediately informs potential purchasers about the nature of applicant's services.

Applicant and the Trademark Examining Attorney submitted briefs.

Preliminary matters

We note that much of the material attached to applicant's appeal brief appears to have been submitted into the record for the first time with the brief. The Trademark Examining Attorney correctly objected to the tardy submission of these materials inasmuch as the record in an application must be complete prior to appeal. 37 C.F.R. § 2.142(d); TBMP §§ 1207.01 *et seq.* See Rexall Drug Co. v. Manhattan Drug Co., 284 F.2d 391, 128 USPQ 114 (CCPA 1960); and In re Psygnosis Ltd., 51 USPQ2d 1594 (TTAB 1999). Accordingly, we have not considered these materials.⁵

first use in commerce in both classes at least as early as October 1999. No claim is made to the term "Global Internet" apart from the mark as shown. This registration has since been assigned to International Data Group, Inc.

⁵ We hasten to add that even if we had considered the contents of this website, it would not have changed the result herein.

Likelihood of Confusion

We turn first to the issue of likelihood of confusion. Applicant contends that the cited service marks "are weak marks." (Applicant's appeal brief, p. 3), that the respective services are quite different, as are the customers and channels of trade (*Id.* p. 5), that given the level of applicant's fees for its services, they will be purchased with the requisite "amount of care and thought" by sophisticated purchasers (*Id.* p. 6), and that its mark is well-known but that there have been no incidents of actual confusion during an extensive period of contemporaneous use of the marks (*Id.* p. 7).

By contrast, the Trademark Examining Attorney contends that the respective marks project substantially similar connotations and convey the same commercial impressions, and that the services are related.

Our determination of likelihood of confusion is based upon our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive,

considerations are the similarities between the marks and the similarities between the goods and/or services. See Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The services

Although the three cited registrations contain slightly different recitals in International Class 35, they are essentially the same - arranging (and conducting) trade show exhibitions, expositions and conferences in the field of online information services (or in the field of IT), and one registration that includes providing an Internet website featuring information related to the field of IT. Applicant's recitation focuses on educational services, specifically conducting seminars on Internet marketing.

In its appeal brief, applicant cites to In re Trackmobile Inc., 15 USPQ2d 1152 (TTAB 1990),⁶ arguing that in the current case, it has shown by a submission of

⁶ In Trackmobile, a Section 2(d) refusal had been issued based on a registration in which the goods were identified as "light railway motor tractors." The applicant, in attempting to overcome the Section 2(d) refusal by demonstrating that its goods were unrelated to the goods identified in the cited registration, offered extrinsic evidence as to the nature of the registrant's goods - evidence that the Board considered.

extrinsic evidence that the recited services are quite different. (Applicant's appeal brief, p. 5).

However, the Board considered the applicant's extrinsic evidence regarding the registrant's goods in Trackmobile because the Board was uncertain as to what the goods identified in the registration entailed. That is, the Board did not consider the extrinsic evidence in order to determine the exact nature of the registrant's particular "light railway motor tractors." Rather, given that this term was subject to very different alternative meanings, the Board considered the extrinsic evidence to determine generally what type of vehicles "light railway motor tractors" comprised.

In the present case, by contrast, no extrinsic evidence is necessary in order to educate the Board as to what, for example, is meant by the expression arranging conferences in the IT field. The cited recitations are neither vague nor uncertain. Accordingly, applicant's reliance on Trackmobile is misplaced, and applicant's proffered extrinsic evidence regarding the nature and scope of the services actually provided by the registrant is not probative of a different result herein.

We can assume from these recitations that registrant is involved in an array of services, such as:

- arranging conferences and events (e.g., trade shows, exhibitions and expositions) focused on the Internet, e-business and IT;
- exploring new e-business models, opportunities in the digital marketplace, and lead generation initiatives for entrepreneurs;
- offering expertise on technology and industry opportunities and trends internationally, changing patterns of profitability, and specific national IT trends;
- providing web services and subscription research services; and
- consulting with investors about technology purchases and helping clients with business strategies, including sales and marketing.

Similarly, from the web pages that applicant has placed into the record, it is clear that applicant arranges for large public seminars touting the secrets of how to get-rich-quick using the Internet. The training involves advice on affiliate marketing, how to become involved in promoting digital products, and other Internet marketing ideas targeted to entrepreneurs.

While it does not seem that applicant has become a competitor to registrant, there are certainly similarities

in the services they offer. Educational seminars are not that dissimilar from conferences. The field of Internet marketing is a subset of the larger fields of online information services and IT. Registrant's recitation of services includes its providing web services, something touted in applicant's online ads. Accordingly, on this record, we find that applicant's services are related to registrant's recited services.

Channels of Trade

As to a related du Pont factor, applicant argues that " ... there is little, or no, overlap between applicant's and registrant's ... customers, or channels of trade as identified in the application." However, we agree with the Trademark Examining Attorney that the cited registrations describe the services broadly without limitations as to their nature, type, channels of trade or classes of purchasers. Hence, it is presumed that the registrations encompass all services of the type described, that they move in all normal channels of trade, and that they are available to all potential customers. In re Linkvest S.A., 24 USPQ2d 1716 (TTAB 1992); and In re Elbaum, 211 USPQ 639 (TTAB 1981).

On the face of the registrations and the application, entrepreneurs who are interested in how web technologies can

be used to transform business models would comprise a receptive audience to these respective service offerings of applicant and of registrant. The potential customers would likely be able to discover through online information the availability of these seminars or conferences, and would probably attend the advertised public event in a venue such as large hotel ballrooms or an urban convention center. Given this presumed overlap between applicant's and registrant's potential customers and channels of trade, this du Pont factor also favors the position of the Trademark Examining Attorney.

Similarity of the marks

Applicant does not focus on the similarity of the marks, preferring instead to emphasize the alleged weakness of the cited marks. However, as noted above, applicant seeks to register the mark WORLD INTERNET SUMMIT, while the marks in the cited registrations are INTERNET SUMMIT, INTERNET WEB SUMMIT and GLOBAL INTERNET SUMMIT.

All these standard form marks involve the words "Internet" and "Summit" in this exact order. "World" and "Global" have similar connotations, and in this context, the word "Web" also carries with it an implication of the "worldwide web." Accordingly, in addition to the obvious

similarities in sound and appearance, we find that applicant's mark projects substantially the same connotation and creates a most similar commercial impression to registrant's three cited marks.

The number and nature of similar marks registered for similar services

Applicant argues that we should accord the cited registrations a narrow scope of protection in light of widespread online usage of the shared terms drawn from the cited registrations:

The Applicant's and registrant's use of the marks in commerce tend to show that the marks would be perceived differently by the relevant public. Indeed, a Google Internet search returns 37,600 pages of the Applicant's "World Internet Summit" mark in use (Exhibit A) while a search of "Global Internet Summit" returns 16,200 pages (Exhibit B) and "Internet Web Summit" returns 2 (Exhibit C).

Applicant argues that as a result, potential purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of services in this field. We disagree.

Without more context, the relative number of Internet search engine hits for "World Internet Summit" and "Global Internet Summit" that applicant has provided for the record seems indeterminative on the question of whether or not potential purchasers have been conditioned to look to the

other elements of the marks (e.g., "Global" or "World") in order to distinguish the source of services in this field. Additionally, the frequency of use on the Internet of each of these three-word expressions would likely pale by comparison with the occurrences of the two-word term comprising another of registrant's cited mark, INTERNET SUMMIT, which applicant has adopted in its entirety. Applicant cannot collaterally attack the validity of this incontestable registration. And of course, as noted by the Trademark Examining Attorney, even allegedly weak marks are entitled to protection against registration by a subsequent user of a similar mark for closely related services. See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976).

Conditions under which, and buyers to whom, sales are made

Applicant argues that inasmuch as its fees for its services are \$ 997.⁰⁰, such a purchaser parts with his money with the requisite "amount of care and thought." However, even at this price, we cannot be sure that all the potential purchasers are sophisticated and careful. Moreover, applicant has submitted web advertisements offering a webcast of its Internet marketing seminar for "a mere \$ 27." Hence, based on this record, we cannot conclude that

applicant's consumers will be any more sophisticated or careful than the ordinary purchaser of consumer goods and services.

Period of contemporaneous use without actual confusion

As to the du Pont factor dealing with the length of time during and conditions under which there has been concurrent use without evidence of actual confusion, applicant argues that coexistence over a period of several years provides strong evidence that confusion is not likely to occur in the future. As to whether there has been sufficient opportunity for confusion to occur, the record contains no indication of the level of sales or advertising by applicant. The absence of any instances of actual confusion is a meaningful factor only where the record indicates that, for a significant period of time, an applicant's sales and advertising activities have been so appreciable and continuous that, if confusion were likely to happen, any actual incidents thereof would be expected to have occurred and would have come to the attention of one or both of these trademark owners. Similarly, we have no information concerning the nature and extent of registrant's use, and thus we cannot tell whether there has been sufficient opportunity for confusion to occur, as we have

not heard from the registrant on this point. All of these factors materially reduce the probative value of applicant's argument regarding asserted lack of actual confusion.

Therefore, applicant's claim that no instances of actual confusion have been brought to applicant's attention is not indicative of an absence of a likelihood of confusion. See Gillette Canada Inc. v. Ranir Corp., 23 USPQ2d 1768, 1774 (TTAB 1992). In any event, we are mindful of the fact that the test under Section 2(d) of the Act is likelihood of confusion, not actual confusion.

Conclusion: Likelihood of Confusion

The respective services involved herein are related, and they will likely be promoted and offered to ordinary consumers through similar channels of trade. Furthermore, when applicant's mark is compared in its entirety with registrant's three cited marks, we find similarities in sound, appearance, connotation and commercial impression.

Descriptiveness

A mark is merely descriptive, and therefore unregistrable pursuant to the provisions of Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), if it immediately conveys information of a significant ingredient, quality, characteristic, feature, function, purpose or use

of the goods or services with which it is used or is intended to be used. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978) [GASBADGE merely descriptive of a "gas monitoring badge"]. See also In re MBNA America Bank N.A., 340 F.3d 1328, 67 USPQ2d 1778, 1780 (Fed. Cir. 2003) [MONTANA SERIES and PHILADELPHIA CARD merely descriptive of "credit card services." The Court found that a "mark is merely descriptive if the ultimate consumers immediately associate it with a quality or characteristic of the product or service."]. Hence, the ultimate question before us is whether the term WORLD INTERNET SUMMIT conveys information about a significant feature or characteristic of applicant's services with the immediacy and particularity required by the Trademark Act.

A mark is suggestive, and therefore registrable on the Principal Register without a showing of acquired distinctiveness, if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987) [APPLE PIE merely descriptive of potpourri mixture: "Whether a given mark is suggestive or merely descriptive depends on whether the mark 'immediately conveys ... knowledge of the ingredients, qualities, or characteristics of the goods ... with which it is used,' or whether 'imagination,

thought, or perception is required to reach a conclusion on the nature of the goods.'" (citation omitted)].

The question of whether a particular term is merely descriptive is not decided in the abstract. That is, when we analyze the evidence of record, we must keep in mind that the test is not whether prospective purchasers can guess what applicant's goods are after seeing applicant's mark alone. *In re Abcor, supra* at 218 ["Appellant's abstract test is deficient - not only in denying consideration of evidence of the advertising materials directed to its goods, but in failing to require consideration of its mark 'when applied to the goods' as required by statute"]; *In re Home Builders Association of Greenville*, 18 USPQ2d 1313 (TTAB 1990) [NEW HOME BUYER'S GUIDE merely descriptive of "real estate advertisement services"]; and *In re American Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985) [APRICOT is merely descriptive of apricot-scented dolls]. Rather, the proper test in determining whether a term is merely descriptive is to consider the applied-for mark in relation to the goods or services for which registration is sought, the context in which the mark is used, and the significance that the mark is likely to have on the average purchaser



encountering the goods or services in the marketplace. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987) [the term "first tier" describes a class of banks]; In re Intelligent Instrumentation Inc., 40 USPQ2d 1792 (TTAB 1996) [the term VISUAL DESIGNER is merely descriptive of "computer programs for controlling the acquisition of data from measurement devices"]; In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991) [MULTI-VIS is merely descriptive of "multiple viscosity motor oil"]; In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986) [DESIGN GRAPHIX merely descriptive of computer graphics programs]; and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979) [COASTER-CARDS merely descriptive of a coaster suitable for direct mailing].



Applicant argues that its mark is suggestive inasmuch as the "dictionary definition of 'world' shows 15 entries and 'summit' 9 entries." According to applicant, the many permutations of these multiple definitions support a conclusion that prospective consumers will need to use "imagination or forethought" in order to reach a conclusion as to the nature of the involved services.

By contrast, the Trademark Examining Attorney argues that applicant has combined three descriptive terms in such

a way that within the resulting combination, each component retains its descriptive significance in relation to the recited services, and hence, the combination results in a composite that is itself descriptive. In re Sun Microsystems Inc., 59 USPQ2d 1084 (TTAB 2001).

Specifically, the word "world" means, "involving or extending throughout the entire world." Applicant's evidence demonstrates that in addition to seminars in the United States, applicant offers its services in places like Australia, Malaysia and Singapore. Applicant conducts worldwide summits or seminars in the field of Internet marketing. In short, applicant has no *raison d'être* without the "Internet." The Trademark Examining Attorney has shown that the term "summit," as defined in dictionaries and as used in the business, is synonymous with the term "seminar." Additionally, applicant has submitted a disclaimer of the term "summit" in this application.

Based on this record, we find that each of the terms "World," "Internet" and "Summit" is descriptive when applied to applicant's Internet marketing seminars. We also find that these individual words do not somehow lose this descriptiveness in the combination "World Internet Summit." While a combination of words may be registrable if it creates a unitary mark with a unique, nondescriptive or

incongruous meaning, in this case each component of applicant's mark **WORLD INTERNET SUMMIT** retains its descriptive significance when used in the combination, and the combination as a whole is also merely descriptive of applicant's services. When applied to Internet marketing seminars held in the United States, Asia and Australia, there is nothing which would require the exercise of imagination, cogitation or mental processing or necessitate the gathering of further information in order for the merely descriptive significance of the term to be readily apparent to consumers of applicant's services.

Accordingly, we find that the term **WORLD INTERNET SUMMIT**, when used in connection with seminars in the field of Internet marketing, would be merely descriptive of the nature of the services, as contemplated under Section 2(e)(1) of the Act.

Decision: The refusal to register this mark under Section 2(d) of the Act is hereby affirmed, as is the refusal to register this mark under Section 2(e)(1) of the Act.