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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Son Tours, Inc.

Serial No. 78557069

Lawrence P. Colton of Powell Goldstein LLP for Son Tours,
Inc.

Michelle E. Dubois, Trademark Examining Attorney, Law
Office 107 (J. Leslie Bishop, Managing Attorney).

Before Hohein, Grendel and Mermelstein, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Applicant seeks registration on the Principal Register
of the mark **SON TOURS** (in standard character form) for
services recited in the application, as amended, as
"organizing, booking and arranging educational multi-night
field trips for students," in Class 39.¹ Applicant has

¹ Serial No. 78557069, filed on January 31, 2005. The
application is based on use in commerce under Trademark Act

disclaimed the exclusive right to use TOURS apart from the mark as shown.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark on the ground that, as used in connection with the services recited in the application, applicant's mark SON TOURS so resembles the mark **SUNTOURS**, previously registered on the Principal Register (in standard character form) for Class 39 services recited in the registration as "operation of a travel agency, tour agency, travel bureau, and booking office,"² as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d).

The appeal is fully briefed. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

Initially, two evidentiary issues require discussion. First, we note that with its response to the Trademark Examining Attorney's first Office action, applicant

Section 1(a), 15 U.S.C. §1051(a). March 1, 1996 is alleged in the application to be the date of first use of the mark anywhere and the date of first use of the mark in commerce.

² Registration No. 0961781, issued on June 19, 1973. Affidavits under Sections 8 and 15 accepted and acknowledged, respectively. The registration has been renewed twice. The registration identifies October 1966 as the date of first use of the mark anywhere and the date of first use of the mark in commerce.

submitted a listing from the Office's TESS database of third-party registrations and applications in which the word "travel" appeared in the identification of goods and/or services and in which the marks included the word SUN and/or the word TOURS. These listings were submitted in support of applicant's argument that, under the sixth *du Pont* likelihood of confusion factor, the cited registered mark SUNTOURS was a weak mark in the travel field. (See discussion *infra*.) In her final Office action, the Trademark Examining Attorney informed applicant that the TESS listing "is not competent evidence" because the listing did not include the identifications of goods and/or services covered by the listed registrations and applications. However, the Trademark Examining Attorney did not specifically advise applicant that a mere listing of third-party registrations was insufficient to make the registrations of record, and that complete printouts of the registrations were required.

Because the Trademark Examining Attorney did not specifically advise applicant that the mere listing of third-party registrations was insufficient to make the registrations of record, we deem the TESS listing of third-party registrations submitted by applicant with its response to the first Office action to be evidence of

record in this appeal, for whatever probative value it may have. See, e.g., *In re Hayes*, 62 USPQ2d 1443, 1445 n.3 (TTAB 2002); *In re Broyhill Furniture Industries Inc.*, 60 USPQ2d 1511, 1513 n.3 (TTAB 2001); TBMP Section 1208.02.

Second, for the first time with its appeal brief, applicant submitted printouts of six third-party registrations which had been included in the TESS listing previously made of record by applicant.³ In her appeal brief, the Trademark Examining Attorney has objected to this evidence on the ground that it is untimely under Trademark Rule 2.142(d). In its reply brief, applicant contends that the Trademark Examining Attorney has waived any objection to this evidence because she had not specifically objected, prior to her appeal brief, to the TESS listing in which the six registrations were included, and the printouts submitted with applicant's brief were merely more complete versions of the registrations identified in the TESS listing. Applicant also notes that it had specifically discussed two of these third-party registrations in the text of its response to the first

³ Applicant submitted printouts of two additional third-party registrations with its appeal brief. However, in its reply brief, applicant has withdrawn its reliance on those two registrations because they were not included in the previously-submitted TESS listing of third-party registrations.

Office action, without subsequent comment or objection by the Trademark Examining Attorney.

Trademark Rule 2.142(d), 37 C.F.R. §2.142(d), provides in pertinent part that "[t]he record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed." In this case, we find that the third-party registration evidence attached to applicant's appeal brief is untimely and can be given no consideration. The mere fact that some of the registrations appeared in the TESS listing previously submitted by applicant, or were mentioned by applicant in its previous responses (in passing, and without supporting exhibits), does not entitle applicant to supplement the record by submitting complete copies of the registrations for the first time with its appeal brief. Such supplementation of the record should have been made prior to appeal. For these reasons, we shall not consider the untimely evidence submitted by applicant for the first time with its appeal brief.⁴

⁴ We hasten to add that even if this evidence had been considered, it would not have changed the result in this case. See discussion *infra*.

We turn now to the merits of the Section 2(d) ground of refusal at issue in this appeal.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

The first *du Pont* factor requires us to determine the similarity or dissimilarity of the marks when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. *Palm Bay Imports, Inc., supra*. The test, under the first *du Pont* factor, is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser,

who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004); *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Finally, in cases such as this, where the applicant's services are legally identical to the the services in the cited registration (see discussion *infra*), the degree of similarity between the marks which is required to support a finding of likelihood of confusion is less than it would be if the services were not identical. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

Applying these principles in the present case, we find as follows. In terms of appearance, applicant's mark and the cited registered mark are not identical, in that (a) applicant's mark is depicted as two words, while the registered mark is depicted as one word, and (b) the second

letter of applicant's mark is "O" while the second letter of the registered mark is "U". However, we find that these points of dissimilarity are outweighed by the fact that, except for the second letter, all of the other letters in the marks look and are the same, and appear in the same order. On balance, we find that the marks are similar in terms of appearance.

In terms of sound, we find that the marks are identical.

In terms of connotation, we find that the marks are similar to the extent that both incorporate the generic word TOURS, but that they are dissimilar due to the different meanings of SON and SUN in the respective marks. SON in applicant's mark connotes a male child, while SUN in the registered mark connotes our solar system's star. To that extent, the marks connote different things. However, we are not persuaded by applicant's further argument that the word SON in its mark

possesses additional meaning within the Christian religion and this trademark application wherein "Son" references the male child of God in the Holy Trinity. Applicant has chosen the word "Son" to evoke readily this connotation when consumers consider Applicant's services. Specifically, the suggestion of Christian services further suggests Christian worship and fellowship.

(Reply brief at 3.) As discussed below, nothing in applicant's recitation of services limits applicant's services to services which are provided only to Christian persons or groups who would understand applicant's mark to refer to the "Son of God." (We note as well that the printout of applicant's website submitted with the application as applicant's specimen of use makes no reference to or claim that the services are primarily or solely directed to Christians.) Thus, the services must be presumed include those to be marketed and rendered to secular purchasers. These purchasers reasonably could be expected to understand the word SON in applicant's mark to have its more obvious meaning as "male child," either as a reference to "sons" in general or perhaps as a reference to the son of applicant's owner or principal. In short, although we are not persuaded by applicant's argument that the marks have different connotations because applicant's mark has a religious connotation that the registered mark does not, we still find that the marks are dissimilar in connotation because of the different meanings of SON and SUN.

In terms of overall commercial impression, we find that SON TOURS and SUNTOURS are somewhat dissimilar to the extent that the registered mark creates an impression of

"travel in a sunny climate," while applicant's mark SON TOURS does not, due to the "male child" meaning of SON.

Considering the marks in their entireties in terms of appearance, sound, connotation and overall commercial impression, we find that the marks are similar rather than dissimilar. Although the marks have somewhat dissimilar connotations and resulting commercial impressions, they are highly similar in terms of appearance and they are identical in terms of sound. It is settled that similarity in sound alone may be sufficient to support a finding that the marks are similar and that confusion is likely. See *Krim-Ko Corp. v. The Coca-Cola Company*, 390 F.2d 728, 156 USPQ 523 (CCPA 1968). This is especially true in this case, where the application and registration are for services which may be referred to or recommended by word of mouth. See *Miles Laboratories, Inc. v. Whorton Pharmacal Co.*, 199 USPQ 758 (TTAB 1978). On balance, we find that the marks are similar, especially given the legally identical services involved herein and the resulting diminished degree of similarity between the marks which is necessary to support a finding of likelihood of confusion. The first *du Pont* factor weighs in favor of a finding of likelihood of confusion.

The second *du Pont* factor requires us to determine the similarity or dissimilarity of the services as recited in the application and in the cited registration. It is settled that it is not necessary that the respective services be identical or even competitive in order to support a finding of likelihood of confusion. That is, the issue is not whether consumers would confuse the services themselves, but rather whether they would be confused as to the source of the services. See *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984). It is sufficient, instead, that the services be related in some manner, or that the circumstances surrounding their use be such that they would be likely to be encountered by the same persons in situations that would 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 source or that there is an association or connection between the sources of the respective services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

Applicant's services as recited in the application are "organizing, booking and arranging educational multi-night

field trips for students." The services recited in the cited registration are "operation of a travel agency, tour agency, travel bureau, and booking office."

We find that the "tour agency" services recited in the cited registration are the same as, or encompass, applicant's "organizing, booking and arranging educational multi-night field trips for students." Applicant's "educational multi-night field trips" are, essentially, travel tours, and applicant, essentially, is a tour operator. This is apparent from applicant's name and mark, and from applicant's website (submitted as the specimen accompanying the application), where applicant repeatedly refers to its services as "tour" services. For example: "SON TOURS is one of the finest Educational Tour Operators you will find"; "One of our expert tour representatives will develop a tour plan based on your needs for a successful school trip"; "Our tours focus on education and experience"; and "In addition to accompanying the tour free of charge, teachers will receive a stipend..."

We also find that the "booking office" services recited in the cited registration are identical to, or encompass, the "booking" element of applicant's services.

We also find that applicant's services are related to and encompassed by the "travel agency" services recited in

the cited registration. The Trademark Examining Attorney has made of record eight use-based third-party registrations in which the recitations of services include both applicant's and registrant's types of services.⁵ Although such registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nonetheless have probative value to the extent that they serve to suggest that the services listed therein are of a kind which may emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

⁵ For example: Reg. No. 2124185 includes "travel agency services, namely, assisting in planning and arranging travel, trips, tours, vacations, and sports adventures..."; Reg. No. 2256536 includes "travel agency services, namely, arranging, organizing, and conducting travel tours and trips..."; Reg. No. 2643884 includes "travel services, namely, arranging tours...; making reservations and bookings for transportation; arranging educational trips for youths and trips for clubs and organizations"; Reg. No. 2658145 includes "organizing and arranging vacation trips, travel, tours and sightseeing, namely organizing and arranging custom and packaged vacation trips, travel tours and sightseeing tours; wholesale and retail travel agency services, namely making reservations and bookings for air, ground and sea transportation services"; and Reg. No. 2915776, which includes "travel agency services, namely making reservations and bookings for temporary accommodations; travel agency services, namely making reservations and bookings for transportation; arranging travel tours; tour operator services, namely, tour guide services, conducting sightseeing tours for others; tour planning services for others; organizing and conducting group trips and tours for others of a cultural, religious or spiritual nature."

Also of record is a Wikipedia entry for "travel agency" which states, inter alia, that "many [travel agencies] concentrate on arranging charter or group trips to different destinations." Additionally, a printout from the website www.travelcraftusa.com informs purchasers that "We are a full service travel agency specializing in student travel, group tours and educational trips of all kinds..."

Based on this evidence, we find that applicant's services are highly similar, and indeed legally identical, to the services recited in the cited registration. The second *du Pont* factor accordingly weighs heavily in favor of a finding of likelihood of confusion.

The third *du Pont* factor requires us to determine the similarity or dissimilarity of the trade channels in which the services (as recited in the application and in the cited registration) are marketed. Applicant's recitation of services might be read as limiting applicant's trade channels to the educational travel market. However, because the recitation of services in the cited registration includes no limitations as to trade channels, we must presume that they are offered in all normal trade channels in which the recited services might move. *In re Elbaum*, 211 USPQ 639 (TTAB 1981). Even assuming that the

educational travel market constitutes its own category within the travel industry, we find that it is among the normal trade channels in which the travel and tour agency services recited in the cited registration would be marketed. Additionally, applicant's argument that its trade channels and purchasers are further or more specifically limited to a Christian tour group "niche" is unavailing, because no such limitation appears in applicant's recitation of services. In any event, even if such a niche exists and applicant's services fall within it, that niche still would be encompassed within the broad recitation of travel-related services recited in the cited registration. For these reasons, we find that the third *du Pont* factor weighs in favor of a finding of likelihood of confusion.

Under the fourth *du Pont* factor, which requires us to consider the conditions of purchase, we find that the purchasers of the services at issue in this case likely would include individuals making travel arrangements, as well as organizations seeking the services of an operator of group tours. There is no evidence which would suggest that these purchasers are likely to exercise more than an ordinary degree of care when seeking out and/or purchasing travel services. Even assuming that travel tours might in

some cases be somewhat expensive, we cannot conclude that they would always be so, or that the services necessarily are so expensive that a heightened degree of care would be involved in their purchase. To the extent that the fourth *du Pont* factor might be deemed to weigh in applicant's favor in our likelihood of confusion analysis, we find that it does so only slightly.

The sixth *du Pont* factor requires us to consider the number and nature of similar marks in use on similar services. Applicant, relying on a TESS listing of third-party registrations and applications, argues that there are numerous third-party uses of SUN and of TOURS for travel-related services.⁶ However, we find that this TESS listing is of limited or no probative value. First, the list does not include the particular goods and/or services covered by each application or registration. Second, the expired or cancelled registrations and the abandoned applications included on the list have no probative value. Likewise, the pending applications included on the list are evidence only of the fact that the applications were filed. *In re Phillips-Van Heusen Corp.*, 63 USPQ2d 1047 (TTAB 2002); *In*

⁶ As discussed, the third-party registration evidence submitted by applicant for the first time with its appeal brief is untimely and has been given no consideration, and would not have affected the outcome in this case in any event.

re *Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992). Next, we note that the list's probative value is de minimis because it includes only one existing registration of a mark which includes both SUN and TOURS (Reg. No. 1124343, of the mark SUN-PLEASURE TOURS). Finally, even if we were to deem the listed registrations themselves to be properly of record, it is settled that third-party registrations are not evidence of third-party use, for purposes of the sixth *du Pont* factor. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).⁷

For these reasons, we find that the sixth *du Pont* factor does not weigh in applicant's favor in this case; at best it is neutral in our analysis.

Applicant contends, under the seventh *du Pont* factor, that it is unaware of any instances of actual confusion between applicant's mark and the cited registered mark despite ten years of contemporaneous use. However, we note that there is no evidence, under the eighth *du Pont* factor, that there has been a significant opportunity, such as

⁷ Applicant does not argue that these third-party registrations are probative as evidence (similar to dictionary evidence) of the meaning of the words SUN and TOURS. However, we find that the evidence, even if it is deemed to be probative on that question, is unnecessary given the undisputed and well-known meanings of the words themselves.

geographic overlap, for actual confusion to have occurred. Moreover, we have not heard from registrant on the question. In any event, it is settled that the absence of actual confusion is of little probative value in an ex parte case such as this. *In re Majestic Distilling Co.*, *supra*.

Having considered all of the evidence of record as it pertains to the du Pont factors, and for the reasons discussed above, we find that a likelihood of confusion exists. We have considered applicant's arguments to the contrary, but we are not persuaded. To the extent that any doubts might exist as to the correctness of our conclusion that confusion is likely, we resolve such doubts against applicant. See *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687 (Fed. Cir. 1993); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *In re Martin's Famous Pastry Shoppe, Inc.*, *supra*.

Decision: The refusal to register is affirmed.