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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re OTS Logistics Group Ltd.

Serial No. 78624296

Mark J. Shean of Orrick, Herrington & Sutcliffe for OTS  
Logistics Group Ltd.

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

Before Quinn, Walters and Mermelstein, Administrative  
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

OTS Logistics Group Ltd. filed an application to  
register the mark OTS LOGISTICS GROUP ("LOGISTICS GROUP"  
disclaimed) for

information management services,  
namely, shipment processing, preparing  
shipping documents and invoices,  
namely, preparing and issuing export  
declarations, bills of lading, and  
other export documentation; arranging  
for pickup, delivery, storage and  
transportation of documents, packages,  
freight and parcels via ground, vessel  
and air; [and] transportation logistics

services, namely, planning and scheduling shipments for users of transportation services (in International Class 35); and

shipping and delivery services, namely, freight shipping transport from the United States to foreign ports globally, cargo hauling, cargo unloading, truck hauling services to and from major cities in the United States; freight ship transport; moving van transport; [and] loading freight into containers for shipment (in International Class 39).<sup>1</sup>

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C.

§1052(d), on the ground that applicant's mark, if used in connection with applicant's services, would so resemble the previously registered mark shown below



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<sup>1</sup> Application Serial No. 78624296, filed May 5, 2005, alleging a bona fide intention to use the mark in commerce. In response to the examining attorney's view that the recitation of services was unacceptable, applicant added Class 35 after the notice of appeal was filed. Although applicant submitted the requisite filing fee to add the class, an additional appeal fee to cover the new class was not submitted. Pursuant to a communication with applicant's attorney, the Office now has charged counsel's deposit account to cover the additional appeal fee.

for "international sea, air and land freight transportation."<sup>2</sup>

When the refusal was made final, applicant appealed. Applicant and the examining attorney filed briefs (although applicant elected to not file a supplemental brief pursuant to the Board's August 23, 2007 order).

Applicant contends that its simple word mark is easily distinguishable from registrant's stylized mark, specifically asserting that the marks are different in sight, sound and commercial impression. Applicant also contends that the services are distinct, stating that applicant's services include services "beyond those listed in the [cited] registration."

The examining attorney maintains that the marks are similar, especially because the dominant portion of applicant's mark is OTS and the dominant portion of registrant's mark is O.T.S. The examining attorney also argues that applicant's services are virtually identical or closely related to registrant's services. In support of the likelihood of confusion refusal the examining attorney introduced a dictionary definition of the term "logistics."<sup>3</sup>

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<sup>2</sup> Registration No. 2183942, issued August 25, 1998; Section 8 affidavit accepted, Section 15 affidavit acknowledged.

<sup>3</sup> The examining attorney submitted additional evidence regarding the requirement for a disclaimer; applicant eventually complied with the requirement.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *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 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).

With respect to the involved marks, we examine the similarities and dissimilarities of the marks in their appearance, sound, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). Contrary to the gist of one of applicant's arguments, the test 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 their entireties that confusion as to the source of the goods and/or services 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. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

With respect to the involved marks, 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. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) ["There is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties. Indeed, this type of analysis appears to be unavoidable."] For example, in the past merely descriptive matter that is disclaimed has been accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997). With respect to applicant's mark, applicant has disclaimed the terms LOGISTICS GROUP. Given the descriptive nature of these words in applicant's mark, applicant's mark is clearly dominated by the letters OTS. Moreover, the letters OTS comprise the first portion in applicant's mark; this first portion is the part of applicant's mark that is most likely to be impressed upon

the mind of a purchaser and will be remembered and used when calling for the services. See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988).

With respect to registrant's mark, where both letters and a design comprise the mark, we accord greater weight to the letters O.T.S. because the letters are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the services. In *re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). See also *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). Thus, in the case of registrant's mark, we find that the dominant portion is the literal portion of the mark, namely O.T.S.

As indicated above, applicant's mark is dominated by the letters OTS, and registrant's mark is dominated by the identical letters O.T.S. The presence of periods after the letters in registrant's mark does not distinguish this portion of the marks in any significant way. There is no logical reason, and certainly no evidence, that consumers would vocalize the periods in registrant's mark.

Although the dominant portion, OTS, of applicant's mark is essential identical to the dominant portion O.T.S. of registrant's mark in sound, appearance, meaning and commercial impression, we must do more than just compare the individual components of the marks; it is necessary that we compare the marks as a whole. *M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1948-49 (Fed. Cir. 2006) ["When comparing the similarity of marks, a disclaimed term...may be given little weight, but it may not be ignored"]. While we have considered the LOGISTICS GROUP portion of applicant's mark, and the design portion of registrant's mark (a triangle and what appears to be the front view of an aircraft), these portions of the respective marks do not sufficiently serve to distinguish the marks.

In sum, the marks, when considered in their entirety, are similar in sound, appearance, meaning and overall commercial impression. This factor weighs in favor of finding likelihood of confusion.

Insofar as the services are concerned, it is not necessary that the respective services be competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient that the respective services are related in some

manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

Applicant's "shipping and delivery services, namely, freight ship transport from the United States to foreign ports globally, cargo hauling, cargo unloading, and freight ship transport" in Class 39 are essentially identical to registrant's "international sea, air and land freight transportation."

As to the Class 35 services, applicant's "shipment processing, preparing and issuing export declarations, bills of lading, and other export documentation; arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels via ground, vessel and air; and planning and scheduling shipments for users of transportation services" are closely related and/or complementary to registrant's "international sea, air and land freight transportation." This is evident by the fact that applicant intends to render both types of services itself. We agree with the examining attorney's assessment

that applicant's information management and logistics services are provided in close connection with its own freight transportation services: "all of the Class 35 services are provided for the purpose of, and in support of, shipping and delivery services in Class 39."

Given the identity or close relationship between applicant's and registrant's services, the classes of purchasers for the services are the same.

The similarity between the services and the identity in purchasers are factors that weigh in favor of finding likelihood of confusion.

In view of the above, the du Pont factors, on balance, weigh in favor of finding likelihood of confusion.

Lastly, to the extent that any of applicant's points raise a doubt about likelihood of confusion, that doubt is required to be resolved in favor of the prior registrant. *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.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984).

**Decision:** The refusal to register is affirmed.