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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mach 1 Air Services Incorporated

Serial No. 78688083

Jason Matthew Lamb of The Walker Law Firm for Mach 1 Air Services Incorporated.

David S. Miller, Trademark Examining Attorney, Law Office 113.

Before Walters, Grendel and Drost, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Mach 1 Air Services Incorporated seeks registration on the Principal Register of the mark MACH 1 (in standard character form) for services identified in the application as "freight forwarding and warehousing services."<sup>1</sup>

<sup>1</sup> Serial No. 78688083, filed August 8, 2005, in International Class 39. The application is based on use of the mark in commerce under Trademark Act Section 1(a), 15 U.S.C. §1051(a), alleging first use and use in commerce as of July 9, 1988.

At issue in this appeal is the Trademark Examining Attorney's final refusal to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark MACH +, previously registered in relevant part for "transportation and storage of goods and small parcels and pick-up and delivery of small parcels by air,"<sup>2</sup> that, if used on or in connection with applicant's services, it would be likely to cause confusion or mistake or to deceive. After careful consideration of the evidence of record and the arguments of counsel, we affirm the refusal to register.

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

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<sup>2</sup> Registration No. 1791499 issued September 7, 1993, in International Class 39, and renewed for a ten-year term. The registration also includes goods in International Classes 12 and 16 that are not part of the basis for the refusal to register.

*Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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); and *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We turn, first, to the evidence and arguments pertaining to the services recited herein. The application includes the specimens consisting of web pages from applicant's website illustrating the nature of applicant's shipping and warehousing services. Applicant argues that its services differ from those of registrant because registrant's service "is an express courier service for small packages by air, while applicant's is a shipping and warehousing service for large freight." (Response of April 10, 2006.) However, we must base our analysis on the services recited in applicant's application vis-à-vis the services recited in the registration, rather than what the evidence shows the services actually are. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d

1813, 1815 (Fed. Cir. 1987). See also, *Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). In this regard, we note the definitions in the record from *The American Heritage® Dictionary of the English Language*, 4th Edition, 2006 (www.dictionary.reference.com, May 11, 2006) of "warehouse" as "a place in which goods or merchandise are stored" and of "warehousing" as "to place or store in a warehouse"; and we take judicial notice of the definition of the term "freight" from *The American Heritage® Dictionary of the English Language*, 4th Edition, 2006, as "n. 1. goods carried by a vessel or vehicle, especially by a commercial carrier; cargo. ... 3. a. commercial transportation of goods."

The examining attorney submitted fifteen third-party registrations and excerpts from twelve Internet websites to demonstrate a relationship between the respective services. The following relevant portions of identifications of goods are examples from the third-party registrations:

Registration No. 2927286	Delivery of documents, letters, packages, cargo, freight and other goods by air, truck, rail and ocean vessels; warehousing services, freight forwarding services
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Registration No. 3058140	Arranging for pickup, delivery, storage and transportation of documents, packages, freight and parcels via ground, air and ocean carriers
Registration No. 2877690	Freight transportation by road, rail, air and sea; freight forwarding; warehousing services ...; storage transportation and delivery of documents, packages, raw materials and other freight for others by road, rail, air and/or sea
Registration No. 3084523	Storage and transportation of documents, packages, freight, and goods of others; warehousing and freight forwarding services

Of the Internet excerpts, three websites are clearly of non-U.S. origin and have been accorded less probative value than the remaining website evidence, although we note that these foreign-based sites are in English and offer worldwide transportation and storage of a wide variety of goods. Nonetheless, the remaining website excerpts provide substantial evidence that each of the excerpted companies offers, among other related services, transportation and storage services for all types and sizes of goods, by all means of transportation, as well as "freight forwarding" of the same.

Based on this record, we find that applicant's "freight forwarding and warehousing services" would be

essentially the same as registrant's "transportation and storage of goods"; and registrant's "transportation and storage of small parcels and pick-up and delivery of small parcels by air" would be either a sub-set of applicant's broader recitation or a closely related service that the record shows are offered by the same entities. Thus, this factor weighs heavily against applicant.

For the same reasons noted above in relation to the services, applicant's arguments about the differences in the trade channels and classes of purchasers of the respective services is unavailing. We must presume that the goods of applicant and registrant are sold in all of the normal channels of trade to all of the usual purchasers for such services. See *Canadian Imperial v. Wells Fargo, supra*. That is, in view of the essentially identical nature of the services as identified, we must presume that the services of applicant and registrant are sold through the same channels of trade to the same classes of purchasers.

We turn, next, to a determination of whether applicant's mark and the registered mark, when viewed in their entireties, are similar in terms of appearance, sound, connotation and commercial impression.

Applicant argues that MACH is a weak component of a mark in view of numerous third-party registrations that include MACH as part of a mark for a variety of goods and services. In support of this position, applicant referenced 128 unidentified registrations and listed three third-party registrations for marks that include the term MACH for a variety of goods and services that include the word "transportation" in the identification of goods.

(Response of April 10, 2006.) As the examining attorney noted, in order to make these registrations properly of record, copies of the registrations themselves, or the electronic equivalent thereof, i.e., printouts of the registrations taken from the electronic records of the Patent and Trademark Office's (PTO) own database, should have been submitted. *See In re Dos Padres Inc.*, 49 USPQ2d 1860 (TTAB 1998); and *Weyerhaeuser Co. v. Katz*, 24 USPQ2d 1230 (TTAB 1992). Therefore, these registrations have not been considered.

Additionally, applicant submitted actual copies of three different third-party registrations with its reply brief. While applicant submitted these registrations in the proper form noted herein, the submission is late because all evidence must be made of record prior to appeal or with a request for reconsideration prior to the end of

the period for appeal. Trademark Rule 2.142(d), 37 C.F.R. 2.142(d). Therefore, these three registrations have not been considered.

Finally, even if we had considered these six third-party registrations, the registrations do not compel a different result herein as each case must be decided on its own facts. *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ["Even if prior registrations had some characteristics similar to [applicant's] application, the PTO's allowance of such prior registrations does not bind the Board or this court."].

The examining attorney submitted definitions from the *Compact Oxford English Dictionary*, 2006 (www.AskOxford.com, May 10, 2006), of "mach" as, in relevant part, "used with a numeral (as Mach 1, Mach 2, etc.) to indicate the speed of sound, twice the speed of sound, etc." and of "plus" as, in relevant part, "adjective (after a grade) rather better than; ... plus sign."

Both marks have the same visual pattern, i.e., both marks begin with the word MACH followed by a single number (applicant's mark) or a single plus sign, a symbol that is often used in conjunction with numerals (registrant's mark). Because it is the first word in each mark and the

"1" and "+" follows MACH in each mark, the "1" and "+" in each mark is likely to be perceived as modifying the word MACH. As indicated by the definition of "mach," the word usually appears followed by a numeral, as in applicant's mark MACH 1. The plus sign following MACH in the cited registered mark also connotes an amount, i.e., MACH is the speed of sound, so MACH + is likely to be understood as "more than the speed of sound." Contrary to applicant's contention, considering these components of the mark as part of our analysis is not a dissection of each mark. Although the marks at issue must be considered in their entirety, 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 National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Viewing the marks in their entirety, the similarities discussed lead us to the conclusion that the overall commercial impressions of the two marks are substantially similar.

We remind applicant that 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 terms of their overall commercial impressions

that confusion as to the source of the goods 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. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

Thus, the factor of the similarities of the marks also weighs against applicant.

Applicant asserts that it is aware of no instances of actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant; and that it has also never received a cease and desist letter from registrant indicating that registrant believes that confusion is unlikely or that confusion has not occurred. We are not persuaded by this argument.

However, as the Board stated in *In re Kangaroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984):

[A]pplicant's assertion that it is unaware of any actual confusion occurring as a result of the contemporaneous use of the marks of applicant and registrant is of little probative value in an ex parte proceeding such as this where we have no evidence pertaining to the nature and extent of the use by applicant and registrant (and thus cannot ascertain whether there has been ample opportunity for confusion to arise, if it were going to); and the registrant has no chance to be heard from (at least in the absence of a consent agreement, which applicant has not submitted in this case. Moreover, the test under Section 2(d)

is not actual confusion but likelihood of confusion. (*citations omitted*)

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, MACH 1, and registrant's mark, MACH +, their contemporaneous use on the same and/or closely related services involved in this case is likely to cause confusion as to the source or sponsorship of such services.

*Decision:* The refusal under Section 2(d) of the Act is affirmed.