

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

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Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Jay S. Cohen

Serial No. 78701838

Jacqueline M. Cohen for Jay S. Cohen.

Anthony M. Rinker, Trademark Examining Attorney, Law Office  
102 (Karen M. Strzyz, Managing Attorney).

Before Bucher, Walsh and Bergsman, Administrative Trademark  
Judges.

Opinion by Bucher, Administrative Trademark Judge:

Jay S. Cohen seeks registration on the Principal

Register of the mark **Elite Cruises** (*in standard character format*)

for services recited in the application, as amended, as  
follows:

"travel booking agencies, namely, making  
reservations and bookings for transportation,  
hotels, excursions, and cruises; providing travel  
booking services via the Internet and telephone;  
providing a website for use in reserving and  
booking transportation, excursions, hotels, and  
cruises" in International Class 39.<sup>1</sup>

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<sup>1</sup> Application Serial No. 78701838 was filed on August 26, 2005 based upon applicant's claims of first use anywhere at least as early as June 1, 1999 and first use in commerce at least as early as August 5, 2000. No claim is made to the word "Cruises" apart from the mark as shown.

This case is now before the board on appeal from the final refusal of the Trademark Examining Attorney to register this designation based upon Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). The Trademark Examining Attorney has found that applicant's mark, when used in connection with the identified services, so resembles the mark **ELITE YACHT CHARTERS** (*in typeset format*) registered in connection with "arranging travel tours and chartering yachts" in International Class 39,<sup>2</sup> as to be likely to cause confusion, to cause mistake or to deceive.

The Trademark Examining Attorney and applicant have briefed the issues in this appeal. We affirm the refusal to register.

In making the case for registrability herein, applicant argues that the cited mark is a weak mark that is entitled to only a limited scope of protection; that the Trademark Examining Attorney has improperly dissected the marks before comparing the dissected portions thereof, finding confusing similarity in a case where the marks are not similar in appearance, sound, connotation or commercial impression;

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<sup>2</sup> Registration No. 2283380 issued on October 5, 1999; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the term "Yacht Charters" apart from the mark as shown.

that he has misconceptions about the relatedness of the respective services and trade channels; and that the Trademark Examining Attorney has disregarded the highly scrutinized nature of the purchases associated with the marks at issue.

By contrast, the Trademark Examining Attorney contends that when compared in their entirety, the marks are quite similar; that the respective travel-related services are related to each other and could well involve similar trade channels; that even sophisticated purchasers may not be immune from source confusion; and that the cited mark is not weak or diluted in the context of the specific services.

### **Likelihood of Confusion**

We turn then to a consideration of the issue of likelihood of confusion. 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 this issue. *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).

**The number and nature of similar marks registered  
in connection with related services**

Applicant argues that the word "Elite" is so commonly used in connection with a wide variety of goods and services that the cited mark is weak and entitled to only a limited scope of protection. Specifically, applicant argues that there are over two-thousand federal trademark applications and registrations for marks incorporating the word "Elite," of which 764 are live registrations. Applicant submitted copies of thirty-five third-party registrations reciting services in International Class 39.

We agree with the Trademark Examining Attorney that among these thirty-five registrations, ones for services such as airline passenger services, limo and car rental services, freight hauling and bulk chemical transporting services, parking garage services, bus tours, courier services, and the like, are hardly persuasive of our finding the word "Elite" weak for registrant's services of "arranging travel tours and chartering yachts."

The following nine registrations owned by four different service mark owners reflect the class 39 services closest to those of registrant and applicant, including those initially cited as bars under Section 2(d) of the Act:

**ELITE AVIATION**

for "airplane chartering" in  
International Class 39;<sup>3</sup>



for "airplane chartering" in  
International Class 39;<sup>4</sup>

**ELITE ISLAND VACATIONS**

for "arranging travel tours" in  
International Class 39;  
"travel agency services, namely,  
making reservations and  
bookings for temporary lodging;  
hotel services" in Int. Class  
43;<sup>5</sup>

**ELITE ISLAND RESORTS**

for "arranging travel tours" in  
International Class 39;  
"travel agency services, namely  
making reservations and  
bookings for temporary lodging;  
hotel services" in Int. Class  
43;<sup>6</sup>

**ELITE EXCURSIONS**

for "administering a consumer  
benefit program which entitles

<sup>3</sup> Registration No. 2392090 issued on October 3, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the word "Aviation" apart from the mark as shown.

<sup>4</sup> Registration No. 2392111 issued on October 3, 2000; Section 8 affidavit (six-year) accepted and Section 15 affidavit acknowledged. No claim is made to the word "Aviation" apart from the mark as shown.

<sup>5</sup> Registration No. 2807308 issued to Elite Island Vacations, Inc. on January 20, 2004. No claim is made to the term "Island Vacations" apart from the mark as shown.

<sup>6</sup> Registration No. 2809214 issued to Elite Island Vacations, Inc. on January 27, 2004. No claim is made to the term "Island Resorts" apart from the mark as shown.

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members to discounts, rebates and bonuses in connection with travel" in Int. Class 35;  
"travel agency services, namely, making reservations and bookings for transportation" in International Class 39;  
"travel agency services, namely, making reservations and bookings for lodging" in Int. Class 43;<sup>7</sup>

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**ELITE COLLECTION**

for "arranging travel tours; travel agency services, namely, making reservations and bookings for transportation; travel and tour information services; travel, excursion and cruise arrangement services" in International Class 39;<sup>8</sup>

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**ELITE EXCURSIONS**

for "promoting the services of others over the Internet by administering a consumer benefit program that entitles customers to receive discounts on travel and lodging" in International Class 35;  
"on-line travel agency services, namely, making reservations and bookings for transportation and car rental by means of a global computer network" in International Class 39;  
"on-line travel agency services, namely, making reservations and bookings for lodging, by means of a global computer network" in International Class 43;<sup>9</sup>

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<sup>7</sup> Registration No. 2902137 issued on November 9, 2004. No claim is made to the word "Excursions" apart from the mark as shown. This registration is owned by the Trilegiant Corporation.

<sup>8</sup> Registration No. 3030928 issued to Trans National Travel, Inc. on the Supplemental Register on December 13, 2005.

<sup>9</sup> Registration No. 3064055 issued to the Trilegiant Corporation on February 28, 2006. No claim is made to the word "Excursions" apart from the mark as shown.

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**ELITE TRAVELER**

for "travel agency services, namely, making reservations and bookings for transportation" in international class 39;  
"travel agency services, namely, making reservations and booking for temporary lodging; travel agency services, namely, making reservations and bookings for restaurants and meals" in international class 43.<sup>10</sup>



for "administering a consumer benefit program which entitles members to discounts, rebates and bonuses in connection with travel; and promoting the services of others over the Internet by administering a consumer benefit program that entitles customers to receive discounts on travel and lodging" in Int. Class 35;  
"travel agency services, namely, making reservations and bookings for transportation; and on-line travel agency services, namely, making reservations and bookings for transportation and car rental by means of a global computer network" in Int. Class 39;  
"travel agency services, namely, making reservations and bookings for lodging; and on-line travel agency services, namely, making reservations and bookings for lodging, by means of a global computer network" in International Class 43;<sup>11</sup>

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<sup>10</sup> Registration No. 3070069 issued to American Express on March 21, 2006 under Section 2(f) of the Act.

<sup>11</sup> Registration No. 3151631 issued to the Trilegiant Corporation on October 3, 2006. No claim is made to the word "Excursions" apart from the mark as shown.

The information placed into the record by applicant shows that over the years a large number of manufacturers, merchants and service providers have adopted the word "Elite" as part of their source-identifiers. Much as one might conclude from a dictionary entry, the intention of these mark owners is to suggest that the involved goods or services are directed to "the best of the group."

Based upon the results of its TESS search report, applicant focuses upon the number and nature of similar marks registered in International Class 39 - in connection with services rendered in transporting people or goods from one place to another.

With an eye toward the marks enumerated above, all beginning with the word "Elite," applicant argues that the word "Elite" is extremely weak in the field of travel agencies and chartering operations. Hence, applicant concludes that consumers are forced to look to other elements in these marks - including merely descriptive and generic matter - in order to distinguish among the various sources of "Elite" travel-related services.

However, terms like "Aviation," "Island," "Excursions," etc., are not as similar to "Yacht Charters" as is "Cruises." Furthermore, live registrations do not prove that the marks

are in use, and hence, there is no way an assessment can be made as to what, if any, impact those marks may have made in the marketplace. See *Seabrook Foods, Inc. v. Bar-Well Foods, Limited*, 568 F.2d 1342, 196 USPQ 289 (CCPA 1977).

Furthermore, as noted by the Trademark Examining Attorney, even weak marks are entitled to protection from confusion with similar marks for closely-related services. *Hollister Incorporated v. Ident A Pet, Inc.*, 193 USPQ 439 (TTAB 1976).

### The marks

We turn next to the *du Pont* factor focusing on the similarities or dissimilarities between applicant's mark and registrant's cited mark as to appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant argues that the Trademark Examining Attorney has improperly dissected the involved marks, focusing only on the common word "Elite," and thereby failing to consider the other distinguishing characteristics of the respective marks. See *Shen Manufacturing Co. Inc. v. The Ritz Hotel Ltd*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004) [overturning finding of likelihood of confusion determination between **RITZ** and **THE RITZ KIDS** inasmuch as the board had improperly

dissected the marks, focusing only on the term "Ritz"]. Accordingly, applicant asserts that there is no confusing similarity when applicant's mark **ELITE CRUISES** and the cited mark **ELITE YACHT CHARTERS** are compared in their entireties.

The Trademark Examining Attorney contends that the term "Elite" is the dominant feature of applicant's mark. Even if this component of registrant's mark is determined to be highly suggestive and used by many service providers, we must still consider the similarity or dissimilarity of the marks when viewed in their entireties, and "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of the mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

The significance of the term "Elite" as the dominant element of applicant's mark is further reinforced by its location as the first word of the marks. *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ["it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered"]. See also *Palm Bay Imports*, 73 USPQ2d at 1692

["Vueve" is the most prominent part of the mark VUEVE CLICQUOT because "vueve" is the first word in the mark and the first word to appear on the label]; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992) [upon encountering the marks, consumers must first notice the identical lead word, "Century"].

Applicant is correct that the cited mark is three words while its mark is only two words. This creates a minor dissimilarity in appearance and sound. However, the Trademark Examining Attorney correctly argues that both marks consist of the leading word, "Elite," followed by merely descriptive wording that suggests "leisure time spent on a boat, whether it is a cruise ship or a smaller vessel." Hence, the Trademark Examining Attorney concludes that this creates a similarity in connotation and commercial impression.

On the other hand, applicant argues that the term "Cruises" and the term "Yacht Charters" have different connotations and mental impressions associated with each of them. That is, applicant argues that while the term "Cruises" "connotes a large capacity commercial cruise liner", the term "Yacht Charters" "connotes the

leasing/renting of an entire privately owned/operated luxury boat."

[T]he term CRUISES actually conveys the concept of a vacation aboard a large capacity, mass-market, non-exclusive access cruise liner, whereas the term YACHT CHARTERS conveys the concept of leasing a luxury, limited access boat to provide a very private and intimate travel experience. The charter[er] of a YACHT generally has control over the itinerary, schedule, meal times, etc., onboard the chartered boat."

Furthermore, the phrase YACHT CHARTERS is associated with a luxury boat accessible only to a very small and elite segment of the wealthy who can afford the large sums of money associated with chartering an entire luxury boat, whereas the term CRUISES is associated with the purchase of a single berth by an average consumer aboard a large passenger ship (as opposed to a boat) with hundreds of strangers, a pre-determined itinerary, fixed time schedules and meal times, etc. over which such purchaser has absolutely no influence.

Reflecting on the dictionary definition of the word "cruise" as "a sea voyage for pleasure," we find that applicant's mark has a broader connotation than applicant argues. While many in the travel and hospitality industry may associate "cruise" with the purchase of a single berth by an average consumer on a large capacity, mass-market, commercial passenger ship, we construe it as any sea voyage for pleasure, and that this could well overlap with the meaning of a "yacht charter." While this latter term often

involves the hiring or leasing of an entire vessel, it is still being used in connection with a pleasure cruise.

Accordingly, we find that in spite of the minor dissimilarities in sound and appearance, the mark are highly similar as to connotations and commercial impressions, and this *du Pont* factor favors the position of the Trademark Examining Attorney.

### **The services**

We turn then to a consideration of registrant's and applicant's services. In order to support a finding of likelihood of confusion, it is not necessary for the goods or services of the parties to be similar or competitive, or even that they move in the same channels of trade. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or 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 originate from the same producer. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Moreover, we must decide the question of likelihood of confusion based upon the services as they are specified in the instant application for registration, and the involved registration, rather than upon what applicant's submissions during this *ex parte* prosecution attempt to show those services to be. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

Applicant is correct in arguing that the relatedness of the respective services herein cannot be presumed merely because the services represented by the marks fall into the same broad category. However, in considering registrant's recitation of services, it seems that applicant would have us read "arranging travel tours and chartering yachts" as "arranging travel tours, *namely* chartering yachts"<sup>12</sup> - arguing, as a result, that registrant's cited services are not even remotely related to the services provided by applicant.

We disagree, viewing the conjunctive term "and" as separating out related, but somewhat different, travel

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<sup>12</sup> Characterized by applicant as "chartering a multi-million dollar yacht and arranging tours associated therewith ... " Applicant's appeal brief at 8 - 9.

services. While it stands to reason that the primary focus of registrant's services is chartering yachts, we cannot interpret the leading phrase in its recitation of services in a way that renders it meaningless. Hence, we find that the ordinary meaning of the phrase "arranging travel tours" is totally without restriction as to the type of tours. This phrase could well include other pleasure cruises, land excursions, including sleeping accommodations and ground transportation, etc. While there may well be a conceptual difference in the amount of planning and effort involved in "arranging" a tour versus that of "booking" a reservation, nonetheless, we conclude that registrant could well be providing services not that dissimilar from applicant's range of travel booking services.

As to naming the types of services connected with vessels plying the waters, the dictionary definition of "cruise" is "a sea voyage for pleasure." Furthermore, among the ninety hits from its Google search engine (that applicant placed into the record) for the words "yacht charter," were websites discussing whale-watching and harbor tours, diving excursions, party cruises available by the hour, for weddings, anniversaries, bar mitzvahs, "sweet-16" or other types of on-board parties. While it is true that many of

these vendors are touting expensive yacht charters for a week or even longer, registrant's recitation of services is not limited to such.

This conclusion is also borne out by two Internet searches that applicant conducted - one directed to the two words "yacht" and "charter" and the other to the word "cruises." We note the variations on the word "cruise" within the "yacht charter" web pages identified by applicant in Appendix A attached to its response of November 11, 2007:

- "All-inclusive private **cruises**"  
<http://www.caribbeancruisingvacation.com/>;
- "luxury dinner **cruises**,"  
<http://www.windridgeyachts.com/>;
- "vacation **cruises**," <http://www.latigo.net/>
- "**Cruising** destinations"; "on Jamal Charters best in Alaska **cruises**"; "**cruising** at its best"; "Alaska **cruising** experience"; "a private yacht **cruise**"  
<http://www.yachtchartersalaska.com/>;
- "yacht charter **cruising** vacations"; "**cruising** grounds of the British Virgin Islands" [www.yachtpromenade.com/](http://www.yachtpromenade.com/);  
and
- "**cruise** the calm waters of Fort Lauderdale"; "FT. Lauderdale Riverfront **Cruises**,"  
<http://www.anticipation.com/>.

Similarly while applicant paints a sharply contrasting picture between ordinary middle-class consumers being herded into tiny cabins aboard large passenger ships, and millionaires luxuriating on smaller

boats, applicant's own evidence does not always suggest such a clear distinction. Its own web page says that "we have access to every ship (large or small)." Likewise, in Appendix B, attached to applicant's response of November 11, 2007, one of the vendors listed on a "cruises" web page that specializes in chartering smaller ships for cruises, says that "you don't have to be a millionaire to vacation like one." <http://smallshipcruises.com/>.

Accordingly, inasmuch as it is not critical to our determination that the respective services be identical or competitive, we do find a definite relationship between the services recited by registrant and those recited by applicant, and this *du Pont* factor favors the position taken by the Trademark Examining Attorney

#### **The channels of trade**

Applicant argues from its Internet searches that inasmuch as the "yacht charter" search elicited information related to yachts and not mass marketed cruises/travel and vice versa, this supports the conclusion that these are very distinct and separate streams of commerce, directed to two entirely distinct and separate classes of consumers. However, as seen above, while the extremes as described by applicant are quite far removed from each other, we also see

an overlap in the form of party cruises on chartered yachts, and hence, conclude there is some overlap in channels of trade and in classes of consumers.

**The conditions of sale**

As noted by the Trademark Examining Attorney, even if we were to conclude from the evidence of record that many of registrant's consumers comprise a sophisticated class of purchasers, we find that even purchasers who closely study and scrutinize an offer of services may well not be immune from source confusion if similar marks are used in connection with closely-related services. *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); and *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

**Conclusion**

Accordingly, in spite of the sophistication of many of registrant's customers, we find that consumers familiar with **ELITE YACHT CHARTERS** services will mistakenly believe that **ELITE CRUISES** services emanate from the same source.

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