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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Clear Channel Outdoor, Inc.

Serial No. 78962079

Pamela B. Huff, Kristi F. Dent and Matthew M. Jennings of
Cox Smith Matthews Incorporated for Clear Channel Outdoor,
Inc.

Shaila E. Settles, Trademark Examining Attorney, Law Office
114 (K. Margaret Le, Managing Attorney).

Before Bucher, Taylor and Bergsman, Administrative
Trademark Judges.

Opinion by Taylor, Administrative Trademark Judge:

Clear Channel Outdoor, Inc. has filed an application
to register on the Principal Register the mark TAXI
ENTERTAINMENT NETWORK (in standard character format) for
services ultimately identified as "Out-of-home advertising
services, namely, rental of advertising space in broadcast
media, and preparing and placing advertisements in
broadcast media for others" in International Class 35.¹ At

¹ Serial No. 78962079, filed August 28, 2006, and alleging a
bona fide intention to use the mark in commerce.

the request of the examining attorney, applicant disclaimed the words "ENTERTAINMENT NETWORK."

The trademark examining attorney has refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), due to a likelihood of confusion with the marks in Registration No. 1888792 for TAXI (in standard character format) for "advertising agency services" in Class 35 [and] "graphic art design services" in Class 42 and Registration No. 2818654 for TAXI and design, shown below,



for "Advertising agencies" in Class 35 [and] "Graphic art design, designing and implementing web sites for others" in Class 42. The registrations are owned by the same entity.

Registration was also refused pursuant to Trademark Act Section 2(e)(1), 15 U.S.C. § 1052 (e)(1), on the ground that the proposed mark TAXI ENTERTAINMENT NETWORK is merely descriptive of a feature or characteristic of applicant's out-of-home advertising services.

When the refusals were made final, applicant appealed. Both applicant and the examining attorney filed briefs.² As discussed below, we affirm the refusals to register under Section 2(d) and reverse the refusal to register under Section 2(e)(1).

LIKELIHOOD OF CONFUSION

We initially note that inasmuch as both applicant and the examining attorney focused their discussion of the relatedness of the services on applicant's recited services vis-à-vis the advertising agency services (advertising agencies) identified in the cited registrations, we will do the same.

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.

² Applicant, in its brief, indicated that its identified services were classified in International Class 42. We note, however, that the services are classified in International Class 35. In any event, it is well recognized that the system of dividing goods (and services) into classes is a USPTO administrative convenience and that a determination on the relatedness of the respective goods (and services) is not restricted by this artificial boundary. See *Jean Patou Inc. v. Theon Inc.*, 9 F.3d 971, 29 USPQ2d 1771 (Fed. Cir. 1003); *Graco Inc. v. The Warner-Graham Company*, 164 USPQ 400, 402 (TTAB 1969).

Cir. 2003). In any likelihood of confusion analysis, 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).

The Marks

Considering first the marks, we must determine whether applicant's mark, TAXI ENTERTAINMENT NETWORK, and registrant's marks, TAXI and TAXI and design are similar or dissimilar in terms of sound, appearance, connotation and commercial impression. Applicant argues that when its mark and the cited marks are viewed in their entirety, "it is clear that there is no reasonable probability of confusion." (Br. p. 4). Applicant particularly contends that its mark differs significantly from the cited marks in terms of commercial impression and that the visual and aural distinctions between all of the marks have significance. The examining attorney, by contrast, maintains that the marks are "similar in commercial impression because applicant has adopted in its entirety the sole source-identifying element in registrant's mark[s] (i.e., 'Taxi') without adding additional elements that distinguish the marks and/or their source." (Br. p. 6).

As applicant correctly points out, the marks must be considered in their entireties. However, 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) ("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.") In addition, with a composite mark comprising a design and words, the word portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed. *CBS, Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198, 200 (Fed. Cir. 1983); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593 (TTAB 2001) ("words are normally accorded greater weight because they would be used by purchasers to request the goods"); *In re Nat'l Data Corp.*, 753 F.2d at 1056.

Furthermore, 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 impression that confusion

as to the source of the services offered under the respective marks is likely to result.

Applying these principles to the marks at issue, we conclude that applicant's mark is similar to both cited marks. While there are differences between the marks, namely the addition of the term "ENTERTAINMENT NETWORK" to applicant's mark and the black quadrangle design to registrant's design mark, we nonetheless find the marks are similar in appearance, sound, connotation and commercial impression. In particular, the dominant portion of applicant's applied-for mark is TAXI inasmuch as the descriptive and disclaimed wording "ENTERTAINMENT NETWORK" is subordinate in nature.

Further supporting the position that the word "taxi" is the dominant portion of applicant's mark is its position as the first word in the mark. *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 Inc. v. Veuve Clicquot Ponsardin*, 386 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) ("Veuve" is the most prominent part of the mark VEUVE CLICQUOT because "veuve" 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 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers must first notice the identical lead word). Accordingly, the dominant portion of applicant's mark is identical to the entire word portion of registrant's TAXI marks.

Applicant is correct that disclaimed matter cannot be ignored. However, inasmuch as the term ENTERTAINMENT NETWORK merely describes a feature of applicant's services, namely, that applicant's advertisements are featured specifically in broadcast media, it will not be looked upon as source indicating.

As regards the cited TAXI and design mark, the term TAXI is the dominant portion because the word portion of a mark is more likely to be impressed upon a purchaser's memory and used in calling for the goods. *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 2001). Moreover, the design consists simply of a black quadrangle carrier having no source-indicating significance.

Put simply, when we consider applicant's mark and the two cited registered marks in their entireties, we find that due to the shared term "TAXI," applicant's mark is similar to both cited, registered marks. The *du Pont*

factor of similarity of the marks thus favors a finding of likelihood of confusion.

Third-Party Usage of TAXI

Applicant also argues that the cited "TAXI" marks are weak and therefore should be afforded only a relatively narrow range of protection. (Br. p. 9). In support of its position that the mark is weak, applicant made of record copies from the TESS database of the U.S. Patent and Trademark Office (USPTO) of forty-five (45) third-party applications and seventy-two (72) use-based third-party registrations for marks containing the term "TAXI" for a variety of goods and services.³ We find these examples of limited probative value. First, as regards the applications, they show only that the applications have been filed. See *Interpayment Services Ltd. v. Docters & Thiede*, 66 USPQ2d 1463 (TTAB 2003). As regards the third-party registrations, while they may be used to demonstrate that a portion of a mark is suggestive or descriptive, they are not evidence that the marks shown therein are in use or that the public is aware of them. See *AMF Incorporated v. American Leisure Products, Inc.*, 177 USPQ 268, 269 (CCPA

³ Applicant included copies of three additional registrations. However, one was owned by applicant and the other two are of no probative value because they are not use based.

1973) ["little weight is to be given such registrations in evaluating whether there is likelihood of confusion."]. Moreover, our review of such registrations reveals that of the seventy-two registrations, the term "TAXI" has been disclaimed in fifteen and two of the marks are registered on the Supplemental Register. The remaining marks include additional distinguishing terms (e.g., TAKEOUT TAXI with knife and fork design, SPACE TAXI PINBALL, PEANUT ISLAND WATER TAXI and TAXI-BOT) or cover very different goods and services (e.g., perfumes, colognes, toilet water and shampoo; toys; restaurant services; and paper goods and printed matter). Essentially, the third-party registrations fail to show that the word "taxi" has any descriptive significance in connection with advertising services.

We add that even if "TAXI" were considered to be weak due to an asserted degree of common usage, even weak marks are entitled to protection where confusion is likely. See *Matsushita Electric Company v. National Steel Co.*, 442 F.2d 1383, 170 USPQ 98, 99 (CCPA 1971) ("Even though a mark may be 'weak' in the sense of being a common word in common use as a trademark, it is entitled to be protected sufficiently to prevent confusion from source arising"). Here, notwithstanding any alleged weakness in the registered

marks, they are still similar in sound, appearance, connotation and commercial impression to applicant's mark. We accordingly find this *du Pont* factor is neutral.

Relatedness of the Services/Channels of Trade

Considering next the relatedness of the services, it is well settled that the question of likelihood of confusion must be determined based on an analysis of the services recited in applicant's application vis-à-vis the services recited in the registrations, rather than on the basis of what the record reveals the services to be. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991). Furthermore, where the services in an application or cited registration are broadly described, such that there are no restrictions as to trade channels and purchasers, it is presumed that the identification of services encompasses not only all services of the nature and type described therein, but that the identified services are provided in all channels of trade which would be normal therefor, and that they would be purchased by all potential customers thereof. See, e.g., *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

In this case, we compare applicant's "out-of-home advertising services, namely, rental of advertising space in broadcast media, and preparing and placing advertisements in broadcast media for others" with registrant's "advertising agency services (advertising agencies)." In analyzing the relatedness of these services, it is not necessary that the services of applicant and the registrant be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective services are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under conditions which could, because of the marks used therewith, give rise to a mistaken belief that they originate from or are in some way associated with the same source. In re Melville Corp., 18 USPQ2d 1386 (TTAB 1991).

Applicant, in urging reversal of the refusal, maintains that the services offered under the cited marks and its mark are so substantially different that confusion is unlikely.

The examining attorney argues that the services are related because registrant's advertising agency services

are highly similar to and likely encompass applicant's "out-of-home advertising services, namely rental of advertising space in broadcast media, and preparing and placing advertisements in broadcast media for others." Noting that likelihood of confusion is determined on the basis of the services as identified in the application and cited registrations, and not on the basis of what the record may show the services to actually be, the examining attorney points out that, as identified, it is presumed that applicant will rent advertising space and prepare and place advertisements in all forms of broadcast media and without limitation to LCD screens in taxi cabs only. In addition, there is no limitation to the type of registrant's advertising agency services. The examining attorney accordingly maintains that the preparation and placement of advertisements in broadcast media are services that are performed by advertising agencies and are therefore encompassed in the description "advertising agency services" and/or "advertising agencies."

In support of this position, the examining attorney made of record with her Final office Action, evidence from Wikipedia indicating that the creative department of an advertising agency creates [or prepares] the actual ads, and the account services department places the

advertisements. She also made of record excerpts of advertising agency websites, including those of Rita Sanders Public Relations and Advertising Agency, Odney Adverting, Blitz, Impact Adverting and Green Dot Advertising, obtained from a search of the Google search engine for the terms "advertising agency placement," showing that advertising agency services include engaging in media buying, i.e., buying space and time for advertisements in media outlets, and planning and placing advertising in broadcast media, including television.

We find this evidence sufficient to establish that registrant's advertising agency services and/or advertising agencies encompass applicant's out-of-home advertising services, namely rental of advertising space in broadcast media, and preparing and placing advertisements in broadcast media for others.

In an attempt to distinguish its services from those of the registrant, applicant argues that its services are not those typically associated with advertising agencies such as strategic planning, advertising and design - the creation of advertising campaigns. Rather, applicant contends that its services involve the broadcasting of informational and entertainment content as well as

advertisement on LCD screens in taxi cabs. Specifically, applicant argues that its mark is used in connection with "programming from NBC, real time tickers with a variety of topics, passenger information including GPS tracking of [the] taxi trip, Time, Fare and the ability to pay by Credit and Debit Card." (Br. p. 2). These arguments are unavailing as an applicant may not restrict the scope of the goods covered in the cited registration by argument or extrinsic evidence. In re Bercut-Vandervoort & Co., 229 USPQ 763, 764 (TTAB 1986).

Applicant similarly argues that its consumers are seeking to place ads in an actual broadcast and not looking to create advertisements to be placed with third parties and thus consumers of applicant's services will not likely encounter the cited marks in the same marketing context. However, in the absence of any limitations in the identification of services as to channels of trade and classes of purchasers in the application and the cited registrations, we must presume that the services will be offered in all usual channels of trade for such services, and will be purchased by the usual classes of purchasers for those services, and thus, at a minimum, the channels of trade and classes of purchasers overlap. In re Elbaum, *supra*.

In view of the above, the *du Pont* factors of the relatedness of the services, channels of trade and classes of purchasers favor a finding of likelihood of confusion.

Conditions of Sale

Applicant also argues that confusion is not likely because its broadcast medium is "extremely advanced technology" and the consumers most likely to rent its advertising space will be technologically savvy professional or commercial purchasers who will be less prone to confusion when making purchasing decisions. (Br. p. 6). Applicant further argues that both applicant and registrant market and sell their services to large corporations whose purchasing employees are unlikely to confuse applicant's services with the cited services or to encounter the informational and entertainment dissemination services of applicant when making large expenditures related to developing an advertising campaign. *Id.* In addition, applicant argues that both its services and registrant's services can be very expensive and, therefore, companies will exercise more care in committing such substantial sums and are therefore unlikely to become confused as to the source of either applicant's or the cited services. (Br. p. 7).

Unfortunately, applicant does not provide any evidence regarding the decision-making process used by these purportedly technologically savvy professional or commercial purchasers, the role trademarks play in their decision making-process, or how observant and discriminating they are in practice. Accordingly, the problem with applicant's argument is that there is no corroborating evidence. See *Refreshment Machinery Inc. v. Reed Industries, Inc.*, 196 USPQ 840, 843 (TTAB 1977) (selling to a sophisticated purchaser does not automatically eliminate the likelihood of confusion because "[i]t must also be shown how the purchasers react to trademarks, how observant and discriminating they are in practice, or that the decision to purchase involves such careful consideration over a long period of time that even subtle differences are likely to result in recognition that different marks are involved").

Moreover, as noted previously in this decision, there is no limitation in either recitation that the services are rendered solely to professional or commercial purchasers. Nor is there any evidence regarding the cost of either applicant's or registrant's services. However, even assuming arguendo that the respective services are expensive and will be offered only to, and purchased only

by, "professional or commercial purchasers," even knowledgeable and careful purchasers can be confused as to source, where, as here, very similar marks are used in connection with partially overlapping services. See *In re Research Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) citing *Carlisle Chemical Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 168 USPQ 110, 112 (CCPA 1970) ("Human memories even of discriminating purchasers ... are not infallible.").

Additional Argument

Last, applicant argues that the Patent and Trademark Office has allowed marks for somewhat similar services to register where the only meaningful difference between the marks was the addition of the phrase ENTERTAINMENT NETWORK. However, as often noted by the Board and the Courts, each case must be decided on its own merits. The determination of registrability of a mark in another case cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, *In re Kent-Gamebore Corp.*, 59 USPQ2d 1373 (TTAB 2001); and *In re Wilson*, 57 USPQ2d 1863 (TTAB 2001).

After considering and balancing all of the evidence as it relates to the relevant *du Pont* factors, we conclude

that purchasers familiar with registrant's advertising agency services (advertising agencies) rendered under the marks TAXI and TAXI and design would be likely to believe, upon encountering applicant's mark TAXI ENTERTAINMENT NETWORK for out-of-home advertising services, namely, rental of advertising space in broadcast media, and preparing and placing advertisements in broadcast media for others, that the services originate from or are associated with or sponsored by the same source.

DESCRIPTIVENESS

We now consider whether the phrase TAXI ENTERTAINMENT NETWORK merely describes applicant's "out-of-home advertising services, namely, rental of advertising space in broadcast media, and preparing and placing advertisements in broadcast media for others."

The examining attorney bears the burden of showing that a mark is merely descriptive of the identified goods or services. See *In re Merrill, Lynch, Pierce, Fenner, and Smith Inc.*, 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A term is considered to be merely descriptive of goods and/or services, within the meaning of Section 2(e)(1) of the Act, if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or services in

connection with which it is used, or intended to be used. See, e.g., in re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215 (CCPA 1978).

To determine whether a term is merely descriptive we must consider the term not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used or intended to be used, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. In re Recovery, Inc., 196 USPQ 830 (TTAB 1977). The question whether a proposed mark is merely descriptive is not determined by asking whether one can guess, from the mark itself, what the goods or services are, but rather by asking, when the mark is seen on or in connection with the goods or services, whether it immediately conveys information about their nature. See In re Patent & Trademark Services Inc., 49 USPQ2d 1537, 1539 (TTAB 1998).

Further, when two or more merely descriptive terms are combined, we must determine whether the combination of terms evokes a new and unique commercial impression. If each component retains its merely descriptive significance in relation to the goods, then the resulting combination is

also merely descriptive. See, e.g., In re Tower Tech, Inc., 64 USPQ2d 1314 (TTAB 2002) (SMARTTOWER held merely descriptive of commercial and industrial cooling towers). However, a mark comprising a combination of merely descriptive components is registrable if the combination of terms creates a unitary mark with a unique nondescriptive meaning, or if the composite has a bizarre or incongruous meaning as applied to the goods. See In re Colonial Stores Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968); In re Shutts, 217 USPQ 363 (TTAB 1983); and TMEP section 1209.03(d).

The examining attorney maintains that the applied-for mark, TAXI ENTERTAINMENT NETWORK, is a combination of merely descriptive terms that fail to create a new nondescriptive phrase. She specifically argues that TAXI ENTERTAINMENT NETWORK "immediately conveys an idea of two significant features and/or characteristics of applicant's services, namely, that applicant's advertisements are broadcast in a media outlet and that the broadcast media outlet and advertisement appear in taxi cabs." (Br. p. 11). As regards the term "Taxi," the examining attorney specifically cites to applicant's March 29, 2007 response to the first Office Action wherein applicant states that:

[a]pplicant's mark TAXI ENTERTAINMENT NETWORK is used in connection with airing 'programming from NBC, real time tickers with a variety of

topics, passenger information including GPS tracking of [the] taxi trip, Time, Fare and the ability to pay by Credit or Debit Card' on state-of-the-art LCD screens installed in the back seats of cabs.

(Br. p. 12 citing applicant's March 29, 2007, Response to Office Action at 1) (emphasis supplied). Based on applicant's above-referenced explanation, she contends that the word "Taxi" describes the fact that the broadcast media and advertisements will be seen in taxicabs. As regards the disclaimed wording "ENTERTAINMENT NETWORK," the examining attorney argues that it describes the fact that the advertisements will be prepared and placed in broadcast media and the advertising space rented in broadcast media. In short, the examining attorney maintains that the combination of these terms create no incongruity, and no imagination is required to understand the nature of the services.

Applicant, by contrast, maintains that its applied-for mark TAXI ENTERTAINMENT NETWORK "is not merely descriptive, but is rather suggestive of, Applicant's services because it requires substantial thought and perception on the part of the consumer to reach a conclusion as to the nature of the services described." (Reply br. p. 3).

We agree with applicant. Although the record demonstrates that "TAXI" and "ENTERTAINMENT NETWORK," as

individual components of applicant's mark, describe features or characteristics of applicant's services, the examining attorney did not establish that consumers, upon seeing applicant's mark TAXI ENTERTAINMENT NETWORK, would perceive it as merely describing a feature or characteristic of applicant's advertising services. It would take at least two mental steps to connect the mark with a significant feature of applicant's rental of advertising space in broadcast media and/or preparing and placing advertisements in broadcast media for others services: 1) the viewer must understand that applicant does not provide entertainment services of any kind but, rather, that the entertainment services are underwritten by advertising applicant prepares and/or that the advertisements are placed in the broadcast medium that applicant provides; and 2) that the advertising services are rendered in a taxi.

In sum, "[i]t has been recognized that there is but a thin line of distinction between a suggestive and a merely descriptive term, and it is often difficult to determine when a term moves from the realm of suggestiveness into the sphere of impermissible descriptiveness." In re Recovery, Inc., supra. Moreover, it is well established that any doubt must be resolved in favor of the applicant. See In

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re Merill Lynch, Pierce, Fenner, and Smith, Inc., *supra*.
(internal citations omitted). In view of the foregoing, we
find that the mark TAXI ENTERTAINMENT NETWORK is not
descriptive of the identified services.

Decision: The refusals to register under Section 2(d)
of the Trademark Act are affirmed, and the refusal to
register under Section 2(e)(1) of the Trademark Act is
reversed.