

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: June 12, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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BellSouth Intellectual Property Corporation

v.

Engle, Richard
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Opposition No. 91164739
to application Serial No. 78338240
filed on 12/9/03
—————

Theodore H. Davis, Jr. of Kilpatrick Stockton LLP for
BellSouth Intellectual Property Corporation.

Timothy D. Beets of Beets & Yanda, PLLC for Richard Engle.
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Before Quinn, Walsh and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

On December 9, 2003, applicant, Richard Engle, filed an application to register on the Principal Register the mark displayed below, based upon an allegation of his use thereof in commerce on or in connection with "telephone and business directories," in International Class 16.¹

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¹ Application Serial No. 78338240 alleges January 1, 2002 as the date of first use of the mark anywhere and in commerce in connection with the goods. Applicant disclaims the exclusive right to use "AMERICA" and "YELLOW PAGES", and the representation



Registration has been opposed by BellSouth Intellectual Property Corporation ("opposer"). As grounds for opposition, opposer asserts that it is the owner of numerous marks, previously used and registered on the Principal Register, including the following:

BELL

in typed or standard character form for, *inter alia*, "telephone, classified and business directories,"² in International Class 16;



of the "walking fingers" apart from the mark as shown. In addition, the application contains the following color statement: The color gray appears in the representation of the Liberty Bell, the color black appears in the word BELLWEST, the "walking fingers" logo, the frame around the "walking fingers" logo, the words YELLOW PAGES, and the outline of the Liberty Bell, the color yellow appears in the background around the "walking fingers" logo, the color white appears in the words PROCLAIM LIBERTY, and the color red appears in the word AMERICA.

² Concurrent Use Registration No. 1565562 issued on November 14, 1989. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

for, *inter alia*, "telephone, classified and business directories,"³ in International Class 16; and

BELLSOUTH

in typed or standard character form for, *inter alia*, "telephone and business directories,"⁴ in International Class 16.

Opposer argues that it and its predecessors in interest have used its famous BELL and BELL-formative marks in connection with the above listed goods since prior to applicant's asserted first use of his involved mark; that applicant's mark, when used on applicant's goods so resembles opposer's BELL and BELL-formative marks for its recited goods as to be likely to cause confusion, to cause mistake, and to deceive; that registration of applicant's involved mark further would dilute the distinctive quality of opposer's BELL marks; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.

The record in this case consists of the pleadings and the file of the involved application. During its assigned

³ Concurrent Use Registration No. 1569327 issued on December 5, 1989. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

⁴ Registration No. 1459196 issued on September 29, 1987. Section 8 affidavit accepted; Section 15 affidavit acknowledged.

testimony period, opposer filed a notice of reliance upon the following: status and title copies of its pleaded registrations; copies of court and World Intellectual Property Organization (WIPO) decisions involving opposer and third parties; applicant's responses to certain of opposer's interrogatories; and the discovery depositions of Richard Engle and Denise Engle, with accompanying exhibits. In addition, opposer filed certain testimony depositions and accompanying exhibits.

Applicant did not take testimony or offer any other evidence during its assigned testimony period.

Opposer and applicant filed main briefs on the case and opposer filed a reply brief.

Opposer's Standing

Because opposer has properly made its pleaded registrations of record, and further because opposer has asserted a likelihood of confusion claim that is not wholly without merit, we find that opposer has established its standing to oppose registration of applicant's mark. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

Priority of Use

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this

case as to the BELL, bell design, and BELLSOUTH marks as well as the goods and services covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

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, even those not specifically discussed in this decision. 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 Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003); and *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

We will concentrate our discussion of the issue of likelihood of confusion on that registration of opposer's which is closest to the mark and goods for which applicant is seeking registration, namely, opposer's concurrent use registration for BELL in typed or standard character form for "telephone, classified and business directories."⁵

⁵ Concurrent Use Registration No. 1545199, *supra*.

The Goods

Turning first to our consideration of the similarities or dissimilarities between the parties' goods, we note that it is well established that the goods of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods 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 source. *See Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telephone Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

In this case, applicant's "telephone and business directories" are included among the goods identified in opposer's pleaded Concurrent Use Registration No. 1565562, namely, "telephone, classified and business directories." Thus, applicant's goods are identical in part to those of

opposer. As a result, we are not persuaded by applicant's assertion that its goods are not competitive with the goods and services of opposer. In view of the fact that applicant is using its mark on goods that are identical to certain of the goods identified in the cited registration, this *du Pont* factor heavily favors opposer.

Channels of Trade

Because the parties' goods are identical in part, and because there are no recited restrictions as to the channels of trade or classes of purchasers, we must assume that the goods are available in all the normal channels of trade to all the usual purchasers for such goods, and that the channels of trade and the purchasers for applicant's goods include those of opposer. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910 (TTAB 2000). It is settled that in making our determination regarding the relatedness of the parties' goods and/or services, we must look to the goods and services as identified in the involved application and pleaded registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's

goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.") Thus, this *du Pont* factor also favors opposer.

The Marks

We turn to the first *du Pont* factor, i.e., whether applicant's mark and opposer's BELL mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall commercial impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot*, *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. Because the involved goods would be marketed to the general public, our 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). Nevertheless, it is well settled that one feature of a mark may be more

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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, 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, "that a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of a mark..." *Id.* at 751.

When considering applicant's mark, we note that the wording "AMERICA" and "YELLOW PAGES," as well as the "walking fingers" design have been disclaimed. The disclaimed terms and design in applicant's mark are subordinate to the remaining, distinctive features thereof, namely BELLWEST, the design of the Liberty Bell, and the wording PROCLAIM LIBERTY.

In addition, the wording BELLWEST AMERICA and the design of the Liberty Bell are by far the largest and most visually prominent features of applicant's mark. The wording PROCLAIM LIBERTY is much less prominent, being difficult to read and easy to overlook as it appears in

small white letters on the upper portion of the light gray Liberty Bell design. The wording YELLOW PAGES and the "walking fingers" design, appearing in the lower right hand corner of the mark, is even less prominent due to its very small size. As a result, consumers viewing applicant's mark will be drawn immediately to the wording BELLWEST AMERICA and the Liberty Bell design and will only notice the remaining features of the mark upon closer inspection. Thus, we find that BELLWEST AMERICA and the Liberty Bell design are the most prominent features of applicant's mark.

Further, it is settled that the literal portions are generally the dominant and most significant features of marks because consumers will call for the goods or services in the marketplace by that portion. See *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *In re Drug Research Reports, Inc.*, 200 USPQ 554, 556 (TTAB 1978). For this reason, greater weight is often given to the literal portions of marks in determining whether there is a likelihood of confusion. See *Id.* Because consumers are likely to call for applicant's goods by the BELLWEST AMERICA portion of his mark rather than by the Liberty Bell design or one of the mark's less prominent features, we find that BELLWEST AMERICA is the dominant and most significant feature of the applied-for mark.

In comparing the parties' marks, we note that applicant's mark incorporates in its entirety opposer's BELL mark. BELL is the first word of the phrase BELLWEST AMERICA, which, as discussed above, is the dominant feature of applicant's mark. Consumers calling for applicant's goods are very likely to pronounce opposer's BELL mark when doing so. Because applicant's mark contains opposer's mark as the first word of its most prominent feature, the marks are highly similar in appearance and sound. Furthermore, opposer's mark is registered in typed or standard character form and thus could be displayed in lettering similar, or even identical, to the BELLWEST AMERICA portion of applicant's mark which is displayed in rather ordinary font. See, e.g., *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); *In re Pollio Dairy Products Corp.*, 8 USPQ2d 2012, 2015 (TTAB 1988); and *Sunnen Products Co. v. Sunex International Inc.*, 1 USPQ2d 1744, 1751 (TTAB 1987). In addition, the relatively prominent Liberty Bell design in applicant's mark is essentially a pictorial representation of opposer's BELL mark. Thus, we find that the marks are highly similar in overall connotation and convey very similar commercial impressions.

Moreover, it is undisputed that the goods identified by applicant's mark are included among the goods identified by the mark in opposer's Registration No. 1565562. Where the

goods identified in the application are identical to the goods identified in an existing registration, "the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 877, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). In addition, confusion is more likely when, as here, an applicant's mark incorporates the entire word portion of a previously registered mark. See, e.g., *In re Hyper Shoppes, Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988); and *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 1022, 194 USPQ 419, 422 (CCPA 1977).

As a result, we find that when viewed as a whole, the similarities between applicant's mark and opposer's BELL mark as to sound, appearance, connotation and commercial impression outweigh the dissimilarities.⁶ In view thereof, this *du Pont* factor also favors opposer.

Summary

In view of the foregoing, we find that opposer has established its standing to bring this proceeding; its priority of use; and that a likelihood of confusion exists

⁶ While we have limited our discussion herein to a comparison of applicant's mark with opposer's BELL mark, we note in addition that the bell design in applicant's mark is confusingly similar to the bell design mark in opposer's pleaded Registration No. 1569327 for, *inter alia*, "telephone, classified and business directories" in International Class 16.

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between its BELL mark and applicant's mark, as used in connection with the parties' identical goods.

DECISION: The opposition is sustained on the ground of priority and likelihood of confusion, and registration to applicant is refused.⁷

⁷ In view of our determination herein, we need not and do not reach opposer's dilution claim.