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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Checkpoint Systems, Inc.  
v.  
CheckPoint Mailers, Inc.

Opposition No. 91165826  
to application Serial No. 76568845  
filed on January 8, 2004

Roberta Jacobs-Meadway, Patricia G. Cramer and Troy E.  
Larson of Ballard Spahr Andrews & Ingersoll for Checkpoint  
Systems, Inc.

Heather C. Lowry for Checkpoint Mailers, Inc.

Before Quinn, Drost and Kuhlke, Administrative Trademark  
Judges.

Opinion by Quinn, Administrative Trademark Judge:

CheckPoint Mailers, Inc. filed an application to  
register the mark shown below

CheckPoint  Mailers  
Incorporated

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("MAILERS" and "INCORPORATED" disclaimed) for "processing and delivery of personal items surrendered at transportation security checkpoints."<sup>1</sup>

Checkpoint Systems, Inc. opposed registration under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground of likelihood of confusion. Opposer alleged that applicant's mark, when used in connection with applicant's services, so resembles opposer's previously used and registered CHECKPOINT and checkmark design marks for retail loss prevention sensors, electronic article surveillance, tracking products, access control entry products and related security products, programs and services as to be likely to cause confusion.

Applicant, in its answer, denied the salient allegations in the notice of opposition.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by opposer; a discovery deposition of applicant with related exhibits, certified copies showing status and title of opposer's pleaded registrations, copies of third-party registrations, copies of articles from printed publications, and applicant's responses to certain interrogatories and requests for admissions, all introduced

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<sup>1</sup> Application Serial No. 76568845, filed January 8, 2004, alleging first use anywhere and first use in commerce on April 28, 2003.

by way of opposer's notices of reliance. Applicant neither took testimony nor offered any other evidence. Both parties filed briefs.<sup>2</sup>

Opposer is engaged in the design, manufacture and sale of identification, security and surveillance products that integrate multiple functions, including pricing, tracking, promotion and shortage control. Opposer also renders related services. Opposer began using its CHECKPOINT mark in 1969. Opposer's business is divided into four general segments: electronic article surveillance (EAS); electronic access control (EAC); closed circuit television (CCTV); and radio frequency identification (RFID). Opposer's security products and services are used to monitor location and track movement of people and physical assets. The products are used in many applications, including in retail stores at airports to prevent unauthorized removal of merchandise, in libraries to prevent theft of reference materials, and at airports in connection with security. Opposer's current annual sales in the United States are approximately \$230 million. In the EAS, EAC and CCTV fields, opposer is among

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<sup>2</sup> The Board, in an order dated June 12, 2007, struck the last five pages of Appendix A attached to applicant's brief. Opposer, in its reply brief, also requests that the Board not consider certain statements in applicant's brief. Suffice it to say that while we have read applicant's entire brief, factual statements in applicant's brief that are not supported by evidence have been given no weight; statements in a brief have no evidentiary value. See, e.g., *Electronic Data Systems Corp. v. EDSA Micro Corp.*, 23 USPQ2d 1460, 1465 n.5 (TTAB 1992); and TBMP §704.06(b) (2d ed. rev. 2004).

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the leaders in market share. Opposer advertises in trade publications, direct mail and at security trade shows. Over a recent 3-year period, advertising expenditures totaled \$3.8 million. Opposer also has been the subject of unsolicited media coverage.

Applicant operates 27 kiosks at airports throughout the United States. Applicant's services are offered to airline passengers who are informed, pursuant to guidelines issued by the Transportation Security Administration (TSA), that they must surrender certain prohibited items from their carry-on luggage before boarding their flight. Passengers preferring to ship prohibited articles back home rather than surrendering them before passing through security at TSA gate entry points have the option of utilizing applicant's services. The passenger picks up a package at applicant's kiosk that is located near the airport's security gates, fills out the required mailing information, and the package containing the prohibited item is sent to the desired location. Applicant's first kiosk began operating in April 2003 at the Charlotte (North Carolina) Douglas airport. Applicant's sales have steadily increased, with sales in 2003 estimated at \$160,000-\$200,000, and sales in 2005 exceeding \$660,000. In 2004, applicant shipped 60,000 packages. Applicant's busiest location is at the Las Vegas, Nevada airport, with approximately \$13,000 in monthly sales;

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the least busy location is at the Akron, Ohio airport, with \$150-\$250 in monthly sales. In the past three years applicant spent about \$60,000 in promotional activities. Heather Lowry, applicant's president and chief operating officer, has given many interviews aired on television and radio.

Opposer has established its standing to oppose registration of the involved application. In particular, opposer has properly made its pleaded registrations of record (see infra) and, further, has shown that it is not a mere intermeddler. Opposer's use and registrations of its marks establish that opposer has standing. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

As to priority, opposer introduced during its testimony period the following registrations: CHECKPOINT (in standard character form) for "security services, namely, preventing the unauthorized removal of materials from restricted areas";<sup>3</sup> "electronic protection equipment, namely, apparatus for detecting articles being removed and locating lost articles";<sup>4</sup> and "electronic security and surveillance

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<sup>3</sup> Registration No. 844752, issued February 20, 1968; renewed.

<sup>4</sup> Registration No. 845817, issued March 12, 1968; renewed.

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systems comprising magnetic sensors, magnetic tags and magnetic tag deactivators; electronic access control systems for securing corporate assets, namely, access control cards, access control card readers, computers for operating and controlling electronic access control systems and computer programs for running the electronic access control system; closed circuit television systems for tracking assets comprising televisions, controllers, cameras and computers for operating and controlling closed circuit television systems; radio frequency identification and surveillance systems for monitoring the location and control of assets comprised of radio frequency readers, radio frequency tags and computer programs for operating the radio frequency identification and surveillance system."<sup>5</sup> Also of record is the registration for the mark shown below



for "RF (radio frequency) security tags."<sup>6</sup>

In view of opposer's ownership of valid and subsisting registrations, there is no issue regarding opposer's

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<sup>5</sup> Registration No. 2440085, issued April 3, 2001; Section 8 affidavit accepted, Section 15 affidavit filed.

<sup>6</sup> Registration No. 2119592, issued December 9, 1997; renewed.

priority. *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Thus, the only issue to decide herein is likelihood of confusion.

We accordingly turn to the issue of likelihood of confusion. Our 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. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Opposer must establish that there is a likelihood of confusion by a preponderance of the evidence. The relevant *du Pont* factors in the proceeding now before us are discussed below.

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 Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). 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 services offered under the respective marks is likely to result. In comparing the marks, we will focus on opposer's CHECKPOINT mark rather than its stylized checkmark design

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mark inasmuch as opposer's word mark is the closer of the two marks to applicant's mark.

In considering applicant's logo mark, 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."].

Where both words and a design comprise the mark (as in applicant's mark), then the words are normally accorded greater weight because the words are likely to make an impression upon purchasers, would be remembered by them, and would be used by them to request the goods and/or 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 applicant's mark, we find that the dominant portion is the literary portion of the mark, namely CHECKPOINT MAILERS INCORPORATED.

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In considering the literary portion of applicant's mark, this portion, in turn, is dominated by the term CHECKPOINT. We so find because descriptive/generic matter generally is subordinate to source-identifying portions of a mark. For example, 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); and *In re Code Consultants Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001) [Disclaimed matter is often "less significant in creating the mark's commercial impression"]. In the present case, applicant has disclaimed the generic terms MAILERS and INCORPORATED. *See Cunningham v. Laser Golf Corp.*, 55 USPQ2d at 1846, quoting, *In re National Data Corp.*, 224 USPQ at 752 ["Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.'"]. The term MAILERS is generic and has no source-indicating capacity. As shown by the multiple dictionary definitions introduced by opposer, the term "mailer" means "a container for mailing something." *See, e.g., The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2000). Opposer also introduced excerpts of numerous third-party websites showing generic uses of "mailers" in connection with mailing containers. Further,

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several third-party registrations covering shipping and packing supplies list "mailers" in the identification of goods. Lastly, although applicant stated that the term "mailers" has multiple meanings, it admitted that one of the meanings "is an envelope or container in which something is to be mailed." (Response to Request for Admission No. 1). As generic matter, the term MAILERS was properly disclaimed. See TMEP §1213.03(b) (5<sup>th</sup> ed. 2007). Insofar as the abbreviation INC. is concerned, INC. clearly is an entity designation and as such has no source-indicating capacity. *In re Packaging Specialists, Inc.*, 221 USPQ 917, 919 (TTAB 1984). See TMEP §1213.03(d) (5<sup>th</sup> ed. 2007).

In view of the above, we find that the term CHECKPOINT is the dominant portion of applicant's mark. This term is identical in sound, appearance, meaning and commercial impression to the entirety of opposer's mark CHECKPOINT. This point is buttressed by Ms. Lowry's testimony that applicant's kiosk is referred to as "a CheckPoint kiosk." (Lowry dep., p. 48).

Although the dominant portion, CHECKPOINT, of applicant's mark is identical to registrant's mark CHECKPOINT, 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 MAILERS and INCORPORATED portions of applicant's mark, purchasers are likely to view these commonly understood and recognized terms as having no distinguishing or source-indicating role in the mark.

In view of the above, we find that the parties' marks are similar. The similarity between the parties' marks is a factor that weighs in opposer's favor.

Opposer characterizes its marks as "strong." Although the term "checkpoint" is somewhat suggestive of opposer's goods and services, the record is devoid of any third-party uses or registrations of "checkpoint" in the security field. Further, the record shows that opposer has enjoyed a degree of success with its goods and services offered under its mark CHECKPOINT, and that opposer's mark has been actively promoted to the relevant purchasers. Accordingly, we accept, for purposes of our analysis, that opposer's mark is strong. This factor weighs in opposer's favor.

We next turn to a consideration of the goods and services. It is not necessary that the respective goods and/or 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

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respective goods and/or services are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods and/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 originated from the same producer. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991).

We readily acknowledge that there are specific differences between the goods and services involved herein. Nevertheless, the goods and services are related to the extent that opposer's goods and services and applicant's services relate to security, and more particularly, to the restriction of articles and individuals to certain areas; in some applications, opposer's goods and services are present in airports as is the case with applicant's services.

Opposer's goods and services are used for restricting the movement of articles beyond a certain point, and applicant's services involve the handling of articles that have been restricted from moving beyond a certain point. Some of opposer's goods, such as the electronic access control and closed circuit television products, are used in connection with airport security. According to David Shoemaker, opposer's group vice president for market development, opposer has contemplated using its technology

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in connection with luggage tags for baggage handling at airports, and the tracking of VIP passengers at airports. Thus, the parties' goods and services essentially are offered in connection with improving the overall security of an airport; in fact, applicant's brochure invites prospective airport customers to "Call Today To Add CheckPoint Mailers to Your Security System."

Further, according to Mr. Shoemaker, "today's airport looks more like a mall," and opposer's customer base includes retail stores located in airports.

In view of the above, we find that the goods and services move through similar trade channels and are directed to overlapping customers. *On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000). Both opposer and applicant market their respective goods and services to airport security departments.

Security professionals familiar with opposer's security products, such as electronic access control and closed circuit television products sold under the mark CHECKPOINT, would be likely to believe, upon encountering applicant's services involving the processing and delivery of personal items surrendered at transportation security checkpoints rendered under the mark CHECKPOINT MAILERS INCORPORATED and

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design, that the goods and services originated with or are somehow associated with or sponsored by the same entity.

We also find that the end users of the parties' goods and services are likely to be confused. As opposer contends:

CheckPoint Mailers' services are also directed to travelers at airports who must pass through security gates. The same individuals who pass through the security gates at airports are the same types of customers who carry Checkpoint electronic access cards which display the Checkpoint Name and Marks, and the same members of the general public who shop at stores where the Checkpoint Name and Marks appear on Checkpoint's EAS tags, sensors and deactivation pads located at the gates at the exits and at the checkout counters. Travelers who also carry Checkpoint electronic access cards, for example, to gain entry to their office buildings, are likely to wrongly conclude that CheckPoint Mailers' services are another aspect of Checkpoint's vast physical security business.

(Opposer's Brief, p. 17). These users, familiar with opposer's goods and services, would be likely to believe that opposer's business activities include providing an additional security service in handling items that travelers are prohibited from carrying with them when they gain access to restricted areas.

The absence of actual confusion is of little moment. Given the short length of time of contemporaneous use of the marks, and applicant's relatively low level of sales and

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advertising under its mark, the opportunity for confusion to have occurred in the marketplace has been minimal.

Moreover, the test is likelihood of confusion, not actual confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). We view this *du Pont* factor as neutral in our analysis.

We find that the *du Pont* factors, on balance, weigh in favor of a finding of likelihood of confusion.

Lastly, to the extent that there may be any doubt on our finding of likelihood of confusion, we resolve that doubt, as we must, in favor of opposer as the prior user and registrant. *See Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

**Decision:** The opposition is sustained on the ground of likelihood of confusion, and registration to applicant is refused.