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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

American Automobile Association, Inc.

v.

Pacific Delight Tours Inc.

Cancellation No. 92046794

Lawrence E. Laubscher, Jr. of Laubscher & Laubscher, PC for
American Automobile Association, Inc.

William Honan and Carla Calcagno of Holland and Knight LLP
for Pacific Delight Tours Inc.

Before Holtzman, Zervas and Taylor, Administrative Trademark
Judges.

Opinion by Zervas, Administrative Trademark Judge:

On January 1, 2002, Registration No. 2525957 ("the '957
registration") for the mark CHINA & ASIA TOURBOOK (in typed
form) issued on the Principal Register to Pacific Delight
Tours, Inc. ("respondent") for "arranging and conducting
travel tours" in International Class 39, based on an
application filed on February 9, 2000. The '957
registration claims first use anywhere and first use in

commerce in March 2000 and includes a disclaimer of CHINA & ASIA. The Office accepted an affidavit under Section 8 of the Trademark Act on April 10, 2008.

American Automobile Association, Inc. ("petitioner" or "AAA") has filed a petition to cancel the '957 registration. In the petition to cancel, petitioner pleaded ownership of Registration No. 1073617 (the '617 registration) for the

mark **TourBook** (hereinafter "TOURBOOK") for "books published annually and from time to time describing, within indicated state and regional areas, places of sightseeing interest, and giving hotel, motel and restaurant ratings, and providing related other information" in International Class 16. Petitioner has alleged that it owns a trademark application for TOURBOOK for "providing travel information via an electronic communications network" and that its trademark application has been refused registration in view of respondent's registration. Additionally, petitioner has alleged that its mark is famous; that it has used its mark on a variety of goods and services in the United States; that it has used the mark in connection with books containing travel information since at least 1925; and that respondent's continued registration of its mark is likely to cause confusion in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Petitioner has also

alleged that respondent's mark "dilutes the distinctive quality of Petitioner's AAA [sic] marks in violation of Section 43(c) of the Trademark Act (15 U.S.C. § 1125(c))."¹

Respondent has answered the petition to cancel by denying the salient allegations thereof and raising several affirmative defenses.

The record consists of the pleadings; the file of the involved registration; and the February 26, 2008 testimonial deposition of James G. Brehm and accompanying exhibits, including a certified status and title copy of the '617 registration for the TOURBOOK mark. The '617 registration issued on September 20, 1997, has been twice renewed and has been registered under Section 2(f) of the Trademark Act, 15, U.S.C. § 1052(f).

Petitioner has filed a main brief; respondent has not filed any evidence or a main brief.

Background

Petitioner is composed of a federation of independent motor clubs in the United States and Canada that provides a variety of services to its members. Petitioner has annually published TOURBOOK books since the 1920s. The books provide travel information on points of interest, accommodations,

¹ We consider the reference to "Petitioner's AAA marks" to be a typographical error and assume that petitioner intended to plead that respondent's mark dilutes the distinctive quality of petitioner's TOURBOOK mark.

restaurants and attractions for a particular geographic region within the United States and Canada. Brehm dep. pp. 7 - 11. TOURBOOK guides are available in printed form and, since 1998, in electronic form on petitioner's aaa.com website. *Id.* at pp. 15 - 17. In printed form, the guides are sold to the independent motor clubs at cost, and then are distributed at no cost to members as part of their membership benefits. *Id.* at p. 8.

Standing

Petitioner has submitted proof that it is the owner of the '617 registration, and that the registration is valid and subsisting. *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). Additionally, petitioner has submitted proof, that it is the owner of a trademark application for TOURBOOK for "providing travel information via an electronic communications network"; and that its trademark application has been refused registration in view of respondent's registration. Brehm ex. 11. Through its proofs, petitioner has established its standing.

Priority

Because this is a cancellation proceeding, petitioner does not necessarily have priority simply because it owns a registration. *Brewski Beer Co. v. Brewski Brothers, Inc.*,

47 USPQ2d 1281, 1284 (TTAB 1998) (the "Board has taken the position, in essence, that the registrations of each party offset each other; that petitioner as a plaintiff must, in the first instance, establish prior rights in the same or similar mark Of course, petitioner or respondent may rely on its registration for the limited purpose of proving that its mark was in use as of the application filing date."). In this case, because respondent has not submitted any evidence, the earliest date upon which it can rely is the filing date of respondent's application which issued as the '957 registration. *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 n. 5 (TTAB 1985) ("The earliest date of first use upon which Intelsat can rely in the absence of testimony or evidence is the filing date of its application."). Inasmuch as petitioner's underlying application for the pleaded '617 registration was filed prior to the February 9, 2000 filing date of the CHINA & ASIA TOURBOOK application, petitioner has priority in connection with its registered mark.

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 issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic*

Distilling Company, Inc., 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §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).

Because petitioner has asserted that its mark is famous, we first consider the *du Pont* factor regarding the fame of this mark. This factor plays a dominant role in cases featuring a famous or strong mark. *Kenner Parker Toys Inc. v. Rose Arts Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. *Id.* at p. 1456. A famous mark is one "with extensive public recognition and renown." *Id.* 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 determining whether a mark is famous, we may consider sales, advertising expenditures, and the length of time the mark has been used. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811

(TTAB 2005). This information, however, must be placed in context (e.g., a comparison of advertising figures with competitive products, market share, reputation of the product, etc.). *Bose*, 63 USPQ2d at 1309.

Petitioner argues as follows, relying on Mr. Brehm's testimony:

Here, the TOURBOOK mark has been used by AAA since 1925 in connection with its travel guide books. Tens of millions of books have been distributed over the last five years to AAA's 45 million members in the United States. Extensive advertising and promotion have resulted in the TOURBOOK guides being a primary factor in causing individuals to join AAA and in providing value in an AAA membership. The growth of views of TOURBOOK online travel information shows that the fame of the TOURBOOK mark for guide books is being translated to the TOURBOOK online information services. In 2008, over 20 million views of the information were made via the Internet.

Brief at p. 10.

We have carefully considered petitioner's evidence and arguments and find that petitioner has not established that its mark is famous.

First, the annual total advertising figures provided by petitioner for 2003 to 2007 are not just for its TOURBOOK publication, and there is no indication as to what percentage of the totals stated are for advertising of the TOURBOOK mark.

Second, petitioner's advertising figures do not appear substantial, totaling \$394,113 in 2003 and \$688,675 in 2007, and petitioner has not provided any context for these

figures by, e.g., comparing such figures for competitive products. See *Bose*, 63 USPQ2d at 1309.

Third, petitioner's reliance on the "Total Annual TourBook Views [Online], 2003 - 2007," Brehm's dep. ex. 17, is not persuasive. It is unclear whether the "Views" of exhibit 17,² numbering approximately eleven million to twenty-three million per year, depending on the year, are for all webpages within the online version of TOURBOOK. If "Views" includes all TOURBOOK webpages, it is unclear how many of such webpages there are within the online version of TOURBOOK and whether the viewer will recognize that he or she is on a TOURBOOK webpage (the record contains only a handful of TOURBOOK webpages).

Fourth, petitioner has submitted statistics for 2004 - 2006 regarding the number of "AAA TOURBOOK[S] ... shipped in bulk quantities to American Automobile Association Club offices in the United States and Canada for redistribution to AAA members on request." Brehm dep. pp. 27 - 18, and ex. 16. The numbers distributed to the Club offices are sizable, numbering around twenty million for each year. However, they do not identify the number of books actually distributed to consumers and, in particular, to consumers in the United States. Also, alone, they are not probative of

² Exhibit 17 includes the following explanation: "TourBook View totals include lodging, restaurants, campgrounds, attractions, events, destination and visitor information."

the alleged fame of petitioner's mark TOURBOOK apart from other marks such as "AAA" which appear in close association with TOURBOOK on petitioner's books, see Brehm's ex. 3.

Fifth, petitioner relies on Mr. Brehm's testimony that petitioner conducted surveys in 2005 and 2007 which indicated that petitioner's members consider petitioner's TOUBOOK guides second to emergency road service as the most valuable resource provided by petitioner. Mr. Brehm's testimony is of limited probative value because the survey and its results are not in the record. Moreover, his testimony is hearsay.

Because the evidence of record regarding fame is not persuasive, we find that petitioner has not established that its mark is famous.

We now consider the similarity or dissimilarity of petitioner's and respondent's marks. We determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports*, 73 USPQ2d at 1692.

Respondent's mark CHINA & ASIA TOURBOOK, contains the term TOURBOOK and the merely descriptive terms CHINA & ASIA, which identify the location of respondent's tours.

Additionally, respondent has disclaimed CHINA & ASIA.

Descriptive matter is often "less significant in creating the mark's commercial impression." *In re Code Consultants, Inc.*, 60 USPQ2d 1699, 1702 (TTAB 2001). See also *Quaker*

State Oil Refining Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972).

The Federal Circuit has recognized that there is nothing improper in giving more weight, for rational reasons, to a particular portion or feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). The Court has also stated that "the 'descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion.'" *Cunningham*, 55 USPQ2d at 1846, quoting, *National Data Corp.*, 224 USPQ at 752.

We therefore find that the dominant portion of respondent's mark is the term TOURBOOK, which is identical to petitioner's pleaded registered mark. Both marks suggest a book for touring, with respondent's mark specifying the geographic content. As such, the marks are similar in meaning and commercial impression. They are also similar in sound and appearance in view of the shared term TOURBOOK. See *Palm Bay Imports, supra*. See also, e.g., *In re Dixie Restaurants*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997) (likelihood of confusion with addition of the words "The" and "Café" and a diamond-shaped design to registrant's DELTA mark); and *In re Denisi*, 225 USPQ 624, 624 (TTAB 1985) (if "the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral

differences.") Further, any differences due to the additional wording in respondent's marks are outweighed by the similarity due to the shared term TOURBOOK. The *du Pont* factor regarding the similarity of the marks is therefore resolved against respondent.

Next, we turn to the *du Pont* factor regarding the similarity or dissimilarity and nature of the goods and/or services. Such goods and services are similar if they are related in some manner. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991). Consumers of respondent's travel tour services would consult guide books such as those of petitioner in connection with their travels to locate hotels, places of interest, etc. A consumer would likely use respondent's travel tour services and petitioner's guide books, concerning the same geographic areas, at the same time. Because there is a relationship between petitioner's books and respondent's tour services, we conclude that the *du Pont* factor regarding the similarity of the goods and services favors a finding of likelihood of confusion. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) (likelihood of confusion must be found if there is a likelihood of confusion with respect to any item that comes within the identification of goods or services in the application or registration).

Cancellation No. 92046794

Considering and balancing all of the evidence as it pertains to the relevant *du Pont* factors discussed above, we conclude that a likelihood of confusion exists.

Respondent's mark is sufficiently similar to petitioner's registered mark that use of the respective marks on respondent's related services is likely to lead to confusion as to source, sponsorship or affiliation.

In view of our finding that there is a likelihood of confusion between petitioner's registered mark and respondent's mark, we need not reach petitioner's pleaded claim of dilution.

DECISION: The petition to cancel Registration No. 2525957 is granted.