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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re 1travel.com, Inc.

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Serial No. 76/016,399

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Rita M. Irani of Haynes and Boone, L.L.P. for 1travel.com, Inc.

Steven W. Jackson, Trademark Examining Attorney, Law Office 114 (K. Margaret Lee, Managing Attorney).

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Before Cissel, Seeherman and Hairston, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by 1travel.com, Inc. to register ONETRAVEL.COM as a service mark for the following services:

> Travel agency services, namely making reservations and bookings for transportation on an interactive web site, including providing and relaying information, and securing payment in connection with such bookings by electronic means in in Class 39; and
>
> Making reservations and bookings for temporary lodging on an interactive web site, including

providing and relaying information, and securing payment in connection with such bookings by electronic means in Class 42.[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, if used in connection with the identified services, so resembles the following marks, which are registered to the same entity, as to be likely to cause confusion, mistake or deception:

(1)

for "travel agency services;"[2] and

(2) TRAVEL ONE for "travel agency services, namely, making reservations and bookings for transportation, and travel agency services, namely, making reservations and bookings for temporary lodging".[3]

[1] Application Serial No. 76/016,399, filed April 3, 2000, based on the assertion of applicant's bona fide intent to use the mark in commerce.
[2] Registration No. 1,573,888 issued December 26, 1989 on the Principal Register; renewed.
[3] Registration No. 2,120,877 issued December 16, 1997 on the Principal Register. The word "TRAVEL" is disclaimed apart from the mark as shown.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested.

Our determination under Section 2(d) is based on an analysis of all of the probative 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). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods/services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

Turning first to the services, applicant argues that the services are different because its travel agency and associated services will be offered through an interactive web site on the Internet, whereas registrant's travel agency services are provided through "conventional" means, i.e., a retail establishment. One problem with this argument is that the question of likelihood of confusion must be determined on the basis of the goods and/or services as they are identified in the subject application and registration, not on what the evidence shows the goods and/or services to be. See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); In re William Hodges & Co., Inc.,

190 USPQ 47 (TTAB 1976). Although applicant's recitation of services indicates that its travel agency and associated services will be provided on an interactive web site, the recitation of services in the cited registration contains no restrictions as to channels of trade. Thus, for purposes of our analysis, we must assume that registrant's travel agency services are rendered through all the normal channels of trade, which would include on an interactive web site. In short, applicant and registrant's services are legally identical. Further, in the absence of any restrictions in either applicant's application or the cited registrations as to classes of purchasers, we must assume that applicant and registrant's services may be offered to all of the usual purchasers of these kinds of services, which would include ordinary consumers. Thus, even if we were to accept applicant's position that its travel agency services and those of the registrant will be offered in different channels of trade, they could still be encountered by the same consumers.

This brings us to consideration of the marks. Applicant contends that the marks have different commercial impressions, with its mark connoting "the first or foremost in the online travel business" and registrant's mark connoting "a person or entity engaging in travel, e.g., the

traveling one." (Brief, p. 5). Further, applicant argues that the cited marks are weak because the word "travel" is generic for registrant's services and the number "one" is laudatory. Thus, applicant argues that the cited marks are not entitled to a broad scope of protection.[4]

The Examining Attorney argues that the generic domain name ".COM" in applicant's mark has no source-indicating function, and thus the dominant portion of applicant's mark is ONETRAVEL which is essentially a transposition of TRAVEL ONE, which is the entirety of one of registrant's marks and the dominant portion of the other.

After careful consideration of the arguments of applicant and the Examining Attorney, we find that the marks, when considered in their entireties, are sufficiently similar in overall commercial impression that

[4] In support of this contention, applicant submitted, for the first time with its brief on the case, three lists of third-party registrations and applications for marks that include the word "travel", or the number "one." Under Trademark Rule 2.142(d), "evidence" submitted for the first time with a brief on appeal is considered by the Board to be untimely and therefore given no consideration. In view thereof, we have not considered the lists of third-party registrations and applications submitted with applicant's brief in reaching our decision herein. Even though we have not considered this untimely evidence, we recognize, as discussed herein, that "travel" and "one" are descriptive and/or laudatory terms.

if applicant's mark were used in connection with the identified services, confusion would be likely. As our principal reviewing court, the Court of Appeals for the Federal Circuit, has pointed out, "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likelihood of confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

As correctly noted by the Examining Attorney, the dominant portion of applicant's mark is ONETRAVEL; the ".COM" portion of the mark is merely a generic domain name and serves no source-identifying function. Further, TRAVEL ONE is the entirety of one of registrant's marks and it is the dominant portion of the other. Thus, we agree with the Examining Attorney that applicant's mark is essentially a transposition of registrant's marks.

As to applicant's argument that the marks have different connotations, we cannot agree that consumers will ascribe the connotations suggested by applicant to these marks. Consumers may well see applicant's mark ONETRAVEL.COM and registrant's marks TRAVEL ONE and TRAVEL ONE and design as suggesting the first or number one in travel.

Further, it must be remembered that in determining whether marks are similar, a side-by-side comparison of the marks is not the proper test. Rather, it is the overall commercial impression of the marks, which will be recalled over a period of time by the average consumer, that must be taken into account.

Finally, although we did not consider the lists of registrations/applications submitted by applicant, we have not overlooked the obviously descriptive/generic nature of the word “travel” for travel agency services and the laudatory nature of the number “one”. However, even weak marks are entitled to protection against confusingly similar marks. In this case, applicant and registrant’s marks are substantially similar and the services are identical.

In sum, based on the substantial similarity in the marks, the identity of the services, trade channels and purchasers, we find that there is a likelihood that consumers would be confused if applicant were to use the mark ONETRAVEL.COM in connection with travel agency and associated services offered on an interactive web site in view of the previously registered marks TRAVEL ONE and TRAVEL ONE and design for travel agency services.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed in both Classes 39 and 42.