

THIS DECISION IS NOT
CITABLE AS PRECEDENT OF
THE TTAB

April 17, 1997

Hearing:
May 28, 1996

Paper No. 25
JER

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

U-Haul International, Inc.
v.
Isaac Mendelovich, Maurry M. Mendelovich,
and Michael Shawn Mendelovich

Opposition No. 91,381
to application Serial No. 74/322,631
filed on October 14, 1992

Rod S. Berman and Elizabeth Barrowman Gibson of Jeffer,
Mangels, Butler & Marmaro for opposer.

Jay K. Meadway, Roberta Jacobs-Meadway, and Michael L.
Lovitz of Panitch Schwarze Jacobs & Nadel, P.C. for
applicants.

Before Rice, Simms, and Quinn, Administrative Trademark
Judges.

Opinion by Rice, Administrative Trademark Judge:

An intent-to-use application has been filed by Isaac
Mendelovich, Maurry M. Mendelovich, and Michael Shawn
Mendelovich, U.S. citizens, to register the mark U-CARD for
credit card services.¹

¹ Application Serial No. 74/322,631, filed October 14, 1992
under the provisions of Section 1(b) of the Trademark Act of

Registration has been opposed by U-Haul International, Inc., which alleges prior use of the trade names U-HAUL INTERNATIONAL, INC. and U-HAUL in connection with vehicle rental services; prior use of the letter U by itself and in combination with descriptive terms such as HAUL, MOVE, and STORE (the "U-" prefix marks) for those services; prior use of the marks U-HAUL, U-HAUL MOVING & STORAGE & Design, U-MOVE U-STORE U-HAUL RENTALS & Design, and U & Design, all for vehicle rental services, U-HAUL HAS IT ALL for retail store services in the field of truck and automobile hitches, and U-HAUL TRUCK SALES OUTLET for retail outlet services featuring trucks and trailers; ownership of registrations of its marks;² that opposer's "U-" prefix marks have become

1946, 15 U.S.C. §1051(b), based on applicants' assertion of a bona fide intention to use the mark in commerce.

² Opposer pleaded ownership of nine registrations. However, only two of them were made of record by opposer. They are Registration No. 795,733, issued September 7, 1965 under the provisions of Section 2(f) of the Act, 15 U.S.C. §1052(f), for the mark U-HAUL for rental of automobile freight trailers, Section 8 affidavit accepted, Section 15 affidavit received, and once renewed; and Registration No. 1,127,296, issued December 4, 1979 for the mark U-MOVE U-STORE U-HAUL RENTALS & Des. (RENTALS disclaimed) for truck and trailer rental and warehouse storage services, Section 8 affidavit accepted, Section 15 affidavit received. Opposer also made of record four additional registrations which were not pleaded in the notice of opposition. They are Registration No. 893,891, issued June 30, 1970 for the mark U-HAUL in stylized form for truck and automobile trailer rentals, Section 8 affidavit accepted, Section 15 affidavit received, and once renewed; Registration No. 1,094,740, issued June 27, 1978 for the mark U-HAUL & Design for truck and automobile trailer rentals and warehouse storage services, Section 8 affidavit accepted, Section 15 affidavit received; Registration No. 1,380,788, issued January 28, 1986 under the provisions of Section 2(f) for the mark U-MOVE for truck and trailer rental services, Section 8 affidavit accepted, Section 15 affidavit received; and Registration No. 1,432,341, issued March 10, 1987 for the mark RENT IT ALL AT U-HAUL (RENT disclaimed) for "rental of trucks, automobile, truck, trailers

famous; that the public has come to recognize the "U-" prefix marks as being in a family of marks belonging solely to opposer; and likelihood of confusion, both with respect to opposer's individual "U-" prefix names and marks, and with respect to opposer's pleaded family of "U-" prefix names and marks.

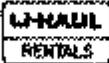
Applicants, in their answer to the notice of opposition, has denied all of the salient allegations contained therein.

The record consists of the pleadings; the file of applicants' subject application; copies of third-party registrations and printouts of articles from the NEXIS database, all made of record by applicants by notice of reliance; and testimony, with exhibits (including status and title copies of opposer's registrations) in behalf of opposer. Both parties filed briefs on the case and were represented at the oral hearing held on this case.

Opposer is essentially in the business of renting vehicles and associated equipment, such as trucks, trailers, and car top carriers, to do-it-yourself household movers. Opposer does business under the trade name U-HAUL INTERNATIONAL, INC. and the shortened form thereof, U-HAUL.

and recreational vehicles" [sic] and for rental of recreational home entertainment equipment and consumer products for use in the home and garden, Section 8 affidavit accepted, Section 15 affidavit received. Although these registrations are outside the pleadings, applicants have raised no objection to them, but rather, in their brief on the case, have treated them as being of record. Under the circumstances, we deem opposer's pleading to be amended pursuant to Rule 15(b) of the Federal Rules of Civil Procedure to assert the four additional registrations.

The business began in 1945, when a predecessor of opposer (hereafter, the term "opposer" is used to refer to both opposer and its predecessors) started to rent out trailers to do-it-yourself household movers. That same year, opposer began to use the marks U-HAUL and U-MOVE in connection with this business, and both marks are still in use. According to the testimony of Mr. Layton John Baker, a vice president of opposer, opposer has also extensively used the mark U-STORE. In addition, opposer's registrations are prima facie evidence of opposer's continuous use of the mark RENT IT ALL AT U-HAUL since April 28, 1986 in connection with the rental of trucks, automobile trailers and recreational vehicles, and the rental of recreational, home entertainment equipment and consumer products for use in the home and garden, and of the mark U-MOVE U-STORE U-HAUL RENTALS and design, shown below, since May 31, 1978 in connection with truck and trailer rental and warehouse storage services.

U-MOVE  **U-STORE**

The record shows that opposer's mark U-HAUL has been very extensively used and advertised in connection with its truck and trailer rental services over a period of many years, with the result that the mark has become famous for

these services.³ The same is not true with respect to opposer's other pleaded "U-" prefix marks, however, nor is the evidence of record sufficient to show that opposer has established a family of marks characterized by the "U-" prefix.⁴

Opposer has a field organization of approximately 1100 company-owned U-HAUL centers located across the United States and Canada. In addition, there are almost 12,000 independent U-HAUL dealers, who have other businesses of their own, and rent out U-HAUL equipment (for which they are paid a commission) as a secondary business. In 1981, opposer put a computer system in its company stores. The system was referred to as U-NET. In about 1992, opposer began to operate a new computer system in the field. The

³ Applicants do not contend otherwise, but rather state, on page 9 of their brief on the case, "[A]pplicants do not dispute that Opposer's 'U-HAUL' mark has become famous in conjunction with renting trucks and trailers services for do-it-yourself residential moving activities."

⁴ It is well settled that merely adopting, using, and registering a group of marks having a particular feature in common for similar or related goods and/or services is insufficient to prove ownership of a family of marks. In order to establish a family of marks characterized by a particular feature, it must be demonstrated that the various marks said to constitute the family, or at least a goodly number of them, have been used and promoted together in such a manner and to such an extent as to create among purchasers an association of common ownership based upon the family characteristic. See, for example, *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991); *Hester Industries Inc. v. Tyson Foods Inc.*, 2 USPQ2d 1646 (TTAB 1987); and *U.S. Plywood-Champion Papers Inc. v. Novagard Corp.*, 179 USPQ 561 (TTAB 1973). In this case, the evidence falls far short of what is necessary to prove ownership of a family of marks.

new system is referred as U-HAUL B.E.S.T.,⁵ or U-B.E.S.T. for short.

Because opposer has a large inventory of equipment, it looked at computer systems for an inexpensive way of keeping track of inventory, and found that a credit card terminal could be used for this purpose. Opposer purchased some of these terminals, which are far less expensive than a regular computer system, for U-HAUL dealerships that do not do enough business to justify giving them a regular computer system. A pilot program involving use of the credit card terminals for inventory control purposes, as well as for credit card authorization and credit card rentals, began in the summer of 1993. By October of 1994, when Mr. Baker's testimony was taken, opposer had 232 of the terminals operating at dealerships across the country. The machines consist of a small credit card terminal with a small keyboard, hooked up over a modem to an electronic clearinghouse which does credit card processing for banks. Opposer and its dealers refer to the credit card terminal system as U-HAUL C.A.R.D.,⁶ or sometimes U-C.A.R.D. for short.⁷

⁵ Mr. Baker testified that the letters B.E.S.T. stand for "Banking Electronic Summary of Transactions."

⁶ Mr. Baker testified that the letters C.A.R.D. stand for "Credit Authorized Receiving and Dispatching."

⁷ No mention was made in opposer's pleading of the terms U-NET, U-HAUL B.E.S.T., U-B.E.S.T., U-HAUL C.A.R.D., or U-C.A.R.D. However, applicants have not objected to these terms as being outside the pleadings, and have treated the evidence relating to at least the terms U-HAUL C.A.R.D. and U-C.A.R.D. on its merits. Accordingly, we deem opposer's pleading to be amended, pursuant

In response to a question as to whether opposer has plans to expand its business to include credit card services, Mr. Baker replied in the affirmative. However, he gave no details concerning these plans. Instead, his "[Y]es" answer was followed immediately by the sentence "[W]e're actually operating right now a credit card terminal, which we call U-Haul C.A.R.D.", as he launched into his testimony about the U-HAUL C.A.R.D. inventory control and credit card transaction system.

Applicants' evidentiary record consists of certified status and title copies of 12 subsisting third-party registrations of marks containing a "U" prefix for banking or related financial services or for vehicle rental or related transportation services,⁸ as well as copies of 25

to Rule 15(b) of the Federal Rules of Civil Procedure, to include these matters.

⁸ Opposer has moved to strike the third-party registrations on the ground that they are irrelevant and of no probative value in the absence of evidence that the marks shown therein are in use. While it is true that third-party registrations, the marks of which have not been shown to be in actual use, are incompetent to establish that two specific marks are or are not confusingly similar, they may be relied on to show the meaning of a mark, or a portion thereof, in the same way that dictionaries are used; that is, they provide at least some evidence that a term which is common to the marks has a readily understood meaning, that it has descriptive or suggestive properties as applied to certain goods or services, and hence that differences in other portions of the marks may be sufficient to render the marks as wholes distinguishable. See *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742 (TTAB 1992); and *United Foods Inc. v. J.R. Simplot Co.*, 4 USPQ2d 1172 (TTAB 1987). Accordingly, opposer's motion to strike is denied.

The third-party registrations made of record by applicants are Reg. No. 1,231,374 for the mark U-SAVE AUTO RENTAL OF AMERICA WE RENT FOR LESS and design for leasing and rental of automobiles,

articles from the NEXIS database, which articles include references to names and marks containing a "U" prefix.⁹

Reg. No. 1,802,270 for the mark U-SAVE AUTO RENTAL and design for, inter alia, automobile rental services, and Reg. No. 1,807,895 for the mark U-SAVE AUTO RENTAL for, inter alia, automobile rental services, all issued to U-Save Auto Rental of America, Inc.; Reg. No. 1,438,686 for the mark U HELP and design for providing loans, grants, and management of funds to assist with academic and other needs of individuals; Reg. No. 1,450,037 for U D CIDE for consumer loan service; Reg. No. 1,514,846 for U CALL for provision of bank account information over the telephone directly from a computer to customers; Reg. No. 1,575,492 for U-SHOW for real estate brokerage services; Reg. No. 1,670,489 for U-LINC for banking services rendered via computer; Reg. No. 1,780,566 for UVEST for securities brokerage services; Reg. No. 1,796,626 for ROADSTERS U-DRIVE BRANSON, MO. and design for, inter alia, rental of classic automobiles; Reg. No. 1,804,748 for UBANK CHECK CARD U.S. BANK and design for banking services featuring automated teller machine services, debit card services and check guarantee card services; and Reg. No. 1,806,903 for U-PACK for transportation services, namely, freight forwarding the goods of others by truck, ship and air.

⁹ Opposer has moved to strike this evidence on hearsay grounds. Although the articles are not probative for the truth of the matters asserted, those articles which were published in magazines, newspapers, and other such printed publications have probative value to the extent that they show common use of "U" prefix names and marks in articles, and resulting exposure of readers of the articles to those names and marks. Cf. *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987). These articles are relevant to the question of how such terms may be perceived by the public. The news service stories, on the other hand, are of more limited probative value, because in the absence of evidence that these stories were picked up and published in a newspaper, magazine, or other printed publication of general circulation, these stories are evidence only of the fact that their authors used (and thus apparently were familiar with) particular names or marks in their writings, and that the editors to whom the stories were circulated were exposed to the names or marks. Cf. *In re Manco Inc.*, 24 USPQ2d 1938 (TTAB 1992), and *In re Men's International Professional Tennis Council*, 1 USPQ2d 1917 (TTAB 1986). Thus, opposer's motion to strike is denied, but the articles in question have not been considered for the truth of the statements contained therein, and the newswire articles have been given very little consideration. We add that even if we did not consider the NEXIS materials at all, we would still reach the same conclusion on the issue of likelihood of confusion presented herein.

Examples of the names and marks mentioned in the NEXIS articles, along with the activities in connection with which they are mentioned, include a company named "U-Max Data System,

The record clearly establishes opposer's standing and its priority of use of the registered marks made of record herein. Thus, the only issue to be determined herein is the issue of likelihood of confusion.

Because opposer has failed to prove its ownership of a family of marks, the issue of likelihood of confusion must be determined by comparing applicants' mark to each of opposer's marks considered individually. The most pertinent of these marks is the mark U-HAUL, i.e., the mark as to which opposer has shown fame.

Comparing applicants' mark U-CARD to opposer's mark U-HAUL, they are similar in that each consists of the prefix "U-" followed by a term which is highly suggestive or merely descriptive. However, opposer has failed to prove that it owns a family of "U-" prefix marks, and the record shows that opposer's use of the letter "U" as a substitute for the word "YOU" is neither unique nor arbitrary.¹⁰ Considered in

Inc."; "USurvey" computer program; "Spector SPRAY-U-TRIM" mouth spray appetite suppressant; "Help U File" legal services company; "U-Save Auto Rental" automobile rental services; "UVEST Investment Services" mutual fund and other investment services; "U2 Wear Me Out" leather and textile products; "U Pick Parts" junkyard; "U-Can" consumer advocacy group; "U-Can-Rent, Inc." rent-to-own store; "Hertz U-Drive-It" car-for-hire firm; "U/Install" computer software for installing the Unix operating system; "UBANK" banking services; and "U Fuel" automated fueling systems.

¹⁰ It is settled that the Board may take judicial notice of dictionary definitions [*B.V.D. Licensing Corp. v. Body Action Design Inc.*, 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988)], and in this case we take judicial notice that in The Random House Dictionary of the English Language (Second Edition Unabridged 1987), there appears the following entry for the capital letter

their entireties, the marks U-CARD and U-HAUL are substantially different in sound, appearance, and meaning. Moreover, the services in connection with which opposer's mark is used, and the services in connection with which applicants' mark is intended to be used, are entirely different. The mere fact that opposer's services may be paid for by credit card does not mean that opposer's services are related to credit card services for purposes of determining likelihood of confusion.

Turning to the unregistered term U-HAUL C.A.R.D., sometimes shortened to U-C.A.R.D., opposer has failed to show use of this term prior to applicants' filing date, and the term is not used by opposer as a mark for a service rendered to the public. Rather, it is a term used by opposer and its dealers to refer to an in-house credit card terminal system used by opposer and its dealers for inventory control and for credit card transactions. There is no evidence that this term would ever be encountered by members of the public. Nor is there any evidence that credit card services are within opposer's area of normal expansion.¹¹ Moreover, Mr. Baker's testimony that opposer has plans to expand its business to include credit card services is too bare to have any real value.¹² That is, the

"U": *"pronoun. Pron. Spelling. you: Shoes Fixed While U Wait."*

¹¹ See, in this regard, *Mason Engineering and Design Corp. v. Mateson Chemical Corp.*, 225 USPQ 956 (TTAB 1985).

¹² Indeed, because Mr. Baker, in response to the question, immediately launched into his testimony about opposer's U-HAUL

testimony includes no details or information about specific plans to expand.

For the foregoing reasons, and notwithstanding the fame of opposer's mark U-HAUL for its truck and trailer rental services, we are not persuaded that there is any likelihood of confusion in this case.¹³

C.A.R.D. inventory control and credit card transaction system, it is not even clear that he fully understood the question which elicited his testimony on the point.

¹³ For similar reasons, we find no likelihood of confusion with respect to each of opposer's other marks.

Decision: The opposition is dismissed.

J. E. Rice

R. L. Simms

T. J. Quinn
Administrative Trademark
Judges, Trademark Trial
and Appeal Board