

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

AUG. 21, 97

Paper No.
BPR/NSD

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AmeriSpec, Inc.
v.
David E. Cook

Opposition No. 97,494
to application Serial No. 74/510,708
filed on April 11, 1994

James P. Quinn of Larkin, Hoffman, Daly & Lindgren, Ltd. for
AmeriSpec, Inc.

David E. Cook, pro se.

Before Simms, Hairston and Walters, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

AmeriSpec, Inc. (opposer), a California corporation,
has opposed the application of David E. Cook (applicant) to
register the mark shown below for home inspection services.¹

¹Application Serial No. 74/510,708, filed April 11, 1994,
claiming use and use in commerce since July 15, 1993. In the
application, applicant has disclaimed the words "America's Home
Inspection Service."



Opposer has pleaded that applicant's mark so resembles opposer's previously used and registered mark AMERISPEC, used since 1987 in connection with home inspection services, as to be likely to cause confusion, to cause mistake or to deceive. In the notice of opposition, opposer pleaded ownership of six registrations, including the marks shown below.²



AMERISPEC

[PF NOTE:should read AMERISPEC HOME
INSPECTION SERVICE]

In its answer, applicant has denied the essential allegations of the notice of opposition.

The record of this case includes testimony (and exhibits) submitted on behalf of opposer as well as status and title copies of opposer's six pleaded registrations,

²Registration No. 1,497,266, issued July 19, 1988, and Registration No. 1,806,582, issued November 23, 1993. The words "HOME INSPECTION SERVICE" have been disclaimed.

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submitted pursuant to notice of reliance. Applicant has submitted no testimony or other evidence during his time for taking testimony.

As a preliminary matter, we shall rule upon applicant's motion to strike part of the Elizabeth Shaffer deposition as well as applicant's motion to strike the David Cook deposition taken by opposer. With respect to the first motion to strike, it appears from the affidavit of the court reporter that there was a transcription error which attributed statements of the witness to counsel for opposer. Accordingly, because the pertinent part of the Shaffer deposition was not, in fact, the testimony of the attorney but rather the witness's, applicant's hearsay objection to this testimony on this basis is not well taken. However, because the witness testified on the basis of what she was told by a franchisee, the testimony bridging pages 35-36 of her deposition is hearsay.

Applicant has also moved to strike his own deposition taken by opposer as part of opposer's trial testimony. Applicant argues that his entire testimony should be stricken because opposer's counsel failed to allow him to clarify his responses after the direct examination was concluded. Applicant contends that the testimony is therefore biased and unfair. Opposer, on the other hand, states that counsel objected to the witness's attempt to "clarify" his testimony by giving a narrative statement. Counsel informed the witness during the deposition that it

was not proper for him to give such a statement but counsel stated that he had no objection to cross-examination which was within the scope of the direct examination. Opposer notes that applicant has not objected to the direct examination per se and that applicant could have introduced testimony on his own behalf during his testimony period.³ For the reasons recited by opposer, applicant's motion to strike this deposition is denied.

Finally, with respect to the testimony of opposer's former franchisee, Gary Hambrick, as applicant has pointed out in his brief, applicant submitted no trial testimony and other evidence and, accordingly, this "rebuttal" testimony is disallowed.

According to the testimony of Elizabeth Shaffer, opposer's director of marketing, opposer has used its mark in connection with home inspection services since 1987. Opposer offers its services to home buyers, home sellers, real estate agents and buyers and sellers of commercial property. Opposer promotes its services by way of direct mail (over 1 million pieces per year), by brochures (millions per year), postcards (about 500,000 per year), by fliers (millions per year), by ads placed in real estate trade magazines, at real estate conventions, in yellow page

³ According to the deposition (pp. 109-13), it appears that the witness wanted to testify concerning the dissimilarities between the marks. Of course, the similarities and dissimilarities are quite apparent from mere observation and we see no prejudice to applicant as a result of the lack of "testimony" concerning any dissimilarities.

advertisements and by way of specialty items. Opposer spends at least \$1/2 million per year in advertising. According to Ms. Shaffer, opposer has 260 franchisees and issues about 80,000 home inspection reports per year. Opposer is the largest home inspection business in this country with more offices and more home inspections than anyone else. She testified that the mark "AMERISPEC" is famous in the industry. Concerning misdirected mail and other examples of confusion, Ms. Shaffer testified as follows, 34-35:

Q And have you seen that misdirected mail yourself?

A Yes.

Q And how do customers and clients tend to misread or mispronounce the AmeriSpec name?

A Well, we regularly get people that will say, "Is this America Home Inspection Service," or, "Is this Amerispect Home Inspection Service," or some other close version.

Q So is it your testimony that with respect to the mistakes that clients and customers make, it's with respect to the last syllable of the word AmeriSpec?

A Yes.

Q Okay. Sitting here today, can you think of specific examples in which that has occurred?

A Yes. One specific example that I can think of just off the top of my head was even with one of our vendors, we have a specialty item vendors that produced specialty items with our actual service mark on them. After they had produced them, they packaged them up, boxed them up to distribute to our system, and labeled them with America's Home Inspection Service. Even though they produced our pieces with our mark, and had certainly seen it and knew our name, they made the honest mistake. And they went out as America's Home Inspection Service.

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During his deposition, Mr. Cook testified that he offers his services under the mark sought to be registered to homeowners, home sellers, home buyers and commercial real estate buyers in and near Billings, Montana, and advertises his services in newspapers, by brochures, business cards and specialty items. He started using his mark in July 1993, and first learned of opposer in November 1994 from one of its franchisees. He is aware of no instances of actual confusion between opposer's mark and applicant's.

Among other things, opposer contends that the respective marks are confusingly similar because the word portions are virtually identical, differing only in the fourth syllable of the first word ("--Spec" vs. "--CA'S"), that both contain an outline of a roof of a house, both have a representation of a star of some sort, and are presented on brochures with a red background. Opposer also maintains that its mark is a famous one in the industry entitled to a broad scope of protection and that, when the respective marks are used on identical services purchased on impulse under tight time constraints, confusion is likely.

Applicant, on the other hand, argues that the respective marks are different, with opposer's mark appearing to be a bird with a beak while applicant's simulates a house with a roof. With respect to the literal portions of the marks, applicant argues among other things that the "AmeriSpec" portion of opposer's marks may stand

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alone but that the word "AMERICA'S" in applicant's mark must be read with the other words in his mark.

There is no dispute that opposer has priority of use. Moreover, opposer's registrations mean that priority is not an issue in this case.

Upon careful consideration of the record and the arguments of the parties, we believe that, although the respective services must be considered, for our purposes, legally identical, there are sufficient differences in the marks that confusion is not likely. In this regard, while the marks must, of course, be compared in their entireties, less weight may be given to descriptive or generic matter-- in this case, the common generic wording of applicant's mark and one of opposer's marks, "HOME INSPECTION SERVICE". (As noted above, these words have been disclaimed in opposer's registration and the entire wording of applicant's mark has been disclaimed.) When the marks are compared, we agree with applicant that they are different in appearance and would be pronounced differently. While opposer states that its marks contain an image of a portion of a star, it is not at all clear to us that purchasers or potential purchasers would so perceive this aspect of opposer's marks. Moreover, the marks have otherwise completely different commercial impressions, applicant's mark clearly containing the inverted "V" image of a house's roof line over the descriptive words "AMERICA'S HOME INSPECTION SERVICE". While opposer's mark may be well known in the field, we

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believe that the differences in the marks simply outweigh their similarities such that confusion is not likely. We have considered opposer's other arguments but find them unpersuasive of a different result.

Decision: The opposition is dismissed.

R. L. Simms

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges
Trademark Trial and Appeal
Board