

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

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Paper No. 43
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Facts On File, Inc.
v.
Credit Bureau of Baton Rouge, Inc.

Opposition No. 92,808
to application Serial No. 74/254,269
filed on March 11, 1992

David A. Einhorn of Anderson, Kill & Olick, P.C. for Facts
On File, Inc.

Claude F. Reynaud, Jr. of Breazeale, Sachse & Wilson, L.L.P.
for Credit Bureau of Baton Rouge, Inc.

Before Simms, Quinn and Hairston, Administrative Trademark
Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Credit Bureau of Baton
Rouge, Inc. to register the mark shown below



credit inquiry and consultation."¹

4/254,269 filed March 11, 1992;
e of June 1, 1991. The application

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Registration has been opposed by Facts on File, Inc. on the grounds that (1) applicant's mark, when used in connection with applicant's services, so resembles opposer's previously used and registered mark shown below



periodical publications; namely, es, atlases, treatises and loose ds of medicine, health, history, , business, finance, sports, vel, art, music, food, science, rtainment, education, criminology, opment"² as to be likely to cause

confusion under Section 2(d) of the Trademark Act; and (2) applicant is not the owner of mark sought to be registered and, therefore, the application is void ab initio.³

Applicant, in its answer, denied the salient allegations of likelihood of confusion. The answer was deemed amended to deny the allegation that applicant is not the owner of the mark sought to be registered.

includes the following statement: "The drawing is lined for the colors yellow and red."

² Registration No. 1,721,863, issued October 6, 1992. A certified copy of opposer's pleaded registration was attached to the notice of opposition.

³ The notice of opposition was deemed amended to include this additional ground. Also, by way of a consented motion to amend, opposer amended the notice of opposition to assert that applicant's services were not rendered in interstate commerce prior to the filing date of the involved application and that, therefore, the application is void ab initio. Summary judgment was granted in applicant's favor on this claim.

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At the outset, we should point out that the parties, through their attorneys, stipulated (1) to the authenticity of all documents produced during the course of discovery and (2) that testimony could be submitted by affidavit. The parties reserved the right to object to any testimony, exhibits or documents on the grounds of relevance and materiality. In this regard, we note that each party has objected to certain of the other party's testimony and exhibits as irrelevant, hearsay, stating legal conclusions, etc. We have reviewed these objections and given them such consideration and weight, if any, as we considered to be warranted, noting that in no case would the inclusion or exclusion of such testimony be critical to our decision in this opposition. Several specific objections, however, require discussion.

Opposer submitted under notice of reliance copies of a personal service contract between applicant and a third-party APPRO Systems, Inc., and an agreement between applicant and its executive officers Kenneth and Steve Uffman. Copies of the contract and agreement were produced by applicant in response to opposer's request for production of documents. It is applicant's position that documents which are obtained in response to a request for production of documents, may not be made of record by notice of reliance. A party which has obtained documents under Fed.

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R. Civ. P. 34 may serve upon its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under Trademark Rule 2.120(j)(3)(i), on the request for admission, the exhibits thereto, and its adversary's admissions. In this case, since the parties' stipulation to the authenticity of documents produced during the course of discovery is in effect, an admission of the authenticity of documents, the contract and agreement may be submitted by opposer under notice of reliance.

Applicant also submitted under notice of reliance a copy of the U.S. Patent and Trademark Office ORBIT Trademark Retrieval System TMARK User Guide. This guide is used by Trademark Examining Attorneys to conduct searches of marks in the Office's Trademark Automated Search System (T-Search). One of the categories of designs in the guide is "check marks" and applicant has submitted the guide to show that marks comprising check marks are weak marks. However, as opposer correctly points out, this guide is not a printed publication or an official record within the meaning of Trademark Rule 2.122(e). Thus, opposer's objection to the guide is well taken and the guide will be given no consideration in our decision herein.

Finally, opposer has objected to portions of the affidavits of applicant's witnesses which concern ownership

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of the mark sought to be registered. Opposer contends that this testimony is barred by the parole evidence rule because it is clear from the above mentioned contract and agreement that applicant is not the owner of the mark sought to be registered. We believe that the language of the contract and agreement is ambiguous, and therefore we have considered the statements in the affidavits which concern ownership of the mark.

Thus, the record in this case consists of the pleadings; the file of the involved application; a certified copy of opposer's pleaded registration; the affidavit of opposer's witness Beverly Balaz (with exhibits); opposer's notice of reliance on applicant's responses to discovery requests; the affidavits of applicant's witnesses John Albert, Kenneth Uffman, and Steven Uffman (with exhibits); and applicant's notice of reliance on, inter alia, copies of third-party registrations.

Opposer publishes and distributes books, periodical publications and CD-ROMS in a wide range of fields, including the business and financial field. According to opposer's president, Beverly Balaz, opposer has used its check mark design since 1975 on all of its books, electronic products, periodical publications, catalogs, and

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advertising. According to Ms. Balaz, the check mark design trademark appears on over 3,000,000 items annually. Opposer's annual advertising expenditures total 1.5 million dollars and its sales approximately fifteen million dollars. Opposer has customers in all fifty states ranging from individual consumers, school and public libraries to government agencies. Opposer's books are available through wholesalers, retail book stores and book clubs.

Applicant, through its Checkfax division, provides check authorization services and recovery systems. This service allows a business to inquire into the check writing history of a particular customer. The response from the system will allow a business to determine whether to accept a check or not. According to Mr. Albert, applicant has been operating this system since 1975. The record contains no details as to sales or promotional expenditures and activities for applicant's services.

Inasmuch as a certified copy of opposer's pleaded registration is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to the issue of likelihood of confusion. Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing

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

Insofar as the parties' respective goods and services are concerned, we start with the premise that they need not be competitive to support a holding of likelihood of confusion. It is sufficient that the goods/services are related or that conditions surrounding their marketing are such that they are encountered by the same persons who, because of the relatedness of the services and similarities of the marks, would believe mistakenly that the goods/services originate from or are in some way associated with the same producer. Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984). We find opposer's proofs to be totally lacking in this regard.

Opposer contends that confusion is likely because applicant's services, i.e., credit bureau or credit inquiry and consultation services, are financial in nature and thus related to opposer's publications in the business and financial field. Also, opposer argues that since its registration and the involved application contain no restrictions as to purchasers or trade channels, it must be assumed that both opposer's goods and applicant's services travel in the same channels of trade to the same purchasers.

In support of its position, opposer relies on Conde Nast Publications, Inc. v. Vogue Travel, Inc., 205 USPQ 579

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(TTAB 1979) [Defendant's use of VOGUE and design for travel agency services likely to cause confusion with plaintiff's registered mark VOGUE for a fashion magazine] and *Triangle Publications, Inc. v. Rohrllich, et al.*, 77 USPQ 196 (2d Cir. 1948) [Defendant's use of SEVENTEEN for girdles likely to cause confusion with plaintiff's registered mark SEVENTEEN for a girl's fashion magazine]. Each of these cases, however, is distinguishable. In *Conde Nast*, the Board held that there was a connection between defendant's travel agency services and plaintiff's well known fashion magazine because the magazine regularly featured a travel section; and in *Triangle Publications*, there was a connection between defendant's girdles and plaintiff's girls' fashion magazine because the magazine permitted tie-ins by advertisers of wearing apparel. In this case, there is no evidence that opposer's books or periodicals feature information about credit bureaus or credit inquiry and consultation, or that opposer does tie-ins with providers of such services.

Here, applicant's credit bureau or credit inquiry and consultation services are readily distinguishable from opposer's books and periodicals. Applicant's services are very specialized in nature and are utilized by businesses seeking information concerning an individual's credit history. The record is entirely devoid of any probative evidence to show why purchasers would be likely to assume

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that such services and books and periodicals, including those in the business and financial field, emanate from the same source.

Also, while there are no restrictions in either opposer's registration or the involved application with respect to purchasers and trade channels, the specialized nature of applicant's services is such that the services are directed to business owners and retailers, and not the general public. These individuals would be fairly sophisticated business people who would be able to distinguish between the two sources based on differences in the goods and services offered thereunder.

Here, opposer's claim of likelihood of confusion essentially fails for lack of proof. Notwithstanding the strength of opposer's mark, and any similarities between the parties' marks by virtue of the check mark designs, opposer's claim of likelihood of confusion essentially fails for lack of proof with respect to the relatedness of applicant's credit bureau or credit inquiry and consultation services and opposer's books and periodicals.

We turn next to the issue of whether applicant is the owner of the involved mark. In support of its contention that applicant is not the owner of the mark, opposer relies on the previously mentioned personal service contract dated April 1, 1987 between applicant and APPRO Systems, Inc. and

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an agreement (undated) between applicant and Kenneth and Steve Uffman. Opposer contends that it is clear from the terms of this contract and agreement that applicant is not the owner of the mark sought to be registered. In particular, opposer points to the following terms of the personal service contract as evidence that APPRO, and not applicant, controls the nature and quality of the services rendered under the mark.

Section 2.04: . . . APPRO shall have the right to determine and make sure that the services covered under this agreement are performed in a competent, efficient and satisfactory manner.

Section 2.06: . . . CREDIT BUREAU shall ensure that all of its undertakings hereunder are performed to the entire satisfaction of APPRO.

Further, opposer points to the following terms of the agreement as evidence that applicant has retained the right, as a licensee, to market services under the involved mark only within certain areas of the state of Louisiana.

WHEREAS, except for the financial backing of the Bureau, the Bureau has no claim or interest to the Checkfax and APPRO systems

. . .

Credit Bureau retains the right to market the Checkfax and APPRO systems in its operational area, which is defined to be:

East Baton Rouge	West Baton Rouge
Livingston	Ascension
Iberville	Point Coupee
West Feliciana	East Feliciana
Lafourche	St. Mary
Terrebonne	Tangipahoa

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Assumption
Washington

St. Helena

It is the intention of paragraphs (1) and (2) that the new corporation to be formed will have the exclusive rights to the ownership and marketing of the Checkfax and APPRO systems, reserving to Credit Bureau the full and complete right to market said systems within the territorial limit described above.

Applicant argues that, if anything, the contract and agreement are ambiguous, and that the testimony of applicant's witnesses make clear that applicant is indeed the owner of the mark sought to be registered. According to the testimony of these witnesses, and as confirmed by the terms of the personal service contract, APPRO Systems, Inc. is a corporation created in 1982 by applicant and its executive officers, Kenneth and Steve Uffman. Applicant owns 20% of APPRO and the Uffmans own the remaining 80%. Kenneth and Steve Uffman testified that APPRO is a related company which applicant has licensed to sell subscriptions for applicant's services in certain regions. Moreover, Mr. Albert testified that applicant has customers not only in Louisiana, but in Mississippi, North Carolina, and Alabama. Applicant made of record a copy of a license between it and Credit Bureau of Greensboro, North Carolina.

In this case, opposer is required to prove by a preponderance of the evidence that applicant is not the owner of the mark sought to be registered. We agree with

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applicant that the contract and agreement are ambiguous with respect to the issue of ownership, particularly inasmuch as neither even mentions the mark sought to be registered.

Under the circumstances, and in view of the testimony of applicant's witnesses, we cannot say that opposer has met its burden of establishing by a preponderance of the evidence that applicant is not the owner of the mark.

Decision: The opposition is dismissed.

R. L. Simms

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board