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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

29 MAY 1998

Hearing
July 17, 1997

Paper No. 27
PTH

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Success Holdings Company, LLC
v.
The Napoleon Hill Foundation

Stim S.

Opposition Nos. 97,379 and 97,470
to application Serial Nos. 74/500,658 and 74/500,660
both filed on March 15, 1994

Norman H. Zivin of Cooper & Dunham for Success Holdings
Company, LLC

Robert T. Johnson of Bell, Boyd & Lloyd for The Napoleon
Hill Foundation.

Before Seeherman, Quinn and Hairston, Administrative
Trademark Judges

Opinion by Hairston, Administrative Trademark Judge.

The Napoleon Hill Foundation has filed applications to
register the mark LAW OF SUCCESS for "education and
entertainment services, namely, providing workshops and
seminars relating to personal achievement and presenting
awards relating to personal achievement;"¹ and

¹ Application Serial No 74/500,658 filed March 15, 1994,
alleging a bona fide intention to use the mark in commerce

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"newsletters and printed teaching activity guides relating to personal achievement, calendars, diaries; [and] memorandum books."

Registration has been opposed by Success Holdings Company, LLC on the ground of likelihood of confusion between applicant's mark and opposer's previously used and registered marks. Opposer pleads ownership of the following valid and subsisting registered marks:



for "magazines pertaining to all aspects of personal, professional and financial achievement;" and



for "general interest magazines."¹ Opposer also alleges that it conducts educational workshops and seminars relating to personal, professional and financial achievement under and in association with the above SUCCESS marks.

¹ Application Serial No. 74/500,660 filed March 15, 1994, alleging a bona fide intention to use the mark in commerce.

Registration No 1,221,662 issued December 28, 1982, Sections 8 & 15 affidavit filed.

² Registration No 1,334,275 issued May 1, 1985; Sections 8 & 15 affidavit filed

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Applicant, in its answers, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the files of the involved applications; trial testimony taken by both parties (and related exhibits); certified status and title copies of opposer's pleaded registrations; and applicant's notice of reliance on third-party applications and registrations of marks which include the word "success." Also, opposer submitted notices of reliance on, inter alia, excerpts of newspaper articles to show the reputation of opposer's magazine among the relevant public; copies of final orders in fourteen Board proceedings which were resolved in opposer's favor as against applicants seeking to register marks which included the word "success", and certain of applicant's responses to opposer's interrogatories.

Both parties filed briefs on the case and were represented by counsel at the oral hearing.

At the outset, we note the parties' dispute regarding whether certain findings of the Board in a prior decision involving opposer's predecessor and a third-party are entitled to preclusive effect. Applicant claims issue preclusion with respect to the Board's findings in Opposition No. 89,762 that SUCCESS is a weak mark in connection with publications and that opposer's mark is not famous. Suffice it to say that because such issues as the

strength weakness and fame of a mark must be determined on the record in each case, the Board is not precluded from reaching different findings on these issues if presented with a different record herein.

The record shows that opposer's principal business is publishing SUCCESS magazine. The magazine provides readers with information relating to entrepreneurship, self-improvement, personal achievement, business matters and productivity. Opposer's predecessor acquired the magazine in 1984.⁵ The circulation of SUCCESS magazine has grown from 329,000 in 1984 to 471,000 copies in 1995.

In 1987 opposer began selling a variety of products to the readers of its magazine. Such products, which relate to entrepreneurship, include computer software, books, tapes and CD-ROMS. In 1994 opposer acquired Executive Gallery, a direct marketing mail order company, that provides products, services and information to business executives, businesses and entrepreneurs. Opposer also distributes a mail order catalog entitled SUCCESSTOOLS which features motivational products such as books, audio tapes, videotapes, and software. Opposer has sponsored two conferences, one in 1995 and the other in 1996, for individuals who want to

⁵ There is conflicting testimony with respect to publication of the magazine prior to this date. However, the record is clear that opposer and its predecessor have continuously published the magazine since at least as early as 1984, which precedes the filing date of applicant's intent-to-use applications. Moreover, as discussed *infra*, priority is not an issue.

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enhance their entrepreneurial skills. Approximately 500 individuals attended each conference.

Opposer spends approximately \$2 million annually on advertising and promotion. Opposer advertises in magazines, by direct mail, and at trade shows and special events.

Opposer also maintains a web site on the Internet.

Opposer's approximate annual revenue is \$20 million of which about a little more than half is attributable to the magazine. SUCCESS magazine has received favorable reviews in other magazines and newspapers and opposer's own market research shows strong loyalty to the magazine among its readers.

Applicant is a not-for-profit educational corporation which was formed in 1962 by Napoleon Hill and his wife Mr Hill, now deceased, is the author of a book entitled Law Of Success, first published in 1928. The book, which is still published, documents Mr. Hill's interviews with over 500 successful people, including Henry Ford, Thomas Edison, and John D. Rockefeller. Applicant's purpose is to perpetuate Mr. Hill philosophy's of personal achievement through books, courses and various publications. Applicant arranges for the publication of Mr Hill's works, creates new books based on his teachings, and conducts seminars which incorporate his philosophy. Applicant is a relatively small business,

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which during the two-year period of 1995 and 1996 had annual gross revenues of approximately \$500,000

Inasmuch as certified copies of opposer's pleaded registrations are 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. It is opposer's position that the newsletters and workshops and seminars applicant intends to offer under the mark LAW OF SUCCESS are related to opposer's SUCCESS magazine and seminars. In addition, opposer contends that the parties' marks are very similar due to the shared presence of the word SUCCESS. However, as demonstrated by the pertinent third-party registrations furnished by applicant, the word SUCCESS is highly suggestive of publications, such as magazines and newsletters, and seminars and workshops. Such registrations, like dictionary definitions, may be used to establish the meaning of a term as applied to particular goods and services and to show, in view thereof, that the inclusion of the term in the marks at issue is alone an

^ For example, among the marks which are registered for publications are SUCCESS SYSTEMS AT WORK, SUCCESS OPPORTUNITY SEEKERS - THE ADVERTISER, SMALL BUSINESS SUCCESS; SUCCESS EXPRESS, CONTINUED SUCCESS, and THE OFFICIAL GUIDE TO SUCCESS. Among the marks which are registered for workshops, seminars and the like are SUCCESS TALK, PERFORMANCE SUCCESS; SUCCESSAVVY; SUCCESS DYNAMICS, and the FEEL OF SUCCESS.

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insufficient basis on which to predicate a holding of likelihood of confusion. See *Tektronix, Inc v Daktronics, Inc*, 137 USPQ 588, 592 (TTAB 1975), *aff'd*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976). Here, the third-party registrations are competent to show that others in the field have adopted and registered marks consisting of the word "success" and that as used therein the term projects its dictionary meaning of "[t]he achievement of something desired, planned or attempted." Consequently, and notwithstanding the considerable strength of opposer's SUCCESS mark, the mere fact that applicant's mark incorporates the same term does not mean that applicant's mark is sufficiently similar to opposer's mark as to be likely to cause confusion.

Here, the presence of the words "LAW OF" in applicant's mark creates a mark which is readily distinguishable in sound, appearance and commercial impression from opposer's SUCCESS mark. In the latter regard, LAW OF SUCCESS suggests rules or principles which lead to success. Thus, notwithstanding any similarities between the parties' goods and services, we find that there is no likelihood of confusion.

The American Heritage Dictionary Of The English Language, (1976) at 1235. The Board may properly take judicial notice of dictionary definitions.

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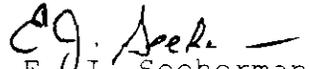
Opposer argues that its SUCCESS mark is famous for magazines. While it appears that opposer has enjoyed a good degree of success, we are not persuaded on this record that opposer's marks are so famous in the field as to preclude the registrations sought by applicant. Cf. Kenner Parker Toys, Inc. v. Rose Art Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992).

An argument made by applicant requires comment, although it does not affect our decision herein. Applicant argues that opposer should be estopped from bringing these oppositions because opposer did not oppose applicant's application for the mark LAW OF SUCCESS for pre-recorded audio and video cassettes relating to personal achievement and has not sought to cancel applicant's registration for the mark SCIENCE OF SUCCESS for educational services. In order to invoke the "Morehouse" defense, both the mark and the goods/services in the prior registration must be substantially identical to the mark and the goods/services which are the subject of the present application. Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969) and TBC Corp. v. Grand Prix, Ltd., 12 USPQ2d 1311 (TTAB 1989). The defense is inapplicable here because an application cannot serve as the basis for the defense, and the mark SCIENCE OF SUCCESS in applicant's registration is not substantially identical to the mark LAW OF SUCCESS,.

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In view of the highly suggestive nature of the word "success" as used in connection with publications and workshops and seminars, and the differences in the marks SUCCESS and LAW OF SUCCESS, we conclude that confusion as to the origin or affiliation of the parties' respective goods and services is not likely to occur.

Decision: The opposition is dismissed.


E. J. Seeherman


T. J. Quinn



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