

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB OCT. 27, 99
U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Daniel L. Kegan doing business as Elan Associates
v.
Marc S. Lane

Opposition No. 102,966
to application Serial No. 74/678,682
filed on May 22, 1995

Daniel L. Kegan of Kegan & Kegan for Daniel L. Kegan d/b/a
Elan Associates.

Mark S. Lane, pro se.

Before Simms, Cissel and Bottorff, Administrative Trademark
Judges.

Opinion by Simms, Administrative Trademark Judge:

Daniel L. Kegan (opposer), doing business as Elan Associates, has opposed the application of Marc S. Lane to register the mark LINEGUIDE for computer services, namely, providing access to a computer bulletin board service providing a wide range of information over a global online information network.¹ In the notice of opposition, opposer

¹ Application Serial No. 74/678,682, filed May 22, 1995, claiming use in commerce since May 1, 1995.

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asserts ownership of the registered mark MACGUIDE (Registration No. 1,522,579, issued January 31, 1989) for magazines directed to the computer community, as well as ownership of a number of GUIDE-suffixed marks such as PCGUIDE, CD-ROMGUIDE, POWERGUIDE, WINGUIDE and OPENGUIDE for computer-oriented products and services; that opposer is in fact the owner of a -GUIDE family of marks with the first word "evocative" of a "computer issue"; that opposer's MACGUIDE magazine pioneered independent online computerized information with opposer's MacGuide online information service; that opposer's magazine has marketed software under the MacGuide trademark; that opposer has spent several millions of dollars in connection with the advertising and promotion of goods and services under the mark MacGuide; that opposer's goods and services and applicant's services are closely related information services oriented to computers and to high technology; and that applicant's mark used in connection with applicant's services so resembles opposer's previously used marks as to be likely to cause confusion, to cause mistake or to deceive.

In his answer, applicant has denied the essential allegations of the notice of opposition. However, applicant has admitted that his services are offered at no or low cost (one of opposer's allegations). Further, applicant asserts that opposer does not have exclusive rights in the -GUIDE

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suffix, which applicant claims is frequently used with various prefixes in the computer and business industries. Applicant also asserts that opposer's marks are not suggestive of online or network services, whereas applicant's prefix ("LINE-") does connote online services. Finally, applicant alleges that opposer's goods are directed to Apple and Macintosh computer users, who are sophisticated consumers.

The record of this case consists of testimony (and exhibits) taken by both parties, and notices of reliance submitted by both parties, as well as the application file. The parties have submitted briefs but no oral hearing was requested.

Opposer and Opposer's Record

Opposer, Mr. Daniel Kegan, testified that MacGuide Magazine, Inc. began publishing the MACGUIDE magazine in 1985 (dep., 168). This magazine has been distributed in a number of ways including being sold at newsstands, on CD-ROMs and more recently being available online and on the Internet computer network. The MacGuide mark has also been used in connection with software, credit card services and hotel and travel services (Kegan dep., 39), although opposer has apparently discontinued use of the mark in connection with credit card, hotel and travel services. Opposer's predecessor spent over \$4 million promoting this and other

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marks which end in the suffix GUIDE. Dep. 186. Mr. Kegan testified that, in March 1994, he obtained the mark MACGUIDE as well as such other marks for publications as HYPERGUIDE, PCGUIDE and CD-ROMGUIDE as a result of the bankruptcy of opposer's predecessor. Opposer has continued to publish a magazine and/or newsletter under the mark MACGUIDE and has begun use of other -GUIDE marks such as OPENGUIDE, WINGUIDE and POWERGUIDE. According to the testimony, over 100,000 MACGUIDE magazines and other MACGUIDE products have been distributed over the years by a licensee of opposer.

Although at one time opposer's publications (and services) were directed primarily to Apple and Macintosh computer users, opposer's focus has recently expanded. Also, since this proceeding commenced, opposer's pleaded OPENGUIDE, WINGUIDE and POWERGUIDE marks have now become registered. Opposer has also applied to register the marks WEBGUIDE, NEXGUIDE and HYPERGUIDE. Opposer's trademarks have appeared together on computer disks and on opposer's Web site. Opposer does not currently conduct paid advertising under its marks.

According to Mr. Kegan's testimony, opposer's -GUIDE marks have also been used together at trade shows. Mr. Kegan also testified that recipients of its publications have received several of these magazines together, such as publications identified under the marks MACGUIDE, OPENGUIDE,

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POWERGUIDE, WINGUIDE and HYPERGUIDE. Kegan dep., 39, 110, 115. Opposer stated that he has continued to publish the MACGUIDE magazine since the mark was acquired in 1994. The magazine is not sold on newsstands (dep., 239-240), but is available in computer retail stores and has been distributed at conferences and trade shows. The magazine is also available on computer disks, can be accessed by bulletin board systems (BBS), and is available on the Internet. Mr. Kegan did not know how many times the magazine had been published in the last year (dep., 295), but there are no paying subscribers (dep., 300). Mr. Kegan also testified that opposer has sold no clothing under the mark MacGuide and that no credit card services under the mark are being offered. Dep., 245.

Opposer's record also includes reference to a settlement agreement with Apple Computer, Inc. in 1992. That agreement resulted from a cancellation proceeding brought by Apple Computer against opposer's predecessor's MACGUIDE registration. In this agreement, Apple Computer recognized the right of opposer's predecessor to use the mark MACGUIDE in connection with the magazine as well as the predecessor's right to an asserted family of -GUIDE marks.

The record also contains testimony and exhibits concerning opposer's policing of its mark, including a number of oppositions brought against third parties seeking

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to register marks terminating in the suffix GUIDE. These marks included TOURGUIDE for information services, SUPERGUIDE for television accessories, DIRECTGUIDE for satellite television services, IGUIDE for online computer services, and a number of other marks such as TECHGUIDE, CYBERGUIDE, KEY:GUIDE, FLURAGUIDE, UNIGUIDE and NETGUIDE. These cases were settled by abandonments of or amendments to the applications involved. Opposer's testimony also includes reference to another entity that has apparently tried to develop a family of -GUIDE marks. Kegan dep., 364.

Mr. Kegan testified that opposer sued Apple Computer for failure to honor the 1992 settlement agreement entered into by opposer's predecessor. See Kegan v. Apple Computer, Inc., 42 USPQ2d 1053 (N.D. Ill. 1996). In that case, Mr. Kegan complained about the use by Apple Computer of the marks APPLE GUIDE and MACINTOSH GUIDE for computer software. In the decision, the District Court, after summarizing the background of opposer's dispute with Apple Computer, noted that Apple had begun to use APPLE GUIDE and MACINTOSH GUIDE for active-assistance software, and stated that the 1992 agreement between opposer's predecessor and Apple Computer was not a bar to consideration of the question of the genericness of -GUIDE. The Court noted that Apple argued that -GUIDE is a generic term and that this word thus could

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not serve as the basis for a family of trademarks. The Court concluded, at 1058-59:

...-GUIDE is used by both parties to describe a product that provides information and/or assistance to users of Macintosh computers. Therefore, the term -GUIDE defines a product category of which both MACGUIDE, APPLE GUIDE, and MACINTOSH GUIDE are a part and can therefore be seen as generic...[I]t appears that no commonly used alternative to the word "guide" would effectively communicate the same information because "guide" is integrally related to a distinctive characteristic of the services being provided...

In light of the relevant factors identified above, this court finds that the term -GUIDE as contained in MACGUIDE, APPLE GUIDE, and MACINTOSH GUIDE is so commonly descriptive of the name of the kind of product that the court finds that the term should be considered generic. Elan itself has admitted that it has no claim to the exclusive use of "the plain word GUIDE standing alone as to computer programs which instruct, direct, or guide"... Elan has also admitted that it is not the exclusive user of -GUIDE in the title of magazines that instruct, direct, or guide.

The court went on to say that, because the generic term -GUIDE could not be appropriated by opposer for its exclusive use, any likelihood of confusion between opposer's marks and Apple's marks must be based on the similarities between the prefixes. The Court noted opposer's single-word, internal-capital style (e.g., MacGuide) and that the marks of the parties were seen by consumers in different contexts (a publication vs. an on-screen help function). The Court concluded that Apple's use of MACINTOSH GUIDE did not infringe opposer's trademarks.

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Mr. Kegan testified herein, at 307, that Apple Computer has agreed not to use APPLE GUIDE as one word.

When asked on cross-examination whether opposer believed that it has exclusive rights to use "GUIDE" as a suffix in trademarks, Mr. Kegan responded, at 274:

A. No, I've never said that. The question is likelihood of confusion.

See also *Kegan v. Apple Computer*, supra, at 1060.

Opposer is not aware of any instances of actual confusion involving the marks of the parties.

Applicant's Record

Mr. Marc Lane testified that he first used the mark LINEGUIDE on or before May 1995 in connection with his bulletin board system (dep., 30). At the time, the mark was used in connection with providing information concerning online information providers and other online BBS services (dep., 36). In March of 1996, applicant created his Internet Web site (dep., 136), which provides information, according to Mr. Lane, concerning how one accesses the Internet, information concerning other Internet service providers and a glossary. Mr. Lane testified that his services do not target Apple or Macintosh computer users; nor does applicant provide software, sell computer disks or CD-ROMs, or render credit card services or sell clothing under the mark LINEGUIDE. Applicant has not advertised his

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computer information services, and his services are rendered free of charge.

With respect to his mark, Mr. Lane testified that it is used without internal capitalization (i.e., the word "guide" does not begin with a capital "G"), that his mark was selected without opposer's marks in mind, nor any trademarks of Apple Computer. In his testimony, Mr. Lane indicates that the mark NETGUIDE was considered by applicant for use in connection with his services, but that he discovered that that mark was already in use (dep., 27). While applicant's mark is displayed with multicolor underlining, the word "LINE" is not displayed in rainbow colors, as are opposer's prefixes. According to Mr. Lane, applicant's mark may connote an online guide.

Mr. Lane testified that the services of the parties are different in that opposer provides general information concerning computers while applicant's services involve how to find Internet services providers (dep., 61). Mr. Lane testified that a recent trademark search produced over 800 trademarks and service marks which contained the term "GUIDE." Finally, Mr. Lane indicated that there have been no instances of actual confusion involving the parties' marks. Applicant's mark as used in connection with his bulletin board service and in connection with his Internet Web site are reproduced below.

The third-party registrations made of record by applicant include such marks as DATAGUIDE for computer programs, COMPU-GUIDE for computer services and CYBERGUIDE for a section of a magazine. Applicant contends that these marks as well as others have computer- or online-related meanings.

Arguments of the Parties

In arguing its case, opposer contends:

At least by August 1992, the diverse MacGuide products and services were so strongly marketed under a series of -Guide trademarks that the distinctive -Guide trademark family was created..

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Elan's -Guide trademark family consists of "one-word trademarks composed of two root phrases, with the second root phrase beginning with a capital letter (intercap), with the second root phrase being GUIDE, and with the first root phrase evocative of a computer issue." ..

MacGuide evokes the Macintosh computer; OpenGuide evokes non-proprietary, open standards and open clarity to lay computer users; WinGuide evokes Windows programs and being a winner; PowerGuide evokes the PowerPC microchip (Made by Motorola and IBM) and computer-power-users; HyperGuide evokes hypertext and the Internet; NexGuide evokes computer technical perspectives... and the NextStep computer operating system Apple Computer purchased to incorporate into its Macintosh operating system software... Members of the MacGuide family are often promoted together, reinforcing mutual associations to one another and to computers...

Brief, 6. Further, opposer argues that others in the computer industry have recognized opposer's trademark rights (in settlements of the trademark disputes).

It is opposer's position that its printed publications, online information service, computer software on floppy disks and on CD-ROMs, credit card services, hotel and travel services are related to applicant's computer services. Although it is not clear when opposer last distributed any issues of the MACGUIDE magazine, opposer contends that the information in previous issues remains available on the Internet.

Years after that major multi-million dollar effort [\$4 million promoting magazines and online information services] at promoting MacGuide had stopped, people still refer to MacGuide in quite favorable ways... For example, MacGuide columnist Steven Bobker is credited

with his MacGuide role and Bobbing Gradebook promotes its earlier MacGuide rating. Elan[']s recent Angels for Apple promotion receive [sic] extensive publicity in the computer community. Helping beleaguered Macintosh computer users, Elan continues to receive national attention via adroit public relations and guerrilla marketing.

Brief, 26. Further, it is opposer's position that, since it has recently acquired the "macguide" domain name and Web site, the parties' services are offered in the same channels of trade. Opposer contends that lay computer users and surfing Internet users are likely to be confused when they encounter applicant's LINEGUIDE mark used in connection with applicant's computer information service. Finally, opposer, argues that applicant's actual use of its service mark is more narrow than that set forth in the application and that applicant's use was not a bona fide use of the mark in the ordinary course of trade.²

Applicant, on the other hand, argues that the only similarity in the marks is the use of the descriptive term "GUIDE," a term which third parties have used and registered in a number of other marks. Applicant notes the federal litigation in which it was determined that the term "GUIDE" in opposer's marks is generic. Applicant also points out

² With respect to the ground of lack of bona fide use of the mark in the ordinary course of trade, we note that this issue was not pleaded, nor do we believe that this issue was tried. Applicant was not, therefore, placed on notice that this was an issue to be determined by the Board. Accordingly, we have given no consideration to this purported issue.

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that, as used, his mark has no internal capital, as does opposer's marks, and that, while applicant's mark may be underlined with colored lines, his mark does not have a prefix in different colors as does opposer's.

Opposer himself puts little effort or capital into his "family of -GUIDE trademarks". The goodwill of opposer's marks comes almost entirely from his predecessor (MacGuide Magazine) from whom he purchased the entire MACGUIDE trademark "family" in bankruptcy court, long past it's [sic] heyday, for the small sum of \$3,000... Since then, Opposer has apparently added -GUIDE trademark registrations by writing small (several paragraph) essays under the new trademark names. Opposer does not receive payment for the material he publishes... Opposer benefits primarily from occasionally licensing use of -GUIDE trademarks to other parties... It appears that Opposer essentially is attempting to manufacture a strong family of trademarks to obtain licensing fees from others wishing to use a -GUIDE brand. When he does gain agreement to either stop using a -GUIDE trademark or to license one of his, obviously under threat of a prolonged legal battle, Opposer terms it "recognition" of his -GUIDE family.

Brief, 7. Finally, concerning applicant's limited use of his mark, applicant contends:

Applicant has worked hard on his public web site. Opposer is well aware that this opposition has left Applicant in doubt for almost three years as to the ultimate registrability of his LINEGUIDE service mark and has caused Applicant to be hesitant to invest in this mark during that time. Applicant's use is bona fide.

Brief, 7.

Applicant also contends that opposer's rights have not been the subject of a final Board decision on the merits.

Discussion and Opinion

Upon careful consideration of this record and the arguments of the parties, we agree with applicant that confusion is unlikely. While applicant's services listed in his application include the providing of a wide range of information over the Internet, and while this description may encompass the activities opposer performs, we believe that the differences in the marks and the existence of third-party marks makes confusion unlikely.

In this regard, we have given some weight to the conclusions of the District Court in the litigation between opposer and Apple Computer. The issue concerning the genericness of a component of opposer's asserted family of marks is identical to one of the issues before us. Under the doctrine of collateral estoppel, or issue preclusion, if an issue is actually and necessarily determined by a court of competent jurisdiction, that determination may be conclusive in a subsequent suit involving the same issue. A non-party to the prior action may invoke this doctrine against one who was a party to that action unless it appears that the party against whom the doctrine is asserted did not have a full and fair opportunity to litigate the issues or unless the court finds that it is otherwise unfair to permit

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the use of this doctrine. See *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1139 (TTAB 1993). See also J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, Sections 32:83 and 32:84 (4th Ed. 1999) ("---the modern view of collateral estoppel--- rejects the mutuality requirement"). We believe that applicant is a party who may assert collateral estoppel. We have reviewed opposer's arguments concerning the inapplicability of the doctrine to this case, including that opposer now owns additional registrations, but find them unpersuasive.

Accordingly, we have given appropriate weight to the finding of the court that "GUIDE" is generic for magazines. Therefore, this term cannot form the basis of a family of marks. *Marion Laboratories Inc. v. Biochemical/Diagnostics Inc.*, 6 USPQ2d 1215, 1219 (TTAB 1988) and McCarthy on Trademarks and Unfair Competition, Sections 12:1 and 22:61.

While the marks of the parties must, of course, be compared in their entireties, it is not improper to afford more or less weight to a particular feature of a mark as long as the ultimate conclusion as to whether the marks in question are similar rests on a consideration of the marks in their entireties. *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In considering the marks in their entireties, we believe that applicant's mark LINEGUIDE and opposer's marks

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MACGUIDE, HYPERGUIDE, OPENGUIDE, POWERGUIDE, WINGUIDE, NEXGUIDE and WEBGUIDE are sufficiently different in sound, appearance and connotation that there is no likelihood of confusion when these marks are encountered by computer users. Not only is applicant's mark specifically different from each of opposer's marks, but also this record adequately establishes that the relevant public may be confronted with various other third-party marks also terminating in the suffix -GUIDE. All of these facts lead us to conclude that the relevant public is not likely to believe that applicant's LINEGUIDE computer information services emanate from or are sponsored by opposer.

Decision: The opposition is dismissed.

R. L. Simms

R. F. Cissel

C. M. Bottorff
Administrative Trademark
Judges, Trademark Trial and
Appeal Board