

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Ameritech Corporation  
v.  
Matthew Hollingsworth

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Opposition No. 103,153  
to application Serial No. 74/648,621  
filed on March 20, 1995

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Robert Mallin of Brinks Hofer Gilson & Lione for Ameritech Corporation.

Matthew Hollingsworth, *Pro Se*.

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Before Cissel, Quinn and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Matthew Hollingsworth has filed an application for registration of the mark "AMERITECH ROOFING SYSTEMS" (with the words "roofing systems" disclaimed) for "residential and commercial roofing installation and repair services."<sup>1</sup>

Ameritech Corporation, a Delaware corporation, filed a timely notice of opposition on August 5, 1996. As grounds

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<sup>1</sup> Serial No. 74/648,621, filed March 20, 1995, alleging dates of first use of October 17, 1994.

for opposition, opposer asserts prior use of the following registered trademarks:

- Reg. No. 1,463,091 of the word "AMERITECH" for "communication services, namely, telephone and telecommunication services."
- Reg. No. 1,487,821 of the mark "AMERITECH and design" shown below, for "providing telecommunications services."



- Reg. No. 1,487,820 of the mark "AMERITECH and design" as shown below, for "providing telecommunications services."



- Reg. No. 1,763,321 of the composite mark "AMERITECH AUDIOTEX SERVICES INC. and design" as shown below, for "voice response services via telephone."



- Reg. No. 1,732,593 of the mark "AMERITECH BUSINESS SYSTEMS" for "telephones."
- Reg. No. 1,760,203 of the mark "AMERITECH INFORMATION SYSTEMS and design" for "managing telecommunications systems and equipment for others."



- Reg. No. 1,784,637 of the words "AMERITECH INFOSERVE" for "environmental services to detect and provide early warning of leaks of halogen-based gases."
- Reg. No. 1,758,773 of "AMERITECH MOBILE COMMUNICATIONS and design" as shown below for "telecommunications services."



- Reg. No. 1,855,991 of the mark "AMERITECH TEAM DATA" for "telecommunications services; namely, electronic transmission of messages and data."
- Reg. No. 1,761,725 of "AMERITECH VOICE MESSAGING and design," as shown below, for "voice messaging services; namely, the recording, storage and retrieval of voice messages by telephone."



- Reg. No. 1,890,203 of "AMERITECH and design," as shown below, for "telecommunication services, namely electronic and wireless transmission, recording, storage, and retrieval of voice, data and information."



- Reg. No. 1,791,980 of "AMERITECH SENIOR OPEN and design," as shown below, for "entertainment services; namely, organizing, promoting and sponsoring golf tournaments."



- Reg. No. 2,041,730 of "AMERITECH" with a typed drawing, and Reg. No. 2,041, 729 of "AMERITECH and design," as shown below, for "billing services, namely, billing of local telephone customers for telecommunications services provided by others; advertising services, namely, distribution of printed matter and electronic transmission of advertising and promotional information for others."



- Reg. No. 2,052,153 of the mark "AMERITECH" and Reg. No. 2,033,614 of "AMERITECH and design," as shown below, both registrations for "travel kits consisting primarily of mouthwash, aftershave, shampoo and lotion, in Int. Cl. 3; shopping bags (leather, mesh or textile), duffel bags, fanny packs, attaché cases, tote bags, business card holders, umbrellas, luggage tags, garment bags for

travel, in Int. Cl. 18; non-metal key rings, non-metal key separators, portable chairs and hand-held mirrors, in Int. Cl. 20; mugs; commuter cups; portable beverage coolers, namely, insulated sleeves for holding canned or bottled beverages; hand tools, namely, ice scrapers; plastic clips for holding food bags closed; water bottles sold empty; and plastic coasters, in Int. Cl. 21; golf towels, in Int. Cl. 24; golf shirts, T-shirts, sweat shirts, hats, caps, sweaters, jackets, wind shirts, visors and button down shirts, in Int. Cl. 25; sewing kits consisting primarily of buttons, pins, needles, thread and miniature scissors, in Int. Cl. 26; and, golf bag covers, golf balls, golf ball markers, golf tees, yo-yos and aerodynamic disks for use in playing catch games, in Int. Cl. 28."



- Reg. No. 2,029,954 of "AMERITECH and design," as shown below, for "telecommunication services, namely, the recording, storage and subsequent transmission of voice messages by telephone; electronic transmission of messages and data; electronic store and forward messaging; and telephone communication services."



- Reg. No. 2,033,611 of the mark "AMERITECH" in a typed format, and Reg. No. 2,028,584 of the mark "AMERITECH and design," as shown below, both registrations for "shoeshine kits consisting primarily of shoe polish, shoe polish applicators, and buffers, in Int. Cl. 3; first aid kits for non-professional use, in Int. Cl. 5; metal key rings and metal key separators, in Int. Cl. 6; manicure sets and hand tools, namely, screwdrivers, in Int. Cl. 8; sunglasses; calculators; tape measures with and without levels; sports radios; computer peripherals, namely, mouse pads; magnets; and telephone caller identification display units, in Int. Cl. 9; flashlights, in Int. Cl. 11; desk clocks; watches; travel alarm clocks with flashlights; and lapel pins, in Int. Cl. 14; telephone indexes; letter openers; paper clip holders; pencils; pens; road maps; highlighter pens; paper containers; paper coasters; file folders; stationery folders; and hanging folders, in Int. Cl. 16."



- Reg. No. 2,039,934 of the mark "AMERITECH SECURITYLINK" shown in a typed drawing format, and Reg. No. 2,039,933 of "Ameritech SecurityLink and design," as shown below, both registrations for "security systems for residential and commercial use, namely, motion detectors; signal transmitting devices; security cards and security card access reading devices; door and window sensors; smoke and fire detectors; video and audio surveillance units; and devices for monitoring building temperature, tank level, and pumps; and air quality detection devices, in Int. Cl. 9; credit card services for payment of commercial and residential security services, in Int. Cl. 36; installation, maintenance and repair of residential and commercial security systems, in Int. Cl. 37; monitoring of alarmed residential and commercial security systems and security system consultation services, in Int. Cl. 42."



and,

- Reg. 1,996,235 of "AMERITECH and design," as shown below, for "telephone and business directories."



As a result of its ownership of this collection of registrations, opposer alleges that applicant's mark, as used in connection with applicant's services, so resembles opposer's marks as to be likely to cause confusion within the meaning of Section 2(d) of the Lanham Act.

Applicant, in his answer, has admitted that he filed the instant application, but has otherwise denied the salient allegations of the opposition. A trial was conducted and briefs have been filed, but neither party requested an oral hearing.

In evidence are the pleadings; the file of the opposed application; and the testimony depositions, with exhibits, taken by opposer. Applicant, Matthew Hollingsworth, has presented no evidence.

Opposer argues that inasmuch as the term "Ameritech" is a fanciful term not otherwise found in the English language, that this is an inherently strong mark. Furthermore, the confidential testimony in the record shows that opposer has spent billions of dollars over the years promoting its "AMERITECH" marks. We are told by several witnesses that a number of opposer's nationwide services require sustained periods of work on the roofs of residential or commercial properties. Opposer has in place very detailed guidelines for the proper usage of its "AMERITECH" marks in order to promote its national identity, and has used the name

consistently on an array of items used by its employees, from uniforms and caps to the company's utility vans.

In the course of rendering this decision, we have followed the guidance of *In re E.I. du Pont DeNemours & Co.*, 476 F.2d 1357, 1362, 177 USPQ 563, 567-68 (CCPA 1973). This case sets forth the factors which, if relevant, should be considered in determining likelihood of confusion.

As can be seen from the extensive listing of federal registrations owned by opposer, "AMERITECH" is clearly the centerpiece of opposer's service marks and trademarks. However, we note that substantially all of its core services involve relatively high-technology sectors (i.e., telecommunication services, alarm services, voice/data/information transmission and storage, etc.). Its nationwide advertising is designed to raise consumer awareness of its brand name for these services. Furthermore, the claimed registrations for goods list a variety of collateral products used to promote opposer's AMERITECH marks among consumers.

When making a likelihood of confusion determination under Section 2(d) of the Act, we must view the respective marks in their entirety. Yet, one feature of a mark may be recognized as having greater significance in creating the overall commercial impression. In this context, greater weight can be given to a dominant feature in determining

whether there is a likelihood of confusion. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and In re J.M. Originals Inc., 6 USPQ2d 1393 (TTAB 1988). Disclaimed matter is typically less significant in this analysis. Here, the dominant, non-disclaimed portion of applicant's mark is identical to some of opposer's marks, and is identical to the consistently dominant portion of opposer's composite marks.

Opposer's earlier corporate name was "American Information Technology Corporation." Based upon the record, we find that the word "AMERITECH" is a suggestive shorthand term derived from the words "American" and "Technology." Now, through extensive use and promotion, it has clearly become a strong mark in the field of telecommunications.

Hence, we turn our attention to the fame of opposer's marks. Opposer has spent significant amounts of money promoting this mark, through general as well as targeted advertising, trade shows, charitable giving, sponsorship of professional sporting events that are also broadcast on nation-wide television, etc. While most of the relevant figures as to sales and advertising are protected in this proceeding as "confidential," opposer's evidence convinces this Board that the "AMERITECH" mark is known to a substantial segment of the relevant public. Specifically,

given the way in which the "AMERITECH" mark is clearly associated in the United States with particular high-tech goods and/or services, we are most comfortable herein holding that "AMERITECH" is indeed a well-known mark in the areas of telecommunications, voice messaging, telephone and business directories, and security systems.

On the other hand, unlike a patent or copyright, a trademark does not confer on its owner any rights in gross or at large.<sup>2</sup> Accordingly, the determinative issue in this case is whether a likelihood of confusion exists when the respective marks are used in connection with the parties' non-competing services. After weighing all the other relevant du Pont factors, we find that this case turns on the similarity or dissimilarity in the nature of the services as described in applicant's trademark application, compared with the array of services specified in opposer's

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<sup>2</sup> The sole issue before this Board is likelihood of confusion. In the absence of any likelihood of confusion, the unauthorized use of a well-known mark on non-competing goods could lead to the dilution of the owner's mark. Opposer has voiced its concerns that the favorable connotation consumers have of its "AMERITECH" mark could well be blurred or tarnished by applicant's use of "Ameritech Roofing Systems." This in turn could lead to a serious impairment of the exclusive association between opposer's well-known "AMERITECH" mark and the opposer's goods and services. However, Section 2(d) of the Lanham Act does not cover trademark dilution, and this Board has previously determined that dilution now covered by recently-enacted federal legislation is not a ground for an opposition proceeding before the Trademark Trial and Appeal Board. See Babson Bros. Co. v. Surge Power Corp., 39 USPQ2d 1953 (TTAB 1996).

registrations (and any other services with which the record demonstrates its prior marks are being used).

We understand that opposer participates almost weekly in a variety of national and regional trade shows, including ones directed to the building trades. For example, in February 1996 opposer's Ameritech Building Automation Services group was touting the open architecture of its building automation systems at a large trade show in Atlanta, Georgia. This event was directed to air conditioning, heating and refrigeration engineers. The show directory also reveals the presence of fellow exhibitors selling roofing products. (Martha Hudak deposition, pp. 4 - 9). However, given the scope of goods and services required in any large building project, vendors involved in selling totally unrelated goods or services may well find themselves at a single trade show targeting the same group of buyers representing large companies in the building trades.

Opposer has demonstrated that, *inter alia*, its telecommunications, cable and alarm installers wear attire and drive trucks prominently displaying the "AMERITECH" mark. Hypothetically, we can envision a worker wearing a uniform labeled "AMERITECH," scaling a ladder at the roof line of a suburban Denver home with her "AMERITECH" truck parked in the driveway. However, the critical issue herein is not whether a neighbor driving by this suburban residence

confuses a cable TV technician with a roofer.<sup>3</sup> In fact, it may be relevant, but still much too narrow a focus, to question whether the suburban homeowner with a leaky roof, who knows of opposer's services and service marks, erroneously thinks Mr. Hollingsworth may in some way be

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<sup>3</sup> In its brief, opposer argues as follows:

"... In any event, some of the services offered by Ameritech include the installation and maintenance of telephone lines and equipment; the installation, repair and maintenance of security systems; the installation of cable television systems; and the installation and maintenance of building automation systems. All of this work is done by Ameritech field technicians. They wear Ameritech uniforms, perform aerial work on roofs and ladders at the roof line, use a variety of hand tools, work at both residential and commercial sites, and drive utility vans with ladders mounted on top.

"In comparison, Hollingsworth's recited services are for residential and commercial roofing installation and repair systems. Based on that description, Hollingsworth undoubtedly also performs aerial work on roofs and ladders at the roof line, uses a variety of hand tools, works at both residential and commercial sites, and even most likely drives a utility van with ladders mounted on top. In fact, Ameritech field technicians often work side-by-side with a roofer. There can be no question that the parties' goods and services are similar and support a finding of a likelihood of confusion." Main Brief for Opposer, pp. 17 - 18.

See also deposition of Michael S. Leary, pp. 12 - 13, as follows:

Q: Mr. Leary, when the technicians are installing the cable TV, where is the cable installed at the house?

A: Generally it's on the side of the home...at about the roof line on the side of a customer's home...where the eaves and the sides of the home meet, anywhere between 12 feet and 18 feet, depending upon how tall the home is.

Q: Would it be typical to walk by an installation and see the Ameritech technicians working up on a ladder next to the roof?

A: Yes. Every one of the homes that we provide service to in an aerial environment would require a technician to have a ladder on the side of the home doing an attachment up on the roof line...

Q: And when the Ameritech technicians are doing an installation, where is the van parked?

A: Generally, we require our technicians to park either in front of the home or at the end of the driveway...

connected with opposer and its array of services.<sup>4</sup> The relevant group of potential purchasers comprises more classes of individuals than the residential homeowner, the commercial building manager, or someone passing a work-site. Rather, the issue is whether upon encountering applicant's service mark used in connection with roofing services, any *potential consumer* of opposer's services is likely to conclude that opposer, known for its high technology services, also renders roofing installation and repair services.<sup>5</sup> After reviewing carefully the entire record put forward by opposer, we conclude that the extent of potential confusion of this nature is *de minimis*. In fact, the record contains no evidence that any single provider of goods or

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<sup>4</sup> Q: When you mention Ameritech products and services, what are ... the products and services offered under the Ameritech brand?

A: A wide variety of goods and services including telecommunications services, leasing and financial services, entertainment, health information, computer hardware and software, security systems, cable TV, Internet access including Internet Web page creation, home automation services, and a variety of other lines of business, and Ameritech is continually looking for and getting into new businesses and growth areas.

(Valerie Barker deposition, p. 16)

<sup>5</sup> Consistent with opposer's stance throughout this proceeding, one witness opined as follows on this very point:

Q: Is Hollingsworth's use of Ameritech Roofing Systems harming Ameritech?

A: Yes.

Q: Why?

A: Because [the mark is] identical, and we've used the Ameritech name for so many different products and services that the consumer looking at that would be very confused and assume that this was part of our company, Ameritech. The Ameritech name is so well known that the use would -- that the consumer would think that this was just another Ameritech product expansion..."

services is engaged in such disparate activities -- roofing installation and repair services on one hand, and telecommunications, voice messaging, telephone and business directories, or security systems, on the other hand.

Accordingly, in spite of the fact that "AMERITECH" is a well-known mark in several high-tech fields -- voice messaging, telecommunications, telephone and business directories, and security systems -- we find that applicant's services are not related to those of opposer. The record contains no evidence that anyone provides both roofing installation services and telecommunications services under a single mark. Therefore, we conclude that relevant customers are not likely to be confused by the use of these similar marks in connection with these services.

Decision: The opposition is dismissed.

R. F. Cissel

T. J. Quinn

D. E. Bucher

Administrative Trademark  
Judges, Trademark Trial  
and Appeal Board

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(Martha Hudak deposition, p. 19).