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OCT. 22, 1999

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Twenty-First Century Products, Inc.
v.
21st Century Marketing Group, Inc.

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Cancellation No. 26,520

Arthur J. Greenbaum and Felicia G. Traub of Cowan Liebowitz &
Latman, P.C. for Twenty-First Century Products, Inc.

Joseph A. Tranfo of Tranfo & Tranfo, L.L.C. for 21st Century
Marketing Group, Inc.

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Before Simms, Chapman and Bucher, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

Twenty-First Century Products, Inc. (petitioner), a New York
corporation, seeks cancellation of three registrations owned by
21st Century Marketing Group, Inc. (respondent), a Connecticut
corporation. These registrations are as follows:

"TWENTY-FIRST CENTURY MARKETING GROUP," for "public
relations services for corporations and businesses;
namely, finding sporting events and educational and
environmental causes for corporate sponsorship and
negotiating the terms of the corporate sponsorship

and coordinating the sponsorship activities," in
International Class 35;¹

¹ Reg. No. 1,799,591 issued on October 19, 1993. This registration matured from an application filed with the U.S. Patent and Trademark Office on April 21, 1992, claiming first use dates of February 14, 1991. The term "Marketing Group" is disclaimed.

"21ST CENTURY MARKETING GROUP," for "public relations services for corporations and businesses; namely, finding sporting events and educational and environmental causes for corporate sponsorship and negotiating the terms of the corporate sponsorship and coordinating the sponsorship activities," in International Class 35;² and,

"21ST CENTURY MARKETING GROUP and design" (as shown below), for "public relations services for corporations and businesses; namely, finding sporting events and educational and environmental causes for corporate sponsorship and negotiating the terms of the corporate sponsorship and coordinating the sponsorship activities," in International Class 35.³



As the basis for cancellation, petitioner alleges that it is the owner of the mark "21ST CENTURY MARKETING" for "preparing direct mail advertising for others, and gathering business information; analyzing, evaluating, and planning direct marketing programs, namely, consultation on the mailing list data base, architecture, and merge/purge coordination of the programs; and

² Reg. No. 1,820,089 issued on February 8, 1994. This registration matured from an application filed with the U.S. Patent and Trademark Office on April 22, 1991, claiming first use dates of February 14, 1991. The term "Marketing Group" is disclaimed.

³ Reg. No. 1,838,064 issued on May 31, 1994. This registration matured from an application filed with the U.S. Patent and Trademark Office on April 22, 1991, claiming first use dates of February 14, 1991. The term "Marketing Group" is disclaimed.

brokerage, consultation, and management services concerning alternative media advertising, namely, advertising in package inserts, ride-alongs, card decks, cooperative advertising, and cable television inserts," having commenced use thereof in interstate commerce since at least as early as October 5, 1977; that petitioner, on July 22, 1996, filed its pending application, Serial Number 75/136,968, to register such mark for the services recited above; and that its application presently stands refused in view of the existence of the three registrations it seeks to cancel.

Respondent, in its answer, denies the essential allegations of the petition to cancel.

The record consists of the pleadings; the files of the involved registrations; and, as petitioner's case-in-chief, the August 5, 1998 testimony, with exhibits, of David O. Schwartz, president of petitioner; a notice of reliance on the Patent and Trademark Office file wrapper for petitioner's application; a notice of reliance on printed publications, and a notice of reliance on certificates of incorporation. Respondent has submitted no evidence in this proceeding. Only petitioner filed a brief. An oral hearing was not requested.

Petitioner has established through official records from the State of New York that "Twenty-First Century Products, Inc." was incorporated in October 1977, and recorded its assumed name with the New York Secretary of State ("Twenty-First Century Products,

Inc. d/b/a Twenty-First Century Marketing") in February 1980.⁴ The testimony of Mr. Schwartz confirms these dates for petitioner's having adopted this trade name and service mark.⁵ Petitioner's services are listed, for example, in annual, printed publications, such as the Standard Rate and Data Service (SRDS) Directory of Mailing Lists for the years 1985 to 1992.⁶ The totality of the evidence in the record demonstrates that petitioner has used the mark "21ST CENTURY MARKETING" in connection with its mailing list marketing and related services continuously since October 5, 1977. This cumulative evidence supports petitioner's claim that its mark "21ST CENTURY MARKETING" was being used in connection with its mailing list marketing services prior to respondent's April 1991 filing dates, and, of course, respondent has failed to present any evidence or arguments to the contrary. Accordingly, petitioner has established prior and continuous use by a preponderance of the evidence.

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

⁴ Notice of Reliance on Certificates of Incorporation, of August 14, 1998, under Trademark Rule 2.122(e).

⁵ Testimony Deposition of David O. Schwartz, pp. 11-12.

⁶ Notice of Reliance on Printed Publications, of August 13, 1998, under Trademark Rule 2.122(e), Exhibits 1 and 9.

When focusing on the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression, it is clear immediately that the marks herein are substantially identical. Respondent's marks, "TWENTY-FIRST CENTURY MARKETING GROUP" and "21ST CENTURY MARKETING GROUP" (with "Marketing Group" disclaimed in all three registrations), differ from petitioner's mark, "21ST CENTURY MARKETING" (with "Marketing" disclaimed) only with the addition of the final word "Group." In the context of a trade name and/or service mark for an organization doing marketing, the word "group" follows the word "marketing" so naturally and effortlessly one hardly notices it. Accordingly, we conclude that compared with the source-indicating value of the shared words herein, "21ST CENTURY MARKETING," the difference created by adding the word "group" is not significant. Finally, while Reg. No. 1,838,064 contains a large "21" and two rectangular design features, this presentation merely serves to accentuate the "21ST CENTURY" component of the mark.

We turn next to the similarity in the nature of the services as described in respondent's registrations and in connection with which petitioner's prior mark is in use. Respondent's particular niche is helping companies whose marketing strategy includes "event marketing" (e.g., in association with sporting events, educational forums, community festivals, charitable fundraisers, etc.). Petitioner is involved with managing and brokering mailing lists, preparing direct mail advertising, gathering business information, analyzing, evaluating, and planning direct marketing programs, and

providing brokerage, consultation, and management services dealing with alternative media advertising. While these are different types of marketing activities, they do represent alternative ways that companies (i.e., the clients of these respective marketing firms) may choose to promote their businesses. In this sense, petitioner's array of services, including that of brokering mailing lists and pushing alternative media, might well compete with respondent's event marketing for a share of any company's marketing budget. We believe that a corporate purchaser who is aware of petitioner's direct mail, promotional services offered under the mark "21ST CENTURY MARKETING," who also encounters respondent's nearly identical mark "21ST CENTURY MARKETING GROUP" used in connection with finding events for corporate sponsorship, would be likely to believe that these services come from the same source.

Decision: The petition to cancel is granted and Registration Numbers 1,799,591, 1,820,089, and 1,838,064 will be cancelled in due course.

R. L. Simms

B. A. Chapman

D. E. Bucher

Administrative Trademark Judges,
Trademark Trial and Appeal Board