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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Scholastic Inc.

v.

Classical Education Foundation Corporation

Opposition No. 99,876
to application Serial No. 74/573,677
filed on September 15, 1994

Edward H. Rosenthal of Frankfurt, Garbus, Klein & Selz, P.C.
for Scholastic Inc.

Frederick R. Guy of Guy Law Office for Classical Education
Foundation Corporation

Before Simms, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Classical Education Foundation Corporation has applied
to register the mark SCHOLASTICOMM for "educational
services, namely, providing secondary and post-secondary
courses of instruction via on-line computer means in the

fields of mathematics, science, social sciences and foreign languages." (Int. Class 41).¹

As grounds for opposition, opposer has alleged that beginning at least as early as 1922 opposer "has used the mark SCHOLASTIC and various marks incorporating the mark SCHOLASTIC, in connection with the sale of both electronic and printed educational materials"; that opposer also owns numerous trademark registrations, including many in Classes 9 and 41; that opposer "has become a leading purveyor of educational materials"; and that applicant's mark, if used on its goods, would so resemble opposer's previously used and registered marks, as to be likely to cause confusion, mistake, or deception.

In its answer applicant has denied the salient allegations of the notice of opposition.

The record includes the pleadings; the file of the opposed application; and opposer's testimony, with exhibits, of Lynette Allison. Applicant has submitted no evidence on its behalf in this case, and applicant did not attend the deposition of Ms. Allison.

Only opposer filed a brief on the case. Neither party requested an oral hearing.

Ms. Lynette Allison, opposer's vice president/general

¹ Application Serial No. 74/573,677, filed September 15, 1994. The application is based on applicant's allegation of a bona fide intent to use the mark in commerce.

counsel and secretary, testified that opposer sells a wide variety of printed and electronic materials, such as books, magazines, videos and computer software; and that opposer first started publishing books in 1920. She also testified regarding a packet of over 60 federal trademark registrations, all for marks which are the word SCHOLASTIC, or SCHOLASTIC with other words and/or designs. Ms. Allison specifically testified that opposer owned all of the registrations, and also that the current status of all of the registrations was as indicated on their in-house status sheet for each registration. Some of opposer's currently existing registrations include SCHOLASTIC², JUNIOR SCHOLASTIC³ and SENIOR SCHOLASTIC⁴, all for periodicals; SCHOLASTIC for "computer-game programs"⁵, for "production of educationally oriented television shows and video programs, conducting fairs and/or conferences promoting new developments and technology in educational materials and

² Reg. No. 273,405, issued August 30, 1930, Section 8 affidavit accepted, Section 15 affidavit acknowledged, third renewal. The claimed dates of first use and first use in commerce are September 1922.

³ Reg. No. 396,008, issued June 23, 1942, Section 8 affidavit accepted, Section 15 affidavit acknowledged, second renewal. The claimed dates of first use and first use in commerce are September 1937.

⁴ Reg. No. 501,092, issued July 20, 1948, Section 8 affidavit accepted, Section 15 affidavit acknowledged, second renewal. The claimed dates of first use and first use in commerce are March 8, 1943.

⁵ Reg. No. 1,658,308, issued September 24, 1991, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are 1984.

books"⁶, for "prerecorded computer programs, prerecorded audio recordings, prerecorded audio/visual programs, and prerecorded video program, all for use in the field of education"⁷, and for "mail-order book club services, made available to schools, librarians, and interested parents, on a variety of topics"⁸; for "prerecorded computer programs with instruction handbook, all sold as a unit"⁹; THE SCHOLASTIC for "computer software programs and instruction manuals sold as a unit for educational use"¹⁰; SCHOLASTIC ART for "educationally-oriented magazines in the field of art"¹¹; SCHOLASTIC BOOK FAIRS for "providing children's books to schools for use in school fundraising programs"¹²; SCHOLASTIC CASSETTES for "audio tape cassettes,

⁶ Reg. No. 1,677,924, issued March 3, 1992, Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are 1981.

⁷ Reg. No. 1,685,119, issued May 5, 1992, Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are 1955.

⁸ Reg. No. 1,741,883, issued December 22, 1992, under Section 2(f), Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are 1949.

⁹ Reg. No. 1,457,214, issued September 15, 1987, under Section 2(f), Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are September 1, 1984.

¹⁰ Reg. No. 1,689,530, issued May 26, 1992, Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are October 30, 1990.

¹¹ Reg. No. 1,736,515, issued December 1, 1992, under Section 2(f), Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are February 1, 1992. The word "art" is disclaimed.

¹² Reg. No. 1,661,230, issued October 15, 1991, Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are August 1983. The words "book fairs" are disclaimed.

Opposition No. 99876

carrying narrations of classic stories of educational value for children"¹³; SCHOLASTIC CHOICES for "general interest magazines for young people"¹⁴; SCHOLASTIC COACH for a "periodical in the field of sports and sports coaching"¹⁵; SCHOLASTIC HIGH TECH REPORTS and design for "instructional videotapes and video laser discs providing information on inventions and other science related matters"¹⁶; SCHOLASTIC MATH for "educationally oriented magazine for the instruction of mathematics, published periodically, and addressed to students of junior high school levels"¹⁷; SCHOLASTIC PARENT for a "newsletter addressed to parents and issued periodically through the school year, being provided as a supplement to books and magazines sold to schools"¹⁸; SCHOLASTIC PRODUCTIONS for "educational services, namely,

¹³ Reg. No. 1,526,606, issued February 28, 1989, Section 8 affidavit accepted, Section 15 acknowledged. The claimed dates of first use and first use in commerce are September 8, 1986. The word "cassettes" is disclaimed.

¹⁴ Reg. No. 1,395,649, issued June 3, 1986, under Section 2(f), Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are July 16, 1985.

¹⁵ Reg. No. 1,985,543, issued July 9, 1996, under Section 2(f), with claimed dates of first use and first use in commerce of September 1931.

¹⁶ Reg. No. 1,880,496, issued February 28, 1995, with claimed dates of first use and first use in commerce of May 1, 1993.

¹⁷ Reg. No. 1,172,229, issued October 6, 1981, Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are January 22, 1980 and January 24, 1980, respectively. The word "math" is disclaimed.

¹⁸ Reg. No. 1,753,219, issued February 16, 1993, with claimed dates of first use and first use in commerce of September 1, 1991.

production of educationally-oriented television shows"¹⁹; SCHOLASTIC SCIENCE PLACE for "printed instruction books, work books, exercise sheet forms, teacher theme folders, pre-recorded video cassettes, pre-recorded audio cassettes, and pre-recorded computer programs, all pertaining to a course of science education for children of primary-school age, and all sold as a unit"²⁰; SCHOLASTIC TEACHER for a "magazine for teachers"²¹; and SCHOLASTIC UPDATE for an "educationally oriented magazine, published periodically, and addressed to students of high-school level"²².

Lynette Allison also testified that opposer's 1996 revenues were almost \$1 billion, with opposer spending \$100 million in marketing and promoting its SCHOLASTIC marks; and that opposer markets its goods and services to students, teachers, parents, and schools. Further, in September 1993 opposer launched (originally through America Online) "an on-line educational service developed for teachers and students

¹⁹ Reg. No. 1,319,947, issued February 12, 1985, under Section 2(f), Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are October 19, 1981. The word "productions" is disclaimed.

²⁰ Reg. No. 1,838,409, issued May 31, 1994, with claimed dates of first use and first use in commerce of February 1, 1993. The word "science" is disclaimed.

²¹ Reg. No. 834,031, issued August 22, 1967, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed. The claimed dates of first use and first use in commerce are September 23, 1946.

²² Reg. No. 1,296,100, issued September 18, 1984, under Section 2(f), Section 8 affidavit accepted, Section 15 affidavit acknowledged. The claimed dates of first use and first use in commerce are March 21, 1983. The word "update" is disclaimed.

with material tied to the curriculum" (Allison dep., p. 17) under the mark SCHOLASTIC NETWORK; that said service has continuously been available and is currently available on the World Wide Web with access directly through opposer's domain name "scholastic.com" (which opposer registered as a domain name with Internic--Internet Network Information Center--in October 1993).

According to its application, applicant is located in Syracuse, New York, and it intends to offer educational services, specifically, secondary and post-secondary courses via on-line computer in the fields of mathematics, science, social sciences and foreign languages. Applicant has not furnished any evidence regarding its business or its activities under the mark, which we note was applied for as an intent-to-use application.

We turn first to the question of priority. Although opposer did not submit status and title copies of its over 60 pleaded registrations, opposer has properly made these registrations of record through the testimony of Ms. Allison, which establishes that opposer owns the registrations, and that the registrations are all subsisting. See Trademark Rule 2.122(d), and TBMP §703.02(a). Thus, priority is not an issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the testimony of Ms.

Opposition No. 99876

Allison proves opposer's use of its marks, SCHOLASTIC and/or SCHOLASTIC with other words (including SCHOLASTIC NETWORK), all prior to applicant's filing date of September 15, 1994.

This brings us to the issue of likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). For the reasons which follow, we hold that a likelihood of confusion exists.

With respect to the goods and services of opposer vis-a-vis the services of applicant, absolute identity of goods and/or services is not required. See *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein. Moreover, it is well recognized that confusion in trade can occur from the use of similar (or the same) marks for products on the one hand and for services involving those products on the other hand. See *Safety-Klean Corporation v. Dresser Industries, Inc.*, 518 F.2d 1399, 186 USPQ 476 (CCPA 1975); and *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983), and cases cited therein.

Since September 1993, opposer has used the mark SCHOLASTIC NETWORK for an on-line educational service developed for teachers and students with content which is tied to the curriculum. Thus, the record shows that opposer provides a service very similar to the service applicant intends to offer, "educational services, namely, secondary and post-secondary courses of instruction via on-line

Opposition No. 99876

computer means in the fields of mathematics, science, social sciences, and foreign languages." In addition, opposer has published educational books and magazines since the 1920s; and opposer has produced video products and computer software, all since well before applicant's filing date. Specifically, opposer uses its SCHOLASTIC marks on a wide variety of educational materials and services, including, for example, computer software programs for educational use; magazines; prerecorded computer programs; prerecorded audio recordings; instructional videotapes and video laser discs providing information on inventions and other science matters; magazines for the instruction of mathematics; and producing educationally oriented television shows.

We acknowledge that applicant's services are restricted to secondary and post secondary courses, and some of opposer's registrations include in the identification a restriction that the goods and/or services are directed toward either pre-school, elementary, junior high or high school students. However, many of opposer's registrations have no such limitation, and, therefore, could pertain to all possible grade levels of students, including those of high school and post-high school.

We find that applicant's services (providing secondary and post-secondary courses of instruction via on-line computer) and opposer's on-line educational services are

legally identical, and that those services are sold through the same channel of trade, that is, via computer on-line. Further, applicant's services are closely related to opposer's other educational goods and services. Even though opposer's other goods and services are not necessarily sold through the same channels of trade as applicant's courses of instruction, nonetheless, it is apparent from the parties' respective identifications of goods and services, that there is overlap in the class of purchasers. Specifically, both applicant's and opposer's potential purchasers include persons of secondary and post-secondary levels seeking to take courses of instruction.

Accordingly, if opposer's goods and services and applicant's services were sold under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning then to a consideration of the marks, first we address opposer's argument that it uses the asserted mark SCHOLASTIC.COM "in connection with its Web site identifying Scholastic's products and services." (Opposer's brief, p. 12). "When a domain name is used only to indicate an address on the Internet, the domain name is not functioning as a trademark. ... Domain names, like trade names, do not act as trademarks when they are used merely to identify a business entity; in order to infringe they must be used to

identify the source of goods or services". Lockheed Martin Corp. v. Network Solutions Inc., 985 F. Supp. 949, 956, 44 USPQ2d 1865, 1871 (CDCA 1997). See also, Data Concepts Inc. v. Digital Consulting Inc., ___ F.3d ___, 47 USPQ2d 1672, concurring opinion, Merritt (6th Cir. 1998); and J. Thomas McCarthy, Vol. 1, Trademarks and Unfair Competition, §7:17.1.

The testimony (with exhibits) of Lynette Allison does not show that opposer uses "scholastic.com" as a trademark or service mark. Opposer's exhibit 10 is simply a one-page computer printout showing opposer's registration with the Internic of opposer's domain name "scholastic.com" in October 1993; and exhibit 11 is "a press kit for launching the network on the World Wide Web under the domain name Scholastic.com". (Allison dep., p. 22). The press kit shows the domain name appearing on virtually all the papers which were submitted as part of the press kit as "<http://scholastic.com>", and in smaller type to the side of or below the larger words, SCHOLASTIC NETWORK. The domain name appears within one press release titled "Scholastic Network Offers 30-Day Trial Offer to First-Time Subscribers" wherein opposer invites schools to become "members free for 30 days by visiting the site at scholastic.com." Thus, we find on this record that opposer uses the term

"scholastic.com" only to indicate opposer's electronic address on the Internet and does not use the term as a trademark or service mark to identify the source of opposer's goods and services²³. Inasmuch as opposer has no trademark or service mark usage of the term "scholastic.com", opposer's use thereof cannot be considered in determining the issue of the similarity of the parties' respective marks. See *In re William H. Eilberg*, ___ USPQ2d ___ (Application Serial No. 75/162,788, TTAB 1998).

We turn to an analysis of the similarity of applicant's mark, SCHOLASTICOMM, and opposer's mark SCHOLASTIC NETWORK. Obviously, both marks include the word SCHOLASTIC as the first word or first portion of the marks. The term "network" appearing in opposer's mark is highly suggestive, if not descriptive, of opposer's services, while the "COMM" suffix of applicant's mark suggests "communication" or the domain extension ".com". Thus, the word SCHOLASTIC is the dominant part of both involved marks. Accordingly, applicant's use of its mark for its identified services is likely to cause confusion with opposer's use of SCHOLASTIC NETWORK.

Moreover, applicant's mark is very similar to opposer's mark SCHOLASTIC and the variations thereof, in particular,

²³ While the question could be raised as to whether use of a domain name could be use analogous to trademark use, opposer has not argued or briefed this issue, and we do not resolve it here.

Opposition No. 99876

such marks as SCHOLASTIC for "prerecorded computer programs..., all for use in the field of education"; SCHOLASTIC THE MOST TRUSTED NAME IN LEARNING for "prerecorded computer programs with instruction handbook, all sold as a unit"; THE SCHOLASTIC for "computer software programs and instruction manuals sold as a unit for educational use"; SCHOLASTIC ART for "educationally-oriented magazines in the field of art"; SCHOLASTIC HIGH TECH REPORTS and design for "instructional videotapes and video laser discs providing information on inventions and other science related matters"; and SCHOLASTIC MATH for "educationally oriented magazine for instruction of mathematics, and published periodically, and addressed to students of junior high level".

Because applicant's mark, SCHOLASTICOMM, consists of the word SCHOLASTIC with what appears to be the suffix COMM, consumers are likely to regard applicant's mark as a variant of opposer's various SCHOLASTIC marks, and are likely to believe that applicant's services and opposer's goods and services emanate from the same source.

While SCHOLASTIC may be a highly suggestive term in the fields of educational materials and/or educational services, it nonetheless carries the same connotation for both opposer

and applicant²⁴. In any event, the record is clear that opposer has a strong mark, SCHOLASTIC, which has been in use for over 75 years for a variety of educational materials and services.

Finally, applicant, as the newcomer, has the opportunity of avoiding confusion, and is obligated to do so. See *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988); and *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, at 1440 (TTAB 1993).

Based on the similarity of opposer's marks and applicant's mark; the close similarity of the parties' on-line educational services, as well as the close relationship between applicant's services and opposer's other educational materials and services; the same trade channel for both parties' educational services offered on-line; and the similar classes of purchasers; we find that confusion is likely.

²⁴ The American Heritage Dictionary defines "scholastic" as "1. Of or pertaining to schools; academic." The Board may take judicial notice of dictionary definitions. See TBMP §712.01.

Opposition No. 99876

Decision: The opposition is sustained, and
registration to applicant is refused.

R. L. Simms

E. J. Seeherman

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal Board