

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

Hearing:
January 18, 2000

Paper No. 47

9/12/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

Delphi Consulting Group, Inc.
v.
Borland International, Inc.

—————
Opposition No. 103,429
to application Serial No. 74/535,376
filed on June 9, 1994

—————
Edward R. Schwartz of Christie, Parker & Hale for Delphi
Consulting Group, Inc.

Martin R. Greenstein of Techmark for Borland International,
Inc. now known as Inprise Corporation

—————
Before Hanak, Holtzman and McLeod, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Borland International, Inc. now known as Inprise Corporation (applicant) seeks to register DELPHI in typed drawing form for "computer programs for use in the field of compilers, assemblers, application development tools and utilities, database implementation, reporting and connectivity, user interfaces, visual development tools and utilities, and instructional manuals sold therewith." The

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intent-to-use application was filed on June 9, 1994.

Subsequently, applicant filed an amendment to allege use with a first use date of October 5, 1994.

Delphi Consulting Group, Inc. (opposer) filed a notice of opposition alleging that long prior to June 1994, it both used and registered the identical mark DELPHI in connection with computer and database related goods and services. Continuing, opposer alleged that the contemporaneous use of the identical mark DELPHI by both opposer and applicant is likely to result in confusion, mistake and deception.

Applicant filed an answer which denied the pertinent allegations of the notice of opposition. Both opposer and applicant filed briefs and were present at a hearing held on January 18, 2000.

At the outset, we note that applicant does not dispute the fact that priority of use rests with opposer. (Applicant's brief page 11). In this regard, opposer has properly made of record a copy of its Registration No. 1,651,752 for the mark DELPHI depicted in typed drawing form for "educational services; namely, conducting classes and seminars in the field of computer hardware and software implementation." This registration issued on July 23, 1991.

In view of the forgoing, we turn now to the only issue in this proceeding, namely, whether there exists a likelihood of confusion resulting from the contemporaneous

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use of the identical mark DELPHI by opposer for its services and by applicant for its goods. In any likelihood of confusion analysis, two key, although by no means exclusive, considerations are to be similarities of the marks and the similarities of the goods and services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks.")

Considering first the marks, they are absolutely identical. Applicant seeks to register DELPHI in typed drawing form, and opposer owns a registration of DELPHI in typed drawing form. In view of the foregoing, we are utterly mystified by applicant's statements that "the marks in issue are not identical as stated by opposer" (applicant's brief page 28) and that "the evidence establishes that the marks of the parties are not identical" (applicant's brief page 40). While it is true that opposer pled and established rights in other marks such as DELPHI REPORT and DELPHI INSTITUTE, the very first mark mentioned in opposer's notice of opposition and in opposer's brief is opposer's DELPHI mark per se. Thus, it is utterly disingenuous for applicant's counsel to claim that the marks in question are not identical. In point of fact, they are

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absolutely identical. At page 11 of its brief, applicant acknowledges that opposer is the owner of four trademark registrations containing the term DELPHI. In the final sentence on page 11 of its brief, applicant enumerates by name the marks of three of opposer's registrations, namely, DELPHI REPORT, DELPHI INSITUTE, and DELPHI THE INFORMATION ADVANTAGE. In the very next sentence which appears at the top of page 12 of applicant's brief, applicant makes an oblique reference to "opposer's other [first] registration" without noting the fact this registration is for the mark DELPHI per se in typed drawing form.

Two comments are in order. First, this Board is not pleased with applicant's attempt to hide the fact that the mark which applicant seeks to register is absolutely identical to the mark which opposer previously used and registered. Second, because opposer has prior rights in the identical mark DELPHI which applicant seeks to register, we will in our likelihood of confusion analysis focus simply upon opposer's rights in its DELPHI mark. We need not consider whether there exists a likelihood of confusion resulting from the use of DELPHI by applicant and the use by opposer of its other registered marks, namely, DELPHI REPORT, DELPHI INSTITUTE and DELPHI THE INFORMATION ADVANTAGE.

In summary, we find that the first Dupont "factor weighs heavily against applicant, as the two word marks are identical." In re Martin's Famous Pastery Shoppe Inc., 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Moreover, as was the case with the identical mark in the Martin's case, the identical mark here (DELPHI) is not suggestive of and certainly not descriptive of either opposer's services or applicant's goods. Indeed, while applicant argues that numerous third parties have used various DELPHI marks, applicant has never contended that as applied to either its goods or opposer's services the mark DELPHI is suggestive or descriptive.

Turning to a consideration of opposer's services and applicant's goods as described in the registration and application, we note that because the marks are absolutely identical, their contemporaneous use can lead to the assumption that there is a common source "even when [the] goods or services are not competitive or intrinsically related." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). However, in point of fact, we find that opposer's services as described in its Registration No. 1,651,752 and applicant's goods as described in its application are clearly related. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987).

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Considering first the services of opposer's Registration No. 1,651,752 they are, as previously noted, "educational services; namely, conducting classes and seminars in the field of computer hardware and software implementation." This is a very broad description. There is, for example, absolutely no restriction on the type of computer hardware and software covered by opposer's registration. Indeed, even applicant concedes that opposer's registration is not limited to "a specific field." (Applicant's brief page 12).

Considering next the goods as described in applicant's application, they are, as previously noted, "computer programs for use in the field of compilers, assemblers, application development tools and utilities, database implementation, reporting and connectivity, user interfaces, visual development tools and utilities, and instructional manuals sold therewith." Applicant itself has described its goods as "general purpose application development programming software tools." (Applicant's brief page 5). Elaborating upon this same point, applicant's vice president of marketing testified that applicant's DELPHI computer programs are "pretty general-purpose." (Urlocker deposition page 11). Indeed, on cross-examination Mr. Urlocker went even further in emphasizing the broad scope of applicant's DELPHI product, as demonstrated by the following series of

questions and answers appearing at pages 71-72 of his deposition:

Q I believe you testified that the Delphi product which is sold by Inprise [applicant] has a wide range of applications; is that correct?

A Yeah.

Q What is the limitation on the range of applications?

A There's no limitation on the range of applications.

Finally, Mr. Urlocker testified that applicant provided to customers who purchased its DELPHI computer programs educational services to educate the customers about said programs. (Urlocker deposition pages 44-45, 69).

Given the very broad scope of opposer's educational services in the field of computer hardware and software and the very broad scope of applicant's computer programs (software), we find that consumers who are aware of both opposer's educational services and applicant's computer programs would assume that both came from a common source, or at the very least, that there were some relationship between the company which provided the educational services and the company which provided the computer programs.

Indeed, the record demonstrates that opposer and applicant marketed their respective DELPHI services and products at the very same trade shows and in the very same publications, and that furthermore, they marketed their respective DELPHI services and products to the very same companies.

Under such circumstances, it comes as no surprise that the record in this case contains numerous instances of actual confusion. While we would find that there exists a likelihood of confusion even in the absence of proof of actual confusion, it must be remembered that "any evidence of actual confusion is strong proof of the fact of a likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition Section 23:12 at page 23-32 (4th ed. 1999). Opposer's chief financial officer (Nicholas Koulopoulos) testified that he was the custodian of records for opposer, and that he maintained in the regular course of business a log of misdirected correspondence sent to opposer which was intended for applicant. Opposer introduced this misdirected correspondence not to prove the truth of the statements contained in said correspondence, but rather to simply show that the correspondence was sent to opposer and not to applicant. Thus, we find that this misdirected correspondence does not constitute hearsay. Moreover, even

it did, it would fall within an exception to the hearsay rule. See Federal Rule of Evidence 803(6).

While not all of the correspondence compiled by Mr. N. Koulopoulos identifies applicant as the intended recipient of said correspondence, at least ten pieces of said correspondence clearly indicate that they were intended for applicant, but were received by opposer. In addition, Mr. N. Koulopoulos identified a completed registration form for one of opposer's educational conferences which was received by opposer. This registration form stated that current clients of opposer could take an additional \$100 off the normal registration fee for opposer's conference. One registrant identified himself as Mike Hukill, a business analyst with Intermountain Health Care of Salt Lake City, Utah. Mr. Hukill claimed the \$100 discount explaining that he was a DELPHI customer. However, Mr. Hukill went on to list his account with applicant Borland and went on to note that his representative was Terry Smith, an employee of applicant Borland. Thus, this registration form received by opposer evidences that Mr. Hukill was of the view that applicant Borland was the sponsor of this DELPHI conference, which, of course, was in actuality one of opposer's conferences.

Before leaving the issue of actual of confusion, two points should be clarified. Opposer's president testified

that when he attended trade shows, he was repeatedly approached by individuals who stated that they thought that opposer and applicant were affiliated. However, because opposer's president was unable to give any specifics about these purported instances of actual confusion, we have accorded his testimony on this point no weight.

Second, during the course of this proceeding applicant took the depositions of various third-party companies whose corporate names contained the word DELPHI. One such third-party deposition was that of Robin Potter, a former president of Delphi Partners, Inc. Counsel for applicant asked Ms. Potter if she was familiar with opposer Delphi Consulting Group, Inc. She said that she was and noted correctly that opposer was located in Boston. (Potter deposition page 24). Counsel for applicant then asked the following question: "Are you aware of any misdirected letters, invoices, checks, communications or otherwise with any other company with Delphi in the name?" Ms. Potter responded as follows at page 24 of her deposition: "There is a company in Boston -- there is a company in Boston with Delphi in its name that we [sic] got some checks from one of our clients and I don't recall which one ended up sending our checks to that company. So we had to unwind that and get it paid properly." Counsel for applicant elected not to ask any further question regarding the issue of actual

confusion. While Ms. Potter's testimony does not conclusively prove that the Delphi company in Boston was indeed opposer, it strongly suggests that this was the case. In any event, at an absolute minimum, Ms. Potter's testimony -- noticed and taken by counsel for applicant -- is evidence of actual confusion involving two companies whose names share the word Delphi.

Two final comments are in order. First, applicant has argued that there are numerous third-party uses of DELPHI and therefore "DELPHI is a weak mark." (Opposer's brief page 18). Applicant then goes on to state that these numerous users of DELPHI "peacefully co-exist." (Opposer's brief page 18). Applicant's argument regarding third-party uses is deficient for at least four reasons. First, the vast majority of third-party uses of DELPHI are for goods and services totally unrelated to those involved in this proceeding. Second, for those uses of DELPHI which involve goods and services at least somewhat related to those involved in this proceeding, it should be noted that the uses involve not DELPHI per se, but rather they involve the use of DELPHI as part of a name or mark containing a number of words, such as the just aforementioned Delphi Partners, Inc. Third, opposer has offered no proof whatsoever as to the extent of use by third parties of marks and names containing the word DELPHI. Indeed, it appears that the

extent of this use is quite limited. For example, opposer's own witness Robin Potter -- the former president of Delphi Partners, Inc. -- was unable to identify any other companies using DELPHI other applicant and the "company in Boston," presumably opposer. (Potter deposition page 24). Thus, the former president of a company engaged in developing software was unable to name any other company using DELPHI as part of its name or mark other than her former employer, applicant and presumably opposer. Fourth, applicant simply is incorrect in its assertion that companies using DELPHI "peacefully co-exist." Indeed, applicant even concedes that "actual confusion ensued" between opposer and a company in New York when both used the same trade name containing DELPHI. (Applicant's brief page 33).

Second, opposer has candidly conceded that "the parties' respective goods and services are expensive." (Opposer's brief page 13). However, while consumers may exercise greater care when dealing with expensive goods and services, this extra care is of little assistance in enabling consumers to differentiate various goods and services when all of them bear the absolutely identical mark DELPHI.

Finally, to the extent that there is any question regarding the issue of likelihood of confusion, we are

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obligated to resolve doubts in favor of opposer as both the prior user and prior registrant. Martin's Famous Pastry, 223 USPQ at 1290.

Decision: The opposition is sustained.

E. W. Hanak

T. E. Holtzman

L. K. McLeod
Administrative
Trademark Judges,
Trademark Trial and
Appeal Board

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