

**THIS DISPOSITION  
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Paper No. 35  
BAC

11/14/00

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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SkyTel Corp.  
v.  
Vehicle Access Corporation, Incorporated  
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Opposition No. 106,611  
to application Serial No. 75/089,963  
filed on April 17, 1996  
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Request For Reconsideration  
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Laurence R. Hefter and Lisa Peller London of Finnegan,  
Henderson, Farabow, Garrett & Dunner for SkyTel Corp.

Marc A. Bergsman of Dickinson Wright PLLC for Vehicle  
Access Corporation, Incorporated.  
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Before Simms, Walters and Chapman, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

The Board, in its decision, dated June 27, 2000,  
sustained the opposition by SkyTel Corp. to the  
registration of the mark                      applied for by  
applicant, Vehicle Access Corporation, Incorporated.

The time to request reconsideration of that decision  
ended on July 27, 2000 pursuant to Trademark Rule

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2.129(c). However, on August 9, 2000, applicant filed a "request for copy of the final decision and motion to reset the time to file a notice of appeal"; and on August 23, 2000 applicant filed a "motion to reopen time to file request for reconsideration," along with applicant's "request for reconsideration of the final decision." Opposer filed a brief in opposition to applicant's request for reconsideration.

In its motion to reopen the time to file a request for reconsideration, applicant stated that it did not receive a copy of the June 27, 2000 decision from the Board, and thus, applicant could not docket any subsequent dates. In view of applicant's attorney's statements to this Board, applicant's time to file a request for reconsideration is hereby extended to August 23, 2000, and applicant's request for reconsideration, filed on that date, is considered timely filed.<sup>1</sup>

Applicant asserted three Board errors on page 2 of its request, specifically: (1) the Board compared opposer's paging and messaging services with a component of applicant's goods, rather than with applicant's

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<sup>1</sup> Applicant's attorney obtained a facsimile copy of the June 27, 2000 Board decision from opposer's attorney, but applicant stated it is still without a good quality copy of the Board decision. In view thereof, a copy of the June 27, 2000 Board decision is enclosed herewith for applicant's attorney.

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product itself; (2) the Board did not properly weigh evidence regarding consumer care; and (3) the Board did not properly evaluate the strength of opposer's marks. Later, on page 13, in the "conclusion" section of its request, applicant set forth the following six asserted errors by the Board: (1) improperly basing our analysis on the similarity of the parties' goods and services on a comparison of opposer's services with a component of applicant's goods and not on the goods themselves despite "unrebutted evidence that consumers will not care about the components of applicant's product"; (2) failing to independently evaluate the conditions under which, and buyers to whom, sales would be made, and, instead, treating this du Pont<sup>2</sup> factor as a sub-element of the similarity or dissimilarity of the goods and services; (3) improperly ignoring the evidentiary weight that should have been accorded the third-party registrations introduced to show that "SKY" has been "commonly adopted in connection with communications related services"; (4) improperly considering statements outside of the evidence in evaluating the third-party registrations; (5) improperly ignoring that opposer commissioned a consumer

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recognition survey and failed to introduce the results thereof; and (6) improperly ignoring that opposer admitted consumers do not associate "SKYPAGER" exclusively with opposer.

Inasmuch as applicant's initial list of three asserted errors is subsumed within its later list of six asserted errors, we will address the six alleged errors.

Applicant's argument regarding our finding on the relatedness of the goods and services is not well taken, and our factual finding on this du Pont factor is fully supported in our original decision. Simply put, we did not compare a component of applicant's goods with opposer's services. Rather, as we are constrained to do, and as explained in the original decision, we compared applicant's goods as identified in the application with opposer's services as registered. Applicant's identification of goods reads "vehicle anti-theft systems comprising cellular telephones, pagers, two way pagers, and satellite signal processors." A fair and reasonable reading of this identification is that applicant intends to sell a "system" (not a "device," a term used frequently in applicant's request for reconsideration) composed of not one, but all of the items listed--

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<sup>2</sup> In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ

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"cellular telephones, pagers, two way pagers and satellite signal processors" (emphasis added). Moreover, in applicant's business plan (a "confidential" exhibit to applicant's co-founder Harvey Carmel's testimony) under the heading "Technology Description," applicant clearly emphasizes the significant role that paging goods and services will play in the operation of applicant's system. For example, it includes statements such as "SKYLOCK uses a specially designed digital controller that is activated by signals from existing paging networks"; "[i]t is important that we have a sound long term relationship with paging providers"; and "[a] paging service will be selected that can provide nationwide coverage."

Moreover, while applicant again argues that only one of the types of "backbones" for the system will be selected, the identification of goods is not so limited. Harvey Carmel, applicant's co-founder, testified that applicant has not commenced use and that paging services remain a viable option for the operation of applicant's system. In addition, Mr. Carmel's testimony that

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applicant's customers will not be concerned about which backbone system is used is mere speculation.<sup>3</sup>

Further, both the record and our previous decision reflect that opposer has worked with other companies to offer services other than paging, including businesses such as a monitoring of courier boxes and of vending machines, as well as a partnership with a company to work on "developing" a vehicle monitoring system (albeit the latter has not yet evolved).

We are not convinced by applicant's attempt to distinguish the case of *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984). There is no requirement in the Martin's case that in order for the Board to find goods and/or services are complementary, we must essentially find the same facts as the Court found with regard to "wheat bran and honey bread" and "cheese."

We find no error in our factual finding that applicant's "vehicle anti-theft systems comprising cellular telephones, pagers, two way pagers, and

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<sup>3</sup> We note opposer's objection to applicant's argument in footnote 4 of applicant's request for reconsideration. Opposer contends, and we agree, that the information in footnote 4 is an untimely attempt to introduce unsubstantiated evidence regarding the likely degree of care of purchasers. The information in applicant's footnote 4 has not been considered.

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satellite signal processors" and opposer's "paging" and "messaging" services are complementary and related.

Regarding our finding about the conditions under which, and the buyers to whom, sales would be made, this is again a factual finding with which applicant simply disagrees. Our decision was clear that (i) the goods and services, as identified, carry no restrictions at all, making applicant's argument that it will target fleet vehicle owners irrelevant; and (ii) even if opposer's core customer base is frequent business travelers, and its target market is all males ages 25 to 45, applicant's co-founder testified that applicant's vehicle anti-theft system could be used in passenger cars, showing that applicant's goods could be directed to the general public, thereby encompassing opposer's target customers. Thus, there is no error in our finding that the conditions of sale and the purchasers for the involved goods and services overlap.

Applicant next contends that we improperly ignored the weight to be accorded the third-party registrations submitted by applicant to show the weakness of the term SKY in connection with communications services. This is again reargument of arguments previously made, specifically that the third-party registrations show the

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SKY prefix has been commonly adopted. As we pointed out in our previous decision, none of applicant's third-party registrations cover the specific goods/services involved herein, namely "paging services" or "vehicle anti-theft systems." The mere fact that a word is registered by others for other goods and/or services, does not establish that the word is commonly adopted and thus weak in the relevant field. Further, importantly, the registrations are not evidence of use or that the public is familiar therewith. See *Smith Brothers Manufacturing Company v. Stone Manufacturing Company*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *AMF Incorporated v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 USPQ 268 (CCPA 1973).

Applicant argues that the Board went outside the record and discounted the evidentiary weight of the third-party registrations because we considered opposer's argument in its reply brief regarding ownership and settlement or license agreements in relation to some of the third-party registrations. Even assuming that we now completely ignore opposer's attorney's statements on ownership or settlement/license agreements, nonetheless, the most relevant fact remains that applicant submitted no evidence of the public's awareness of the third-party

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marks in the marketplace. Thus, even considering all of the third-party registrations, they are still accorded very little weight in the circumstances of this case. In view of the above, and because we also held that opposer established a family of SKY prefix marks, we find no substantive error in the weight accorded the third-party registrations made of record by applicant.

Applicant argues that it is error for the Board to ignore "the fact that opposer commissioned a consumer recognition study and failed to introduce the results"; and further, that the Board should accept as fact that "opposer's failure to introduce the results of the survey means that the survey results were not favorable." These arguments are specious. First, even applicant acknowledges that evidence to gauge the strength of a mark may be submitted through direct or circumstantial evidence. Thus, opposer is not obligated to submit direct consumer evidence. (In this case, opposer established that its family of marks are entitled to a broad scope of protection through circumstantial evidence, e.g., its numerous federal registrations, and testimony by opposer regarding, inter alia, marketing and advertising strategies, expenditures, sales, trade channels, and the manner of use of opposer's family of

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marks.) Second, opposer's witness testified as follows regarding the "branding studies" (not "consumer recognition surveys" as characterized by applicant in its request for reconsideration) (McKelvey dep., p. 43):

Q. Do you recall any earlier studies?

A. Yeah, there were some branding studies done a few years back, but off the top of my head, I can't remember what the recall was for our brand.

Applicant apparently did not obtain discovery regarding such studies, and, in any event, applicant did not pursue this matter at trial. Thus, applicant cannot now be heard to complain that little is known in this record about any "branding studies" conducted by opposer. There is absolutely no evidence on which the Board could make any inference (negative or positive to opposer) about the branding studies in question. In fact, the studies could involve marks, and or goods/services unrelated to those involved herein.

Finally, applicant's argument that we improperly ignored opposer's admission that consumers do not associate one of opposer's marks, SKYPAGER, exclusively with opposer is unconvincing. Applicant relies on a portion of the testimony of opposer's witness, McKelvey, to assert that opposer's mark SKYPAGER has been used descriptively by consumers, and thus, the weight accorded

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that mark is diminished. The involved testimony (McKelvey dep., pp. 43-44), was in response to the question "Can you explain why SkyTel has selected or adopted several marks that all begin with the word 'Sky'?" and the witness' full response is set forth below:

When we first started off with SkyTel - I think it was back in 1988 when we started using the SkyTel brand for the company, we were the first to offer nationwide paging and we chose a product name for our first nationwide numeric pager called SkyPager. And SkyTel was the only company that had a nationwide frequency and could deliver nationwide paging and became the defacto standard for nationwide paging back in the late '80s and early '90s. *And the SkyPager became so well known and so popular that people actually begin to refer to all nationwide paging or paging as "Sky page me." They started using it as a verb, and the SkyPager became quite well known, and it's still used quite often regardless of the paging company; "Why don't you just send me a Sky page?"* (Applicant relies on the portion in italics.)

We simply do not read opposer's testimony to have the breadth and the specific legal meaning that applicant reads into it. This testimony is from a lay witness, and, taken in context, appears to emphasize the success and renown of opposer's business and SKYPAGER mark. Even

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if we were to interpret this testimony as evidence of public misuse of opposer's SKYPAGER mark, applicant did not counterclaim to cancel opposer's registrations for SKYPAGER. Applicant cannot be heard to attack the validity of opposer's SKYPAGER registrations at this stage. Therefore, the SKYPAGER registrations are entitled to the full presumptions of the law under Section 7(b) of the **Trademark Act**.

Accordingly, we stand by our decision dated June 27, 2000, and applicant's request for reconsideration is denied.<sup>4</sup>

R. L. Simms

C. E. Walters

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

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<sup>4</sup> Applicant's motion to reset the time to file a notice of appeal is moot inasmuch as the time for appeal runs from the date of the decision on applicant's request for reconsideration. See Section 21(a)(2) of the **Trademark Act**, and Trademark Rule 2.145(d)(1).