

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 20, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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DraftWorldwide, Inc., by change of name from DraftDirect  
Worldwide

v.

Arnold Communications, Inc.

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Cancellation No. 27,229

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Patricia Hatry of Davis & Gilbert LLP for petitioner.

Gary H. Fechter of Hall Dickler Kent Friedman & Wood LLP for  
respondent.

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Before Seeherman, Chapman and Bucher, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

DraftWorldwide, Inc. has filed a petition to cancel  
Registration No. 2,133,481 on the Supplemental Register for  
the mark BRAND ESSENCE for "business and market analysis and  
research services."<sup>1</sup>

As grounds for cancellation petitioner alleges that  
since prior to respondent's first use petitioner or its

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<sup>1</sup> Registration No. 2,133,481 issued January 27, 1998, from an  
application filed on April 22, 1996. The claimed dates of first

predecessors in interest have continuously used the mark BRAND ESSENCE for "research services linking direct marketing with brand building"; that on November 10, 1997 petitioner filed an application for the mark BRAND ESSENCE for those services (Serial No. 75/386,980<sup>2</sup>), and respondent's registration will be an impediment to registration of petitioner's application; and that the existence of the registration will make it difficult for petitioner to enforce its prior rights in court.<sup>3</sup>

Respondent, in its answer, admits that petitioner filed application Serial No. 75/386,980 on November 10, 1997 for the mark BRAND ESSENCE; and otherwise denies the salient allegations of the petition to cancel.

The record consists of the pleadings; the file of the involved registration<sup>4</sup>; and the testimony, with exhibits, of

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use and first use in commerce are November 30, 1994 and January 1, 1995, respectively.

<sup>2</sup> Action on petitioner's application has been suspended by the Examining Attorney in Law Office 109 handling the application.

<sup>3</sup> While the petition to cancel is not particularly artfully drafted, it is apparent that petitioner is claiming priority and likelihood of confusion under Section 2(d) as the basis of the petition. See Fed. R. Civ. P. 8. To whatever extent it is necessary, the pleadings are considered amended to conform the pleadings to the evidence pursuant to Fed. R. Civ. P. 15(b), that is, to specifically include a claim of likelihood of confusion under Section 2(d).

<sup>4</sup> Petitioner stated in its brief on the case that its pending application also forms part of the record. Petitioner is incorrect. Its pending application is not in the record because it is not the subject of the Board proceeding as is respondent's registration [see Trademark Rule 2.122(b)(1)]; and petitioner did not otherwise make its pending application of record during trial by way of a notice of reliance [see Trademark Rule 2.122(e)] or as an exhibit to the testimony of the witness.

Jacqueline Silver. Respondent did not take any testimony or offer any evidence. Only petitioner filed a brief. An oral hearing was not requested by either party.

Inasmuch as respondent admits that petitioner filed an application (Serial No. 75/386,980) for the mark BRAND ESSENCE for research services linking direct marketing with brand building, petitioner's standing is established. See *The Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).

Jacqueline Silver testified<sup>5</sup> that since 1991 she has been an independent marketing and advertising consultant and for about 20 years prior thereto she worked for different major advertising agencies; that in 1986, while working for the Ted Bates advertising agency (a predecessor of petitioner), she created the trademark BRAND ESSENCE used for a market research service, which provided a way to fully study the brand positioning and identify the core-related image criteria for the brands of clients; and that petitioner, and its predecessors, have since 1986 continuously used the mark BRAND ESSENCE in connection with petitioner's services. (See exhibit Nos. 3-11, consisting of client presentations, workshops or consumer studies, and dated from 1987-1998.)

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<sup>5</sup> Respondent did not attend the deposition of Ms. Silver.

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Petitioner, having established continuous use of its mark in connection with its services since 1986, has proven priority over respondent.

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The marks are identical, and the services are virtually identical, as petitioner's specific research services are encompassed within respondent's "business and market analysis and research services." We therefore find that there is a likelihood of confusion in this case where the identical mark is used by both petitioner and respondent in connection with essentially the same services. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Decision: The petition to cancel is granted, and Registration No. 2,133,481 will be cancelled in due course.

E. J. Seeherman

B. A. Chapman

D. E. Bucher  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board