

9/27/01

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

Hearing:  
April 12, 2001

Paper No. 69  
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board  
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E.I. duPont de Nemours and Company  
v.  
duPont Publishing, Inc.  
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Opposition No. 109,415  
to application Serial Nos. 75/094,850; 75/100,959;  
75/123,644; and 75/128,916  
filed on April 26, 1996; May 1, 1996; June 21, 1996; and  
July 2, 1996, respectively.  
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Dickerson M. Downing and Kathryn E. Diaz of Morgan & Finnegan, L.L.P. and David J. Gould for E.I. duPont de Nemours and Company.

J. Douglas Baldridge of Howrey Simon Arnold & White, LLP for duPont Publishing, Inc.  
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Before Hohein, Hairston and Holtzman, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

duPont Publishing, Inc. (applicant) has filed four applications to register the following marks:

- (1) DUPONT REGISTRY in typed capital letters for "magazines advertising the goods and services of others featuring a wide variety of

collectible, customized luxury services, consumer products and real estate properties" in class 16 and "computer services, namely, providing on-line serial magazine featuring collectible, customized luxury services, consumer products and real estate properties provided on-line by means of a global computer information network" in class 42;<sup>1</sup>

- (2) DUPONT REGISTRY in typed capital letters for "promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed by a global computer network, and promoting the goods and services of others through the distribution of serial magazines on the topic of luxury, collectible and customized services, items and properties" in class 35;<sup>2</sup>
- (3) DUPONT REGISTRY and design as shown below,

for "all purpose sport bags" in class 18; "non-metal key chains" in class 20; "coffee mugs" in class 21; "T-shirts, caps" in class 25; and "golf balls and golf tees" in class 28;<sup>3</sup> and

- (4) DUPONTREGISTRY.COM in typed capital letters

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<sup>1</sup> Serial No. 75/094,850, filed April 26, 1996, alleging dates of first use of January 10, 1985.

<sup>2</sup> Serial No. 75/100,959, filed May 1, 1996, alleging dates of first use of January 10, 1985. The application was subsequently amended to seek registration under the provisions of Section 2(f) of the Trademark Act.

<sup>3</sup> Serial No. 75/123,644, filed June 21, 1996, alleging dates of first use of January 10, 1985.

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for "promoting the goods and services of others by preparing and placing advertisements in an electronic magazine accessed through a global computer network" in class 35; "electronic

transmission of data and documents via computer terminals and electronic mail service" in class 38; "dissemination of educational materials in the fields of automotive mechanics, vehicle restoration and repair, vehicle driving instruction, fitness instruction, yachting, airplane flight and navigation instruction, antiques and antique exhibitions, fashion, wine and wine festivals, sports instruction, namely, golf and golf exhibitions, tennis and tennis exhibitions, polo and polo exhibitions, gemology and jewelry, art and art exhibitions, dissemination of educational materials on the subject of horse showing, breeding and training, dog showing, breeding and training" in class 41; and "providing information on a wide range of subjects via a global computer network" in class 42.<sup>4</sup>

Registration of each of applicant's marks has been opposed by E.I. duPont de Nemours and Company (opposer). In the amended notice of opposition, opposer alleges that for many years it has used the trade name and mark DUPONT and variations thereof for the manufacture, sale and distribution of a wide variety of products, including chemicals, fibers, polymers, powders and petroleum products for end-use applications in virtually every type of industry; that as a result of extensive use and promotion, opposer's DUPONT marks have become famous; that opposer is the owner of a number of federal

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registrations for such marks; that applicant's use of its marks for the involved goods and services is likely to cause confusion with opposer's previously used and registered marks; and that applicant's use of its marks will dilute opposer's DUPONT marks.

Applicant, in its answer, has denied the salient allegations of the amended notice of opposition<sup>5</sup> and asserts the affirmative defenses of laches, acquiescence, and equitable estoppel.<sup>6</sup> Further, applicant asserts that refusing to register its marks would interfere with applicant's fair use of its marks which incorporate the surname of Thomas L. duPont, applicant's president and chief executive officer.

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<sup>4</sup> Serial No. 75/128,916, filed July 2, 1996, alleging dates of first use of June 10, 1996.

<sup>5</sup> We note that as a result of an inadvertence, applicant was not allowed time to amend its answer in response to opposer's amended notice of opposition which added a claim of dilution. However, inasmuch as applicant has contested the claim of dilution on the merits, we deem applicant's answer to be amended to deny the allegations relating to the claim of dilution.

<sup>6</sup> We note that applicant also asserts as an "affirmative defense" that "[t]here is no likelihood of confusion between Applicant's marks as they are used in commerce and the alleged marks of opposer as they are used in commerce." Apart from the fact that this is not a proper affirmative defense, it is pointed out that, in determining likelihood of confusion with respect to applications for and/or registrations of marks in typed capital letters, we must consider all reasonable manners in which the marks could be depicted, and not simply the manner in which the marks are actually used. For applications and/or registrations involving marks in a stylized format, we must consider the marks as depicted therein.

Finally, in paragraphs 14 and 15 of the answer, applicant asserts that:

14. In the alternative, Applicant is at least entitled to registration of the mark "DUPONT REGISTRY" [in typed capital letters] for magazines advertising the goods and services of others featuring a wide variety of collectible, customized luxury services, consumer products and real estate in international class 16; and to registration of "DUPONT REGISTRY" [in typed capital letters] for promoting the goods and services of others through the distribution of serial magazines on the topic of luxury, collectible and customized services, items and properties in international class 45.

15. In the alternative, applicant is at least entitled to registration of the stylized version of the "DUPONT REGISTRY" mark, for magazines advertising the goods and services of others featuring a wide variety of collectible, customized luxury services, consumer products and real estate in international class 16; and to registration of "DUPONT REGISTRY" for promoting the goods and services of others through the distribution of serial magazines on the topic of luxury, collectible and customized services, items and properties in international class 35.<sup>7</sup>

The record includes the pleadings; the files of the four involved applications; and the testimony, with exhibits, of opposer's witnesses Kathleen H. Forte, Jeffrey Brown, James Moore, John Murray, Alfred Strolle, Harry O'Neil, and Scott Gostyla. Opposer also submitted

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<sup>7</sup> With respect to paragraphs 14 and 15 of the amended notice of opposition, we should point out that applicant subsequently filed motions to formally amend Serial Nos. 75/123,644 and 75/128,916 to limit the identification of goods and services therein. These motions will be discussed infra.

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by way of notices of reliance certified copies of the over fifty registrations owned by opposer; excerpts of printed publications; portions of the discovery depositions of Kathleen H. Forte, John Murray and Weston Anson; and copies of: The Congressional Record Proceedings concerning the Federal Trademark Dilution Act of 1995; 104<sup>th</sup> Congress,

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House of Representatives 1st Session 104-374 Report on the Federal Trademark Dilution Act of 1995; New York State Legislative Annual S.I. 1970, Pr. 3055, Mitchell Ch. 630 (1954); and McKinney's Session Laws of 1954, Chapter 630.

Applicant submitted the testimony depositions, with exhibits, of its witnesses Thomas L. duPont, Michael Rappeport and Howard Shimmel. Applicant additionally made of record by way of notice of reliance portions of the discovery depositions, with exhibits, of Kathleen H. Forte, James L. Moore, Alfred H. Strolle, Weston Anson, John Murray and Thomas L. duPont; copies of printed publications; certified copies of certain registrations owned by applicant; and opposer's responses to applicant's interrogatories.

Each party undertook a survey on likelihood of confusion and introduced its own survey evidence. Numerous objections have been raised by both parties relative to the testimony and other evidence in this case. Suffice it to say that these objections have been taken into account during our determination of the issues herein. Both parties

filed briefs on the case<sup>8</sup> and both participated in oral argument.

**THE PARTIES**

***Opposer***

Opposer, E.I. duPont de Nemours and Company, was founded by Eleuthère Irénéé duPont in 1802. It began as a manufacturer of gunpowder, but has evolved into a world leader in science and technology, with a product line that includes chemicals, fabrics and fibers, polymers, pigments, performance coatings, polyesters, pharmaceuticals, agricultural and nutritional products. It is the largest chemical company in the world with 92,000 employees worldwide and 54,000 in the United States. Opposer has manufacturing and processing facilities in forty countries. In 1998, opposer's U.S. sales revenue exceeded \$13 billion and it ranked 16<sup>th</sup> on the *Fortune 500* list of America's largest corporations.

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<sup>8</sup> We note applicant's motion to strike opposer's reply brief as exceeding the 25-page limitation. Although opposer's reply brief is 25 pages, opposer filed along with its reply brief a 4-page paper styled "Memorandum On Evidentiary Matters." It is applicant's position that the evidentiary objections raised in this memorandum should have been included in opposer's reply brief, and thus, "the true reply [brief] exceeds the page limitation by 4 pages." While a party may include evidentiary objections in its brief, it is not prohibited from filing a separate motion or paper detailing such objections. In view thereof, applicant's motion to strike opposer's reply brief as exceeding the 25-page limitation is denied.

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Kathleen Forte, opposer's vice-president for global public affairs, testified that since 1802 opposer has used the name "DuPont" or "DuPont Company". In addition, since the early 1900's, opposer has used the "DUPONT Oval" mark shown below.

Opposer's current company policy calls for the "DUPONT oval" mark to be displayed, at least once, on all company products and communication materials. Opposer also uses the identifying phrase "Only From DuPont" on certain product packaging, labeling and in advertising.

Opposer has over two-thousand products and owns over fifty trademark registrations, dating from as early as 1922, for the "DUPONT oval" mark. These registrations cover, inter alia, chemicals, pharmaceuticals, construction materials, paints, measuring instruments, machine parts, adhesives, film, fiber, acids, explosives, pigment, fabrics, laminates, x-ray machines, and biomedical devices. Opposer also owns several registrations for the mark DUPONT REFINISH RACING and

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design for clothing, flags, banners, household utensils, mugs, beverage containers and glasses. Each of opposer's registrations is valid and subsisting. A 1994 valuation study conducted by Trademark Licensing Associates, Inc. estimated the DuPont trade name and mark to be worth between \$11.3 and \$15.1 billion.

Most of opposer's products are sold "business-to-business." The "business-to-business" products that opposer maintains are most relevant to this proceeding include automotive paints, parts and safety devices; paint, nylon, and boat hull material for the boating industry; materials incorporated in clothing used in sporting activities; and materials used in sporting goods such as skis and tennis rackets. A few of opposer's products are sold directly to consumers and these brands include TEFLON bakeware liners, DACRON and COMFOREL pillows, COOLMAX fabric, TYVEK home insulation, STAINMASTER carpet, and CORIAN solid surfaces. Since the early 1900's, opposer has owned The Hotel DuPont in Wilmington, Delaware and opposer's consumer brand products are used in the hotel.

Opposer engages in two basic levels of advertising. First, it has regularly promoted the overall DUPONT "brand" in national broadcast and print advertising since

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the 1930's. Second, opposer's strategic business units also engage in advertisements in selected media for their respective product lines. Since 1985, opposer has spent approximately \$200-250 million on corporate advertising and \$1 to 1.5 billion on product advertising.

Opposer actively promotes the DUPONT mark and is a current sponsor of NASCAR race car driver Jeff Gordon. Opposer also sponsors an annual sailboat show in Annapolis, Maryland and participates in boat shows including the Fort Lauderdale International Boat Show. From 1990-1997 opposer sponsored the Tour DuPont bicycle race. According to Ms. Forte, opposer has sold DUPONT branded merchandise such as T-shirts, caps, sport bags, key chains, coffee mugs and the like.

Opposer has published a periodical known as *DuPont Magazine*, at least four times a year, since 1913. The purpose of the magazine is to describe the company's products and services and to promote the company's contributions to society. The magazine is distributed, free of charge, to approximately 110,000 current and former employees, and 125,000 additional individuals such as corporate executives, federal, state and local elected leaders, educators and members of the media.

**Applicant**

Applicant, duPont Publishing, Inc., was founded in 1984 by Thomas L. duPont, who is a descendant of the founder of opposer. Applicant's business is the publication of three magazines that primarily contain pictorial advertising for automobiles, homes, and boats, respectively. Applicant published its first magazine, primarily devoted to automobiles, in March 1985. Applicant subsequently expanded to separate magazines devoted to luxury yachts and homes, and to internet services and promotional items. The magazines are available at newsstands and by subscription, and retail for between \$5.00 and \$7.00 a copy. Applicant's magazines and services are directed to the high-end market and indeed a readership study of its magazine devoted to automobiles shows that the average reader is male, has a net worth of \$1.2 million and an annual income of \$172,000, and owns four vehicles.

Applicant has advertised in *Playboy* and *Forbes* magazines. Applicant has engaged in the partial sponsorship of golf tournaments and has participated at various boat shows, including the same show in Fort Lauderdale that opposer attends. Applicant sells and distributes branded merchandise, such as T-shirts, caps,

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sports bags, coffee mugs and golf balls, under its DUPONT REGISTRY marks.

**PRIORITY**

Because opposer has made of record certified copies of the registrations upon which it relies, which show such registrations to be subsisting and owned by opposer, priority of use is not an issue in this proceeding. King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, the record establishes opposer's priority with respect to use of the DuPont trade name and "DUPONT oval" mark.

**LIKELIHOOD OF CONFUSION**

Our determination of likelihood of confusion under Section 2(d) is based on all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See In re E. I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding now before us are discussed below.

***Fame of Opposer's Mark***

The first relevant factor in this case is the fame of opposer's mark. Before discussing this factor, however, we must address applicant's contention that the "DUPONT oval" is the only mark on which opposer may rely

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in this proceeding. Stated differently, applicant contends that opposer is not entitled to rely on simply the term DUPONT.

The record herein shows that opposer is the owner of over fifty registrations for the "DUPONT oval" mark. Although opposer has made no registrations of record which cover DUPONT alone, opposer's witness testified that opposer has used DuPont and DuPont Company as trade names since well prior to applicant's dates of first use. Moreover, it is obvious that when the "DUPONT oval" mark is spoken, it is simply DUPONT and not "DUPONT in an oval." The oval operates as a vehicle for display of DUPONT. As used in the foregoing manners, DUPONT creates a commercial impression separate and apart and thus opposer has rights in DUPONT per se. Thus, notwithstanding applicant's arguments, we find that opposer is also entitled to rely on DUPONT alone.

With the foregoing in mind, we turn to a consideration of the fame of the DUPONT mark. Thomas L. duPont, applicant's Chairman and Chief Executive, has acknowledged that the DUPONT mark is "well-known." (Dep. Page 35). However, applicant maintains that the DUPONT mark's fame is "limited", i.e., it does not extend beyond chemicals and ingredient-type products, and that

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consumers are not likely to be confused vis-à-vis applicant's DUPONT REGISTRY marks for magazines and associated products and services which feature collectible and luxury products and services.

Opposer, in discussing the fame of the DUPONT mark in its brief, does not point to any particular products for which the mark is famous. Rather, it is opposer's position that, because the DUPONT mark is used with an extensive line of products and services "ranging from bulk chemicals to a luxury hotel" (Brief, p. 22), the fame of the mark encompasses many different products, services and fields.

Opposer points to a 1997 Corporate Image Tracking Study conducted by Opinion Research Corporation which opposer maintains shows that the "aided awareness" of DUPONT among upscale consumers is 100%. Further, opposer argues that this same study shows that it has a leading presence in a number of fields. The survey was based on a total of 1,121 telephone interviews conducted among upscale consumers, and influential individuals involved in investment, government, business, media, and academia. The upscale consumer audience, of which there were 612 persons, was defined as individuals who meet the following minimum qualifications: 25 years of age,

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\$50,000 household income and some college education. In response to the question, "In which of the following markets (listed below) do you feel DuPont has a leading presence?", the percentage of respondents saying "Yes" was as follows:

Medical and Health	60%
Automotive	48%
Fashion/apparel	46%
Home furnishings	44%
Sports/equipment	37%
Printing/Publishing	20%

As further proof of the fame of the DUPONT mark, opposer made of record three articles as examples of the media attention which it receives. The first article is titled "There Will Always Be A DuPont" from the October 13, 1997 issue of *Forbes* magazine. The article begins with "Fortunes come and go, companies wax and wane, but the DuPont company-almost alone in U.S. industry-has managed to stay on top throughout this century." Another article, which appeared in the January 11, 1999 edition of *The Wall Street Journal*, is titled "It Began With Gunpowder," and begins with "The history of DuPont speaks volumes about the history of the modern corporation." A third article appeared in the May 11, 1998 issue of

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Barron's magazine and featured on its cover a photograph of opposer's Chief Executive with the caption "THE NEW DUPONT."

Opposer's witness, Ms. Forte, testified that the DUPONT mark has been in use for well over 100 years and the record establishes that the mark has been extensively advertised and promoted throughout the U.S. since the 1930's. Moreover, opposer owns over fifty registrations for an array of products, with the first registration being issued as early as 1922. We also note that in the case of *G. B. Kent Sons, Ltd. v. P. Lorillard Co.*, 114 F.Supp. 62, 98 USPQ 404 (S.D.N.Y. 1953), "DuPont" was characterized as a household name. Additionally, we note that the legislative history of the recently enacted *Federal Trademark Dilution Act* cites DUPONT as an example of a famous mark.

We conclude that by virtue of its long use, considerable advertising and promotion, the breadth of products and services it covers, the extent of the sales thereunder, and the substantial publicity it has received, DUPONT is an exceptionally famous mark. Contrary to applicant's contention, this fame is not "limited" to opposer's principal products, i.e., chemicals and ingredient-type products, but extends to

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essentially all of its goods and related products. In this regard, we are particularly mindful of our primary reviewing court's instruction in *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000), in its decision remanding that case to the Board (footnotes omitted):

The Board erred when it limited the weight accorded to the fame of the FRITO-LAY mark. We think that the Board's rule--that the fame of the FRITO-LAY mark extends no further than the products with which the marks are currently used--undercuts the legal standard of protection for famous marks. Famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark. For this reason this court emphasizes:

When an opposer's trademark is a strong, famous mark, it can never be "of little consequence." The fame of a trademark may affect the likelihood purchasers will be confused inasmuch as less care may be taken in purchasing a product under a famous name.

We are obliged, therefore, to accord the fame of opposer's DUPONT mark full weight in our likelihood of confusion determination.

Before leaving this factor, two arguments made by applicant require comment. First, applicant maintains that the fame of the DUPONT mark emanates from the famous duPont family and that there has been an understanding for 200 years establishing the boundary between the duPont family and opposer. Apart from the fact that

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applicant failed to present evidence regarding the "fame" of the duPont family, the evidence herein establishes that the DUPONT mark has become famous as result of opposer's extensive efforts. Moreover, it is well settled that when one elects a family surname as a trademark or as part of a trademark, the name, for that purpose, is severed from the owner's personality and registrability thereof is subject to the same consideration as other types of marks, including the prohibition of Section 2(d) against the registration of marks where confusion, mistake or deception is likely to occur. See *Ford Motor Co. v. Ford*, 162 USPQ 418 (TTAB 1969).

Second, with respect to applicant's argument that its DUPONT REGISTRY marks are famous in their own right, the record falls far short of demonstrating that applicant's marks are so well known as to be famous. Cf. *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1456 (Fed. Cir. 1992).

***Similarity/Dissimilarity of the Marks***

The second relevant factor is the similarity or dissimilarity of the parties' marks. While the marks must be compared in their entirety, it is nevertheless the case that, in articulating reasons for reaching a

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conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.3d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's DUPONT REGISTRY, DUPONT REGISTRY and design, and DUPONTREGISTRY.COM marks contain opposer's DUPONT mark in their entireties. The first word in each of applicant's marks is DUPONT and "it is often the first part of the mark which is most likely to be impressed upon the mind of a purchaser and remembered." See Presto Products, Inc. v. Nice-Pak Products, Inc., 9 USPQ2d 1895 (TTAB 1988). Moreover, in view of the fame which opposer's DUPONT mark has achieved, we think that it is this well known term which the public would view as the dominant part of applicant's DUPONT REGISTRY, DUPONT REGISTRY and design, and DUPONTREGISTRY.COM marks. When considered in their entireties, applicant's DUPONT REGISTRY marks are similar in sound, appearance, and commercial impression to opposer's DUPONT mark. We should add that the ".COM" portion of applicant's DUPONTREGISTRY.COM mark has no source-indicating

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significance and does not serve to distinguish the parties' marks.

With respect to opposer's DUPONT mark and applicant's DUPONT REGISTRY and design mark in particular, we note that when one of the marks comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods. See *In re Appetito Provisions Co.*, 3 USPQ2d 1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scutto*, 228 USPQ 461, 462 (TTAB 1985). Thus, in analyzing these marks, it is appropriate to accord greater weight to the words DUPONT REGISTRY because these words would be used by purchasers to request applicant's magazines, in particular.

***Third-Party Use***

Where there is evidence of widespread and significant use by third parties of marks containing elements in common with marks being opposed, such evidence has been considered by the Board to demonstrate that confusion is not likely. In this case, the overwhelming majority of the evidence relied on by applicant falls far short of being accorded any probative value. In particular, the search report listing of

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third-party registrations and purported common law uses of "DuPont" identified in opposer's interrogatory answers is not competent to establish that the listed marks and names are, or have been, in use. Similarly, the telephone directory listings are not persuasive to show any weakness of opposer's DUPONT mark because this evidence does not show the extent to which the various names therein have been used. The remaining evidence, i.e., a few DuPont classic automobiles; the use of the mark S.T. DUPONT in a stylized format for lighters, pens and the like (per an agreement with opposer); and a web page for Dupont Associates for a consulting firm, do not constitute widespread or significant third-party use such that the strength of opposer's mark, including its particular fame as indicated above, is lessened.

***Actual Confusion***

Opposer offered evidence of asserted instances of actual confusion. Opposer's vice-president for global affairs, Kathleen Forte, testified that opposer's telemarketing center receives several calls a week intended for applicant and in some weeks receives as many as ten such calls. Ms. Forte indicated that this information was relayed to her by Cindi Hearn, the supervisor at opposer's corporate telemarketing center.

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Jim Moore, editor of opposer's *DuPont Magazine*, testified that he receives at least three or four calls a year from persons who want to speak to someone from applicant duPont Publishing, Inc. Further, Thomas duPont, applicant's Chairman and Chief Executive Officer, testified that, among two million incoming calls over a fifteen-year period, his employees had received seventeen misdirected telephone calls.

Applicant has objected to the testimony of Ms. Forte as inadmissible hearsay. As regards the other asserted instances of actual confusion, applicant maintains that they are insignificant in number. We agree with applicant that the Forte testimony is hearsay. We note in this regard that the information relating to the telephone calls was gathered for the purposes of this proceeding, and it does not appear that such information was maintained in the regular course of business. Moreover, as to the telephone calls received by the editor of *DuPont Magazine*, it is not clear whether these contacts were made on the basis of applicant's trade name, i.e., duPont Publishing, Inc., rather than on the basis of applicant's DUPONT REGISTRY marks. Further, as to the telephone calls received by applicant, they are insignificant in number. In short, we conclude that

these asserted instances of actual confusion are of little probative value.

***Goods/Services***

The parties have spent a considerable amount of time during trial and in their briefs on the issue of the relatedness of the involved goods and services.

Opposer's position essentially is that the goods and services listed in applicant's applications either overlap or are related to the extensive goods and services which have been offered by opposer under the DUPONT mark. Opposer argues that the parties' goods and services are related because opposer has been involved in the primary product areas featured in applicant's magazines and on-line services, namely, autos, homes and boats, for decades. In particular, opposer points to the fact that a number of its products are used in autos, homes and boats. Finally, opposer argues that both parties distribute magazines and some of the identical items of branded merchandise, namely, sports bags, T-shirts, and caps.

Applicant, on the other hand, argues that the fact that some of opposer's ingredient-type products ultimately make their way into automobiles, homes and boats, i.e., the consumer products featured in

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applicant's magazines, does not mean that opposer's goods and applicant's magazines and associated goods and services are closely related for likelihood of confusion purposes.

There is no evidence in this record that opposer's principal products, namely, chemicals and ingredient-type products and applicant's type of magazines and associated goods and services are offered by the same companies. Nor is there evidence how these particular goods and services would be encountered by the same classes of purchasers. In this regard, we note that opposer's witness has acknowledged that most of opposer's chemical and ingredient-type products are sold "business-to-business" and may be "invisible" to the ordinary consumer. (Murray at 10). Thus, we cannot say on this record that opposer's chemicals and ingredient-type products and applicant's magazines and related goods and service are closely related goods and services.

Nonetheless, the record does show that opposer uses the DUPONT mark on an extensive line of products, several of which are consumer products and several of which are items of branded merchandise; that opposer distributes a magazine under the name *DuPont Magazine*; and that opposer operates a luxury hotel under the name Hotel DuPont.

**Survey Evidence**

In support of its position that confusion is likely, opposer offered the results of a consumer survey commissioned by it for use in this case. The survey was designed by and conducted under the direction of Harry O'Neil, Vice-Chairman of the Roper Division of Roper Starch Worldwide. It was a mall intercept survey of 209 respondents, all men, and its purpose was "to ascertain whether and, if so, to what extent relevant consumers might believe that the DUPONT REGISTRY magazines are put out by [opposer]." The interviewer handed each respondent an exhibit card with the words DUPONT REGISTRY and asked question 1 as follows:

The name shown on this card is used on magazines that advertise the goods and services of others featuring automobiles, books, real estate, and other luxury products and services. From the name shown here [DUPONT REGISTRY - on the exhibit card], what company would you say puts out these magazines, or would you say you don't have any idea?"

Eighty-eight (88) respondents, or 42%, answered DUPONT or stated a response that contained the word DUPONT. These 88 respondents were then asked:

Why do you think (answer to Q. 1) is the company that puts out the magazines with this name. (PROBE) What else?

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The most frequently given reasons to this question were because it says DuPont (37 respondents or 42%) and that DuPont is the name of the magazine (11 respondents or 13%).

In order to determine if these "DUPONT" responses were merely recitations of the word on the exhibit card or were meant to indicate opposer, the two questions below (nos. 3 and 4) were asked of the 88 respondents. The responses which are designated with an asterisk(\*) are considered to indicate that the respondents were referring to opposer.

What, if anything, can you tell me about DuPont, that is, what kind of company is it? (PROBE):  
What else?

<u>Kind of Company</u>	<u>%</u>	<u>No.</u>
*Chemical company	33	33
*Make paint	33	33
*Plastics	16	16
*Make synthetics	7	7
*Aluminum	5	5
*Rubber	4	4
*Household products	4	4
*Textiles/Fabrics	3	3
*Sponsors car racing	3	3
*Nylon	2	2

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*Research and development	2	2
Metal	2	2
Don't know	9	9
Other	15	15

What other products or services, if any, do you associate with DuPont? (PROBE): What else?

<u>Other Products &amp; Services</u>	<u>—%—</u>	<u>No.</u>
*Paint	12	12
*Chemicals	9	9
*Plastics	8	8
Magazines	4	4
*Carpets	3	3
*Cleaning Products	3	3
*Resins	2	2
*Rubber	2	2
*Household products	2	2
*Kitchenware	2	2
*Sponsors race cars	2	2
Cosmetics	2	2
Other	16	16
Nothing else	21	21
Don't know	28	28

Of course, with respect to questions three and four above, some respondents gave multiple responses. The

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responses were "netted" and it was determined that 85% of these respondents and 40% of the total survey respondents gave a response that "relates to [opposer]." It was Mr. O'Neil's opinion that this survey is "convincing evidence that among relevant consumers, a significant portion believe that the source of magazines using the DUPONT REGISTRY name is E.I. DuPont [opposer]." (Survey summary, p. 5.)

Applicant, during its testimony period, introduced its own survey conducted by R. L. Associates under the supervision of Dr. Michael Rappaport. This was also a mall intercept survey and 200 individuals were interviewed. Respondents were shown four magazines, one being applicant's DUPONT REGISTRY magazine featuring automobiles. The respondents were given time to look through each magazine, and in connection with the DUPONT REGISTRY magazine, the respondents were asked the following questions?

Question 1: Who do you think puts out this magazine?

Question 2: Do you think there is any other company that is involved with putting out or sponsoring this magazine?

Question 3: What is the name of that company?

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The table below shows the percentage of respondents who indicated that the DUPONT REGISTRY magazine is put out and/or sponsored by a company that has the word "DUPONT" in its name.

DUPONT	48%
DUPONT REGISTRY	9%
DuPont family/ The DuPonts/ Thomas I. DuPont	
6%	
DuPont Publishing	3%
DuPont Company/DuPont Chemical/The financial Part of the DuPont Company	3%
DuPont car company	1%
Net any mention "DUPONT" in Question 1 Or Question 3	70%
No mention of DUPONT" in Question 1 or Question 3	30%

All respondents who gave an answer that included the word "DUPONT" in response to either Question 1 or Question 3 were then asked the closed-ended follow-up question below:

Question 4 Although you may have already said this, which one or more of these, if any, do you think DUPONT REGISTRY is published by:

The table shows the results:

No mention of "DUPONT" in Question 1 or Question 3	30%
Net any mention "DUPONT" in Question	

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1 or Question 3	70%
Member of the family that started DuPont company that makes chemicals	21%
DuPont company that makes chemicals	16%
Person named duPont who is not part of the family that started DuPont company that makes chemicals	16%
None of these	16%
Don't know	7%

As a "control", all 200 of the respondents were then asked questions identical to those above with respect to the *Robb Report* magazine and a fictitious company with the name Robb Telecommunications Company. Based on the responses to these questions, it was determined that there was a 13% level of noise in the study. This 13% was subtracted from the 16% (DuPont company that makes chemicals) responses in the previous table. It was concluded from this survey that 3% of all respondents believed the DUPONT REGISTRY magazine was put out and/or sponsored by the DuPont company that makes chemicals, i.e., opposer. In particular, the survey states its conclusion as "no meaningful proportion of consumers are likely to be confused into believing that DUPONT REGISTRY magazine is published and/or sponsored by opposer." (Study, p. 11).

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Not surprisingly, each party has raised a number of objections and perceived flaws regarding its adversary's survey. As regards applicant's survey, opposer has alleged that an improper stimulus was used because respondents were presented with the mark DUPONT REGISTRY in a stylized format when two of the applications involved in this proceeding are for the mark DUPONT REGISTRY in typed capital letters; that the survey population was inappropriate in that it included too many women (i.e., 39.5%) when, according to applicant's readership survey, women constitute only 3% of its readership; and that the follow-up question, "Do you mean the DuPont Company that makes chemicals?", was prejudicial and limiting because it foreclose respondents who may associate opposer with other products.

Applicant takes issue with the universe of respondents in opposer's survey and argues that there was a failure to determine that the respondents were upscale consumers which is the audience for applicant's magazines. Further, applicant criticizes the fact that the respondents were not shown any of applicant's magazines or given an accurate description of the magazines. In addition, applicant maintains that no controls were used to eliminate guessing in the survey

and that one of the interviewers was being less than forthright in filling out the questionnaires.

Surveys are statistical evidence that can be an aid to the Board. It must be kept in mind, however, that survey evidence is only one factor to be considered in the overall determination of likelihood of confusion. We find both Messrs. O'Neil and Rappeport to be qualified as survey experts. In this case, both parties, with significant merit, have perceived flaws in the other's survey. Our skepticism about the reliability of the parties' surveys in this case is fueled by the virtually opposite results reached by each party, namely a confusion rate of forty percent (opposer's) versus three percent (applicant's). In view of the flaws noted above and the wide disparity in these surveys which purport to determine essentially the same thing, we find that neither survey is particularly reliable. All in all, neither survey is of any particular assistance to the Board in resolving the issue of likelihood of confusion.

***Laches, Estoppel and Acquiescence***

Applicant maintains that Thomas Murray, opposer's former brand manager, knew of applicant's magazines and related activities; encouraged applicant in its activities; knew that applicant intended to register the

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DUPONT REGISTRY mark; and indeed "ceded to registration of the DUPONT REGISTRY mark." (Brief, p. 36 ).

Applicant's President and

Chief executive officer, Thomas duPont, testified on direct examination that Mr. Murray had knowledge of applicant's magazines for some time, that Mr. Murray never objected to applicant's use of "duPont REGISTRY"; and that Mr. Murray "encouraged me in my endeavors and congratulated me on an attractive, upscale, high quality book". (pp. 202-203).

On cross-examination, Mr. duPont testified that he had "dozens" of conversations with Mr. Murray regarding applicant's magazines, the first having occurred during the initial year of publication; and that he sent copies of the magazines to Mr. Murray. On further questioning, Mr. duPont testified as follows:

Q. Did you ever tell Mr. Murray that the company planned to seek to register the words "duPont REGISTRY" in block print as a trademark in the United States Patent and Trademark Office?

A. Quote-unquote, no.

Q. Did you ever tell Mr. Murray that the company planned to register "duPont REGISTRY" in any format in the United States Patent and Trademark Office?

A. I'm certain that I told Mr. Murray we were going to register the trademark.

Q. When did that conversation occur?

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A. I have no recollection about when that was.

Q. But you are sure it took place?

A. I'm certain.

Q. Where did it take place?

A. I don't know.

Q. What did Mr. Murray say?

A. I don't recall.

Q. What exactly did you say.

A. I don't recall exactly what I said. That's what I said; I don't recall exactly.

It is essentially opposer's position that it did not know of applicant's intent to register the DUPONT REGISTRY mark in typed capital letters; and that it never consented to the use or registration of the DUPONT REGISTRY mark in typed capital letters. Opposer admits that Mr. Murray and some other DuPont representatives did see some of applicant's magazines at some point. However, according to opposer, these individuals saw the "composite mark" depicted on the magazines; e.g., DUPONT REGISTRY and the phrase "A Buyer's Gallery of Fine Automobiles" along with a steering wheel design on the automobile magazine.

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It is well settled that when the right to register is at issue, the affirmative defenses of laches, estoppel and acquiescence do not begin to run until the applications are published for opposition. National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1431-1432 (Fed. Cir. 1991) and DAK Industries, Inc. v. Daiichi Kosho Co., Ltd., 25 USPQ2d 1622 (TTAB 1992). In this case, opposer timely filed oppositions to the involved applications after publication of the marks, and thus, the defenses of laches, estoppel and acquiescence are not available to applicant here.

As regards applicant's contention that opposer consented to registration of the DUPONT REGISTRY mark, the testimony of Mr. duPont regarding his conversations with Mr. Murray lacks sufficient detail for us to conclude that Mr. Murray "ceded" to registration of the mark.

**DECISION**

After careful consideration of all the evidence of record bearing on the relevant duPont factors, we conclude that confusion is likely to result from the contemporaneous use of opposer's DUPONT mark and applicant's DUPONT REGISTRY marks on the parties'

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respective goods and services. In particular, we believe it likely that persons familiar with opposer's DUPONT mark, would be likely to believe that opposer is connected to applicant, in some way, if not directly, then by authorizing or sponsoring applicant's activities. We reach this conclusion by giving heaviest weight to the exceptional fame of the DUPONT mark and the fact that opposer uses its mark on a wide variety of goods and services. An additional factor which weighs in favor of this conclusion is the similarity in commercial impression of opposer's DUPONT mark and applicant's DUPONT REGISTRY marks. While we recognize that other than the items of branded merchandise, e.g., T-shirts, sport bags, and caps, none of the parties' goods and services are identical or closely related, we are mindful of our primary reviewing court's further instruction in *Recot*, supra at 1897 (emphasis added):

[The] reasoning [that famous marks are accorded more protection precisely because they are more likely to be remembered and associated in the public mind than a weaker mark] applies with equal force when evaluating the likelihood of confusion between marks that are used with goods that are not closely related, because the fame of a mark may also affect the likelihood that consumers will be confused when purchasing these products.

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Further, to the extent that we have any doubt on the question of likelihood of confusion, we must resolve that doubt against the newcomer inasmuch as the newcomer has the opportunity of avoiding confusion and is obligated to do so.

See TBC Corp. v. Holsa Inc., 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and In re Hyper Shoppes (Ohio) Inc., 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

In view of our decision finding a likelihood of confusion, we need not decide the issue of dilution.

Finally, as noted in footnote no. 7, applicant filed motions to amend the identification of goods in Serial Nos. 75/123,644 and 75/128,916. In addition, applicant filed motions to amend the dates of first use in Serial Nos. 75/094,850; 75/123,644; and 75/100,959. In view of our decision herein, the motions are moot. It is noted, however, that the evidence at trial supports the amendments to the dates of first use.

**Decision:** The opposition is sustained and registration to applicant is refused in each application.

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