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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
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Paper No. 9
Bottorff

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

DeLorme Publishing Company, Inc.
v.
The Buxton Company

Opposition No. 119,522
to application Serial No. 75/557,809
filed on September 22, 1998

Gordon H.S. Scott of Eaton Peabody for DeLorme Publishing
Company, Inc.

Geoffrey A. Mantooth of Decker Jones McMackin et al. for
The Buxton Company.

Before Hohein, Bucher and Bottorff, Administrative
Trademark Judges.

Opinion by Bottorff, Administrative Trademark Judge:

The Buxton Company, applicant herein, seeks
registration on the Principal Register of the mark MAPS
TO GO (in typed form) for "maps" in Class 16 and for
"market research services in the field of geographic

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information" in Class 35.¹ Applicant has disclaimed MAPS apart from the mark as shown.

DeLorme Publishing Company, Inc., opposer herein, filed a timely notice of opposition to registration of applicant's mark. As grounds for opposition, opposer alleged that it is the owner of a registration of the mark MAP'N'GO for

computer programs for retrieval and display of geographic data and related commercial, demographic, educational, natural resource, historical, travel and recreation information, and for production of route and trip directions, together with pre-recorded compact discs featuring a database containing the foregoing information, instructions and a printed atlas, all licensed and distributed as a unit

in Class 9,² that it has used its MAP'N'GO mark on such goods since July 1994, a date prior to applicant's date

¹ Serial No. 75/557,809, filed September 22, 1998 based on applicant's alleged bona fide intent to use the mark, Trademark Act Section 1(b).

² Registration No. 1,930,309, issued October 24, 1995. Opposer did not properly make its pleaded registration of record in this case. A plain photocopy of the registration (not status and title copies, as required by Trademark Rule 2.122(d)(1)) was attached as an exhibit to the notice of opposition. Another plain photocopy of the registration was introduced as an exhibit to the testimony deposition of opposer's witness Thomas Jensen, who testified (at page 10) that opposer is "the present owner" of the registration. Also, at page 16 of the April 16, 2001 deposition, the following exchange appears: "Q. This is the - this is the sixth year since registration. Does DeLorme intend to file a Section 8 affidavit for the Map - to refresh the

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of first of use of applicant's mark, that applicant's mark, as applied to applicant's identified goods and services, is likely to cause confusion, to cause mistake, or to deceive, and that it therefore is unregistrable under Trademark Act Section 2(d), 15 U.S.C. §1052(d). Applicant filed an answer by which it denied the allegations of the notice of opposition which are essential to opposer's claim.

Opposer submitted the testimony deposition of its Vice-President of Legal and Contracts, Thomas E. Jensen, with attached exhibits. Applicant submitted no testimony or any other evidence. Opposer filed a brief on the case, but applicant did not. We sustain the opposition.

Mr. Jensen's testimony establishes that opposer has used the mark MAP'N'GO continuously since July 1994. (Jensen depo. at 8, 12.) His testimony as to the nature of opposer's goods includes the following:

Map'n'Go registration? A. Yes, it does." Although this testimony is sufficient to establish opposer's present title to the registration, it does not establish the current status of the registration or that the registration is currently subsisting. Opposer accordingly may not rely on its pleaded registration in this proceeding. See, e.g., *Cadence Industries Corp. v. Kerr*, 225 USPQ 331, 332 n.2 (TTAB 1985); *Alcan Aluminum Corporation v. Alcar Metals Inc.*, 200 USPQ 742, 744 n.5 (TTAB 1978). As discussed *infra*, however, opposer has presented testimony establishing its prior use of its mark on goods essentially the same as those identified in its registration.

Q. Describe the products on which the mark was first used.

A. Map'n'Go is a computer mapping program consisting of computer software that - that offers a map engine to allow you to store, retrieve, manipulate, and view geographic and related information.

...

Q. Now, can Map'n'Go print out maps?

A. Yes, it can print out a number and variety of maps. It can print out individual maps of a location at various levels of resolution and detail. It can also print out a series of maps, showing your entire route between two points.

...

Q. And give me a general description, if you will, of the product of which Map'n'Go continues to be used as a trademark?

A. Well, it's very much like my description of the early version of Map'n'Go. We've made improvements over the years. Principally, or notably, we've added more information than we had in the original version.

...

Q. Now, does the present Map'n'Go product have the ability to print maps?

A. Yes, it does, both maps of a single location or maps of a trip, a route.

...

Q. What medium is the Map'n'Go product distributed on?

A. From the beginning it's been distributed on CD-ROM. There were a couple of versions on which we also offered it on DVD-ROM.

(Jensen depo. at 7-8, 10-12.)

Mr. Jensen further testified that opposer's sales of the Map'n'Go product have totaled over seventeen million dollars from 1994 through 2001. (Jensen depo. at 13-15, and Exhibit 2.) Opposer's trade channels for the product include retailers such as Best Buy, Office Depot, Office

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Max and Staples; distribution via opposer's own Web site; and marketing of new versions of the product to current customers via direct mail or e-mail. (Jensen depo. at 15.)

Based on the evidence discussed above concerning opposer's use of the mark MAP'N'GO on its CD-ROM map product, we find that opposer has a real interest in the outcome of this proceeding and a reasonable basis for its belief of damage, and that it therefore has established its standing to bring this proceeding. Trademark Act Section 13; *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

We further find, based on the evidence discussed above, that opposer has used its mark on its CD-ROM map product continuously since July 1994. Applicant presented no evidence as to its date of first use of its mark, and therefore is limited to its application filing date, September 22, 1998, for purposes of determining priority. *See, e.g., Lone Star Manufacturing Co., Inc. v. Bill Beasley, Inc.*, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); *Levi Strauss & Co v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 17115 (TTAB 1991). We

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conclude that opposer has established its priority for purposes of its Section 2(d) ground of opposition.

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

First, we turn to a determination of whether applicant's mark and opposer's mark, when compared in their entireties in terms of appearance, sound and connotation, are similar or dissimilar in their overall commercial impressions. The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result.

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The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

We find that applicant's mark MAPS TO GO is similar to opposer's mark MAP'N'GO, when the two marks are compared in their entireties in terms of appearance, sound, connotation and overall commercial impression. The marks look and sound alike in that they both begin with the word MAP and end with the word GO, and both consist of three short syllables. The marks have very similar connotations. Although there are slight differences between the marks when they are compared side-by-side, we find that the marks are highly similar in overall commercial impression, and that confusion is likely to result if these marks were to be used on or in connection with related goods or services.

We turn now to a comparison of the parties' goods and services. It is not necessary that the respective goods or services be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods or services are related in some manner, or that the circumstances surrounding their marketing are such, that they would be

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likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same source or that there is an association or connection between the sources of the respective goods or services. See *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991); *In re International Telephone & Telegraph Corp.*, 197 USPQ2d 910 (TTAB 1978).

The evidence of record establishes that opposer uses its MAP'N'GO mark on a computer software product, presented in a CD-ROM format, that allows the user "to store, retrieve, manipulate, and view geographic and related information" as well as to print out "individual maps of a location at various levels of resolution and detail." The evidence also establishes that opposer's product is sold through normal retail channels to ordinary consumers and other travelers.

Applicant's goods and services, as identified in the application, are "maps" in Class 16 and "market research services in the field of geographic information" in Class 35. Because no further limitations or restrictions are set forth in the identification of goods and services, we

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must presume that applicant's Class 16 "maps" encompass all types of printed maps which are marketed to all normal classes of purchasers for such products. We likewise must presume that applicant's Class 35 "market research services in the field of geographic information" likewise encompass all manner of such services and that they are marketed to all normal classes of purchasers for such services. See *In re Elbaum*, 211 USPQ 639 (TTAB 1981).

Based on these presumptions and on the evidence of record, we find that opposer's goods and applicant's goods and services are closely related. Opposer's CD-ROM map software can be used to generate printed maps; to that extent, opposer's software and applicant's "maps" are complementary and/or competitive products. Likewise, opposer's mapping software and applicant's market research services both are designed to provide "geographic information"; they thus are complementary to that extent, if not also directly competitive.

In sum, we find that applicant's mark is highly similar to opposer's mark, and that applicant's goods and services are closely related to opposer's goods and could be marketed in the same trade channels and to the same classes of purchasers. Based on these findings, we

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conclude that a likelihood of confusion exists, and that
opposer has made out its Section 2(d) claim.

Decision: The opposition is sustained.