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Paper No. 8  
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re American Library Association

Serial No. 76/082,645

Eric H. Weimers and Lisa Parker Gates of Jenner & Block,  
LLC for American Library Association.

Bridgett Smith, Trademark Examining Attorney, Law Office  
115 (Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Hairston, Administrative  
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

American Library Association has appealed from the  
final refusal of the Trademark Examining Attorney to  
register ALA EDITIONS, with the work EDITIONS disclaimed,  
as a trademark for "a series of fiction and nonfiction  
books on a variety of topics."<sup>1</sup> Registration has been  
refused pursuant to Section 2(d) of the Trademark Act, 15

<sup>1</sup> Application Serial No. 76/082,645, filed July 3, 2000, and  
asserting first use and first use in commerce in January 1994.

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U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark ALA, previously registered for "educational services—namely, providing instruction by classes, residential school programs and the like, to others for development of English language skills and cultural background, and the training of teachers and development of multi-media materials for such instruction,"<sup>2</sup> as to be likely, when used on applicant's identified goods, to cause confusion or mistake or to deceive.

Applicant and the Examining Attorney have filed appeal briefs, but an oral hearing was not requested.

We affirm the refusal of registration.

Our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in **In re E.I. du Pont de Nemours & Co.**, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. **Federated Foods, Inc. v. Fort Howard Paper Co.**, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

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<sup>2</sup> Registration No. 1,286,516, issued July 17, 1984; Section 8 affidavit accepted; Section 15 affidavit received. Registration had also been finally refused in view of another registration owned by the same entity for a stylized form of ALA. The Examining Attorney withdrew this refusal in her appeal brief.

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Applicant's mark ALA EDITIONS incorporates the cited mark ALA in its entirety, and merely adds the descriptive and disclaimed word EDITIONS to it. A subsequent user may not appropriate the mark of another and by adding subordinate or descriptive matter thereto avoid a likelihood of confusion. **The Wella Corp. v. California Concept Corp.**, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); **In re Equitable Bancorporation**, 229 USPQ 709 (TTAB 1986); **Henry I. Siegel Co., Inc. v. A & F Originals, Inc.**, 225 USPQ 626 (TTAB 1985); **Gumpert Co., Inc. v. ITT Continental Baking Co.**, 191 USPQ 409 (TTAB 1976); **Alberto-Culver Co. v. Helene Curtis Industries, Inc.**, 167 USPQ 365 (TTAB 1970).

Although we have considered the marks in their entireties, because the word descriptive word EDITIONS in applicant's mark has less source-identifying value than the arbitrary term ALA, it is ALA which is entitled to greater weight in our assessment of the likelihood for confusion. See **In re National Data Corp.**, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Accordingly, we find that the marks are nearly identical in appearance, pronunciation and connotation, and that they are identical in commercial impression.

This brings us to a consideration of the goods and services. It is not necessary that the goods or services

of the parties be similar or competitive, or even that they move in the same channels of trade to support a holding of likelihood of confusion. It is sufficient if the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See **In re International Telephone & Telegraph Corp.**, 197 USPQ 910, 911 (TTAB 1978).

Applicant's identification describes its goods broadly as a series of fiction and nonfiction books on a variety of topics; the cited registration is for educational services which include providing instruction by classes for the development of English language skills and cultural background, as well as the training of teachers for such instruction. Because applicant's books are not limited as to topic, they must be deemed to include books which could be used in classes for the development of English language skills (e.g., ESL classes) and cultural background, and also books for the training of teachers. Thus, the complementary nature of applicant's goods and the registrant's services is clear. Moreover, the Examining

Attorney has made of record third-party registrations which show that a party has registered a single mark for both educational services such as conducting workshops and seminars in a particular field and for books in that field. Third-party registrations which individually cover a number of different items and which are based on use in commerce serve to suggest that the listed goods and/or services are of a type which may emanate from a single source. See **In re Albert Trostel & Sons Co.**, 29 USPQ2d 1783 (TTAB 1993).

Applicant argues that the channels of trade for its goods and the registrant's services are different, and specifically that applicant's books are sold to librarians via libraries, while, according to applicant, the registrant's services are offered to non-English speaking students enrolled in universities, colleges, and boarding schools. Aside from the fact that applicant has not submitted any evidence to support its contentions as to the registrant's activities,<sup>3</sup> even if such evidence were properly of record it would not affect our decision herein. The question of likelihood of confusion must be determined on the basis of the identification of goods set forth in

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<sup>3</sup> Applicant refers for the first time in its appeal brief to a description it found for registrant in registrant's website. Applicant did not timely make this evidence of record during the prosecution of its application, and we will not consider applicant's report of what the website contains to be of record.

the subject application and the cited registration. **In re William Hodges & Co, Inc.**, 190 USPQ 47 (TTAB 1976).

Applicant's identification is not limited to books sold only to librarians through libraries; there are no restrictions on the channels of trade at all, and therefore we must deem the goods to move through all appropriate channels of trade, and to all relevant purchasers. These channels would include all places where books are sold, including bookstores and schools; the consumers would include the public at large. These same classes of consumers would encompass those members of the public who would purchase the registrant's educational services for the development of English language skills, and the teachers who would purchase the registrant's training services.

Applicant also contends that the buying public is sophisticated, but this assertion is based on the fact that applicant has promoted its books to librarians via libraries. As noted above, applicant's identification is not restricted to such purchasers through such trade channels, and must be deemed to include the public at large, who would not have the sophistication of librarians. Nor can we accept applicant's argument that consumers of the registrant's services "are likely to ascertain easily

that the source of those educational services is the American Language Academy and not the American Library Association." Brief, p. 4. By suggesting that consumers would have to look behind the respective trademarks to the actual sources of the goods and services, applicant would essentially have us ignore the determination of likelihood of confusion between the applied-for mark and the cited mark, and instead determine the issue of likelihood of confusion based on the respective companies' trade names.

We will touch briefly on the other du Pont factors discussed in applicant's brief. We agree with applicant that there is no evidence of fame of the registrant's mark. This factor must therefore be regarded as neutral in our analysis. Applicant also states that there are no other similar marks in use on similar goods or services. This factor must be deemed to favor the registrant, as indicating that ALA is a strong mark. Applicant claims in its appeal brief that it owns a family of ALA marks, and references two applications and one registration for marks which include ALA. Aside from the fact that these applications and registration were not made of record, and that an application is not proof of use of a mark, an applicant cannot register a mark which is likely to cause confusion with a previously registered mark merely because

it owns a registration for a different mark which includes a common element or because it has filed applications for other marks. In this case, because of the cumulative differences in the marks and goods/services between applicant's registered mark ALANET for electronic mail services and both the cited registration and its applied-for mark, the existence of this registration is not persuasive that there is no likelihood of confusion between ALA EDITIONS and ALA for the respective identified goods and services.

Finally, applicant points to the lack of evidence of any actual confusion despite applicant's use of its mark since 1994 and the registrant's claimed use since 1970. While the absence of any instances of actual confusion over a significant period of time is indeed a du Pont factor which is indicative of no likelihood of confusion, it is a meaningful factor only where the record demonstrates appreciable and continuous use by the applicant of its mark in the same markets as those served by registrant under its mark. See, e.g., **Gillette Canada Inc. v. Ranir Corp.**, 23 USPQ2d 1768, 1774 (TTAB 1992). In particular, there must be evidence showing that there has been an opportunity for incidents of actual confusion to occur. See, e.g., **Cunningham v. Laser Golf Corp.**, 222 F.3d 943, 55 USPQ2d

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1842, 1847 (Fed. Cir. 2000). In this case, we do not find the lack of such evidence persuasive that confusion is not likely. As applicant has stated, it has marketed its goods exclusively to librarians through libraries. It is possible that confusion has not occurred because of this limitation in applicant's actual channels of trade and customers. However, as noted above, applicant's identification does not include such a restriction, and therefore we cannot assume that confusion is not likely to occur if applicant were to sell its goods through other channels of trade. Moreover, we have not had an opportunity to hear from the registrant in this ex parte proceeding as to what have been its experiences regarding confusion.

Decision: The refusal of registration is affirmed.