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Mailed:
June 30, 2004
Bucher

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The General Assembly of the Christian Church (Disciples of Christ)

Serial No. 76386279

Donald H. Zarley and Timothy J. Zarley of Zarley Law Firm, P.L.C. for The General Assembly of the Christian Church (Disciples of Christ).

Leslie L. Richards, Trademark Examining Attorney, Law Office 106 (Mary I. Sparrow, Managing Attorney).

Before Bucher, Bottorff and Holtzman, Administrative Trademark Judges.

Opinion by Bucher, Administrative Trademark Judge:

The General Assembly of the Christian Church (Disciples of Christ) seeks registration on the Principal Register of the mark THE DISCIPLE for goods identified, as amended, as "a periodically distributed publication, namely, a religious magazine," in International Class 16.[1]

[1] Application Serial No. 76386279 was filed on March 22, 2002 based upon applicant's allegation of a *bona fide* intention to use the mark in commerce.

This case is now before the Board on appeal from the final refusal of the Trademark Examining Attorney to register this mark based upon Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d). The cited registrations are for the identical mark, THE DISCIPLE, registered for goods and services as follows:

> "Bi-weekly religious magazine," also in International Class 16,[2] and
>
> "providing multiple user access to an electronically distributed newsletter on a global computer information network for the transfer and dissemination of information in the field of religion," in International Class 42.[3]

The Trademark Examining Attorney has taken the position that applicant's mark, when used in connection with the identified goods, is likely to cause confusion, to cause mistake or to deceive.

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[2] Registration No. 1072229 issued on August 30, 1977 to the instant applicant, The General Assembly of the Christian Church (Disciples of Christ). Section 8 affidavit accepted and Section 15 affidavit acknowledged; renewed. Then, according to the records of the Assignment Division of the United States Patent and Trademark Office, on August 12, 1998, this registration was assigned to Christian Board of Publication (CBP). CBP continues as the last listed owner of this registration.

[3] Registration No. 2247423 issued on May 25, 1999 to Christian Board of Publication, the assignee and current owner of the first cited registration, *supra*. The General Assembly of the Christian Church (Disciples of Christ) was the original applicant (December 16, 1997) but the transfer of August 12, 1998 was recorded during the pendency of this application, and the registration then issued to CBP.

The Trademark Examining Attorney and applicant have fully briefed the case. Applicant did not request a hearing before the Board.

The Trademark Examining Attorney argues that the marks are identical and that applicant's goods are substantially identical to the goods in the first cited registration and closely related to the services in the second cited registration.

Applicant does not contest this conclusion, but argues that inasmuch as registrant has abandoned use of this mark for these goods and services, the involved application should proceed to publication given the specific circumstances of this case:

> Applicant is a protestant denomination formed in the United States in the 1800's, and continues today with 3,000 - 4,000 congregations in the United States and Canada. Applicant has a plurality of separate autonomous units or affiliates, and CBP is one of them. In the fall of 2002 [sic 2001], CBP announced that the 140 year history of THE DISCIPLE was coming to an end, and publication was discontinued in March 2002 (the last issue). *See* attached Exhibits A and B showing statements by CBP and applicant which were from Exhibit C, the March 2002 issue. Thus, the publication of THE DISCIPLE has ended by CBP's own statements and has not been continued, either in published or electronic form. This constitutes legal abandonment of the marks and registrations.

> Even if a mark is incontestable, and even though abandonment can involve a matter of intent, such an act of publicly announcing the use of a mark is legally sufficient to conclude abandonment. *See* the attached copy of the decision in the *Hiland Potato Chip Company*, No. 83-1156 (Exhibit D)[4] from which a conclusion of legal abandonment of the CBP marks and registrations must be drawn.

Applicant's response of February 3, 2003, pp. 2 – 3.

The Trademark Examining Attorney correctly noted in her appeal brief that because these two cited registrations are valid and subsisting, cancellation proceedings against the cited registrations were the proper fora in which to make such arguments, not during the *ex parte* prosecution of this application. Then, in its reply brief, applicant finally took up the suggestion made by the Trademark Examining Attorney in her final refusal that perhaps applicant could demonstrate the existence of a relationship between applicant and Christian Board of Publication that would obviate the likelihood of confusion. Applicant argued in its reply brief that indeed a *Wella*-type exception[5] applied to this application:

> First, the Christian Board of Publication is an affiliate of the Applicant. Second, the

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[4] *Hiland Potato Chip Company v. Culgro Snack Foods, Inc.*, 720 F.2d 981, 222 USPQ2d 790 (8th Cir. 1983).

[5] *In re Wella A.G.*, 787 F.2d 1549, 229 USPQ 274 (Fed. Cir. 1986); and *In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987), *rev'd on other grounds,* 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988).

> Applicant licensed the registered trademarks to the Christian Board of Publication. Finally, because of the Applicant's previous ownership of the registered trademarks the public perception is that the source of goods came from both the Christian Board of Publication and the Applicant. Consequently, the two registered trademarks cited against the Applicant should not be considered and this application should be allowed.

We disagree with applicant's contentions, and rather, are compelled to affirm the refusal of registration.

As argued by the Trademark Examining Attorney, these cited registrations cannot be disregarded. She cites to the following case from our principal reviewing Court:

> The certificate of registration is *prima facie* evidence of the validity of the registration and the registrant's exclusive right to use the mark in connection with the services specified. 15 U.S.C. Section 1057(b) (1994). Dixie's argument that DELTA is not actually used in connection with restaurant services amounts to a thinly-veiled collateral attack on the validity of the registration. It is true that a *prima facie* presumption of validity may be rebutted. *See Dan Robbins & Assocs., Inc. v. Questor Corp.*, 599 F.2d 1009, 1014, 202 USPQ 100, 105 (CCPA 1979). However, the present *ex parte* proceeding is not the proper forum for such a challenge. *Id.* ("One seeking cancellation must rebut [the *prima facie*] presumption by a preponderance of the evidence."); *Cosmetically Yours, Inc. v. Clairol Inc.*, 424 F.2d 1385, 1387, 165 USPQ 515, 517 (CCPA 1970); TMEP Section 1207.01(c)(v) (1993); 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, Section 23.24[1] [c] (3d ed.

> 1996). In fact, *Cosmetically Yours* held that "it is not open to an applicant to prove abandonment of [a] registered mark" in an *ex parte* registration proceeding; thus, the "appellant's argument … that [a registrant] no longer uses the registered mark … must be disregarded." 424 F.2d at 1387, 165 USPQ at 517; *cf. In re Calgon Corp.*, 435 F.2d 596, 598, 168 USPQ 278, 280 (CCPA 1971) (applicant's argument that its use antedated a registered mark was effectively an improper collateral attack on the validity of the registration, which should have been made in formal cancellation proceedings). Dixie claims that it is not arguing that the DELTA mark has been abandoned, only that it has not been used for restaurant services, so there is no likelihood of confusion. However, unless it establishes abandonment, the registration is valid, and we must give effect to its identification of services. *Cosmetically Yours*, 424 F.2d at 1387, 165 USPQ at 517 ("As long as the registration relied upon … remains uncanceled, it is treated as valid and entitled to the statutory presumptions.").

In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 - 35 (Fed. Cir. 1997).

We turn then to consider whether applicant has made a sufficient showing that this case fits this narrow exception to the operation of Section 2(d) of the Act.

The Trademark Examining Attorney, while alluding to the possibility of a *Wella*-type exception in her final Office action, found that applicant had failed to provide

evidence that applicant and Christian Board of Publication constitute a single source:

> … [T]he Court of Appeals for the Federal Circuit has held that, where the applicant is related in ownership to a company that owns a registered mark that would otherwise give rise to a likelihood of confusion, the examining attorney must consider whether, in view of all the circumstances, use of the mark by the applicant is likely to confuse the public about the source of the applicant's goods because of the resemblance of the applicant's mark to the mark of the other company. *See* TMEP §§1201.07(a). Therefore, in some limited circumstances, the close relationship between related companies will obviate any likelihood of confusion in the public mind because the related companies constitute a single source. *See* TMEP §§1201.07(b) *et seq*. for further information. The applicant has not provided any such evidence.

It was not until the time of filing its reply brief that applicant first argued that, indeed, this exception applied to the instant case. We find this argument to be too little offered too late.

As to the exact relationship between applicant and the CBP, applicant has on several occasions characterized the relationship as follows: "Applicant has a plurality of separate autonomous units or affiliates, and CBP is one of them." Applicant's response of February 3, 2003, p. 2; and applicant's appeal brief, p. 4. However, when seeking to determine whether two entities have demonstrated a "unity

of control" under *Wella*, nebulous characterizations such as "separate autonomous units" or "affiliates" are most inadequate to meet the standard set out by the Court of Appeals for the Federal Circuit. Moreover, there has been no attempt to establish the manner in which applicant controls the nature and quality of the goods and/or services that have been marketed by CBP. This kind of information is critical to making a determination as to unity of control.

Furthermore, applicant's statements are contradictory as to how applicant itself views ownership of the mark, THE DISCIPLE, in the field of religious publications. While it claims ownership of this mark in the instant intent-to-use application, the records of the United States Patent and Trademark Office, supported by applicant's own responses to Office actions herein, show that applicant assigned its entire interest in the mark (recorded as to both cited registrations) to the CBP in August 1998. On the other hand, applicant also suggests continued ownership by applicant while merely providing a license to CBP ("… Applicant licensed the registered trademarks to the Christian Board of Publication." Applicant's reply brief, p. 2). In the next sentence, applicant suggests what could

be construed as joint ownership ("…[T]he public perception is that the source of the goods came from [sic] both the Christian Board of Publication and the Applicant." *Id*). Hence, on this record, the actual facts concerning who has been controlling the nature and quality of the religious publications marketed under this mark – the gravamen of ownership of a source-identifier –and whether there is a unity of control remain somewhat murky.

In conclusion, there is no question but that the identical mark, THE DISCIPLE, used on substantially identical printed publications and/or on closely-related online publications will result in a likelihood of confusion. Applicant cannot attack the validity of the cited registrations by pointing to extrinsic evidence of registrant's having abandoned the mark. Moreover, applicant has not demonstrated a unity of control between applicant and registrant in the use of the mark.

Decision: The refusal to register based upon the ground of likelihood of confusion is hereby affirmed.