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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AT&T Wireless Services, Inc. (Formerly McCaw Cellular
Communications, Inc.)

v.

Terry L. Wright

Opposition No. 91094808 to Application
Serial No. 74360084 filed February 16, 1993

Heidi L. Sachs of Perkins Coic LLP for AT&T Wireless
Services, Inc.

Steven B. Salai of Harter, Secrest & Emery for Terry L.
Wright.

Before Hanak, Quinn and Holtzman, Administrative Trademark
Judges.

Opinion by Hanak, Administrative Trademark Judge:

Terry L. Wright (applicant) seeks to register in typed
drawing form IMAGINET for "communication services namely,
interactive, multimedia transmission services." The
intent-to-use application was filed on February 16, 1993.

On February 22, 1994 AT&T Wireless Services, Inc. (opposer) filed a Notice of Opposition stating that it "owns registrations for or has applied to register the marks IMAGINE, IMAGINE NO LIMITS, and 1-800-IMAGINE for telecommunications goods and services." (Notice of Opposition paragraph 3). Continuing, opposer alleged that applicant's mark IMAGINET "is substantially and confusingly similar to opposer's IMAGINE marks." (Notice of Opposition paragraph 8). While opposer did not make specific reference to Section 2(d) of the Trademark Act, it is clear that this is the basis for the Notice of Opposition.

Applicant filed an answer which denied the pertinent allegations of the Notice of Opposition. Opposer and applicant filed briefs. Neither party requested a hearing.

Descriptions of the record in this case are contained at opposer's brief pages 1 and 2 and applicant's brief pages 1 and 2. It consists of, in part, the testimony deposition of applicant Terry L. Wright noticed by opposer and taken on March 3, 2003, over nine years after the Notice of Opposition was filed.

At the outset, two matters need to be disposed of. First, on October 23, 2003 opposer filed a motion to amend its Notice of Opposition because of applicant's purported non-use of its mark IMAGINET. This motion to amend came

over seven months after the deposition of Mr. Wright taken on March 3, 2003. In that deposition, Mr. Wright testified that he (applicant) had not made any use of IMAGINET since his application was filed in February 1993. Moreover, the motion to amend came long after all testimony periods were closed. In addition, opposer was long aware that applicant had not made any use of his mark IMAGINET since the filing of its application in February 1993. Accordingly, opposer's motion to amend the Notice of Opposition to add a claim of abandonment is denied.

In its brief, opposer not only argued that applicant had abandoned his mark, but in addition, opposer argues that "applicant did not have a bona fide intent to use the mark when he filed his application in 1993." (Opposer's brief page 13). To the extent that opposer may be arguing that these two issues were tried by the consent of the parties during the taking of Mr. Wright's deposition on March 3, 2003, opposer is mistaken. The bulk of Mr. Wright's deposition, noticed by opposer, goes not to the issue of likelihood of confusion which was the only issue pled in the Notice of Opposition, but rather goes to the issues of abandonment and lack of bona fide intent to use the mark in 1993. Applicant's counsel repeatedly objected to such questioning, as evidenced by the following

statement made by applicant's counsel at page 5 of applicant's deposition: "I'm going to object generally to questions that go beyond the scope of likelihood of confusion, which is the sole issue that remains in this case." Applicant's counsel repeated his objection on numerous other occasions, and counsel for both parties agreed that it was a continuing objection.

Accordingly, the issues of abandonment and applicant's purported lack of a bona fide intent to use the mark in 1993 were not properly pled nor were they tried by the consent of the parties. This Board will give no further consideration to them.

Second, before beginning our likelihood of confusion analysis, we must determine which marks opposer established that it had rights to prior to February 16, 1993 which is applicant's filing date for its intent-to-use application for IMAGINET. Opposer attached as Exhibit 1 to its Notice of Opposition a mere list of registration numbers for its marks IMAGINE NO LIMITS and 1-800-IMAGINE. At no time did opposer attempt to introduce by means of a notice of reliance any of its registrations. Moreover, the only witness in this proceeding was applicant Terry L. Wright. At his deposition, counsel for opposer introduced as exhibits status and title copies of opposer's registrations

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for IMAGINE NO LIMITS and 1-800-IMAGINE. Opposer's counsel attempted to have applicant Terry L. Wright authenticate opposer's registrations. Mr. Wright could not, and accordingly the registrations have not been made of record as a result of Mr. Wright's deposition.

Opposer called no other witnesses. In particular, opposer did not depose any of its officers or employees. Thus, not only has opposer not made of record its registrations in the conventional manner, but in addition, opposer has established absolutely no common law rights in any of its purported marks.

However, the story does not end here. On July 17, 1995 opposer filed a motion for partial summary judgment requesting that this Board rule "that opposer possesses rights in its marks IMAGINE NO LIMITS and 1-800-IMAGINE that are prior to applicant right's, if any, in the subject mark IMAGINET." (Motion page 1). Attached to its motion for partial summary judgment were status and title copies of opposer's typed drawing registrations for IMAGINE NO LIMITS and 1-800-IMAGINE for "telecommunications services." Registration Nos. 1,689,646 and 1,718,806. Applicant did not contest opposer's motion for partial summary judgment.

On April 17, 1996 this Board issued a three-judge order stating, in part, as follows: "For the reasons set

forth in opposer's motion including that opposer is the owner of unchallenged registrations covering the marks IMAGINE NO LIMITS and 1-800-IMAGINE for various telecommunications goods and services ... opposer's motion for partial summary judgment is granted. Accordingly, this case will go to trial on the issue of likelihood of confusion."

Obviously, any reasonable interpretation of this Board's order of April 17, 1996 would clearly indicate that opposer's registrations for IMAGINE NO LIMITS and 1-800-IMAGINE for telecommunications services were not only part of the record, but in addition, the issue of priority with regard to these two of opposer's marks versus applicant's mark IMAGINET was resolved in favor of opposer.

However, once again, this is not the end of the story. Nearly seven years later on January 16, 2003 this Board issued another three-judge order. At page 2 of this order, the Board stated as follows: "On April 17, 1996, the Board granted opposer's motion for partial summary judgment on the issue of priority, stating that this proceeding would go to trial on the issue of likelihood of confusion." However, at page 6 of this order the Board made the following statement: "Finally, we note that in support of opposer's partial summary judgment motion, opposer

submitted status and title copies of its relied-upon registrations. Said registrations are of record solely for the purpose of opposer's partial summary judgment motion, and are not of record as evidence of this proceeding."

As might be expected, this Board's order of January 16, 2003 did not go unnoticed by applicant. At page 11 of his brief, applicant argues that in light of this Board's order of January 16, 2003, "opposer's registrations were not in evidence in this proceeding."

To cut to the quick, this Board's orders of April 17, 1996 and January 16, 2003 are in conflict. In considering how to resolve this conflict, we could state that the Board's order of April 17, 1996 never explicitly said that opposer's registrations for IMAGINE NO LIMITS and 1-800-IMAGINE for telecommunications services were of record other than for the limited purposes of opposer's partial summary judgment motion on the issue of priority. We could then go on to find that while opposer's registrations were not of record, that nevertheless this Board held that opposer had priority for these two marks.

However, such reasoning flies in the face of logic. In order to have priority in a mark, one must first have rights in a mark. Given the fact that opposer attached status and title copies of its registrations for IMAGINE NO

LIMITS and 1-800-IMAGINE for telecommunication services to its motion for partial summary judgment, the only fair reading of the Board's order of April 17, 1996 was that opposer had properly made of record, for all purposes, the registrations for these two marks. Without opposer having rights in these two marks through the registrations of these two marks for telecommunication services, this Board simply could not have found on April 17, 1996, that opposer had priority.

Accordingly, while this is an extremely rare occurrence, this Board hereby overrules the interlocutory order of January 16, 2003 to the extent that it is in conflict with the interlocutory order of April 17, 1996. In other words, opposer's registrations of IMAGINE NO LIMITS and 1-800-IMAGINE for telecommunication services are properly of record for all purposes in this proceeding.

In overruling that portion of the interlocutory order of January 16, 2003 that is in conflict with the interlocutory order of April 17, 1996, this Board is on firm legal ground because interlocutory (prejudgment) orders can be reconsidered and overturned at any time. See 1B J. Moore, J. Lucas & T. Currier, Moore's Federal Practice Section 0.404[1] (2d ed. 1984) ("At the trial court level, the doctrine of the law of the case is little more

than a management practice to permit logical progression toward judgment. Prejudgment orders remain interlocutory and can be reconsidered at any time ... [T]he doctrine of the law of the case does not require nor encourage a trial court to render a judgment erroneous in law.") Prejudgment orders include those granting summary judgment, which "remain subject to change at any time." Id. at Section 0.404[4.-1].

We will now begin our likelihood of confusion analysis. This will consist of a comparison of applicant's mark IMAGINET for "communication services namely, interactive, multimedia transmission services" and opposer's marks IMAGINE NO LIMITS and 1-800-IMAGINE for "telecommunication services." To be clear, opposer has not established any rights in the mark IMAGINE per se. As previously noted, opposer has not established common law rights in any mark. Moreover, opposer has not established registration rights in the mark IMAGINE, and opposer concedes as much. In this regard, reference is made to opposer's brief of August 27, 2003 at page 6, footnote 2 where opposer states as follows: "The registration certificate for opposer's IMAGINE application should issue shortly."

We now turn to the real issue in this proceeding, namely, whether there is a likelihood of confusion between opposer's marks IMAGINE NO LIMITS and 1-800-IMAGINE for "telecommunications services" and applicant's mark IMAGINET for "communication services namely, interactive, multimedia transmission services."

In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods or services. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.").

Considering first the services of the parties, opposer made of record no evidence showing how its services and applicant's services are related. Nevertheless, we are permitted to take judicial notice of the dictionary definition of the word "telecommunication" which is as follows: "communication at a distance (as by cable, radio, telegraph, telephone, or television)." Webster's Third New International Dictionary (1993). Applicant's services are a particular type of communication services namely, interactive, multimedia transmission services. Applicant's

identification of services does not contain any limitation that would prohibit such services from being rendered between two distant points. Indeed, applicant testified that his communication services would be delivered over the Internet and through cable television networks. (Wright deposition pages 36-37).

In short, we find that opposer's identification of services (telecommunications services) is a very broad identification of services which encompasses applicant's more specific identification of services. Thus, for our likelihood of confusion analysis purposes, the services of the parties are legally identical. Whether in actuality there are differences in opposer's services and applicant's services is of no consequence because in Board proceedings we must consider the services as described in the application and registrations, and not the actual services of applicant and registrant. See Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (It is well settled that in Board proceedings, "the question of likelihood of confusion must be determined based on an analysis of the mark as applied to the goods and/or services recited in applicant's application vis-à-vis the goods and/or services recited in registrant's

registration, rather than what the evidence shows the goods and/or services to be.”).

Turning to a consideration of the marks, we note at the outset that when the services of the parties are legally identical as is the case here, “the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines.” Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

However, having said the foregoing, we find that applicant’s mark IMAGINET is different enough from opposer’s marks IMAGINE NO LIMITS and 1-800-IMAGINE such that there is no likelihood of confusion. Marks are compared in terms of visual appearance, pronunciation and connotation.

In terms of visual appearance, applicant’s mark is quite distinct from registrant’s two marks. Obviously, applicant’s mark consists of one word. On the other hand, registrant’s mark IMAGINE NO LIMITS consists of three words, and registrant’s mark 1-800-IMAGINE has the clear look of a toll-free telephone number.

In terms of pronunciation, the significant differences in the marks are quite obvious. This is true even if we assume that some consumers would pronounce applicant’s mark

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IMAGINET and the IMAGINE portion of opposer's two marks in a similar fashion.

Finally, in terms of connotation, we acknowledge that all three marks bring to mind the word "imagine." However, this is the only point of similarity. Applicant's mark IMAGINET conjures up the phrase "imagine it." This phrase is different in connotation from opposer's mark IMAGINE NO LIMITS and opposer's mark 1-800-IMAGINE which, as just noted, brings to mind images of a toll-free telephone number.

In short, despite the fact that the services of the parties are legally identical, we find that applicant's mark IMAGINET is different enough from opposer's two marks such that there is no likelihood of confusion.

Decision: The opposition is dismissed.