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THE TTAB**

Oral Hearing:
August 10, 2005

Mailed: June 22, 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Time Warner Entertainment Company L.P.
and
Warner Bros. Entertainment, Inc.
v.
FTC Communications, Inc.

Opposition No. 91119934
to Application No. 75388666
filed on November 12, 1997

Michael A. Grow, Elizabeth H. Cohen and Leo M. Laughlin of
Arent Fox Kintner Plotkin & Kahn for Time Warner
Entertainment Company L.P. and Warner Brothers
Entertainment, Inc.

James Stone Craven of Craven & Reid for FTC Communications,
Inc.

Before Walters, Rogers and Kuhlke, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Time Warner Entertainment Company L.P. ("opposer" or "Warner Bros.")¹ filed its opposition to the application of FTC Communications, Inc. ("applicant" or "FTC") to register the mark FTC Roadrunner for "electrical and scientific apparatus, namely, a pager," in International Class 9, and "telecommunications, namely, a paging service," in International Class 38.²

As grounds for opposition, opposer asserts³ that applicant's mark, when applied to applicant's goods and services so resembles opposer's previously used and registered family of famous Road Runner marks and a Road Runner cartoon character design for a wide variety of goods and services as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

As a second ground of opposition, opposer asserts, under Section 2(a) of the Trademark Act, that applicant's mark is deceptively misdescriptive; that applicant's mark so closely resembles opposer's mark that it falsely suggests a connection with opposer; that applicant's mark disparages

¹ The relevant marks were assigned during the pendency of this proceeding to Warner Bros. Entertainment, Inc., which has been joined as a party plaintiff.

² Application Serial No. 75388666, filed November 12, 1997, based upon use of the mark in commerce, alleging dates of first use and first use in commerce as of October 10, 1997.

³ Amended Notice of Opposition filed January 29, 2002.

opposer and will tend to bring opposer into contempt and disrepute.⁴

As a third ground of opposition, opposer asserts, under Section 43(c) of the Trademark Act, that applicant's mark will dilute the distinctive quality of opposer's famous marks, which became famous prior to applicant's use of its marks.

Applicant, in its answer, denied the salient allegations of the claims, except that it admitted opposer's ownership of registration nos. 1288072, 1946471, and 2135226. Applicant asserted "affirmative defenses" which are actually amplifications of its position, alleging that opposer is not the owner of claimed registration nos. 2246924 and 2246925 and, thus, has no basis for alleging use of marks in connection with providing Internet access; that opposer's marks and goods and services are distinctly different from applicant's mark and goods and services and, thus, there is no likelihood of confusion, disparagement, or false suggestion of a connection with opposer.⁵

⁴ In the Board's order of March 29, 2002, opposer was found not to have standing to assert that applicant's mark is deceptive because it falsely suggests a connection with or approval by the Federal Trade Commission, known by the acronym FTC; and, thus, paragraph 17 was stricken from the amended notice of opposition.

⁵ Applicant's fourth affirmative defense alleges error in granting opposer's second and third extensions of time to oppose. This was the subject of applicant's motion to dismiss, which was denied by the Board's order of March 29, 2002, and will not be reconsidered.

Evidentiary Objections

In its brief, opposer objected to the declaration of Brandy Tillis and accompanying exhibits on the ground of relevance, alleging, further, that there is no evidence of use of the third-party registered mark exhibits and Ms. Tillis lacks personal knowledge of any third-party use. While there is no question, as opposer asserts, that applicant is not asserting a fair use defense with respect to the terms "roadrunner" or "road runner" we find the exhibits to Ms. Tillis' declaration, for example, dictionary definitions and various articles and advertisements involving the roadrunner bird as native to the southwest, are relevant to our consideration of the strength of both parties' marks. Further, the third-party registrations attached to Ms. Tillis' declaration are properly submitted and there is no requirement that Ms. Tillis be aware of, or testify to, the use of the registered marks or that the record otherwise contain evidence of the use of the registered marks. Opposer's objection is not well taken and is overruled. Ms. Tillis' declaration and exhibits have been considered.

Additionally, opposer objects to specified portions of the testimony of Frank Bradley Erwin and to exhibit nos. 17 and 19-41 thereto. In particular, opposer contends that Mr. Erwin has no personal knowledge of any use that may be

evidenced by the marks shown in several exhibits and, thus, his testimony about these exhibits is inadmissible because it constitutes hearsay; that exhibit nos. 19-22 and 28-32 are dictionary definitions of the term "roadrunner"⁶ and, thus, are inadmissible because they are not relevant; that exhibit nos. 23-27 are copies of third-party registrations from the USPTO database and are inadmissible because there is no evidence that anyone is using the marks; and that Mr. Erwin's testimony regarding an agreement between opposer and a third party is inadmissible because Mr. Erwin has no personal knowledge of the agreement and, thus, it constitutes hearsay.

Regarding the exhibits of information downloaded from the Internet, such material must be properly authenticated by the individual who downloaded the material. Mr. Erwin did not do this and admitted his lack of personal knowledge regarding the exhibits. However, the vast majority of the exhibits to Mr. Erwin's testimony consisting of Internet material are identical to those exhibits attached to the declaration of Brandy Tillis, who personally downloaded the material from the Internet and otherwise personally obtained the evidence submitted. As such, those documents that are identical to documents properly authenticated by Ms. Tillis

⁶ The dictionaries of record and of which we take judicial notice show the term as it identifies the bird as both one word and two words.

are properly of record. Mr. Erwin's testimony in relation thereto is considered for the sole purpose of presenting his reactions to the material shown to him, not for the truth of the information contained in the documents. With regard to dictionary definitions and articles relating to the roadrunner bird, as noted above, such evidence is relevant to the strength of the parties' marks. With regard to the third-party registrations, we agree that these registrations do not evidence use of the subject marks; however, there is no requirement that Mr. Erwin or anyone testify to the use of the registered marks in order for the registrations to be properly of record.⁷ With regard to Mr. Erwin's testimony about opposer's purchase of trademark registrations from, and agreement with, a third party, we agree with opposer that Mr. Erwin has no personal knowledge of this transaction and his testimony regarding these facts is hearsay and has not been considered. Opposer's objection to Mr. Erwin's testimony and accompanying exhibits is overruled to the

⁷ Third-party registrations can be used to illustrate how a term is perceived in the trade or industry. *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("Said third party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection. Used in this limited manner, 'third party registrations are similar to dictionaries showing how language is generally used.'" (Internal citation omitted.) "Such third party registrations show the sense in which the word is used in ordinary parlance and may show that a particular term has descriptive significance as applied to certain goods or services." *Institut National Des Appellations D'Origine v. Vintners International Co.*, 958 F.2d 1574, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992) (third-party registrations found to be "persuasive evidence").

extent noted. Mr. Erwin's testimony and exhibits and been considered as noted.

Finally, opposer also objects to various exhibits submitted by applicant's notice of reliance. Specifically, opposer contends that exhibit nos. 6-9 are excerpts from the discovery depositions of applicant's own employees and are not proper rebuttal to the portions of the same depositions submitted by opposer at trial; that exhibit 8, p. 79 of the discovery deposition of Emily Ward, is inadmissible because it is hearsay with respect to a reported conversation between Ms. Ward and a third party; and that exhibit nos. 14-27, dictionary definitions and articles about the roadrunner bird, are inadmissible because this information is irrelevant. We find the excerpts from discovery depositions to be proper rebuttal to opposer's submission of excerpts from the same. We reiterate that the dictionary definitions and articles about the roadrunner bird are relevant to the strength of the parties' marks. Ms. Ward's report of her conversation with a third party is not hearsay as to her recounting what she said and what she heard from the third party. Opposer's objection is overruled and the subject evidence has been considered.⁸

⁸ In its reply brief, opposer argues that applicant has essentially conceded to a number of opposer's evidentiary objections. We disagree and have considered the objections on their merits.

The Record

The record consists of the pleadings and the file of the involved application. Numerous documents were made of record by both parties' notices of reliance and, by stipulation of the parties, both parties submitted witness declarations with exhibits. Such submissions were made by opposer both during its case in chief and on rebuttal. The following testimony depositions were made of record by opposer, each with accompanying exhibits: Jordan Sollitto, vice president of world-wide marketing and international licensing for Warner Bros. Consumer Products; Gregg R. DiPaulo, senior vice president of high-speed data for Time Warner Cable; Howard L. Pfeffer, vice president of broadband technology for Time Warner Cable; and Jeffrey M. King, president of Roadrunner High Speed Online and executive vice president of Time Warner Cable.⁹ Applicant made of record the testimony deposition of F. Bradley Erwin, applicant's general manager, with accompanying exhibits.

Both parties filed briefs on the case and an oral hearing was held.

Factual Findings

We judicially notice the definition of the term "roadrunner" as "a largely terrestrial bird (Geococcyx

⁹ Roadrunner High Speed Online is Roadrunner Holding Co., a wholly owned subsidiary of Time Warner Cable, which, along with Time Warner Entertainment, Inc., is owned by Time Warner.

Californianus) of the cuckoo family that has a long tail and a crest, is a speedy runner, and inhabits arid regions from the southwestern U.S. to Mexico" (*Merriam-Webster's Collegiate Dictionary*, 11th ed. 2003). The record contains several further definitions and in-depth articles about the roadrunner bird, as well as evidence of third-party jewelry and small collectible items showing the actual roadrunner bird available on eBay. Also of record is reference to the "New Mexico Road Runner Cash Lotto," which is one of the state of New Mexico's lottery games advertised on the state's lotto website with a picture of an actual roadrunner bird. Clearly, the roadrunner is not an obscure bird.

The record establishes that the term "road runner" is also used regularly to describe an individual or vehicle that runs on roads. For example, applicant submitted evidence of references to many different running clubs, such as Ohio River Road Runners; several retail running equipment stores, such as Road Runner Sports and Roadrunner Athletics; and a motorcycle club named Road Runner Motorcycle Cruising and Touring.

Opposer, through its predecessors in interest, began using a roadrunner character, aptly known as "Road Runner," in cartoons in 1949. Like the actual roadrunner bird, the cartoon character is very speedy and inhabits an arid region not unlike a cartoon version of the southwestern United

States. The Road Runner cartoons are part of a group of cartoons known as Looney Tunes. Road Runner cartoons have been shown in movie theaters and, later, on television continuously since the early 1950's.

Opposer provided confidential evidence of its extensive advertising and promotion of its Looney Tunes characters and marks, including the Road Runner character and mark, in connection with its entertainment services and a wide variety of collateral goods. The Looney Tunes cartoons and characters, including Road Runner, have been very popular and, as a group and individually, these characters have been the subject of licensing in connection with a wide variety of goods and services, including, to name just a few categories, collectibles, toys, clothing, electronic equipment, computers, and an amusement park ride. Opposer also licenses its Looney Tunes characters and names, including Road Runner, to third parties for use as dramatic devices in promotional campaigns, rather than as direct endorsements of products; for example, Road Runner appeared in the context of speed with football player Deion Sanders in a Pepsi advertisement that aired during the 1996 and 1998 Super Bowl games. The record contains substantial evidence of Looney Tunes character merchandise, including Road Runner, being advertised on eBay.

Jordan Sollitto, vice president of world-wide marketing and international licensing for Warner Bros. Consumer Products, stated that its licensees' use of the Looney Tunes characters, including Road Runner, is carefully controlled to preserve the unique characteristics of the characters; and that each Looney Tunes character has one main quality for which it is noted. Opposer's consumer testing indicates that the Road Runner character is associated with speed.

Mr. Sollitto stated that Road Runner is one of opposer's most popular characters for licensing and one of its most valuable brands for generating revenue. Opposer grants only a small number of the numerous license requests it receives; it licenses the mark only in connection with goods and services that it determines are viewed favorably by consumers; and it controls, owns, directs and approves all advertising done in connection with its licensed characters and names.

Opposer, Warner Bros. Entertainment, Inc., is owned by parent company Time Warner, which also owns Time Warner Cable ("TWC"). TWC offers cable television, telephone and Internet access services. Opposer licensed the Road Runner character and name to its affiliate, TWC, for use specifically in connection with its Internet access and related services. In this regard and contrary to applicant's allegations in its answer that opposer does not

own this registration, opposer established its ownership of the following pleaded and registered mark:

ROADRUNNER for "providing multiple-user access to a global computer information network for transfer and dissemination of a wide range of information;" [Registration No. 2246924, registered on May 25, 1999, claiming use and use in commerce since August 1, 1994; Section 8 and Section 15 affidavits filed; assigned from Roadrunner Computer Systems, Inc., recorded on September 9, 1999 at Reel 1965, Frame 0751, indicating an execution date of August 4, 1999.]

Opposer's service of providing multiple-user access to a computer database encompasses a broad range of topics, including weather, news, sports, educational and financial information, and entertainment.

Opposer established that TWC first began using the Road Runner cartoon character and name as marks, under license from opposer's predecessor, in connection with Internet access services in September, 1996. TWC's services include providing both homes and businesses with dial-up and high-speed Internet access via cable and related services, including, *inter alia*, email, instant messaging, virus protection and spam filters. These services are offered in 31 geographic areas encompassing several major metropolitan areas in approximately 25 states, including North and South Carolina. TWC advertises extensively across all types of media in its service areas. All advertising involves prominent use of the Road Runner marks.

Gregg R. DiPaulo, senior vice president of high-speed data for TWC, stated that TWC chose the Road Runner name and character to identify its Internet access services because TWC wanted a name synonymous with "speed," which is an important quality of Internet access services, and because of the brand equity already accruing to that property. He stated that business in this field today requires bundling of voice, video and data services to remain competitive; and that, for this reason, cable Internet access companies are offering phone service via the Internet (e.g., VoIP) and phone companies are partnering with satellite companies to be able to offer these three services together. Opposer submitted a significant amount of evidence of third parties advertising on the Internet both email and paging services together.

Opposer's witness, Jeffrey M. King, president of Roadrunner High Speed Online and executive vice president of TWC, described several aspects of TWC's Internet services, demonstrating TWC's Road Runner unified messaging service, available since 2002. "Unified messaging" describes applications allowing a user to have all messages (e.g., phone, email, text and fax) handled and presented in a unified fashion on a single wired or wireless device capable of connecting to the Internet, such as a personal digital assistant (PDA). Additionally, Mr. King stated that he, or

any subscriber with the appropriate service, can receive a page on his cell phone that was sent via the Internet, in particular, via the TWC Road Runner portal. Mr. King stated and introduced evidence establishing that several major companies offer both Internet access and paging services, including applicant (albeit under different marks), Verizon, AOL, Earthlink, NetZero, Frontier Communications and SBC. Those companies that are telephone companies offer high-speed Internet access services principally through a DSL protocol.

Opposer's witness, Howard L. Pfeffer, vice president of broadband technology for TWC, added that a pager can receive text and instant messaging if it has the appropriate software. He defined "paging" as "the ability to send a user or a person a text message, whether alphanumeric or numeric, that they will receive over a wireless device[;] and they will get notification from the device that the message has arrived..." (Pfeffer Dep. p. 17). Mr. Pfeffer stated that in recent years there has been a convergence of telecommunications technology so that it is no longer necessary to maintain separate protocols or connectivity for different types of communications devices. Rather, technology has moved in the direction of basing all devices on Internet protocols, with common networks and integrated services.

While opposer's evidence regarding TWC's advertising of its Internet services and its brand awareness statistics is confidential, suffice it to say that TWC spends substantial sums annually advertising its Road Runner Internet services; its annual growth rate, i.e., increase in numbers of customers, has been substantial since its inception; and, at least in its geographic service areas, consumer brand awareness, both aided and unaided, is extremely high and second only to AOL.

Opposer has established its ownership of the following additional pleaded and registered marks:



for "candy;" [Registration No. 1288072, registered on July 7, 1984, claiming use and use in commerce since July 1976; Section 8 affidavits accepted; Section 15 affidavit acknowledged; renewed.]

THE ROAD RUNNER & WILE E. COYOTE for "a series of motion picture, video and television films; series of prerecorded audio-video tapes, cassettes and/or discs featuring animation and/or music;" [Registration No. 1946471, registered on January 9, 1996, claiming use and use in commerce since August 12, 1992; Section 8 affidavit accepted; Section 15 affidavit acknowledged.]

ROAD RUNNER & WILE E. COYOTE for "video game cartridges; video and computer game programs, cartridges, and cassettes;" [Registration No. 2135226, registered on February 10, 1998, claiming use and use in commerce since November 1993; Section 8 and Section 15 affidavits filed.]; and

ROADRUNNER for "retail store services in the field of computer hardware, computer software and books related to computers." [Registration No. 2246925, registered on May 25, 1999, claiming use since August 17, 1983, and use in commerce since February 5, 1992; Section 8 and Section 15 affidavits filed; assigned from Roadrunner Computer Systems, Inc. recorded on September 9, 1999 at Reel 1965, Frame 0517, indicating an execution date of August 4, 1999.]

Applicant is a wholly-owned subsidiary of Farmers Telephone Cooperative, Inc. ("FTC"), a telephone company that provides, *inter alia*, local and long distance wired and wireless phone services and dial-up and broadband Internet access services and web hosting in five counties in South Carolina. FTC was the sole provider of local phone services in this area between 1952 and 1996. FTC began offering long distance service in this area in 1992. FTC offers its wireless phone services through Cingular, as part of a consortium of independent phone companies covering North and South Carolina, coastal Georgia and eastern Tennessee. The companies sell Cingular-branded equipment and follow Cingular's pricing plan and business dictates. Applicant's wireless phone service does include a paging service option, which is digital.

Applicant's competitors for local wired phone service include Verizon and Time Warner; its competitors for long distance wired phone service include MCI, Swift, Sprint and many other companies; its competitors for wireless phone service includes Sprint, Verizon and AllTel; its competitors

for Internet services include Time Warner, AOL, Earthlink, Level 3 and several local providers; and its competitors for paging services are several small local companies, including Carolina Page and Dial Page.

The services offered under the FTC umbrella are identified by different marks, all of which include the FTC name and logo. FTC offers its Internet services under the mark FTC-I.NET. FTC offers its high-speed DSL Internet services under the mark FTC BLAST.

Applicant offers only its paging services under the FTC Roadrunner mark. The mark is affixed to all of applicant's pagers, which are manufactured by Motorola. Its paging services are rendered through an analog network and are offered only to individual and business subscribers within applicant's service area, although subscribers can receive pages outside applicant's local area through its agreements with Morris Communications and PageNet. Subscribers can receive numeric pages and, as an added option, alphanumeric pages of up to 180 characters. An additional option for subscribers is to receive a daily news broadcast with stock quotes on the pager. Paging devices can only receive numeric or alphanumeric information; they cannot be used to send pages or other messages; and pages through applicant's paging service can be received only on its pagers.

Applicant advertises in its service area through many media, including newspapers, direct mailings, brochures, radio, and the Internet. A prospective subscriber must go to one of applicant's seven customer service locations to sign a subscription contract and obtain a pager. Applicant employs 50 customer service representatives and has fewer than 10,000 customers. Applicant first sold its paging services and pagers under the FTC Roadrunner mark on October 10, 1997.

Applicant's witness, Mr. Erwin, stated that applicant was aware of opposer's use of the Road Runner name and character in connection with Internet services; that applicant chose the name FTC Roadrunner for its paging services because of the actual bird's connotation of speed; that applicant believes that paging services and Internet services are substantially different; and that the marks are distinguished by applicant's use of FTC as part of its mark and by the merger of "road" and "runner" to form Roadrunner.

Analysis

Turning to the merits of opposer's claims, we find that opposer has established its standing to bring this opposition. Opposer has presented evidence of its use, registration and promotion of the mark Road Runner for a variety of goods and services. This is sufficient to establish that opposer has an interest in the outcome of

this proceeding and a reasonable basis for its belief that it will be damaged by the registration of applicant's mark. See Trademark Act Section 13, 15 U.S.C. §1063; *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); and *Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998).

Likelihood of Confusion

Opposer contends that it has used, through strictly controlled licenses, and registered the mark Road Runner and its Road Runner cartoon character design mark in connection with a wide variety of goods and services, including high-speed Internet services; that its Road Runner mark is famous and this fame extends to its use of Road Runner in connection with business and residential high-speed Internet services, including email, web mail, and instant messaging; and that its use of the mark Road Runner in connection with these services predates applicant's use of its mark FTC Roadrunner in connection with pagers and paging services.

Opposer contends that the parties' services are closely related and the trade channels are the same; that both parties' services can send text messages to a wireless device; that technology now permits communication via the Internet to all manner of wired and wireless devices using both voice and text; and that, as a result, the parties'

respective services provide to users similar communication functions and, thus, are directly competitive. Opposer notes that applicant is a telephone company that offers its customers, *inter alia*, both high-speed Internet services and pagers and paging services, albeit under different marks.

Regarding the parties' marks, opposer argues that its Road Runner mark is famous and entitled to a broad scope of protection; that its mark is inherently distinctive and arbitrary in relation to the goods and services involved in this proceeding; that the parties' marks are "virtually identical"; that opposer's mark is entirely subsumed in applicant's mark, FTC Roadrunner; and that the Roadrunner portion of applicant's mark is dominant.

Regarding the marks, applicant contends that both parties' marks are similarly highly suggestive and applicant chose its mark in view of the actual roadrunner bird "to suggest speed and to bring to the consumer's mind the impression of road running or being able to stay in touch while traveling on the road" (brief, p. 14); that the commercial impressions of the marks are different because "FTC," which applicant uses in connection with all its many goods and services, distinguishes applicant's mark from opposer's Road Runner mark and because the manner in which the respective marks are used is distinctively different; and that numerous third-party registrations incorporating

the word roadrunner for various goods and services demonstrates the suggestiveness of the term.

Regarding the parties' goods and services, applicant contends that, while both its paging services and opposer's Internet access services are in the broad class of telecommunications, the nature of the services is quite different and each service uses entirely different media and devices to render the services; and that three of opposer's pleaded registrations are for goods so dissimilar to applicant's goods and services that confusion is not likely. Applicant argues, further, that the channels of trade are different because the parties' respective services, and applicant's pagers, are sold only through the parties' own stores and, thus, the parties' services will never be offered side-by-side; and that the purchase of the respective services requires a deliberate purchasing decision, the signing of a contract, monthly fees, and, in relation to opposer's services, possible installation in a home or office.

Applicant argues that opposer's two pleaded registrations nos. 2246924 and 2246925 were assigned to opposer by a third party in 1999 and, thus, applicant has priority with respect thereto because it began use of its mark in 1997.

Regarding opposer's allegations of fame, applicant contends that the character design mark is not relevant to this proceeding as applicant's mark contains no such design; that, while the character design "has acquired notoriety in the field of children's entertainment, it has not done so in the area of telecommunications" (brief, p. 22); that "the fame of the suggestive term roadrunner is insufficient itself to establish likelihood of confusion" (id.); and that, in view of opposer's recent launch of its Internet service, it should not be "afforded a broad scope of protection for the word mark Road Runner such as to create a monopoly in the word so as to preclude its use as a suggestive term by others in commerce" (id.).

Finally, applicant notes that there have been no instances of actual confusion, despite applicant's use of its mark for over seven years.

Inasmuch as a certified copy of each of opposer's registrations is of record, there is no issue with respect to opposer's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In this regard, we note that applicant's argument that opposer may not claim priority based on the two registrations assigned to it in 1999 except from the date of assignment is not well taken. With the assignment, opposer stands in the shoes of the assignor and all rights accruing

to assignor now accrue to opposer as the assignee. *In re Aktiebolaget Electrolux*, 182 USPQ 255 (TTAB 1974). We also find that opposer has established priority based on the evidence of record of common law use of its Road Runner mark in relation to Internet access and related services since 1996.

As discussed below, we find that applicant's mark, FTC ROAD RUNNER, as applied to applicant's paging services and pagers, so resembles opposer's mark Roadrunner¹⁰ in opposer's registration no. 2246924 for "providing multiple-user access to a global computer information network for transfer and dissemination of a wide range of information," and as used in connection with Internet access and related services, as to be likely to cause confusion, to cause mistake, or to deceive.

However, we find that opposer has failed to prove a likelihood of confusion with respect to any of its other four pleaded and established registrations. Thus, our Section 2(d) determination is not based on these registrations. The marks and/or goods and services in registration nos. 1288072, 1946471, 2135225 and 2246925 are too dissimilar to applicant's mark and goods and services to be likely to cause confusion. Similarly, we do not base our

¹⁰ We note that opposer's registration is for the mark Roadrunner as a single word. As previously stated, we do not find the distinction

Section 2(d) decision on any alleged common law rights opposer claims in the Road Runner designation other than the Internet and related services noted herein. However, we have considered opposer's other evidence and registrations to the extent that they demonstrate the fame of opposer's Road Runner mark.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 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 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We begin with a discussion of the fifth *du Pont* factor, fame, which plays a dominant role in cases involving a strong or famous mark. *Kenner Parker Toys, Inc. v. Rose Art*

between the one or two-word representation of the term to be of

Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 1992); and *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

While opposer's Road Runner character is clearly a caricature of the actual roadrunner bird and is so named, the evidence clearly establishes that both the character and the Road Runner name have acquired renown as marks used in connection with opposer's entertainment services in the nature of cartoons. Further, as applicant concedes, the Road Runner cartoon character and the name Road Runner, are famous marks in connection with such entertainment services. The promotion, sales and use of the Road Runner character and name in connection with the wide variety of collateral goods shown in this record reinforces the conclusion that the Road Runner mark is famous in connection with entertainment services. See also *Time Warner Entertainment Co. v. Karen L. Jones*, 65 USPQ2d 1650 (TTAB 2002).

We find, further, that the evidence in this record, most of which is confidential, of revenues, numbers of customers, promotion expenditures, and mark recognition of opposer's mark Road Runner for Internet access and related services is sufficient to establish that the mark is famous in connection with these services. In our likelihood of

noteworthy significance.

confusion analysis, the fame of opposer's mark weighs heavily in its favor. We note that the evidence also establishes that the parties' geographic areas for their respective goods and services overlap.

Next, we turn to the *du Pont* factor of whether the parties' marks, 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 impressions that confusion as to the source of the goods or services offered under the respective marks is likely to result. 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).

As applicant has pointed out, there are specific visual differences between the marks, *i.e.*, applicant's mark begins with "FTC" and displays "ROADRUNNER" as one word. However, opposer's use of a two-word formulation and applicant's use of a one-word formulation is of little legal consequence, particularly in view of the fact that opposer's two registrations are of a one-word formulation. Further, "a purchaser is less likely to *perceive* differences from a

famous mark." *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 730, 6 USPQ2d 1719, 1722 (Fed. Cir. 1988) (Nies, J., dissenting) (emphasis in original), and quoted with approval in *Kenner Parker, supra*. Applicant's mark includes opposer's mark in its entirety. And while applicant has established that FTC is a house mark that it uses in combination with all of its marks, as a general rule, the mere addition of a trade name, house mark or the like to one of two otherwise confusingly similar marks will not serve to avoid confusion between them. See *In re Champion Oil Co.*, 1 USPQ2d 1920 (TTAB 1986); *In re Shawnee Milling Co.*, 225 USPQ 747 (TTAB 1985) and cases cited therein. Further, we do not consider applicant's mark to be distinct because applicant does not use opposer's or a similar cartoon character design. The Road Runner cartoon character design is a separate mark and, as previously stated, we are conducting our analysis in relation only to opposer's Road Runner word mark as used and registered in connection with Internet access and related services.

The connotation of applicant's mark differs from that of opposer's mark to the extent that it includes the term "FTC." In connection with the parties' respective goods and services, we find the connotation of the term Road Runner or Roadrunner in each mark to be the same, *i.e.*, it equally evokes either the actual roadrunner bird or the famous

cartoon character. Both parties indicated that they chose their respective marks because the term Road Runner or Roadrunner evokes speed, which is a desirable quality of both parties' services. This does not, as applicant contends, make either mark "highly suggestive," as there are quite a number of mental steps from the perception of the roadrunner bird to a connotation of speed and then to the respective services. We find applicant's argument that the term also suggests, in connection with paging services, that the consumer can receive messages while on the road to be of minor consequence herein and such a connotation does not distinguish the marks.

In terms of appearance, sound, connotation and overall commercial impression, we find that the similarity between the marks which results from the presence of the term Road Runner or Roadrunner in each mark outweighs the minor points of dissimilarity between the marks. This is particularly true in view of the fame of opposer's mark in connection with its Internet access and related services. Thus, this *du Pont* factor favors opposer.

Turning to the next relevant *du Pont* factor, we consider the goods and services involved in this case. We note that the question of likelihood of confusion must be determined based on an analysis of the goods and services recited in applicant's application and the relevant

registration of opposer, registration no. 2246924. *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). *See also, Octocom Systems, Inc. v. Houston Computer Services, Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1992); and *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715 (TTAB 1991).

Additionally, we consider opposer's extensive evidence of common law use of its mark Road Runner in connection with Internet access and related services.

Applicant presents evidence and arguments demonstrating how its paging services are different from opposer's Internet access and related services, for example, the technology differs, applicant's pagers can receive only limited information and are not interactive, and a subscriber must go to one of applicant's locations to sign a contract and obtain a pager. However, goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that some circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used therewith, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the

producers of each parties' goods or services. *In re Melville Corp.*, 18 USPQ2d 1386 (TTAB 1991), and cases cited therein.

In this case, applicant itself offers both Internet access services and paging services and, while these services are identified by applicant's different marks, both marks contain the term FTC to emphasize that both services are under the umbrella of Farmer's Telephone Cooperative. Additionally, the record contains numerous examples of third-party Internet web sites offering both paging services and various Internet-related communications services. Further, opposer's witnesses discussed at great length the nature of the various technologies for electronic communication, the interactivity of different services and devices in the field of electronic communications, and the practices of service providers to bundle different types of electronic communication services, including Internet access services and paging services. The record also establishes that a pager can receive pages from another device via the Internet, if so configured. Applicant's witnesses and evidence did not contradict this testimony and the nature and extent of its own business confirms opposer's witnesses' statements.

In this case, the relevant consumers of both parties' respective services are general consumers for both business

and personal use. As applicant contends, it is unlikely that consumers will confuse paging services with Internet access services. However, there is ample evidence that paging services and Internet access and related services, including email, often come from the same source regardless of the technology used, so that it is highly likely that consumers encountering paging services bearing applicant's confusingly similar mark are likely to assume that opposer has licensed or approved use of such mark. Thus, for the reasons discussed above, we find that applicant's paging services and its pagers, which are an integral part of that service, are sufficiently related to opposer's services that confusion is likely to result from the use of the parties' similar marks in connection therewith. This is especially so in view of the fame of opposer's mark. See *Recot, Inc.*, *supra*.

The evidence establishes that the trade channels of the parties' respective services are essentially the same, i.e., a consumer must contact a service provider directly to obtain a subscription contract. We note, also, that the parties advertise through the same media to the same general consumers. Although the consumer must contact either applicant or opposer to subscribe to their respective services, this does not, as applicant contends, make the trade channels different. While the fact that the consumer

must initiate the contact with the provider of the respective service mitigates against confusion, it is insufficient, alone, to avoid any likelihood of confusion.

The record indicates no instances of actual confusion during applicant's seven years of use and during at least several years opposer operated within applicant's geographic area. Concurrent use of confusingly similar marks over a period of time in the same geographic area without any evidence of actual confusion weighs in applicant's favor. *See, G. H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635 (Fed. Cir. 1990). However, actual confusion is notoriously difficult to come by and, while probative, it is not necessary to a finding of likelihood of confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768 (TTAB 1992); *Block Drug v. Drug-Mat Inc.*, 17 USPQ2d 1315 (TTAB 1989); and *Guardian Products Co. Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

After careful consideration of the evidence of record pertaining to all of the relevant *du Pont* factors, we find that a likelihood of confusion exists as between applicant's mark FTC Roadrunner for paging services and pagers and opposer's mark RoadRunner in registration no. 2246924 and Road Runner as used in connection with Internet access and related services. Moreover, opposer's mark is a famous

mark, which is entitled to a broad scope of protection under *Kenner Parker Toys and Recot, Inc., supra.*

Because we sustain opposer's Section 2(d) ground of opposition, we find it unnecessary to address opposer's additional grounds of opposition under Sections 2(a) and 43(d) of the Trademark Act.

Decision: The opposition is sustained under Section 2(d) and registration to applicant is refused.