

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

Mailed:

February 24, 2006
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Transcend Logistics, Inc.

v.

Transflo Corporation

Opposition No. 91159666 to application Serial No. 78156062
filed on August 20, 2002

Opposition No. 91159708 to application Serial No. 78231960
filed on March 31, 2003

Mark G. Kachigian of Head, Johnson & Kachigian for Transcend
Logistics, Inc.

Karen Koster Burr of Atlantic Beach Law, P.A. for Transflo
Corporation.

Before Hohein, Hairston and Kuhlke, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Transflo Corporation has filed applications to register the mark "TRANSCEND" in standard character form for "web-based software for freight transportation logistics planning, management, tracking, billing and payments" in International Class 9 and "consulting services in the area of freight transportation logistics management" in International Class 35¹

¹ Ser. No. 78156062, filed on August 20, 2002, which is based on an allegation of a bona fide intention to use such mark in commerce.

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and the mark "TRANSCEND" and design, in the special form show below,



for "consulting services in the area of freight transportation logistics management" in International Class 35 and "providing temporary use of non-downloadable software for freight transportation logistics planning, management, tracking, billing and payments" in International Class 42.²

Transcend Logistics, Inc. has opposed registration on the ground that, as set forth in the notices of opposition respectively filed in connection with these consolidated proceedings,³ it has "promoted the mark TRANSCEND LOGISTICS to create in the minds of the purchasing public the concept of a nationally recognized organization offering freight transportation logistics"; that it has done so "since a time earlier than Applicant"; and that applicant's use of its "TRANSCEND" marks "is likely to cause confusion in the minds of the purchasing public."⁴

² Ser. No. 78231960, filed on March 31, 2003, which alleges a date of first use of such mark anywhere and in commerce of January 1, 2003.

³ Pursuant to an uncontested motion therefor, proceedings herein were consolidated by the Board in an order dated July 14, 2004.

⁴ Although each notice of opposition also alleges, as to the respective marks of applicant, that applicant's use thereof "dilutes the uniqueness and exclusivity of the mark TRANSCEND LOGISTICS as employed by the Opposer since at least March, 2002, well in advance of Applicant's use," such allegation was not pursued at trial or argued in opposer's briefs on the case. Accordingly, no further consideration will be given thereto.

Applicant, in its answers, has in relevant part admitted opposer's allegations, by its failure specifically to deny such, that each of applicant's "TRANSCEND" marks "is substantially identical and confusingly similar to the trademarks [sic] of Opposer," but otherwise has denied the remaining salient allegations of the notices of opposition. Fed. R. Civ. P. 8(b) and (d). Briefs have been filed, but neither party requested an oral hearing.

The record includes the pleadings; the file of each of the opposed applications; and, as part of opposer's case-in-chief, the affidavits, two of which also have exhibits, of each of the following persons, which opposer filed pursuant to a stipulation by the parties:⁵ (i) Garth Hill, president of opposer; (ii) Bob Weaver, president and chief executive officer of P.A.M. Transport, Inc. (hereinafter "P.A.M."); (iii) Larry Goddard, chief financial officer of P.A.M.; (iv) Tim Hill, president of Source Logistics, Inc.; (v) Robert R. Harron, president of GHC Services, Inc.; and (vi) Delton Couch, formerly chief financial officer of Daymark, Inc. The rest of opposer's case-in-chief consists of a notice of reliance upon, *inter alia*, an abandoned application by applicant for the mark "TRANSCEND FULLSUPPLYCHAIN.COM" and design,⁶ applicant's responses and

⁵ Such stipulation, citing TBMP Section 501.01, recites in pertinent part that "[t]he Parties may submit the testimony of any and all witnesses in the form of an affidavit" as permitted by Trademark Rule 2.123(b).

⁶ Ser. No. 78156072, filed as an intent-to-use application on August 20, 2002 and expressly abandoned on May 22, 2003, which sought to register such mark for "web-based software for freight transportation logistics planning, management, tracking, billing and payments" in

objections to opposer's interrogatories and request for production of documents and things,⁷ and applicant's supplemental response to opposer's interrogatories and request for production.⁸ Applicant's case-in-chief consists of the affidavit, with exhibits, of Belinda Hess, its director of marketing and logistics, which it filed pursuant to the above-noted stipulation by the parties and its notice of reliance on opposer's answers to applicant's interrogatories, opposer's responses to applicant's first request for production of documents and things,⁹ letters between counsel for the parties relating to and confirming supplementation of discovery

International Class 9 and "consulting services in the area of freight transportation logistics management" in International Class 35.

⁷ While Trademark Rule 2.120(j)(3)(i) provides that interrogatories and answers thereto may be made of record by timely filing a notice of reliance thereon, such rule does not permit the filing of a notice of reliance on objections to interrogatories. In addition, Trademark Rule 2.120(j)(3)(ii), as a general matter, does not permit the filing of a notice of reliance on requests for production and the responses thereto, stating in particular that: "A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e)" as official records or printed publications. Nonetheless, inasmuch as applicant in its brief has not objected to opposer's notice of reliance upon various improper subject matter, such matter is considered to be stipulated into the record. See TBMP Sections 704.10 and 704.11.

⁸ Although applicant's supplemental response consists of correspondence from its attorney to opposer's counsel and thus, strictly speaking, is not proper subject matter for a notice of reliance under Trademark Rules 2.120(j)(3)(i) and (ii) for the reasons previously explained in footnote 7, applicant has not objected thereto in its brief. In view thereof, such matter is considered to be stipulated into the record. See TBMP Sections 704.10 and 704.11.

⁹ While, as previously indicated, Trademark Rule 2.120(j)(3)(ii) does not as a general proposition permit the filing of a notice of reliance on responses to requests for production, such responses are considered to form part of the record since opposer has not objected thereto in its briefs. See TBMP Section 704.11.

responses,¹⁰ and opposer's answers to applicant's requests for admission. Opposer did not offer any rebuttal evidence.

According to the record, opposer was incorporated under the name of Transcend Logistics, Inc. in the State of Indiana on April 24, 2002. Prior thereto, opposer's president, Mr. Hill, "operated for a short period as an unincorporated sole proprietorship under the designation TRANSCEND LOGISTICS." (Garth Hill aff. at ¶1.) Opposer, which has offices in Arkansas, Texas, Oklahoma, Mississippi and Florida, "is a full service logistics, supply chain and transportation management resource company." (Id. at ¶3.) Such services, for example, include "customers [who] outsource management of their transportation of raw materials and products to" opposer. (Id.)

According to opposer's president, in the spring of 2002, he "had the capability to provide logistics, supply chain and transportation management services and began soliciting customers." (Id. at ¶4.) On March 28, 2002, a date which is prior to opposer's incorporation, he "made a sales and marketing presentation on behalf of Transcend Logistics to Porter Paints, a prospective customer [located in Louisville, Kentucky], and used the tradename [sic] and trademark TRANSCEND LOGISTICS to identify our services." (Id. at ¶5.)

Beginning in April 2002, opposer's president "had meetings with Tim Hill of Source Logistics, Inc. of Russellville,

¹⁰ Although such letters technically are not proper subject matter for a notice of reliance under Trademark Rules 2.120(j)(3)(i) and (ii) for the reasons set forth above in footnote 7, opposer has not objected thereto in its briefs. Such matter is therefore considered to be stipulated into the record. See TBMP Sections 704.10 and 704.11.

Arkansas to discuss the possibility of Transcend Logistics, Inc. providing logistics services to Source Logistics, Inc." (Id. at ¶6.) During such meetings, opposer's president "made sales and marketing presentations under the TRANSCEND LOGISTICS tradename [sic] and trademark." (Id.) Likewise, according to Tim Hill, he acknowledges that he met with opposer's president "on several occasions, beginning in April 2002[,] to discuss the possibility of ... [opposer providing logistics services to Source Logistics, Inc." and that, "[d]uring each of those meetings, Garth [Hill] made sales and marketing presentations under the TRANSCEND LOGISTICS tradename [sic] and trademark and solicited business from Source Logistics, Inc." (Tim Hill aff. at ¶¶2 and 3.) Delton Couch, who "sat in on a meeting between Garth Hill ... and Tim Hill ... which took place in April 2002," confirms that "Garth discussed the possibility of ... [opposer] providing logistics services to Source Logistics, Inc." and that "[d]uring that meeting, Garth made a sales and marketing presentation under the TRANSCEND LOGISTICS tradename [sic] and trademark and solicited business from Source Logistics, Inc." (Couch aff. at ¶¶2 and 3.)

In April 2002, opposer's president also "held phone meetings with Joe Metkler of PPG, Inc., a prospective customer, concerning providing logistics management services ... to PPG, Inc. in Delaware, Ohio." (Garth Hill aff. at ¶7.) "In each of such meetings," according to opposer's president, he "used the tradename [sic] and trademark TRANSCEND LOGISTICS to identify our services." (Id.)

Although opposer's president testified that, "[o]n or about April 23, 2002, Transcend Logistics, Inc. acquired the domain names of Transcendlogistics.com; Transcendlogistics.org[;] and Transcendlogistics.net through Network Solutions," the documentary evidence submitted with respect thereto, which consists of printouts from the Network Solutions website, recites the following as the owner of such names: "Registrant: Hill, Garth E." (Id. at ¶8 and Ex. B.) Nonetheless, opposer's president further testified that opposer, in connection with its business, has "utilized one or more of those domain name designations since that time" and a copy of an advertisement in the January 2003 issue of Inbound Logistics magazine evidences opposer's use of the "www.transcendlogistics.com" domain. (Id. at ¶8 and Ex. F.)

On April 25, 2002, the day after its incorporation, opposer "made an offer to purchase assets of a business, Daymark, Inc., under the TRANSCEND LOGISTICS trademark or tradename [sic]." (Id. at ¶9.) Beginning in May 2002, opposer's president "met on several occasions with Robert Harron of GHC Services, Inc., a prospective customer, to discuss the possibility of ... [opposer] providing transportation, logistics and consulting services for GHC Services and its clients." (Id. at ¶10.) "During each of those meetings," opposer's president "made sales and marketing presentations under the TRANSCEND LOGISTICS tradename [sic] and trademark." (Id.) Mr. Harron, noting that "GHC Services, Inc. is a transportation and distribution services company and has customers located throughout the United States

and Mexico," corroborates meeting with opposer's president "on several occasions, beginning in May, 2002." (Harron aff. at ¶¶3 and 4.) According to Mr. Harron, "[d]uring each of those meetings," he "met with Garth Hill ... to discuss the possibility of ... [opposer] providing supply chain management services to GHC Services, Inc." and that, "[a]t these meetings," he and "Garth Hill ... also discussed the possibility of ... [opposer] providing transportation, logistics and consulting services for GHC Services and its clients." (Id. at ¶¶5 and 6.) Mr. Harron confirms that, during the course of such meetings, opposer's president "made sales and marketing presentations under the TRANSCEND LOGISTICS tradename [sic] and trademark." (Id. at ¶5.)

In May 2002, opposer also "registered with the Council of Logistics Management ('CLM') as a member." (Garth Hill aff. at ¶11.) CLM, which "is now known as [the] Council of Supply Chain Management Professionals," "is a professional association for logistics providers." (Hess aff. at ¶15.) Such organization, according to opposer's president, publishes "the leading industry magazine for logistics management." (Garth Hill aff. at ¶11.) However, "[a]ccess to membership information is only available to other logistics professionals." (Hess aff. at ¶15.)

In June 2002, opposer's president "held a phone meeting with Darlene Klapper of Procter and Gamble, a prospective customer, regarding [opposer] providing logistics services to Procter and Gamble," which services opposer "offered to provide ... under the designation TRANSCEND LOGISTICS." (Garth Hill aff.

at ¶12.) Also, in June 2002, opposer's president "had a meeting with Bob Weaver and Larry Goddard of P.A.M. . . . , a prospective customer, to discuss [opposer] providing logistics services." (Id. at ¶13.) In particular, according to the affidavits of Bob Weaver and Larry Goddard, their June 2002 meeting with opposer's president involved a discussion of opposer "providing supply chain management services to P.A.M." (Weaver aff. at ¶2; and Goddard aff. at ¶2.) Messrs. Weaver and Goddard corroborate that, during his "sales and marketing presentation," opposer's president "utilized the TRANSCEND LOGISTICS tradename [sic] and trademark." (Weaver aff. at ¶2; Goddard aff. at ¶2; and Garth Hill aff. at ¶13.) In August 2002, opposer's president "held a meeting with Rick Gallagher of Prime, Inc. in Springfield, Missouri, a prospective customer[,] to discuss [opposer] providing logistics services to Prime, Inc." in which he "utilized the TRANSCEND LOGISTICS tradename [sic] and trademark." (Garth Hill aff. at ¶14.) Subsequently, on September 19, 2002, P.A.M. "acquired" opposer as a subsidiary.¹¹ (Id. at ¶15.)

Opposer "advertises and markets its services through various channels, including *Inbound Logistics Magazine*" as well as both opposer's and P.A.M.'s websites. (Id. at ¶16.) For instance, in January 2003 two advertisements for opposer, both of which featured its "TRANSCEND Logistics, Inc." logo and one of which also included the "TRANSCEND LOGISTICS" mark, "appeared in the annual planner issue of . . . *Inbound Logistics Magazine*" and

¹¹ Both Messrs. Weaver and Goddard confirm that the acquisition by P.A.M. of opposer occurred "in September of 2002." (Weaver aff. ¶3; and Goddard aff. ¶3.)

such logo "was included on the *Inbound Logistics Magazine* website for the entire year of 2003." (Id. at ¶¶17 and 18 and Ex. F.) Likewise, the website for "Inbound logistics PLANNER 2004," as well as the website ("www.transcendlogistics.com") for opposer and its parent, both display the "TRANSCEND LOGISTICS" mark and the "TRANSCEND Logistics, Inc." logo. (Id. at Exs. D and E, respectively.) In addition, the "PLANNER INDEX & RFP" page from the January 2003 edition of the print version of such magazine lists the names of 48 advertisers, including opposer; invites readers thereof to "Check the companies you're interested in and fax this page to" Inbound Logistics; and states that "Inbound Logistics ... is published 12 times a year on the 15th of the month for 55,050 people who buy, specify, or recommend logistics, logistics technology, transportation and related services." (Id. at Ex. F.)

For the year 2003, opposer "made sales and marketing presentations to the following customers and prospective customers using the TRANSCEND LOGISTICS tradename [sic] and trademark:

- A. MTD, Inc. of Williard, Ohio
 - B. Benjamin Moore Paints
 - C. O'Reilly Auto Parts of Springfield, Missouri
 - D. Trane of St. Louis, Missouri
 - E. Procter & Gamble of Cincinnati, Ohio
 - F. DuPont, Inc. of Wilmington, Delaware
 - G. Porter Paints of Louisville, Kentucky
 - H. PPG, Inc. Delaware, Ohio
 - I. Monarch Paints of Houston, Texas
 - J. Hanna's Candles of Fayetteville, Arkansas
 - K. Allen Canning Company of Siloam Springs, Arkansas
 - L. Ultimate Distribution, Inc. of Edison, New Jersey
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- M. NYK Logistics/ETA of Bentonville, Arkansas
- N. BONUS Stores of Columbia, Mississippi[.]"

(Id. at ¶19.) "In some cases, an electronic ('Power point') presentation was made and a copy of the first page or slide prominently featuring TRANSCEND LOGISTICS" is of record. (Id.) Except for the date and name of the targeted customer, each slide (with the further exception of the one with a logo for "PTSI Quality Transportation" instead of opposer) is identical and displays the "TRANSCEND Logistics, Inc." logo. (Id. at Ex. G.)

Opposer "provided logistics services to MTD, Inc. in 2002 in the total amount of \$15,000; and in 2003 in the total amount of \$60,000. It provided logistics services to O'Reilly Auto Parts, Inc. and MTD, Inc. in the first quarter of 2004 for [an amount totaling] \$65,000, ... in the second quarter of 2004 for [an amount totaling] \$40,000 and ... in the third quarter of 2004 for [an amount totaling] \$40,000." (Id. at ¶20.) In particular, opposer maintains that "MTD, Inc. was provided with services ... in October, November and December of 2002 and that the TRANSCEND trademark was used beginning in November or December of 2002 with MTD, Inc.," although no supporting documents or any other evidence pertaining thereto has been made of record. (Supplementation of discovery responses as set forth in July 8, 2004 letter from opposer's counsel to applicant's attorney.) Instead, to the extent that it is legible, opposer further indicates that it "provided \$15,000 worth [of services] to MTD, Inc. in 2002 by providing those services through Decker (a part of parent) [P.A.M.]" (Supplementation of discovery responses as set forth in June 18, 2004 letter from opposer's

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counsel to applicant's attorney.¹²) In short, as to the actual rendering of its services, opposer "admits that during the last quarter of 2002, Opposer provided logistics services for compensation to one customer" and that, "in 2003 and 2004, Opposer provided services for compensation to one additional company." (Answer to Applicant's Req. for Adm. Nos. 10 and 11.)

Opposer denies having not spent any money on or otherwise not doing any advertising in 2002, although no amount of any expenditures for advertising in 2002 has been indicated. (Answer to Applicant's Req. for Adm. Nos. 4 and 5.) In 2003, opposer "spent \$5,015 for advertising and \$4,136 in the first quarter of 2004 for advertising." (Garth Hill aff. at ¶21.)

In the opinion of opposer's president, applicant's services, as recited in its involved applications, "overlap and conflict with the services offered by Opposer." (Id. at ¶23.) Opposer, however, "has no information, knowledge or documents regarding any instance of confusion, mistake or deception." (Answer to Applicant's Interrog. No. 8.) Opposer, furthermore, maintains that it did not become aware of applicant's use of applicant's "TRANSCEND" mark until "November 19, 2002." (Answer to Applicant's Interrog. No. 7.) Opposer "has not filed any ... trademark applications which incorporate the term TRANSCEND." (Answer to Applicant's Interrog. No. 4.)

¹² Such letter, as shown in the single-page photocopy thereof, contains a crease in the first page which serves to obscure portions of such page while most of the second page of the letter is masked by being covered by the first page.

Applicant, in connection with its adoption of its "TRANSCEND" marks, had a search conducted by a third party prior to the filing date of the earliest of its involved applications. The resulting search report is dated August 14, 2002. Prior to receipt of the notices of opposition in this consolidated matter, applicant was not aware of any use of the mark "TRANSCEND LOGISTICS" by opposer, although in light of the search report it "was aware of a registered domain name with no active website on August 15, 2002." (Reply to Opposer's Interrog. No. 26.) In particular, according to applicant's director of marketing and logistics, Belinda Hess:

During the time that we were investigating the availability of the TRANSCEND mark in connection with transportation logistics services, we were not aware of any commercial activity by Opposer. There were no trademark applications and no indications of ... [opposer's] use in internet searches.

(Hess aff. at ¶7.) Further, she notes that "[i]t is our experience that many domain names are reserved and never used or simply bought to be sold." (Id. at ¶9.) Thus, while "[t]he only hint of a planned use was the discovery of the registration of the transcendlogistics.com domain name," inasmuch as "no active website could be found at that address, we found no trace of public, active commercial activity." (Id. at ¶8.) Applicant "first learned that Opposer was actually engaged in business when contacted by Opposer in December 2003." (Id. at ¶11.)

Applicant first used its "TRANSCEND" mark, both "locally and in interstate commerce," "on the web" and "in brochures" on "September 27, 2002" in connection with "freight

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transportation logistics consultation services and software."
(Reply to Opposer's Interrog. No. 7.) Applicant provides its "TRANSCEND" services in "all of North America (including Mexico, Canada and the United States)". (Reply to Opposer's Interrog. No. 8.) Belinda Hess, in her affidavit, confirms that as to use of its "TRANSCEND" mark, applicant "began commercial and interstate use of the mark on September 27, 2002," stating that such mark "was introduced in brochures and on the Transflo.net website at that time in all of North America." (Hess aff. at ¶6.) She also states that applicant first used its "TRANSCEND" and design mark in connection with its services "in interstate ... commerce in January 2003." (Id. at ¶4.) Applicant regards the customers for its "TRANSCEND" services as being "sophisticated commercial consumers." (Applicant's Reply to Opposer's Interrog. No. 9.) Such services "are marketed and offered to the bulk freight shipping community." (Applicant's Reply to Opposer's Interrog. No. 10.)

Opposer, in its main brief, asserts that the parties "agree that Opposer's TRANSCEND LOGISTICS [mark] is substantially similar to Applicant's TRANSCEND word mark and word mark with design" and maintains that "[b]oth parties use the designation TRANSCEND in connection with freight transportation logistic[s] services and related software." Applicant, in its brief, essentially concurs, stating that the "threshold determinations of ... similarity of the marks as applied to the [respective goods and] services is not disputed by the Parties." Likewise, the parties do not dispute that opposer's trade name, Transcend

Logistics, Inc., is confusingly similar to applicant's "TRANSCEND" marks.¹³ We agree with the parties that, when considered in their entirety, the marks and trade name at issue are substantially similar in sound, appearance, connotation and commercial impression. Such is due to the shared presence in each of the arbitrary term "TRANSCEND," which constitutes the dominant and/or distinguishing element of applicant's marks and, in view of the genericness of the term "LOGISTICS," is also the dominant and distinguishing portion of opposer's mark and trade name. See, e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); and In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Thus, because contemporaneous use of the respective marks and trade name in connection with essentially identical services in the area of freight transportation logistics management and software related thereto would be likely to cause confusion, the dispositive issue in this proceeding is which party has priority of actual, technical service mark use or use analogous thereto.

Opposer argues in its main brief that the record shows that, "beginning in March 2002, Opposer offered its services to prospective customers under the designation TRANSCEND LOGISTICS" and has "also used and uses the ... designation TRANSCEND LOGISTICS on its website" Opposer insists that, "[b]y

¹³ Although not pleaded in the notices of opposition, we find that the issue of whether applicant's use of its "TRANSCEND" marks for the goods and services set forth in its involved applications is likely to cause confusion with opposer's trade name as used in connection with its business was in fact tried by the implicit consent of the parties. The pleadings are accordingly deemed to be amended so as to conform to the evidence with respect to such issue. Fed. R. Civ. P. 15(b).

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virtue of its extensive and continuous use, the trademark [and trade name] TRANSCEND LOGISTICS has become closely associated with Opposer both in connection with its services and with its corporate identity." Among other things, opposer points in support thereof to the fact that, in addition to "an extensive and on-going program of sales and marketing presentations using the trademark and tradename [sic] TRANSCEND LOGISTICS in offering its services," it was "incorporated under the corporate name Transcend Logistics, Inc. on April 24, 2002"; that it assertedly "acquired the Internet domain names Transcendlogistics.com, Transcendlogistics.org and Transcendlogistics.net on April 23, 2002; and that it "registered with the Council of Logistics Management in May 2002." Opposer maintains that such activities, spanning the period from March 2002 through August 2002, "constitute extensive and continuous actions of the Opposer using the trademark [and trade name] TRANSCEND LOGISTICS." Thereafter, it further insists, it "supplemented and followed up these activities with usage of the trademark and trade name TRANSCEND LOGISTICS in various activities including print advertising, internet website advertising and sales of services." In view thereof, and inasmuch as "customers and prospective customers have testified to their identification of the trademark and trade name TRANSCEND LOGISTICS as associated with the Opposer," opposer argues that it is entitled to priority and hence to prevail herein.

Applicant, on the other hand, contends in its brief that:

Section 7(c) of the *Lanham Act* provides that filing an application to register a trademark on the principal register confers a nationwide constructive use priority right against any other person except one who, prior to such filing, has used the mark. 15 U.S.C. § 1057(c). Section 2(d) precludes registration of a mark or trade name previously used in the United States and not abandoned where it will cause a likelihood of confusion. 15 U.S.C. § 1052(d). To succeed in opposing Applicant's applications, Opposer must establish priority over Applicant's constructive use date. *T.A.B. Systems v. Pactel [sic] Teletrac*, 77 F.3d 1372, 1374; 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996). Since Opposer has no application or registration for the mark at issue, it must establish common law priority to overcome Applicant's constructive priority date. *Lucent Information Management, Inc. v. Lucent Technologies, Inc.*, 186 F.3d 311, 317-318; 51 U.S.P.Q.2d 1545 (3rd Cir. 1999), cert. denied, 528 U.S. 1106 (2000). The burden of establishing common law priority is greater than that to support registration, and even higher when it seeks "to stifle the efforts of others to use a similar mark." *McDonald's Corporation v. Burger King Corporation*, 107 F. Supp.2d 787, 789 (D. Mich. 2000) (internal citations omitted).

Arguing, furthermore, that for purposes of determining whether opposer has priority, "[t]he focus of the inquiry is [on] the perception of the relevant potential customer pool, not the subjective intention of the adopter of the mark," applicant urges that opposer has failed to make a significant impact on the relevant market.

In particular, applicant asserts in its brief that (italics in original):

Opposer had no customers prior to August 20, 2002. Accordingly, it cannot rely on actual use of the service mark in conjunction with the provision of services in commerce to support its opposition. An opposition may be grounded on use analogous to service mark

use. *T.A.B. Systems v. Pactel [sic] Teletrac*, 77 F.3d 1372, 1375; 37 U.S.P.Q.2d 1879 (Fed. Cir. 1996). However, opposer must have use that is "sufficiently clear, widespread and repetitive to create the required association in the minds of the potential purchasers between the mark as an indicator of a particular source and the service to become available later." *Id.*, at 1376. See also, *Blue Bell, Inc. v. Farah Mfg. Co, Inc.*, 508 F.2d 1260, 1266 (5th Cir. 1975). This significant impact on purchaser perception must involve more than an insubstantial number of potential customers. *T.A.B. Systems*, 77 F.3d at 1377; *Herbko Int'l Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 1162 (Fed. Cir. 2002). *Lucent, supra*, 186 F.3d at 316.

In the instant case, Opposer's sole advertisement prior to Applicant's priority date consisted of power point presentations to a handful of prospective clients. Even if we count the membership in the trade association, whose rolls are unavailable to the general public, Opposer's promotions were extremely limited in this period and only touched the awareness of an infinitesimal segment of the potential freight transportation logistics market. The website and magazine advertisements that were available only after Applicant's filing date constitute the only additional promotions in 2002-2003 outside of less than a dozen additional personal presentations to new prospective customers. The infrequent forays into the market prior to Applicant's applications did not grow to a substantial market presence even a year later. Opposer's commercial activity was inadequate in the time at issue to establish priority rights over Applicant. See, *Lucent, supra*, 186 F.3d at 317 and *Duffy d/b/a Retirement Report Card v. Charles Schwab & Co.*, 97 F. Supp.2d 592, 54 U.S.P.Q.2d 1820 (D. N.J. 2000). (presentations to a few prospective customers is insufficient to establish priority).

Finally, applicant insists that in order to have priority, opposer has to do more than merely prepare to do

business under its mark and trade name. Specifically, applicant maintains that:

Moreover, analogous trademark use is not adequate in itself to establish priority. It must be followed by actual trademark use within a reasonable time. *Dyneer Corp. v. Automotive Products, PLC*, 37 U.S.P.Q.2d 1251 (TTAB 1995); *Evans Chemetics, Inc. v. Chemetics Int'l Ltd.*, 207 U.S.P.Q. 695 (TTAB 1980). Mere promotional activities and materials do not constitute trademark use for priority purposes. *Sweetwater Brewing Co. LLC v. Great American Restaurants, Inc. d/b/a Sweetwater Tavern*, 266 F. Supp.2d 457, 464 (E.D. Va. 2003). Opposer obtained a single client by the end of 2002, roughly seven months after incorporation and several months after Applicant's priority date. It added one additional customer for 2003 and 2004. Sporadic and infrequent sales also cannot sustain a claim of common law priority. *Momentum Luggage & Leisure Bags v. Jansport, Inc.* [,] U.S. Dist. LEXIS 18122 (S.D.N.Y. Nov. 8, 2001). Weighing in the small number of customers, slow growth, and minimal advertising as earmarks of Opposer's market penetration during the relevant period and for the next year or so beyond does not change ... [matters]. Opposer has not met his burden of establishing common law priority of use of the TRANSCEND [LOGISTICS] mark.

As a starting point for our analysis regarding which party has priority of actual, technical service mark use or use analogous thereto,¹⁴ we note that it is well established that, in the absence of testimony or other proof which demonstrates that

¹⁴ Given that the examples of record of opposer's use of its trade name include the use thereof in a logo format in which the "TRANSCEND Logistics" portion thereof also functions in the manner of a service mark, we need not consider whether opposer has prior trade name use of "Transcend Logistics, Inc." See, e.g., *In re Univar Corp.*, 20 USPQ2d 1865, 1869 (TTAB 1991). Moreover, despite its insistence that prior trade name use alone is sufficient for it to prevail, opposer has not pointed to a single instance in which its use of its trade name solely as such is earlier than its use of the logo format thereof.

the actual use of the mark which an applicant seeks to register is prior to the filing date of its involved application, the earliest date upon which such an applicant can rely in an opposition proceeding is the filing date of the involved application. See, e.g., Lone Star Mfg. Co., Inc. v. Bill Beasley, Inc., 498 F.2d 906, 182 USPQ 368, 369 (CCPA 1974); Columbia Steel Tank Co. v. Union Tank & Supply Co., 277 F.2d 192, 125 USPQ 406, 407 (CCPA 1960); Zirco Corp. v. American Tel. & Tel. Co., 21 USPQ2d 1542, 1544 (TTAB 1991); and Miss Universe, Inc. v. Drost, 189 USPQ 212, 213 (TTAB 1975). Thus, on the record in this consolidated case, while applicant has proven a date of first use anywhere and in commerce of September 27, 2002 in connection with its "TRANSCEND" mark, as to that mark it is nonetheless entitled for priority purposes to rely on the earlier August 20, 2002 filing date of its intent-to-use application for such mark.¹⁵ Furthermore, although the parties, in their briefs, chiefly focus their attention on applicant's attempt to register its "TRANSCEND" mark and therefore tend to overlook the fact that applicant also seeks to register its "TRANSCEND" and design mark, the record reflects that applicant has proven a date of first use in commerce of January 2003 in connection with such mark.¹⁶ Inasmuch as such date is obviously prior to the March 31, 2003 filing date of its involved application for the "TRANSCEND" and design mark, the earliest date upon which applicant is entitled

¹⁵ We observe in this regard that opposer does not maintain otherwise in its briefs.

¹⁶ Opposer, we also note, does not contend to the contrary in its briefs.

to rely herein for purposes of priority as to that mark is its January 2003 date of actual first use thereof.

Accordingly, in order for opposer to prevail herein, it must prove a date of its actual or analogous service mark use of the term "TRANSCEND LOGISTICS" *anywhere* (although, contrary to the thrust of applicant's arguments,¹⁷ such use does not have to be in interstate or foreign commerce; it may instead be wholly intrastate¹⁸) which is on or before August 20, 2002 vis-à-vis applicant's "TRANSCEND" mark and on or before January 2003 vis-à-vis applicant's "TRANSCEND" and design mark. While the oral testimony, even of a single witness, can nonetheless suffice to prove priority if "sufficiently probative," the testimony as to opposer's first use cannot be characterized by contradictions,

¹⁷ Applicant contends in effect that opposer must have use in commerce, arguing that opposer "cannot rely on actual use of the [TRANSCEND LOGISTICS] service mark in conjunction with the provision of services *in commerce* to support its opposition" (emphasis added) if opposer had no customers. Section 45 of the Trademark Act, 15 U.S.C. §1127 defines "use in commerce" in relevant part as follows:

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this Act, a mark shall be deemed to be in use in commerce--

....

... on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

¹⁸ Proof of prior and continuous use in intrastate commerce is sufficient to preclude registration. *See, e.g.,* National Cable Television Ass'n v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1429 n.4 (Fed. Cir. 1991) ("Section 14 [of the Trademark Act, 15 U.S.C. §1064,] requires only prior use; 'in commerce' is noticeably absent"). However, like "use in commerce," use of a mark which is wholly intrastate must still be bona fide use in the ordinary course of trade, and not use which is made merely to reserve a right in a mark.

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inconsistencies or uncertainties. *Powermatics, Inc. v. Global Roofing Products Co., Inc.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965).

Moreover, as set forth in *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002):

To establish priority, the [opposer or] petitioner must show proprietary rights in the mark that produce a likelihood of confusion. *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 1320, 209 USPQ 40, 43 (CCPA 1981). These proprietary rights may arise from a prior registration, prior trademark or service mark use, prior use as a trade name, prior use analogous to trademark or service mark use, or any other use sufficient to establish proprietary rights. *Id.*; see, e.g., *Nat'l Cable Television [Ass'n v. American Cinema Editors, Inc.]*, 937 F.2d 1572 at 1582 (canceling [registration of a] mark based on petitioner's prior use of trade name); *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 508-09, 175 USPQ 417, 422 (CCPA 1972) (permitting reliance on copyrighted appearance of stuffed rag doll in opposition and cancellation proceedings).

Before a prior use becomes an analogous use sufficient to create proprietary rights, the [opposer or] petitioner must show prior use sufficient to create an association in the minds of the purchasing public between the mark and the [opposer or] petitioner's goods [or services]. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 1065, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). A showing of analogous use does not require direct proof of an association in the public mind. *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996). Nevertheless, the activities claimed to create such an association must reasonably be expected to have a substantial impact on the purchasing public before a later user acquires proprietary rights in a mark. *Id.*

In essence, the approach often followed by tribunals in making such an assessment involves an evaluation of the totality of the circumstances in each case. See, e.g., *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 58 USPQ2d 1222, 1228 (9th Cir. 2001).

Applying such an approach, we find that opposer has not discharged its burden of proof and thus has failed to establish priority. As to actual or technical service mark use of the mark "TRANSCEND LOGISTICS," the record shows that the earliest that opposer *may* have rendered its freight transportation logistics services was sometime in the last two months of 2002. While such services, in particular, were rendered to a single customer, MTD, Inc., in the amount of \$15,000, it is unclear as to whether that figure represents a substantial amount of business in the logistics management field. However, even if it does, it is unclear whether opposer itself actually commenced rendering its freight transportation logistics services to MTD, Inc. beginning in November 2002 or a month later in December 2002. Tellingly, there are no invoices or any other documentation bearing the mark "TRANSCEND LOGISTICS" as it was allegedly used by opposer during such period. Moreover, it appears that a third party by the name of Decker, which is part of opposer's parent P.A.M., may have provided the \$15,000 of freight transportation logistics services to MTD, Inc. in the last month or two of 2002 instead of opposer.

Many of the same uncertainties and other deficiencies pertain to the evidence of opposer's sales of its services in 2003 and 2004. For instance, although opposer's sales to MTD,

Inc. in 2003 amounted to a total of \$60,000 for the entire year, there is no evidence that any such sales were for services rendered during January 2003 or even at any time during the first quarter of such year. There also is absolutely no documentary evidence of any kind showing the manner of use of the mark "TRANSCEND LOGISTICS" in connection with freight transportation logistics or any other services rendered by opposer in 2003. While opposer nonetheless appears to have commenced advertising under such mark in 2003 with respect to freight transportation logistics services, as well as in connection with supply chain management services,¹⁹ in the amount of \$5,015, its sole print advertising featuring the "TRANSCEND LOGISTICS" mark and/or the "TRANSCEND Logistics, Inc." logo consisted of just two ads appearing only in the January 2003 edition of Inbound Logistics magazine. There notably are no examples, however, of the manner in which opposer's "TRANSCEND Logistics, Inc." logo assertedly appeared on the Inbound Logistics website throughout the year in 2003 and there is no information as to the frequency with which the www.transcendlogistics.com website of opposer and its parent, which does show such logo displayed along with the "TRANSCEND LOGISTICS" mark, was visited.

Finally, while opposer, in 2004, added a second customer, O'Reilly Auto Parts, Inc., and retained MTD, Inc. as a

¹⁹ Although, as previously indicated, opposer has denied not spending any funds for advertising in 2002, no amount of any expenditures for advertising in such year is of record and the sole examples of its promotional efforts in 2002 are the slides featuring its "TRANSCEND Logistics, Inc." logo, which were not used in the rendering of its services but instead were utilized only in attempts to solicit business.

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customer, the volume of its business was just \$65,000 in the first quarter of 2004, in which it spent \$4,136 on advertising, and business volume was only \$40,000 for each of the following two quarters. Again, however, there is an absence of any invoices or other documentary evidence featuring the mark "TRANSCEND LOGISTICS" and only a single website ad, which appears under the banner "inbound logistics PLANNER 2004," displays the mark "TRANSCEND LOGISTICS" and the "TRANSCEND Logistics, Inc." logo. Such ad nonetheless states, *inter alia*, with respect to services available from opposer, that "Transcend Logistics is a full service logistics, supply chain, and transportation management resource offering a wide array of services to customers spanning multiple industries."

Considering the totality of the circumstances, it simply cannot be said on this record that opposer has sufficiently established that prior to either August 20, 2002 or January 2003, it was engaged in the bona fide use of a mark consisting of or prominently featuring the designation "TRANSCEND LOGISTICS" in the ordinary course of trade with respect to providing freight transportation logistics services and/or supply chain management services. Given the above-noted contradictions, inconsistencies and indefiniteness in the record as a whole, and in particular the scarcity of supporting documentary evidence, the record is insufficient to demonstrate that, technically, opposer was actually rendering a commercially significant level of freight transportation logistics services and/or supply chain

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management services under its "TRANSCEND LOGISTICS" mark and/or "TRANSCEND Logistics, Inc." logo on or prior to the earliest dates of use upon which applicant can rely herein with respect to its "TRANSCEND" marks.

Nonetheless, as previously pointed out, opposer may still prevail herein if the record establishes that it has priority based on use which is analogous to service mark use. However, as set forth in, for instance, T.A.B. Systems v. PacTel Teletrac, 37 USPQ2d at 1882, analogous use priority demands that opposer must have use that is "sufficiently clear, widespread and repetitive to create the required association in the minds of potential purchasers between the mark as an indicator of a particular source and the service to become available later." In order to constitute a significant impact on purchaser perception, such use "must involve more than an insubstantial number of potential customers." Id. at 1883; see also, Herbko Int'l Inc. v. Kappa Books Inc., 64 USPQ2d at 1378; and Lucent Information Management Inc. v. Lucent Technologies Inc., 45 USPQ2d at 1024.

In this case, however, opposer has offered insufficient proof that its efforts to publicize and attract business under the designation "TRANSCEND LOGISTICS" did in fact create the necessary prior association or public identification of such designation with opposer. Unlike, for instance, the situation in Dyneer Corp. v. Automotive Products plc, supra at 1255 (TTAB 1995), in which a party's promotional materials bearing the mark in issue, which were presented to upwards of a dozen prospective customers over a 16-month period during which actual meetings

with the potential buyers took place, were held sufficient to establish an initial identification of the subject mark "among a very substantial group of relevant manufacturers" inasmuch as such group consisted of most of the "immediately recognizable major manufacturing concerns in the United States that could have become purchasers ... or licensees," the totality of the circumstances herein are more closely analogous to those in *T.A.B. Systems v. PacTel Teletrac*, 37 USPQ2d at 1882-84.

Specifically, as pointed out therein by our principal reviewing court (*italics in original*):

[T]here [cannot] be any doubt that purchaser perception must involve more than an insubstantial number of potential customers. For example, if the potential market for a given service were 10,000 persons, then advertising shown to have reached only 20 or 30 people as a matter of law could not suffice. However close the linkage between the mark and the future service, analogous use could not be shown on such facts because the actual number of potential customers reached, not the strength of the linkage for some "reasonable potential customer," is the focal point of the analogous use inquiry. As noted above, ... what is required is "public exposure of a mark that would be expected to have any *significant impact* on the purchasing public."
....

This is *not* to say that a fixed percentage, like 20%, much less 51%, of the potential customers must have formed in their mind the required "prior public identification." As we noted above, it simply requires "more than a negligible portion of the relevant market." In other words, advertising of sufficient clarity and repetition to create the required identification must have reached a substantial portion of the public that might be expected to purchase the service. Thus, the [putative prior] user must prove that the "necessary association" was created among

more than an insubstantial number of potential customers. Otherwise, he cannot show "significant impact on the purchasing public."

It is true, for example, that seven fleet owners saw a slide show about PacTel's tracking service that included display of the mark. But, as we noted, in the absence of any proof by PacTel of the size of the market, it is simply impossible for us to conclude that seven customers was more than a negligible or insubstantial number. PacTel utterly failed to prove the size of the market. Moreover, since one of the competing and inconsistent marks it used during the same period, CORPORATE FLEET LOCATOR SERVICE, suggests that every corporation that has a fleet of cars falls within the relevant market, one can only assume that the market may include many thousands of companies. If, for example, PacTel had shown that its service was directed only to major car rental companies, then it might have established that the relevant market consisted of only a dozen or two potential customers, of which seven would clearly have been a substantial number. However, there was no such proof.

Id. at 1883. After further noting deficiencies due to, among other things, the absence of any evidence of PacTel's advertising efforts, including even the lack of "gross dollar figures on advertising expenditures" or "any indication of 'readership'" of any ads, id., the court concluded its discussion of the PacTel's failure of proof with respect to analogous service mark use by emphasizing that:

Whether adequate proof was in fact available but simply not gathered and proffered by PacTel is not a subject on which we can, should of do speculate. Rather, we must take the record as PacTel made it.

Id. at 1884.

Likewise, the evidence of opposer's assertion of prior analogous service mark use of the designation "TRANSCEND

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LOGISTICS" is insufficient to support a conclusion of public association or identification of such term with opposer on or before the August 20, 2002 and January 2003 dates of first use on which applicant is entitled to rely as to, respectively, its "TRANSCEND" and "TRANSCEND" and design marks. Priority is not established by using a mark in preliminary steps to launch a business, such as opposer's incorporation on April 24, 2002 and the acquisition by its president, on the preceding day, of three domain names, each of which featured "Transcendlogistics" as the distinguishing portion thereof. See, e.g., Maritec Industries Inc. v. Sterling Powerboats Inc., 75 USPQ2d 1145, 1148 (M.D. Fla. 2004). Prior to February 2003, opposer's only public use of the designation "TRANSCEND LOGISTICS" consisted of: (i) soliciting business through various presentations which were made by opposer's president, initially on behalf of himself and later on behalf of opposer, to just seven potential customers;²⁰ (ii) making an offer to purchase the assets of a single business, Daymark, Inc.; (iii) joining CLM, the professional association for logistics providers which is presently known as the Council of Supply Chain Management Professionals; and (iv) advertising on at least one or two of several websites and in the industry leading trade journal, Inbound Logistics magazine.

Collectively, such activities are insufficient to establish prior analogous service mark use since it simply cannot

²⁰ While the record indicates that opposer additionally made sales and marketing presentations under the "TRANSCEND LOGISTICS" designation to 14 firms in 2003, most of which had not previously been solicited, there is simply no proof that any of such presentations occurred during January 2003.

be reasonably inferred that a substantial public association or identification of the mark "TRANSCEND LOGISTICS" with opposer was created in the marketplace for freight transportation logistics and/or supply chain management services. Clearly, as in *PacTel*, making presentations to at most only seven prospective clients for opposer's "TRANSCEND LOGISTICS" services constitutes an insubstantial number of potential customers. The fact that such presentations were corroborated, in the case of three of those customers, is inconsequential inasmuch as it is the actual number of prospective customers reached which matters for purposes of establishing analogous service mark use priority. A mere seven prospective customers, at most, plainly are a negligible portion of the relevant market and, thus, opposer's efforts to solicit their business cannot be expected to have had any significant impact on the purchasing public as a whole.

Moreover, because there is no proof by opposer as to the size of the market for services of the kinds involved herein, it is simply impossible to conclude, as was also the case in *PacTel*, that seven potential customers is more than a negligible or insubstantial number. Nonetheless, judging from the fact that two of opposer's prospective customers in 2002, namely PPG, Inc. and Proctor & Gamble, are immediately recognizable as major (if not Fortune 500) corporations, it may be assumed that the market for opposer's services spans a wide range of firms, including virtually all medium to large size manufacturers and producers. Coupled with the fact that a page from the January 2003 edition

of the print version of Inbound Logistics magazine lists the names of 47 advertisers in addition to opposer and states that such magazine is published 12 times a year for 55,050 people who buy, specify, or recommend logistics, logistics technology, transportation and related services, a fair inference therefrom is that the market for opposer's services is considerably larger, at a minimum, than one of which the mere handful of firms to which opposer personally directed its solicitations for business would be representative.

Furthermore, it is obvious that opposer's offer to purchase the assets of Daymark, Inc. involved the exposure of only that single firm to the "TRANSCEND LOGISTICS" designation, and it is not even known whether such firm was part of the market for services of the kinds involved herein. As to the impact on others in the marketplace for opposer's services from its having registered with a professional association for logistics providers, suffice it to say that no effect on the relevant public is apparent or otherwise discernable from such action.

On the other hand, while opposer's advertising on at least one or two of several websites and in both the web-based and print versions of Inbound Logistics magazine may have had some impact on the market, it is not possible to know whether such advertising was of sufficient clarity and repetition to create or meaningfully assist in the creation of the required identification of the designation "TRANSCEND with opposer's services among a substantial portion of the public that might be expected to purchase those services. There are no examples of

opposer's use of such designation on its or its parent P.A.M.'s websites on or before January 2003, nor is there any indication as to the frequency with which those in the industry visit such websites. No advertising figures have been furnished for 2002 and, of the \$5,015 spent on advertising in 2003, there is no indication as to what portion thereof was expended in January 2003. Instead, the sole evidence of opposer's advertising in January 2003 consists of two advertisements for opposer which ran in the January 2003 issue of Inbound Logistics magazine. Both of such ads featured its "TRANSCEND Logistics, Inc." logo, which also appeared on the website for such magazine for the entire year (although no example thereof was furnished),²¹ and one of the ads also included the "TRANSCEND LOGISTICS" mark. However, even assuming a readership of just over 55,000 persons in the market (as indicated by the "PLANNER INDEX & RFP" page from the print version of the January 2003 issue of Inbound Logistics), such evidence is insufficient to establish that the necessary association or public identification was indeed created among more than an insubstantial number of potential customers, given, for instance, the absence of any indication as to the response, if any, received to such ads and the nominal business done by opposer as of the end of January 2003. See, e.g., *Chance v. Pac-Tel Teletrac Inc.*, supra ["mailing of ... 35,000 post cards,

²¹ Even assuming a cumulative impact of some measure from the yearlong exposure provided thereby, any such public recognition or association of the logo and/or designation "TRANSCEND LOGISTICS" with opposer which was created does not relate back to January 2003 for priority purposes. See *Herbko Int'l Inc. v. Kappa Books Inc.*, 64 USPQ2d at 1379.

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which generated 128 responses to ... 800 number and no sales, cannot be considered a first use under the law" for purposes of analogous service mark use priority]. Opposer, therefore, has failed to show analogous use of the designation "TRANSCEND LOGISTICS" which is sufficiently clear, widespread and repetitive so as to have created the requisite association in the minds of potential customers between such designation as an indicator of a particular source and its services.

It is settled that opposer, as the plaintiff in this proceeding, bears the burden of proof with respect to its claim of priority of use and likelihood of confusion. See, e.g., Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) ["[t]he burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion"]; Hoover Co. v. Royal Appliance Mfg. Co., 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) ["[i]n opposition proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark"]; Champagne Louis Roederer S.A. v. Delicato Vineyards, 143 F.3d 1373, 47 USPQ2d 1459, 1464 (Fed. Cir. 1998) (Michel, J. concurring); Sanyo Watch Co., Inc. v. Sanyo Electric Co., Ltd., 691 F.2d 1019, 215 USPQ 833, 834 (Fed. Cir. 1982) ["[a]s the opposer in this proceeding, appellant bears the burden of proof which encompasses not only the ultimate burden of persuasion, but also the obligation of going forward with sufficient proof of the material allegations of the Notice of Opposition, which, if not

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countered, negates appellee's right to a registration"]; and Clinton Detergent Co. v. Proctor & Gamble Co., 302 F.2d 745, 133 USPQ 520, 522 (CCPA 1962) ["[o]pposer ... has the burden of proof to establish that applicant does not have the right to register its mark."]. In view thereof, and inasmuch as the evidence of record is insufficient to establish that, on or prior to the August 20, 2002 and January 2003 dates upon which applicant can respectively rely herein as to its "TRANSCEND" and "TRANSCEND" and design marks, opposer either was actually rendering a commercially significant level of freight transportation logistics services and/or supply chain management services under its "TRANSCEND LOGISTICS" mark and/or "TRANSCEND Logistics, Inc." logo or that opposer had made analogous service mark use of the "TRANSCEND LOGISTICS" designation which was sufficient to expect that such would have had a significant impact on the purchasing public for its services, it is adjudged that opposer has not satisfied its burden of proof and that the opposition must fail.

Decision: The opposition is dismissed.