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OF THE TTAB

Hearing:
February 3, 2005

Mailed: April 19, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

United States Conference of Catholic Bishops

v.

Media Research Center

Cancellation No. 92032746

G. Franklin Rothwell and Anne M. Sterba of Rothwell, Figg,
Ernst & Manbeck for United States Conference of Catholic
Bishops.

Christopher T. Craig of Herge, Sparks & Christopher for
Media Research Center.

Before Chapman, Grendel¹ and Rogers, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

United States Conference of Catholic Bishops (a
District of Columbia not-for-profit corporation) has filed a
petition to cancel a registration issued on the Principal
Register to Media Research Center (a Virginia not-for-profit

¹ Formerly known as Bottorff.

corporation) for the mark shown below



("cybercast news service" disclaimed) for "computer services, namely, providing information on-line, concerning news, special interest and opinions" in International Class 42.²

Petitioner asserts as grounds for cancellation that since June 1989 it has continuously used the marks "CNS and CNS NEWS as an acronym for Catholic News Service for providing information online concerning news, special interests and opinions" (paragraph 1); that petitioner has invested considerable sums in advertising and promoting its marks, and the public has come to recognize CNS and CNS NEWS as being identified with petitioner;³ that respondent was

² Registration No. 2528246 issued January 8, 2002, from an application filed October 14, 1999, based on applicant's assertion of a bona fide intention to use the mark. The claimed date of first use and first use in commerce is June 15, 2000. The registration includes the following statement: "The stippling and lining shown in the drawing is a feature of the mark not intended to indicate color."

³ Petitioner argued in its briefs after trial only as to its mark CNS. Petitioner made no argument that it uses the pleaded mark CNS NEWS. See, e.g., petitioner's brief, pp. 5, 8, 13; and petitioner's reply brief, pp. 1, 8, 10, 15. In fact, in answer to respondent's interrogatory No. 24 regarding petitioner's use of the mark CNS NEWS, petitioner stated " ... Petitioner states that it does not use the term CNS NEWS in connection with its goods and services." (Exhibit A, Item No. 4.) Accordingly, no further consideration will be given to petitioner's pleaded claim of common law rights in the mark CNS NEWS.

formerly known as "Conservative News Service"; that petitioner has corresponded several times with respondent requesting that respondent abandon its (then) application and providing respondent with "numerous examples of actual confusion" (paragraph 6); and that respondent's mark, when used in connection with its services, so resembles petitioner's previously used mark, as to be likely to cause confusion, mistake, or deception.

In its answer respondent admits that petitioner "has communicated with [respondent]," and otherwise denies the salient allegations of the petition to cancel. Respondent also raises the affirmative defenses of "laches, acquiescence, waiver, and equitable estoppel" (paragraph 1).⁴ Respondent specifically alleges that petitioner has been aware of respondent's application since not later than December 26, 2000 (the date of publication) and petitioner may have been aware of respondent's mark "for two to three years prior to March 7, 2001" (paragraph 3); that petitioner has delayed taking action and respondent built up a good will in its mark during the time petitioner failed to act; and that petitioner's "silence and inaction" resulted in prejudice to respondent (paragraph 3).

⁴ Respondent's later-added affirmative defenses of genericness and mere descriptiveness will be fully discussed later herein.

The Record

The record consists of the pleadings; the file of respondent's registration; and the evidence stipulated into the record through the parties' "Joint Stipulation" filed July 8, 2004. The evidence in this joint stipulation consists essentially of the evidence submitted by both parties in support of and in opposition to their motions for summary judgment. (Both motions for summary judgment were denied by Board order dated January 22, 2004.) "Exhibit B" in the parties' joint stipulation is the evidence on behalf of petitioner listing 65 items (including two declarations of Mark Lombard, petitioner's Senior Business Officer/Chief Financial Officer; the declaration of Patricia Zapor, a reporter for petitioner; and two declarations, with exhibits, of Anne Sterba, one of petitioner's attorneys).⁵ "Exhibit A" in the parties' joint stipulation is the evidence on behalf of respondent listing 19 items (including items such as printouts from web pages, petitioner's responses to respondent's interrogatories and requests for admission, and respondent's answers and supplemental answers to petitioner's interrogatories).

⁵ A portion of Exhibit B to the "Joint Stipulation" was submitted under seal as confidential. However, both parties included in their briefs after trial references to information originally submitted under seal. Thus, the confidentiality of those matters is waived. The Board will nonetheless utilize discretion in discussing such matters.

We first decide the parties' respective objections to the stipulated evidence. In petitioner's brief on the case, it argues that respondent provided no declarations to support its evidence and therefore "any reference made by [respondent] to its evidence should be stricken as improper." (Brief, p. 4.) Petitioner cited to no authority in support its position, and the Board is aware of none. Inasmuch as there is no requirement that evidence stipulated into the record by parties be supported by declarations, petitioner's request that any reference to respondent's evidence (the materials comprising Exhibit A) be stricken is denied.

Respondent included as an appendix to its brief after trial a copy of Exhibit B and specified objections to 11 of the 65 items comprising the exhibit. Respondent's objections relate to various documents (but not the declarations used to introduce them) and the objections are generally based on the grounds of relevance and/or hearsay. The Board has carefully considered each objection and overrules respondent's objections. Of course, all evidence of record is considered only for whatever appropriate probative value it may have.⁶

⁶ For completeness of the record, the Board hereby grants any consented motions to extend dates not previously formally approved or granted by the Board in this case.

Both parties filed briefs on the case after trial, and both were represented at an oral hearing held before this Board on February 3, 2005.

The Parties

Petitioner, United States Conference of Catholic Bishops, owns Catholic News Service, which operates as a "financially self-sustaining division." Catholic News Service is "a news agency specializing in reporting religion, [and] is the primary source of national and world news that appears in the U.S. Catholic press." Catholic News Service describes its mission as follows: "The mission of Catholic News Service is the mission of the Church itself -- to spread the Gospel through contemporary means of communication. Our mission is to perform this task by reporting the news which affects Catholics in their everyday lives." It provides news reports, photo/graphics, movie and television reviews, and the like. (Exhibit A, Item 3--pages from petitioner's website.)⁷

⁷ Mark Lombard, senior business officer/chief financial officer of petitioner's Catholic News Service, averred that it "provides an on-line news service, photo service, cartoons, and other features which are of *general interest* and of interest to Catholics." (Emphasis added.) (First Lombard declaration, paragraph 8.) However, the record does not show that the news service offers news of general interest, but instead, the record shows that it offers news which is of interest to Catholics and/or is from a Catholic perspective. The documents cited in Mr. Lombard's declaration in support of his statement generally consist of invoices, which do not establish a broader focus of petitioner's news service. (Hereinafter, references to "petitioner" include both the conference and its division, the news service.)

Cancellation No. 92032746

Petitioner has applied to register the mark CNS for "printed materials, namely, newsletters, periodicals and brochures, containing information about current affairs, including news, features and photographs, from a Catholic perspective" in International Class 16; and "providing news, features and photographs of current events from a Catholic perspective via the global computer network" in International Class 42. The Examining Attorney reviewing petitioner's application has refused registration thereof under Section 2(d) of the Trademark Act based on respondent's registration, and suspended action on petitioner's application pending resolution of this proceeding. (Exhibit A, Item 49--copy of the file of application Serial No. 76219234, filed March 2, 2001.)

Petitioner's first use of the mark CNS for its involved services began in June 1989 and has been continuous since then. (First Lombard declaration, paragraph 7.) According to Mark Lombard, "[Petitioner's] mark CNS can be considered an abbreviated form of the phrase Catholic News Service." (First Lombard declaration, paragraph 5.)

Petitioner's subscribers and purchasers include AOL, CNN, ABC News, Time Magazine, WNET-TV and Vatican Radio. (Catholic News Service advertises in trade association publications but not in other types of publications due to contractual obligations to its client publications.) Non-

paying users of petitioner's services include "Petitioner's Third World Grant Program" and anyone who visits petitioner's website. (Exhibit A, Item 2, question 8.) Petitioner received 1.5 million hits per month on its news service website during the first eight months of 2002. (First Lombard declaration, paragraph 14.)

Petitioner has a graduated billing scale based on ability to pay, and in 1999 petitioner charged between about \$180 - \$280 per month for the right to publish petitioner's CNS Daily News Report; about \$140 - \$170 per month for CNS Digital Photo Service; and about \$75 per month to access petitioner's secure website. (Exhibit A, Item 7.) Petitioner has had over 200 publishing clients each year since 1999. Petitioner's total revenue from subscriber and user fees for October 1999 to July 2002 under the mark CNS totaled just over \$11,000,000. (First Lombard declaration, paragraphs 18 and 20.)

Mr. Lombard and Ms. Zapor discussed various instances of asserted confusion regarding petitioner and respondent.

Media Research Center, respondent, has a news division which is CNSNews.com-Cybercast News Service. Respondent's news service division is a "secular news service providing coverage of a wide variety of general breaking news, political news and international news." (Exhibit A, Items 12 and 15, question 21.) Respondent's first use of its

registered mark (as shown previously herein) was on June 26, 2000. (Exhibit A, Item 13, questions 2 and 20.)

Respondent explains that it "has never been known as 'Conservative News Service.'" ... "'Conservative News Service' was a project of [respondent's] which has since been renamed CNSNews.com—Cybercast News Service." (Exhibit A, Item 15, question 21.)

The "majority of [respondent's] sales revenues to date are the result of subscription sales to the Cybercast system of streaming news text to client Internet sites." Non-client users of respondent's services "include a wide variety of media entities and private individuals [e.g., The New York Times, The Wall Street Journal, The Washington Post, The Washington Times, The Baptist Press, The Village Voice, Investors Business Daily, The Salt Lake Tribune, The USA Radio Network, Rush Limbaugh, Dr. Laura Schlessinger, Sean Hannity] who have on one or more occasions accessed [respondent's] services in creating their own product." (Exhibit A, Item 15, question 21.)

In 2001, the annual subscription fee for respondent's services (including six news categories and a "host of political cartoonists") ranged from \$360 to \$11,750, with discounts offered to not-for-profit groups. (Exhibit A, Item 16.)

Respondent's total sales of goods and services for the year 2002 were submitted as confidential and cannot be stated with specificity here. (Exhibit A, Items 12, 13 and 15, question 18.) With regard to advertising and promotional expenses, respondent takes the position that "every news article published by MRC, ... is, in part an advertisement and/or promotion of the news agency, its products and services." Respondent's expenditures since its inception were designated as confidential, but are in the millions of dollars. (Exhibit A, Item 13, question 19.)

Respondent has not received any mail or any inquiries regarding confusion as to the source of respondent's services, and the only documents of which respondent is aware even relating thereto are those sent by petitioner's attorney to respondent's attorney as asserted examples of actual confusion. (Exhibit A, Item 15, question 16.)

Burden of Proof

In Board proceedings regarding the registrability of marks, our primary reviewing Court has held that the plaintiff must establish its pleaded case (e.g., likelihood of confusion, descriptiveness), as well as its standing, and must generally do so by a preponderance of the evidence. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir.

1993); Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Thus, petitioner bears the burden of proving by a preponderance of the evidence its standing, and its claim of priority and likelihood of confusion. Respondent bears the burden of proving its affirmative defenses under the same standard--preponderance of the evidence.⁸

Standing

Standing requires only that a party seeking cancellation of a registration have a good faith belief that it is likely to be damaged by the registration. See Section 14 of the Trademark Act, 15 U.S.C. §1064. See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §20:46 (4th ed. 2001). The belief in damage can be shown by establishing a direct commercial interest.

Petitioner's application for the mark CNS for various printed materials in International Class 16 and an online news service in International Class 42 has been refused registration on the basis of respondent's involved registration. Thus, petitioner has standing to bring this

⁸ If petitioner's unregistered mark is found by the Board to be merely descriptive of petitioner's involved services, then petitioner must prove acquired distinctiveness of its mark. See *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 and 1008 (Fed. Cir. 1988).

petition to cancel. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Linville v. Rivard*, 41 USPQ2d 1731, 1734 (TTAB 1996), aff'd at 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); and *Rail-Trak Construction Co., Inc. v. Railtrack, Inc.*, 218 USPQ 567, 571 (TTAB 1983).

Moreover, in the case now before us we find that petitioner's use of the mark CNS for an online news service providing news, features, photos, cartoons, etc. of interest to Catholics and/or from a Catholic perspective establishes petitioner's direct commercial interest and its standing to petition to cancel. See *Cunningham v. Laser Golf Corp.*, supra.⁹

Priority

A party asserting a claim under Section 2(d) of the Trademark Act must establish prior use of a trademark or service mark, or trade name or other indication of origin. As stated by the Court of Appeals for the Federal Circuit in the case of *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990):

Under the rule of *Otto Roth* [*Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA

⁹ Respondent argues that because 'CNS' is generic or descriptive without acquired distinctiveness, petitioner lacks standing to bring this petition to cancel. (Brief, p. 6.) The merits of petitioner's assertion of common law rights in a service mark will be addressed later herein. In any event, however, petitioner has established its standing to file this petition to cancel.

1981)], a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently, or through the acquisition of secondary meaning or through "whatever other type of use may have developed a trade identity." *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43.

That is, petitioner must establish that its unregistered service mark is entitled to service mark status, either inherently or through acquired distinctiveness.

Respondent argues that CNS is generic or, at least, merely (and highly) descriptive, and that petitioner has not shown that its asserted mark CNS has acquired distinctiveness.

In this regard, we consider the pleadings. Respondent did not plead as affirmative defenses that petitioner's mark is generic and/or merely descriptive of its involved services. Nonetheless, respondent argues that it "raised genericness as a defense" to the petition to cancel.

(Respondent's brief, p. 16.) While this issue was not pleaded by respondent, it was raised in respondent's motion for summary judgment (filed in January 2003); and petitioner, in its response thereto (filed in April 2003), fully addressed this defense on the merits and cross-moved for summary judgment in its favor thereon as well as on its pleaded ground of likelihood of confusion. Thus, the parties "tried" the additional affirmative defenses of genericness and descriptiveness, insofar as genericness has

been said to be the ultimate case of descriptiveness, because the evidence submitted at the summary judgment stage of this case is essentially the evidence submitted under the parties' joint stipulation as the evidence for trial.

Respondent's answer is now considered amended to conform to the evidence under Fed. R. Civ. P. 15(b) to include the affirmative defenses of genericness and mere descriptiveness without acquired distinctiveness.

Petitioner contends that respondent has not proven that petitioner's mark CNS is either generic or merely descriptive of petitioner's online news services featuring stories, cartoons etc. of interest to Catholics. Petitioner further contends that the evidence shows CNS is neither generic nor merely descriptive, but if the Board finds CNS to be merely descriptive the mark has acquired distinctiveness.

The second matter we clarify is that of the burden of proof on these two affirmative defenses--genericness and mere descriptiveness. Respondent argues that petitioner "'bears the burden of proving nongenericness.'" *Yellow Cab Co. of Sacramento v. Yellow Cab of Elk Grove*, 266 F.Supp.2d 1199, 1203 (E.D. Cal. 2003)." We disagree with respondent's argument which is based on a citation to a trademark infringement civil action. There is no question that a plaintiff asserting rights in an unregistered mark in a

registrability question before the Board must show that its mark is either inherently distinctive or has acquired distinctiveness. See *Towers v. Advent*, supra. However, there is no requirement in a Board case that as an element of the plaintiff's proof it must show that its mark is not generic. Rather, if a defendant is asserting that the plaintiff's unregistered mark is generic and/or merely descriptive without acquired distinctiveness, it must so plead (putting both the plaintiff and the Board on notice as to the defendant's position), and later prove those defenses. (Of course, as explained previously, acquired distinctiveness must be proven by the party asserting that its mark has acquired distinctiveness).

Here petitioner's mark is the letters CNS, which petitioner has acknowledged stand for the words "Catholic News Service." Moreover, respondent referred in its brief (pp. 12-13) to dictionary definitions of the words "Catholic," "news," and "service."¹⁰ Both parties referred to petitioner's Registration No. 2630640 issued under Section 2(f) of the Trademark Act on October 8, 2002 for the mark CATHOLIC NEWS SERVICE ("news service" disclaimed) for "printed materials, namely, newsletters, periodicals and

¹⁰ The Board hereby takes judicial notice of said dictionary definitions. See *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). See also, TBMP §704.12 (2d ed. rev. 2004).

brochures, containing information about current affairs including news, features and photographs, from a Catholic perspective" in International Class 16 and "distribution of news, features and photographs of current events from a Catholic perspective, via a global computer information network, postal service and print publications" in International Class 42. (Exhibit B, Items 7 and 8.)

Respondent contends that petitioner's asserted mark, CNS, is a generic, or at least a highly descriptive, acronym for the generic words "Catholic News Service"; and that petitioner's asserted mark has not acquired distinctiveness.

Petitioner's position is that its mark is inherently distinctive, or in the alternative, if it is found to be merely descriptive, that its mark has acquired distinctiveness.

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered to refer to the genus or category of goods or services in question. See *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999); and *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986).

Having carefully reviewed the record in this case, it cannot be said that there is a preponderance of evidence

showing that relevant consumers perceive the letters CNS as generic for an online news service covering matter of interest to or from the perspective of Catholics. That is, the evidence before us does not show that CNS is generic for petitioner's services.

We consider next whether petitioner's mark, CNS, is merely descriptive of petitioner's services. Because this is a letter mark, we start with the guidance of the predecessor of our primary reviewing Court in *Modern Optics, Incorporated v. The Univis Lens Company*, 234 F.2d 504, 110 USPQ 293, 295 (CCPA 1956):

While each case must be decided on the basis of the particular facts involved, it would seem that, as a general rule, initials cannot be considered descriptive unless they have become so generally understood as representing descriptive words as to be accepted as substantially synonymous therewith.

See also, *Racine Industries Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832 (TTAB 1994); and *Avtex Fibers Inc. v. Gentex Corporation*, 223 USPQ 625 (TTAB 1984). The reasoning of the Modern Optics case has received favorable treatment by other Courts of Appeals. See *G. Heileman Brewing Co. v. Anheuser-Busch Inc.*, 873 F.2d 985, 10 USPQ2d 1801, 1808 (7th Cir. 1989); and *Anheuser-Busch Inc. v. Stroh Brewery Co.*, 750 F.2d 631, 224 USPQ 657, 659 (8th Cir. 1984). Of course, the Board is bound to follow the rule of Modern Optics

regardless of its favorable reception by other Courts of Appeals.

Thus, if some operation of imagination is required to connect the initials to the services, the initials cannot be equated with the descriptive phrase, and the letters are then suggestive in nature, and are protectable.

The record before us does not establish that the letters CNS would be recognized by relevant consumers as "substantially synonymous" with the phrase "CATHOLIC NEWS SERVICE." Even if relevant consumers recognized the letters "NS" as news service in the context of a news service, the letter "C" could stand for any number of words. For example, Exhibit B, Item 28 (printouts of web pages from the "Charisma News Service") and Item 57 (the search report from a private company of its search of "CNS" for "computerized news services providing online access to news") shows that other entities have used or registered marks consisting of or including the letters CNS for related goods and services. (CNS CHARISMA NEWS SERVICE ONLINE for a Christian news service;¹¹ Registration No. 1210917 issued on September 28, 1982 to Commodity News Services, Inc. for the mark CNS for "news wire and video news wire services featuring commodity

¹¹ The record includes information that this entity has apparently ceased use of the letters CNS per petitioner's request. (Exhibit B, Item 28.)

quotations and related information messages, and data by means of a communications network.")

Respondent has not established by a preponderance of evidence that "CNS" is generic or merely descriptive of petitioner's involved services. To whatever extent respondent's evidence might show that the words CATHOLIC NEWS SERVICE, considered separately or together, are generic or merely descriptive, we note that those words are not the mark upon which petitioner is relying in this case. We find that petitioner's mark CNS is inherently distinctive and protectable.

We find that petitioner has established trade identity rights which the law will recognize in its common law mark CNS, and has established use of that mark since June 1989 for its daily news report, photo service, cartoon service, movie reviews, etc. services of interest to Catholics and/or from a Catholic perspective, and since 1995 for the digital photo service. Respondent's registration issued from an application filed October 14, 1999 and respondent's established first use is June 15, 2000.¹²

In sum, we find that petitioner's mark is inherently distinctive (or if upon appellate review it is necessary, petitioner has established acquired distinctiveness), and

¹² If petitioner's mark CNS is ultimately found to be merely descriptive, we find that petitioner has established that its

that petitioner has established continuous use of its mark since 1989, which is well prior to respondent's filing date in October 1999 and respondent's proven first use in June 2000. Therefore, with regard to the issue of priority and petitioner's claim of common law rights in the mark CNS for an online news service featuring news, cartoons, photos, etc. of interest to Catholics and/or from a Catholic perspective, petitioner has established its priority.

Respondent's Remaining Affirmative Defenses

At this juncture, we will address respondent's remaining affirmative defenses. Respondent originally pleaded the affirmative defenses of laches, acquiescence, waiver, and equitable estoppel. In its brief on the case, respondent's "Statement of the Issues" (pp. 6-7) refers only to the genericness/descriptiveness of petitioner's mark and likelihood of confusion, with no reference to laches, acquiescence, waiver, and/or equitable estoppel. However, later in its brief (pp. 40-41), in the discussion of the du Pont factor relating to the interface between respondent and petitioner, respondent referred to the possibility of respondent being "entitled to judgment under a theory of laches or estoppel," with an even more passing reference to the word "acquiescence."

mark CNS has acquired distinctiveness under Section 2(f) of the Trademark Act prior to respondent's first use of its mark.

Respondent has waived its affirmative defenses of acquiescence and waiver as it did not pursue them at trial or in its brief.

With regard to laches and estoppel (two separate and different defenses), respondent essentially asserts that petitioner had actual knowledge of respondent's mark in "early 2000," contacted respondent through a cease and desist letter dated March 7, 2001, and filed the petition to cancel on "April 18, 2002" only after "both parties invested heavily in their marks for several years."

In contradiction to this argument, the record shows that the mark petitioner became aware of in early 2000 was respondent's use of CONSERVATIVE NEWS SERVICE (Exhibit A, Item 2, question 18); that respondent's mark involved in this cancellation proceeding, CNSNEWS.COM CYBERCAST NEWS SERVICE and design, was published for opposition on December 26, 2000; that petitioner sent a cease and desist letter to respondent on March 7, 2001 (referencing respondent's use of CNS as an acronym for Conservative News Service); that in response to a phone message from respondent, petitioner then sent another cease and desist letter on April 24, 2001 (referencing respondent's website address and application/registration; that again after a phone message from respondent, petitioner sent a follow-up letter dated June 13, 2001; that petitioner sent a further letter dated

July 18, 2001; that there was further correspondence between the parties dated July 18, 2001 (from respondent), August 9, 2001 and September 30, 2001;¹³ and that petitioner filed its petition to cancel on January 30, 2002.

It is an understatement to say that respondent has not established either laches or estoppel in this case. To the contrary, it is clear that petitioner made its concerns known to respondent throughout 2001 and filed the petition to cancel in January 2002, the same month that respondent's registration issued. Thus, respondent's remaining affirmative defenses must fail.

Likelihood of Confusion

We now turn to our determination of likelihood of confusion, which must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. See *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). Based on the record before us in this case, we find that confusion is not likely.

¹³ See Exhibit B, Items 62, 64 and 65. Copies of the last three referenced correspondence letters were not submitted by petitioner "due to the talks of settlement." (Petitioner's reply brief, p. 6, footnote 2.) Reference was made to these last three letters in the second Sterba declaration. (Exhibit B, Item 62, paragraph 6.)

Turning first to a consideration of the parties' respective services, petitioner is restricted to the services for which it has proven use of its mark, because it is relying on common law rights in its mark CNS. Petitioner has established that it offers an online news service which features stories of interest to and/or is presented from a Catholic perspective. Respondent's services, as identified in its registration, are "computer services, namely, providing information on-line, concerning news, special interest and opinions." Thus, while petitioner is restricted to the specific services for which it has established use of its mark (an online news service featuring stories of interest to Catholics and/or presented from a Catholic perspective), respondent's identification of services is not restricted and could include features and stories of interest to Catholics.

We find that respondent's identified services encompass those more limited or specific services of petitioner. Thus, this factor weighs in petitioner's favor.

The trade channels through which both parties' services are offered include the Internet. Thus, the involved services are offered through at least one of the same trade channels. See *On-line Careline Inc. v. American Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000). This factor favors petitioner.

Turning to a consideration of the marks, petitioner argues, *inter alia*, that the dominant feature of respondent's mark is the letters CNS as this is the first portion of the mark and the letters appear in larger type than the disclaimed words "CYBERCAST NEWS SERVICE."

Respondent, on the other hand, argues that the marks must be considered in their entireties; that the only matter the marks share is the letters CNS; that respondent uses the letters in the same font size as the words NEWS.COM and the mark includes the phrase "CYBERCAST NEWS SERVICE" as well as a very noticeable design and stippling, which cannot be ignored as only background; and that petitioner's letter mark CNS is not at all similar to the combination of letters, words and design features used together to form respondent's registered mark.

In *In re Electrolyte Laboratories Inc.*, 913 F.2d 930, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990), another case involving composite marks featuring letters, the Court of Appeals for the Federal Circuit made the following statement:

There is no general rule as to whether letters or design will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue. No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone. ...

...[T]he spoken or vocalizable element of a design mark, taken without the design, need not of itself serve to distinguish the goods. The nature of stylized letter marks is that they partake of both visual and oral indicia, and both must be weighed in the context in which they occur.

...[E]ven if the letter portion of a design mark could be vocalized, that was not dispositive of whether there would be likelihood of confusion. A design is viewed, not spoken, and a stylized letter design can not be treated simply as a word mark.

As stated by McCarthy at 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:33 (4th ed. 2001):

For similar design or letter marks, similarity of appearance is usually controlling, for such marks are incapable of being pronounced or of conveying any inherent meaning, as do word marks. For such marks, the lettering style may be sufficient to prevent a likelihood of confusion.
(Footnote omitted)

Moreover, it is well settled that marks must be considered in their entirety, not dissected or split into component parts and each part compared with other parts. This is so because it is the entire mark which is perceived by the purchasing public, and therefore, it is the entire mark that must be compared to any other mark. It is the impression created by the involved marks, each considered as a whole, that is important. See *Kangol Ltd. v. KangaROOS U.S.A. Inc.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992); and *Franklin Mint Corporation v. Master Manufacturing*

Company, 667 F.2d 1005, 212 USPQ 233 (CCPA 1981). See also, 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §23:41 (4th ed. 2001).

In this case, respondent's mark consists of "CNSNEWS.COM" and the words "CYBERCAST NEWS SERVICE" (in smaller font), all in a rectangle with multiple horizontal lines and stippling. Thus, respondent's mark combines letters and words (in differing size fonts) with design features, whereas petitioner's common law mark consists of only the letters CNS in standard character (typed) font. The rectangle design including horizontal lines is a very noticeable visual feature of respondent's mark.

As to the connotations of the parties' marks, respondent's mark clearly has the connotation of "CYBERCAST NEWS SERVICE" and in fact, those words appear as part of respondent's mark. As explained previously herein, the record before us does not prove that petitioner's mark, CNS, is generic or even merely descriptive of online news services. Nonetheless, and not in the context of the letters per se, but on the likely perception by consumers of the letters given petitioner's specific service relating to Catholic perspective, we find that consumers may perceive petitioner's mark as connoting or relating to "Catholic News Service." This is particularly true as the evidence shows that petitioner sometimes uses "CNS CATHOLIC NEWS SERVICE"

and a design. Exhibit B, Item 49 (includes petitioner's specimens submitted with its application), and Items 29-40 (examples of petitioner's invoices).

Considering the marks in their entireties, we find that respondent's mark when considered in relation to petitioner's common law mark CNS, differs substantially in appearance, sound, connotation and commercial impression. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992). It is this du Pont factor which is a pivotal factor in this case. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 148 F.3d 1373, 47 USPQ2d 1459 (Fed. Cir. 1998); and *Kellogg Co. v. Pack'em Enterprises Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). That is, even considering the various du Pont factors which favor petitioner, as discussed elsewhere in this opinion, this factor of the dissimilarities of the marks so outweighs the other factors that respondent must prevail on the issue of likelihood of confusion.

Another du Pont factor we consider in this case is the fame of petitioner's mark. Petitioner contends that its mark "has achieved notoriety" and the evidence "supports a finding that CNS has achieved a degree of recognition (apparent notoriety) and success among the consuming public" (brief, pp. 13-14); and later in its reply brief (p. 10), petitioner contends that the evidence "establish[es] the

fame of the mark." The strongest evidence before the Board of the "fame" of petitioner's common law mark CNS is found in the first declaration of Mark Lombard, wherein he avers that the mark has been in continuous use since June 1989; that petitioner's promotional expenses for the CNS mark from October 1999 - July 2002 totaled \$275,851; that petitioner's revenues from subscriber and user fees for its CNS mark from October 1999 - July 2002 totaled \$11,028,994; that petitioner has had over 200 publishing clients in the United States from 1999 through 2002; that petitioner's website had approximately 1.5 million hits per month in the first eight months of 2002; that petitioner's CNS service typically produces 25-30 news stories a day; and that petitioner serves clients in over 50 countries and has correspondents all over the world.

However, as respondent contends, the evidence shows that petitioner's mark CNS is frequently used with another of petitioner's marks, "CATHOLIC NEWS SERVICE" (Exhibit B, Items 29-40, 45 and 49); and that petitioner acknowledges that it "advertises in trade association publications but not in other types of publications due to contractual obligations to its current client publications." (First Lombard declaration, paragraph 12.) Thus, the record is vague and ambiguous about whether the consumers/users recognize the letters CNS per se as identifying petitioner

as the source of these services, or if instead the consumers/users recognize petitioner's use of CNS in the context of petitioner's "CATHOLIC NEWS SERVICE."

We find that "fame" has not been proven. Petitioner's CNS mark may be strong within its purchaser group, but it has not been established that the mark is well known or famous to the user or reader group of consumers. Petitioner does not advertise to readers/users due to its contractual obligation in relation to subscribers/purchasers. There is no particular context of the size of the market for petitioner's services or petitioner's relative market share thereof. Mere length of use is not sufficient to establish consumer awareness of the mark, such that the mark can be found to be famous. See *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1277 (TTAB 1992). The limited evidence we have regarding petitioner's use of its mark CNS is not sufficient to establish public recognition and renown of petitioner's mark, as that du Pont factor has been interpreted. See *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1795-1796 (TTAB 2002); and *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1170 (TTAB 2001). Cf. *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000); and *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). Simply put, we cannot find on the evidence in this

record that petitioner's CNS mark is "famous" to the relevant purchasers/users. However, the evidence does establish that petitioner's mark is well known. To some extent, this factor favors petitioner, but "fame is relative, not absolute" (Sports Authority v. PC Authority, 63 USPQ2d at 1796); and petitioner's mark is certainly not on a par with the marks in Kenner, supra, and Recot, supra.

With regard to the purchasers and the conditions of sale, it is clear that there are two distinct classes of consumers, each with its own method of accessing petitioner's services -- first there are the purchasers of the news services (such as AOL, CNN, Time) who pay from hundreds of dollars to over \$11,000 annually for the services; and second, there are users who read the news service stories for free by accessing petitioner's service via the Internet. Certainly the purchasers are sophisticated consumers who purchase the services not on impulse but with care and deliberation. See *Electronic Design & Sales v. Electronic Data Systems*, 754 F.2d 713, 21 USPQ2d 1388 (Fed. Cir. 1992). While the users may well be less sophisticated and may not use the same care, presumably these users know which website they are on, and to whatever extent they may be confused by the letters CNS, respondent's words "CYBERCAST NEWS SERVICE" make clear that respondent is not the "CATHOLIC NEWS SERVICE." This factor is neutral.

With regard to the du Pont factor of the number and nature of similar marks in use in connection with similar services, we start by stating there is very minimal evidence of third-party use. However, respondent contends that the record contains evidence of a few uses and that its evidence of third-party registrations can be used to illustrate how a term is perceived in the industry. Some examples include a printout of web pages from the CHARISMA NEWS SERVICE and its use of CNS;¹⁴ and Registration No. 1210917 for the mark CNS, issued to Commodity News Services, Inc. for "news wire and video news wire services featuring commodity quotations and related information." Clearly the generic words "news service" are in use and will be used by various entities who provide news services, and the letters "NS" are used to refer to "news service." The letter "C" may refer to any number of words which begin with the letter "C," including those of record herein such as "Catholic," "Conservative," "Charisma," "Cybercast." This factor slightly favors respondent.

We turn to the du Pont factor relating to actual confusion. Despite simultaneous use since June 2000, and notwithstanding petitioner having a large presence in its field (e.g., receiving 1.5 million hits per month on its

¹⁴ The record shows that petitioner sent this entity cease and desist letters regarding use of the letters CNS, which apparently resulted in Charisma News Service ceasing use thereof.

news service website in 2002), there has been minimal (if any) actual confusion. Petitioner contends that it has provided evidence of two instances of actual confusion (brief, pp. 10-12 and reply brief, pp. 6-7). Specifically, the two instances are the following: (1) a July 17, 2002 e-mail from a man "active in raising awareness about important issues in our culture as they relate to faith, life, family and education" and who "was appalled by the article below [regarding cloning and carrying 'CNSNews.com' and 'CNSNews.com Staff Writer' bylines] from CNS"; and (2) a May 17, 2002 e-mail from a man associated with the Alliance for Marriage who wrote [in a story regarding homosexual marriage carrying 'CNSNews.com' and 'CNSNews.com Staff Writer' bylines] that "the 'Catholic News Service' has again shown their determination to give voice to groups and interests other than the leaders of the Catholic church in the United States." (First Lombard declaration, paragraphs 28 and 30; and Exhibit B, Items 9 and 11.)

Mr. Lombard's first declaration also includes his averments about incidents such as a radio station in Vermont referring to "a report from CNS" when it was respondent, not petitioner (paragraph 32); and e-mails to petitioner referring to respondent (paragraphs 33, 34, 35). In addition, Patricia Zapor averred in her declaration (paragraph 10) regarding (1) an incident on an elevator

involving one of respondent's reporters identifying himself as working for CNS, and (2) receiving an email list from the director of the Institute on Religion and Public Policy wherein the sender stated that "people in his business circle had expressed confusion about who CNSNews.com is."

Importantly, one problem with petitioner's asserted examples of actual confusion is that none of the examples involve respondent's mark as registered which is the only issue before the Board. That is, there is no evidence of actual confusion between petitioner's mark and respondent's registered mark. Moreover, in several of the examples it is quite clear that the writer is not at all confused about the source of or the differences between petitioner's service and respondent's service. (For example, a February 10, 2000 email from "cgunty" to "mlombard" includes the following:

"Can CNS (the real news service) [petitioner] go after these pretenders?"; and an email from Helen Osman to Julie Asher states "I just got this [an email article carrying a CNSNews.com byline]. I am assuming it is not from the real CNS [petitioner], and wanted to alert y'all to it...").

Finally, some of the examples, such as the instance by Patricia Zapor referring to another person's statements about confusion reported to him is of virtually no probative value as there is no evidence directly from the man who asserted people told him they were confused. In addition,

the way this incident is reported in Ms. Zapor's declaration indicates that this did not involve confusion based on respondent's registered mark.

Thus, the record is devoid of any instance of actual confusion by relevant purchasers and/or users as to petitioner's and respondent's respective involved marks. While evidence of actual confusion is not required to establish a likelihood of confusion, in this case, where petitioner itself asserts a vast presence in the field since 1989 (25 to 30 stories a day with over 200 publishing clients and 1.5 million hits per month in 2002 on petitioner's website) and respondent's presence since June 2000 (with large sales and expenditure figures), it is significant that despite all this, there is no evidence of actual confusion. The absence of any instances of actual confusion weighs in respondent's favor, especially in the circumstances of this case, where both parties have used these marks for the essentially same services for several years, but the parties have not encountered any instances of actual confusion by consumers.

Another du Pont factor argued by petitioner in the case now before us is "the variety of goods on which a mark is or is not used (house mark, 'family' mark, product mark)." Petitioner contends that its CNS mark is used as a trade name, trademark and service mark in that petitioner

distributes news, photos, cartoons and other features of interest to Catholics. We do not agree that this has been clearly established in this case. Thus, this factor is neutral.

Petitioner argues that that there is a significant potential for confusion in that respondent is creating "initial interest confusion" because respondent uses CNS, CNS NEWS and CNS NEWS.COM as metatags which helps direct traffic to respondent's website, and because respondent uses CNSNEWS.com as a byline in its stories.

Respondent contends that this du Pont factor favors it because its registered mark includes the words "CYBERCAST NEWS SERVICE" as well as a significant design feature; and that considering the number of times petitioner's mark has appeared in the then-four years since respondent commenced use of its registered mark with petitioner able to offer only two flawed instances of actual confusion, it is clear that the potential for confusion is de minimis.

Again we emphasize that this cancellation proceeding involves the question of the registrability of respondent's mark as shown in the registration (not the letters CNS or CNSNEWS or CNSNEWS.COM used alone in connection with respondent's services or as metatags or bylines).

There must be shown more than a mere possibility of confusion; instead, there must be demonstrated a probability

or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987). The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. In this case, it is our belief that the possibility or likelihood of confusion between petitioner's mark CNS and respondent's registered mark is remote.¹⁵

In summary, despite the relatedness of the parties' services and the similar trade channels, in balancing the relevant du Pont factors (similarity or dissimilarity of the marks, similarity or dissimilarity and nature of the goods/services, similarity or dissimilarity of the channels

¹⁵ Petitioner referred in its reply brief (p. 6) to this Board proceeding as involving "trademark infringement." It is not such an action, however. Respondent's asserted uses of metatags and journalist bylines is not a question before this Board and would more properly be addressed in a trademark infringement action.

of trade, conditions under which and buyers to whom sales are made (i.e., sophistication of purchasers, cost of goods/services), fame of the prior mark, the nature and extent of any actual confusion, and the length of time during and the conditions under which there has been use by both parties without evidence of actual confusion), we find that petitioner has not met its burden of establishing a likelihood of confusion between the involved marks. The contemporaneous use of these marks, as has occurred since June 2000, in connection with these services, is not likely to cause confusion as to the source or sponsorship of such services. See *Champagne Louis Roederer S.A. v. Delicato Vineyards*, supra; and *Kellogg Co. v. Pack'em Enterprises Inc.*, supra; and *Burns Philip Food Inc. v. Modern Products Inc.*, 24 USPQ2d 1157 (TTAB 1992), aff'd, unpub'd, but appearing at 1 F.3d 1252, 28 USPQ2d 1687 (Fed. Cir. 1993).

Decision: The petition to cancel is denied.