

THIS DISPOSITION
IS NOT CITABLE AS
PRECEDENT OF
THE TTAB

Mailed: October 26, 2004

Oral Hearing:
June 3, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Diners Club International Ltd.
v.
Rosenbluth International, Inc.

Opposition No. 91106261
to Application No. 74697987
filed on July 16, 1995

Richard Lehv and Michael Chiappetta of Fross Zelnick Lehrman
& Zissu for Diners Club International Ltd.

Timothy D. Pecsénye and Dennis P. McCooe of Blank Rome for
Rosenbluth International, Inc.

Before Hanak, Hairston and Walters, Administrative Trademark
Judges.

Opinion by Walters, Administrative Trademark Judge:

Diners Club International Ltd. filed its opposition to
the application of Rosenbluth International, Inc. to
register the mark GLOBAL VISION for "computer software for

use in the travel industry for information management," in International Class 9.¹

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's goods so resembles opposer's previously used mark GLOBAL VISION for "computer software designed to manage reporting of travel expenses" as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of the claim and asserted affirmatively that it "is the owner of a family of marks containing the dominant commercial term VISION for travel and travel related goods and services; including VISION, VISION CONSOLIDATOR, VISION DIRECT, USER VISION and TAP THE POWER OF VISION, as well as the mark GLOBAL VISION" (Answer, p. 2, para. 9.)

Applicant asserts, further, that it has been using its VISION marks since at least September 1986, and that its use predates opposer's use alleged in its notice of opposition.

The Record

The record consists of the pleadings; the file of the involved application; the testimony deposition by opposer of Judith Hilvers, opposer's senior vice president of corporate

¹ Application Serial No. 74697987, filed July 16, 1995, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods. The application includes a statement that applicant is the owner of Registration Nos. 1,504,237 and 1,627,853, although we note that the latter registration is cancelled.

marketing, Yolanda Piazza, opposer's senior vice president of information products, and Norma Love, opposer's director of information products in 1992, all with exhibits; opposer's rebuttal testimony deposition of Norma Love, with exhibits; opposer's responses to applicant's first request for admissions, and status and title copies of registrations owned by applicant, both of which were submitted by applicant's notice of reliance; and the testimony deposition by applicant of Nina Keenehan, applicant's business manager for information management, with exhibits. Both parties filed briefs on the case and an oral hearing was held, but only opposer appeared at the oral hearing.

Factual Findings

Opposer's principal business is the issuance of credit cards and charge cards to charge expenses that are billed monthly. The cards are issued to individuals, including personal cards and corporate cards for employees of corporate customers.

Opposer also offers information management software to its corporate clients so that such clients can receive spending summaries and analyses of the travel and entertainment expenditures of corporate employees. This information is formatted so that clients can conduct business planning, such as negotiating discount travel rates, allocating personnel and money for business travel,

and determining the cost and business benefit balance of corporate travel and entertainment expenditures. The software permits a corporate client to aggregate and organize the travel data of large numbers of employees into different summaries and reports for numerous purposes.

Opposer's key competitor in the field of management information reporting is American Express. Opposer's business differs from the business of American Express because, while both offer charge card products, American Express has its card program and travel agency under one umbrella. To compete with American Express, opposer has, since 1984, aligned itself with travel agencies in the market. Applicant is one of the travel agencies with whom opposer has a "preferred" arrangement. The two entities work closely together to present their products to corporate customers. Joint promotional materials include both opposer's logo and applicant's logo.

As part of opposer's relationship with applicant, opposer conducts training sessions to educate applicant's sales force about opposer's product offerings. Opposer submitted a copy of a promotional item called a "sell" sheet (Hilvers Dep., Ex. 25) that promotes opposer's core products, including GLOBAL VISION software, and includes applicant's logo thereon. This sell sheet is used by applicant in its proposals and sales presentations, and by

opposer in sales initiatives conducted jointly with applicant.

Opposer submitted a copy of its "Continuum Presentation" (Hilvers Dep., Exs. 27 & 28), which was part of an interactive exhibition set up by applicant in the lobby of applicant's headquarters in Philadelphia. The exhibit showcased for corporate customers the travel services and products of applicant and its preferred vendors, including opposer. Opposer's interactive Continuum Presentation includes an explanation of its GLOBAL VISION Internet product.

Opposer first introduced its travel information management software at a trade show in July 1992 under the trademark T&E ANALYZER. This software was initially distributed on disks during the first quarter of 1993.²

Opposer subsequently developed an updated version of its T&E ANALYZER software and determined that it would be renamed "GLOBAL VISION," with the first version numbered 2.0. Disk labels were first printed in April 1995 and a press release announcing the product is dated April 17, 1995 (Love Dep., Ex. 2). The information contained in the press release appeared in the April 17, 1995 issue of *Business Travel News*, an industry periodical (Love Dep., Ex. 3). On

² The record indicates that opposer may have used the mark GLOBAL VISION on a software product in 1992, but that opposer could find no documentation of this use. Since this use has not been adequately established, we have not considered it.

June 1, 1995, opposer distributed a bulletin to its customers announcing the availability of its GLOBAL VISION version 2.0 software and advising customers of the hardware and software requirements necessary to upgrade to the GLOBAL VISION software from the T&E ANALYZER software (Love Dep., Ex. 6). Several customers responded to the bulletin in June 1995. On June 5, 1995, opposer loaded the software onto disks and mailed a copy to one of its customers, Ted Barrett of National Starch (Love Dep., Ex. 7). Opposer's telephone tracking system shows a telephone call from Mr. Barrett on June 7, 1995 indicating that National Starch had installed the GLOBAL VISION software but was having problems loading data; and another telephone call is logged from Mr. Barrett on June 13, 1995 with a question about GLOBAL VISION software report results. (Love Rebuttal Dep., Ex. 31.)

Opposer has used the mark GLOBAL VISION continuously since June 1995 in connection with each of the successive versions of opposer's information management software and the user manuals and bulletins distributed in connection therewith. The type of media used has migrated from diskettes to CD Rom and, presently, to a web-based product. Opposer's GLOBAL VISION software is part of what applicant describes as its suite of "GLOBAL" software products,

presently consisting of GLOBAL PRODUCT MANAGER, GLOBAL VISION and T&E RECONCILER.³

Applicant began its business as a steamship ticket office in 1892; in the 1930's and 1940's, applicant's business expanded to include leisure travel sales; and in 1965, applicant's business expanded to include national and international corporate customers. At the time of trial, applicant had approximately 1,500 clients worldwide and an annual business of \$3.2 billion. The record does not establish what percentage of clients and business is in the United States.

Applicant owns the following registrations:

Registration No. 2,678,526
Mark: EVISION@ROSENBLUTH
Services: "Travel information services available through a global computer network"
Registered: January 21, 2003 based on an application filed on August 30, 1999.⁴

Registration No. 2,663,703
Mark: VISION@ROSENBLUTH
Services: "Travel information services available through a global computer network"
Registered: December 17, 2002 based on an application filed August 31, 1999.⁵

Registration No. 1,998,414
Mark: VISION DIRECT

³ There is insufficient evidence in the record to draw any conclusions about the use of marks other than GLOBAL VISION by opposer.

⁴ Ms. Keenehan, applicant's business manager for information management, testified that applicant first used this mark in connection with the identified services in July 2000.

⁵ Ms. Keenehan testified that applicant first used this mark in connection with the identified services in August 1999.

Goods: "Computer software used in connection with the management of travel expense information and general travel information"

Registered: September 3, 1996 based on an application filed October 26, 1995.⁶

Registration No. 2,087,044

Mark: VISION CONSOLIDATOR

Goods: "Computer software for use in the travel industry, namely, for national and global travel management"

Registered: August 12, 1997 based on an application filed February 7, 1996.⁷

Registration No. 2,064,590

Mark: TAP THE POWER OF VISION

Goods: "Computer software for use in managing travel information"

Registered: May 27, 1997 based on an application filed October 26, 1995.⁸

Registration No. 1,977,102

Mark: VISION DIRECT

Goods: "Computer software used in connection with the management of travel expense information,"

Registered: May 28, 1996 based on an application filed December 7, 1993.⁹

Registration No. 1,504,237

Mark: VISION

Goods: "Processing management data and generating management reports for others concerning the travel activities of their personnel"

Registered: September 13, 1988 based on an application filed November 6, 1986.¹⁰

⁶ Ms. Keenehan testified that applicant first used this mark in connection with the identified goods in November 1993.

⁷ Ms. Keenehan testified that that applicant first used this mark in connection with the identified goods in April 1995.

⁸ Ms. Keenehan testified that she was aware that this mark was a slogan that would have been used, but that she had no personal knowledge of its use.

⁹ Ms. Keenehan testified that that applicant first used this mark in connection with the identified goods in February 1994.

¹⁰ Ms. Keenehan testified that the VISION mark was first used in connection with the identified services on or around September 1986. However, she also stated that she first began working for applicant in 1993 and that her knowledge about the first use of this mark is based on

Applicant's core technology is its Global Distribution Network, which allows applicant to access all stored information necessary to provide services to a corporate client regardless of where that corporate client, or the client's traveler, is in the world. Applicant's travel management system, where all client travel data is integrated and maintained, is identified by its registered mark, VISION. The information contained therein is organized into management reports for clients and reports can be customized for clients. Applicant's software program that monitors travel itineraries and, among other things, flags travel itineraries that are not in compliance with a client's travel policies, is identified by the mark ULTRAVISION. It is not clear from the record exactly when clients began using the described services identified by the ULTRAVISION mark, *i.e.*, whether it was in July 1993 or some time thereafter. An article entitled "Travel Agencies Still Search for Global Uniformity" in *Business Travel News*, May 18, 1998 (Keenehan Dep., Ex. 5), includes the following statements:

Like its mega competitors, Rosenbluth International [applicant] also is working diligently on selling the concept of a global account management, but still has a limited number of truly global customers.

conversations with colleagues. Therefore, we find her statements in this regard to be of little probative value.

. . .

On the technology side, Rosenbluth provides global data collection through its Global Distribution Network. "We operate on a dominant CRS platform and our international offices are linked through the GDN. All data from the Apollo/Galileo platform is forwarded electronically into Vision, our back-office system," McGurk said.

Applicant's desktop software program, that clients license and use to obtain data from applicant's VISION system and manipulate the data into various types of reports, is identified by the registered mark VISION DIRECT.¹¹

Ms. Keenehan stated that applicant's first on-line Internet-based reporting product was identified by the registered mark VISION@ROSENBLUTH. A second related product, identified by the mark EVISION, was launched in July 2000 and permits clients to obtain on-line ad hoc reporting on a flexible schedule. Both products were still available at the time of trial. A third product, identified by the mark IVISION, was launched during 2002 and permits

¹¹ Applicant's attorney stated during and at the close of Ms. Keenehan's testimony that several specified exhibits were marked confidential. We note that applicant complied with none of the requirements for submitting confidential documents to the Board and the referenced exhibits are presently part of the public record. In this regard, we note the relevant provisions of Trademark Rule 2.125(e), 37 CFR §2.125(e):

Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of §2.27(e). Although required, there is no protective order in place and applicant did not submit the allegedly confidential documents separately under seal.

clients to access data via the Internet and run reports at any time. A fourth product, identified by the registered mark VISION CONSOLIDATOR, permits applicant to import historical data from a corporate client and merge it with the client's data in applicant's Vision database so that the corporate client has a single source for its travel management reporting.

Ms. Keenehan opined that if both applicant and registrant use the mark GLOBAL VISION, customers are likely to be confused.

Analysis

This case is primarily a priority dispute. In its brief, applicant concedes that there is a likelihood of confusion and argues that applicant has priority of use.

Regarding the marks, there is no question that the marks are identical. Both parties agree that their respective goods are closely related, and the evidence of record supports this conclusion. Both parties offer travel-related computer software. Opposer describes its software as being designed to manage reporting of travel expenses; and applicant describes its software as being designed for use in the travel industry for information management. The record shows that the information "managed" by the software of the two parties herein overlaps and, to the extent it does not overlap, it is substantially similar.

The evidence also establishes, and the parties agree, that the channels of trade for their respective software products are identical, namely, corporations with employees who travel. This is reinforced by the fact that opposer and applicant have a business relationship to offer services to the same corporate clients, albeit not with respect to the goods involved in this case.

Turning to the issue of priority in this case, we begin by noting that applicant's position is based primarily upon its affirmative defense that it owns a family of VISION marks and that, by virtue thereof, applicant has priority of use of its GLOBAL VISION mark. However, as opposer points out, the Board has clearly and affirmatively determined that a family of marks argument can be used only offensively by a plaintiff, not defensively by a defendant. See *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048 (TTAB 1992).

The *Baroid* decision addressed "the question of whether a defendant in a Board inter partes proceeding can rely upon its asserted ownership of a family of marks as a defense against a plaintiff's intervening common-law rights." *Baroid, supra* at 1049. The Board stated the following in this regard:

The issue under Section 2(d) is whether applicant's mark sought to be registered, or respondent's mark, the registration of which is sought to be cancelled, so resembles plaintiff's

registered and/or previously used mark or marks as to be likely to cause confusion. Thus, the fact that a plaintiff may rely upon any confusingly similar mark which it has either registered or previously used, is to be contrasted with the fact that a defendant whose sole mark in issue is its mark sought to be registered or its mark sought to be cancelled, can rely upon only its rights in that mark, except in very limited situations.

One situation involves a defendant's claim that it already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff. See *Morehouse Manufacturing Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969).

A second situation involves a defendant's attempt to defeat a plaintiff's priority of use claim by virtue of the defendant's earlier use of a mark which is the legal equivalent of defendant's involved mark for the same or similar goods. This latter situation involves the concept of 'tacking.' See *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991), *aff'g* 18 USPQ2d 1804 (TTAB 1990) [other citation omitted] ... [A] party seeking to tack on its use of an earlier mark to its use of a later mark may do so only if the earlier mark is the legal equivalent of the mark in question or indistinguishable therefrom, and would be considered by purchasers as the same mark. For purposes of tacking, two marks are not necessarily legal equivalents merely because they are considered to be confusingly similar. Tacking of an earlier use of one mark onto the later use of a very similar mark, for purposes of priority, has been permitted only in "rare" instances. [citation omitted.]

To allow a defendant to plead and prove as a defense against a plaintiff's intervening common-law rights that it owns an earlier family of marks would create, at least in our minds, an unacceptable loophole to the stringent standards applicable to the two situations set forth above. [footnote omitted.] The loophole would be unacceptable because, as noted above, the

priority-of-use issue under Section 2(d) (when priority of use is in issue) is whether the defendant's use of its mark sought to be registered, or the registration of which is sought to be cancelled, precedes the plaintiff's use of the plaintiff's pleaded mark(s), not whether the defendant has priority of use of another mark or marks which the plaintiff's mark(s) so resembles as to be likely to cause confusion. Thus, we must narrowly construe the availability of defenses grounded upon ownership of other earlier-used and/or registered marks.

Id. at 1052-53. See also *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733 (TTAB 2001).

As noted above in *Baroid*, there are two exceptions to the rule that a defendant may rely only on the mark in the opposed application, which brings us to applicant's assertion of a *Morehouse* defense, one of the exceptions noted in *Baroid*, for the first time in its brief. See *Morehouse Mfg. Corp. v. J. Strickland Co.*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969). Opposer objects that this defense was neither asserted in applicant's answer, nor tried by the express or implied consent of the parties. We agree. We do not consider applicant's pleading of a family of marks to implicitly include a *Morehouse* defense. Therefore, this defense has been given no consideration.¹²

¹² Moreover, even if we were to consider whether a *Morehouse* situation exists in this case as a limited exception to the family of marks prohibition, we would find that applicant has not met the requirements set out in *Morehouse*. *Morehouse* requires that the marks and goods in the prior registration(s) and involved application are "substantially identical." *Id.* at 717. See also *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989). For purposes of the *Morehouse* defense, two marks are "substantially identical" when they are either literally identical or legally equivalent. See *O-M Bread Inc. v. United States*

Nor has applicant established the other *Baroid* exception, namely, the legal equivalency of marks and goods necessary to permit tacking of earlier dates of use of its other VISION marks to the mark herein. Therefore, *Baroid* is directly applicable to the situation involved in this case and we conclude that whether applicant has a family of VISION marks is irrelevant and we have given this allegation no further consideration in reaching our decision. As in *Baroid*, our analysis considers only opposer's pleaded and established mark and goods and the mark and goods identified in the opposed application.

In this regard, the earliest date upon which applicant can rely is its application filing date of July 16, 1995.

Opposer does not own a federal registration for its GLOBAL VISION mark.¹³ Regarding its use, Opposer contends that its first use of its pleaded mark was "bona fide use in the ordinary course of business, and demonstrate[s] legitimate, substantial and continuing use of the GLOBAL VISION mark in connection with its software product."

(Brief, p. 10.) Opposer contends that its use precedes the

Olympic Committee, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995) (OLYMPIC and OLYMPIC KIDS are neither the same nor legally equivalent). Applicant has not established that any of the registered or unregistered marks about which it has submitted substantial evidence are literally identical or legally equivalent to the mark in the application herein.

¹³ Neither party has alleged that the mark GLOBAL VISION is not inherently distinctive in connection with the parties' respective goods and, therefore, for the purposes of this proceeding at least, we consider the mark to be inherently distinctive in connection with each party's goods.

July 6, 1995 filing date of applicant's intent-to-use application.

Applicant disputes opposer's allegations that it made any sales of its product prior to applicant's July 6, 1995 filing date, and argues that opposer's June 5, 1995 shipment was a single shipment that "does not constitute a bona fide use in commerce in the ordinary course of business sufficient to establish priority."¹⁴ (Brief, p. 14.) Applicant states that opposer's evidence of use is ambiguous at best and applicant infers from opposer's evidence that no product was actually shipped by opposer on June 5, 1995; that only a draft user manual was sent to the customer; and that the customer was merely testing a beta version of opposer's software on a trial basis. (Brief, p. 15.)

We find that the record clearly establishes that opposer began promoting its GLOBAL VISION product and printing labels and user manuals in April 1995; that, in June 1995, opposer's software was ready for delivery, product bulletins were distributed, and orders were received; and that product sales were made and delivered beginning June 5, 1995. Applicant's mere statement to the contrary is insufficient to refute opposer's showing that

¹⁴ Applicant contends that opposer's evidence is also insufficient to establish use analogous to trademark use. However, opposer points out that it has not made such an argument; rather, opposer asserts that it commenced actual bona fide use of its mark in commerce on June 5, 1995. Therefore, we have not considered this argument by applicant.

its use commenced on June 5, 1995. Whether opposer sold only one product on June 5, 1995 is not important in view of the evidence of its continued sales up to and including the time of trial.

Therefore, we conclude that opposer has clearly established its priority of use in this case.

Decision: The opposition is sustained.