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**THIS DISPOSITION
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Paper No. 18
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Missing Children Minnesota
v.
Run*Yell*Tell, Ltd.

Opposition No. 114,186
to application Serial No. 75/388,989
filed on November 12, 1997

Cecilia M. Michel of Hinshaw & Culbertson for Missing
Children Minnesota.

Robert C. Faber of Ostrolenk, Faber, Gerb & Soffen, LLP
for Run*Yell*Tell, Ltd.

Before Walters, Chapman and Drost, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Run*Yell*Tell, Ltd. (a New York corporation) filed
an application to register on the Principal Register the
mark shown below

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for services identified as amended, as "instructional services, namely providing workshops featuring child protection and safety" in International Class 41. The claimed dates of first use and first use in commerce are April 1996 and June 1996, respectively. Applicant included in its original application the following statement: "The drawing is lined for the colors Black, Blue, Green and Pink and color is claimed as a feature of the mark." In addition, in response to a requirement of the Examining Attorney, applicant disclaimed the words "RUN YELL TELL."

Missing Children Minnesota (a Minnesota non-profit corporation) has opposed registration of the mark alleging that opposer owns the mark RUN, YELL & TELL! for educational services, namely, conducting abduction prevention safety workshops for parents and children and distributing related program material in the nature of books, song and music sheets, instructor's presenter's manuals, posters and videotapes; that on May 11, 1998, opposer filed an application to register the mark RUN, YELL & TELL! for the above-listed services and related

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goods¹; that opposer has continuously used its mark RUN, YELL & TELL! since at least as early as 1989, long prior to applicant's filing date of November 12, 1997; that opposer's mark has become well known

¹ Action on opposer's application is currently suspended in Law Office 107.

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in connection with child safety programs; and that applicant's mark, when used in connection with its services, so resembles opposer's previously used mark as to be likely to cause confusion, mistake, or deception.

In its answer, applicant admitted that it had not used its mark prior to the dates of first use (April 1996) and first use in commerce (June 1996) claimed in its application; but applicant otherwise denied the salient allegations of the notice of opposition.

Applicant asserted affirmatively, inter alia, that the phrase "RUN YELL TELL" was determined to be descriptive by the Examining Attorney handling applicant's involved application, and that opposer cannot acquire exclusive rights to the descriptive phrase "RUN, YELL & TELL!"

The record consists of the pleadings; the file of the opposed application; the testimony, with exhibits, of Carol Watson, opposer's executive director; and opposer's notice of reliance on opposer's requests for admissions served November 28, 2000 (in which opposer requested that applicant admit the genuineness of 18 documents provided by applicant), to which applicant failed to respond, and opposer specifically relied on documents labeled as Exhibit Nos. 2, 7, 10, 11, 13, 14, 16 and 18.

Applicant's attorney did not attend and thus, did not

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cross-examine opposer's witness, Carol Watson. Applicant took no testimony and offered no evidence during its testimony period. Only opposer filed a brief on the case. Neither party requested an oral hearing.

Missing Kids Action Agency was founded (incorporated) in 1984 and the name was changed to Minnesota Missing Children in 1986. Among other things, opposer conducts abduction and abuse prevention safety educational programs and workshops for the public, for parents and professionals, and for children. In 1986, Carol Watson (opposer's executive director) created the RUN, YELL & TELL! program for young children (ages three through seven)²; and opposer conducted the first such program in Minnesota that year. The program has been adopted by other organizations (i.e., various national and state missing and exploited children or children's rights organizations), and the program is provided nationally and internationally. In fact, opposer's RUN, YELL & TELL! program has been included in the National Victim Center's National Missing Children's Day "Strategies For Action Kit." The videotape version of opposer's RUN, YELL & TELL! workshop has been sold and distributed nationally since 1989; and its book RUN, YELL

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& TELL! A Safety Book For Children, first published in 1993, continues to be distributed and sold nationally.

In the RUN, YELL &

² Opposer also conducts educational programs and workshops under the marks "S.A.F.E.R." and "Erica's Choices."

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TELL! program/workshop an adult presenter teaches young children to recognize potentially harmful situations and to get help, using hand puppets (Elvis the Elephant and Rosie the Rabbit³). Opposer's program is presented to groups of any size (e.g., from 10 to 200); and it is available in videotape and/or audiotape versions. Ms. Watson distributes information about opposer's RUN, YELL & TELL! program and products at every national and international conference and meeting (e.g., Association of Missing and Exploited Children Organization) she attends, which she has done continuously since 1988. In addition, the record shows that opposer advertises the RUN, YELL & TELL! program (and the related materials) by "word of mouth" (Watson dep., p. 28) and through public service advertising. That is, publications will print pro bono opposer's advertisement on a space available basis. Occasionally, opposer has placed ads in media publications. Moreover, opposer created a website in 1994 which features the RUN, YELL & TELL! workshop and

³ Opposer sometimes uses depictions of the rabbit and the elephant such as that shown below.

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book; and in 1996 opposer obtained the telephone number 1-888-RUN-YELL.

Although applicant submitted no evidence or testimony, we know from the application that applicant is a for-profit corporation of New York; and that the application was filed on November 12, 1997, claiming first use since April 1996. According to applicant's specimen of use, applicant provides an education program "that speaks with children in a non-threatening way about the issues of abduction and abuse. The workshops are appropriate for children age four and older and are individually designed for the specific age and number of children participating." Further, applicant's "program mascot" is an animal, a bee named "U-Bee Safe." Applicant offers three programs - (1) a one and one-half hour program, (2) a five-hour program, and (3) a 4-8 week program which combines the teachings of Run*Yell*Tell, Ltd. with self-defense training. (See also, exhibit No. 7 - a biography of applicant's founder, and No. 14 - applicant's press release about its RUN*YELL*TELL workshop on children's safety; both submitted as part of opposer's notice of reliance.)

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The record also establishes that on March 16, 1998 applicant's attorney wrote a cease and desist letter to opposer regarding opposer's use of the mark "Run, Yell & Tell" on a publication, and asserting "Your use of my client's trademark may confuse your customers and certainly will confuse my client's customers as to the source of your publication or the affiliation between the two entities." (Watson dep., exhibit No. 206, and opposer's notice of reliance, exhibit No. 16.)

On October 13, 2000, opposer filed a Domain Name Dispute Complaint against applicant for its use of the "runyelltell.com" domain name; and on November 20, 2000 the arbitration judge ordered that the domain name be transferred to the complainant (opposer herein).⁴

We turn first to the question of priority. The record establishes opposer's priority of use of its common law mark, RUN, YELL & TELL! for educational services, and various related goods. Specifically, opposer's evidence establishes its continuous use of the mark RUN, YELL & TELL! for educational services in the nature of conducting abduction prevention safety workshops for parents and children since 1986; for

⁴ Ms. Watson testified that the transfer had taken place and that opposer is currently the owner of the "runyelltell.com" domain name. (Dep., pp. 119-120)

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videotapes of said workshops since 1989; for books since 1993; for audiotapes since 1995; and for puppets (Rosie the Rabbit and Elvis the Elephant) since 1995. Inasmuch as applicant introduced no testimony or evidence, it is limited to the filing date of its application, November 12, 1997. See *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1716 (TTAB 1991). Opposer has shown continuous use of its mark RUN, YELL & TELL! from a date long prior to applicant's filing date.

Under the case of *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981), a plaintiff opposing registration of a trademark on the ground of likelihood of confusion with the plaintiff's own unregistered mark cannot prevail unless the plaintiff shows its mark is distinctive of its goods and/or services, either inherently, or through acquired distinctiveness, or through "whatever other type of use may have developed a trade identity." *Otto Roth*, supra at 43. See also, *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039 (Fed. Cir. 1990).

In the case now before us, applicant disclaimed the words "RUN YELL TELL" in its own application upon the request of the Examining Attorney, and applicant asserted affirmatively in its answer to the notice of opposition

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that opposer cannot acquire exclusive rights to the descriptive phrase "RUN, YELL & TELL!" As noted earlier, applicant has not introduced any evidence or testimony on this defense at trial. However, opposer specifically lists one issue before this Board is whether opposer's mark has acquired distinctiveness. (Brief, p. 5.)

Therefore, without deciding whether opposer's mark RUN, YELL & TELL! used in connection with its services and goods is inherently distinctive, but after careful review of the relevant evidence of record on the issue of acquired distinctiveness, we find opposer's unregistered mark RUN, YELL & TELL! has acquired distinctiveness.

Opposer has continuously used the mark for over 16 years in connection with the educational services and workshops, for over 11 years on videotapes, and for at least five years on books, audiotapes and puppets. It is clear that opposer actively promotes its workshop/program through the use of these associated goods, such as books, tapes, and puppets.

Moreover, the books and audiotapes are available for sale through Barnes & Noble and Amazon.com. Within a few years of opposer's first use of RUN, YELL & TELL! for its safety and abduction prevention program for young children the National Victim Center selected the program

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for inclusion in its National Missing Children's Day activities. Opposer's RUN, YELL & TELL! program is, in part, sponsored and/or underwritten by nationally known companies such as, Barnes & Noble Bookseller, American Express Foundation, IDS Corporation, and Northwestern National Life.

Opposer is frequently contacted by the media (e.g., Nickelodeon TV, and numerous radio and television stations from around the country) requesting interviews (generally with Carol Watson, opposer's executive director) and/or written information about the RUN, YELL & TELL! program. Opposer's educational program has clearly achieved nationwide acclaim. Also, opposer made of record several letters directly from third parties regarding the RUN, YELL & TELL! program, in which it is obvious that the writers of these letters recognized opposer as the source of the RUN, YELL & TELL! program.⁵

This record establishes that opposer's mark has acquired distinctiveness.

⁵ The sales figures for opposer's services are not large, but Ms. Watson explained that initially the RUN, YELL & TELL! program was provided at no cost, but in the mid 1990s opposer started charging \$.50 per child taking the course because the program was more frequently being presented at for-profit day care centers. Items such as pencils and crayons carrying the RUN, YELL & TELL! mark are distributed free to the participants. (Watson dep., pp. 58-59.)

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We now turn to the issue of likelihood of confusion. Our determination of likelihood of confusion 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). Based on the record before us in this case, we find that confusion is likely.

Turning first to consideration of the parties' respective services, applicant's services are identified as "instructional services, namely providing workshops featuring child protection and safety," and opposer has established common law rights in its mark for workshops and educational programs featuring personal safety and abduction prevention for children. The parties' services are virtually identical.⁶ "When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Obviously, identical services are offered through all the same channels of trade to similar

⁶ Opposer has also established common law rights in various goods (videotapes, audiotapes, books and puppets), specifically

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potential purchasers, for example in this case, day care centers, schools, civic organizations and community centers.

We turn next to consideration of the similarities or dissimilarities of the marks. In this case, there are obvious differences in the appearance of the two marks, including that opposer's common law mark is the words RUN, YELL & TELL!, whereas applicant's mark is a composite mark, as shown below

consisting of the words RUN YELL TELL ANTENNA POWER! and the design of a fanciful bee. The words RUN YELL TELL are

associated with its services. However, we have focused on the services of the parties.

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clearly emphasized in applicant's mark as they appear in thick, block capital letters at the top of the mark, and the words RUN and TELL are lined for the color pink and the word YELL is lined for the color blue, whereas the words ANTENNA POWER! are in smaller type and appear in plain, thin lettering. While the marks are different in appearance, the RUN YELL TELL portion of applicant's mark is a very noticeable element. It is the words RUN YELL TELL that would likely be utilized in asking for and about applicant's services. See *In re Appetito Provisions Co., Inc.*, 3 USPQ2d 1553 (TTAB 1987). Moreover, these words carry the same connotation for both parties' services and goods.

Despite the differences in the appearance of the marks, we nonetheless find that the involved marks, RUN, YELL & TELL! and RUN YELL TELL ANTENNA POWER! and design, considered in their entireties, have sufficient similarities that consumers are likely to view the marks as variations of each other, with both indicating a common source for the services. Thus, purchasers, upon seeing applicant's mark used in connection with workshops featuring child protection and safety, would assume that applicant's services come from

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the same source as opposer's services, or are sponsored by or associated with opposer. The design feature of a bee and the stylized lettering in applicant's mark simply do not offer sufficient differences to create a separate and distinct commercial impression. See *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

Moreover, the differences in the marks may not be recalled by purchasers seeing the marks at separate times. The emphasis in determining likelihood of confusion is not on a side-by-side comparison of the marks, but rather must be on the recollection of the average purchaser, who normally retains a general rather than a specific impression of the many trademarks encountered; that is, the purchaser's fallibility of memory over a period of time must also be kept in mind. See *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973); and *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735 (TTAB 1991), *aff'd unpub'd* (Fed. Cir., June 5, 1992).

Accordingly, we find these marks are similar in sound, meaning and commercial impression.

Opposer contends that there is evidence of actual confusion in the form of three affidavits from

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individuals (submitted as exhibits with opposer's "domain name dispute complaint," which is Exhibit 200 in this opposition) who stated that when presented with the phrase RUN YELL TELL ANTENNA POWER, they would believe the source of such services to be opposer. These affidavits do not show that the affiants experienced any confusion based on use of the involved marks in the marketplace. Rather, these individuals simply averred that "when presented with the phrase RUN YELL TELL ANTENNA POWER" they would believe opposer to be the source. Thus, there are no instances of actual confusion of record herein. Of course, instances of actual confusion are not necessary to prove the issue of likelihood of confusion. See *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992).

Finally, opposer contends that applicant had an intent to copy opposer's mark when applicant selected its mark. Specifically, opposer argues that "the facts and circumstances of this case lead to the conclusion that Applicant knew of and intentionally tried to take advantage of [opposer's] reputation..." (brief, p. 18). There is no evidence that applicant was aware of opposer's mark. Even if opposer had clearly established that was true, it would not, by itself, establish

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wrongful intent. Mere knowledge of another's mark does not establish bad faith or wrongful intent, and we decline to infer a likelihood of confusion on that basis. See Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793, 1797-1798 (Fed. Cir. 1987); and Electronic Water Conditioners, Inc. v. Turbomag Corporation, 221 USPQ 162, 165 (TTAB 1984).

In view of the identical services, trade channels and potential purchasers; and the similarities of the marks, we find that opposer has established its case on likelihood of confusion.

Decision: The opposition is sustained, and registration to applicant is refused.