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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bell South Intellectual Property Corporation
v.
VCS Technologies Inc.

Opposition No. 91119656¹
to Application No. 75707930
filed on May 18, 1999

Virginia S. Taylor, R. Charles Henn Jr. and Alex S. Fonoroff
of Kilpatrick Stockton for Bell South Intellectual Property
Corporation.

Bruce A. Tassan of Bruce Tassan Law Firm for VCS
Technologies Inc.

Before Hairston, Walters and Rogers, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Bell South Intellectual Property Corporation filed its
opposition to the application of VCS Technologies Inc. to

¹ This opposition was consolidated with Opposition Nos. 91122602, 91122702, 91123111 and 91123559; and this opposition also included a counterclaim to cancel one of opposer's pleaded registrations. The noted oppositions and the counterclaim herein were dismissed with prejudice by the March 15, 2004 order of the Board and will not be addressed further in this opinion.

register the mark REALCOMMERCE for "dissemination of advertising for others via on-line electronic communications and business marketing consulting services in the field of e-commerce," in International Class 35, and "computer services, namely, designing and implementing network web pages and websites for others, hosting the web sites of others on a computer server for a global computer network; and technical consultation and research in the field of electronic commerce," in International Class 42.²

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services so resembles opposer's previously used and registered "REAL" marks, shown below, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

1,951,126	THE REAL WHITE PAGES	"telephone directories" International Class 16 Disclaimer of WHITE PAGES	Registered January 23, 1996 [§§ 8 (6 yr) & 15]
1,663,388		"classified directories" International Class 16 Disclaimer of YELLOW PAGES	Registered November 5, 1991 [Renewed - 10 yr. term; § 15]
1,839,350	REAL TALK	"telephone directory feature in which audiotext	Registered June 14, 1994

² Application Serial No. 75707930, filed May 18, 1999, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified services.

		services are listed and advertised" International Class 16	[§§ 8 (6 yr) & 15]
1,725,613	REAL SAVINGS COUPONS	"coupons for goods and services which are distributed to customers by insertion in yellow page directories" International Class 16 Disclaimer of COUPONS	Registered October 20, 1992 [Renewed - 10 yr. term; § 15]
1,837,497		"telephone directory feature in which audio-text services relating to a classified heading are listed and advertised" International Class 16 "Communications services; namely, the transmission and storage of voice messages" International Class 38	Registered May 24, 1994 [§§ 8 (6 yr) & 15]
1,875,586	REAL CONSUMER TIPS	"communications services; namely, the transmission and storage of voice messages" International Class 38 Disclaimer of CONSUMER TIPS	Registered January 24, 1995 [§§ 8 (6 yr) & 15]

1,806,033	<i>The Real White Pages</i>	"telephone directories" International Class 16 Disclaimer of WHITE PAGES	Registered November 23, 1993 [Renewed - 10 yr. term; § 15]
1,781,368	THE REAL YELLOW PAGES	"classified directories" International Class 16 Disclaimer of YELLOW PAGES	Registered July 13, 1993 [Renewed - 10 yr. term; § 15]
2,088,738	THE REAL YELLOW PAGES	"promoting the goods and services of others through consulting on directory advertising programs, designing directory advertisements and listings and placing such advertisements and listings in directories" International Class 35 Disclaimer of YELLOW PAGES	Registered August 19, 1997 [§§ 8 (6 yr) & 15]
2,207,898	<i>The Real Yellow Pages</i>	"promoting the goods and services of others through consulting on directory advertising programs, designing directory advertisements and listings and placing such	Registered December 8, 1998

		<p>advertisements and listings in directories" International Class 35</p> <p>Disclaimer of YELLOW PAGES</p>	
2,343,973	REAL HELP FOR THE REAL WORLD	<p>"on-line classified directories downloadable from global computer network" International Class 42</p>	Registered April 18, 2000
2,359,478	REAL TALKING ADS	<p>"telephone directory feature in which audiotext services are listed and advertised" International Class 16</p> <p>"advertising services, namely, promoting the goods and services of others through the use of audiotext services and interactive advertising accessed via telephone" International Class 35</p> <p>Disclaimer of TALKING ADS</p>	Registered June 20, 2000

Opposer also asserted various applications. However, applicant submitted no evidence establishing the existence and filing of the listed applications. Further, even if the applications were properly of record, they would be of little probative value, absent evidence of use of the marks in the applications.

Opposer also asserts as a ground that its "REAL" marks have been famous and distinctive within the meaning of 15 U.S.C. §1125(c) since long before the filing of applicant's application; and that applicant's proposed use of its mark in connection with the identified services is likely to dilute the distinctiveness of opposer's famous "REAL" marks.

Applicant, in its answer, denied the salient allegations of the claim.

The Record

The record consists of the pleadings; the file of the involved application; certified status and title copies of the pleaded registrations submitted by notice of reliance³;

³ Opposer submitted certified status and title copies of Registrations Nos. 2,403,314; 1,933,412; and 2,548,661. However, these registrations were not pled in the notice of opposition and, thus, they have been given no consideration in reaching our decision.

Opposer also submitted a certified status and title copy of Registration No. 2,528,906 for the mark shown below for "computer services, namely, providing electronic telephone and classified directories via a global computer network," in International Class 42. This registration issued from pleaded Application Serial No. 75749920 on January 15, 2002, and the notice of opposition is considered amended to include this registration.

~~Real Pages~~

the discovery deposition of Michael J. Vaselenak, applicant's president and designee under F.R.C.P. Rule 30(b)(6), and applicant's responses to opposer's first set of interrogatories, both submitted by opposer's notice of reliance; and the testimony depositions by opposer of Braxton Caswell, Jr., executive director of planning and development for Intelligent Media Ventures, LLC, and Mark Chicoine, employed in the advertising department of BellSouth Corporation, both with accompanying exhibits.⁴ Applicant submitted no testimony or other evidence.⁵ Only opposer filed a brief on the case and a hearing was not requested.

Factual Findings

Opposer is a subsidiary of BellSouth Corporation ("BellSouth"). Its affiliate corporation, BellSouth Advertising and Publishing Corporation ("BAPCO") produces and distributes THE REAL YELLOW PAGES, a yellow pages directory containing classified listings of various businesses, in the nine-state region covered by BellSouth Corporation⁶; and produces the Internet version, known as

⁴ Applicant's counsel did not appear or otherwise participate in opposer's testimonial depositions.

⁵ Opposer submitted the rebuttal testimony deposition of Jacqueline Gregorski, opposer's vice president of patent and trademark procurement. However, in view of the fact that applicant took no testimony and submitted no evidence, there is nothing for opposer to rebut. Thus, this rebuttal testimony is improper and has not been considered.

⁶ The nine-state region is North and South Carolina, Georgia, Florida, Kentucky, Tennessee, Alabama, Mississippi and Louisiana.

REALPAGES.COM. Approximately fifty million copies of THE REAL YELLOW PAGES directory are delivered annually in approximately 500 markets throughout the nine-state region to both residential and business addresses. The trademark THE REAL YELLOW PAGES has been used on these directories since 1984. BellSouth's sales force solicits entries for its directories through direct contact with potential advertisers and with businesses.

BellSouth also produces and distributes to residences and businesses THE REAL WHITE PAGES, a directory of residential numbers, throughout the same nine-state region.

BellSouth's trademark REAL CONSUMER TIPS identifies a voice product whereby consumers call a gateway number that permits them to obtain consumer information related to the particular heading where this consumer tip is printed. BellSouth sells space to advertisers who sponsor the various tips. REAL CONSUMER TIPS information also appears in various places within THE REAL YELLOW PAGES directories. REAL SAVINGS COUPONS are savings coupons provided by advertisers and printed in THE REAL YELLOW PAGES directories.

Mr. Chicoine stated that BellSouth uses the word REAL in connection with all of its products and services "to keep a consistent look and feel and recognition for the BellSouth family of products, family of information that we do provide to the public" (Chicoine Dep. p. 18); and that "[t]he

underlining of the word REAL within THE REAL YELLOW PAGES and all of our other REAL products is, again, part of the - our attempt to make a - give a consistent look and feel to all of our products, to give the same - to make sure that everybody understands that it's the same family of products from BellSouth" (Chicoine Dep. p. 20).

REAL TALKING ADS is a voice product that provides a phone number within an advertiser's advertising space in the directory that consumers may call to hear updated messages from advertisers about the business and sales.

BellSouth advertises its REAL products via television, radio, newspaper, billboards and various sponsorships, spending, in the past year alone, approximately \$15 to \$20 million. Typical advertisers that purchase space from BellSouth in the directories are principally small- to medium-sized businesses doing business within the geographic scope of the directories, including retail businesses, service-oriented businesses and professionals.

Intelligent Media Ventures ("IMV"), a subsidiary of BAPCO, is responsible for managing REALPAGES.COM, which pertains to all of BellSouth's electronic initiatives, including the online versions of THE REAL YELLOW PAGES and THE REAL WHITE PAGES. THE REAL WHITE PAGES online directory, available since 1999, carries listings for individuals throughout the U.S. In connection therewith,

BellSouth offers REAL PAGES REMINDERS, which is an e-newsletter to which consumers may subscribe and that permits subscribers to personalize information listed in the online directory. The online version of THE REAL YELLOW PAGES is a directory of businesses that includes Internet links to additional information, and was first launched commercially in 1997.

BellSouth uses multiple REAL marks on its Internet sites. Mr. Caswell stated the following (Caswell Dep. p. 14-15):

We have several products that we have used. And so we will quite often leverage the REAL mark to differentiate our product.

So, for instance, we have REAL WEB SITES. We have had in the past REAL WEB STORES. We have REAL WEB SAVINGS, REAL WEB AUDIO.

. . .

The REAL WEB SITES product is a product where we will actually go out and design; create; host; maintain; and drive, market and therefore drive, searches to a web site for an advertiser ... [,] any business that has a listing in our site that we then append content to.

BellSouth has partnerships with online entities such as Cox and Yahoo whereby BellSouth provides content for Internet searches.

Additionally, BellSouth has registered many Internet domain names that divert customers to its online products. Examples includes: REALARTS.COM, REALATTORNEYS.COM, REALPAGESSTORES.COM, REALPAGESRESULTS.COM, etc.

BellSouth provides ISP services under the name BellSouth Internet Services; and provides consulting services including content collection and creation of web hosting under the name THE REAL WEB SITE.

Applicant does business exclusively in Canada at this time, although it intends to expand to offer its services in the U.S. Applicant's president, Mr. Vaselenak, described applicant's mark in relation to its services as follows (Vaselenak Dep. P. 23-24):

A: REALCOMMERCE is not intended to be merely a description of commerce services. It's very specifically intended to make ... a statement, an approach, a position, a marketing position, a positioning of what we are offering in the marketplace.

We talk about the real solutions at commerce that we provide for e-commerce as opposed to, if you will, competing solutions that are more along the line of technology looking for a problem. So the use of the word REAL together with COMMERCE is very closely tied to our positioning in the marketplace and our differentiation. It means a lot.

Q: In your advertising you have stated that REALCOMMERCE intends to help "real business" or real businesses. What did you mean by real businesses?

A: Again, this relates to the whole positioning of this by providing real e-solutions to real businesses, that is businesses that are established out there in the non-online world, and therefore are looking for again real solutions, are looking for real commerce.

In his discovery deposition, Mr. Vaselenak described applicant's business model as marketing its services to

third parties who would then bundle applicant's services in a "bundled solution" to their target market, the ultimate purchaser. Mr. Vaselenak also described several business products applicant has available in the Canadian market that are marketed under marks that include the term COMMERCE. Applicant indicated that the cost of applicant's services "ranges from zero to 50,000 Canadian dollars for the initial setup for a client [with] additional fees anywhere from \$200 to \$5,000 per month for operation services, plus negotiated charges for custom setup and/or operation." (Applicant's Answer to Opposer's Interrogatory No. 4.)

Analysis

Likelihood of Confusion

Inasmuch as certified copies of opposer's pleaded registrations are of record, there is no issue with respect to opposer's priority, as to the registered marks and goods or services identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). As to unregistered marks, opposer would, of course, have to prove priority of use for specific goods or services. *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1726 (TTAB 2003)

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors

bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999) and the cases cited therein.

We begin by noting that opposer's witness, Mr. Caswell, testified about numerous marks apparently used by opposer's parent or affiliated companies, for example, IMV, in connection with Internet-based goods and services. To the extent that opposer may be seeking to rely on these alleged common law marks, we note that opposer did not assert these marks in its notice of opposition, nor does the record contain any evidence of particular dates of first use or extent of current use, or examples of how these marks have been used. Further, opposer may not rely on the use of unregistered trademarks by its sister company, IMV, in the absence of any evidence of any license agreement between opposer and IVM, showing that use by IMV is pursuant to

license from opposer. Thus, we consider only opposer's pleaded and established registered marks in determining whether a likelihood of confusion exists.

Turning to consider the registered marks, we note that while we must base our determination on a comparison of the marks in their entireties, we are guided, equally, by the well established principle that, in articulating reasons for reaching a conclusion on the issue of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties." *In re National Data Corp.*, 732 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

We note, initially, that opposer argues in its brief that its marks constitute a "family" of "REAL" marks. However, the notice of opposition does not contain a pleading that opposer has a family of "REAL" marks. The notice of opposition states only that "[o]pposer and its predecessors have adopted and have continuously used the foregoing marks incorporating the word "REAL" as the principal element (the "REAL marks") beginning at least as early as October 16, 1984 ..." (Para. 4). We do not consider this statement or subsequent references throughout the notice of opposition to "the REAL marks" as an allegation

that opposer has a family of "REAL" marks. Nor do we find that this issue was tried by the express or implied consent of the parties. Applicant, not having participated in opposer's taking of testimony, can scarcely be said by opposer to have been put on notice that opposer was trying a family of marks claim; neither can applicant be said to have impliedly consented to trial of such issue.

Opposer alleged that its marks are well known. The evidence in this regard is very limited. Opposer provided no sales figures and only a gross estimate of advertising expenditures with no indication as to whether such expenditures pertained to the pleaded and established marks or to all marks owned by opposer and/or its parent and affiliated companies. Additionally, there is no indication as to public perception of opposer's pleaded and established marks other than the statement that its directories are delivered to all businesses and residences in BellSouth's nine-state region. Therefore, we find that opposer has not established that its pleaded and established marks are famous.

The common element of the parties' marks is the word REAL. In all of the involved marks there is no indication that the REAL portion of these marks has any connotation

other than the ordinary dictionary definition of the word.⁷ We find that this is where the similarities between opposer's marks and applicant's mark end. Not only do the marks look and sound different, but the connotations of opposer's various marks are quite different from the connotation of applicant's mark. Applicant's mark, REALCOMMERCE has a connotation of "doing business," which is somewhat suggestive of its identified services rendered to businesses in the field of electronic commerce.

Opposer's marks have various different connotations, which are either vague or somewhat suggestive of the services rendered in connection with each mark and quite different from the connotation of applicant's mark. For example, opposer's mark REAL TALKING ADS is somewhat suggestive of the identified directory services that include audiotext, or spoken ads. Opposer's mark REAL HELP FOR THE REAL WORLD is a slogan that is somewhat vague in connection with the identified services and it has a very different connotation than REALCOMMERCE; the connotation of the slogan would be of "finding one's way in the world."

We conclude that opposer has not established that the look, sound, connotations and overall commercial impressions

⁷ We take judicial notice of the definition of "real" in *The American Heritage Dictionary* (2nd ed. 1985) as "1. not imaginary, fictional, or pretended: actual. 2. authentic or genuine ..."

of opposer's pleaded and established registered marks and applicant's mark are similar.

With respect to the goods and services of the parties, we find that opposer has not established that its various identified goods and services are sufficiently similar or related to applicant's services that, even if identified by confusingly similar marks, confusion as to source is likely. There is no established relationship between opposer's non-electronic services and applicant's identified services. Nor has opposer established any relationship between its electronic services pertaining to directories and applicant's services. Mere proof that two parties are operating in the online or digital world does not establish that their respective services are related.

Thus, we conclude that, despite establishing its priority as to certain registered marks, opposer has not established that a likelihood of confusion exists between its pleaded and established registered marks and applicant's mark REALCOMMERCE, as used or intended to be used in connection with the respective identified goods and services.

Dilution

As previously concluded, *supra*, opposer has not established that its marks are famous and, thus, it has not established its claim of dilution.

Decision: The opposition is dismissed.