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Mailed: December 29, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Collegetown Relocation, LLC

v.

Garan Services Corp.

Opposition No. 91122058

Robert D. Frawley of Law Offices of Robert D. Frawley for
Collegetown Relocation, L.L.C.

Robert S. Weisbein of Darby & Darby P.C. for Garan Services Corp.

Before Simms, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Holtzman, Administrative Trademark Judge:

An application has been filed by Garan Services Corp.
(applicant) to register the mark COLLEGETOWN on the Principal
Register for the following goods (as amended): "clothing, namely,
shirts, tops, blouses, skirts, pants and jackets."¹

¹ Application Serial No. 75544711 filed on August 31, 1998, based on an
allegation of a bona fide intention to use the mark in commerce.

On January 31, 2001, Collegetown Relocation, L.L.C., (opposer) filed an opposition to registration of the above application. As grounds for opposition, opposer asserts that through its predecessor, Rezun Interactive Concepts, Inc., and opposer's affiliate, Weinberg Management Corporation, opposer is the owner of Registration No. 2011820 for COLLEGETOWN for "providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information involving education and educational institutions";² that through its affiliate, opposer is the owner of Registration No. 1996120 for COLLEGETOWN RELOCATION for "provision of real estate information including availability, locale and description of properties for sale or lease, demographic information of use to persons planning to move their residence or business";³ that since August 12, 1998, opposer has used the mark COLLEGETOWN to identify items of clothing, namely hats, shirts and sweatshirts; that opposer or its affiliate has "actively used the Collegetown name, both via conventional channels and via the Internet" (Notice of Opp., ¶ 5); that opposer "has registered and uses the Internet domain names 'collegetown.com' and 'collegetown.org'" (Id.); and that applicant's mark COLLEGETOWN when used in

² Issued October 29, 1996; Section 8 affidavit accepted.

³ Issued August 20, 1996; affidavits under Sections 8 and 15 accepted and acknowledged. The word "Relocation" has been disclaimed.

connection with applicant's goods is likely to cause confusion with "Opposer's use of its mark for its goods." Notice of Opp., ¶ 9C.

Applicant, in its answer, has denied the salient allegations in the opposition.

The record includes the pleadings; the file of the involved application; opposer's testimony (with exhibits) of Jan R. Weinberg, applicant's vice president; and opposer's notice of reliance on the following: Status and title copies of opposer's pleaded registrations, applicant's responses to certain discovery requests, and copies of printed publications and official records. The record also includes defendant's notice of reliance on opposer's answers to certain discovery requests including portions of the discovery deposition, with exhibits, of Mr. Weinberg. In rebuttal, opposer submitted a notice of reliance on supplemental portions of Mr. Weinberg's discovery deposition and an exhibit applicant had referred to but omitted from its notice of reliance.⁴

Both parties have filed briefs. An oral hearing was not requested.

⁴ In addition, we have considered of record opposer's responses to certain interrogatories which were submitted by opposer with its reply brief and were introduced to address applicant's contention in its brief that such evidence was not produced by opposer during discovery.

Applicant has raised a number of objections to opposer's evidence. Such objections will be considered and the probative value of the subject matter will be weighed accordingly.

As a preliminary matter, opposer has submitted evidence and argument on the unpleaded claim that applicant did not have a bona fide intention to use the mark in commerce as of the filing of the application. Applicant objected to the introduction of this evidence on the ground that opposer failed to either originally plead or amend the pleading to assert the new issue and that, as a result, applicant proffered no evidence in defense of this claim and would therefore be severely prejudiced if the claim were to be heard.

In effect, opposer contends that the issue was tried with the implied consent of applicant and that therefore the pleadings should be deemed amended to conform to the evidence. See Fed. R. Civ. P. 15(b). It is opposer's position that the information contained in its notice of reliance put applicant on notice that opposer intended to assert this claim at trial. Under items 2 and 3 of its notice of reliance, opposer states that it has attached copies of applicant's responses to interrogatories and admission requests. Under item 4, the notice of reliance indicates that responses to opposer's document production requests and the documents produced "are provided to document the absence of documents other than those produced, as admitted by

Applicant in its responses to Opposer's [requests for admissions]." Notice of Reliance, p. 3. Then under item 5 entitled "Printed Publications," opposer states that it has attached the following:

Summary Sheet and copies of Official Records of the [USPTO], Trademark electronic Search Service (TESS), showing trademark registrations applied for by Applicant and abandoned or inactive, submitted to show Applicant's proclivity to file applications to register marks which it does not intend to use in commerce.

Rule 15(b) of the Federal Rules of Civil Procedure provides that when an issue not raised by the pleadings is tried by express or implied consent of the parties, an amendment of the pleadings may be made to conform to the evidence. Because an amendment under Rule 15(b) may be extremely prejudicial in the absence of the express or implied consent of the defending party, fair notice of the claim must be clearly established. See *P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801 (CCPA 1978).

It is not clear from the record that applicant has been given fair notice of this claim, and we believe that any doubt in this regard should be resolved in applicant's favor. See *Oromeccanica, Inc. v. Ottmar Botzenhardt GmbH. & Co. KG*, 223 USPQ 59 (TTAB 1983). The claim cannot be reasonably inferred merely from the attachment of applicant's discovery responses to

the notice of reliance or opposer's broad reference in the notice of reliance to "the absence of documents other than those produced." In addition, opposer's assertion that applicant had a proclivity to file applications without any intent to use is not the same as specifically alleging that applicant had no intent to use the mark herein. Under the circumstances, we do not find that the issue was tried with the implied consent of applicant.

However, even if we did consider this issue to have been tried and the pleadings deemed amended to conform to the evidence, opposer would not prevail on the claim. In support of its claim, opposer points in its brief to applicant's lack of any business or marketing plans with respect to the goods. Opposer notes that in response to opposer's request for such documents, applicant responded, "No such documents exist."⁵ Opposer also points to the 26 applications and registrations purportedly owned by applicant herein as further evidence that applicant "was merely applying for the mark to reserve it." Brief, p. 27.

While the filing of "numerous" or "excessive" intent-to-use applications under certain circumstances "may cast doubt on the

⁵ Applicant's objection to opposer's notice of reliance on documents produced by applicant in response to document production requests is sustained and such documents have not been considered. See Trademark Rule 2.120(j)(3)(ii). However, that rule does not prohibit introduction of a response to a request for production that states that no responsive documents exist. See *NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718 (TTAB 1998).

bona fide nature of the intent" (see *McCarthy on Trademarks and Unfair Competition* (4th ed.) §19:14, quoting Senate Judiciary Committee Report on S. 1883, S. Rep. No. 100-515, pp. 23-24 (Sept. 15, 1988)) such evidence is lacking here. First, opposer has not shown that the filing of 26 applications over the course of a ten year period qualifies as numerous or excessive. Further, it cannot be inferred from this evidence that applicant intended to merely reserve those marks and not to use them. Although they were filed as intent-to-use applications, five of the applications issued into registrations, albeit now cancelled, and two of the applications were subsequently amended to allege use of the marks therein. In addition, at least four other applications are still pending before the office either before the examining attorney or as the subject of oppositions or extensions of time to oppose, and several others were withdrawn by applicant after a nonfinal action issued. See, e.g., *McCarthy on Trademarks and Unfair Competition*, supra at §19:15 (indicating that the withdrawal of applications under certain circumstances can evidence original good faith). Thus, we fail to see how this evidence shows a "proclivity to file applications" which applicant does not intend to use (Notice of Reliance, p. 4), or for that matter the lack of a bona fide intention to use the mark herein.

In addition, although applicant did not produce a business or marketing plan, other discovery responses submitted under opposer's notice of reliance provide sufficient evidence to rebut opposer's claim that applicant lacked a bona fide intention to use its mark in commerce. Those responses indicate that applicant is waiting for this proceeding to be resolved before proceeding further with its plans to use the mark; that applicant had a trademark search conducted before filing the application; and that applicant filed a petition to cancel two registrations for "COLLEGE TOWN CLOTHES" for clothing against a third party to protect its asserted rights in the mark in this case.⁶

Thus, even considering the claim on its merits, opposer has not shown by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark in commerce at the time the application was filed.⁷

⁶ Opposer's contention that the declaration in the application was executed by a representative "who apparently had no knowledge of the facts" (Brief, p. 26) is meritless. As an officer of applicant, Alexander J. Sisterenik was properly authorized to sign the application on behalf of the applicant (See Trademark Rule 2.33(a)) and the fact that Mr. Sisterenik may not have actually "participated" in any decisions regarding the mark does not necessarily mean that he did not have knowledge of such decisions.

⁷ Opposer's alternative request to remand the application to the examining attorney to consider this issue is denied since no facts have been disclosed which would appear to render the mark unregistrable. See Trademark Rule 2.131. Moreover, contrary to opposer's contention, opposer may indeed be estopped from asserting this claim in a later proceeding if it should be determined that opposer could have and should have properly raised the claim in the present proceeding. See *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1494 (Fed. Cir. 2000).

We turn then to the issue of priority and likelihood of confusion.

As general background, Mr. Weinberg testified that he is the owner of a real estate company called Weinberg Management Corporation and through that company began offering real estate services under the mark COLLEGETOWN RELOCATION in February 1995. On June 18, 1998, Collegetown Relocation, L.L.C., was formed to provide those services and the alternate business name "Collegetown" was registered with the State of New Jersey on April 20, 2000. Opposer acquired rights to the pleaded registration for COLLEGETOWN on April 10, 2000 from Rezun Interactive Concepts, Inc. and on July 20, 2000, opposer acquired the Internet domain name "collegetown.com" through which the educational information and real estate information services identified in its pleaded registrations would be provided.

As described by Mr. Weinberg, the collegetown.com website offers three resource directories: 1) the education resource directory which contains a database for college preparation and for college student resources and lists about 1,000 professional educational associations; 2) the "Collegetown Relocation" section, which provides "resources for individuals and companies that are relocating specifically to college town communities and their respective states" including public libraries, chambers of commerce, child care and voter registration information (Test.

Dep., p. 22); and 3) the employment resource directory which contains information on employment resources.

The collegetown.com website became operational on November 7, 2001. Since November 15, 2001, opposer has demonstrated the website for testing purposes to a total of about 250 people, consisting of a beta test group,⁸ members of opposer's advisory board, and certain professional organizations. The website is password protected and has not yet been "launched." Test. Dep., p. 79. Mr. Weinberg estimated that about 20-25 people have requested a password to access the website.

In addition to the use of COLLEGETOWN in connection with services, Mr. Weinberg asserted that opposer uses COLLEGETOWN on clothing to promote its services. On August 12 1998, applicant made its first shipment of certain items of clothing in interstate commerce.

Mr. Weinberg states that the primary market for opposer's goods and services is comprised of high school and college-age men and women, college graduates who are relocating for employment opportunities, and college faculty, administration and staff. There is no evidence of any advertising expenditures

⁸ Opposer did not explain the nature of a "beta test" but *Microsoft Encarta College Dictionary* (2001) defines the term as "a test of a product, especially computer software, by giving it to a few customers to try out before the final version is put on sale."

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associated with opposer's services and Collegetown Relocation L.L.C. has not generated any revenue since its inception in 1998.

Applicant intends to use the mark COLLEGETOWN for wearing apparel, namely shirts, tops, blouses, skirts, pants and jackets, and it filed its intent-to-use application on August 31, 1998. Applicant has not as yet sold any goods under its mark but intends to sell its clothing to mass merchandise, chain and retail stores, and to target all the usual consumers for those goods.

PRIORITY

Opposer has made of record status and title copies of its two pleaded registrations, both showing current status and ownership in opposer. Therefore, opposer's standing has been established, and its priority with respect to the registered marks for the services identified therein is not in issue. King Candy Co., Inc. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Opposer claims that it also has priority of use in COLLEGETOWN for clothing items such as hats and t-shirts that are used to promote its services. In order to establish priority based on common law rights, opposer's burden is to demonstrate by a preponderance of the evidence proprietary rights in COLLEGETOWN for clothing prior to August 31, 1998, the filing date of applicant's intent-to-use application. See, e.g., Eastman Kodak

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Co. v. Bell Howell Document Management Products Co., 994 F.2d 1569, 26 USPQ2d 1912 (Fed. Cir. 1993); NASDAQ Stock Market Inc. v. Antartica S.r.l., 69 USPQ2d 1718 (TTAB 1998); and Corporate Document Services Inc. v. I.C.E.D. Management Inc., 48 USPQ2d 1477 (TTAB 1998). Opposer has not met this burden.

A plaintiff may establish prior proprietary rights in a mark through technical trademark use, that is "use in commerce" as contemplated by Sections 2(d) and 45 of the Trademark Act, or through "nontechnical" use of the designation in connection with a product or service in interstate or intrastate commerce in a manner analogous to trademark use, i.e., through use in advertising, use as a trade name, or any other manner of public use, provided that it is an open and public use of such nature and extent as to create, in the mind of the relevant purchasing public, an association of the designation with the plaintiff's goods or services. See *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981); *Jim Dandy Co. v. Martha White Foods, Inc.*, 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); and *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216 (TTAB 1992). See also *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996); and *In re Cedar Point, Inc.*, 220 USPQ 533 (TTAB 1983).

It is opposer's contention that it has prior technical trademark use of COLLEGETOWN on clothing. It is also apparently

opposer's contention that even if its use of the COLLEGETOWN mark does not constitute technical trademark use, it should be construed as prior use analogous to trademark use.

Technical trademark use on goods requires a bona fide sale or transportation of the goods in commerce made in the ordinary course of trade and not merely to reserve a right in a mark. See Section 45 of the Trademark Act. Thus, a mere token sale or shipment of the goods, even if made in interstate commerce, does not constitute "use" under the Trademark Act. See *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1774 (TTAB 1994) (noting that the purpose of the Trademark Law Revision Act of 1988 was to eliminate "token use" as a basis for registration, and that the new, stricter standard contemplates instead commercial use of the type common to the particular industry in question).

Accordingly, we turn to the circumstances surrounding opposer's use of COLLEGETOWN on clothing prior to the August 31, 1998 constructive use date of applicant's intent-to-use application.

Mr. Weinberg testified that in August 1998 he had three hats and three t-shirts embroidered with COLLEGETOWN at a kiosk in a mall. On August 12, 1998, Mr. Weinberg shipped a single hat and shirt from Princeton, New Jersey to Jennifer T. McNamee at her business office in Valley Forge, Pennsylvania. Ms. McNamee was a

personal friend of Mr. Weinberg as well as a member of the advisory board of opposer's company.⁹

In a letter sent with the hat and shirt, Mr. Weinberg said "I hope you like this first draft of the 'hat idea'" and asked Ms. McNamee to let him know,

... what you and Bernie [Ms. McNamee's husband] think[] about these items. At this time we are only giving them to a few people but we would appreciate artistic comments because we will be doing greater production someday and we want to get it right.

Mr. Weinberg testified that this letter was to be a memorialization of the fact that he shipped the Collegetown hat and shirt in interstate commerce.

On August 24, 1998, Ms. McNamee responded with her comments on the items in a letter written on her personal letterhead, and attached a photograph of her husband wearing the clothing. She states in her letter,

... The font that you use for Collegetown needs to be consist [sic] with your letterhead. If you don't want to spend the money to have these embroidered (usually expensive), you should explore silk screening. ...

A single shipment in commerce may be sufficient to constitute use in commerce within the meaning of the Trademark

⁹ Mr. Weinberg explained that the advisory board was formed in 1998 and consists of about 15 members of "[v]arious individuals that we've assembled that we asked if we can ask them advice periodically." (Disc. Dep., p. 124). Mr. Weinberg states that he selected people "who were involved in community service projects who understood volunteerism in a community." Id.

Act provided that the shipment was a bona fide commercial transaction in the ordinary course of trade. As stated in *McCarthy on Trademarks and Unfair Competition*, supra at §19:118, "[a] formal "sale" is not necessary if the goods are "transported" in commerce. ... It seems clear that "transportation," as an alternative to "sale," requires the same elements of open and public use before potential customers. Thus, purely intra-company shipments only for in-house experimentation, evaluation or preparation do not constitute bona fide shipments to satisfy the "transportation alternative." [citations omitted].

We do not view this single shipment of a hat and shirt to Ms. McNamee on August 28, 1998 as a bona fide commercial transaction in the ordinary course of trade. We find instead that it was a token, albeit interstate, shipment that was done merely to reserve a right to use the mark on clothing at some future time. The two items of clothing were sent to Ms. McNamee, not as an actual or potential customer for the goods, but rather to consult with her, either as a personal friend or business associate, regarding the artistic merit of the mark's design. Thus, this was merely a private rather than a public use of the mark made in preparation for offering the goods for sale, the

implication being that opposer would proceed to market the clothing if Ms. McNamee's comments were favorable.¹⁰

As further evidence that the first shipment of clothing was mere token use, this transaction was not followed by any genuine continuing effort or intent to engage in commercial use.¹¹ In fact, at least two and half years passed during which time opposer did virtually nothing to put any clothing on the market.¹² Opposer did not sell or distribute any clothing during that time period. Moreover, opposer admittedly had no formal business or marketing plans with respect to clothing in effect during this time (Resp. to Doc. Req. No. 7), and only the vaguest, if any,

¹⁰ Opposer's reliance on *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986) is misplaced. That case was decided prior to the Trademark Law Revision Act when token transactions were accepted provided there was an accompanying intent to engage in subsequent continuing commercial use. Token use is no longer acceptable and, in any event, as discussed infra, opposer has not demonstrated an accompanying intent to engage in subsequent continuing commercial use.

¹¹ In order to establish priority, opposer is required to only show prior use, not continuous use of its mark. See *West Florida Seafood Inc. v. Jet Restaurants Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994). Moreover, since there is no affirmative assertion by applicant that the mark, even if used, has been abandoned by opposer, the issue of abandonment is not before us either. Thus, we have construed the parties' arguments regarding "continuous" use of the mark as relating to the question of whether opposer's first shipment of clothing was token use.

¹² Any evidence of the promotion of opposer's services, or vague references to plans to use the mark on promotional materials other than clothing, is irrelevant to the question of whether opposer has made any effort to market clothing.

informal plans to commercially market those goods.¹³ Compare, e.g., *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 390 F.2d 1015, 157 USPQ 55 (CCPA 1968) (in the eighteen months between the first and subsequent sales the applicant conducted marketing and advertising tests and otherwise prepared to merchandise its products on a national scale).

Mr. Weinberg admitted that COLLEGETOWN was not in use on clothing during this two and a half year period,¹⁴ citing as the reason that he "hesitated to interfere with the rights or potential rights of other companies." Test. Dep., p. 56. Specifically, Mr. Weinberg pointed to a company called Cliftex that "held two marks" for clothing for "College Town Clothes," a company named Interco that had a state registration for "College Town" in New York for clothing, and the existence of the present application. Test. Dep., p. 56. The extent of his investigation into the use by Cliftex and Interco consists of his attempt "in 1998" to "find phone numbers for [those companies] but could not find them." Test. Dep., p. 57.

¹³ For example, a document prepared by Mr. Weinberg in 1995 entitled "Rough List to Precede a Developed Outline" and in notes he took during a seminar on intellectual property in 1996 contain passing references to "merchandising" in connection with clothing.

¹⁴ In response to the question "So, would you agree with me, would you not, that from August of 1998 through ...April of 2001, you didn't distribute any hats or tee shirts bearing the Collegetown mark," Mr. Weinberg responded, "Yes. Though it is possible that we might have given away a gift here or there." Disc. Dep., p. 172

This argument fails to justify or overcome the token nature of the initial shipment, and moreover is undermined by Mr. Weinberg's earlier answer to applicant's interrogatory (no. 1(b)) asking for "the reason for such discontinuance" which does not even allude to potential rights of others as a reason for delaying commercial use.¹⁵ Instead, Mr. Weinberg stated:

Opposer's use of the mark COLLEGETOWN for clothing has not been continuous. Opposer is a small, start-up business and following its first use of the mark COLLEGETOWN on clothing in August of 1998, Opposer occupied itself with a number of related activities, namely developing the COLLEGETOWN website, and securing assignment of registration No. 2011820 for COLLEGETOWN, and developing quality, American manufacturing sources for its clothing products.

Following this two and half year period of inactivity, opposer claims to have given away approximately 140 hats, t-shirts, and sweatshirts. The testimony concerning this distribution is vague and undocumented and it is not clear exactly when the distribution occurred, over what period of time, or the number of people to whom these goods were distributed. The extent of Mr. Weinberg's testimony regarding this distribution is as follows: "They have been given to persons

¹⁵ We also find this contention somewhat inconsistent because opposer proceeded to make its first shipment of clothing while fully aware that Cliftex owned two federal registrations for "COLLEGE TOWN CLOTHES" for clothing (i.e., Reg. No. 1145829 issued January 13, 1981 and Reg. No. 518308 issued December 6, 1949). Test. Dep., p. 89. In addition, we note that a petition to cancel the two Cliftex registrations was not filed until November 8, 1999, a year after Mr. Weinberg's unsuccessful attempt to "find them," and it was applicant, not opposer who filed it.

visiting our office, they have been mailed to persons in New Jersey, New York State, Florida, Massachusetts, [and] Texas."

Test. Dep., p. 50.

No further transactions occurred until February 12, 2002, when opposer listed a single "COLLEGETOWN" t-shirt for sale on eBay. This sale was followed by three more auctions, taking place on April 24, 2002, June 1, 2002, and October 4, 2002. Each auction listed a single t-shirt for sale and each t-shirt received three or fewer bids and ultimately sold for \$10 or less. Mr. Weinberg admitted that these sales were made for the purpose of "testing out several of our designs." Test. Dep., p. 51.

Thus, the record as a whole shows nothing more than sporadic and nominal sales or shipments of clothing over a five-year period, from 1998 to the time of trial in 2003, further reinforcing our finding that the initial shipment of clothing was token use.¹⁶

As pointed out in Paramount Pictures Corp., supra at 1773, even under the more lenient standard in effect prior to November 16, 1989 (the effective date of The Trademark Law Revision Act) when token use was accepted, "trademark rights were not created by sporadic, casual, and nominal shipments of goods bearing a mark. Rather, there had to be a trade in the goods sold under

¹⁶ Even assuming the distribution of 140 items of clothing did occur, it would not change our finding that the initial shipment of clothing was merely token use.

the mark, or at least an active and public attempt to establish such a trade, in order for a trademark (and registrable rights) to exist." See also, e.g., *La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 181 USPQ 545 (2nd Cir. 1974) (89 perfume bottles sold over a 20-year period constituted sporadic and nominal usage); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983) (rights not established or maintained by sporadic, nominal shipments interspersed with long periods of inactivity); *Lever Brothers Co. v. Shacklee Corporation*, 214 USPQ 654 (TTAB 1982) (sales of \$10.40 over four years are sporadic non-commercial token sales); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982) (initial shipment in interstate commerce of a jar of cold cream costing \$1.27 followed by no further sales for four years insufficient).

Not only do we find that the initial shipment of clothing does not constitute technical trademark use, but further that the shipment and any associated activities are far from adequate to confer priority based on use analogous to trademark use.¹⁷ See,

¹⁷ The only relevant pre-sales activities for purposes of establishing priority for clothing are those occurring prior to the filing of the opposed application and those associated with clothing. Activities taking place after filing date and/or relating to the promotion of opposer's services, to the extent there were any such activities, are irrelevant to this determination.

Opposer has attempted to introduce evidence that its predecessor, Rezun Interactive Concepts, Inc., engaged in promotion of the mark on clothing (i.e., an e-mail communication, a photograph, the results of an Internet search and a *Newsweek* article). Applicant's objection to

e.g., T.A.B. Systems v. PacTel Teletrac, supra (no evidence was presented from which to infer that a substantial share of the consuming public had been reached).

LIKELIHOOD OF CONFUSION

Thus, we turn to the question of likelihood of confusion between applicant's mark COLLEGETOWN for clothing and opposer's marks COLLEGETOWN and COLLEGETOWN RELOCATION for the educational information and real estate information and relocation services identified in opposer's pleaded registrations.¹⁸ Here, as in any likelihood of confusion analysis, we look to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), giving particular attention to the factors most relevant to the case at hand, including the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d)

this evidence is well taken as there is no foundation for the evidence and/or it constitutes inadmissible hearsay.

¹⁸ In its notice of opposition, opposer has alleged likelihood of confusion only based on use of its COLLEGETOWN marks for goods, i.e., wearing apparel. We find that the issue of likelihood of confusion based on the services identified in the pleaded registrations was tried with the implied consent of applicant, as applicant made no objection to the evidence on this issue and moreover, has addressed the issue on the merits in its brief. Thus, the notice of opposition is considered amended under Fed. R. Civ. P. 15(b) to include a claim of likelihood of confusion with regard to opposer's pleaded services.

goes to the cumulative effect of differences in the essential characteristics of the goods [and/or services] and the differences in the marks.")

Applicant's mark COLLEGETOWN is identical in all respects to opposer's mark COLLEGETOWN in Registration No. 2011820 and is identical to the dominant portion of the mark COLLEGETOWN RELOCATION in Registration No. 1996120. The disclaimed word RELOCATION is descriptive of opposer's services and therefore of little value in distinguishing one party's mark from the other. See, e.g., *Hilson Research Inc. v. Society For Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

Our primary reviewing court has held that when marks are identical but neither suggestive nor descriptive of the goods or services associated with them, the first *du Pont* factor weighs heavily against the applicant. In *re Majestic Distilling Co.* 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003) citing *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 1566, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Suggestive marks, on the other hand, are accorded a more limited scope of protection than arbitrary marks. See *Shoe Corporation of America v. The Juvenile Shoe Corporation of America*, 266 F.2d 793, 121 USPQ 510 (CCPA 1959).

In this case, there is no question that the term "COLLEGETOWN" is suggestive. The term clearly identifies or refers to the market to which opposer's educational and real

estate information services are directed. Mr. Weinberg acknowledges the suggestive meaning of the two-word term "college town" describing it as "any community that hosts a higher education facility, whether it's two-year colleges, four-year colleges, graduate school [sic]." Disc. Dep., p. 47. Mr. Weinberg states that "[i]t was our intention to provide relocation services through the Internet for just college town communities" (Disc. Dep., p. 57) and further that "we have information on approximately 2000 college towns in the country and not doing other communities, just college town communities." Disc. Dep., p. 37. Mr. Weinberg also notes that the cities of Baltimore, Maryland and Ithaca, New York are nicknamed "Collegetown." Resp. to Int. No. 14.

Contrary to opposer's contention, the suggestive meaning of the term is not overcome by compressing the two words "college" and "town" into the single term "collegetown." See, e.g., In re SPX Corp., 63 USPQ2d 1592 (TTAB 2002).

However, it is opposer's apparent contention that its marks have achieved some degree of strength and recognition in the relevant market. Opposer states that it has used "COLLEGETOWN" through its predecessor since 1995; that opposer sent out e-mails to the 1000 educational associations that are posted in the "education resource directory" of its website and received 100 e-mail responses to its offer to provide free links to their

websites; that opposer visited ten associations in the Washington DC area in 2002 and sent follow-up "COLLEGETOWN" promotional material to those associations; that opposer is a member of several business and professional organizations such as the U.S. Chamber of Commerce and the Better Business Bureau under its business name "Collegetown"; that opposer has engaged in the development of COLLEGETOWN promotional items; and that opposer has policed its COLLEGETOWN marks.

In order to establish market recognition, the evidence must be sufficient to at least permit an inference of wide exposure of the mark to the relevant public and an inference that the exposure has been effective in creating recognition. See, e.g., *In re Ennco Display Systems Inc.*, supra and *In re Recorded Books Inc.*, 42 USPQ2d 1275 (TTAB 1997). Opposer's evidence in this regard is insufficient.

It is clear that the COLLEGETOWN marks have had minimal public exposure in the relevant market. Evidence of any activity under the marks in connection with opposer's services prior to opposer's offer of the services on its website in November 2001 is inadmissible and/or too vague to be of any probative value.¹⁹ Most of the 250 or so people who have accessed the website since that time, i.e., the focus group, opposer's advisory board, and

¹⁹ We noted earlier, among other things, that opposer's evidence of use of COLLEGETOWN by its predecessor is inadmissible hearsay.

some professional organizations, have done so only for the purpose of testing the website and then only at opposer's request.²⁰ Public access to the website is password protected and actual public use has been minimal, numbering 20-25 users at best, a negligible portion of opposer's entire market.²¹ Opposer's advertising expenditures are nonexistent and opposer's COLLEGETOWN business has not generated any revenue since its inception in 1998.

In addition, there is no evidence that the 100 organizations that agreed to allow opposer to provide links to their websites were motivated by recognition of opposer's marks or anything other than the opportunity to essentially advertise their organizations free of charge on opposer's website.²²

²⁰ When asked on cross-examination "Except for the few here and there this is the entire universe of people who have had access to your website, correct?" Mr. Weinberg responded "Yes." Test. Dep., p. 75.

²¹ Opposer argues that it is unable to specify the exact number of users because "opposer has a strict privacy policy and does not track visitors or use 'cookies'." Reply Brief, p. 11. However, it is opposer's burden to produce evidence on this issue. The reason for its inability to do so is not relevant. Moreover, this contention is contradicted by Mr. Weinberg's statement, in his discovery deposition, to the effect that the website does in fact keep track of visitors to its website. Disc. Dep., p. 66.

²² We have already found that opposer's promotional use of COLLEGETOWN on clothing was minimal, and to the extent opposer is claiming use or distribution of "Collegetown" on promotional items other than clothing such as stationery, business cards, and pencils, without information as to the extent of any such distribution and where and to whom these items were distributed, this evidence is not meaningful. Opposer's long lists of phone calls, meetings, e-mails, office visits, etc. "whereby each of the people whom we met with have heard us introduce ourselves as Collegetown" (Test. Dep., p. 68) are hearsay and in any

Finally, we note that although opposer was aware of the existence of the two Cliftex registrations for "COLLEGE TOWN CLOTHES" for clothing in 1998, the fact that opposer took no action with respect to those registrations (it was applicant, not opposer, that filed the petition to cancel on November 8, 1999) tends to detract from any claim that opposer has diligently policed its mark.

We find the evidence as a whole falls far short of indicating strength and recognition of COLLEGETOWN in opposer's market.

We turn then to the question of whether applicant's goods and opposer's services are sufficiently related and/or whether the circumstances surrounding the marketing of the goods and services are such that purchasers encountering them would, in view of the similarity of the marks, mistakenly believe that the goods and services emanate from the same source. See *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978) and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978). Even if the marks are identical, if these conditions do not exist, confusion is not likely to occur. See, e.g., *Nautilus Group Inc. v. ICON Health and Fitness Inc.*, 372 F.3d 1330, 71

event far too speculative to merit any weight on the issue of public recognition of the mark. Opposer has also submitted a list of its "collegetown" domain names but Mr. Weinberg admitted that none of these websites, except collegetown.com, is operational. Test. Dep., p. 108.

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USPQ2d 1173 (Fed. Cir. 2004); In re Unilever Limited, 222 USPQ 981 (TTAB 1984); and In re Fesco, Inc., 219 USPQ 437 (TTAB 1983).

Opposer's educational and real estate information services and applicant's wearing apparel, are vastly different goods and services and opposer has failed to show that they are related. Despite any overlap in purchasers, there is no persuasive evidence that such purchasers would expect these vastly different goods and services to emanate from the same source.

Opposer argues that the goods and services are related, contending that the use of marks on collateral products is a common promotional practice. Opposer relies on such cases as In re Phillips-Van Heusen Corporation, 228 USPQ 949 (TTAB 1986) and on evidence purporting to show that collateral products such as clothing are used to promote a diverse range of primary goods and services.

First, the mere fact that use of marks on collateral products such as clothing may be a common practice does not mean that clothing is related to every other conceivable product and service as a matter of law. The question is whether purchasers would perceive the goods and services herein as emanating from the same source. See Shen Manufacturing Co., Inc. v. The Ritz Hotel Limited, ___F.3d___, ___USPQ2d___(Fed. Cir. 2004). Further, an important factor in the cases cited by opposer was the fame or renown of the marks. See, e.g., General Mills Fun

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Group, Inc. v. Tuxedo Monopoly, Inc., 204 USPQ 396, affirmed 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) ("MONOPOLY"); NASDAQ Stock Market Inc. v. Antartica S.r.l., 69 USPQ2d 1718 (TTAB 1998) ("NASDAQ"); Turner Entertainment Co. v. Nelson, 38 USPQ2d 1942 (TTAB 1996) ("GILLIGAN'S ISLAND"); and In re Phillips-Van Heusen, supra ("21 CLUB"). Obviously, a famous mark is more likely to be associated by the purchasing public with a greater breadth of goods or services. See Dan Robbins & Associates, Inc. v. Questor Corp., 559 F.2d 1009, 202 USPQ 100 (CCPA 1979).

Opposer's evidence is similarly unpersuasive, most of it appearing to relate to the use of well known or famous marks on collateral goods. In any event, none of the evidence has been properly introduced and to the extent applicant has objected to the evidence, its objections are well taken. The evidence consists of a typed list of purported third-party websites which "have a merchandise section" (Test. Dep., p. 39, Ex. 2); a typed list of purportedly registered and pending marks for Class 25 goods (clothing); pages of typed lists of purportedly pending and registered marks (that include notations indicating whether Class 25 was "not found" in the application or registration and fail to specify any of the goods or services offered under the marks), accompanied by copies of photographs of each company's asserted mark on various items of clothing; copies of photographs of various design logos on clothing items; pages of design logos

with the typed wording "When you see [logo] on a shirt, you think [company name]"; and copies of photographs of nine t-shirts bearing logos which Mr. Weinberg states "that we purchased." Test. Dep., p. 40.

At a minimum, the mere listing of third-party registrations and applications is insufficient to properly make them of record. Opposer should have submitted copies of the official records themselves, or the electronic equivalent of those records. See *In re Smith and Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). The evidence is otherwise completely lacking in foundation (it is unknown who prepared any of the lists or took the photographs, or how, when or where they were obtained) and opposer has in any event omitted significant information about the listed applications and registrations, most notably the goods and services.

We note that applicant has objected to the website listings only "beyond the allegation that these web sites do indeed contain a merchandise section." Brief, p. 29. Even so, the evidence is unpersuasive since there is no indication as to the nature of the products sold in those "merchandise sections" or the nature of any logos allegedly used on those products. Opposer contends that the listing includes six real estate companies. However, at least four of those websites appear to be tied to the well known REALTOR mark. The merchandise sold at

those websites could very well display the REALTOR mark and not the affiliated real estate company name.²³

Opposer's claim that it has "bridged the gap" because it has actually used the COLLEGETOWN mark on clothing must fail as well. As stated in *Charles of the Ritz Group, Ltd. v. Quality King Distributors, Inc.*, 832 F.2d 1317, 4 USPQ2d 1778, 1782 (2d Cir. 1987), this factor turns on whether the two companies are likely to compete in the same market. Applicant's clothing, as identified in the application, would be sold in all the usual outlets for such goods. Opposer's clothing, on the other hand, to the extent it is offered at all, is not offered through the usual trade channels. It is acquired from opposer at opposer's offices or through its own website.²⁴ Thus, opposer has not competed in applicant's intended market. Nor has opposer presented any evidence that it intends to do so. Moreover, as discussed earlier, there is no persuasive evidence of any genuine intent by opposer to expand into the clothing field.

In view of the foregoing, and considering the suggestive nature of opposer's marks and the absence of any persuasive

²³ Opposer contends that applicant itself is affiliated with a real estate company. There is no competent evidence of this alleged relationship in the record or of the services that company allegedly provides and moreover, no evidence that any such real estate services are provided under the same mark as clothing.

²⁴ As noted earlier, opposer has sold four t-shirts on eBay but there is no indication of any intention to continue such sales and no evidence that eBay is a normal trade channel for wearing apparel.

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evidence that clothing on the one hand and educational and real estate information services on the other are related goods and services, the protection of opposer's COLLEGETOWN marks should not extend beyond opposer's services to clothing.

Thus, we find that the contemporaneous use of the marks in connection with the respective goods and services is not likely to cause confusion.

Decision: The opposition is dismissed.