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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sun Microsystems, Inc.
v.
Glen Ballard

Opposition No. 91153401
to Application Serial No. 75484938
filed on 5/14/1998

Connie L. Ellerbach and Hoang-chi Truong of Fenwick & West
for Sun Microsystems, Inc.

Robert A. Becker of Fross Zelnick Lehrman & Zissu, P.C. for
Glen Ballard.

Before Seeherman, Zervas and Walsh, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

Sun Microsystems, Inc. (opposer) has opposed the
application by Glen Ballard (Applicant) to register the mark
JAVA RECORDS in standard characters for services identified
as "entertainment services, namely, providing information
about music, musical performers, and recent sound recordings
via a web site on a global computer network" in
International Class 41 and "computer services, namely,

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providing an on-line bulletin board in the field of music and entertainment, and providing links to related web sites of others" in International Class 42.¹ Applicant alleges both first use of the mark anywhere and first use of the mark in commerce as to both classes in 1997. Applicant has disclaimed "RECORDS."

As grounds for the opposition, opposer asserts priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), as to Applicant's JAVA RECORDS mark and opposer's JAVA mark, and several variations of the JAVA mark. Opposer asserts that it has used and registered its JAVA marks for a wide range of computer and Internet-related goods and services.² In his answer Applicant denied the essential allegations in the notice of opposition. Opposer filed a brief. Applicant did not file a brief.

The record consists of the file related to the JAVA RECORDS application, the pleadings and four notices of reliance filed by opposer. One notice of reliance includes status and title copies of opposer's JAVA registrations discussed below. Applicant did not submit any evidence.

¹ Application Serial No. 75484938 filed May 14, 1998.

² In the notice of opposition opposer also refers to "dilution," but opposer failed to pursue a dilution ground in its brief. Accordingly, we conclude that opposer has abandoned the dilution ground, and we have not considered it.

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Because opposer has pleaded and shown that it owns registrations for the JAVA marks, opposer has established standing. *See generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987).

Priority is not at issue in this proceeding, again because opposer has made of record valid and subsisting registrations for its JAVA marks which it owns. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Section 2(d) of the Trademark Act precludes registration of an applicant's mark "which so resembles a mark registered in the Patent and Trademark Office... as to be likely, when used on or in connection with the goods of the applicant, to cause confusion..." 15 U.S.C. § 1052(d). The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods and services of the parties. *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) goes to the cumulative effect of differences in the essential

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characteristics of the goods and differences in the marks.”).

Below we will consider each of the factors as to which opposer presented evidence or argument. Before proceeding to do so we note that, under one of its notices of reliance, Opposer submitted a copy of Requests for Admissions under FED. R. CIV. P. 36 which opposer had served on Applicant during discovery. Opposer states that Applicant failed to respond to the requests and applicant relies on these admissions, which must be deemed to be admitted, along with other evidence, to establish certain facts, for example, that the goods and services of the parties are related and that the goods and services of the parties move in similar trade channels. See Opposer’s Brief at 22-23. We have considered Applicant’s admissions with regard to factual matters, but in addition there is independent evidence other than the admissions sufficient to support the findings of fact necessary to support our final conclusion regarding likelihood of confusion.

In reaching our ultimate conclusion regarding likelihood of confusion, we have not considered applicant’s admission that there is a likelihood of confusion in this case. Requests for admissions are a discovery device and cannot be used to elicit admissions as to the questions of

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law in the case. *Harco Laboratories, Inc. v. The Decca Navigator Company Ltd.*, 150 USPQ 813, 814, n.2 (TTAB 1966).

Opposer has pleaded and provided status and title copies of thirteen currently active JAVA registrations it owns. These registrations alone provide a sufficient factual basis for the essential conclusions in this case. The registrations which are properly of record are the following:

Registration No. 2178784 for the mark JAVA in standard-character form for goods identified as "computer programs for use in developing and executing other computer programs on computers, computer networks, and global communications networks, and instruction manuals sold therewith; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks, and instruction manuals sold therewith" in International Class 9;

Registration No. 2298389 for the mark JAVA in standard-character form for services identified as "electronic transmission of data over a global communication network" in International Clas 38;

Registration No. 2242938 for the mark HOTJAVA in standard-character form for goods identified as "computer programs for use in developing and executing other computer programs on computers, computer networks, and global communications networks, and instruction manuals sold therewith; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks, and instruction manuals sold therewith" in International Class 9;

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Registration No. 2304483 for the mark JAVABEANS in standard-character form for goods identified as "Computer programs for use in developing and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in viewing other computer programs on computers, computer networks and global communications networks" in International Class 9;

Registration No. 2501545 for the mark JAVA COMMUNITY PROCESS with "COMMUNITY PROCESS" disclaimed for services identified as "information technology development and consulting services and software development and consulting services" in International Class 42;

Registration No. 2277260 for the mark shown below with "COMPATIBLE" disclaimed:



for goods identified as "computer programs for use in developing, compiling and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks, and global communications networks; and computer operating systems programs" in International Class 9;

Registration No. 2582470 for the mark JAVA COMPATIBLE in standard-character form with "COMPATIBLE" disclaimed for goods identified as "computer software for use in connection with computer networks, and global communications networks and instruction

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manuals sold as a unit therewith" in International Class 9;

Registration No. 2453367 for the mark JAVA DEVELOPER CONFERENCE in standard-character form with "DEVELOPER CONFERENCE" disclaimed for services identified as "arranging and conducting trade shows in the fields of computer and information technology" in International Class 35 and "arranging and conducting educational conferences" in International Class 41;

Registration No. 2137780 for the mark JAVAONE in standard-character form for services identified as "arranging and conducting trade shows in the fields of computer and information technology" in International Class 35 and "arranging and conducting educational conferences" in International Class 41;

Registration No. 2574003 for the mark shown below:



for goods identified as "computer hardware; computer peripherals; computer operating system programs; computer utility programs; computer programs for recording, processing, receiving, reproducing, transmitting, modifying, compressing, decompressing, broadcasting, merging, and/or enhancing sound, video, images, graphics, and/or data; computer programs downloadable from global communications networks; computer programs for use in developing, compiling, and executing other computer programs on computers, computer networks, and global communications networks; computer programs for use in navigating, browsing, transferring information, and distributing and viewing

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other computer programs on computers, computer networks, and global communications networks" in International Class 9;

Registration No. 2416017 for the mark JAVA SCRIPT in standard-character form for goods and services identified as "computer programs, namely, utility programs, language processors and interpreters" in International Class 9 and "providing computer programs, namely, utility programs, language processors and interpreters, that may be downloaded from a global computer network" in International Class 42;

Registration No. 2453383 for the mark JAVASERVER in standard-character form for goods and services identified as "computer software, namely, server computer software and computer software for creating other computer software and instruction manuals sold therewith" in International Class 9 and "providing computer software, namely computer server software and computer software for creating other computer software that may be downloaded from a global computer network" in International Class 42; and

Registration No. 2357860 for the mark JAVAWORLD in standard-character form for services identified as "computer services, namely, providing on-line publications, namely, brochures, catalogs and pamphlets in the fields of computer and information technology" in International Class 42.

We have listed all registrations opposer relies on for completeness and to demonstrate the scope of the rights opposer asserts here. However, for purposes of our analysis of likelihood of confusion we confine our discussion to the first two registrations. These registrations include the mark which is most relevant, that is, JAVA in standard

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characters, and also the goods and services which are most relevant.

First we compare the marks of the parties. In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

While we must consider the marks in their entireties, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... 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. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Applicant's mark is JAVA RECORDS with "RECORDS" disclaimed. Opposer's Registrations Nos. 2178784 and 2298389 are for the mark JAVA in standard characters. Disclaimed wording, which is not distinctive, is less significant when comparing the marks. *In re Dixie*

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Restaurants, Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1534 (Fed. Cir. 1997). Applicant has disclaimed "RECORDS" in his application, a term which is not distinctive as applied to the identified services. Thus, the inclusion of "RECORDS" in Applicant's mark is insufficient to distinguish Applicant's mark from opposer's JAVA marks. Accordingly, when we consider Applicant's JAVA RECORDS mark and opposer's two JAVA marks in their entireties, we conclude that the marks of the parties are highly similar.

Based on the record before us, opposer's JAVA mark also appears to be arbitrary; there is no evidence of any third-party use. Therefore, we conclude that opposer's JAVA mark is a strong mark for purposes of evaluating likelihood of confusion.

Next we consider whether or not the goods and services of the parties are related and whether the trade channels for the respective goods and services are similar. The goods and services of opposer and Applicant need not be identical to find a likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods or services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). See also *On-Line Careline*

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Inc. v. America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and services and the channels of trade for the goods and services, we must consider the goods and services as identified in the application and registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 177 USPQ at 77 ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Also, the proper inquiry is not whether the goods and services could be confused, but rather whether the source of the goods and services could be confused. *Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 186 USPQ 476, 480 (CCPA 1975); *In re Rexel, Inc.*, 223 USPQ 830, 831 (TTAB 1984).

In evaluating these factors, we have considered principally (1) Applicant's admissions regarding these matters and (2) the goods and services identified in the application and opposer's registrations. Each, by itself, provides a sufficient independent basis for us to conclude that the goods and services of the parties are related and that the trade channels are similar.

Opposer submitted under a notice of reliance twenty-five articles which it asserts to be "printed publications" under Trademark Rule 2.122(e) to show that the parties' goods and services are related and that the channels of trade are similar. However, we cannot consider any printed publications submitted in this manner for proof of the facts asserted in the printed publications, as opposer urges us to do here. *See Logicon, Inc. v. Logisticon, Inc.*, 205 USPQ 767, 768 n.6 (TTAB 1980). *See Generally* TBMP § 704.08 (2d ed. 2003). The articles are hearsay and merely serve as evidence that the content appeared and that the public was exposed to that content.

Furthermore, most of the articles appear to be from wire services. Generally, wire service materials are not available to the public in places such as libraries. Accordingly, they are not proper subject matter for submission under a notice of reliance as "printed publications." *See* TBMP § 704.08 (2d ed. 2003) and cases

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cited therein. Therefore, we have considered only those articles which appeared in publications which appear to be available to the public and only for appropriate purposes related to "printed publications" under our rules. Also, we have not found it necessary to rely on the articles to reach any conclusions in this case.

With regard to the admissions, opposer's Request No. 2 states, "Admit that JAVA RECORDS Products/Services are similar to, or at least related to, the products or services bearing Opposer's JAVA-Based Marks." Request No. 3 states, "Admit that the Applicant sells, offers, or plans to sell or offer JAVA RECORDS Products/Services in the same, or overlapping, Channels of Trade as products or services bearing Opposer's JAVA-Based Marks." Request No. 4 states, "Admit that the Applicant sells, offers, or plans to sell or offer JAVA RECORDS Products/Services to the same or overlapping, End-Users as products or services bearing Opposer's JAVA-Based Marks." Based on these admissions, together with opposer's definitions of terms accompanying the admissions, we conclude that the goods and services of the parties are related and that the channels of trade for those goods and services are similar.

While these admissions alone are sufficient to reach these conclusions, we have also considered the identifications of goods and services in the application and

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opposer's registrations to reach our conclusions regarding these factors. Here too, based on the wording in the identifications alone, we conclude that the goods and services of the parties are related and that the trade channels are similar.

Applicant identifies its services as follows:

entertainment services, namely, providing information about music, musical performers, and recent sound recordings via a web site on a global computer network in International Class 41 and

computer services, namely, providing an on-line bulletin board in the field of music and entertainment, and providing links to related web sites of others in International Class 42.

Opposer's JAVA registrations on which we have focused our discussion are as follows:

Registration No. 2178784 for the mark JAVA in standard-character form for goods identified as "... computer programs for use in navigating, browsing, transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks..." in International Class 9; and

Registration No. 2298389 for the mark JAVA in standard-character form for services identified as "electronic transmission of data over a global communication network" in International Class 38.

We focus on these registrations because they provide the most obvious examples of the close relationship between the goods and services of the parties. Applicant's identified services, as identified, are information services

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rendered online or over global computer networks limited to the music field. Opposer's Registration No. 2298389 covers "electronic transmission of data over a global communication network." Thus, in at least this instance, opposer's broadly identified services actually encompass the applicant's more narrowly identified services.

The mode of offering the respective services is identical, that is, online or through computer/communications networks. In Registration No. 2298389 there is no restriction as to subject matter. The "data" identified in the registration could include the type of content applicant identifies. The *Microsoft Computer Dictionary* (5th ed. 2002) defines "**data**" as follows: "n. Plural of the Latin *datum*, meaning an item of information. In practice, *data* is often used for the singular as well as the plural form of the noun."³ Thus, the data or "information" could include information in the music field. Registration No. 2298389 is for JAVA alone, a mark we have concluded is highly similar to Applicant's JAVA RECORDS mark.

Also, Registration No. 2178784 covers goods including "computer programs for use in navigating, browsing,

³ The Board may take judicial notice of dictionary definitions. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

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transferring information, and distributing and viewing other computer programs on computers, computer networks and global communications networks..." Here too, the computer programs identified are not restricted in a way which would limit their uses. Thus, the uses could include uses with services of the type identified in the application. Here too, the mark covered by the registration is JAVA alone, a mark we concluded to be highly similar to Applicant's mark. We find the goods identified in this registration related to the services Applicant identified.

In addition to concluding that the goods and services of the parties are overlapping or related, we also conclude, based on the same analysis, that the channels of trade for the goods and services of the parties are similar and that the services of the parties could be rendered to the same potential consumers. The common trade channels are most evident in the overlapping services we identified above.

Based on Applicant's admissions opposer also argues that there is actual consumer confusion. Opposer's Request No. 12 states, "Admit that Applicant is aware of instances of actual consumer confusion as to the source, origin or sponsorship as a result of its use of JAVA RECORDS." While we deem the factual matter delineated in this request admitted based on Applicant's failure to respond, we ascribe no probative value to the admission. It lacks sufficient

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clarity or specificity as to the marks or matters as to which actual consumer confusion exists. Accordingly, we have not accorded any probative value to the admission regarding actual consumer confusion in our determination of likelihood of confusion.

Also, based on Applicant's admissions, opposer argues that applicant acted in bad faith in adopting the JAVA RECORDS mark. Specifically, Request Nos. 8 and 9 relate to admissions that Applicant knew of opposer prior to the adoption of the JAVA RECORDS mark and Request No. 13 includes an admission that "Applicant adopted the JAVA RECORDS Mark with the intent of trading on the good will of Opposer." Again, while we deem the factual matters covered by these requests admitted as a result of Applicant's failure to respond, we accord no probative value to the admissions. The admissions regarding Applicant's knowledge of opposer are lacking in specificity. Furthermore, a determination of bad faith requires a legal conclusion based on those facts. *See, e.g., Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). Again, we cannot rely on admissions stating legal conclusions. *Harco Laboratories, Inc. v. The Decca Navigator Company Ltd.*, 150 USPQ at 814, n.2. We find the admissions in this case insufficient to reach any legal conclusion regarding bad

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faith. Accordingly, we have not considered bad faith as a factor in this case.

Finally, based on all evidence of record in this proceeding bearing on the *du Pont* factors, we conclude that there is a likelihood of confusion between Applicant's JAVA RECORDS mark as applied to the identified services and opposer's JAVA marks as applied to the goods and services identified in opposer's Registration Nos. 2178784 and 2298389 for JAVA in standard characters. In the case of these two registrations and the application, the marks of the parties are highly similar and the goods and services of the parties are overlapping or closely related.

Decision: The opposition is sustained on the grounds of likelihood of confusion. Registration is refused.