

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Mailed: May 21, 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Duke University

v.

Duke Publishing and Software Corporation, Inc.

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Opposition No. 91162560

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Vedia Jones-Richardson of Olive & Olive, P.A. for Duke
University.

Gregory Scott Smith of Gregory Smith & Associates for Duke
Publishing and Software Corporation, Inc.

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Before Seeherman, Drost and Cataldo,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Applicant, Duke Publishing and Software Corporation,
Inc., has applied to register on the Principal Register the
mark shown below based upon its allegation of a bona fide
intent to use the mark in commerce for the following goods
and services, as amended:¹

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¹ In an interlocutory order issued on April 8, 2005, the Board deferred until final hearing applicant's December 20, 2004 unconsented motion to amend the identification of goods and services in its involved application. Inasmuch as the proposed amendment limits the goods and services as previously recited, it

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Printed matter, namely books, workbooks, journals, worksheets, instructional materials, and organizer systems relating to the subject of parenting, parental skills, parental experiences, child care information and guidance, and families and not relating to sports or a sports team; books, workbooks, journals, worksheets, and organizer systems for child education all not relating to sports or a sports team; books, journals, and organizer systems for child medical records, all not relating to sports or a sports team,

in International Class 16; and

Online retail store services featuring goods and services of general interest to parents not relating to sports or a sports team; dissemination of advertising for others via the Internet, such services relating to the subjects of parenting, parental skills, parental experiences, child care information and guidance, and families and not relating to sports or a sports team; promoting the goods and services of others by providing hypertext links to the web sites of others, such services relating to the subjects of parenting, parental skills, parental experiences, child care information and guidance, and families and not relating to sports or a sports team; promoting the goods and services of others by means of operating an on-line shopping mall with links to the retail web sites of others, such services relating to the subjects of parenting, parental skills, parental experiences, child care information and guidance, and families and not relating to sports or a sports team,

in International Class 35.²

hereby is approved and entered. See Trademark Rule 2.71(a); and *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993).

² Application Serial No. 76515242 was filed on May 19, 2003.



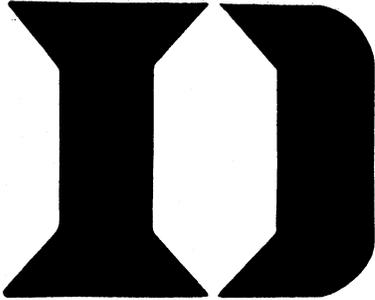
Registration has been opposed by opposer, Duke University. As grounds for opposition, opposer asserts that it is the owner of numerous marks, previously used and registered on the Principal Register, including the following:



for, *inter alia*,

business card holders, pens, pencils, sets containing pens and pencils, desk top accessories; namely, pens, pencils, pen and pencil sets, blotters, paperweights and desk top calendars, paperweights, book ends, stationery, playing cards, paper napkins, cardboard gift boxes, paper bags, decals, stickers, filler paper, notepads, notebooks, clipboards, stationery type portfolios, memorandum boards, calendars, address books, paper coin holders, and paper diploma cases

in International Class 16;³



for "key chains made primarily of metal" in International Class 6, "tables" in International Class 20, and "scarves, hats, socks, shirts, sweaters and pants" in International Class 25;⁴



for "note cards, note pads, stationery and bookmarks" in International Class 16;⁵ and

DUKE UNIVERSITY STORES

in typed or standard character form for

³ Registration No. 1724999 issued on October 20, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

⁴ Registration No. 1707766 issued on August 18, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

⁵ Registration No. 1731046 issued on November 10, 1992. Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

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retail store and mail order services in the field of clothing, furniture, toys, games, sports equipment, school and office supplies, educational materials, computers, books, photography, housewares, towels, floor coverings, jewelry, ornaments, stationery, prints, camping equipment, pennants, decals, memorabilia, items bearing Duke University trademarks, and items depicting Duke University or its students, faculty, or campus life

in International Class 35.⁶

Opposer argues that it has used its registered marks in connection with, *inter alia*, the above listed goods and services since prior to any date upon which applicant may rely for purposes of priority of use of its involved mark; that applicant's mark, when used on applicant's goods and services so resembles opposer's marks for its recited goods and services as to be likely to cause confusion, to cause mistake, and to deceive; and that opposer will be damaged thereby.

Applicant's answer consists of a general denial of the allegations in the notice of opposition.⁷

Opposer attempted to take discovery, but applicant did not provide any responses. Specifically, opposer has established that it timely served on applicant 70 specific

⁶ Registration No. 1702350 issued on July 21, 1992 with a disclaimer of "STORES." Section 8 affidavit accepted; Section 15 affidavit acknowledged. Renewed.

⁷ In addition, applicant asserted "affirmative defenses" that are more in the nature of amplifications of its denial of the salient allegations of the notice of opposition.

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requests for admission, as well as interrogatories and requests for production. During its testimony period, opposer timely filed a notice of reliance, introducing thereby status and title copies of its pleaded registrations and a copy of its requests for admission.⁸

Only opposer filed a brief on the merits of the case. In view of applicant's effective admission of opposer's requests for admission, we sustain the opposition.

Opposer's requests for admission cover all the integral issues on which opposer has the burden of proof as plaintiff in this proceeding. Specifically, applicant was asked to admit, among other things, the following:

Opposer is the owner of its pleaded registrations;

Opposer's registrations are presently valid and subsisting;

Opposer's first use of its registered marks in connection with its recited goods and services is prior to applicant's first use of its mark;

At the time applicant adopted its mark, it was aware of opposer, as well as opposer's goods and services;

⁸ Opposer also submitted with its notice of reliance copies of the interrogatories and requests for production it served on applicant. Answers to interrogatories may be made of record by notice of reliance, while documents produced in response to a document production request may not be made of record in this manner. See Trademark Rules 2.120(j)(3)(i) and 2.120(j)(3)(ii). In this case, these discovery requests were not submitted for their evidentiary value, but only to show that they were served on applicant and that applicant did not respond to them. We have considered them only for this purpose.

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Applicant's mark is substantially similar to opposer's pleaded marks;

The goods and services recited in opposer's registrations and applicant's application are substantially similar;

Applicant's goods and services are provided to the same customers through the same channels of trade; and

"Not all of the purchasers of Applicant's Goods and Services are sophisticated consumers."

Applicant has not denied opposer's contentions that the requests for admission were timely served, received by applicant, and not responded to by applicant. Further, applicant did not, in any way, contest or object to opposer's filing of its notice of reliance. Because applicant failed to respond to opposer's requests for admission, each of the requests is deemed admitted by applicant. See Fed. R. Civ. P. 36(a), made applicable to this proceeding by Trademark Rule 2.116(a), 37 C.F.R. §2.116(a) ("The matter is admitted unless, within 30 days after service of the request, or within such shorter or longer time as the court may allow or as the parties may agree to in writing, subject to Rule 29, the party to whom the request is directed serves upon the party requesting the admission a written answer or objection addressed to the matter, signed by the party or the party's attorney.")

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Any matter admitted under Federal Rule 36 "is conclusively established unless the court on motion permits withdrawal or amendment of the admission." See Fed. R. Civ. P. 36(b). See also *American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C.*, 930 F.2d 1117, 19 USPQ2d 1142, 1144 (5th Cir. 1991) ("An admission that is not withdrawn or amended cannot be rebutted by contrary testimony or ignored by the district court...."). The prejudice that would fall upon opposer if we were to ignore applicant's admissions is manifest, for opposer clearly relied on the admissions and did not offer any other evidence at trial other than certified copies of its pleaded registrations. See *American Automobile Ass'n*, 19 USPQ2d at 1145.

Applicant's admissions establish opposer's standing, insofar as applicant has admitted that the involved marks are substantially similar, that the goods and services are substantially similar, and that both parties' goods and services move in the same channels of trade and are sold to the same consumers. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999) (opposer must show that it has a direct and personal stake in the outcome of the opposition and a reasonable basis for its belief that it will be damaged). See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002) (opposer held to

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have established its standing by its presentation of evidence regarding its ownership of pleaded registrations and evidence "sufficient to show that its likelihood of confusion claim is not wholly without merit").

Moreover, because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks therein and goods and services covered thereby. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Finally, we turn to the issue of likelihood of confusion, which is assessed using the factors that were articulated by one of our primary reviewing court's predecessors, the Court of Customs and Patent Appeals, in the case of *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). See also *Recot, Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In any likelihood of confusion analysis, two key, although not exclusive, considerations are the similarities of the marks and the similarities of the goods and 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) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks").

As noted above, applicant has admitted that its

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involved mark is substantially similar to the marks in opposer's pleaded registrations, that the goods and services also are substantially similar, and that both parties' goods and services move in the same channels of trade and are sold to the same consumers. Applicant has also admitted that purchasers of the involved goods and services are not limited to sophisticated consumers.⁹ Accordingly, we find a likelihood of confusion to exist.

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

⁹ We note that applicant, in the "affirmative defenses" included with its answer, asserts that it has made prior use of its mark; that its mark, as well as its goods and services, differ from those in opposer's pleaded registrations; and that its goods and services are sold to sophisticated purchasers. However, applicant remains bound by its admissions which it did not seek to withdraw or amend.