

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

Mailed: May 7, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

AT&T Delaware Intellectual Property, Inc., f/k/a BellSouth
Intellectual Property Corporation

v.

Owl Marketing, Inc.

Opposition No. 91168395

Theodore H. Davis Jr. of Kilpatrick Stockton LLP for AT&T
Delaware Intellectual Property, Inc., f/k/a BellSouth
Intellectual Property Corporation.

Daryl Michalik, President and CEO, for Owl Marketing, Inc.

Before Bucher, Bergsman, and Ritchie de Larena,
Administrative Trademark Judges.

Opinion by Ritchie de Larena, Administrative Trademark
Judge:

Owl Marketing, Inc. filed an application for the mark
ADWATCH, in standard character format, for services
identified as "application service provider (ASP) featuring
software in the field of advertising effectiveness
measurement and analysis for online businesses" in
International Class 42.¹

¹ Application No. 78292037, filed August 25, 2003, under Section
1(a) of the Trademark Act of 1946, 15 U.S.C. §1051(a), and
subsequently amended to an intent-to-use application under
Section 1(b).

AT&T Delaware Intellectual Property, Inc., f/k/a BellSouth Intellectual Property Corporation, opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). Specifically, opposer alleged that applicant's mark is likely to cause confusion with opposer's mark ADWATCH for "business services, namely providing telephone call frequency and distribution information in the form of detailed reports to advertisers" in International Class 35 and for "telecommunications services, namely, routing telephone calls made to a subscriber's number based on origin of call, time of day, day of week and percentage of distribution, capturing caller identification, tracking distribution of calls and providing reports to the subscribers based on such tracking" in International Class 38.²

Applicant denied the essential allegations in the notice of opposition, and asserted the affirmative defense of abandonment. Applicant additionally filed a counterclaim to cancel opposer's pleaded registration on the ground of abandonment. Opposer denied the essential allegations in the counterclaim.

² Registration No. 2079787, issued July 15, 1997. Sections 8 and 15 affidavits accepted and acknowledged.

Opposer filed a brief in this proceeding.³ Applicant did not. For the reasons discussed herein, we dismiss the counterclaim for cancellation with prejudice and we sustain the opposition.

Evidentiary Issues

A. Opposer's Status and Title Copy of its Pleaded Registration

Opposer submitted a plain copy of its pleaded registration via Opposer's Notice of Reliance, filed during the testimony period for opposer's case-in-chief. That copy of the registration did not include the current status and title information as required by Trademark Rule 2.122(d), 37 CFR §2.122(d). Opposer later submitted a proper status and title copy of its trademark registration via Opposer's Second Notice of Reliance on February 20, 2007, during the time period allotted for opposer's rebuttal testimony as plaintiff in the opposition and testimony period as defendant in the counterclaim. However, in a subsequent order dated July 5, 2007, the Board retroactively suspended the proceedings in this case to January 11, 2007, at which date applicant had filed a Motion to Compel. Although

³ Opposer filed its brief on May 4, 2007. Opposer then filed a Renewed Trial Brief on December 27, 2007, noting its change of name. The Board accepted the Renewed Trial Brief by order dated February 18, 2008, which also noted that applicant had not submitted a brief.

denying Applicant's Motion to Compel as untimely, the order indicated that Opposer's Second Notice of Reliance was filed during a time that the proceedings should have been -- and were retroactively -- suspended, and that therefore:

"Inasmuch as opposer's testimony period had closed, this evidence will be given no consideration."

In this final decision on the merits, we determine that the equities weigh in favor of accepting the status and title copy of opposer's pleaded registration into the record. A pleaded registration should be submitted during the party's testimony period per Trademark Rule 2.122(d)(2), 37 CFR §2.122(d)(2). In this case, opposer submitted the status and title copy during the time period of its rebuttal testimony in the opposition proceeding, which was also opposer's testimony period as defendant in the cancellation proceeding. Applicant has not objected to the evidence as improper rebuttal. In its discretion, the Board may accept improper rebuttal evidence if the other party does not object and the equities otherwise dictate the propriety of entering it into the record. *See Set Products, Inc. v. Construction Products, Inc.*, 208 USPQ 842, 846 (TTAB 1980) (rebuttal testimony by petitioner establishing priority should have been offered during case-in-chief, but was nevertheless accepted by Board since respondent did not object).

Applicant was clearly on notice of the pleaded registration, particularly as it was the subject of applicant's counterclaim for cancellation. Furthermore, opposer has otherwise established priority of its common law usage via testimony and evidence. Accordingly, applicant is not unduly prejudiced by our decision to accept the status and title copy of opposer's pleaded registration.

B. Other Documents Submitted with Opposer's and Applicant's Notices of Reliance

Both applicant and opposer attempted to submit improperly authenticated evidence via their various notices of reliance. Opposer's notices of reliance included website printouts; samples of its marketing materials; copies of its product plans; market research and sales reports; and other documentation related to opposer's ADWATCH service. Applicant, for its part, included its own responses to opposer's interrogatories; website printouts; and marketing information for services rendered by both applicant and by opposer under the ADWATCH mark.

None of these documents are appropriately submitted via a notice of reliance. There is no provision in the Trademark Rules of Practice for filing websites or the marketing materials of parties through a notice of reliance. See Trademark Rule 2.122(e), 37 CFR §2.122(e), which provides for the filing of printed publications and official records through a notice of reliance.

With respect to applicant's responses to opposer's written discovery filed by applicant, only the inquiring party may introduce responses to interrogatories through a notice of reliance. Trademark Rule 2.120(j)(5), 37 CFR §2.120(j)(5).

To the extent some of the documents included in the parties' notices of reliance were properly authenticated during the testimony deposition of Laurel MacKenzie, we consider them accordingly. For those that were not, we give them no consideration. Trademark Rule 2.122(e), 37 CFR §2.123(i) ("Evidence not obtained and filed in compliance with these sections will not be considered.").

The Record

By operation of law, the record includes the pleadings and the files for applicant's application and opposer's registration. Trademark Rule 2.122(b), 37 CFR §2.122(b). The record also includes the following testimony and evidence:

A. Opposer's Evidence.

1. Notice of Reliance on applicant's responses to opposer's interrogatories.
2. Opposer's Second Notice of Reliance on the status and title copy of opposer's pleaded trademark registration.
3. Opposer's Third Notice of Reliance on a series of name changes by opposer from BellSouth Intellectual Property

Corporation to AT&T Delaware Intellectual Property, Inc. as documented via recorded assignments at the Trademark Office.

4. The testimony deposition of Laurel Mackenzie, Senior Product Manager at BellSouth, with attached exhibits.⁴

B. Applicant's Evidence.

Notice of Reliance on opposer's responses to applicant's interrogatories.

Standing

A party has standing to oppose a registration under Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063 if that party can demonstrate that it has a real interest in the proceeding (*i.e.*, a direct and personal stake in the outcome of the proceeding). *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-1026 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). Opposer has submitted a status and title copy of its pleaded registration, which we accept in accordance with the section on "Evidentiary Issues," *supra*. Opposer has also testified as to the use of its ADWATCH mark over at least the past six years. (Mackenzie

⁴ The Board observes that counsel at the MacKenzie deposition read an opening statement into the record, stating, among other things: "We would like to designate this deposition as confidential in its entirety." However, since the deposition was submitted to the TTAB without a designation of confidentiality, it is public record, and we treat it as such.

dep. at 21:8-15 and 23:3-4). Therefore, opposer has established its standing to oppose applicant's registration. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ 185 at 189. Meanwhile, applicant's standing to counterclaim for cancellation is established by virtue of the opposition proceeding. *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478 (TTAB 2007) (applicant subject to opposition has inherent standing to counterclaim for cancellation); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492 (TTAB 2005) ("Applicant, by virtue of its position as defendant in the opposition, has standing to seek cancellation of the pleaded registrations," citing *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999)).

Applicant's Counterclaim to Cancel Opposer's
Pleaded Registration

Applicant has not provided any evidence to support its counterclaim for cancellation. In fact, applicant introduced evidence that opposer has used its ADWATCH mark continuously in commerce since 1995. (Opp.'s Resp. to Inter. No. 5). Opposer has also produced evidence of significant revenues (Mackenzie dep. at 21:8-15) and advertising expenses (Mackenzie dep. at 23:3-4) associated with its ADWATCH mark over the past six years. Therefore,

lacking proof of abandonment of opposer's ADWATCH mark, the counterclaim for cancellation is dismissed with prejudice.

Priority

Because opposer's registration has been made of record, Section 2(d) priority is not an issue with respect to the services identified in opposer's registration. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1506 (TTAB 2007). In any event, as indicated *supra*, opposer has introduced testimony regarding its prior use of ADWATCH. (Mackenzie dep. at 21:8-15 and 23:3-4). Applicant further submitted evidence that opposer has used the ADWATCH mark in connection with the services indicated on the certificate of registration continuously since 1995. (Opp.'s Resp. to Inter. No. 5).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities or dissimilarities between the marks and the similarities or

dissimilarities between the goods or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The Similarity or Dissimilarity of the Marks
in their Entireties.

We first consider and compare 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). In this case, the marks are identical. The Board therefore finds that the first *du Pont* factor weighs heavily in favor of finding a likelihood of consumer confusion.

The Similarity or Dissimilarity
and Nature of the Services, Channels of Trade, and
Classes of Consumers

Preliminarily, we note that the greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and registrant's goods or services necessary to support a finding of likelihood of confusion. *In re Opus One, Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001); *In re Concordia International Forwarding Corp.*, 222 USPQ 355, 356 (TTAB 1983).

Furthermore, it is not necessary that the services at issue be similar or competitive, or even that they move in the same channels of trade to support a holding of

likelihood of confusion. It is sufficient instead that the respective services are related in some manner, and/or that the conditions and activities surrounding the marketing of the services are such that they would or could be encountered by the same persons under circumstances that could, because of the similarity of the marks, give rise to the mistaken belief that they originate from the same producer. See *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978).

Applicant is seeking registration for a service that measures "advertising effectiveness" for clients. Opposer's registration covers a service "providing telephone call frequency and distribution information in the form of detailed reports to advertisers"; and "routing telephone calls made to a subscriber's number." Specifically, opposer's ADWATCH service tracks incoming calls made by the public to its ADWATCH subscribers in response to their targeted advertisements. (MacKenzie dep. at 11:17-25; 12:1-22) First, opposer provides its subscribers with a virtual number to use in their advertising materials. (MacKenzie dep. at 13:20-25; 14:1-5). Opposer then tracks all calls dialed into that virtual number, and provides the ADWATCH subscriber with information about the call, including the time of the call; the calling party's phone number; the status and duration of the call; the name of the caller; and

the caller's originating zip code. (MacKenzie dep., Exs. 3 and 7). Opposer provides this information to its ADWATCH subscribers in a detailed tracking report. (MacKenzie dep. at 11:17-25; 12:1-8).

In sum, opposer's ADWATCH service provides a means for ADWATCH subscribers to measure the demographics of potential consumers that call in response to specific ads, thereby allowing the subscribers to focus their advertisements on targeted groups. (MacKenzie dep. at 30:1-7). Likewise, applicant's "advertising effectiveness" ADWATCH service provides subscribers with a report on "clicks, conversions, sales, and ROI for any online ad, and for natural search keywords." (MacKenzie dep., Ex. 9).

Although applicant contends that its services are provided via the Internet while opposer's services are provided via telephone thereby somehow differentiating their respective services for measuring advertising effectiveness, opposer has produced probative evidence that it relies heavily on the Internet both for marketing (MacKenzie dep. at 21:1-22) and for actual services provided under its ADWATCH mark. (MacKenzie dep. at 15:13-25; 16:1-25; 17:1-22) Furthermore, nothing in opposer's registration precludes it from targeting online or other businesses for opposer's ADWATCH service. In the absence of specific limitations in the registration, we must presume that both parties'

services will travel in all normal and usual channels of trade and methods of distribution and be sold to all classes of consumers. *Squirtco v. Tomy Corporation*, 697 F.2d 1038, 216 USPQ 937 (Fed. Cir. 1983). Thus, evidence that applicant will target only certain types of businesses, or that opposer will not, cannot be considered. *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986).

Since the parties' respective services, channels of trade, and classes of consumers overlap, the second, third and fourth *du Pont* factors weigh in favor of finding that there is a likelihood of consumer confusion.

Balancing the Factors

Considering all of the evidence of record as it pertains to the *du Pont* factors, we conclude that a likelihood of confusion exists because the marks are identical, they are used on highly similar and even overlapping services, they are likely to be sold through the same channels, and they are likely to target the same consumers. Accordingly, the opposition is sustained.

Decision: The counterclaim for cancellation is dismissed with prejudice, and the opposition is sustained. Serial No. 78292037 is refused registration.