

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

Mailed:
December 12, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The American Education Corporation

v.

School Specialty, Inc.

Opposition No. 91173861 to application Serial
No. 78630775 filed on May 16, 2005

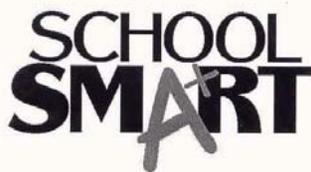
Grant C. Aguirre and Jerry J. Dunlap II of Dunlap Law
Office, P.C., for American Education Corporation.

Nicholas A. Kees and Kristi J. Hinner of Godfrey & Kahn,
S.C. for School Specialty, Inc.

Before Drost, Zervas and Wellington, Administrative
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

School Specialty, Inc. ("applicant") is the owner of an
application filed on May 16, 2005 for registration of the
mark

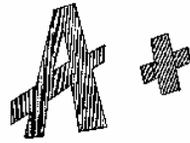
The logo for "SCHOOL SMART" features the word "SCHOOL" in a bold, sans-serif font above the word "SMART". The letter "A" in "SMART" is stylized with a large, grey, handwritten-style letter "A" overlaid on it, creating a layered effect.

Opposition No. 91173861

on the Principal Register for goods in several International Classes, including "educational software featuring instruction on mathematics, language arts and science; tape recorders; boom boxes; headphones; jack boxes; projectors; time clocks; calculators; blank CD's and DVD's; blank cassettes; blank diskettes; CD and cassette storage boxes; printer stands; mouse pads; mice; keyboards; microscopes, including electric microscopes; binoculars; batteries; curriculum kits comprised of software featuring instruction on mathematics, language arts and science and instructional books sold as a unit; magnets; graduated rulers" in International Class 9.¹ Applicant has asserted a bona fide intent to use the mark in commerce under Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), and has entered a disclaimer of SCHOOL and a statement providing that the stippling in the mark is for shading purposes only.

The American Education Corporation ("opposer") has filed a notice of opposition to registration of applicant's mark for the goods in International Class 9 only. In the notice of opposition, opposer alleged that it is the owner of Registration No. 1535032 for the mark

¹ The application also recites goods in International Classes 2, 8, 12, 15, 16, 18, 20, 21, 25, 27, 28 and 35.



for "educational pre-recorded computer program on a variety of scholastic subjects designed for students from elementary grades to college level" which issued on April 18, 1989 on the Principal Register ("A+ mark");² that it has priority of use; that applicant's mark is likely to be confused with its mark; and that applicant's use and registration of its mark will dilute the distinctive quality of opposer's A+ mark.

Applicant has denied the salient allegations of the notice of opposition. Both parties have filed briefs.

The Record

In addition to the file of application Serial No. 78630775 and the pleadings, the record includes opposer's two notices of reliance introducing (i) the declaration of Thomas A. Shively, Executive Vice President and Chief Operating Office of opposer, and exhibits thereto including a certified copy of pleaded Registration No. 1535032 establishing that the registration is subsisting and owned by opposer; and (ii) a copy of applicant's answers to opposer's interrogatories. Additionally, the record includes applicant's single notice of reliance introducing

² Registration No. 1535032, alleging February 1, 1983 as the date of first use and date of first use in commerce. The registration

(i) the declaration of David Zasada, Director of the "School Smart" product line of applicant, and exhibits; (ii) the declaration of James T. Berger, a faculty member at Roosevelt University and principal of James T. Berger/Market Strategies, a strategic marketing communications and consulting firm, who conducted a telephone survey at applicant's request, with one exhibit consisting of his survey report; and (iii) opposer's answers to applicant's interrogatories.³

Evidentiary Questions

The parties have submitted the testimony of various individuals through declarations pursuant to a notice of reliance. The Trademark Rules do not provide for the submission of testimony by means of a notice of reliance. See Trademark Rule 2.122, 37 CFR § 2.122, and TBMP 704.02 (2d ed. rev. 2004) regarding notices of reliance. However, TBMP § 705 states that parties may stipulate that the "testimony of a witness may be submitted in the form of an affidavit by the witness." Although the record does not contain any stipulation providing for the submission of testimony through a declaration, because both parties have

includes a statement that the mark is lined for the color red. Section 9 affidavit accepted, Section 15 affidavit acknowledged.
³ The stated "hypothesis and rationale" tested by Mr. Berger in the survey was "(1) purchasers of school or classroom supplies were unlikely to reside in the same channels of trade as purchasers of school or classroom software products; (2) there is

Opposition No. 91173861

submitted testimony pursuant to the notice of reliance procedure, and because both parties in their briefs have identified the declarations as being part of the record, we find through their actions that they have agreed that testimony may be submitted by declaration. We therefore have not stricken the declarations because they were filed via the notice of reliance procedure.

Opposer has objected to Mr. Berger's declaration on the basis that the "identity of James T. Berger as an expert qualified to perform a consumer survey and the results of such survey were not made known to Opposer until the filing of the Applicant's Notice of Reliance." Reply at p. 4. We see no reason why the parties apparent agreement to submit testimony by declaration should not extend to expert testimony and opposer has not pointed out why Mr. Berger does not have the qualifications to provide expert testimony. Thus, we decline to strike Mr. Berger's declaration but give it the weight it is due, which is not much in view of the deficiencies in the survey noted below.

Standing/Priority

Because the record contains a status and title copy of pleaded Registration No. 1535032, showing that the registration is in full force and effect and owned by opposer, opposer has established its standing to oppose

virtually no confusion as to the source of the Opposer's A+

registration of applicant's mark and its priority is not in issue. See *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

The Goods

We first examine the similarity or dissimilarity of the parties' goods, considering the goods as they are described in the identifications of goods in the application and registration. See *Paula Payne Products Co. v. Johnson Publishing Co., Inc.*, 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Registration of an entire class of goods may be refused if

brand." Berger dec. ex. 1 at ¶ 9.

Opposition No. 91173861

one or more of the goods in an International Class are similar when the applied-for mark is likely to cause confusion with an asserted mark.

Applicant's identification of goods includes "educational software featuring instruction on mathematics, language arts and science" and opposer's identification of goods is "educational pre-recorded computer program on a variety of scholastic subjects designed for students from elementary grades to college level." Applicant's educational software concerning mathematics, language arts and science is encompassed within opposer's educational pre-recorded computer programs on a variety of scholastic subjects.

Applicant's identification of goods also recites "curriculum kits comprised of software featuring instruction on mathematics, language arts and science and instructional books sold as a unit." Because such kits include software and the software is an important part of the kits which evidently contain only two items, we find that these goods are similar.

In view of our findings, we resolve the *du Pont* factor regarding the similarity of the goods in opposer's favor.

Trade Channels/Classes of Purchasers

The parties' respective identifications of goods in the application and the registration do not contain any

limitations with respect to trade channels or classes of purchasers. We therefore presume, as we must, that opposer's educational computer programs and applicant's educational software and kits containing educational software are marketed in the same trade channels to the same classes of purchasers. *Kangol Ltd. v. KangaROOS U.S.A., Inc.*, 974 F.2d 161, 23 USPQ2d 1945, 1946 (Fed. Cir. 1992) ("There is no evidence that opposer's and applicant's goods are currently being sold in the same channels of trade. Yet, in neither the applicant's application nor the opposer's registrations are the trade channels in any way restricted. The issue of likelihood of confusion is resolved by considering the 'normal and usual channels of trade and method of distribution.'") (Citations omitted). Indeed, Mr. Berger, in his report regarding the survey he conducted, allowed that "there is a small overlap" in trade channels, ostensibly referring to the overlap in trade channels concerning the software and computer programs. Berger dec. ex. 1 at ¶ 16.

Applicant has argued that the trade channels are different because "Opposer's goods are a narrow category of educational materials" and applicant's goods "range from mouse pads to microscopes to rulers"; and that "a consumer seeking classroom supplies such as headphones, calculators, mouse pads, batteries or microscopes would not look to a

company that sells specialized computer software programs for specific learning needs." Brief at p. 13. The problem with applicant's argument is that it ignores the fact that applicant's software falls within opposer's identification of goods. The trade channels, at least for applicant's educational software and kits containing educational software, are presumed to be identical to opposer's trade channels. We may resolve the *du Pont* factor regarding trade channels in opposer's favor based on these goods, even if the trade channels for applicant's other goods differ from the trade channels of opposer's goods.

Applicant also relies on Mr. Berger's survey in arguing that the trade channels differ. Mr. Berger questioned purchasers in schools of "school supply-type products" to determine in part whether the parties' goods travel in the same trade channels. He concluded that "the purchaser of school supplies is highly unlikely to be the purchaser of educational software ..." (Emphasis added.) Berger dec. ex. A ¶ 8. Mr. Berger has not properly determined the universe of purchasers of the parties' goods - he has identified purchasers as only those who purchase or are "responsible for purchasing supplies for his/her school." See "Interviewer Instructions," Berger dec. ex. B. While such individuals are among the purchasers of opposer's and applicant's goods, they are certainly not limited to them;

opposer's and applicant's identifications of goods are not restricted to particular channels of trade. Purchasers of both opposer's and applicant's products may include members of the general public who purchase educational software in department stores, retail stores featuring electronic goods or even in toy stores. For this reason alone, Mr. Berger's conclusions regarding trade channels are entitled to limited weight.⁴

The presumptive common channels of trade and classes of purchasers therefore weigh in opposer's favor.

The Marks

We now turn to the marks. We must determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The A+ in applicant's mark appears prominently within the term SMART in a style very similar to that of opposer's mark. The crossbar in each letter "A" is inclined, the lettering style of each A+ is similar, and both plus signs are raised, slightly rotated, and to the right of each

⁴ Mr. Berger also states that participants in the survey were "selected through lists of schools generated on-line through Google and Yahoo"; and a "total of 200 interviews took place." Berger dec. ex. A ¶ 8. He has not identified the nature of the schools. Also, it is unclear whether the individuals interviewed represent a cross-section of purchasers of school or classroom supplies or, for example, are only from one geographic area.

Opposition No. 91173861

letter "A." Both A+s have the impression of being on a slant. Even though there are other letters in applicant's mark, by including the A+ prominently in the lower word SMART (which is in thicker lettering than the term SCHOOL, thereby emphasizing the term SMART), we find that overall, the marks are similar in appearance. Further, the connotation of both marks is excellence.⁵ Because of the prominence of the A+ in applicant's mark and the similar connotation of the marks, we find too that the marks are similar in commercial impression. By including the A+ in its mark in a style similar to opposer's A+, consumers, which include members of the general public, when encountering applicant's mark, would likely consider applicant's goods to be sponsored by, associated with or authorized by opposer. Indeed, the record reflects that opposer owns registrations for marks with A+ embedded within a word in such marks, just as is the case with applicant's mark. See A+DVANCED LEARNING SYSTEM (Registration No. 2038215) for "educational computer programs ..." and A+NYWHERE LEARNING SYSTEM (Registration No. 2488551) for "downloadable electronic educational materials" Regarding the sound of the marks, opposer has not offered evidence on how consumers

⁵ Applicant maintains that A+ "is commonly associated with education, as it is the highest mark that can be obtained by a student in a class. It is also used often to suggest a high level of quality or service" Brief at p. 15.

would pronounce applicant's mark, and it is likely that the "+" portion of applicant's mark would not even be pronounced at all. However, any differences in sound are eclipsed by the similarities in appearance, meaning and commercial impression of the marks. In view of the foregoing, and because (i) a "[s]ide by side comparison is not the test," *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973), (ii) the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks, *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975), and (iii) "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines," *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we find that the marks are more similar than dissimilar.

Thus, the *du Pont* factor regarding the marks is resolved in opposer's favor.⁶

⁶ Mr. Berger's conclusion that "the A+ brand as a product of the American Education Corporation has no recognition[] in the school supplies purchasing channel of trade" is of little relevance. Opposer's registered mark is entitled to all of the presumptions of Trademark Act Section 7(b), 15 U.S.C. § 1057(b), including its validity and of opposer's exclusive right to use the registered mark in commerce on the goods specified in the registration. Also, whether purchasers know the identity of the owner of a mark is irrelevant to the likelihood of confusion analysis.

Third-Party Marks/Strength

Applicant argues that opposer's mark deserves only a narrow scope of protection in view of applicant's "search of federally registered trademarks and allowed or published applications ... [numbering] more than 75 marks ..." Brief at p. 16. Applicant has not introduced its search results, the applications or the registrations into the record, thus its argument is without evidentiary support and not persuasive. Even if it had submitted such applications and registrations, its argument would not be persuasive because applications are "incompetent as proof of anything other than the fact that [] an application for registration was filed in the Patent Office," *Zappia-Paradiso, S.A. v. Cojeva Inc.*, 144 USPQ 101, 102 n.4 (TTAB 1964), and third-party registrations are not evidence of use of the marks shown therein, and, therefore, are not proof that consumers are familiar with said marks so as to be accustomed to the existence of similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982).

Additionally, applicant has argued:

The "A+" symbol is a well-known symbol, and Opposer's use of it as a trademark is just one of many examples of others utilizing the same symbol. "A+" is commonly associated with education, as it is the highest mark that can be obtained by a student in a class. It is also used often to

suggest a high level of quality or service for a variety of products and services. Simply because Opposer has chosen to use a common and well-known descriptor of quality with its software products does not mean that the public strongly associates the mark with Opposer.

Brief at p. 15. We are not persuaded by applicant's arguments. First, even if an A+ is commonly used, there is no evidence in the record or widespread use in the context of educational software. Second, there is a stylization to opposer's mark and there is no evidence in the record that this stylization is commonly used at all, or commonly used with respect to an A+.

In sum, based on the record before us, we do not accord opposer's mark a reduced scope of protection. In fact, in view of opposer's evidence that since 2000, it has sold \$56 million worth of educational computer software products bearing the A+ mark and spent in excess of \$3.1 million in advertising its marks, and that it's A+ educational computer software products are installed in over 11,000 elementary, secondary and higher education institutions in the United States, with a market share of approximately 10 percent of the school market in the United States, we find opposer's A+ mark to be a strong mark. See Shivey dec. ¶¶ 3 and 4.

Absence of Actual Confusion

Applicant argues that the *du Pont* factor regarding actual confusion weighs in its favor in light of the fact that there are no reported instances of actual confusion.

Opposition No. 91173861

According to applicant, there have been more than three years of coexistence in the marketplace with substantial sales and advertising of products bearing the marks without any actual confusion, and that this suggests that confusion is not likely. Applicant notes that it has sold more than \$200 million worth of SCHOOL SMART products throughout the United States and has spent more than \$1.03 million in advertising and promoting the SCHOOL SMART mark, including distributing more than 20 catalogs per year with a combined annual circulation of over 4 million. See *Zasada* dec. ¶¶ 2 - 3. As for opposer, applicant points out that it has sold in excess of \$56 million worth of educational computer software products under its mark and has spent in excess of \$3 million in advertising its A+ marks. See *Shively* dec. ¶ 3.

First, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375 (Fed. Cir. 2002). Second, the record is silent as to the amounts applicant has spent in connection with the promotion of its computer programs, which are the goods in issue herein. Third, applicant has not shown that in the field of educational computer programs, a three year period is sufficiently long so that we may resolve the *du Pont* factor regarding actual confusion in its favor. This *du*

Pont factor is therefore neutral.

Conclusion

After weighing the relevant *du Pont* factors, and considering the marks in their entireties, we hold that there is a likelihood of confusion. We make this determination in view of the similarities between the marks, the fact that at least applicant's educational software lies within the scope of the identification of goods of opposer's asserted registration, the presumed overlapping trade channels and classes of purchasers, and the fact that opposer's mark is not accorded any diminished strength.

Dilution

In view of our disposition of opposer's likelihood of confusion claim, we need not reach opposer's claim of dilution.

DECISION: The opposition is sustained on opposer's likelihood of confusion claim and registration of applicant's mark in International Class 9 is refused. The application will proceed for the identified goods and services in International Classes 2, 8, 12, 15, 16, 18, 20, 21, 25, 27, 28 and 35.