

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

Hearing: May 8, 2012

Mailed: June 17, 2013

**UNITED STATES PATENT AND TRADEMARK OFFICE**

**Trademark Trial and Appeal Board**

United States Postal Service

v.

RPost International Ltd.

Consolidated Opposition Nos.  
91158431 to application Serial No. 76437188;  
and  
91158514 to application Serial No. 76438606.

Consolidated Cancellation Nos.  
92044260 to Registration No. 2928365;<sup>1</sup>  
and  
92043665 to Registration No. 2867278.

Sean D. Garrison and Shane E. Olafson of Lewis and Roca LLP  
for United States Postal Service.

Henry Ben-Zvi of Ben-Zvi & Associates for RPost  
International Ltd.

Before Cataldo, Taylor and Mermelstein,  
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

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<sup>1</sup> On July 3, 2008, the Board issued an interlocutory order acknowledging that defendant filed an answer to the petition to cancel in Cancellation No. 92044260 and vacating the default judgment issued in that proceeding. Accordingly, the October 29, 2011 paralegal order entering judgment by default against defendant in Cancellation No. 92044260 was issued in error, and is hereby withdrawn. In view thereof, defendant's November 7, 2011 motion to set aside the October 29, 2011 default judgment is moot.

RPost Int'l. Ltd. ("RPost" or "defendant") filed applications to register in standard characters on the Principal Register the following marks:

(R)ETURN RECEIPT

with a disclaimer of "RETURN RECEIPT" for "delivery of electronic messages to a designated recipient on a basis equivalent to registered receipt mail;"<sup>2</sup> and

(R)EGISTERED RECEIPT

with a disclaimer of "REGISTERED RECEIPT" for "delivery of electronic messages to a designated recipient on a basis equivalent to registered receipt mail."<sup>3</sup>

In addition, RPost owns registrations for the following marks:

REGISTERED E-MAIL

on the Supplemental Register with a disclaimer of "E-MAIL" for "delivery of messages by electronic transmission to a designated recipient to provide results on a basis equivalent to the results obtained by registered mail;"<sup>4</sup> and

(R)EGISTERED E-MAIL

on the Principal Register with a disclaimer of "REGISTERED

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<sup>2</sup> Application Serial No. 76437188 was filed August 2, 2002, based upon applicant's assertion of a bona fide intent to use the mark in commerce.

<sup>3</sup> Application Serial No. 76438606 was filed August 7, 2002, based upon applicant's assertion of a bona fide intent to use the mark in commerce.

<sup>4</sup> Registration No. 2928365 issued on February 22, 2005. Section 8 affidavit accepted.

E-MAIL" for "delivery of messages by electronic transmission to a designated recipient on a basis equivalent to registered mail."<sup>5</sup>

United States Postal Service ("USPS" or "plaintiff") has opposed registration of the involved applications and petitioned to cancel the involved registrations, alleging the following grounds:

Opposition Nos. 91158431 to Serial No. 76437188 and 91158514 to Serial No. 76438606 - false suggestion of a connection under Trademark Act Section 2(a), and mere descriptiveness under Trademark Act Section 2(e)(1);

Cancellation No. 92044260 of Registration No. 2928365 (Supplemental Register) - priority and likelihood of confusion under Trademark Act Section 2(d), and false suggestion of a connection under Trademark Act Section 2(a);

Cancellation No. 92044265 of Registration No. 2867278 - priority and likelihood of confusion under Trademark Act Section 2(d), false suggestion of a connection under Trademark Act Section 2(a), and mere descriptiveness under Trademark Act Section 2(e)(1).

Defendant filed answers to the notices of opposition and petitions to cancel wherein it denied the essential allegations thereof.

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<sup>5</sup> Registration No. 2867278 issued on July 27, 2004. Section 8 affidavit accepted.

### The Record

By rule, the record consists of the pleadings and the files of the involved applications and registrations. In addition, the parties stipulated to accept the December 11, 2009 declaration and accompanying exhibits of Ms. Megaera Ausman, the Historian of USPS, as her trial testimony herein. Further, pursuant to Trademark Rule 2.123(b), the parties submitted a written stipulation to the following facts:

1. The United States Postal Service ("USPS") is an Independent Establishment of the Executive Branch of the United States Government, doing business at 475 L'Enfant Plaza SW, Washington, DC 20260-1135.
2. RPost International Limited ("RPost") is a Bermuda company, with a mailing address of c/o M Q Services, Ltd. Chauncery Hall 52 Reid Street Hamilton HM 12, Bermuda.
3. USPS has operated nationwide in one form or another for over 200 years, and currently operates in every city in the United States.
4. On February 14, 2001, RPost and USPS signed a letter of intent to explore a customized Registered E-mail service based on RPost's technology.
5. In April 2002, USPS terminated that letter of intent.

The parties also stipulated to the admissibility of Exhibits 1-11, related to and supporting the above stipulated facts, as evidence in this proceeding.

Plaintiff submitted testimony and exhibits through testimonial depositions of the following individuals:

Thad Dilley, Manager of Public Affairs for USPS;  
Elke Reuning-Elliott, Marketing Specialist for USPS;  
J. Otis Smith, III, Manager of Vehicle Programs for  
USPS; and

Thomas J. Foti, Manager of Marketing Mail for USPS.  
USPS also filed notices of reliance upon certain of RPost's  
interrogatory responses and Rule 36 admissions; the  
discovery deposition transcript of RPost's Rule 30(b)(6)  
witness Mr. Zafar Khan, its founder, CEO and President; a  
copy of RPost's United States Patent No. 7,840,199;  
dictionary definitions of "e-" and "e-mail" and articles and  
publications concerning the history, public recognition,  
use, and asserted fame of the USPS marks; and 38 U.S.  
Trademark Registrations owned by various third parties  
reciting both electronic mail or messaging services, as well  
as hard copy mail and delivery services.

For its part, RPost took the testimonial deposition of  
Mr. Zafar Khan and the following individuals:

Michael Cowan, an attorney and executive with a third-  
party customer of RPost;

Richard Pryor, a former executive with WorldCom;

Peter Jacobson, a former employee of USPS;

Edward Cohen, former tax attorney with the U.S.  
Treasury Department; and

Maureen O'Gara, a journalist in the field of computers and computing. RPost further submitted numerous notices of reliance upon official records, printed publications, dictionary definitions, USPS's responses to RPost's Second Set of Interrogatories, and pleadings and orders from proceedings involving USPS before the Postal Regulatory Commission.

Plaintiff has filed numerous objections to certain testimony and exhibits introduced by defendant. Specifically, plaintiff objects on procedural grounds to defendant's Exhibits S-AH, AL-AR, and AV-BH to its notices of reliance. Plaintiff objects on substantive grounds to certain of these exhibits as well. Defendant has responded to plaintiff's objections. In addition, defendant has filed a motion to take judicial notice of its Exhibits S-AH or, in the alternative, to admit such exhibits as evidence from other proceedings. The motion is fully briefed.

None of the exhibits sought to be excluded is outcome determinative. Given this fact, coupled with the number of objections, we see no compelling reason to discuss them in a detailed fashion. Suffice it to say, we have considered all of the testimony and exhibits submitted by the parties in this case.<sup>6</sup> In doing so, we have kept in mind the various

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<sup>6</sup> Accordingly, defendant's motion regarding its Exhibits S-AH is moot and will not be considered.

objections raised by the parties, and we have accorded whatever probative value the subject testimony and exhibits merit.

### **Plaintiff's Standing**

Standing is a threshold issue that must be proved in every *inter partes* case. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). To establish its standing, plaintiff must prove that it has a "real interest" in these opposition and cancellation proceedings and a "reasonable basis" for its belief in damage. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999).

Plaintiff's allegations in its brief (p. 19) regarding standing consist, in their entirety, of the following:

As the owner and prior user of the Registered Mail™ mark, and the associated terms Registered Receipt and Return Receipt, USPS has standing to challenge RPost's applications and registrations. 15 U.S.C. §§ 1052(a), 1052(d), 1063; T.B.M.P. § 309.03(b).

"A petitioner's allegations alone do not establish standing." *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 188 (CCPA 1982). Nonetheless, we find that, as discussed below, plaintiff has introduced testimony and evidence that it has made prior use of REGISTERED MAIL and the terms "Registered Receipt" and "Return Receipt," all in connection with mail delivery services, and alleged a reasonable belief that these designations also serve as its

identity for purposes of its claim under Trademark Act Section 2(a). As a result, plaintiff has met the liberal threshold established for standing, and has demonstrated a real interest in preventing and cancelling registration of defendant's marks. *Id.* See also *Jeweler's Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987); and *Toufigh v. Persona Parfum Inc.*, 95 USPQ2d 1872, 1874 (TTAB 2010) (standing found where petitioner holds a reasonable belief that "there is a likelihood of confusion there between the marks, or that the presence on the register of the respondent's mark may hinder the petitioner in using or registering [its] mark").

Because plaintiff has established its standing with respect to one of its pleaded grounds for opposition and cancellation, it has the right to assert any other ground as well, that also has a reasonable basis in fact. See *Lipton Indus., Inc. v. Ralston Purina Co.*, 213 USPQ at 190 (CCPA 1982).

#### **Priority**

In order for plaintiff to prevail on its likelihood of confusion claim, it must prove, in the absence of asserted ownership of any registered trademark, that it has a proprietary interest in a distinctive designation and that its interest was obtained prior to the filing date of



defendant's applications underlying its registrations or defendant's dates of first use of the involved marks.

It is well-settled that in the absence of any evidence of earlier use, the earliest date upon which a respondent in a cancellation proceeding may rely is the filing date of its underlying applications.<sup>7</sup> See Trademark Act Section 7(c), 15 U.S.C. §1057(c). See also *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995). In this case, the applications that matured into defendant's registrations at issue were accorded filing dates of January 23, 2002 (Registration No. 2928365) and February 4, 2002 (Registration No. 2867278). Defendant also has introduced uncontroverted testimony (Khan p. 20-21) that "it began using 'Registered eMail' to describe its principal product as soon as it was formed, in 2000."

Inasmuch as plaintiff has not pleaded ownership of any registered trademark, it must rely on common-law use of one or more of its asserted designations to prove priority. In its brief (p. 7), plaintiff asserts that "The Registered Mail™ service began over 150 years ago, in 1855..." Plaintiff further asserts in its brief (*id.*) that it has "used the phrase 'Return Receipt' since at least the 1880s on various forms, including those used in conjunction with

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<sup>7</sup> As noted above, plaintiff has asserted priority and likelihood of confusion as a ground for cancellation of defendant's involved registrations, but not its involved applications.

Registered Mail™" and also that it has "used the phrase 'Registered Receipt' since at least as early as 1989" as "a receipt for Registered Mail™." Plaintiff's discussion of priority in its brief (p. 9) is reproduced in its entirety below:

The Postal Service has offered its Registered Mail™ service continuously and exclusively since 1855. (Ausman Decl., para. 4). Similarly, the Postal Service has used the terms "Return Receipt" since at least the 1880s (Id. at para. 6), and the phrase "Registered Receipt" since at least as early as 1989. (Id. at para. 8).

In contrast, RPost filed its applications for Registered e-Mail and (R)egistered e-Mail in 2002, and subsequently claimed a date of first use of January 2003.

Thus, it appears from plaintiff's brief that it is claiming common-law use of REGISTERED MAIL as a trademark as early as 1855 in connection with its mail delivery services. With regard to the terms "Return Receipt" and "Registered Receipt," plaintiff does not argue that such terms are trademarks or trade names, but are used as a "phrase," often in conjunction with services under the REGISTERED MAIL mark. Plaintiff's assertion solely of REGISTERED MAIL as a mark is further reinforced in the discussion of priority in its reply brief (p. 2), reproduced in its entirety below:

RPost offers no evidence or argument to dispute the evidence that the Postal Service has long-standing prior rights in the Registered Mail™ mark, or that the Postal Service had been using the terms Registered Receipt and Return Receipt in connection with the Registered Mail™

service and other mailing services long before RPost first offered its e-mail services. Accordingly, this issue must also be decided in favor of the Postal Service.

Finally, we note that in its discussion in its briefs of the similarity between the parties' marks, plaintiff limits its arguments to its REGISTERED MAIL mark and, as noted above, has asserted likelihood of confusion solely as a ground for cancellation of defendant's involved REGISTERED EMAIL and REGISTERED (E)MAIL marks.

For a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common-law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). We observe in this case that defendant has not raised an issue as to the distinctiveness of plaintiff's REGISTERED MAIL mark or otherwise put plaintiff on notice of this defense.<sup>8</sup> Absent any such argument from defendant, we are constrained to find that the REGISTERED MAIL mark is distinctive.<sup>9</sup> *See Wet Seal Inc. v. FD Management Inc.*, 82

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<sup>8</sup> We note in this regard that throughout its brief defendant acknowledges that REGISTERED MAIL is a mark.

<sup>9</sup> Indeed, defendant does not appear to seriously dispute plaintiff's priority of use of its REGISTERED MAIL mark in its brief, aside from an observation (p. 3, n.3) that plaintiff only began using the "TM" symbol in connection therewith since 2006, and only in limited circumstances. However, defendant does not argue that the designation REGISTERED MAIL lacks distinctiveness or that plaintiff has not made prior use thereof.

USPQ2d 1629, 1634 (TTAB 2007) (absent argument or evidence from applicant, opposer's mark deemed distinctive). See also *The Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, note 5 (TTAB 1991) (affirmative defense regarding descriptiveness of opposer's mark, raised for the first time in applicant's brief, was untimely and not considered by the Board).

In order to establish priority, plaintiff must show that it made common-law use of its REGISTERED MAIL mark in connection with its alleged services prior to 2000. In a case involving common-law rights, "the decision as to priority is made in accordance with the preponderance of the evidence." *Hydro-Dynamics Inc. v. George Putnam & Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).

In this case, plaintiff has established (Ausman decl., para. 4) that it has made continuous use of its REGISTERED MAIL mark since 1855. We find that Ms. Ausman's testimony declaration is sufficient to establish plaintiff's priority of use with regard to its REGISTERED MAIL mark. "Oral testimony, if sufficiently probative, is normally satisfactory to establish priority of use in a trademark proceeding." *Powermatics, Inc. v. Globe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430, 432 (CCPA 1965). See also *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993).

### Likelihood of Confusion

Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). 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 [or services] and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976). We also must bear in mind that the fame of a plaintiff's mark, if it exists, plays a "dominant role in the process of balancing the DuPont factors." *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 1327, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

#### Asserted Fame of Plaintiff's REGISTERED MAIL Mark

As noted, we are required to consider evidence of the fame of plaintiff's REGISTERED MAIL mark and to give great weight to this *du Pont* factor, if fame is found to exist. See *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1309 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton, supra*; and *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). "Famous marks thus enjoy a wide latitude of legal

protection." *Recot*, 214 F.3d at 1327, 54 USPQ2d at 1897. This is true as famous marks are more likely to be remembered and associated in the public mind than a weaker mark, and are thus more attractive as targets for would-be copyists. *Id.* A famous mark is one "with extensive public recognition and renown." *Id.* See also *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305.

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," by widespread critical assessments and through notice by independent sources of the products and services identified by the marks, as well as by the general reputation of the branded products and services. *Bose*, 63 USPQ2d at 1305-06, 1309. Although raw numbers of product and service sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in

the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to prove it clearly. *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007).

In this case, plaintiff's evidence of fame may be summarized as follows: The REGISTERED MAIL mark has been used continuously for over 150 years, is offered in every city in the United States, and is prominently advertised in each of USPS's 36,000 retail outlets. (Dilley Testimony, pp. 38-39, Ex. 20). Since 1997, USPS has annually delivered millions of pieces of mail bearing the REGISTERED MAIL mark, which has generated tens of millions of dollars in annual revenues. (Dilley Testimony, pp. 27, 34-35, Ex. 17, 18 and 19). In the combined five years prior to trial, USPS has delivered over 26 million pieces of mail through REGISTERED MAIL, resulting in over \$310 million dollars in revenue. (Ex. 17). In 2009 alone, USPS delivered over three million pieces of REGISTERED MAIL, resulting in almost \$50 million in revenue. (*Id.*).

Plaintiff's evidence shows long use of the REGISTERED MAIL mark and substantial, though not overwhelming, revenues during the five years prior to trial. However, plaintiff's evidence mostly consists of raw volume and revenue numbers without any context by which we may assess these statistics. *See Bose*, 63 USPQ2d at 1309. For instance, the record is

silent as to the recognition or revenues generated by similar services offered by private carrier services. In addition, plaintiff does not provide any evidence from media outlets of recognition of its REGISTERED MAIL mark by independent sources. Finally, we observe that while defendant has not argued that the REGISTERED MAIL mark lacks distinctiveness, we would be remiss not to note that while plaintiff has used the REGISTERED MAIL mark for over 150 years, it appears, at best, to be very weak as applied to plaintiff's services.

In view of the extreme deference that is accorded to a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. Based on the evidence presented by plaintiff, we cannot conclude that its mark is famous for purposes of a likelihood of confusion analysis.

#### Similarity of the Marks

We must now determine whether defendant's marks, REGISTERED E-MAIL and (R)EGISTERED E-MAIL (standard characters) and plaintiff's REGISTERED MAIL mark, when compared in their entireties in terms of appearance, sound and connotation are similar or dissimilar in their overall commercial impressions. *See Palm Bay Imports, Inc. v. Veuve*



*Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005).

The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the marks is likely to result. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ2d 106 (TTAB 1975).

In this case, plaintiff's REGISTERED MAIL mark is nearly identical to defendant's REGISTERED E-MAIL and (R)EGISTERED E-MAIL marks in appearance and sound. The sole difference between the marks is the presence of the letter "E" in defendant's marks and the use of parentheses in one of them. The slight variations in appearance and pronunciation of the marks resulting from this difference are far outweighed by the similarities. With regard to meaning or connotation, the meaning of "mail" and "e-mail" or "electronic mail" is a matter of common knowledge. Plaintiff's mark thus connotes paper mail provided with proof of delivery while defendant's marks connote electronic mail provided with proof of delivery. These connotations are highly similar notwithstanding that they apply to paper mail on the one hand and electronic mail on the other. Simply put, the marks suggest that these related forms of

communication may be made with proof of delivery. The presence of the parentheses in defendant's (R)EGISTERED E-MAIL mark also does little to distinguish the marks. There is nothing in the mark to suggest that the parentheses are pronounced, and as a result they will not be apparent to consumers speaking the mark. In addition, they do not appear to provide an obvious difference to the meaning of the mark, nor do they significantly change its appearance.

In view of the foregoing, we find that the similarities between the parties marks in appearance, sound and connotation far outweigh the differences and that, when viewed as a whole, the marks overall convey highly similar commercial impressions.

#### Similarity of the Services

We turn next to a consideration of the similarities or dissimilarities between the parties' services. We begin by identifying the services provided by plaintiff under its common-law REGISTERED MAIL mark. In its brief (p. 7), plaintiff explains:

Registered Mail™ is a special service offered to protect highly valuable items. Registered Mail™ is placed under tight security from the point of mailing to the point of delivery, and insured up to \$25,000 against loss or damage. (Dilley Depo., Ex. 21) And it allows the sender to verify the date and time of delivery and the delivery attempts online or through receipt of an email.  
(*Id*)

Thus, plaintiff's services may be identified as mail

delivery service provided with additional security and verification or proof of delivery. As recited in its involved registrations, defendant's services are "delivery of messages by electronic transmission to a designated recipient (to provide results) on a basis equivalent to (the results obtained by) registered mail."<sup>10</sup> Defendant explains in its brief (p. 8) that it provides

a managed email service that permits senders of emails to electronically sign, encrypt, contract, record, and diagnose message transmission metadata, prove to other parties precisely what content was contained in the body text and all attachments of an email message, and authenticate message metadata to reconstruct a validated original email message with all attachments.

It is well established that the services of the parties need not 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 that the respective services of the parties are related in some manner, or that the conditions and activities surrounding the marketing of the services are such that they could or would 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 source. *See In re International Telephone & Telegraph*

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<sup>10</sup> Material in parentheses is additional wording in the recitation of services in Reg. No. 2928365. The recited services otherwise are identical.

*Corp.*, 197 USPQ 910 (TTAB 1978); and *Monsanto Company v. Enviro-Chem Corp.*, 199 USPQ 590 (TTAB 1978).

As noted above, petitioner's services are mail delivery services with additional security and proof of delivery. As identified, defendant's services are e-mail delivery services intended to provide the same features as those provided under the REGISTERED MAIL mark. As explained by defendant, these features include security in the form of encryption and proof of delivery. Thus, on the face of their identification, defendant's services appear to be related to those provided by plaintiff. Indeed, the recitations of defendant's services state that such services are intended to function in a manner akin to those provided by plaintiff under its REGISTERED MAIL mark.

Defendant argues that its services "exclusively occur by electronic message transmission," (brief, p. 9, citing to Khan Testimony, p. 6-8, 13-14, 16-17, 25-29) whereas plaintiff's services are provided exclusively with regard to paper mail. The parties further argue at length regarding the nature of certain electronic services offered by plaintiff; whether such services may be considered electronic messaging services; and the extent to which plaintiff has been prohibited by Congress from entering or expanding into the electronic messaging service.

We note, however, that it is unnecessary for us to

determine the extent of plaintiff's presence in the electronic messaging market. First, plaintiff's evidence of use of REGISTERED MAIL as a common-law mark is overwhelmingly directed toward paper mail delivery with additional security and proof of delivery. Second, plaintiff made of record fifteen use-based third-party registrations reciting both paper mail and package delivery and related services and electronic mail delivery and related services.<sup>11</sup> Although these registrations are not evidence that the marks shown therein are in commercial use, or that the public is familiar with them, they nevertheless are probative evidence to the extent that they suggest that the services identified therein are of a type which emanate from a single source under a single mark. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); and *In re Mucky Duck Mustard Co., Inc.*, 6 USPQ2d 1467 (TTAB 1988).

In short, the evidence of record shows that various entities provide paper mail delivery, package delivery and services related to tracking and providing proof of delivery thereof, as well as electronic messaging and services related to encrypting, storing, and providing proof of

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<sup>11</sup> Plaintiff's Second Notice of Reliance. These include Registration Nos. 1801313; 3208053; 3800207; 3136691; 3310770; 3356003; 3124984; 3227997; 3673566; 2961694; 2479989; 2263056; 2261071; 2015762; and 2261073.

delivery thereof. In other words, the evidence of record shows that services of a type provided by plaintiff and defendant may emanate from a common source under the same marks.

Channels of Trade and Classes of Purchasers

Defendant argues that its electronic messaging services move in different channels of trade from those in which plaintiff's paper mail services are encountered. The testimony and evidence adduced at trial presents conflicting views on this point. Nonetheless, plaintiff's core services under its REGISTERED MAIL mark are clearly directed toward paper mail while defendant's services are exclusively directed toward electronic mail. We observe, however, that defendant's services are intended to provide consumers with an alternative to paper mail services but with the same security and proof of delivery available to users of REGISTERED MAIL services. Thus, it appears that plaintiff's services are encountered in somewhat different trade channels from those in which defendant's services are marketed. On the other hand, the latter is provided as an alternative to the former; and so there is an intended overlap between consumers of both. In other words, the same consumers of plaintiff's services may utilize those of defendant. We find, as a result, that while the parties'

services may be marketed in somewhat different channels of trade, the end consumers are the same, at least in part.

Defendant's Intent In Adopting Its Marks

Next, plaintiff points out that defendant has admitted that its selection and use of the REGISTERED E-MAIL and (R)EGISTERED E-MAIL marks, was made with actual knowledge of defendant, its REGISTERED MAIL mark and with the intent to partner with plaintiff and tie its marks and services to the REGISTERED MAIL mark and services provided thereunder.

Defendant, for its part, argues (brief, p. 27) that from 2000 to 2002, the parties were in fact working together to allow plaintiff to enter the electronic message transmission trade channel utilizing defendant's services. Defendant further argues that "from the beginning, Rpost identified its own product as 'Registered eMail'" (*Id.*) and that "USPS personnel admitted they were aware from the time Rpost first approached USPS in mid-2000 that Rpost had been calling its product 'Registered eMail.'" (*Id.* at 27-28, Jacobson Testimony, p. 16-17; 27-29; Khan Testimony, p. 47-48, Ex. 2, 10, 11.)

It is settled that mere knowledge of the existence of a plaintiff's mark does not, in and of itself, constitute bad faith. See *Action Temporary Services Inc. v. Labor Force Inc.*, 870 F.2d 1563, 10 USPQ 1307 (Fed. Cir. 1989); and *Ava Enterprises, Inc. v. Audio Boss USA, Inc.*, 77 USPQ2d 1783

(TTAB 2006). In this case, it is clear that defendant's adoption of its marks was done with knowledge of plaintiff and its REGISTERED MAIL mark. It further is undisputed (stipulation of facts, paras. 4-5) that from February 2001 until April 2002, the parties engaged in a joint effort to create a registered e-mail service based upon defendant's technology. Based upon the circumstances of this case, it is not clear the extent to which defendant's selection of its marks was intended to further the joint purpose of the parties from 200-2002 or to tie its brand to plaintiff's REGISTERED MAIL mark. Furthermore, it appears that plaintiff was aware of defendant's intention to identify its services by the involved marks when they were working together from 2001-2002. Thus, the record is not clear whether defendant adopted its marks in bad faith. We accordingly treat this factor as neutral.

Actual Confusion

Defendant argues in its brief (p. 31) that the "lack of a single instance of actual confusion [since 2002] is sufficient standing alone to dismiss this action." While we acknowledge this factor weighs in defendant's favor, we also note that it is often difficult to adduce reliable evidence of actual confusion. *See, e.g., Mallory & Church Corp.*, 25 USPQ2d 1236 (TTAB 1992). Furthermore, it is not necessary to show actual confusion in order to establish likelihood of



confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Finally, the absence of actual confusion often is outweighed by other factors including, in this case, the similarities between the marks and related nature of the services. See, for example, *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557 (Fed. Cir. 2001). We are therefore unable to give this factor much weight in our analysis.

#### Summary

When all of the relevant *du Pont* factors are considered, particularly the similarity of the identified services and the similarities between the marks, we find that defendant's use of REGISTERED E-MAIL and (R)EGISTERED E-MAIL for its recited services is likely to cause confusion with respect to the services offered by plaintiff under its REGISTERED MAIL mark.

#### **False Suggestion of a Connection**

Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a), provides, in relevant part, that registration may be denied or cancelled when the mark "consists of or comprises . . . matter which may . . . falsely suggest a connection with persons living or dead." A "person" may include a corporation or governmental agency. Plaintiff, USPS, thus may be considered a "person" for purposes of Section 2(a). See *In re Peter S. Herrick, P.A.*, 91 USPQ2d

1505 (TTAB 2009); and *In re Brumberger Co.*, 200 USPQ 475 (TTAB 1978).

Following our principal reviewing court's decision in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), *aff'g* 213 USPQ 594 (TTAB 1982), the Board utilizes the following four-part test to determine whether a false suggestion of a connection has been established:

1. The mark is the same as, or a close approximation of, the name of or identity previously used by another person;
2. The mark would be recognized as such because it points uniquely and unmistakably to that person;
3. The person named by the mark is not connected with the activities performed by the applicant under the mark; and,
4. The prior user's name or identity is of sufficient fame or reputation that a connection with such person would be presumed when applicant's mark is used on applicant's goods.

*In re MC MC S.r.l.*, 88 USPQ2d 1378 (TTAB 2008); *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006); *In re Wielinski*, 49 USPQ2d 1754, 1757 (TTAB 1998); and *In re Sloppy Joe's Int'l Inc.*, 43 USPQ2d 1350, 1353 (TTAB 1997).<sup>12</sup>

Whether defendant's marks are a close approximation of the plaintiff's identity?

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<sup>12</sup> Defendant's assertion in its brief that likelihood of confusion is a condition precedent to finding a false suggestion of a connection was rejected by the Federal Circuit in *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 217 USPQ at 509.

As discussed above, defendant has registered the marks (R)EGISTERED E-MAIL and REGISTERED E-MAIL, and seeks to register the marks (R)EGISTERED RECEIPT and (R)ETURN RECEIPT. With regard to defendant's registered marks, plaintiff argues (brief, p. 32) that "RPost identifies its 'functional equivalent' service with a name that is virtually identical to one of the core services provided by USPS." With regard to the applied-for marks, plaintiff argues (*Id.* at 33) that "RPost has tightened the connection by also utilizing the subsidiary marks (R)egistered Receipt and (R)eturn Receipt, to serve the very same functions that the Return Receipt and Registered Receipt serve in the USPS's Registered Mail™ service." Plaintiff explains (*Id.*) that, "In short, RPost designed its service to closely approximate USPS's pre-existing and successful service."

However, plaintiff does not explain how defendant's marks are a close approximation of its *identity*. Plaintiff argues that defendant's marks are the same as the names of some of its services and other activities related to the delivery of paper mail. Plaintiff does not argue, let alone demonstrate, that defendant's marks approximate the identity of USPS. As discussed above, the evidence of record suggests that defendant provides under its marks services that are related to those provided by plaintiff under its REGISTERED MAIL mark, and may also be related to activities

related to the delivery of paper mail identified by plaintiff under the terms or phrases Return Receipt and Registered Receipt. Nonetheless, there is insufficient evidence that either plaintiff's asserted mark or the terms it uses to identify its services are the equivalent of USPS's identity such that defendant's marks may be found to be a close approximation thereof.

Whether defendant's marks point uniquely and unmistakably to plaintiff?

As to whether defendant's marks point uniquely and unmistakably to plaintiff, plaintiff argues (brief, p. 33) that "The long-standing use of and notoriety associated with the Registered Mail™ mark, and associated Return Receipt and Registered Receipt services, equates that *service* with USPS" [emphasis added]. While noted above, plaintiff has demonstrated use of its REGISTERED MAIL mark for over 150 years, steady revenues and extensive presence in the paper mail delivery market. Nonetheless, plaintiff did not explain or offer evidence to support its contention that defendant's applied-for marks point uniquely to USPS's identity. Rather, plaintiff's arguments and evidence attempt to associate defendant's marks with plaintiff's services.

Whether plaintiff is connected with defendant's services?

It is clear from the record of this case, and the parties agree, that aside from their unsuccessful effort to

work together from 2000-2002, plaintiff USPS is not connected with defendant RPost's services.

Whether plaintiff's name or reputation is sufficiently famous that a connection with plaintiff would be presumed when defendant's marks are used on defendant's services?

Plaintiff argues (*Id.* at 34) that given the notoriety, long use, and ubiquitous presence of itself and the REGISTERED MAIL mark in the field of mail, "a connection with USPS would be presumed from use of the Disputed Marks with a service that operates as the 'electronic' or 'functional equivalent' of Registered Mail™, offering secured delivery with a 'return' or 'registered receipt.'" Plaintiff further argues (*Id.* at 34-35) that "RPost's addition of 'e-' before mail suggests a direct connection with (*i.e.*, the electronic versions of) the Registered Mail™ service." However, as discussed above, we have found plaintiff's REGISTERED MAIL mark not to be famous. Furthermore, plaintiff has failed to argue or establish that REGISTERED MAIL is synonymous with its identity such that the requisite connection would be presumed.

Based upon plaintiff's failure to establish the factors enumerated by the Federal Circuit, this Section 2(a) claim fails for lack of proof.

### Mere Descriptiveness

Finally, plaintiff argues that defendant's involved (R)EGISTERED E-MAIL; (R)ETURN RECEIPT; and (R)EGISTERED RECEIPT marks are merely descriptive of its services.<sup>13</sup>

As noted above, Registration No. 2861922 for the mark (R)EGISTERED E-MAIL is registered on the Principal Register with a disclaimer of all the wording in the mark. Application Serial Nos. 76437188 for the mark (R)ETURN RECEIPT and 76438606 for the mark (R)EGISTERED RECEIPT are registered on the Principal Register with disclaimers of all the wording in the marks. In all cases, the parentheses "()" around the letter "R" are the apparently distinctive portion of the involved marks.

In support of its mere descriptiveness claim, plaintiff argues that:

However, the (R) is itself merely descriptive of a key functional feature of RPost's service. Specifically, RPost's service is triggered when a user places the "(R)" in the subject header of an e-mail. (USPS NOR, Exhibits A-C, Interrogatory No.9 and RPost's Answer to No. 9; Khan Trial Depo., pp. 107-109; Exhibit 69, p.7). RPost admittedly incorporated the "(R)" in its marks as a reminder of how to use the service. *Id.*

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<sup>13</sup> Plaintiff correctly notes that defendant's involved Registration No. 2928365 for the mark REGISTERED E-MAIL is registered on the Supplemental Register (with a disclaimer of "E-MAIL"), which is a concession that the mark is merely descriptive of the identified services. See *Quaker State Oil Ref. Corp. v. Quaker Oil Corp.*, 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972); and *In re Cent. Soya Co., Inc.*, 220 USPQ 914, 916 (TTAB 1984). As such, Registration No. 2928365 is not subject to this ground for cancellation, and plaintiff does not so assert.

Plaintiff further argues that:

Even if the "(R)" did not itself describe a feature of the service, the addition of a parenthesis is insufficient to negate the mere descriptiveness of these marks and otherwise render them non-descriptive. ...

...RPost's addition of common punctuation does not create a substantially different commercial impression so as to magically transform the admittedly descriptive terms, Registered e-Mail, Registered Receipt and Return Receipt, into distinctive and protectable marks. For this independent reason, and because RPost has not come forward with any evidence to otherwise establish the secondary meaning in any of these marks, registration should be rejected on grounds that these marks are merely descriptive of RPost's services. 15 U.S.C. §1052(e).

Plaintiff argues that this tribunal's decisions in *In re Vanilla Gorilla L.P.*, 80 USPQ2d 1637 (TTAB 2006) (refusal to register "3-O's" for wheel rims affirmed); and *In re Litehouse Inc.*, 82 USPQ2d 1471 (TTAB 2007) (refusal to register "Caesar! Caesar!" for salad dressing affirmed) are persuasive in this case.

Whether a particular term is merely descriptive is determined in relation to the services for which registration is sought and the context in which the term is used, not in the abstract or on the basis of guesswork. *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978); *In re Remacle*, 66 USPQ2d 1222, 1224 (TTAB 2002). In other words, the issue is whether someone who knows what the services are will understand the mark to convey information about them. *In re Tower Tech, Inc.*, 64 USPQ2d 1314, 1316-17

(TTAB 2002); *In re Patent & Trademark Servs. Inc.*, 49 USPQ2d 1537, 1539 (TTAB 1998); *In re Home Builders Ass'n of Greenville*, 18 USPQ2d 1313, 1317 (TTAB 1990); and *In re Am. Greetings Corp.*, 226 USPQ 365, 366 (TTAB 1985).

Turning to plaintiff's first argument, we observe that in order for defendant's marks to be merely descriptive of its recited services, the marks in their entireties must immediately convey information about the services to someone who is familiar with them.<sup>14</sup> Defendant, by the disclaimers has acknowledged that the wording "Registered E-Mail," "Return Receipt" and "Registered Receipt" is descriptive, leaving us to determine if the "(R)" feature, common to all of the involved designations, immediately conveys information about the services to someone who is familiar with them. In other words, an individual viewing defendant's marks, who is familiar with the services identified thereby, would, according to plaintiff, need to understand the nature of the services as a result of typing "(R)" in the subject line of an email message and triggering them. As plaintiff notes above, evidence made of record by both parties indicates that typing "(R)" in the subject header of an email is a method of triggering the recited

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<sup>14</sup> We further observe that to the extent plaintiff's arguments may be interpreted as asserting a functionality claim under Section 2(e)(5) of the Trademark Act, such a claim was neither pleaded nor tried by the express or implied consent of the parties and, as such, has been given no consideration.



services.

However, plaintiff fails to show that consumers familiar with defendant's services will, without some conjecture or reasoning, immediately understand that defendant's involved (R)EGISTERED E-MAIL, (R)ETURN RECEIPT and (R)EGISTERED RECEIPT marks are merely descriptive thereof as a result of that feature triggering such services when "(R)" is typed in an email header. In other words, even if defendant's services include this feature, plaintiff fails to demonstrate or produce evidence sufficient to show that such feature, viewed in the context of defendant's involved marks, renders them merely descriptive. Rather, if consumers are aware that typing "(R)" in the subject header of an email message may trigger defendant's services, the presence of "(R)" in defendant's marks imparts an additional meaning thereto beyond the wording. Consumers viewing the marks would perceive not only the wording, but the additional significance of "(R)" and understand the marks to suggest, rather than merely describe, a number of functions or features of the services.

Turning to plaintiff's second argument, we agree that in many cases, merely descriptive marks featuring common punctuation, such as hyphens and exclamation points, are not rendered suggestive or otherwise registrable thereby. Plaintiff argues (brief, p. 36) that "RPost's marks would

each be pronounced as if the "(" were not present."

However, the mere fact that the parentheses in defendant's marks are not vocalized does not necessarily render the marks merely descriptive. In this case, defendant's involved (R)EGISTERED E-MAIL, (R)ETURN RECEIPT and (R)EGISTERED RECEIPT marks feature parentheses not around a word or phrase, but the single letter "R." Consumers familiar with the services, regardless of whether they are aware of the feature discussed above, are likely to view the letter "(R)" set off by parentheses in the marks as somewhat incongruous or novel use of punctuation, imparting some significance to the marks beyond that of the disclaimed wording. In other words, this is not a case in which defendant has merely added punctuation in a common or conventional manner to the wording in its marks, e.g., REGISTERED EMAIL!, RETURN-RECEIPT or (REGISTERED RECEIPT). Rather, defendant has surrounded a single letter with parentheses, namely, "(R)" in its marks in a novel manner that imparts a significance thereto beyond the wording.

Furthermore, if as discussed above consumers are aware that typing "(R)" in the subject header of an email message may trigger defendant's services, the presence of "(R)" in defendant's marks suggests an additional meaning and, combined with the wording, suggests rather than merely describes the services.

In view thereof, we find that defendant's marks are highly suggestive of its recited services. However, we find that plaintiff has failed to prove that the involved marks are merely descriptive.<sup>15</sup>

**Decision:**

The petition to cancel is granted on the ground of priority and likelihood of confusion as to both of respondent's challenged registrations. In view thereof, Registration Nos. 2867278 and 2928365 will be cancelled in due course. The petition to cancel on the grounds of false suggestion of a connection is dismissed. The petition to cancel Registration No. 2861922 on the ground of mere descriptiveness is dismissed.

The notice of opposition to registration of application Serial Nos. 76437188 and 76438606 is dismissed on the grounds of false suggestion of a connection and mere descriptiveness.

In view thereof, application Serial Nos. 76437188 and 766438606 will proceed to registration in due course.

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<sup>15</sup> Moreover, and as noted above, plaintiff's REGISTERED MAIL mark appears to be highly suggestive of the services identified thereby.