

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

Mailed:
June 15, 2010

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Message in a Bottle, Inc. f/k/a Gold Shells, Inc.

v.

Keith Cangiarella

Opposition No. 91162780
to application Serial No. 78229875
filed on March 25, 2003

Peter H. Smith, Esq. for Message in a Bottle, Inc. f/k/a
Gold Shells, Inc.

Keith Cangiarella, pro se.

Before Seeherman, Cataldo and Taylor, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

This proceeding involves an opposition initially
brought by Gold Shells, Inc., which company, during the
course of this proceeding, changed its name to Message in a
Bottle, Inc. Opposer opposes the registration of Keith
Cangiarella's application to register MESSAGE IN A BOTTLE in
typed form as a mark for goods identified as:

Novelty, favor, and souvenir bottle
[sic] containing messages and greetings,

Opposition No. 91162780

invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing.

The application was filed on March 25, 2003, is based on use in commerce (Section 1(a) of the Trademark Act), and claims first use on March 10, 1998 and first use in commerce on June 10, 1998.

One of the grounds for the opposition is likelihood of confusion, in connection with which opposer has alleged ownership of Registration No. 2243269, issued May 4, 1999, for MESSAGE IN A BOTTLE in typed form (with MESSAGE disclaimed), from an application filed January 6, 1997, for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others."¹ Mr. Cangiarella has counterclaimed to cancel this registration. Although the roles of the parties are reversed in connection with the opposition and the counterclaim for cancellation, for ease of reference we will use the term "opposer" to refer to Message in a Bottle, Inc. (or, as appropriate, it and its predecessor-in-interest), and we will refer to Mr. Cangiarella as "applicant."

¹ Section 8 affidavit accepted; Section 15 affidavit received; renewed.

Opposition No. 91162780

In its notice of opposition, in addition to claiming ownership of its pleaded registration, opposer has alleged that the registration was assigned to opposer on October 5, 2004 by its predecessor-in-interest, Roger Rojas, who is opposer's Chief Executive Officer; that since October 16, 1999, opposer or its predecessor has continuously used the MESSAGE IN A BOTTLE mark in connection with the services identified in the registration and for novelty, favor and souvenir bottles containing messages and greetings; that opposer has used or has made constructive use of its mark through the filing of its underlying application since prior to any date on which applicant can rely; that because the marks are identical and the goods and services of the parties are substantially similar, applicant's mark so resembles opposer's mark as to be likely to cause confusion or mistake or to deceive; and that

in view of the fact that Applicant's mark is identical to Opposer's designation, and in view of the substantially similar nature of the uses thereof, it is alleged that Applicant's mark consists of and comprises matter that may disparage and falsely suggest a connection with Opposer, and therefore is not registrable under Section 2(a) of the Lanham Act (¶ 5).²

² Opposer also alleged, as paragraph 6 of the notice of opposition, that "Opposer is informed and believes and therefore alleges that Applicant's application is not supported by actual use of the mark on the goods described in the application, and that Applicant's specimens submitted in support of his application are not genuine samples of uses of the mark which have been made in commerce." Opposer did not refer to such

In his answer³ applicant has admitted that he did not use the mark MESSAGE IN A BOTTLE prior to the January 6, 1997 filing date of the application which matured into the registration claimed by opposer, and asserted, as part of his counterclaim, that his first use of the mark was March 10, 1998 and his first use in commerce was June 10, 1998. He otherwise denied the salient allegations of the notice of opposition. Applicant also asserted various affirmative defenses, including unclean hands and that opposer lacks standing, and asserted a counterclaim for cancellation based on the ground of fraud. The counterclaim consists of eight pages with 25 numbered paragraphs, and we will not burden this opinion by reciting all of the allegations. Essentially, he alleges that the registration pleaded by opposer was registered to and remains in the name of Roger Rojas; that during the prosecution of the underlying application Mr. Rojas intentionally mischaracterized and misclassified his goods as telecommunications services instead of goods in order to avoid a potential descriptiveness refusal and to mislead potential third-party opposers, including applicant, as to the nature of the

ground in its briefing of the case, and we therefore treat this ground as waived.

³ At the time applicant filed his answer he was represented by counsel. His counsel withdrew (with consent) from representation on May 18, 2006.

goods; that in filing the Statement of Use in the underlying application Mr. Rojas made intentionally false statements regarding the date of first use and the manner and mode of use with the intent of misleading the Patent and Trademark Office and/or depriving third parties, including applicant, of their opportunity to oppose such application; that opposer's predecessor made such misleading representations to avoid a conflict based on applicant's prior use of the term MESSAGE IN A BOTTLE; and that Mr. Rojas knew at the time of filing his application that third parties had rights in the mark superior to his and, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which he was not entitled.⁴

⁴ Applicant also asserted the ground of abandonment in the counterclaim, alleging that Mr. Rojas knowingly consented to Gold Shells, Inc. [the prior name of opposer Message in a Bottle, Inc.,] describing itself as the owner of the mark MESSAGE IN A BOTTLE since 2003, prior to the date the mark was assigned to this company; and that after the filing of the application that matured into the registration sought to be cancelled, Mr. Rojas abandoned the mark for failure to use it in connection with his products and services for at least two [sic] years. However, applicant did not discuss such claims in his trial brief in support of his counterclaim, listing only fraud as the issue to be considered in connection with the counterclaim. See applicant's brief as plaintiff in the counterclaim, p. 6. Accordingly, we consider the ground of abandonment to have been waived. In addition, paragraph 24 of the counterclaim states that "As alleged by the Opposer in its opposition herein, Registrant's [Mr. Rojas's] mark caused consumers to make a false connection with Applicant. Registrant's mark falsely suggests a connection with Applicant's mark as barred by Lanham Act §2(a)." Applicant did not mention a ground of false suggestion of a connection in his brief, and therefore, to the extent that a Section 2(a) ground was in fact pleaded, we treat this ground as having been waived. We also point out that applicant has failed to prove this claim; paragraph 8 of his own answer states that "there is a myriad of adoptions and uses of the mark MESSAGE IN A

Opposer has denied the salient allegations of the counterclaim in its answer thereto.⁵

Record and Objections

The record includes the pleadings; the file of the opposed application and the registration sought to be cancelled, by operation of Trademark Rule 2.122(b); and the testimony, with exhibits, of opposer's witness, Roger Rojas. Applicant has objected to Exhibits N, U, X, Y and Z, all of which were submitted during Mr. Rojas's deposition. With respect to Exhibit N, he states that it is merely a printed form signed by Roger and Adriana Rojas, but that there is nothing in the document to show the authenticity of the date of the document. The document itself was authenticated by Mr. Rojas by his testimony. Therefore, the document is admissible. As for the email communications that comprise Exhibits U, X, Y and Z, Mr. Rojas also authenticated them during his testimony deposition. Therefore, they are admissible. The Board notes applicant's unsupported comment that he "doubts the veracity" of this evidence. Such a

BOTTLE," and applicant states that he does business as "Dream Weaver Studios." In view of this, applicant has conceded that MESSAGE IN A BOTTLE is not applicant's "persona" and that the term does not point uniquely to him. See discussion of requirements to prove a false suggestion of a connection claim, infra.

⁵ Opposer also asserted several affirmative defenses, as well as statements that more fully expanded on its denials of the allegations in the counterclaim. Because opposer did not address the affirmative defenses in its brief, we treat them as having been waived.

comment goes to the probative value accorded the evidence, not its admissibility. Applicant's objections are overruled.

Opposer has made of record, under a notice of reliance, copies of certain official records and applicant's responses to opposer's requests for admission and interrogatories.⁶ Applicant has also submitted two notices of reliance: The first notice, filed May 27, 2008, made of record opposer's responses to applicant's interrogatories (Ex. A) and opposer's responses to applicant's requests for admission (Ex. J). See Board order mailed May 17, 2009. Included with the notice of reliance were documents from the file of the registration sought to be cancelled (Exhibits H, I, and a second Ex. J). As noted above, and in footnote 3 below, the registration file is automatically of record. Finally, on May 14, 2009, applicant submitted a second notice of reliance, consisting of documents taken from the file of the registration sought be cancelled, as well as what applicant has characterized as printed publications. Again, the

⁶ Opposer also submitted with its first notice of reliance a copy of opposer's pleaded registration. That registration is automatically of record by virtue of the counterclaim to cancel that was filed by applicant. Opposer also filed a second notice of reliance on July 17, 2009 merely stating that, in its position as defendant in the counterclaim, it would rely on testimony and evidence previously submitted with its first notice of reliance. Applicant filed a similar notice of reliance on October 26, 2009. Such filings were unnecessary; once evidence is properly made of record, it is of record for all purposes and for use by all parties.

Opposition No. 91162780

registration file is automatically of record, and the repeated submission of documents from this file are unnecessary.

Opposer has objected to Exhibits O, U, V, W, X and Y. Applicant has responded by stating that Exhibit U is admissible as a printed publication, in that it is an excerpt from the "Orange County Register," a daily newspaper based in Santa Ana, CA. We agree, and this objection is overruled. As for Exhibits O, V, W and Y, applicant has addressed only opposer's relevancy objection, and not whether the exhibits constitute printed publications. We find that the business wire and Dun & Bradstreet listings, Exhibits W, X and Y, are not printed publications as contemplated by Trademark Rule 2.122(e), and sustain opposer's objection to these exhibits.⁷ As for Exhibits O and V, they appear to be taken from technical publications, and therefore the exposure of the articles to the consuming public for opposer's and applicant's goods and services must be considered limited. The probative value of these articles is therefore also limited, but they are admissible.

The opposition and the counterclaim have been fully briefed. In fact, rather than filing a combined brief, applicant submitted both a brief in opposition to the

⁷ Even if we had considered these exhibits, they would not change our decision herein.

Opposition No. 91162780

opposer's trial brief in the opposition and a brief as plaintiff in the counterclaim, while opposer submitted a reply brief in support of its opposition and a separate brief in opposition to the counterclaim, rather than filing a combined brief. However, because each party's separate briefs did not, together, exceed the page limitations for briefs, see Trademark Rule 2.128(b), we have considered all six briefs.

Standing

Opposer has submitted evidence that it is the record owner of a registration for MESSAGE IN A BOTTLE for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." The application that resulted in this registration was filed by Roger Rojas on January 6, 1997, on the basis of intent-to-use, and after Mr. Rojas filed a Statement of Use on January 28, 1999, the registration issued to him on May 4, 1999. On July 7, 2003 Gold Shells, Inc. was incorporated in California. Mr. Rojas and his wife are the sole shareholders of the corporation, and Mr. Rojas is also the Chief Executive Officer. At the same time that the business was incorporated, Mr. Rojas licensed the Trademark MESSAGE IN A BOTTLE ("Trademark" being defined as the words MESSAGE IN A BOTTLE used either as a trademark or a service mark) for advertising, marketing

Opposition No. 91162780

and sale of products, the license agreement containing a provision that all goods and services on which the mark is used conform to the standards established by Mr. Rojas. On October 5, 2004, Mr. Rojas assigned the registration and marks (including the mark of a then-pending application, now abandoned) to Gold Shells, Inc., and this assignment was recorded at the U.S. Patent and Trademark Office on October 15, 2004. A change of name of Gold Shells, Inc. to Message in a Bottle, Inc. was recorded at the Office on January 30, 2008.

Although the ownership of a registration of the identical mark would normally be a sufficient basis to demonstrate standing, applicant appears to claim that opposer does not have standing to bring this opposition. Applicant states that opposer "has its existence derived from the Articles of Incorporation which bears a date [July 7, 2003] subsequent to the filing date of this application and whose right to question this application accrued only on a date subsequent to that on which the cause of action arose,"⁸ does "not have a legal competency to question this application." Applicant's brief as defendant in the opposition, p. 10. It appears from this statement that

⁸ Applicant states that "The cause of action for filing the opposition arose when the application of this Applicant for the registration of his trade mark 'Message in a Bottle' was put for opposition in the official gazette." Applicant's brief as defendant in the opposition, p. 9.

applicant believes that opposer had to have been in existence prior to the filing of applicant's application in order to challenge the application or, perhaps, that the pleaded mark and registration had to have been assigned to opposer at the time that the application was published for opposition on June 29, 2004.⁹ That is not correct. Section 13 of the Trademark Act provides that "any person who believes that he would be damaged by the registration of a mark" may file an opposition. As noted, opposer is the record owner of the pleaded registration and was so at the time it filed the notice of opposition; further, as of July 7, 2003, prior to the publication for opposition of applicant's mark and opposer's filing of its requests for an extension of time to oppose, opposer was licensed to use the mark MESSAGE IN A BOTTLE. This is sufficient to show that opposer had and has a reasonable basis for believing that it will be damaged by the registration of applicant's mark, and that it is not a mere intermeddler. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185

⁹ It is possible that applicant, who is now acting pro se, has taken this position based on statements made in his answer, which was prepared by an attorney, and which were based on a belief that Roger Rojas, and not opposer, was the owner of the registration. However, in applicant's response, also prepared by his attorney, to Interrogatory No. 45, which asked the basis for applicant's denying that opposer is the owner of the pleaded registration, he stated that he "does not presently deny that Opposer is the owner by way of assignment of [the registration]," explaining that at the time applicant had approved the draft of the answer applicant "had no information or belief which would suggest that such assignment had ever occurred."

Opposition No. 91162780

(CCPA 1982). After considering the evidence and all of applicant's arguments, including those not specifically discussed here, we find that opposer has established its standing. As for applicant, its standing to bring the counterclaim to cancel opposer's registration is established by the fact that opposer has opposed applicant's application on the basis of likelihood of confusion with its registration.

Counterclaim

Applicant has counterclaimed to cancel opposer's pleaded registration. Whether or not opposer may rely on its registration is crucial to the issue of priority in connection with opposer's pleaded ground of likelihood of confusion, since when an opposer owns a registration priority is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). Moreover, in this case, opposer's claim of priority is dependent on its registration because opposer did not commence use of its mark until after applicant's date of first use. Therefore, we first consider applicant's counterclaim to cancel that registration.

Applicant seeks to cancel opposer's pleaded registration on the ground of fraud. The fraud that applicant alleges is that opposer misidentified its services during the prosecution of its application. More

Opposition No. 91162780

specifically, based on applicant's discussion of the difference between a trademark and a service mark, it appears that applicant is asserting that opposer's activities are more in the nature of offering goods rather than services, and that opposer did not advise the Office that it was transmitting messages using "novelty, favor and souvenir bottles." Request for admission No. 12. Applicant also states that opposer is not rendering "telecommunications" services and, in his response to Interrogatory 26, which asked for applicant's basis for denying opposer's registration was valid, stated that "applicant has no information that would suggest that Opposer or its predecessor has ever engaged in any services that could properly or legally be characterized as telecommunications services or which would otherwise be properly classified within International Class 38."

In the recently decided *In re Bose Corp.*, 530 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), the Court reiterated the requirements for proving fraud:

A third party may petition to cancel a registered trademark on the ground that the "registration was obtained fraudulently." 15 U.S.C. §1064(3). "Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir. 1986). A party seeking cancellation of a trademark

registration for fraudulent procurement bears a heavy burden of proof. *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 377 F.2d 1001, 1004 (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981).

As noted previously, the services in opposer's registration are identified as "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." The crux of applicant's position is that opposer never rendered, or intended to render, "telecommunications services," which is the class heading for Class 38, as listed in the international schedule of classes of goods and services. See 37 C.F.R. §6.1. Applicant asserts that the main component of opposer's business is tangible goods, and therefore opposer's predecessor made a false statement in characterizing his offerings as "services" and seeking registration of a service mark in Class 38. Applicant also appears to assert that, even if opposer's activities constituted a service, it would not be a telecommunications service. Opposer explains, through the testimony of Mr. Rojas, that at the time its underlying application was filed the class heading was "Communications," not

Opposition No. 91162780

"Telecommunications," a statement that applicant disputes ("Class 38 always had read as 'telecommunication' and never has it read as 'communication,'" brief as plaintiff in the counterclaim, p. 16, although applicant has submitted no evidence to support his statement).

As noted above, in order to prove fraud, a plaintiff must show that a statement was false, that the falsity was intentional, and that the false statements were material to obtaining or maintaining a registration. Moreover, fraud must be proven to the hilt. Applicant's claims about the misclassification of opposer's services, even if true, fall far short of establishing fraud. There is "a material legal distinction between a 'false' representation and a 'fraudulent' one, the latter involving an intent to deceive, whereas the former may be occasioned by a misunderstanding, an inadvertence, a mere negligent omission, or the like." In re Bose Corp., supra, 91 USPQ2d at 1940, quoting Kemin Indus., Inc. v. Watkins Prods., Inc., 192 USPQ 327, 329 (TTAB 1976). The explanatory notes for Class 38, even today, state that "Class 38 includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which ... transmit messages from one person to another." Opposer has submitted evidence that his activities involve receiving messages from a party, transcribing the message on special

paper, putting the message in a bottle and then sending it to another party. Even if such services do not fall in Class 38 (and applicant has not proved that they do not), given the nature of opposer's services and the explanation of what services fall in Class 38, it cannot be said that opposer's predecessor made a knowingly false statement in designating Class 38 when he filed the application. In fact, his testimony that the heading of this class was merely "Communications" at the time he filed the application supports his good faith belief that his services belonged in Class 38.

Nor can we find that the classification of the services in Class 38 was material to the allowance of the application. As applicant himself has recognized, opposer's specimen, a direct mail advertisement, submitted with the Statement of Use, explains the nature of opposer's services:

Our service is sending art quality greetings in unique and distinctive bottles to that someone special. You let us know the communication you want to send, and who you want it sent to, and we will record your communication in beautifully hand-written form, insert it in a bottle, and transmit it for you.

The examining attorney thus was well aware of the nature of opposer's services at the time the mark was approved for registration in Class 38. If the examining attorney believed that Class 38 was not acceptable, he could have changed the classification. See TMEP § 1401.03(b): If

Opposition No. 91162780

the class number designated by an applicant is incorrect, the Office will change the classification either during or prior to examination.

Applicant's claim that opposer's predecessor misdesignated the class for his application is part of applicant's larger point that opposer is not rendering services at all, but is selling goods. This position is based on his claim that selling bottles--goods--is the primary object of opposer's activities, and not services. However, a business activity may be considered a service even though it involves the sale of goods. For example, retail store services for the sale of clothing is a service, even though the primary object of the activity is to sell goods, i.e., clothing. Thus, applicant has not proved that opposer's statements in the application and in the Section 8 affidavit that it was rendering services were false, much less that the statements were intentionally false. We also point out that opposer's specimen, quoted above, clearly states that opposer's service involves sending "unique and distinctive bottles." The specimen submitted with opposer's Section 8 affidavit also emphasizes that opposer offers bottles as part of its service:

the largest selection of decorative bottles in the gift bottle industry so that you'll always have the appropriate bottle for any occasion.

Opposition No. 91162780

The examiners who reviewed these papers were therefore aware of the nature of opposer's activities, and considered them to be a service. Accordingly, we find that applicant has failed to show that any false statements were made in obtaining or maintaining the registration, or that the examiners were misled as to the nature of opposer's activities.

After considering all the evidence of record, as well as the arguments of the parties, including those not specifically discussed herein, we find that applicant has failed to prove that opposer (or its predecessor) committed fraud in obtaining or maintaining its registration. The counterclaim to cancel opposer's registration is dismissed.

Opposition

Issues

Priority and Likelihood of Confusion

Because we have dismissed applicant's counterclaim to cancel opposer's pleaded registration, opposer may rely on that registration, and therefore priority is not in issue. See *King Candy Company v. Eunice King's Kitchen, Inc.*, supra. Moreover, opposer is entitled to rely on the filing date of the application that issued as that registration. That date, January 6, 1997, is earlier than any date on which applicant may rely; applicant did not submit any evidence pertaining to his use of the mark, and he does not

Opposition No. 91162780

claim use earlier than the filing date of opposer's underlying application, stating in paragraph 2 of his counterclaim that the first use date of his mark in connection with his goods and services is March 10, 1998 and his first use in commerce is June 10, 1998.

With respect to the issue of likelihood of confusion, our determination is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003).

The first of these factors is the similarity of the marks. The marks are identical, a fact that applicant concedes. This du Pont factor strongly favors a finding of likelihood of confusion. Where the applicant's mark is identical to the opposer's mark, as it is in this case, there need be only a viable relationship between the respective goods or services in order to find that a likelihood of confusion exists. *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

Here opposer has certainly shown that relationship. It is not necessary that the goods or services of applicant and opposer be similar or competitive, or even that they move in the same channels of trade, to support a holding of

Opposition No. 91162780

likelihood of confusion. It is sufficient that the respective goods or 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). Further, likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in the application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

Opposer's services are identified as "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others"; applicant's goods are identified as "novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing." As previously discussed, opposer renders its services through placing communications in novelty, favor or souvenir bottles, and the description of services in its registration encompasses

Opposition No. 91162780

transmitting communications in this manner. It is settled law that the likelihood of confusion may result from the use by different parties of the same or similar marks in connection with goods, on the one hand, and services which deal with or are related to those goods, on the other. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1639-49 (TTAB 2007). The complementary nature of the opposer's services and applicant's goods is obvious; the bottles are used as a primary feature in the rendering of the services. A consumer who is familiar with opposer's services offered under the mark MESSAGE IN A BOTTLE is likely to believe, upon encountering a bottle in which communications may be placed, offered under the identical mark, that this is a product offered by opposer. This is particularly true since opposer's website which offers its services prominently features different bottles, and the price of the service is dependent on the price of the bottle. We find that the parties' goods and services are closely related, and this du Pont factor favors a finding of likelihood of confusion.

As to channels of trade and classes of consumers, applicant states that his goods are sold, inter alia, through the Internet, at retail, through catalogs and telephone sales, and that he advertises in magazines, newspapers, brochures and through direct mail. Response to interrogatory 17. His customers are "all consumers,

Opposition No. 91162780

including individuals, families, commercial entities and merchants without any limitation." Response to interrogatory 21. Opposer offers its services through the Internet, and has advertised through direct mail, Internet ads and radio. Rojas test. pp. 24, 28. Its customers are individuals from all over the United States. Response to interrogatory 17. Because myriad goods and services are offered through the internet, the mere fact that applicant's goods and opposer's services are offered through this channel of trade has limited effect. However, it is clear that opposer and applicant offer their respective services and goods to the same classes of consumers, and those seeking to obtain such goods and services may do so by an Internet search. This du Pont factor must be considered to favor opposer.

With regard to the conditions of purchase, the consumers for the parties' services and goods are the general public, who cannot be considered to be particularly sophisticated as to the goods and services at issue. Further, the goods and services are relatively inexpensive, and they are of a nature that may be purchased on impulse. This du Pont factor favors a finding of likelihood of confusion.

The fifth du Pont factor, fame, is not relevant to our decision. Opposer has not argued that its mark is famous, nor has it submitted evidence that would prove such fame.

With respect to the factor of third-party use of similar marks on similar goods and services, applicant points to opposer's response to interrogatory 11, which asked opposer to "identify each third party use, former use, or claim of use of any term consisting of MESSAGE IN A BOTTLE." Opposer's response was to provide a four-page list consisting of two columns, one with a url and one with a contact name. It is not clear whether each listing represents a third-party use; for example, the first two listings are for opposer's website and applicant's website. Nor is it clear whether the entities listed use the specific phrase MESSAGE IN A BOTTLE as a trademark or service mark or merely in advertising or some other text, or, if as a trademark, the extent of such usage, or whether the usage is current or occurred at some point in the past. As the Court pointed out in *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1693 (Fed. Cir. 2005), a case relied on by applicant:

The probative value of third-party trademarks depends entirely upon their usage. *E.g., Scarves by Vera, Inc. v. Todo Imports, Ltd.*, 544 F.2d 1167, 1173 (2d Cir. 1976) ("The significance of third-party trademarks depends wholly upon their usage. Defendant introduced no evidence that these trademarks were

actually used by third parties, that they were well promoted or that they were recognized by consumers.").

More importantly, although third-party use of a term may show, as applicant recognizes, that customers have become so conditioned by a plethora of similar marks so that they have been educated to distinguish between different such marks on the basis of minute distinctions, Palm Bay, supra, 73 USPQ2d at 1694, here the marks are not merely similar, they are identical. Thus, there are not even minute differences between the marks that consumers could use to distinguish them.

The next two du Pont factors relate to the existence or absence of actual confusion. Opposer has submitted evidence of what it characterizes as actual confusion, consisting of emails that it received. The first, Rojas Ex. X, is a May 21, 2004 email from an individual who states that she saw the Message in a Bottle invitations on "your website," but now cannot find the bottles with confetti. Opposer does not offer bottles with confetti, but applicant does. The second, Rojas Ex. Z, is an August 31, 2007 email from an individual regarding his order for wedding invitations, which was sent to the attention of "Keith" and states that the writer had spoken with Keith and gave him a credit card number for a deposit on an order. Keith, of course, is the first name of applicant. The third, Rojas Ex. Y, is a chain

Opposition No. 91162780

of emails on February 11, 2005 from a Ms. Kramer complaining that she had recommended opposer's website to three coworkers, that they were victims of a bait and switch shipping policy, and that she was going to put her complaint on every consumer electronic bulletin board she could find. Opposer responded that it did not offer free shipping so it could not be opposer that they dealt with. Ms. Kramer then responded that although she recommended opposer's website, the people she recommended it to "googled it or something" and got applicant's website. Mr. Rojas also testified that "We have received phone calls in which the person indicates that they had previously talked to Keith, and they wanted to talk to Keith in connection with an order that they had placed." He gave no further details, did not specifically say that he had personally spoken to these persons, and he could not estimate how many times this had occurred.

When these pieces of evidence and testimony are individually examined fault can be found with each. Mr. Rojas's testimony about phone calls is extremely vague. Ms. Kramer's email is, in effect, double hearsay. She was not personally confused, but is merely reporting confusion of co-workers, and reporting what she was told they did, with even that being vague ("googled it or something"). The email about bottles with confetti could refer to applicant's product, or might be another company that sends

communications in bottles. As for the email about the wedding invitations, it is not clear what caused the writer to send the email to opposer, and whether it was because applicant uses the same mark as opposer, or some other reason.

We recognize that it is difficult to obtain evidence of actual confusion. The evidence submitted by opposer, although perhaps individually not sufficient to show actual confusion, when taken together paints a circumstantial picture that people consider applicant's goods sold under the mark MESSAGE IN A BOTTLE and opposer's services rendered under that identical mark to emanate from the same source. However, we do not need such evidence in order to conclude that applicant's use of his mark for his identified goods is likely to cause confusion with opposer's mark, although the evidence submitted by opposer reinforces that conclusion. Quite simply, because of the identical marks of the parties, and the closely related nature of the goods and services, the general public who are the purchasers of these goods and services are likely to be confused into believing that applicant's goods and opposer's services come from a single source.

Applicant has also discussed the remaining du Pont factors, but we are not persuaded that these factors favor applicant, or that they compel a finding of no likelihood of

confusion. There is no market interface between the parties, as that concept is explained in the du Pont decision. Applicant appears to believe that he has the prior right to use MESSAGE IN A BOTTLE for bottles, and that opposer's right to use the mark is limited to "telecommunications services." Opposer's registration, however, gives it the right to use its mark for the services identified in that registration, namely, "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." As explained previously, that identification of services encompasses transmitting communications in bottles.¹⁰ And as also explained previously, because of the existence of that registration, priority is not in issue. Thus, applicant's arguments regarding the du Pont factor of the extent to which applicant has a right to exclude others from use of his mark are not persuasive. As to the factor of the extent of potential confusion, the extent of potential confusion is high, since the goods and services are offered to the

¹⁰ We recognize that opposer's identification is very broad, and that in some instances a restriction of the registration under Section 18 would be appropriate. Here, however, any attempt by applicant to restrict the registration would have been unavailing because limiting the identification to the specific nature of the services, i.e., transmitting communications to others in bottles, would not avoid a finding of likelihood of confusion. See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, 34 USPQ2d 1266 (TTAB 1994).

general public, and even with the relatively limited sales of both parties, there have been incidents of, at the very least, misdirection of mail.

After considering all of the relevant du Pont factors, and the evidence submitted and arguments made by the parties in connection therewith, including those arguments not specifically discussed herein, we find that applicant's use of the mark MESSAGE IN A BOTTLE for his identified goods is likely to cause confusion with opposer's mark MESSAGE IN A BOTTLE for the services identified in its registration.

False Suggestion of a Connection and Disparagement

Although false suggestion of a connection and disparagement are two separate grounds for opposition, opposer has treated them as a single issue. "Whether Applicant's mark may disparage Opposer's mark and falsely imply a connection with Opposer." Opposer's brief as plaintiff in the opposition, p. 7 and opposer's reply brief, p. 2. Opposer clearly is not placing great reliance on these grounds. Although opposer devotes nine pages of the argument in its brief to the ground of likelihood of confusion, and sets out the thirteen du Pont factors, it has discussed both the false suggestion of a connection and disparagement grounds in three sentences.

Opposer's argument for its claim of a false suggestion of a connection is that "Opposer's principal has testified

to persons having called him and asking for Applicant, and this is evidence of there being a false implication of a connection between the parties, which again would seem to be inevitable when the same mark is used." Opposer's brief as plaintiff in the opposition, p. 23. In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505, 509 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit discussed the basis for the Section 2(a) prohibition of marks which falsely suggest a connection with the plaintiff:

It is a right of this nature, a right to control the use of one's identity, which the University also asserts under § 2(a).

Under concepts of the protection of one's "identity," in any of the forms which have so far been recognized, the initial and critical requirement is that the name (or an equivalent thereof) claimed to be appropriated by another must be unmistakably associated with a particular personality or "persona."
[footnotes omitted]

Thus, the Court stated that the mark, as used by the defendant, must point uniquely to the plaintiff. In *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985), the Board explained:

In accordance with those principles [discussed in Notre Dame], the Board now requires that a plaintiff asserting a claim that a mark falsely suggests a connection with persons, living or dead, or institutions, demonstrate (i) that the defendant's mark is the same or a

Opposition No. 91162780

close approximation of plaintiff's previously used name or identity; (ii) that the mark would be recognized as such; (iii) that the plaintiff is not connected with the activities performed by the defendant under the mark; and (iv) that the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on its goods or services, a connection with the plaintiff would be presumed.

Opposer has not explained how its evidence meets the above requirements for proving a false suggestion of a connection. As noted, opposer states in its brief only that "opposer's principal has testified to persons having called him and asking for applicant." The actual testimony consists of the following:

Q: Have you had other instances of actual confusion with Mr. Cangiarella [in addition to emails] come to your attention?

A: Yes. We have received phone calls in which the person indicates that they had previously talked to Keith, and they wanted to talk to Keith in connection with an order that they had placed.

Q: Do you have any estimate as to how many times this has occurred over the years?

A: No.

This evidence goes to the issue of likelihood of confusion, but is insufficient to prove a false suggestion of a connection. In particular, opposer has not shown that MESSAGE IN A BOTTLE points uniquely to opposer's persona or

Opposition No. 91162780

identity. There is a distinction between a term being perceived as a company's trademark and being a company's persona. Opposer's own website indicates that others may be using the term "Message in a Bottle." For example, it includes the statement, "Although it is said imitation is the sincerest form of flattery, Message in a Bottle.com wants to assure you that we are the only company legally registered to sell and distribute the Message in a Bottle[®] service and product. And on several of its webpages it states, "Look for our signature 'Gold Shells from Carmel' logo to ensure it's a real Message in a Bottle[®]." Rojas Ex. V. Such statements detract from any claim that MESSAGE IN A BOTTLE points uniquely to opposer. Nor has opposer shown that its name or identity is of sufficient fame or reputation that when applicant's mark is used on his goods or services, a connection with opposer would be presumed.

As for the ground of disparagement, opposer relies on Ms. Kramer's email (Rojas ex. Y), which it claims is "evidence of consumer hostility having been visited on Opposer when intended for Applicant," and that "if Applicant is allowed to register Opposer's mark for Applicant's recited goods, more such disparagement of Opposer's mark can be expected." Brief as plaintiff in the opposition, p. 23. As discussed previously, the email in question complains that opposer is engaging in a bait and switch shipping

policy by advertising free shipping and then charging for it, and threatens to expose this conduct on electronic bulletin boards.

Section 2(a) of the Trademark Act prohibits registration of a mark that "consists of or comprises ... matter which may disparage ... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." The Board has stated that there are two elements of a claim of commercial disparagement: 1) that the communication reasonably would be understood as referring to the plaintiff; and 2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635, 1639 (TTAB 1988). Disparagement, thus, relates to a problem with the defendant's mark per se, e.g., that the mark both points to the plaintiff and that the mark communicates something offensive or objectionable about the plaintiff. Opposer has pointed to no cases in which disparagement has been found because of complaints about the services provided by the defendant under the mark and, again, such damage would appear to go to a claim of likelihood of confusion, not disparagement.

Accordingly, we dismiss the opposition with respect to opposer's claims of false suggestion of a connection and disparagement.

Fraud

In its briefs opposer has asserted that one of the issues is "Whether Applicant's application should be rejected due to Applicant's fraud through untrue statements in the application." Brief as plaintiff in the opposition, p. 7, reply brief, p. 2. Opposer did not plead fraud as a ground for its notice of opposition, nor do we find that the issue of fraud was tried by consent. Opposer refers, in connection with the ground of fraud, to applicant's admissions that prior to the filing of his application he knew that goods or services featuring the mark MESSAGE IN A BOTTLE had been sold by someone else and that he knew that Roger Rojas, opposer's predecessor-in-interest, had obtained a registration for the mark. However, requests for admission to such effect could have gone to the ground of likelihood of confusion as showing bad faith intent in adopting the mark, and therefore applicant, in responding to the admissions request, cannot be said to have consented to trial of the issue of fraud.¹¹ Accordingly, we have given the claim of fraud no consideration.

¹¹ We also point out that in the Board order issued on May 5, 2009, more than one year after both opposer's submission of the notice of reliance containing applicant's discovery responses and

Decision

Applicant's counterclaim to cancel opposer's Registration No. 2243269 is denied. Opposer's opposition to the registration of applicant's mark is granted solely with respect to the issue of likelihood of confusion.

opposer's taking of the testimony deposition of its witness, the Board, in summarizing the grounds on which the notice of opposition was brought, did not list fraud as one of the grounds. Despite that, opposer did not file a motion to indicate that it believed that the ground of fraud had been tried by consent and should be considered by the Board.