

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

Hearing:  
June 11, 2009

Mailed:  
June 25, 2009

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**  
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General Cable Technologies Corporation  
v.  
National Rural Electric Cooperative Association

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Opposition No. 91165554  
to Application Serial No. 78337966  
filed on December 8, 2003  
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Timothy D. Pecsénye of Blank Rome LLP for General Cable Technologies Corporation.

Elizabeth C. Buckingham of Dorsey & Whitney LLP for National Rural Electric Cooperative Association.

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Before Hairston, Walsh and Bergsman, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

National Rural Electric Cooperative Association ("applicant") filed a use-based application for the design mark shown below for services ultimately identified as "promoting the interests of electric cooperatives by promulgating standards for uniform data formatting to facilitate the transfer of data between software applications," in Class 35.



In the application, applicant described its marks as "three arcs forming a boomerang" and it claimed March 1, 2001 as its date of first use of the mark anywhere and in commerce.

General Cable Technologies Corporation ("opposer") opposed the registration of applicant's mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d).<sup>1</sup> Specifically, opposer alleged that it is the owner of ten registrations for variations of what it refers to as the "Roleaux" design mark shown below for, *inter alia*, the following goods and services:



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<sup>1</sup> Opposer also alleged that applicant's mark does not function as a service mark because applicant licenses its mark to third parties as a certification mark. However, because opposer did not reference this ground of opposition in its brief, or at the oral hearing, we find that opposer has waived it.

Wire and cable for energy and electrical applications, namely bare and insulated electrical wire and cable, interlocked armored cable, buried and aerial trunk cable, distribution and drop cable, plenum cables, electrical power instrumentation and control cable, electrical aluminum cable, and low, medium and high voltage power transmission cable, in Class 9;<sup>2</sup>

Mail order and internet catalog services featuring electrical wire and cable, in Class 35;<sup>3</sup> and,

Design for others of electrical wire and cable products, in Class 42.<sup>4</sup>

Because the mark in the three above-noted registrations is closer to applicant's mark than opposer's other marks, we have focused our likelihood of confusion analysis on these marks, as well as on services that opposer contends fall within the natural scope of expansion of its registered marks.

Applicant denied the salient allegations in the notice of opposition.

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<sup>2</sup> Registration No. 2654145, issued November 26, 2002; Sections 8 and 15 affidavits accepted and acknowledged. We did not set forth the entire description of goods. We listed the most relevant products.

<sup>3</sup> Registration No. 2811285, issued February 3, 2004; Sections 8 and 15 affidavits accepted and acknowledged.

<sup>4</sup> Registration No. 2735482, issued July 8, 2003; Sections 8 and 15 affidavits accepted and acknowledged.

Preliminary Issues

A. Improper designation of confidential testimony and evidence.

Opposer introduced into evidence the discovery depositions of applicant's Rule 30(b)(6) witnesses, Martin E. Gordon and Gary A. McNaughton, and the testimony deposition of Lisa Lawson, opposer's Vice President of Corporate Communications, under seal without any attempt to delineate the truly confidential portions by redaction. However, the parties cannot shield from public information that which is not appropriately confidential. See Trademark Rule 2.27(d) and (e). It is readily apparent that most of the testimony submitted under seal is not confidential. Within thirty days of the mailing date of this decision, the parties are ordered to resubmit a redacted copy of the discovery and testimony depositions with attached exhibits submitted under seal with only those portions which truly need to be kept under seal redacted. The redacted copy will be placed in the public record. If the parties fail to make this submission as to any sealed deposition, the entire deposition and exhibits will become part of the public record.

B. Evidence attached to briefs.

Opposer submitted its main brief with evidentiary attachments comprising duplicates of evidence and testimony previously filed during the assigned testimony periods.

Evidence which was timely filed during the parties' trial periods need not, and should not, be resubmitted. *Life Zone Inc. v. Middleman Group, Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008); *Entm't Group Ltd. v. Nintendo of Am. Inc.*, 45 USPQ2d 2021, 2022 (TTAB 1998). Opposer seems to be under the impression that attaching previously-filed evidence to a brief is a courtesy or a convenience to the Board. It is neither. When considering a case for final disposition, the entire record is readily available to the panel. Because we must determine whether such attachments are properly of record, Trademark Rule 2.123(l), citation to the attachment requires examination of the attachment and then an attempt to locate the same evidence in the record developed during trial, requiring more time and effort than would have been necessary if citations were directly to the trial record. Accordingly, we did not consider the attachments to opposer's brief. We only considered the evidence that was timely filed during the assigned testimony periods.

#### The Record

By rule, the record includes applicant's application file and the pleadings. Trademark Rule 2.122(b), 37 CFR §2.122(b).

#### A. Opposer's evidence.

1. A notice of reliance on copies of opposer's pleaded registrations prepared and issued by the U.S. Patent

and Trademark Office showing both the current status of and the current title to the registrations;

2. Notices of reliance on applicant's responses to selected interrogatories and requests for admission;

3. A notice of reliance on the following discovery depositions:

- a. Martin E. Gordon, applicant's Research Project Manager, with attached exhibits; and,
- b. Gary A. McNaughton, an engineering consultant with Cornice Engineering, a contractor engaged by applicant, with attached exhibits; and,

4. The testimony deposition of Lisa Lawson, opposer's Vice President of Corporate Communications, with attached exhibits.

B. Applicant's evidence.

1. The testimony deposition of Robert D. Saint, applicant's principal engineer, with attached exhibits; and,

2. The testimony deposition of Gary A. McNaughton with attached exhibits.

The Parties

A. Opposer.

Opposer is a leading global developer and manufacturer of wire and cable. Opposer, through its predecessors, has

manufactured and sold wire and cable for over 150 years. It has operated as an independent public company since 1997.<sup>5</sup>

Opposer's operations are divided into three main segments: (1) energy; (2) industrial & specialty; and (3) communications.

Energy cable products include low-, medium- and high-voltage power distribution and power transmission products for overhead and buried applications. Industrial & specialty wire and cable products conduct electrical current for industrial, OEM, commercial and residential power and control applications. Communications wire and cable products transmit low-voltage signals for voice and data applications.<sup>6</sup>

The principal market for opposer's energy cable products are power utilities such as rural electric associations.<sup>7</sup>

In addition to wire and cable products, opposer supplies its customers with a managed inventory system wherein customers may monitor and maintain inventory, as well as other inventory control, product ordering and information distribution systems.<sup>8</sup>

Opposer's Roleaux design mark is a housemark used in connection with all of opposer's products and services since

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<sup>5</sup> Opposer's 2005 Form 10-K, pp. 3 and 5-6, filed with the U.S. Securities and Exchange Commission attached as part of Exhibit 1 to the Lawson Dep.

<sup>6</sup> *Id.*

<sup>7</sup> *Id.* at 5.

<sup>8</sup> Lawson Dep., pp. 27-30.

1927. It is placed on all of opposer's products, packaging, literature and advertising and promotional materials.<sup>9</sup>

B. Applicant.

Applicant is a trade association for electric cooperatives. An electric cooperative is an energy utility owned by the customers. There is no stock. The customers vote for an individual to represent them on the board of directors.<sup>10</sup> Applicant promotes the interests of electric cooperatives by lobbying legislative bodies, providing technical expertise, education and training in engineering, human relations, information technology and the law.<sup>11</sup> Companies that sell goods and services to electric cooperatives (hereinafter "vendors") may join applicant as associate members.<sup>12</sup>

Applicant's mark is the logo for the MultiSpeak initiative.<sup>13</sup> MultiSpeak is a project to develop standards for data format and exchange. The purpose of the initiative is to reduce the cost and effort necessary to integrate different software applications.<sup>14</sup>

[Applicant's] MultiSpeak Specification  
is an industry-wide software standard  
that facilitates interoperability of

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<sup>9</sup> Lawson Dep., pp. 25-27.

<sup>10</sup> Gordon Dep., pp. 15, 23-24.

<sup>11</sup> Gordon Dep., pp. 19-20, 21; Saint Dep., pp. 9-11.

<sup>12</sup> Gordon Dep., pp. 25-26, 28; McNaughton Testimony Dep., p. 16.

<sup>13</sup> Gordon Dep., p. 50.

<sup>14</sup> McNaughton Testimony Dep., pp. 7, 13; Gordon Dep., pp. 50, 52, 64, 89, 93 and 107; Saint Dep., pp. 12-14.



diverse business and automation applications used in electric utilities.

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MultiSpeak is a specification for the automation of business processes and the exchange of data among software applications commonly applied in utilities. The foundation of the specification is an agreement on the details of the data objects that need to be exchanged to more fully integrate disparate software applications. *The MultiSpeak specification is intended to assist vendors and utilities to develop interfaces that enable software products from a variety of vendors to interoperate without the need for extensive custom interface development.* (Emphasis added).

\* \* \*

MultiSpeak defines data objects and specifies message structures so that vendors or utilities can write a single, common interface that facilitates communication with another type of software.<sup>15</sup>

Electric cooperatives benefit from industry-wide software standards for data format and exchange as follows:

1. It facilitates a high level of application integration;
2. It minimizes expensive and maintenance-intensive custom interfaces;
3. It allows utilities to focus on the best software application available rather than interface-type issues; and,

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<sup>15</sup> McNaughton Testimony Dep., Exhibit 22.

4. It reduces the deployment time and risk in implementing new software.<sup>16</sup>  
Software developers benefit from industry-wide software

standards for data format and exchange as follows:

1. It reduces the time spent in developing and maintaining custom interfaces;
2. It frees programmers to develop better applications;
3. It facilitates the release and implementation of new products; and,
4. It increases the willingness of utilities to invest in new software applications.<sup>17</sup>

The MultiSpeak initiative has three types of membership: (1) vendor members comprising software vendors; (2) auditing members comprising service providers (e.g., consultants or system integrators); and (3) utilities.<sup>18</sup> Representative vendor members include IBM, Oracle, and Siemens.<sup>19</sup>

Applicant first used its logo in the March 2001 issue of *Rural Electrification*, applicant's magazine for electric cooperatives.<sup>20</sup> The logo has been in continuous use since its first use.<sup>21</sup> Only applicant may use the logo as a stand alone mark.<sup>22</sup> Vendors may use the logo in combination with

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<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> McNaughton Testimony Dep., pp. 16-17, 23; Saint Dep., p. 16.

<sup>19</sup> McNaughton Dep., Exhibit 22; Saint Dep., pp. 18-19.

<sup>20</sup> Gordon Dep., p. 62.

<sup>21</sup> McNaughton Testimony Dep., p. 19.

<sup>22</sup> McNaughton Testimony Dep., pp. 19-20.

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other matter pursuant to a license to indicate membership in the MultiSpeak initiative, to indicate that a product is in

compliance with the MultiSpeak specification or to indicate that a company or person has achieved specific training in connection with the MultiSpeak specification.<sup>23</sup>

Applicant actively promotes the MultiSpeak initiative at electric utility industry conferences, trade shows and other meetings because the success of the project depends upon the willingness of software vendors to support the standard and the willingness of utilities to demand compliance with the MultiSpeak standards.<sup>24</sup>

#### Standing

Because opposer has properly made its pleaded registrations of record, opposer has established its standing. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

#### Priority

Because opposer's pleaded registrations are of record, Section 2(d) priority is not an issue in this case as to the marks and the services covered by the registrations. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

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<sup>23</sup> McNaughton Testimony Dep., p. 20.

<sup>24</sup> McNaughton Testimony Dep., p. 10; Saint Dep., pp. 14-15.

Likelihood of Confusion

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

A. The fame of opposer's marks.

This *du Pont* factor requires us to consider the fame of opposer's mark. Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

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," widespread critical assessments and through notice by independent sources of the products identified by the marks,

as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product 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). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

We have considered the following testimony and evidence in determining whether opposer's mark is famous:

1. Opposer has been using its mark since 1927;<sup>25</sup>
2. Opposer has made substantial sales of wire and cable in the United States during the five years preceding Ms. Lawson's testimony:<sup>26</sup>

<u>Year</u>	<u>Net Sales</u>
2007	\$1.8 billion
2006	\$1.5 billion
2005	\$952 million
2004	\$788 million
2003	\$615 million

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<sup>25</sup> Lawson Dep., p. 25.

<sup>26</sup> Lawson Dep., Exhibit 1 (Opposer's 2007 Annual Report, Bates No. 1767). Opposer reported worldwide revenues, but Ms. Lawson testified that 40% of opposer's sales are from the United States. (Lawson Dep., p. 9). The figures listed above are U.S. sales.

3. Opposer has extensively advertised its products:<sup>27</sup>

4. While opposer vies with Southwire as the largest manufacturer of wire and cable in the United States, it is the largest supplier of energy cable in the United States.<sup>28</sup>

Based on our review of the evidence, we find that opposer's Roleaux design mark has achieved a high degree of recognition as a mark for wire and cable products, such that the mark would be viewed as a strong and distinctive mark. However, we cannot find on this record that the relevant U.S. consumers have been so exposed to the mark, or that they are so aware of it, that it can be considered a famous mark as contemplated by the case law. In view of the extreme deference that a famous mark is accorded, and the dominant role fame plays in the likelihood of confusion analysis, a plaintiff asserting that its mark is famous has a duty to clearly prove fame. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007); *Blue Man Productions Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005).

In this case, opposer's evidence falls short of proving that its mark is famous because opposer's mark is primarily

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<sup>27</sup> Lawson Dep., pp. 21-23; Exhibit 1 (Opposer's 2007 K-1 Form, Bates No. 1331). Out of an abundance of caution, we have not listed the actual advertising figures because we are not clear whether they are truly confidential.

<sup>28</sup> Lawson Dep., p. 33.

displayed in connection with the trade name General Cable as shown below.<sup>29</sup>



Furthermore, the industry publications about opposer introduced into evidence (Lawson Deposition Exhibit 5) do not reference the design mark although it may appear next to the trade name.

The problem with opposer's evidentiary showing on the issue of fame is that there is nothing that demonstrates that the Roleaux design mark has any renown independent of the trade name General Cable. *Cf. Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1308 ("If a product mark used in tandem with a famous house mark . . . has independent trademark significance, it should not be a great burden to substantiate the point"). The nature and context in which the mark is used is a reliable measure of mark independence, as is the strength of the public reputation of the product mark. *Id.* As indicated above, there is very little evidence that opposer's Roleaux mark is used as a stand alone mark or that it has any recognition separate and apart from opposer's trade name. Because we will not infer fame,

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<sup>29</sup> Lawson Dep., Exhibits 1-5, 8-12. We note that in some of the packaging presented in Lawson Dep. Exhibit 7 the Roleaux design mark is displayed in an ornamental manner; but that appears to be the exception rather than the rule.



we find that although the strength of opposer's mark is a factor that favors opposer, opposer's mark does not rise to the level of a famous mark.

B. The similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 177 USPQ at 567. The marks at issue are arbitrary designs. As such, they are perceived graphically, rather than being spoken or read: that is, they are not translated into words. In fact, neither party references the designs in their advertising and promotional materials (e.g., there is no look for advertising). Moreover, neither party submitted any evidence concerning how consumers perceive the respective marks. Accordingly, the similarity or dissimilarity of the marks must be analyzed simply on the visual similarity of the marks. *Daimler-Benz A.G. v. Ford Motor Co.*, 143 USPQ 453, 456 (TTAB 1964). *See also General Foods Corp. v. Ito Yokado Co. Inc.*, 219 USPQ 822, 828 (TTAB 1983) (the comparison of design marks comes down to a "subjective 'eye ball' reaction"). Comparing each of the marks in their entirety, we find that applicant's mark is similar to opposer's mark. While a close visual inspection

of the marks reveals some differences, the overall impressions created by the marks are similar (*i.e.*, intersecting arcs forming a circular triangle).

C. The similarity or dissimilarity and nature of the products and services described in the application and registrations.

As noted above, opposer three most relevant registrations cover wire and cable, sales services in connection with wire and cable including providing customers with access to inventory control systems, and designing wire and cable. Applicant seeks to register its mark for what are essentially trade association services for electric cooperative (*i.e.*, a form of electric utilities) in the nature of "promulgating standards for uniform data formatting to facilitate the transfer of data between software applications." On their face, the services of applicant appear to be different from the goods and services of opposer in terms of their character and use.

Accordingly, it is incumbent upon opposer to show that its respective goods and services and applicant's services are related in some manner and/or the conditions surrounding the marketing thereof are such that they would be likely to be encountered by the same person under circumstances that could give rise (because of the marks) to the mistaken belief that they originate from or are in some way

associated with the same source. *Champion International Corp. v. Genova, Inc.*, 199 USPQ 301, 305 (TTAB 1978).

Opposer's testimony and argument is directed almost exclusively to the similarity of trade channels and class of consumers.<sup>30</sup> While both opposer and applicant sell their goods and services to electric cooperatives, that does not change the distinctly different character and use of their goods and services. Opposer's contention that the channels of trade and classes of consumers are the same does not address the similarity of the goods and services themselves. "The mere fact that two products may move in the same channels of trade to the same class of purchasers does not, ipso facto, prove that there is a definite relationship between the goods." *Champion International Corp. v. Genova, Inc.*, 199 USPQ at 305. See also *Canada Dry Corp. v. American Home Product Corp.*, 468 F.2d 207, 175 USPQ 557 (CCPA 1972) (despite the fact that applicant's laundry detergent is sold in the same channels of trade to the same consumers as opposer's soft drinks, the two products are so

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<sup>30</sup> Lisa Lawson testified that opposer provides its customers with access to a vendor managed inventory system which automatically keeps track of the wire and cable the customer has on hand and replenishes the supply as appropriate. (Lawson Dep., pp. 27-28). Opposer also provides an online system where customers may check inventory, receive reports and access product data sheets. (Lawson Dep., pp. 28-29). We find that these services are ancillary to the sale of opposer's wire and cable and that they are not related to promulgating software specifications for data format and exchange.

different in their essential character and purpose that there is no likelihood of confusion); *Alliance Mfg. Co., Inc. v. Chicago Musical Instrument Co.*, 184 USPQ 118, 121 (TTAB 1974). As discussed more fully below, there is no evidence of record to show that the goods and services of the parties will come to the attention of the same types of actual or potential consumers or users suggesting a common origin.

In view of the foregoing, we find that applicant's services are not related to opposer's goods and services.

D. The similarity or dissimilarity of likely-to-continue trade channels and classes of consumers or users.

The channels of trade and classes of consumers or users factor involves how and to whom the goods and services at issue are sold or marketed. We must determine, therefore, whether there is likely to be an overlap between the respective purchasers/users of the goods and services of the parties to confuse actual and potential purchasers/users.

*Electronic Design & Sales v. Electronic Data Systems*, 954 F.2d 713, 21 USPQ2d 1388, 1390 (fed. Cir. 1992).

[W]here both applicant's goods and opposer's services are marketed and sold in the medical and certain other fields, it is error to deny registration simply because "applicant sells some of its goods in some of the same fields in which opposer provides its services," without determining who are the "relevant persons" within each corporate customer. This is especially true where, as here, the Board acknowledged

that "applicant's goods are specifically different and noncompetitive."  
[Internal citations omitted].

Thus, although the two parties conduct business not only in the same fields but also with some of the same companies, the mere purchase of the goods and services by both parties by the same institution does not, by itself, establish similarity of trade channels, or overlap of customers. The likelihood of confusion must be shown to exist not in a purchasing *institution*, but in "customer or purchaser." [Internal citations omitted] (Emphasis in the original).

*Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d at 1391.

It's clear from the record that both parties market products and services or otherwise interact with electric cooperatives. Applicant uses its mark to identify the MultiSpeak initiative for developing software standards for use by electric cooperatives and software suppliers. Opposer sells wire and cable to electric cooperatives, including members of applicant. In fact, opposer was formerly an associate member of applicant. Opposer and applicant attend the same trade shows and place advertisements in the same publications.

Indeed, at at least one IEEE trade show, [applicant's] and [opposer's] booths, which both prominently displayed their respective [marks], the Roleaux Mark and the NR Mark that Applicant uses in connection with its MultiSpeak

initiative, were located directly next to one another.<sup>31</sup>

Because opposer and applicant market their goods and services to electric cooperatives through the same media, opposer contends that the channels of trade and classes of consumers are identical.<sup>32</sup> The problem with opposer's argument is that opposer presumes that the same people who buy wire and cable for an electric cooperative are also involved with the software used by electric cooperatives. There is no evidence regarding the organization of electric cooperatives that establishes that the persons in charge of information technology are also responsible for purchasing wire and cable. Considering the obvious complexity involved in distributing electricity and managing an electric cooperative, it is inconceivable that the individuals in charge of information technology are also involved with purchasing wire and cable. Based on this record, there is no basis for us to presume that the same people in charge of information technology are also the same individuals who purchase wire and cable. *Electronic Design & Sales v. Electronic Data Systems*, 21 USPQ2d at 1391 ("it cannot be presumed . . . that the general computer services are selected by the same individuals who select battery chargers and power supplies"). Therefore, the mere fact that both

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<sup>31</sup> Opposer's Brief, p. 22.

<sup>32</sup> Opposer's Brief, pp. 46-50.

parties market their goods and services to electric cooperatives through the same media does not establish that actual and potential purchasers from electric cooperatives would be the same.

In view of the foregoing, we find that that channels of trade and classes of consumers are different notwithstanding that both parties market their goods and services to electric cooperative through the same media.

E. Degree of consumer care.

The degree of care that relevant consumers exercise in purchasing opposer's wire and cable products and utilizing applicant's specialized software standards weighs against finding that there is a likelihood of confusion. We are convinced that electric cooperatives and software vendors interested in applicant's software standards exercise a very high degree of care before agreeing to use the standard. The use of applicant's software standards involve considerable planning that requires that electric cooperatives and software vendors have a specific purpose or plan for implementing the standards. This entails educating cooperatives and vendors regarding the benefits of standard specifications for data format and exchange.<sup>33</sup>

Q. What have you done to convince companies like IBM and Oracle to become members?

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<sup>33</sup> Saint Dep., pp. 14-15; McNaughton Testimony Dep., pp. 10-11.

A. Well, I show them that we have developed a specification that they can use, that can be - - a standardized specification that they can use to do their integration so they don't have to do customized integration, and point out that we are also encouraging utilities to specify MultiSpeak usage when they buy software, so if one of their customers specifies MultiSpeak, if they already have it, already utilizing it, they can comply with that request.

A. When you make this pitch, what happens?

Q. Well, they either agree or disagree. And, you know, they don't join on the spot. It's not like they sign up and have their - - you know, it not that type of operation.

But the people that I talk to that go to these trade shows is usually not the decision maker. So they have to take it back to their corporate decision makers, which are sometimes marketing people, sometimes software development people. It varies by company.<sup>34</sup>

Applicant uses knowledgeable engineers to promote the benefits of the standardized software data formats and the electric cooperatives and software vendors have equally knowledgeable personnel evaluating the costs and benefits of a standardized interface. Because of the technology involved and the personal marketing necessary to promote

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<sup>34</sup> Saint Dep., pp. 20-21.



standard software protocols, the electrical cooperatives and software vendors know that they are dealing with applicant as the source of the software standards.

By the same token, we find that opposer's purchasers undoubtedly exercise a high degree of care in purchasing wire and cable, especially the electric utilities that purchase opposer's energy related products. Opposer's wire and cable are specialized products that are undoubtedly purchased in bulk after significant research and comparison of competing products.

We therefore find that the parties' products and services are purchased after careful consideration by person who are knowledgeable about the goods and services and their source.

F. No instances of actual confusion.

Opposer and applicant have been concurrently using their marks since March 2001. Applicant argues that during the period that the parties have been concurrently using their marks on purportedly related goods and services and in purportedly identical channels of trade in connection with the same classes of consumers there have been no reported instances of actual confusion.<sup>35</sup> On the other hand, opposer argues that evidence of actual confusion is not necessary to prove likelihood of confusion and that since applicant is

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<sup>35</sup> Applicant's Brief, p. 11.

rendering a trade association type service, people will be less likely to report confusion.<sup>36</sup>

Where the parties have coexisted in the marketplace under circumstances where there has been an opportunity for confusion to have occurred, the lack of any reported instances of confusion is a factor that the Board may consider. *G.H. Mumm & Cie v. Desnoes & Geddes, Ltd.*, 917 F.2d 1292, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990) (despite over a decade of marketing in the United States, opposer was unable to offer any evidence of actual confusion); *Mr. Hero Sandwich Systems, Inc. v. Roman Meal Co.*, 781 F.2d 884, 228 USPQ 364, 367 (Fed. Cir. 1986) (the concurrent use of the marks for approximately 20 years without any reported instances of confusion suggests that the marks are not likely to cause confusion); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (absence of confusion for over 20 years supports finding that confusion is not likely). Because we

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<sup>36</sup> Opposer's Reply Brief, pp. 15-18. Opposer also asserts that applicant did not prove its date of first use and, thus, there is no basis for asserting that there has been any concurrent use. However, as indicated above, applicant has been continuously using its mark since March 2001. (Gordon Dep., p. 62; McNaughton Testimony Dep., p. 19). See *National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976).

have previously found that the channels of trade and classes of consumers are different, there has not been a meaningful opportunity for confusion to have occurred and, therefore, the lack of any reported instances of confusion is a neutral *du Pont* factor.

G. Balancing the factors.

In view of the facts that applicant's services are so different from opposer's goods and services, that applicant's services and opposer's goods and services move in different channels and are sold to different classes of consumers, and that the purchasers/users and potential purchasers/users of the goods and services at issue exercise a high degree of care, we find that there is no likelihood of confusion by the contemporary use of applicant's design mark and opposer's Roleaux marks. We reach this conclusion despite the strength of opposer's Roleaux marks and the similarity of the marks of the parties. We also note the interesting role played by the lack of any reported instances of actual confusion under the facts in this case. Had we accepted opposer's contention that the channels of trade and classes of consumers are identical, then the lack of any reported instances of confusion would suggest that there is no likelihood of confusion. However, the lack of any reported instances of confusion actually supports our

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finding that the channels of trade and classes of consumers are different.

Decision: The opposition is dismissed and the application will register in due course.

Also, as explained above, within thirty days of the mailing date of this decision, the parties are ordered to resubmit a redacted copy of all testimony and exhibits submitted under seal, including their briefs, with only those portions which truly need to be kept under seal redacted, failing which the entire record will be made public.