

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing:
Dec. 2, 2010

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Dec. 31, 2012

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Chamber of Commerce of the United States of America
v.
United States Hispanic Chamber of Commerce

Cancellation No. 92045876

William M. Merone of Kenyon & Kenyon LLP for The Chamber of
Commerce of the United States of America.

Jill M. Pietrini of Manatt, Phelps & Phillips, LLP for
United States Hispanic Chamber of Commerce.

Before Grendel, Cataldo and Bergsman, Administrative
Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

INTRODUCTION.

United States Hispanic Chamber of Commerce (respondent)
is the owner of Registration No. 2886207 (now cancelled
under Section 8; see footnote 1 below) of the mark **UNITED
STATES HISPANIC CHAMBER OF COMMERCE (and design)**, depicted
below,



for services identified in the registration as "chamber of commerce services, namely promoting business by and among Hispanic businesses and corporate America while fostering procurement and economic development opportunities as well as commercial and financial relations by and among Hispanic businesses with the general business community."¹ The

¹ The mark was registered on the Principal Register on September 21, 2004, based on an application filed on October 10, 2001. The registration was based on use in commerce under Trademark Act Section 1(a), 15 U.S.C. 1051(a), and alleged use of the mark since 1999.

On April 22, 2011, during the course of this proceeding (after final briefing and an oral hearing), respondent's registration that is the subject of petitioner's petition to cancel, Reg. No. 2886207, was cancelled by the Office pursuant to Trademark Act Section 8, 15 U.S.C. Section 1058, after respondent failed to file the required Section 8 affidavit of continued use. On June 17, 2011, the Board issued an order requiring respondent to show cause why judgment should not be entered against respondent in the cancellation proceeding pursuant to Trademark Rule 2.134(a), 37 C.F.R. Section 2.134(a). After resolution of many interlocutory matters including the Section 8 cancellation of respondent's registration and respondent's Petition to the Director for reinstatement of its registration (which was denied), respondent responded satisfactorily to the Board's show cause order, and on April 18, 2012 the Board discharged the show cause order pursuant to Trademark Rule 2.134(b), 37 C.F.R. Section 2.134(b).

In accordance with Board practice, the Board's April 18, 2012 order also allowed petitioner time to indicate whether it

registration includes a disclaimer of all of the wording in the mark, i.e., UNITED STATES HISPANIC CHAMBER OF COMMERCE.

The Chamber of Commerce of the United States of America (petitioner) has filed a petition to cancel respondent's registration, alleging priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), as its ground for cancellation.²

In the petition to cancel, petitioner pleaded ownership of Reg. No. 1522157, which is of the mark **U.S. CHAMBER OF COMMERCE** (registered in standard character form), for services identified in the registration as "association services, namely promoting the interest of business men and women."³ This mark is registered on the Principal Register pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f), 15 U.S.C. §1052(f). This

wished to proceed to a decision on the merits of its Section 2(d) claim in the cancellation proceeding, or rather to have the petition for cancellation dismissed without prejudice as moot (in light of the fact that respondent's involved '207 registration had already been cancelled under Section 8). On May 8, 2012, petitioner responded to the April 18, 2012 order, indicating that it wished to proceed to a final decision on the merits of its Section 2(d) claim as asserted in the cancellation proceeding.

Accordingly, we now proceed (in the present opinion) to final determination of petitioner's Section 2(d) claim against respondent's registration (as well as respondent's counterclaims; see below).

² In the petition to cancel, petitioner also alleged a dilution claim, but has not pursued that claim in its briefs on the case. We therefore deem petitioner to have withdrawn the dilution claim, and we shall give it no further consideration.

³ Issued January 24, 1989, based on an application filed on July 26, 1985. Renewed.

Section 2(f) registration also includes a disclaimer of the words CHAMBER OF COMMERCE.

Respondent filed an answer by which it denied all of the salient allegations in the petition for cancellation. In its answer, respondent also asserted the affirmative defenses of laches and acquiescence.⁴

Respondent also has asserted counterclaims for cancellation of three registrations owned by petitioner, on the ground of genericness.⁵ The first of these registrations is the '157 registration pleaded by petitioner in the petition for cancellation in this case, i.e., of the mark U.S. CHAMBER OF COMMERCE. The second registration respondent has counterclaimed to cancel (which was not pleaded by petitioner in the petition to cancel) is Reg. No. 1686865, which is of the mark CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA (in standard character form) for services identified in the registration as "association

⁴ Respondent asserted numerous other affirmative defenses in its answer, but in its briefs on the case has presented argument only as to the defenses of laches and acquiescence. We deem respondent to have waived the other pleaded defenses.

⁵ Respondent also counterclaimed to cancel a fourth registration, i.e., petitioner's Reg. No. 1436813, which is of the mark NATIONAL CHAMBER (in standard character form) for "association services, namely promoting the interest of business men and women." This registration was cancelled/expired on January 19, 2008 under Trademark Act Sections 8 and 9, U.S.C., Sections 1058 and 1059. In its Main Brief at 19, respondent asserts that this registration "is no longer at issue in the instant proceedings." We deem respondent to have withdrawn its counterclaim against this registration, and we shall give it no further consideration.

services, namely promoting the interest of business men and women."⁶ The third registration respondent has counterclaimed to cancel is Reg. No. 1430627, which is of the mark U.S. CHAMBER (in standard character form) for services identified in the registration as "association services, namely promoting the interest of business men and women."⁷

The case has been fully tried and briefed, and an oral hearing was held on December 2, 2010. After careful consideration of all of the parties' evidence and arguments, we **DISMISS** respondent's counterclaims for cancellation of petitioner's Reg. Nos. 1522157, 1686865, and 1430627. Further, we **DENY** petitioner's petition for cancellation of respondent's Reg. No. 2886207.

THE EVIDENCE.

The record in this case is voluminous, totaling 160 docket entries and some 11,000 pages. For ease of reference and in view of the large and sometimes unwieldy record, citations to the record in this initial listing of the

⁶ Issued May 12, 1992; second renewal. This mark is registered on the Principal Register pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f), and the registration includes petitioner's disclaimer of the words CHAMBER OF COMMERCE.

⁷ Issued February 24, 1987; renewed. This mark is registered on the Principal Register (without a Section 2(f) claim and with no disclaimer).

evidence and throughout this opinion (and especially as to the numerous exhibits to petitioner's Peck deposition and respondent's Danner deposition; see below) often may be accompanied by the corresponding TTABVUE docket number(s) and page number(s), in the format "Docket No./Page No." For example, a citation to evidence located at TTABVUE Docket No. 100, pp. 59-65, would include a citation to "TTABVUE 100/59-65." For an item of evidence which bridges two or more docket entries, the TTABVUE reference would be the beginning docket/page through the final docket/page. For example, if the item of evidence starts at Docket No. 100, page 91 and continues through Docket No. 101, page 200, the TTABVUE reference will be "TTABVUE 100/91 - 101/200." A citation to an entire docket entry will name that docket entry number without reference to page numbers, e.g., "TTABVUE 65" for the entire docket entry number 65. At times, the parties' Bates Nos. for the evidence also will be referenced.

Petitioner's Evidence:

- **Testimony Deposition of Steven Bokat** (petitioner's former general counsel) (depo. text at TTABVUE 48/5-183).
- **Testimony Deposition of Patricia Cole** (petitioner's vice president of sales and marketing) (depo. text at TTABVUE 49/6-152; exh. at TTABVUE 49/153-346).
- **Testimony Deposition of Karen Elzey** (executive director of petitioner's Institute for a Competitive Workforce) (depo. text at TTABVUE 50/6-158; exh. at TTABVUE 50/159 - 52/253).

- **Testimony Deposition of Julie Herrera** (petitioner's legal department secretary) (depo. text Part 1 at TTABVUE 118/1-24); depo. text Part 2 at TTABVUE 125/1-70).

- **Testimony Deposition of Christine Kanuch** (petitioner's vice president of finance) (depo. text at TTABVUE 53/5-90; exhibits at TTABVUE 53/91-94).

- **Testimony Deposition of Lydia Logan** (executive director of petitioner's Institute for a Competitive Workforce) (depo. text at TTABVUE 54/5-179; exhibits at TTABVUE 54/180-190).

- **Testimony Deposition of Jeff Marcoe** (petitioner's executive director of government affairs) (depo. text at TTABVUE 104/1-31; exhibits at TTABVUE 104/32-76).

- **Testimony Deposition of Lucia Olivera** (former associate manager of petitioner's Access America program) (depo. text at TTABVUE 55/5-192).

- **Testimony Deposition of Bradley Peck** (petitioner's senior director of communications and publishing) (depo. text at TTABVUE 57/6-234); exhibits:

- Exh. 1-2 at TTABVUE 57/235-308;
- Exh. 3-8 at TTABVUE 58/1-304;
- Exh. 9-11 at TTABVUE 59/1-308;
- Exh. 12-18 at TTABVUE 60/1-326;
- Exh. 19-26 at TTABVUE 61/1-327);
- Exh. 27-38 (part) at TTABVUE 62/1-305;
- Exh. 38(cont.)-53 at TTABVUE 63/1-379.)

- **Testimony Deposition of Rita Perlman** (former executive director of petitioner's Access America program) (depo. text at TTABVUE 56/5-160; exhibits at TTABVUE 56/161-174).

- **Testimony Deposition of Chrissie Jones** (petitioner's mail room purchasing manager) (depo. text at TTABVUE 65-66).

- **Third-party Testimony Deposition of Rima Matsumoto** (executive director of Hispanic Association on Corporate Responsibility) (depo. text at TTABVUE 103/1-40).

- **Third-party Testimony Deposition of Daniel Ramos** (president of National Hispanic Corporate Achievers) (depo. text at TTABVUE 70/1-50; exhibits at TTABVUE 70/50-55).

- **Petitioner's 1st Notice of Reliance ("NOR")** (petitioner's registrations) (TTABVUE 67).

- **Petitioner's 2nd NOR** (pages from Washington Hispanic newspaper) (TTABVUE 68).

- **Petitioner's 3rd NOR** (various printed publications relating to petitioner) (TTABVUE 69).

- **Petitioner's 4th NOR** (transcript of speech by former President George W. Bush) (TTABVUE 64).

- **Petitioner's 5th NOR** (file history of third-party Reg. No. 2887973) (TTABVUE 117).

Respondent's Evidence:

- **Testimony Deposition of Frank Lopez** (president and CEO of the U.S. Hispanic Chamber of Commerce Foundation) (depo. text at TTABVUE 75/7-255; exhibits:
 - Exh. 1-4 at TTABVUE 75/256-305;
 - Exh. 5-20 at TTABVUE 76/1-307;
 - Exh. 20-22 at TTABVUE 77/1-100).
- **Testimony Deposition of Jose Nino** (respondent's former president and CEO) (depo. text at TTABVUE 77/101-290; exhibits:
 - Exh. 23-25 at TTABVUE 77/291-317;
 - Exh. 26-32 at TTABVUE 78/1-278).
- **Testimony Deposition of Monica Danner** (respondent's counsel's paralegal) (depo. text at TTABVUE 84/7-126); exhibits:
 - Exh. 35-49 at TTABVUE 84/127 - 94/7;
 - Exh. 50 at TTABVUE 94/8-249 (also of record as respondent's 2nd NOR Exh. 3-205 at TTABVUE 97/59 - 98/105);
 - Exh. 51 at TTABVUE 94/250 - 96/21;
 - Exh. 52 at TTABVUE 96/22-295).
- **Testimony Deposition of Melinda Guzman** (respondent's general counsel) (depo. text at TTABVUE 102/3-75; exh. at TTABVUE 102/76-199).
- **Third-party Testimony Deposition of Mahir Iskandarov** (from the United States-Azerbaijan Chamber of Commerce) (depo. text at TTABVUE 106/29-137; exh. at TTABVUE 106/138 - 107/1-259).
- **Third-party Testimony Deposition of Johannes Hofer** (from the U.S. Austrian Chamber of Commerce) (depo. text at TTABVUE 107/261-358; exh. at TTABVUE 107/359 - 108/81).
- **Third-party Testimony Deposition of Margot Dorfman** (from the U.S. Women's Chamber of Commerce) (depo. text at TTABVUE 108/83-201; exh. at TTABVUE 108/202 - 109/216).
- **Third-party Testimony Deposition of Albert Zapanta** (from the United States-Mexico Chamber of Commerce) (depo. text at TTABVUE 109/218-320).
- **Third-party Testimony Deposition of Frederique Raeymaekers** (from the Belgian-American Chamber of Commerce) (depo. text at TTABVUE 110/3-75; exh. at TTABVUE 110/76-160).
- **Third-party Testimony Deposition of Curtis Carlson** (from the Swedish-American Chambers of Commerce) (depo. text at TTABVUE 78/279 - 79/40; exh. at TTABVUE 79/41 - 81/126).
- **Third-party Testimony Deposition of Mary Ginnane-Singer** (from the French-American Chamber of Commerce in the United States) (depo. text at TTABVUE 81/127-207; exh. at TTABVUE 81/208-268).

- **Third-party Testimony Deposition of Melissa Brown** (from the Spain-U.S. Chamber of Commerce) (depo. text at TTABVUE 81/269-334; exh. at TTABVUE 82/1-137).

- **Respondent's Amended 1st Notice of Reliance** (TTABVUE 101):

- Exh. 1-2 (Petitioner's discovery responses) (TTABVUE 101/9-34);

- Exh. 3 (pages from petitioner's website) (TTABVUE 101/35-45);

- Exh. 4-10 (dictionary evidence) (TTABVUE 74/46-71);

- Exh. 11 (respondent's incorporation documents) (TTABVUE 101/72-81);

- Exh. 12-55 (third-party registrations) (TTABVUE 101/82-181);

- Exh. 56-57 (respondent's registrations) (TTABVUE 101/182-185);

- Exh. 58-72 (third-party registrations) (TTABVUE 101/186-263);

- Exh. 73 (respondent's registration) (TTABVUE 101/264-270).

- **Respondent's 2nd Notice of Reliance** (TTABVUE 97-98):

- exh. 1-2 (directory evidence) (TTABVUE 97/31-58).

- exh. 3-205 (state corporation division records) (TTABVUE 97/59 - 98/105) (also of record as Danner Depo. Exh. 50).

- **Respondent's Request for Judicial Notice** (unopposed) (dictionary evidence) (TTABVUE 73).

RESPONDENT'S COUNTERCLAIMS FOR CANCELLATION OF PETITIONER'S REGISTRATIONS.

Introduction.

We turn first to respondent's counterclaims for cancellation of three registrations owned by petitioner, each on the ground of genericness.

As noted above, the first registration is Principal Register Reg. No. 1522157 for the mark U.S. CHAMBER OF COMMERCE, for services identified in the registration as

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"association services, namely promoting the interest of business men and women." This mark is registered pursuant to a claim of acquired distinctiveness under Trademark Act Section 2(f), and includes a disclaimer of the words CHAMBER OF COMMERCE.

The second registration is Principal Register Reg. No. 1686865 for the mark CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA, for the same services as those identified in the '157 registration. This mark also is registered pursuant to Trademark Act Section 2(f), and also includes a disclaimer of the words CHAMBER OF COMMERCE.

The third registration is Principal Register Reg. No. 1430627 for the mark U.S. CHAMBER, for the same services as those identified in the other two registrations. This mark is registered on the Principal Register, without a Section 2(f) claim and without any disclaimer.

Petitioner's registrations are entitled to a presumption of validity. See Trademark Act Section 7(b), 15 U.S.C. §1057(b). Respondent bears the burden of rebutting that presumption by a preponderance of the evidence. See *West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994).

To prevail on its counterclaims in this proceeding, respondent, as counterclaim plaintiff, must establish (1) its standing to counterclaim/petition for cancellation of

petitioner's registrations, and (2) at least one statutory ground for cancellation of the registrations. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Person's Co. Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982).

Respondent's Standing.

We find that respondent, by virtue of its position as defendant in the main cancellation case, has a real interest in the outcome of this proceeding and thus a reasonable basis for believing that it is or will be damaged by the presence on the Principal Register of petitioner's registrations involved in the counterclaims, including the two registrations which petitioner has not pleaded in the petition to cancel. See Trademark Act Section 14, 15 U.S.C. §1064. We thus find that respondent has standing to bring its counterclaims for cancellation of petitioner's three registrations. See *Cunningham v. Laser Golf Corp.*, *supra*; *Lipton Industries, Inc. v. Ralston Purina Co.*, *supra*.

Genericness.

"Determining whether a mark is generic ... involves a two-step inquiry: First, what is the genus of goods or

services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?" *H. Marvin Ginn Corp. v. Int'l Assoc. of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986).

In this case, we find that the relevant genus of services is commensurate with the identification of services in each of petitioner's registrations, i.e., "association services, namely promoting the interest of business men and women." We further find that the relevant public for our genericness inquiry consists of the business men and women who are the purchasers of such association services, i.e., the members and potential members of such associations.

Thus, the remaining inquiry is whether the designations registered as petitioner's respective marks are understood by this relevant public primarily to refer to this genus of services.

Respondent's argument is that each of petitioner's registered marks is generic because it merely combines two generic terms or designations, and that the mere combination of these two generic designations results in a whole that itself remains generic as well. Specifically, respondent contends that the designations "CHAMBER OF COMMERCE" and "CHAMBER" in the respective registered marks are generic, as

are the designations "U.S." and "OF THE UNITED STATES OF AMERICA" in the respective registered marks.

There is no dispute, and we find, that the disclaimed designations in petitioner's Section 2(f) registrations CHAMBER and CHAMBER OF COMMERCE in the respective marks are generic designations as applied to the genus of services at issue here, i.e., "association services, namely promoting the interest of business men and women."

However, we find that although CHAMBER OF COMMERCE and CHAMBER are generic terms as applied to the relevant genus of services, the remainders of the respective marks, i.e., "U.S." and "OF THE UNITED STATES OF AMERICA," are not generic but rather are merely descriptive and/or geographically descriptive terms as applied to the relevant genus of services.⁸ They certainly modify, in a highly descriptive or geographically descriptive manner, the generic designations CHAMBER and CHAMBER OF COMMERCE. However, the evidence does not establish that they are themselves also generic designations for the services. Thus, respondent's argument and the basis of respondent's genericness claim, i.e., that petitioner's registered marks

⁸ Those designations have been included and accepted in petitioner's Principal Register registrations pursuant to Section 2(f), which is an admission that those designations are not inherently distinctive. See *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626 (Fed. Cir. 2009); *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988).

are generic because they consist merely of the combination of two generic designations, is not persuasive.

As will be discussed below in connection with petitioner's Section 2(d) claim, respondent has submitted a large amount of evidence establishing that numerous third-party chambers of commerce or similar associations and organizations in the United States have names which include both the designations "chamber of commerce" and some form of either "U.S." or "United States." However, this evidence does not also establish that the relevant public refers to or would understand any of the particular phrases comprising petitioner's marks as a whole, i.e., U.S. CHAMBER, U.S. CHAMBER OF COMMERCE, or CHAMBER OF COMMERCE OF THE UNITED STATES, as the name of the relevant genus of services here, i.e., "association services, namely promoting the interest of business men and women." Stated differently, the evidence does not establish that the relevant public refers to or would refer to any of these third-party organizations, such as The United States African American Chamber of Commerce (see below), generically as "a U.S. Chamber," or "a U.S. Chamber of Commerce," or "a Chamber of Commerce of the United States of America."

We find, however, that the designations comprising petitioner's registered marks as a whole are highly descriptive, inherently weak, and arguably even "apt" names

for a chamber of commerce or other business association or organization which is located in the United States or which has some sort of connection to or supports business interests in the United States.⁹ However, the Court of Appeals for the Federal Circuit, our primary reviewing court, has specifically stated that "[a]ptness is insufficient to prove genericness." *In re American Fertility Soc.*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999) (for example, NATIONAL BAR ASSOCIATION is apt name for association of lawyers, but not a generic name for such an association).

In short, we have carefully considered all of respondent's evidence and arguments but, for the reasons discussed above, we cannot conclude that petitioner's registered marks are generic. Accordingly, respondent's counterclaims for cancellation of petitioner's three registrations on that ground are dismissed.

PETITIONER'S PETITION TO CANCEL RESPONDENT'S REGISTRATION.

⁹ In this regard, we note that when petitioner's witness Karen Elzey was asked during cross-examination as to her opinion regarding the significance of petitioner's mark, she testified: "My opinion is that 'U.S.' as part of U.S. Chamber of Commerce means that it's representing businesses that have to do something with the United States of America." (Elzey Depo. at 126-27.)

We turn now to petitioner's petition to cancel respondent's registration of the mark U.S. HISPANIC CHAMBER OF COMMERCE (and design).

To prevail in this cancellation proceeding, petitioner must establish (1) its standing to petition to cancel respondent's registration, and (2) at least one statutory ground for cancellation of the registration. *See Cunningham v. Laser Golf Corp. supra; Person's Co. Ltd. v. Christman, supra; Lipton Industries, Inc. v. Ralston Purina Co., supra.*

Petitioner's Standing.

Petitioner has properly made its pleaded Reg. No. 1522157 of record, which establishes that the registration is in effect and is owned by petitioner. (Petitioner's 1st NOR (TTABVUE 67)). In view thereof, and because petitioner has established that its pleaded ground for cancellation of respondent's registration is colorable, we find that petitioner has a real interest in the outcome of this proceeding and thus a reasonable basis for believing that it is or will be damaged by the presence on the Principal Register of respondent's registration. *See Trademark Act Section 14, 15 U.S.C. §1064.* Accordingly, we find that petitioner has established its standing to petition to cancel respondent's registration. *See Cunningham v. Laser*

Golf Corp., supra; Lipton Industries, Inc. v. Ralston Purina Co., supra.

Petitioner's Section 2(d) claim.

Section 2(d) priority.

Because petitioner has made its pleaded registration of record (Petitioner's 1st NOR (TTABVUE 67)), and because respondent's registration is now cancelled under Section 8, Section 2(d) priority is not an issue in this case as to the mark and services set forth in petitioner's registration. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Miss Universe L.P. v. Community Marketing Inc.*, 82 USPQ2d 1562, 1566 (TTAB 2007).¹⁰

Likelihood of Confusion.

Our likelihood of confusion determination under Section 2(d) is a legal conclusion, based on an analysis of all of

¹⁰ Even if Section 2(d) priority were an issue in this case, we find that petitioner has priority. For purposes of determining Section 2(d) priority, petitioner is entitled to rely on the filing date of the application that matured into its pleaded registration, i.e., July 26, 1985. *See Brewski Beer Co. v. Brewski Brothers Inc.*, 47 UDPQ2d 1281, 1283-84 (TTAB 1998). That date is prior to the October 10, 2001 filing date of the application which matured into respondent's involved (now-cancelled) registration, and also is prior, on this record, to any other date upon which respondent might rely for priority purposes. We note in any event that respondent has not disputed petitioner's priority.

the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors). *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See M2 Software Inc. v. M2 Communications Inc.*, 450 F.3d 1378, 78 USPQ2d 1944, 1946 (Fed. Cir. 2006); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

It is settled that "...not all of the [*du Pont*] factors are relevant or of similar weight in every case. Indeed, any one of the factors may control a particular case." *In re Dixie Restaurants, Inc.*, *supra*, 41 USPQ2d 1531 at 1533 (internal citations and quotation marks omitted).

We find as follows regarding the various *du Pont* factors relevant to this case, turning initially to the second factor.

***Du Pont* Factor 2: Similarity of the Services.**

Under the second *du Pont* factor, we determine the similarity or dissimilarity of the parties' respective services. *See In re E. I. du Pont de Nemours & Co.*, *supra*, 177 USPQ 563 at 567. *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). We must base this determination on the

parties' services as they are set out in the identifications of services in their respective registrations. *See id*; *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Petitioner's services as identified in its pleaded registration are "association services, namely promoting the interest of business men and women."

Respondent's services as identified in its registration are "chamber of commerce services, namely promoting business by and among Hispanic businesses and corporate America while fostering procurement and economic development opportunities as well as commercial and financial relations by and among Hispanic businesses with the general business community."

We find that the "chamber of commerce" services identified in respondent's registration are highly similar and related to the "association services" identified in petitioner's registration. Evidence of record submitted by respondent shows that "chamber of commerce" is defined as "an association, primarily of businessmen, to protect and promote the commercial interests of a city, state, country, etc."¹¹ We find that "chamber of commerce" services in essence are a particular type of "association services," directed to promoting the interests of businesses.

¹¹ Random House Dictionary of the English Language (1983). (Respondent's Request for Judicial Notice) (TTABVue 73).

We note that respondent has restricted its identification of services to chamber of commerce services directed specifically to Hispanic businesses. However, petitioner's identification of services is not restricted, and the "business men and women" identified in petitioner's identification of services are presumed to include all such business men and women, including Hispanic business men and women. See *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987) (if the services are identified broadly in the registration, it must be presumed that they encompass all services of the nature and type identified).

Respondent also argues that petitioner's primary activity is advocacy and lobbying on behalf of business before the federal government. There indeed is plentiful evidence in the record which suggests that petitioner's primary purpose and activities relate to policy development and advocacy before the federal government. (Bokat Depo. at 9; see also the discussion below as to *du Pont* factor 5 (fame of petitioner's mark)). Again, however, and as respondent acknowledges, the identification of services in petitioner's registration is unrestricted. Even if we assume that petitioner's primary activity is policy development and advocacy before the federal government, petitioner's identification of services in its registration

is not limited in that way or to that activity, and we will not read such a limitation into the identification of services.

In short, we will not construe petitioner's registration's broadly-identified "association services, namely promoting the interest of business men and women," so as to exclude chamber of commerce services directed to Hispanic businesses, nor will we limit it so as to include only petitioner's advocacy and lobbying activities.

For these reasons, we find, for purposes of the second *du Pont* factor, that respondent's services as they are identified in respondent's registration are highly similar and closely related to the services identified in petitioner's registration.

***Du Pont* Factor 3: Similarity of Purchasers and Trade Channels.**

Under the related third *du Pont* factor, we determine the similarity or dissimilarity of the trade channels in which and the classes of purchasers to whom the parties' respective services are marketed. Inasmuch as, and to the extent that, the parties' respective services as identified in their respective registrations are highly similar and closely related, as discussed above, we also find that the trade channels and purchasers for the respective services

likewise are highly similar. See *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). These “purchasers” include businesses of all sizes, and regional, state, local and other specialized chambers of commerce and trade associations. Respondent has restricted its identification of services as being directed specifically to Hispanic businesses. However, as noted above, petitioner’s identification of services includes no restrictions as to class of purchasers (other than “business men and women”) or trade channels, and we therefore must presume that its services, like respondent’s services, also are marketed to Hispanic business owners in similar trade channels.

Du Pont Factor 4: Conditions of Purchase.

In the absence of any restrictions in the respective identifications of services, we presume that both parties are or could be marketing their chamber of commerce services to businesses and local chambers of commerce of all sizes. Some of these businesses and organizations, especially the truly large corporations that are members of petitioner, are likely to be knowledgeable and sophisticated purchasers of the parties’ services. However, the evidence does not support a finding that all prospective purchasers, such as individual small business owners, necessarily are or would

be sophisticated purchasers of the parties' services. Respondent's mere arguments to the contrary are not supported by the evidence of record. We find that the fourth *du Pont* factor, conditions of purchase, is neutral or perhaps tends to weigh in favor of a conclusion that confusion is likely.

***Du Pont* Factors 5 and 6: Strength of Petitioner's Mark.**

We turn now to what we deem to be a critical issue in our overall likelihood of confusion analysis in this case, i.e., the issue of the strength of petitioner's pleaded mark, U.S. CHAMBER OF COMMERCE, and the resulting scope of protection to which it is entitled vis-à-vis respondent's mark, UNITED STATES HISPANIC CHAMBER OF COMMERCE (and design).

Petitioner contends that its mark is a famous mark and that such fame under the fifth *du Pont* factor must play a great and even dominant role in our likelihood of confusion analysis in this case, entitling petitioner's mark to a broad scope of protection which precludes registration of respondent's mark.

Respondent, for its part, contends that petitioner's mark, if not generic (see discussion of respondent's counterclaims, above), is a very weak mark both inherently on its face and when considered in the light of the numerous

third-party uses of similar marks on similar services under the sixth *du Pont* factor (see below), and that it therefore deserves only a limited scope of protection which does not preclude registration of respondent's mark.

For the reasons discussed below, we find that petitioner's mark has achieved a degree of fame for purposes of the fifth *du Pont* factor. However, we also find that the inherent weakness of petitioner's mark and the evidence in the record of third-party use of similar marks for similar services under the sixth *du Pont* factor supports a finding that petitioner's mark is highly descriptive and inherently weak as applied to the relevant services in this case. On balance, we find that the marketplace fame of petitioner's mark is effectively outweighed by the inherent weakness of that mark for purposes of determining the scope of protection to which the mark is entitled.

Strength of Petitioner's Mark: *du Pont* Factor 5 (Fame).

Under the fifth *du Pont* factor, we consider evidence pertaining to the fame of petitioner's mark. A famous mark is entitled to broad scope of protection, and a finding that petitioner's mark is famous under the fifth *du Pont* factor generally warrants great weight in our overall likelihood of confusion analysis. See *Palm Bay Imports Inc., supra*, 78

USPQ2d 1689 at 1694; *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000).

The record in this case supports the following findings pertaining to the fame of petitioner's mark under the fifth *du Pont* factor.¹²

Petitioner has been in existence as a national business federation since 1912. (Bokat Depo. at 9-10.)

In numerous articles in the national business press, petitioner is identified as and is widely-reported by business journalists to be the largest and most influential business federation in the United States, representing the interests of some three million businesses of all sizes.

For example:¹³

¹² In a 27-page appendix to its main brief, respondent has objected to essentially all of petitioner's evidence pertaining to fame. Although respondent has summarily cited to various of the Federal Rules of Evidence in its statement of objections, in most cases respondent has presented little or no argument pertaining to the actual objections in terms of admissibility. It is clear that most of the objections as stated and argued actually speak to the probative value of the evidence, not to its admissibility; and we have disregarded those objections to the extent that they comprise arguments not discussed, as they should have been, in the main body of respondent's briefs. As to the objections which are true evidentiary objections, to the extent that they are relevant to our findings of fact, we shall address them during the course of our discussion below. All of respondent's other objections are overruled.

¹³ These articles are among the numerous articles submitted by petitioner as Peck Depo. Exh. 39 and 40 (TTABVUE 63 and 64). Respondent's hearsay objections to these articles are overruled; we are considering the articles not for their truth but for what they show on their face. See *Nike Inc. v. Maher*, 100 USPQ2d 1018, 1024 n.12 (TTAB 2011) ("The probative value of the news articles is that they show how the authors perceive, or refer to, opposer's mark, and the exposure of the public to the mark."). See also *Research in Motion Ltd. v. Defining Presence Marketing*

Business Monthly (March 2007): Headline: "Fighting For Business"; Excerpted text: "Thomas Donohue is a force within a force. As president and CEO of the Washington-based US Chamber of Commerce (USCC), he heads the world's largest and most influential business federation, representing the interests and ambitions of more than 3 million businesses via an extensive network of local chambers and association members."

Bloomberg.com (March 12, 2007): Headline: "SEC Should Close Inspections Office, Chamber Urges in Report"; Excerpted text: "The U.S. Chamber of Commerce, the nation's largest business lobby, urged the federal government to loosen regulation of financial markets..."

The Wall Street Journal (March 9, 2006): Headline: "Moving the Market: U.S. Chamber of Commerce Calls For Changes to SEC Enforcement"; Excerpted text: "'The U.S. Chamber of Commerce, which is the advocate for millions of businesses of all sizes, undoubtedly has a valuable perspective on a variety of regulatory issues,' SEC Chairman Chris Cox said in a statement."

Likewise, an entry from the web resource Answers.com, which was made of record by respondent, in defining and discussing "chamber of commerce," includes the following statement (citing Small Business Encyclopedia): "At the national level, chambers of commerce function as a unified voice for their affiliates. The U.S. Chamber of Commerce, for example, counts individual companies, affiliate chambers of commerce, and trade and professional associations among its members. Through them, it represents more than three

Group Inc., 102 USPQ2d 1187, 1193 n.17 (TTAB 2012); *Starbucks U.S. Brands LLC v. Ruben*, 78 USPQ2d 1741, 1751 (TTAB 2006).

million business organizations and individuals." (Danner Depo. Exh. 49) (TTABVUE 94/3-7).)

Petitioner is mentioned by name hundreds of times a day in the national and local press on various topics and issues pertaining to the field of business. (Bokat Depo. at 15-16; Peck Depo. at 33-34, 174-77, Exh. 39-40 (TTABVUE 63, 64).)

For example:

Business Week Online (March 9, 2006): Headline: "A Rap on the SEC's Hard Line; The U.S. Chamber of Commerce is charging that the agency is too punitive in its enforcement practices. But the watchdog's chairman says it has no intention of letting up"; Excerpted text: "The 63-page report by the U.S. Chamber of Commerce is a stinging rebuke of the aggressive enforcement stance the SEC has taken in the post-Enron era."

Chicago Tribune (June 11, 2004): Headline: "Panel urges immigration reform; Newcomers are called key to future"; Excerpted text: "In recent years, corporate interests such as the U.S. Chamber of Commerce have forged an unlikely alliance with labor unions and liberal immigrant advocacy groups, all of whom have a stake in an efficient flow of immigrant workers."

The Washington Times (March 1, 2007): Headline: "Poor education found in states; Business sector grades efforts"; Excerpted text: "U.S. Chamber of Commerce leaders yesterday said states are doing a poor job educating America's children for the future...."

Petitioner issues over one hundred press releases per year to stimulate media coverage of the U.S. Chamber and its policy positions and activities. (Peck Depo. at 38-39, 181-85, Exh. 43 (TTABVUE 63/316).)

Petitioner routinely makes its experts and representatives available to the media for interviews on matters of interest to the business community. Petitioner's former general counsel Mr. Bokat was himself interviewed in the mass media hundreds of times during his career with petitioner. (Bokat Depo. at 66-73.)

Petitioner has presented evidence showing that as of 2006, petitioner had approximately 41,600 dues-paying members of all sizes, including approximately 2,500 regional, state and local chambers of commerce and industry-specific trade associations which in turn have their own memberships. (Kanuch Depo. at 6-13, 67-73, Exh. 1.)¹⁴ We find that the probative value of these numbers is lessened by the fact that petitioner has not provided any context for these membership numbers as compared to those of other, competing national business federations or organizations.¹⁵

¹⁴ Given Ms. Kanuch's clear and specific testimony (including her subsection to detailed cross-examination) as to the accuracy of these membership figures based on her review of petitioner's business records and her personal knowledge as petitioner's vice-president of Finance ("I work with these numbers every day" (Kanuch Depo. at 75-76)), respondent's various objections to Kanuch Depo. Exh. 1 (a summary chart of petitioner's membership numbers, created by Ms. Kanuch to prepare for and use in her deposition) are overruled. Also, we note that petitioner submitted Kanuch Depo. Exh. 1 (membership chart) as confidential, but has referred to the specific content of the exhibit without redaction throughout its briefs. We shall do likewise.

¹⁵ Petitioner's witness Patricia Cole identified the National Association of Manufacturers and the National Federation of Independent Businesses as examples of petitioner's competitors in the business association and federation field. (Cole Depo. at 111-13.)

However, we have considered these membership numbers in conjunction with the other evidence in the record (discussed above) that petitioner is the largest such business federation in the United States.

Further with respect to petitioner's membership numbers, we note that in 2004 (during the course of this proceeding), petitioner instituted its "Business Federation Program," by which it provides free U.S. Chamber memberships to individual businesses (purportedly numbering some 229,000 in 2006) that are the individual members of petitioner's 2,500 dues-paying local chamber and trade association members. (Kanuch Depo. at 9-10, 32-33, Exh. 1.) Petitioner includes these non-dues-paying federation program members in asserting that it has an "indirect" total membership base of 270,000 members as of 2006. (Id.) However, the record does not show the degree to which or manner in which these essentially "default" members of petitioner are actually involved with, or even familiar with, petitioner itself and its activities, either directly or through their local organizations.¹⁶ We have taken this fact into account in

¹⁶ For example, we note that petitioner's monthly membership magazine, by which petitioner provides its members with information about petitioner's resources and activities (Peck Depo. Exh. 13-16 (TTABVUE 60/191-250)), is distributed in print runs of 50,000. (Peck Depo. at 127-29.) This suggests that the magazine is sent only to petitioner's dues-paying or most active members and not to all of petitioner's claimed 229,000 federation program "members."

considering petitioner's reliance on its membership numbers as a specific basis for its claim of fame.

Petitioner has presented evidence showing that in 2006, petitioner had approximately \$160,000,000 in revenue, and expended approximately \$27,000,000 in advertising and promotional efforts. (Kanuch Depo. at 8-9, 13-20, 25, 33-36, 52-64, 67-76, Exh. 2.)¹⁷ Again, the probative value of this evidence is lessened by the fact that petitioner has failed to provide any context for the numbers as compared to those of its competitors in the business association and federation field. However, we have considered these revenue and advertising/promotional expenditure numbers in conjunction with the other evidence in the record (discussed above) that petitioner is the largest such business federation in the United States.

In further support of its claim of fame, petitioner has presented evidence that petitioner and its affiliates annually sponsor a number of conferences, meetings and other

¹⁷ As was the case with Kanuch Depo. Exh. 1, given Ms. Kanuch's clear and specific testimony (including her subjection to detailed cross-examination) as to the accuracy of these 2006 revenue and promotional expenses numbers based on her review of petitioner's business records and her personal knowledge as petitioner's vice-president of Finance ("I work with these numbers every day" (Kanuch Depo. at 76)), respondent's various objections to Kanuch Depo. Exh. 2 (a summary chart of petitioner's revenue and promotional expenses numbers, created by Ms. Kanuch to prepare for and use in her deposition) are overruled. Also as was the case with Kanuch Depo. Exh. 1, Kanuch Depo. Exh. 2 was submitted as confidential, but petitioner has referred to the specific content of the exhibit without redaction throughout its briefs. We shall do likewise.

events for petitioner's members and the public. (Elzey Depo. at 15-17, 20-55, Exh. 1-7; Logan Depo. at 5-8; Olivera Depo. at 6-18; and Perlman Depo. at 8-9, 13-28, Exh. 1.) However, the record does not reveal the actual number of such events, and does not show the number of attendees at these events, except for a few of them at which the numbers of attendees are not particularly impressive as evidence of fame.

Further with respect to petitioner's reliance on its conferences and events as evidence of fame, we find that petitioner's repeated assertion in its briefs that it sponsors 3,000 such events annually is not supported by the record. Petitioner bases this assertion on a statement contained in a document retrieved from its publications archives called "Beyond Policy: How the Chamber Can Help Your Bottom Line," which is included in a membership and fundraising folder. (Peck Depo. Exh. 37 (TTABVUE 62/282) (Bates No. 56271).) This statement in what essentially is merely a marketing piece (and a similar statement in petitioner's membership application (Cole Test. Depo. Exh. 2 (TTABVUE 49/186)), which petitioner specifically asserts that it is relying on for its truth (Petitioner's Evidentiary Objections Appendix at 10), is hearsay, and we reject petitioner's contentions that the business record hearsay objection of Fed. R. Evid. 803(6)

and/or the residual hearsay objection of Fed. R. Evid. 807 apply to it.

In further support of its claim of fame, petitioner has presented evidence that petitioner, through its in-house publishing department, prepares and publishes numerous reports, studies, speeches, transcripts of Congressional testimony, books and other publications. (Peck Depo. Exh. 1-30, 37-38, 43-44 (TTABVUE 57-63).) However, the probative value of petitioner's evidence regarding its publishing activities is lessened by the fact that Mr. Peck, the head of petitioner's publishing department who was petitioner's sole witness on the topic, with only a few exceptions could not testify as to how many copies of the various printed publications submitted as exhibits to his deposition were actually printed by the publishing department.¹⁸ Nor could he testify as to the nature and extent of the distribution of the publications to recipients outside the U.S.

Chamber.¹⁹ Mr. Peck also testified that petitioner's

¹⁸ The exceptions are Peck Depo. Exh. 1-4 (yearly editions of a book entitled The State of American Business), with print runs of 1,000 copies per year; Exh. 18-19 (two annual editions of a book entitled Employee Benefits Study), each with a print run of 20,000 copies, and Exh. 13-16 (issues of petitioner's monthly membership magazine), with approximately 50,000 copies printed per month.

¹⁹ Petitioner's publishing department receives orders for the various publications from other internal departments in the U.S. Chamber, and delivers the finished publications to those respective departments. (Peck Depo. at 58.) Mr. Peck could not testify as to what these internal customers did with the publications after receiving delivery of them from the publishing

publications often are also available for purchase, viewing or downloading on petitioner's website. However, in most cases Mr. Peck could not testify with any specificity as to how many times the publications have actually been accessed or purchased over the website.

Next, petitioner has presented evidence showing that petitioner's website home page is visited by some 8,000 unique visitors per week. (Peck Depo. at 41, 188-89, Exh. 47 (TTABVUE 63/339).) Petitioner also makes "web stickers" available for download by its members for placement on the members' own websites, which allow members to indicate their membership in the U.S. Chamber and which provide a link back to petitioner's website. (Peck Depo. at 44-46, Exh. 52-53 TTABVUE 64/372).) Also, links to petitioner's website appear on the websites of third parties such as Monster.com in connection with "co-branding" arrangements between petitioner and those third parties. (Peck Depo. at 41-44, Exh. 48 (TTABVUE 63/346).) Mr. Peck did not know how many

department. (Peck Depo. at 64-65.) However, despite Mr. Peck's lack of specific knowledge on that question, we reasonably infer that the publications generated by petitioner's publishing department in fact are distributed outside the U.S. Chamber by the various internal departments that order the publications from the publishing department. It is highly unlikely that the internal departments would order and take delivery of the publications unless they intended to then distribute the publications to recipients outside the U.S. Chamber, and it is unlikely that the publications in fact were not so distributed. Again, however, the lack of details as to such distribution affects the probative value of petitioner's evidence on this issue.

times the Monster.com link to petitioner's website has been accessed. (Peck Depo. at 194.) He did not know how many other third parties petitioner has such co-branding arrangements with. (Id.)

In further support of its claim of fame, petitioner has presented evidence showing that, from 1978 to 1997, petitioner operated a business-focused cable television network called BizNet, which broadcast from a television studio petitioner had set up in its headquarters building. (Bokat Depo. at 22.) During that time, petitioner produced a weekly syndicated television program called "It's Your Business." (Bokat Depo. at 22-24, 79-80.) Mr. Bokat testified that he does not know the number of stations around the country that had picked up the program, nor does he know what the viewership for the program had been. (Bokat Depo. at 80-81, 84.) Petitioner also produced a daily cable television business news program called "Nation's Business Today" during the 1990's. (Bokat Depo. at 22-23, 81-82.) Mr. Bokat testified that he does not know what the viewership for that program was. (Bokat Depo. at 85.) Mr. Bokat did not testify as to how or whether petitioner's U.S. CHAMBER marks were used in connection with these television programs in addition to the names of the two programs and/or the name of the network, i.e., BizNet.

Petitioner also currently produces a nationally-syndicated short radio segment called "Speaking for Business." (Bokat Depo. at 86-89; Peck Depo. at 34-37, Exh. 41-42 TTABVUE 63/306.) Mr. Bokat testified that he did not know how many radio stations actually play the segments, in what markets, or how often they are played. (Bokat Depo. at 88.) Mr. Peck likewise did not know these numbers. (Peck Depo. at 178-79.) The radio segments are also available on petitioner's website, but Mr. Peck did not know how many times they have been accessed or listened to through the website. (Peck Depo. at 182.) The record does not show whether or how petitioner's U.S. CHAMBER marks are used in connection with the "Speaking For Business" radio segments.

In further support of its claim that its mark is famous, petitioner relies on an "Online Brand Perception Audit for U.S. Chamber of Commerce," a study commissioned by petitioner in December 2002 and performed by a company called New Media Strategies (NMS). (Cole Depo. Exh. 13, TTABVUE 49/313.) Specifically, petitioner cites to the study's purported findings that 78% of small businesses, 62% of the general public, and essentially all political "insiders" are, in petitioner's words, "aware of the U.S. Chamber." (Petitioner's Main Brief at 17, 31-32.)

We accord this document little probative value as evidence of fame. The "audit" apparently did not involve

any questioning or interviewing of relevant purchasers as to their awareness of petitioner's marks, but rather involved some sort of monitoring and review by NMS of instances where petitioner had been mentioned on Internet websites, chat rooms and message boards. The basis for the specific percentage numbers stated above is not apparent from the report itself as submitted by petitioner, and Ms. Cole testified that she did not know how these numbers were derived. (Cole Depo. at 77-78.)

As noted above, a famous mark is entitled to a broad scope of protection, and such fame, if proven, is entitled to great weight in our likelihood of confusion analysis. On this record and for purposes of this case, we will find that petitioner's U.S. CHAMBER OF COMMERCE mark has achieved a degree of fame as used in connection with its business association services, especially with respect to its lobbying and advocacy activities before the federal government.

Strength of Petitioner's Mark: *du Pont* Factor 6 (Similar Marks In Use on Similar Services).

Under the sixth *du Pont* factor, we examine evidence of third-party use of similar marks in connection with similar services, with a view toward determining the strength of petitioner's mark and the scope of protection to which it is

entitled. Evidence showing numerous such third-party uses suggests that purchasers are accustomed to distinguishing between such marks based on small differences in the marks. See *Palm Bay Imports, Inc.*, *supra*, 73 USPQ2d 1689 at 1693-94; *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011). Also, evidence that all or some of the wording in the parties' marks appears in numerous third-party marks can suggest, in the same manner as dictionary evidence, that such wording is inherently weak and has a recognized descriptiveness significance to relevant purchasers, which would lessen any likelihood of confusion that otherwise might result from the parties' common use of that wording in their marks. See *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); *Rocket Trademarks Pty Ltd.*, *supra*, 98 USPQ2d 1066 at 1075-76; *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313 (TTAB 2005).

In this case, the record reveals the existence of a large number of third-party chamber of commerce organizations operating in the United States using names or marks which, like petitioner's and respondent's marks, combine or include the generic words "CHAMBER OF COMMERCE" and some formative of the highly descriptive and/or geographically descriptive designation "U.S." or "UNITED STATES."

Respondent has made of record the testimony depositions (with exhibits) of witnesses representing several third-party chambers of commerce operating in the United States with marks that include both "U.S" or "UNITED STATES" and "CHAMBER OF COMMERCE." These are: United States Women's Chamber of Commerce (Dorfman Depo., TTABVUE 108-109); U.S.-Mexico Chamber of Commerce (Zapanta Depo., TTABVUE 109-110); U.S. Austrian Chamber of Commerce (Hofer Depo., TTABVUE 107-108); Spain-U.S. Chamber of Commerce (Brown Depo., TTABVUE 81-82); and United States-Azerbaijan Chamber of Commerce (Iskandarov Depo., TTABVUE 106-107).

Our review of the record also reveals references, from various sources, to at least forty-five third-party chambers of commerce operating in the United States which use marks or names employing both "U.S." or "UNITED STATES" and "CHAMBER OF COMMERCE." These sources include:

- Printouts of records from the online databases of various states' Secretary of State Corporation Divisions (or equivalent) (Resp. 2nd NOR Exh. 13-205 (TTABVUE 97/85 - 98/185)); also of record as Danner Depo. Exh. 50 (TTABVUE 94/8-249).²⁰

²⁰ Petitioner has objected to Exh. 13-205 of respondent's Second Notice of Reliance (state online corporation division records) on the ground that they are not admissible via notice of reliance because they are official records which have not been properly authenticated under the Federal Rules of Evidence, particularly Rules 902(4) and 1105, as required by Trademark Rule 2.122(e), 37 C.F.R. Section 2.122(e). Petitioner's objection is overruled.

- Printouts of various third-party chamber of commerce websites (Danner Depo. Exh. 44, starting at TTABVUE 91/76).

- Listings in the trade directory Business Organizations and Agencies Directory (Danner Depo. Exh. 47, starting at TTABVUE 93/228); also at Respondent's 2nd NOR Exh. 1 (TTABVUE 97/32).

- Listings in the trade directory Encyclopedia of Associations (Resp. 2nd NOR Exh. 2, TTABVUE 97/36).

- Listings in the online directory resource 411.com (Danner Depo. Exh. 35, starting at TTABVUE 84/127).

We deem the exhibits to be materials obtained from the Internet which are properly of record under *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010). In *Safer*, the Board held: "The Board will henceforth deem a document obtained from the Internet displaying a date and its source as presumptively true and genuine." *Id.* at 1039. Here, each of the Internet documents submitted as Exh. 13-205 to respondent's Second Notice of Reliance displays its source (its URL) and its date of access, and each therefore is admissible under *Safer*.

In any event, these Internet printouts also were separately and properly made of record as Exhibit 50 to the testimony deposition of respondent's counsel's paralegal, Monica Danner. (TTABVUE 94/8-247.) "Materials that do not fall within [Rule 2.122(e)]... may nevertheless be introduced into evidence through the testimony of a person who can clearly and properly authenticate and identify the materials, including identifying the nature, source and date of the materials." Trademark Board Manual of Procedure (TBMP) Section 704.08 (3rd Ed., 1st Rev. June 2012.) Here, Ms. Danner testified that she downloaded and printed out the documents, and she testified as to their nature, source and dates of access. (Danner Depo. at 35-37.) *Cf. Rocket Trademarks Pty Ltd.*, *supra*, 98 USPQ2d 1066 at 1071 (*Safer* rule regarding Internet evidence applies to testimony deposition exhibits as well).

We have considered these documents only for what they show on their face, i.e., that these third-party chamber of commerce entities and their names appear in the various states' corporation records databases and can be retrieved by a search of those databases.

- Listings from the website worldchambers.com (Danner Depo. Exh. 43, starting at TTABVUE 90/66).
- References appearing on various Google "hitlists" retrieved by searches for (a) "'United States' and 'Chamber of Commerce'" (Danner Depo. Exh. 36, starting at TTABVUE 89/107); (b) "U.S.*'chamber of commerce'" (Danner Depo. Exh. 38, starting at TTABVUE 89/170); and (c) "*U.S.'chamber of commerce'" (Danner Depo. Exh. 39, starting at TTABVUE 89/189).

These forty-five examples of third-party chambers of commerce located by the Board in the record are listed below:

U.S. Hispanic Women's Chamber of Commerce.²¹
United States African American Chamber of Commerce.²²
United States Black Chamber of Commerce.²³
United States American Indian Chamber of Commerce.²⁴
United States Christian Chamber of Commerce.²⁵
United States Indian American Chamber of Commerce.²⁶

²¹ Resp. 2nd NOR Exh. 70 (TTABVUE 97/200); Danner Depo. Exh. 50 (at Bates No. H08129, TTABVUE 94/66).

²² Resp. 2nd NOR Exh. 65 (TTABVUE 97/64); Danner Depo. Exh. 50 (at Bates No. H08124, TTABVUE 94/61).

²³ Resp. 2nd NOR Exh. 16 (TTABVUE 97/90); Danner Depo. Exh. 50 (at Bates No. H08073, TTABVUE 94/11).

²⁴ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06868, TTABVUE 89/111)

²⁵ Resp. 2nd NOR Exh. 159 (TTABVUE 98/82); Danner Depo. Exh. 50 (at Bates No. H08230, TTABVUE 94/167); Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06867, TTABVUE 89/110).

²⁶ Encyclopedia of Associations (Danner Depo. Exh. 48 at Bates No. H08039, TTABVUE 93/290).

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U.S. Pan Asian American Chamber of Commerce.²⁷
United States Junior Chamber of Commerce.²⁸
U.S. Women's Chamber of Commerce.²⁹
U.S. Africa Chamber of Commerce.³⁰
U.S. Algerian Chamber of Commerce.³¹
U.S.-Angola Chamber of Commerce.³²
United States-Arab Chamber of Commerce.³³
United States Asian Chamber of Commerce.³⁴
United States Austrian Chamber of Commerce.³⁵
United States Azerbaijan Chamber of Commerce.³⁶

²⁷ Encyclopedia of Associations (Resp. 2nd NOR Exh. 2 at Bates No. H07994, TTABVUE 97/48); Resp. 2nd NOR Exh. 180 (TTABVUE 98/142); Danner Depo. Exh. 50 (at Bates No. H08270, TTABVUE 94/207).

²⁸ Business Organizations & Agencies Directory (Danner Depo. Exh. 1 at Bates No. H07981, TTABVUE 97/35); Reg. No. 1426110 (Resp. Am. 1st NOR Exh. 17 TTABVUE 74/93); Danner Depo. Exh. 36 (Google "hitlist" at Bates H06874, TTABVUE 89/117).

²⁹ Dorfman Depo.; Supp. Reg. No. 2887973 (Pet. 5th NOR (TTABVUE 117/5); Resp. Am. 1st NOR Exh. 47 (TTABVUE 74/160); Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06869, TTABVUE 89/112). Petitioner asserts that it is "protesting" use of this mark. The record shows that this consists of a single cease and desist letter sent on December 19, 2002. Herrera Depo. Exh. 1 (TTABVUE 118/1-24). Also, even if petitioner is "protesting" use of this mark, the mark nonetheless appears in the publicly-available sources cited above and thus is probative evidence under the sixth *du Pont* factor.

³⁰ Listing in 411.com (Danner Depo. Exh. 35 at Bates No. H01524, TTABVUE 88/312).

³¹ Resp. 2nd NOR Exh. 72 (TTABVUE 97/204); Danner Depo. Exh. 50 (at Bates No. H08131, TTABVUE 94/68).

³² Website us-angola.org (Danner Depo. Exh. 44 at Bates No. H06158, TTABVUE 91-76); Encyclopedia of Associations (2nd NOR Exh. 2 at Bates No. H07993, TTABVUE 97/47); Danner Exh. 36 (Google "hitlist" at Bates No. H06866, TTABVUE 89/109).

³³ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06866, TTABVUE 89/109).

³⁴ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06868, TTABVUE 89/111).

³⁵ Hofer Deposition; Website usaustrianchamber.com (Danner Depo. Exh. 44 at Bates No. H06164, TTABVUE 91/82); Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06865, TTABVUE 97/108).

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U.S.-Baltic Chamber of Commerce.³⁷
Central America-United States Chamber of Commerce.³⁸
Chile-U.S. Chamber of Commerce.³⁹
U.S. Chinese Chamber of Commerce.⁴⁰
United States Colombian Chamber of Commerce.⁴¹
Costa Rica-United States Chamber of Commerce.⁴²
United States-Democratic Republic of Congo Chamber of
Commerce.⁴³
Ecuadorian-U.S. Chamber of Commerce.⁴⁴
U.S. Egypt Chamber of Commerce.⁴⁵
U.S. Guatemala Chamber of Commerce.⁴⁶
Indo-U.S. Chamber of Commerce.⁴⁷

³⁶ Iskandarov Depo.; Website usacc.org (Danner Depo. Exh. 44 at Bates No. H06166, TTABVUE 91/84); [Encyclopedia of Associations](#) (Resp. 2nd NOR Exh. 2 at Bates No. H07993, TTABVUE 97/47); Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06866, TTABVUE 97/109).

³⁷ Resp. 2nd NOR Exh. 29 (TTABVUE 97/118); Danner Depo. Exh. 50 (at Bates No. H08087, TTABVUE 94/25).

³⁸ Listing from website WorldChambers.com (Danner Depo. Exh. 43 at Bates No. H06538, TTABVUE 90/66); Resp. 2nd NOR Exh. 90 (TTABVUE 97/240); Danner Depo. Exh. 50 at Bates No. H08150, TTABVUE 94/87).

³⁹ Danner Depo. Exh. 39 (Google "hitlist" at Bates No. H06958, TTABVUE 89/201).

⁴⁰ Resp. 2nd NOR Exh. 69 (TTABVUE 97/198); Danner Depo. Exh. 50 (at Bates No. H08128, TTABVUE 94/65).

⁴¹ Resp. 2nd NOR Exh. 149 (TTABVUE 98/58); Danner Depo. Exh. 50 (at Bates No. H08326, TTABVUE 94/153).

⁴² Resp. 2nd NOR Exh. 13 (TTABVUE 97/86); Danner Depo. Exh. 50 (at Bates No. H08070, TTABVUE 94/8).

⁴³ Resp. 2nd NOR Exh. 63 (TTABVUE 97/186); Danner Depo. Exh. 50 (at Bates No. H08122, TTABVUE 94/59).

⁴⁴ Danner Depo. Exh. 39 (Google "hitlist" at Bates No. H06964, TTABVUE 89/207).

⁴⁵ Resp. 2nd NOR Exh. 30 (TTABVUE 97/120); Danner Depo. Exh. 50 (at Bates No. H08088, TTABVUE 94/26); Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06930, TTABVUE 89/173).

⁴⁶ Danner Depo. Exh. 35 (listing in 411.com at Bates No. H01528, TTABVUE 89/5).

⁴⁷ Danner Depo. Exh. 39 (Google "hitlist" at Bates No. H06947, TTABVUE 89/190).

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U.S. Kazakhstan Chamber of Commerce.⁴⁸
United States Laotian Chamber of Commerce.⁴⁹
United States Mexico Chamber of Commerce.⁵⁰
United States-Mozambique Chamber of Commerce.⁵¹
U.S.-Nigeria Chamber of Commerce.⁵²
Pacific U.S. Chamber of Commerce.⁵³
United States Pacific Rim Chamber of Commerce.⁵⁴
United States Pakistan Chamber of Commerce.⁵⁵
Portugal-U.S. Chamber of Commerce.⁵⁶
U.S. Poland Chamber of Commerce.⁵⁷
U.S. Puerto Rican Chamber of Commerce.⁵⁸
U.S.-Russia Chamber of Commerce.⁵⁹
U.S. Salvadoran Chamber of Commerce.⁶⁰

⁴⁸ Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06944, TTABVUE 89/187).

⁴⁹ Resp. 2nd NOR Exh. 17 (TTABVUE 97/94); Danner Depo. Exh. 50 (at Bates No. H8074, TTABVUE 94/12).

⁵⁰ Zapanta Depo.; Encyclopedia of Associations (Resp. 2nd NOR Exh. 2 at Bates No. H07994, TTABVUE 97/48); Resp. 2nd NOR Exh. 192 (TTABVUE 98/168); Danner Depo. Exh. 50 (at Bates No. H08286, TTABVUE 94/223); Danner Exh. 36 (Google "hitlist" at Bates No. H06865, TTABVUE 89/108).

⁵¹ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06871, TTABVUE 89/114).

⁵² Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06941, TTABVUE 89/184).

⁵³ Business Organizations and Agencies Directory (Danner Depo. Exh. 47 (at Bates No. H07981, TTABVUE 93/228)).

⁵⁴ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06871, TTABVUE 89/114).

⁵⁵ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06872, TTABVUE 89/115).

⁵⁶ Danner Depo. Exh. 44 (portugal-us.com website at Bates No. H06434, TTABVUE 92/22).

⁵⁷ Danner Depo. Exh. 35 (listing in 411.com at Bates No. H01530, TTABVUE 89/6).

⁵⁸ Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06933, TTABVUE 89/176).

⁵⁹ Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06929, TTABVUE 89/172).

Spain-U.S. Chamber of Commerce.⁶¹
U.S. Tajikistan Chamber of Commerce.⁶²
Uruguay-U.S. Chamber of Commerce, Inc.⁶³
United States-Venezuela Chamber of Commerce.⁶⁴
U.S. Vietnam Chamber of Commerce.⁶⁵

Also of probative value, albeit perhaps of less direct probative value than that of the above-referenced marks combining U.S.- or UNITED STATES-formatives and CHAMBER OF COMMERCE, the record also shows many hundreds of third-party chambers of commerce in the United States which combine CHAMBER OF COMMERCE with the descriptive and/or geographically descriptive "AMERICA(N)-formative" in their marks. Examples include:

French-American Chamber of Commerce.⁶⁶
Swedish-American Chambers of Commerce USA.⁶⁷
Belgian-American Chamber of Commerce.⁶⁸

⁶⁰ Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06931, TTABVUE 89/174).

⁶¹ Brown Depo.; Encyclopedia of Associations (Resp. 2nd NOR Exh. 2 at Bates No. H07993, TTABVUE 97/47); Danner Depo. Exh. 44 (TTABVUE 91/76 - 92/111.)

⁶² Danner Depo. Exh. 35 (listing in 411.com, at Bates No. H01520, TTABVUE 89/6).

⁶³ Resp. 2nd NOR Exh. 71 (TTABVUE 97/202); Danner Depo. Exh. 50 (at Bates No. H08130, TTABVUE 94/67).

⁶⁴ Danner Depo. Exh. 36 (Google "hitlist" at Bates No. H06876, TTABVUE 89/119).

⁶⁵ Danner Depo. Exh. 38 (Google "hitlist" at Bates No. H06932, TTABVUE 89/175).

⁶⁶ Ginnane-Singer Depo.; U.S. Reg. No. 2452532 (Resp. Am. 1st NOR Exh. 28).

⁶⁷ Carlson Depo.

⁶⁸ Raeymaekers Depo.

Jewish American Chamber of Commerce.⁶⁹
American Muslim Chamber of Commerce.⁷⁰
American Arab Chamber of Commerce.⁷¹
European American Chamber of Commerce.⁷²
American Chinese Chamber of Commerce.⁷³
Italy-America Chamber of Commerce.⁷⁴
German American Chamber of Commerce.⁷⁵
Russian-American Chamber of Commerce.⁷⁶

As discussed above in connection with respondent's counterclaims, we cannot find that petitioner's mark U.S. CHAMBER OF COMMERCE is a generic designation as applied to a chamber of commerce organization operating in the United States. Based on the evidence set out above, however, and on the face of the mark itself, we find that petitioner's mark, which consists of what we deem to be the highly descriptive and/or geographically descriptive designation "U.S." combined with the obviously generic designation "CHAMBER OF COMMERCE," is highly descriptive and inherently weak as applied to such services.

⁶⁹ Resp. 2nd NOR Exh. 46 (TTABVUE 97/151); Danner Depo. Exh. 50 (at Bates No. H09104, TTABVUE 94/42).

⁷⁰ Resp. 2nd NOR Exh. 35 (listing in 411.com (TTABVUE 97/130); Danner Depo. Exh. 50 (at Bates No. H080093, TTABVUE 94/31).

⁷¹ Website americanarab.com (Danner Exh. 44 at Bates H06176, TTABVUE 91/94).

⁷² U.S. Reg. No. 3197790 (Resp. Am. 1st NOR Exh. 25).

⁷³ Resp. 2nd NOR Exh. 32 (TTABVUE 97/123); Danner Depo. Exh. 50 (at Bates No. H08090, TTABVUE 94/28).

⁷⁴ U.S. Reg. No. 1744753 (Resp. Am. 1st NOR Exh. 15).

⁷⁵ U.S. Reg. No. 2842342 (Resp. Am. 1st NOR Exh. 30).

⁷⁶ U.S. Reg. No. 2208534 (Resp. Am. 1st NOR Exh. 41).

Indeed, we find that the mark is so highly descriptive and inherently weak as applied to such services that relevant purchasers, including American businesses which are doing business or seeking to do business in the United States or in other countries, upon encountering chambers of commerce operating in the United States using marks or names which include or incorporate the highly descriptive designation "U.S." or "United States" and the generic designation "chamber of commerce," will readily look to other elements in the marks in order to distinguish the various chambers as to source. *See Rocket Trademarks Pty Ltd., supra*, 98 USPQ2d 1066 at 1077.

We acknowledge that the Internet printouts and other documentary evidence of third-party marks submitted by respondent are proof only of what they show on their face, i.e., that these references to third-party chambers of commerce in various sources exist and are readily accessible by basic searches of those sources. However, we will accord them the probative value to which they are entitled. Moreover, as to many of the particular third-party chambers listed above, the record includes references to them from multiple sources, which, when considered together, tend to corroborate each other on the question of these third parties' use of their marks. *In re Broadway Chicken Inc.*, 38 USPQ2d 1559, 1565 n.16 (TTAB 1996).

In any event, whatever the limitations in the probative value of each particular item of evidence as evidence of third-party use, we find that the sheer number of such references to third-party chambers of commerce operating in the United States with marks that combine U.S./UNITED STATES-formatives with CHAMBER OF COMMERCE, together with the testimony of respondent's witnesses from various third-party chambers of commerce as to their chambers' use of such marks, is sufficient, as a whole, to establish the inherent weakness and highly descriptive significance of those designations and of the marks that contain them, including petitioner's mark, as applied to chambers of commerce operating in the United States. *See Rocket Trademarks Pty Ltd., supra*, 98 USPQ2d 1066 at 1077; *In re Broadway Chicken Inc., supra*, 38 USPQ2d 1559 at 1565 n.16.

Petitioner argues that the evidence does not show any third-party use of "a variant of the 'U.S. Chamber of Commerce' formative in connection with services consumers might perceive as related to the association services or chamber of commerce services at issue here." (Petitioner's Main Brief at 42.) For the reasons discussed above, we disagree. Also and as a general point, to the extent that petitioner might be arguing that the mark and services of a third party will be deemed to be "similar" for purposes of the sixth *du Pont* factor only if they also would be deemed

to be confusingly similar under the more stringent standards of the first and second *du Pont* factors, we find that argument to be unsupported and unpersuasive.

Petitioner argues that respondent's evidence of third-party use is insufficient under the sixth *du Pont* factor due to the dissimilarity of the third parties' services from petitioner's services. Petitioner argues that essentially all of these third parties are what is known as "bi-lateral" chambers of commerce, which are "small, niche organizations that are set up in the United States to encourage and facilitate trade with businesses in a foreign country (or region)," and are directed only to those "with a keen interest in doing business in the foreign country." (Petitioner's Reply Brief at 9.)

This argument is unpersuasive. Initially, we note that the first nine of the forty-five third-party chambers listed above are not such "bi-lateral" chambers. Also, even as to the bi-lateral chambers, although their chamber of commerce services may focus on promoting and facilitating trade in foreign countries, they, like petitioner, still are operating in the United States and rendering their services to American businesses.

Moreover, the record shows that petitioner itself is involved in promoting trade for U.S. businesses in foreign countries, and indeed touts that aspect of its chamber of

commerce services. Exhibit 1 to the testimony deposition of Patricia Cole is petitioner's "Member Resource Guide" which is given to new members and which explains petitioner's activities and resources. (Cole Depo. Exh. 1, at Bates 54420, TTABVUE 49/154.) Among those activities and resources is petitioner's "International Division," assertedly devoted to "Representing U.S. Business Abroad." The Guide informs new members that "[t]he Chamber works with more than 100 American Chambers of Commerce Abroad in more than 80 countries, many of which sponsor business development programs and distribute publications about business in particular countries." (Cole Depo. Exh. 1 at Bates 54442, TTABVUE 49/176.)

Petitioner next argues (Petitioner's Reply Brief at 10) that the "U.S.-[country]" bi-lateral marks like 'U.S.-Mexico Chamber of Commerce,' on one hand, and marks "in which 'U.S.' modifies a *known descriptive reference* for a large portion of the U.S. population" (Petitioner's Reply Brief at 10; emphasis in original), like "U.S. Hispanic Chamber of Commerce" or "U.S. Women's Chamber of Commerce," on the other hand, are fundamentally different in structure. Petitioner argues that the structure of the geographical bi-lateral marks distinguishes those marks from petitioner's mark, such that purchasers would not assume an affiliation or connection between petitioner and those bi-lateral

chambers, "thus making them irrelevant to the analysis here." (Petitioner's Main Brief at 42, n.19.)

Petitioner further argues that, conversely, the third-party marks in which "U.S." modifies a broad demographic group in the United States, such as "Hispanic" or "Women's," are in fact similar to petitioner's mark and that purchasers on that basis would assume an affiliation or connection between petitioner and those third-party chambers.

Petitioner contends that this purported distinction between bi-lateral chamber marks and demographic group marks in terms of their relevance under the sixth *du Pont* factor is borne out by the fact that there has been actual confusion between petitioner's mark and the demographic group marks UNITED STATES HISPANIC CHAMBER OF COMMERCE and U.S. WOMEN'S CHAMBER OF COMMERCE, but there has been no actual confusion between petitioner's mark and the bi-lateral marks.

We are not persuaded by this argument. First and as a general point, we have already rejected petitioner's apparent or implied argument that in order to be relevant to the analysis under the sixth *du Pont* factor, a third party's mark and services must be so similar under the first and second *du Pont* factors as to cause a likelihood of confusion. (See discussion above.) To the extent that petitioner is now arguing that the only relevant third-party marks and services under the sixth *du Pont* factor are those

as to which there assertedly has been actual confusion with petitioner's mark, we likewise reject that argument, a *fortiori*. In any event, and as discussed at length below, we find that petitioner has failed to support its claim that there has been significant actual confusion between the parties' marks in this case.

More specifically as to petitioner's argument based on the purported distinction, for purposes of the sixth *du Pont* factor in this case, between the third-party geographical bi-lateral marks and demographic group marks, we are not persuaded because we find it to be unlikely that relevant purchasers would parse the third-party marks that carefully or distinguish them on that basis. Second, we note again that of the forty-five third-party marks listed above, the first nine in fact are not geographical bi-lateral chamber marks but rather are marks like respondent's which, according to petitioner's proffered distinction, identify chambers directed to different U.S. demographic groups like HISPANIC and WOMEN'S.

Finally, and in any event, we find that regardless of whether the additional designations in the marks modified by "U.S." or "United States" be bi-lateral country designations or demographic group designations, purchasers will use either and both of those designations to distinguish source when they encounter marks like petitioner's and

respondent's, which otherwise consist merely of the inherently weak combination of the highly descriptive and/or geographically descriptive designation "U.S.,"/"United States" and the generic designation "Chamber of Commerce."

We disagree with petitioner's contention that "[u]se of bilateral chamber names are simply not dilutive."

(Petitioner's Reply Brief at 10.)

As stated above, we find that petitioner's mark on its face is inherently weak. We further find, under the sixth *du Pont* factor, that the documentary evidence in the record showing the sheer number of references in publicly-available databases and other sources to third-party chambers of commerce operating in the United States with marks that combine U.S./UNITED STATES with CHAMBER OF COMMERCE, as well as the testimony of respondent's witnesses from various third-party chambers of commerce as to their chambers' use of such marks in the United States, are sufficient, viewed as a whole, to establish the inherent weakness and highly descriptive significance of the designations U.S./UNITED STATES and CHAMBER OF COMMERCE and of marks that employ those designations, both in terms of third-party use in the marketplace and in the manner of dictionary definitions.

The predecessor to our primary reviewing court stated long ago:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.

Sure-Fit Products Co. v. Saltzon Drapery Co., 254 F.2d 158, 160, 117 USPQ 295, 297 (CCPA 1958). Likewise in a more recent case involving the mark SPORTSMAN'S WAREHOUSE, the Board stated:

Moreover, it is well settled that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term.

Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc., 89 USPQ2d 1844, 1857 (TTAB 2008).

Similarly in this case, we find that petitioner's mark is inherently weak and highly descriptive, and that it is entitled only to the narrow scope of protection afforded to such inherently weak marks.

Strength of Petitioner's Mark: Conclusion.

We find that petitioner's mark has achieved a degree of fame for purposes of the fifth *du Pont* factor, and that this

fame is entitled to significant weight in our overall likelihood of confusion analysis.

However, we also find, under the sixth *du Pont* factor, that petitioner's mark is highly descriptive and inherently weak as applied to chamber of commerce services rendered in the United States, both on its face and as demonstrated by the abundant evidence of third-party use. In accordance with the above-quoted language from the *Sure-Fit* and *Sportsman's Warehouse* cases, we find that petitioner's mark therefore is entitled only to a very narrow scope of protection vis-à-vis respondent's mark.

Considering all of the evidence pertaining to the strength of petitioner's mark as contemplated by the fifth and sixth *du Pont* factors, we find, in our overall likelihood of confusion analysis, that the highly descriptive nature and the inherent weakness of petitioner's mark outweighs the marketplace fame of petitioner's mark. We therefore find, as to the strength of petitioner's mark under the fifth and sixth *du Pont* factors, that petitioner's mark on balance is entitled to a narrowed scope of protection.

Du Pont Factor 1: Similarity of the Marks.

Under the first *du Pont* factor, we determine the similarity or dissimilarity of petitioner's mark and

respondent's mark when they are viewed in their entireties in terms of appearance, sound, connotation and commercial impression. Petitioner's mark is U.S. CHAMBER OF COMMERCE. The mark respondent seeks to register on the Principal Register is depicted below:



Although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be found to be more significant than another in terms of the mark's function as a source-indicator, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark, and in comparing the marks at issue under the first *du Pont* factor. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004). "Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

In this case, we find that the dominant feature of respondent's mark is its design element, i.e., the circular

"seal" with the concentric display of stars and the large depiction of the integrated "H" and eagle feature. This design element comprises the largest and most prominent element of the mark viewed in its entirety. The wording in the mark, UNITED STATES HISPANIC CHAMBER OF COMMERCE, is not only disclaimed as descriptive and generic wording, it also appears in very small lettering in the mark.

Petitioner contends that it is the wording UNITED STATES HISPANIC CHAMBER OF COMMERCE that is the dominant feature of respondent's mark. Petitioner argues:

The "design" of the U.S. Hispanic Chamber composite mark, however, merely functions to add common elements of American federalism - a circular "seal" effect (with the organization's name written around the perimeter), an eagle, stars - and the letter "H" (which stands for "Hispanic")... Indeed, the logo is typical of almost any number of government agencies or departments that use circles, eagles and stars, including the seal of the President of the United States.

Petitioner argues that consumers will be apt to "filter" these design elements out, and will focus instead on the wording in the mark. (Petitioner's Reply Brief at 16.)

We find this argument to be wholly unpersuasive; neither petitioner nor respondent is a government agency.

Petitioner also argues that in a composite word-and-design mark it is usually the words that dominate the mark, citing *In re Appetito Provisions Co. Inc.*, 3 USPQ2d 153

(TTAB 1986) and *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). We find those cases to be readily distinguishable from the present case. In both of those cases, the wording in the mark was highly distinctive, being either suggestive (APPETITO) or arbitrary (GIANT). In this case, however, the wording in respondent's mark is merely descriptive and/or generic, and disclaimed.

We find that it is the distinctive and prominent design element which dominates respondent's mark. Indeed, we find that the design element dominates respondent's mark to such a large degree that when respondent's mark and petitioner's mark are compared in their entireties, the design element in respondent's mark suffices, by itself, to immediately and clearly distinguish the two marks in terms of appearance and commercial impression.

As for the sound and the connotation of the marks, we find that the marks differ in sound as to "U.S." in petitioner's mark and "UNITED STATES" in respondent's mark, and also as to the presence of the "H" (if vocalized) and the word "HISPANIC" in respondent's mark. In terms of connotation, each mark connotes chamber of commerce services by the use of the words CHAMBER OF COMMERCE, and that each party is rendering its chamber of commerce services in the United States. However, we find that the presence of the

word HISPANIC in respondent's mark distinguishes the marks in terms of connotation, in that it informs purchasers that respondent's chamber of commerce services are directed specifically to Hispanic businesses, a connotation petitioner's mark does not have.

In support of its argument that the word portions of the respective marks are similar, petitioner relies on two instances where a person who purportedly was intending to refer to one of the parties referred to the other one instead.

First, petitioner relies on an exchange which occurred in the testimony deposition of respondent's former president, Mr. Nino, during direct examination by respondent's counsel [the "Foundation" is respondent's affiliated foundation, the United States Hispanic Chamber of Commerce Foundation]:

Q. In your understanding, what are the differences between the services offered by the Foundation and by the U.S. Chamber of Commerce?

A. The U.S. Hispanic Chamber of Commerce is real clear. It supports the Hispanic chamber of commerce and its members, its Hispanic business members, to help them with their business and economic development. The Foundation is an educational institution that promotes, molds, enhances the educational experience of Hispanic youth that is looking to go into Hispanic Business or someday work in corporate America or government.

...

Q. So how do the services of the Foundation differ from those of the U.S. Chamber of Commerce?

A. Well, first of all, the ones for the Foundation are exclusively for youth. Those of the U.S. Hispanic Chamber of Commerce is for existing business.

Q. No, I'm talking about the U.S. Chamber of Commerce.

A. Oh, the U.S. Chamber of Commerce.

(Nino Depo. at 27-28.)

We are not persuaded that this exchange during Mr. Nino's deposition is probative evidence which supports a finding that the parties' marks are so similar as to create a likelihood of confusion. The deposition transcript shows that essentially all of the questioning by respondent's counsel up to that point had been focused on detailed questions regarding the formation, purposes and activities of the "United States Hispanic Chamber of Commerce" and its Foundation. The questioning (quoted above) then turned abruptly to a question about the "U.S. Chamber of Commerce." In answering, Mr. Nino obviously thought that the questioning continued to be about the United States Hispanic Chamber of Commerce. His answer referring to the United States Hispanic Chamber of Commerce rather than to the U.S. Chamber of Commerce obviously resulted from his failure to "switch gears" in following the thread of the questioning. We do not agree with petitioner's contention that Mr. Nino

said respondent's name when he was meaning to say petitioner's name, or that this is evidence of any confusingly similarity between the parties' names or marks themselves. Instead, it is obvious that he simply misunderstood or misheard the question because, again, he did not realize or follow the abrupt change in counsel's line of questioning.

The second instance upon which petitioner relies in support of its claim that the parties' marks are so similar as to create a likelihood of confusion is a March 24, 2004 speech given by former president George W. Bush at respondent's annual convention. (Petitioner's 4th Notice of Reliance (TTABVue 64).) In his introductory remarks thanking respondent for his invitation to speak, Mr. Bush named several people affiliated with respondent. At one point he said: "So, Hector Barreto, Sr., I appreciate you here. He's the co-founder of U.S. Hispanic Chamber of Commerce." Then a few seconds later he said: "I appreciate so very much J.R. Gonzales, the Chairman and Acting President of the U.S. Chamber."

Petitioner's 4th Notice of Reliance states that this evidence is offered "as an example of how the name 'United States Hispanic Chamber of Commerce' can be and frequently is truncated to just the name 'U.S. Chamber,' which is Petitioner's registered trademark." We assume that by

"truncated," petitioner means that Mr. Bush was using "U.S. Chamber" as a shorthand way of referring to the "United States Hispanic Chamber of Commerce." However, we find this proposed interpretation of Mr. Bush's remarks to be highly speculative. Moreover, even assuming that this incident is an instance of a "truncation" of respondent's mark, we find that such a truncation was not due to any similarity between the parties' marks or to any source confusion, but rather is more likely to have been merely an unremarkable misstatement by the former president. It certainly appears to be merely an isolated incident; it does not support petitioner's contention that such "truncation" happens "frequently."

As discussed at length above in connection with the sixth *du Pont* factor as well as respondent's genericness counterclaims, we find that petitioner's mark U.S. CHAMBER OF COMMERCE is inherently weak. In view thereof, and as the Board stated in *Bass Pro, supra*:

... Moreover, it is well settled that when a mark, or a portion of a mark, is inherently weak, it is entitled to a narrow scope of protection. In other words, when a business adopts a mark incorporating a descriptive term, it assumes the risk that competitors may also use that descriptive term.

Bass Pro Trademarks LLC, supra, 89 USPQ2d 1844 at 1857.

Similarly, the court's analysis in *Sure-Fit* is relevant here. The court was "strongly influenced" by the fact that SURE-FIT and RITE-FIT, for furniture slip-covers, are the "weakest possible type of mark." The court found: "Under these circumstances, we do not feel that appellant [the owner of the SURE-FIT mark] is entitled to the broad protection which it seeks. What appellant is in effect asking us to do is to allow it, at least insofar as registration is concerned, to pre-empt the field as far as the word 'Fit' is concerned." *Sure-Fit Products Co. supra*, 117 USPQ at 297. The court further stated:

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights.

(*Id.*)

Likewise in the present case, we find that petitioner, although it is claiming to the contrary, essentially is asking us to allow it to preempt the field as far as marks containing both "U.S." and "CHAMBER OF COMMERCE." We find that, given the inherent weakness of petitioner's mark, the features respondent has added to its own mark, most of all the addition of the clearly dominant and prominent design element to the inherently weak wording appearing in its

mark, are quite sufficient to distinguish respondent's mark from petitioner's mark, for purposes of our likelihood of confusion analysis in this case.

This is so, notwithstanding the high degree of similarity between the parties' respective services, and the fact that petitioner's mark has achieved a degree of fame. Those factors expand the normal scope of protection to which petitioner's mark is entitled. However, we find that any such expansion is effectively countered and in fact overridden by the inherent and demonstrated weakness of petitioner's mark. We find that the scope of protection to be afforded to petitioner's mark does not extend so far as to preclude registration of respondent's fundamentally dissimilar mark.

For these reasons, we find, under the first *du Pont* factor, that the parties' marks are dissimilar when compared in their entirety as to appearance, sound, connotation and commercial impression. We have considered all of petitioner's arguments and evidence to the contrary, including those not specifically discussed in this opinion, but we are not persuaded by them.

Du Pont Factor 7: Actual Confusion.

Under the seventh *du Pont* factor, we consider evidence pertaining to "the nature and extent of any actual

confusion." Petitioner asserts that the evidence of record establishes that there have been numerous instances of actual confusion in the marketplace between its mark and respondent's mark as used in connection with the parties' similar services, and that such actual confusion is indeed conclusive evidence supporting a finding of likelihood of confusion. Respondent in turn argues that petitioner's evidence fails to establish that any legally-cognizable actual confusion has occurred.

For the reasons discussed below, we find on this record that petitioner has failed to prove the existence of actual confusion as contemplated by the seventh *du Pont* factor. However, because proof of actual confusion is not required in order to sustain a likelihood of confusion claim, we find that the seventh *du Pont* factor is neutral in our likelihood of confusion analysis in this case.

In making our determination regarding actual confusion, the issue is whether there has been actual confusion among relevant purchasers. *See, e.g., Sunenblick v. Harrell*, 38 USPQ2d 1716, 1728 (S.D.N.Y. 1995), *aff'd without op.*, 101 F.3d 684 (2d Circuit 1996) ("the relevant confusion to be avoided is that which affects purchasing decisions, and not confusion generally"). In this case, petitioner argues, and we find, that the relevant class of purchasers for purposes of analyzing actual confusion (and the extent of the

opportunity for actual confusion) in this case are Hispanic businesses and chambers of commerce. Petitioner has identified this "market niche" as the relevant class of purchasers for purposes of the actual confusion analysis.⁷⁷ It is this class of purchasers that petitioner is claiming have been actually confused by respondent's use of its mark and who are likely to be confused by respondent's continued use of its mark.

Second, our findings as to actual confusion must be based on a consideration of the parties' marks in their entirety, as they appear in their respective registrations. In *Bass Pro, supra*, where the parties' marks included the wording SPORTSMAN'S WAREHOUSE but other elements as well, the Board noted:

Petitioner has introduced evidence of actual confusion based on each party's use of the term "Sportsman's Warehouse." However, the instances of confusion were based on the term "Sportsman's Warehouse," not on the marks at issue: the marks in petitioner's registration and respondent's registration.

Bass Pro, supra, 89 USPQ2d 1844 at 1858.

⁷⁷ See Petitioner's Reply Brief at 7, where petitioner argues that there has been no significant opportunity for actual confusion to have occurred because "until very recently, the U.S. Chamber had not specifically recruited minority-owned businesses to join as members"; and that it has "the presumptive right to exploit more fully that market niche."

In this case, petitioner's registered mark in its entirety is the standard character mark consisting of the highly descriptive and inherently weak wording U.S. CHAMBER OF COMMERCE. Respondent's registered mark in its entirety is the composite mark depicted previously in this opinion, consisting of a highly distinctive circular seal encompassing the H/Eagle and stars design elements and the highly descriptive and/or generic and disclaimed wording UNITED STATES HISPANIC CHAMBER OF COMMERCE. It is these two marks, as registered and in their entireties, that we must consider in our actual confusion analysis.

We turn now to consideration of petitioner's evidence in support of its actual confusion allegations under the seventh *du Pont* likelihood of confusion factor.

Petitioner asserts:

As the U.S. Chamber has begun to market itself and its services more aggressively to self-identified women and minority businesses, however, it has repeatedly run into a significant problem. Time and again, women and minorities who have already been exposed to the marks of either of the two specialized chambers operating in those areas mistakenly believe that petitioner's use of its marks is actually a reference to one of the specialized chambers. This 'reverse confusion' significantly restricts the U.S. Chamber's ability to use its registered U.S. CHAMBER OF COMMERCE marks for the full range of covered services."

(Petitioner's Main Brief at 21.) Petitioner similarly asserts:

... there has been real confusion in the marketplace ever since the parties began marketing to the same groups of consumers. Indeed, the record evidence does not reflect a mere "[f]our or five tenuous instances of actual confusion" over twenty-five years, as Respondent would like to suggest, *see Resp. Br. p.3*, but rather *dozens* of instances *during just the past few years*, which is when the parties began to compete with one another in earnest.

(Petitioner's Reply Brief at 1; emphasis in original.)

Petitioner also asserts: "Once the U.S. Chamber began actively reaching out to Hispanic-owned businesses, however, marketplace confusion quickly followed. The problem of 'actual confusion,' is therefore not *de minimus* ... but, rather, represents a real and growing threat."

(Petitioner's Reply Brief at 1.)

In support of these assertions, petitioner has submitted and relies on the testimony depositions (with exhibits) of its witnesses Lucia Olivera, Rita Perlman, Lydia Logan, and Daniel Ramos. We shall take each of these witnesses in turn.⁷⁸

⁷⁸ As was the case with the previous section of our opinion dealing with the fame of petitioner's mark under the fifth *du Pont* factor, respondent has objected to essentially all of petitioner's proffered evidence on this seventh factor pertaining to actual confusion. Also as was the case in respondent's objections to petitioner's fame evidence, most of respondent's objections to petitioner's actual confusion evidence are not evidentiary objections to the admissibility of petitioner's evidence, but rather are more properly characterized as arguments regarding the probative value of petitioner's evidence, and we have disregarded them to the extent that they are not also set forth in the body of respondent's briefs. As to the actual evidentiary objections, we find that most of them are not well-taken. To the extent that they are relevant to our findings of

Lucia Olivera.⁷⁹

Ms. Olivera currently is the manager for federation outreach for petitioner's Political Affairs and Federation Programs division. She formerly was associate manager for petitioner's "Access America" program. (Olivera depo. at 5.)

Ms. Olivera testified:

Access America is a program that was to provide information and resources to minority and women organizations. We had a website that had information on how to get certified if your business was 50 percent or more minority or women owned. We were trying to provide information for people wanting to do business with bigger organizations, information on supplier diversity programs, trying to get more minority and women owned businesses to attend the Chamber's small business summit, things like that.

(Olivera Depo. at 6-7.) Also, Ms. Perlman, the former executive director of the program, testified: "Access America is the U.S. Chamber of Commerce's women and minority outreach initiative. Through that program we put together

fact, we shall address them as appropriate in our opinion. All of respondent's other objections are overruled.

⁷⁹ In its Main Brief Appendix of evidentiary objections (at p. 24), respondent objects to portions of Ms. Olivera's testimony based on "lack of foundation" under Fed. R. Evid. 901. Aside from the words "Lacks Foundation" in the objection as stated, no specific basis for the objection is identified. The objection is overruled. Second, upon review of the relevant testimony, respondent's objections under Fed. R. Evid. 611(c) as to unspecified and allegedly "leading" questions are not well-taken and are overruled.

events, put together information resources, and managed a task force of individuals to target ethnicity groups to join the Chamber and help in the retention of membership."

(Perlman Depo. at 8.)

Ms. Olivera testified, as to her responsibilities as associate manager of Access America, that she attended conferences, lunches, dinners, receptions and trade shows. "The objective was to tell people about the U.S. Chamber and about what the U.S. Chamber was doing for women and for minorities and to ultimately get them to join the Chamber and become members." (Olivera Depo. at 10-11.)

The Access America program was begun in Spring 2002, shortly before these proceedings began. (Perlman Depo. at 39.) The program was terminated in December 2006, during the course of this proceeding. (Olivera Depo. at 47.)

In Fall 2006, Ms. Olivera attended respondent's annual National Convention and Business Expo, on behalf of Access America. (Olivera Depo. at 19-23.)

The Expo hosted some 4,000 attendees. (Lopez Depo. at 75.) They largely were representatives from local Hispanic Chambers of Commerce and Hispanic small business owners. (Olivera Depo. at 19-23.)

When she was asked why petitioner decided to have her attend this conference on behalf of Access America, Ms. Olivera testified:

Access America is a program that was targeted to minorities and women, and Hispanics are a large minority. We knew there would be a lot of Hispanics attending the conference, and we wanted to tell them about the U.S. Chamber of Commerce and the Access America program, so we thought it would be a good place to meet people to do that, people who would be interested in what we do.

(Olivera Depo. at 20-21.)

The convention featured many networking opportunities. (Olivera Depo. at 22-24.) Like all of the events she had attended on behalf of Access America, Ms. Olivera attended the convention largely in order to network with attendees, "and I would try to tell them about the U.S. Chamber and about what we did, and I would find out about their business and try to find a way to tell them that they should become members of the U.S. Chamber." (Olivera Depo. at 24.) Ms. Olivera testified:

Q. And what did you tend to do at these conferences and other events?

A. When I attended these events I would just go and talk to people and introduce myself, I would tell them that I was with the U.S. Chamber of Commerce and ask them if they were familiar with us, and typically they would say right away that they were familiar with us. I would tell them about the Chamber, ask them about their business, and try to find a connection between how the Chamber could help them and get their business cards and follow up with them.

Q. And when you would introduce yourself to people with whom you were networking at these events, how would you tend to introduce yourself?

A. Lucia Olivera with the U.S. Chamber of Commerce.

(Olivera Depo. at 12.)

At the convention, Ms. Olivera wore a convention name badge that identified her as "Lucia Olivera" above the words "U.S. Chamber of Commerce." Her badge, like all of the attendees' badges, also displayed respondent's logo (the mark respondent seeks to register). (Olivera Depo. at 27-28.) At the convention, respondent's logo was prominently displayed; "They had their logos everywhere, their names everywhere. It was their convention." (Olivera Depo. at 156.)

Ms. Olivera testified:

The first day that I got there, every time I introduced myself I would introduce myself as Lucia Olivera with the U.S. Chamber of Commerce, and right away the person I was talking to would say, "Oh, you're with the U.S. Hispanic Chamber of Commerce," or, "Oh, you are with USHCC", or "Oh, so you work with so and so in the Hispanic Chamber," or "Oh, we work with your boss a lot, Michael." I would have to clarify that I was with the U.S. Chamber of Commerce, not with the U.S. Hispanic Chamber of Commerce, and I would say something like, we represent Hispanics and non-Hispanics, or, we represent all business, or, we don't discriminate, ha-ha-ha. It basically happened every time I introduced myself to somebody at that conference. By the second day, when I introduced myself, to avoid confusion I would right away introduce myself as Lucia Olivera with the U.S. Chamber of Commerce, not the U.S. Hispanic Chamber of Commerce, or Lucia Olivera with the U.S. Chamber of Commerce, the one that serves all races or things like that. ... I was trying to avoid confusion because I realized on

the first day that everybody that I talked to pretty much was confusing me - right away when I said that I was with the U.S. Chamber of Commerce, everybody assumed that I was with the U.S. Hispanic Chamber of Commerce, so I was trying to be proactive and avoid confusion by doing that.

(Olivera Depo. at 25-27.)

Ms. Olivera testified that she engaged in dozens of these types of conversations on the first day of the convention. (Olivera Depo. at 106-108).

When asked about the fact that respondent's logo was displayed on her convention name badge, Ms. Olivera testified:

Q. Do you believe the confusion was caused by having the same logo on it?

A. Do I believe the confusion was brought on by the logo?

Q. Yes, at least in part.

A. I don't know.

Q. Well, in your particular instance do you believe that you were confused, that your place of employment was confused because you were wearing the badge with the logo on it?

A. I don't know what the confusion was about. I couldn't say. I mean, I never asked them, "Oh, did you confuse me because of the logo?" I have no way to know why they were confused. I just know they were.

Q. Did anybody at the convention tell you that the confusion was caused because you were wearing a badge with the Hispanic Chamber logo on it?

A. No.

(Olivera Depo. at 100-102.)

Ms. Olivera testified that as to these conversations she had at the respondent's convention, she cannot now name any specific person or organization who was actually confused as to respondent's and petitioner's names or organizations. (Olivera Depo. at 131-32.)

Ms. Olivera also testified that, during her time at Access America, she also had attended four or five other conferences, as well as various lunches, dinners, receptions, and trade shows, all on behalf of Access America. (Olivera Depo. at 10, 51-52.) Ms. Olivera testified that respondent's conference was the only time that she ever experienced any instances of apparent confusion, either before or after. (Olivera Depo. at 64-65, 155-56, 162-63.)

Petitioner argues that Ms. Olivera's testimony establishes numerous incidents of "reverse confusion," where attendees at respondent's own convention, at which respondent's logo was prominently displayed, including on Ms. Olivera's convention name badge, mistakenly assumed that she was with the United States Hispanic Chamber of Commerce, even though she introduced herself clearly as being from the U.S. Chamber of Commerce. Petitioner argues that these convention attendees are the very businesses and

organizations to whom petitioner is marketing its chamber of commerce services.

Respondent, for its part, argues that Ms. Olivera's testimony is merely anecdotal, that it does not identify any specific persons or organizations that allegedly were confused, nor the actual reasons for any such alleged confusion.

We find Ms. Olivera's testimony as to her experiences at respondent's convention to be unpersuasive and insufficient as evidence of actual source confusion, whether forward confusion or reverse confusion, caused by any alleged similarity between petitioner's and respondent's respective marks as viewed in their entireties.

We find that the attendees at respondent's convention, made up of Hispanic businesses and chambers of commerce, are among the relevant class of purchasers for purposes of our actual confusion analysis in this case.

However, we find that the probative value of Ms. Olivera's testimony as to these alleged instances of actual confusion is significantly lessened by the fact that her testimony is largely anecdotal. Of these allegedly dozens of conversations with convention attendees, Ms. Olivera could not identify any specific allegedly-confused persons with whom she had spoken, or the organizations they worked for. This is so, despite the fact that her whole purpose in

attending the convention was to network with the attendees and get their business cards and contact information, so that she could later undertake follow-up efforts to recruit them as potential new members of the U.S. Chamber.

We also find that these alleged instances of actual confusion are just as readily explainable by the fact that Ms. Olivera was attending respondent's own convention. In this regard, we find it to be significant that Ms. Olivera had attended four or five other minority-focused conventions and events on behalf of Access America, presumably events at which Hispanic businesses or chambers of commerce were present, but the only time she ever experienced any instances of alleged actual confusion was when she went to respondent's own convention. She had introduced herself at these other events in the same way that she had introduced herself at respondent's convention, i.e., "Lucia Olivera with the U.S. Chamber of Commerce." No one ever mistakenly assumed that she was with the United States Hispanic Chamber of Commerce at any of these events.

Finally, we cannot conclude on this record that the alleged actual confusion, if in fact it occurred, was based on the parties' marks viewed in their entireties. As discussed at length above, petitioner's mark consists of the highly descriptive and inherently weak wording U.S. CHAMBER OF COMMERCE. Likewise, the wording in respondent's mark,

UNITED STATES HISPANIC CHAMBER OF COMMERCE, is inherently weak. Respondent's mark, viewed in its entirety, includes its dominant circular seal design element. There is no evidence that the allegedly confused persons with whom Ms. Olivera conversed at the convention, if they in fact were confused, were confused as a result of their seeing respondent's logo mark as a whole, either as it appeared on Ms. Olivera's name badge or elsewhere at the convention. Ms. Olivera testified that she did not know if the allegedly confused persons were confused by the logo mark, either in whole or in part, and she specifically testified that no one ever told her that they were confused on that basis. We conclude that if there was any actual confusion at respondent's convention, it would likely have been caused merely by the appearance or verbal use of the inherently weak wording in petitioner's and respondent's marks in the conversations Ms. Olivera engaged in, and not as a result of any confusion as to respondent's mark as a whole.

In short, we are not persuaded that Ms. Olivera's experiences at respondent's convention necessarily were the result of actual confusion between petitioner's mark and respondent's mark on the part of convention attendees. Her testimony is merely anecdotal, and does not support a finding that the alleged actual confusion, if it occurred, was caused by respondent's mark as a whole and not merely by

the common presence in both marks of the highly descriptive and inherently weak designations U.S./UNITED STATES and CHAMBER OF COMMERCE.

Rita Perlman.⁸⁰

Ms. Perlman is currently Director of Operations for the Institute for Legal Reform, an affiliate organization of petitioner. (Perlman Depo. at 4-5.) Previously, she was the executive director of petitioner's Access America program, from January 2005 through the program's termination in December 2006. (Perlman Depo. at 7.)

Petitioner relies on Ms. Perlman's testimony to establish two instances of purported actual "reverse confusion" between petitioner's and respondent's marks.

First, in Fall 2006, Ms. Perlman, on behalf of Access America, attended an event sponsored by the Minority Business Enterprise in Washington, D.C. The Minority Business Enterprise is a government agency directed toward helping minority business enterprises do business with the federal government and supporting minority business in

⁸⁰ In its Main Brief Appendix of evidentiary objections (at p. 24), respondent objects to portions of Ms. Perlman's testimony based on "lack of foundation" under Fed. R. Evid. 901. Aside from the words "Lacks Foundation" in the objection as stated, no specific basis for the objection is identified. The objection is overruled. Second, upon review of the relevant testimony, Respondent's objections under Fed. R. Evid. 611(c) as to unspecified and allegedly "leading" questions are not well-taken. Respondent's objections to this testimony are overruled.

general. (Perlman Depo. at 28.) It holds an annual conference attended by some five hundred minority business owners and entrepreneurs, including Hispanic-owned businesses and state and local Hispanic chambers of commerce. (Perlman Depo. at 28-29, 77-78.) Ms. Perlman testified:

I was attending the exhibit hall, and at one point in time I went over to - it was a Florida Hispanic Chamber of Commerce, and I introduced myself and had some confusion in that conversation as well. ... I went up, and I was excited because now with Lucia [Olivera] coming on board I was able to do more outreach to ethnicity groups and not just focus on women. And when I went up to a gentleman looking for liaison partners I introduced myself as Rita Perlman from the U.S. Chamber of Commerce, and he instantly said, "Oh, you're with the Hispanic Chamber of Commerce," and I said, "No, I'm with the U.S. Chamber of Commerce." He was a little confused, not really understanding who the U.S. Chamber of Commerce was, but he was familiar with the Hispanic organization, and so I clarified with him, you know, what our organization did and why I was representing women and wanting to become possibly a partner to understand what his Chamber of Commerce was doing down in Florida.

(Perlman Depo. at 28-29.) During cross-examination regarding this incident, Ms. Perlman also testified:

I guess he made some assumption, I don't know exactly, but there was confusion about the fact that they thought that I was with the U.S. Hispanic Chamber. Through that conversation he may have assumed that, but I can't speak to him because I don't know what his thinking was when he asked me that question.

As for the second instance of purported actual reverse confusion involving Ms. Perlman, petitioner relies on Ms. Perlman's testimony (Perlman Depo. at 31-34) regarding an incident at a January 2007 reception in Washington, D.C. hosted by the Congressional Hispanic Caucus. She testified:

There was an instance where I was invited by our congressional office and independently got an invitation to the inauguration or I should say the induction of the new Congress, the Congressional Hispanic Caucus group here in D.C. ... And I went over, again just to be supportive and representative of the Chamber, and when I walked around and introduced myself as Rita Perlman from the U.S. Chamber, because it was a Hispanic event, they again thought I was from the Hispanic Chamber. And in conversations it was just, "Hello, I'm Rita Perlman from the U.S. Chamber representing women and minority functions," and somebody would turn to me and say, "Oh, you're representing the Hispanic Chamber," and I would say "No, I'm representing the U.S. Chamber." But because it was a Hispanic event by default - I can't say for sure why that person asked me that question, but what I can tell you is there was confusion as to what organization I belonged to.

(Perlman Depo. at 30-32.) Regarding this incident, Ms. Perlman also was asked, "Why do you believe those people experienced confusion at that event?" She answered, "Again, I can't speak to what the other individuals were thinking." (Id.)⁸¹

⁸¹ We note that during cross-examination in her deposition, Ms. Perlman was asked by respondent's counsel: "Have you discussed with anybody the instances of confusion that you experienced at the two Hispanic events that we were just talking about?" After an exchange between counsel regarding an attorney work-product privilege objection by petitioner's counsel, Ms. Perlman was

We find that Ms. Perlman's testimony regarding the incident at the Minority Business Enterprise event in Fall 2006 is not persuasive evidence of actual confusion, either reverse or forward.

First, we find that the unidentified gentleman from the Florida Hispanic Chamber of Commerce was a relevant purchaser for purposes of our actual confusion analysis in this case.

However, when Ms. Perlman introduced herself to this gentleman as "Rita Perlman from the U.S. Chamber of Commerce," "[h]e was a little confused, not really understanding who the U.S. Chamber of Commerce was..." Also, Ms. Perlman specifically testified that "I don't know what his thinking was when he asked me that question." We do not know either, and we will not assume or infer based solely on her testimony here that the unidentified gentleman was actually confused as to the source of petitioner's services vis-à-vis respondent's services based on any confusing similarity between the marks. Moreover, petitioner has not shown that the alleged confusion was based on the parties'

asked again: "Have you discussed the instances of confusion that took place at the two Hispanic events?" Petitioner's counsel repeated his objections and then said, "I will remove my objection and instruction with respect to counsel if you ask her if she's discussed the incidents that occurred that she discussed this morning. You keep calling them instances of confusion. I don't want there to be any confusion on the record as to whether this witness can make a judgment as to what constitutes an instance of confusion or not in a legal sense. That's my objection." (Perlman Depo. at 105-107.)

marks as a whole, and not merely on the common use in both marks of the inherently weak designations U.S./UNITED STATES and CHAMBER OF COMMERCE.

As for the second incident, at the Congressional Hispanic Caucus reception, we likewise find that Ms. Perlman's merely anecdotal testimony fails to establish that there in fact was any actual confusion.

First, we find that her testimony does not establish the identity of these allegedly confused "other individuals" and the organizations they represented, and we cannot conclude that they necessarily were members of the relevant class of purchasers in this case, i.e., Hispanic businesses and chambers of commerce. The fact that it was a Hispanic-focused event does not necessarily mean that the allegedly confused "somebody" was from the class of relevant purchasers of the parties' services.

Second, Ms. Perlman testified regarding this incident, "Again, I can't speak to what the other individuals were thinking." We do not know either, and we will not just assume or infer based solely on her testimony here that anyone was actually confused as to the source of petitioner's services vis-à-vis respondent's services based on any confusing similarity between the parties' marks.

Finally, the alleged actual confusion has not been shown to have been based on respondent's mark as a whole,

rather than merely on the common use in both marks of the inherently weak designations U.S./UNITED STATES and CHAMBER OF COMMERCE.

Lydia Logan.

Ms. Logan is the Executive Director of the "Institute for a Competitive Workforce," an organization affiliated with petitioner. (Logan Depo. at 4-5.)

In November 2006, she attended a fundraiser (with her husband and friends, in her personal capacity and not as a representative of petitioner) for a charity called Mary's Center, a non-profit organization providing social services and healthcare to those in need in the Washington, D.C. metro area, including a significant number of Hispanic clients. (Logan Depo. at 11-12.)

At the fundraising event, there was a professional photographer who took her group's picture. Ms. Logan testified (Logan Depo. at 13-14):

Q. Okay. And did you interact with the photographer?

A. I did.

Q. And can you, please, describe your interaction with the photographer?

A. He asked me my name and where I worked.

Q. And what did you tell him?

A. I told him Lydia Logan and that I worked at the U.S. Chamber of Commerce.

Q. And did he respond to your description?

A. He wrote it down.

Q. And what did he write down?

A. I couldn't see his tablet.

Exhibits 1 and 2 to Ms. Logan's deposition are a hard copy and an online printout of a page from the November 17, 2006 issue of the Spanish-language newspaper Washington Hispanic, reporting on the Mary's Center event.⁸² The page includes a photograph of Ms. Logan and her husband and friends at the event, presumably the photograph taken by the photographer mentioned by Ms. Logan above. The caption for the photograph reads: "Scott Logan, de Monster Worldwide; Lydia Logan, U.S. Hispanic Chamber of Commerce; Kathy Padian, Building Hope; con ellos Tom Lane y su esposa Kimberly, de Children's National Medical Center." In her

⁸² At the deposition and in its Main Brief Appendix of evidentiary objections (at pp. 23-24), respondent objected to Logan Depo. Exh. 1 and 2, essentially on the ground that these exhibits should have been produced in discovery, but were not made available to respondent until the day of the deposition. However, respondent never filed a motion to strike these exhibits, and in any event it has not identified or produced the relevant discovery request(s) to which the objection refers. With respect to Exh. 2, respondent also objects on the ground of hearsay. However, aside from the word "Hearsay" in the stated objection, respondent has not identified explained the specific basis of the objection. Nor do we find any basis for the objection. The exhibits are merely a photograph and its caption, and are probative for what they show on their face, i.e., that the photograph and its caption appeared in that issue of the Washington Hispanic newspaper.

deposition, Ms. Logan translated the caption as "Scott Logan, of Monster Worldwide; Lydia Logan, U.S. Hispanic Chamber of Commerce; Kathy Padian, Building Hope. With them, Tom Lane and his wife, Kimberly, of Children's National Medical Center." (Logan Depo. at 28.)

During cross-examination, Ms. Logan testified that no one has ever asked her as a result of the photo in the Washington Hispanic newspaper whether she works for respondent. (Logan Depo. at 129-30.)

We find that this incident with Ms. Logan is not evidence of any actual confusion among relevant purchasers, whether reverse confusion or forward confusion. The testimony does not establish the identity of the supposedly-confused person, be it the photographer, or perhaps a newspaper reporter or editor at the Washington Hispanic newspaper, none of whom would be a relevant purchaser here in any event. Also, the incident of alleged actual confusion was not based on respondent's mark as a whole, i.e., it did not involve the design element of respondent's mark. Ms. Logan's testimony does not suggest, much less establish, what the cause of the apparent mistake was, and we find that petitioner's contention that this was an instance of actual confusion to be mere conjecture.

Daniel Ramos.

Petitioner took the third-party testimony deposition of Daniel Ramos on April 21, 2008.⁸³ Mr. Ramos is president of National Hispanic Corporate Achievers, Inc. (NHCA), an organization that works to support the hiring, retention and promotion of Hispanic executives within corporate America. (Ramos Depo. at 6-7.)

⁸³ In its Main Brief Appendix of evidentiary objections (at pp. 24-25), respondent has objected to Mr. Ramos' deposition in its entirety based on Fed. R. Evid. 403, on the ground that, in the language of the Rule, the testimony's "probative value is substantially outweighed by a danger of ... undue delay." Respondent argues that "Respondent was not given ample time to prepare for Mr. Ramos' deposition, and was only able to attend the deposition telephonically. Furthermore, Respondent's counsel was sick at the time of the deposition."

Initially, we deem Fed. R. Evid. 403 to be inapposite here; its reference to "undue delay" would pertain to a delay in the assertion of and reliance on the evidence itself, e.g., the age of the evidence. For purposes of this Board proceeding, it would appear that respondent's objection to this deposition actually goes to the adequacy of the notice of deposition and the circumstances of the deposition itself.

As to the adequacy of the notice of deposition, although it was raised during the deposition (at pp. 14-15), respondent never filed a motion to strike the deposition on the ground of untimely notice. See Trademark Rule 123(e)(3), 37 C.F.R. Section 123(e)(3) ("Promptly after the testimony is completed, the adverse party, to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances."). In any event, we find that one week's notice was adequate, and we note that respondent's counsel had been furnished before the deposition with a copy of the sole exhibit that was made of record during the deposition. Respondent's counsel appeared at the deposition by phone and in fact conducted extensive cross-examination of the witness. We also note that after receiving the notice of deposition, Respondent did not move for an extension of time for the deposition and apparently did not even request one from opposer prior to the deposition. For these reasons, respondent's objection on this basis is overruled.

Respondent also objects to the entirety of Mr. Ramos' deposition on the ground that it lacks foundation, pursuant to Fed. R. Evid. 901. Aside from the words "Lacks Foundation" in the stated objection, no specific basis for the objection is offered. The objection is overruled.

Petitioner relies on two aspects of Mr. Ramos' testimony to support its claim of actual confusion. First, petitioner relies on his testimony concerning a piece of mail sent by his organization which was intended for respondent's former president Michael Barrera but which was incorrectly addressed and mailed to petitioner's headquarters instead. Second, petitioner relies on Mr. Ramos' testimony regarding his own perceptions as to whether petitioner and respondent are likely to be affiliated based on their respective names. We shall address each of these in turn.

Incident of Misdirected Mail⁸⁴

As of January 2008, Mr. Ramos's organization NHCA had been involved in trademark litigation against another third-

⁸⁴ In its Main Brief Appendix of evidentiary objections (at pp. 24-25), respondent has objected to portions of pages 8-10 of Mr. Ramos' testimony (pages 8:25 through 10:7), on the grounds that the testimony constitutes inadmissible opinion testimony (Fed. R. Evid. 701), that it lacks foundation (Fed. R. Evid. 901), and that Mr. Ramos lacks personal knowledge of the matters he testifies to (Fed. R. Evid. 602). Regarding Rule 701, the objected-to testimony asserts facts, not opinion, and even if it is lay opinion it satisfies the Rule's requirements for admissibility of such testimony. As for Rule 901, lack of foundation, respondent has not identified the basis for the objection other than citing to the rule. As for Rule 602, nothing in the objected-to testimony suggests Mr. Ramos' lack of personal knowledge as to the facts asserted, nor does the additional testimony at pages 19-20 (cited by respondent as the basis for this objection) call into question Mr. Ramos' personal knowledge of the facts asserted at pages 8-10 of the deposition. Respondent's objections are overruled.

party nonprofit organization named "Hispanic Association of Corporate Responsibility" (HACR). (Ramos Depo. at 7-8.)

In 2007 and 2008, HACR's website included a listing of the members of its board of directors, along with the names of their affiliated organizations. (Matsumoto Depo. at 6-8, Exh. 1 and 2.)⁸⁵

Michael Barrera, respondent's then-president, was a member of the HACR board of directors in 2007. (Matsumoto Depo. at 8-10, 14, Exh. 1.) He was listed as such on HACR's 2007 website with the other directors, and was identified on the website as the President and CEO of the "United States Hispanic Chamber of Commerce." (Matsumoto Depo. Exh. 1.)

The HACR 2007 website did not include the mailing addresses of the board members and their organizations, including the address for Mr. Barrera and respondent. (Matsumoto Depo. at 9-10, Exh. 1 and 2.)

During the course of the NHCA/HACR litigation, NHCA decided to send letters regarding the litigation to each of the members of HACR's board of directors listed on HACR's 2007 website. (Ramos Depo. 8, 16.)

In preparation for mailing the correspondence to each of the HACR board members, NHCA volunteers, per Mr. Ramos' instructions, attempted to locate the mailing addresses of

the HACR board members' respective organizations, most likely by searching the Internet for those organizations. (Ramos Depo. at 18-20.) Upon locating the apparent mailing addresses, the volunteers prepared mailing labels to attach to the envelopes which contained the correspondence to be mailed to each of the HACR board members at their organizations. The envelopes as addressed then were mailed. (Ramos Depo. 9, 18-19.)

The envelope addressed to Mr. Barrera (respondent's then-president) as an HACR director was addressed as follows:

Michael L. Barrera
United States Chamber of Commerce
1615 H Street, NW
Washington, DC 20062-2000

(Ramos Depo. Exh. 1). On the envelope, Mr. Barrera's name, as an HACR board member, was set out correctly, but his organization was identified on the envelope as "U.S. Chamber of Commerce," and not the name of the correct organization as it appeared on the HACR website, i.e., "United States Hispanic Chamber of Commerce." The H Street address to which the envelope was mailed is petitioner's headquarters address.

⁸⁵ Rima Matsumoto is the Executive Director of HACR. (Matsumoto Depo. at 5.)

No one from petitioner is included on the list of the HACR 2007 and 2008 websites' list of HACR board of directors, and petitioner does not appear by name on the HACR website. (Matsumoto Exh. 1, 2.)

We find that this is not evidence of actual confusion among relevant purchasers. The particular circumstances surrounding the mistake are not established by the record, and may well have been due to a simple misprint or mere sloppiness on the part of the NHCA volunteer(s) in preparing the mailing labels for the correspondence, who simply mis-read or mis-remembered respondent's name as it was set out on the HACR website when they searched for respondent's mailing address. These volunteers are not relevant purchasers in this case. Moreover, the apparently mis-directed mail did not involve respondent's mark as a whole as it appears in respondent's registration, i.e., it did not involve the distinctive design element of the mark.

Daniel Ramos' personal opinions regarding a possible affiliation between Petitioner and Respondent.

In addition to his position at NHCA, Mr. Ramos is the Director of the Seminole County chapter of the Hispanic Leaders Chamber of Commerce of Florida. (Ramos Depo. at 33-34.) Mr. Ramos testified (Ramos Depo. at 10-13):

Q. Okay. Are you familiar with the U.S. Chamber of Commerce?

A. By name and by some contacts there that I've never contacted but through newspapers and the grapevine. But I don't have contact with them directly.

Q. Are you familiar at all with the U.S. Hispanic Chamber of Commerce?

A. Same thing. You know, I may know some people that go to their annual event and - but I've never done business with them.

...

Q. ... To the best of your understanding, have you ever believed there was any sort of connection or affiliation between the U.S. Chamber of Commerce and the U.S. Hispanic Chamber of Commerce?

A. I don't have any direct knowledge about that. But based upon the closeness of the name, I would have thought there is some kind of affiliation.

Q. And why do you say that?

A. Because one is United States and the other is United States and they're both chambers of commerce. ... That's a personal opinion. ... Because I really don't know what affiliation they have with each other.

Mr. Ramos also testified (Ramos Depo. at 24-26):

Q. You said that you believe that there was some affiliation between United States Chamber of Commerce and United States Hispanic Chamber of Commerce?

A. That's an assumption.

Q. What's the basis of your assumption?

A. The similarity in the name.

He also testified (Ramos Depo. at 29-32):

Q. You also stated earlier today that you assumed that United States Chamber of Commerce and United States Hispanic Chamber of Commerce worked together. What's the basis of your assumption?

A. The basis of my assumption is the similarity in the organizational presentation.

Q. The "organizational presentation," what does that mean?

A. That means the name. The name sounds very similar. It's just United States. They both start with United States, they're both chamber of commerce. That's an assumption on my part. It's not, by any means, you know, anything other than that. It's just an assumption based upon the name.

Mr. Ramos also testified (Ramos Depo. at 12):

Q. Have you, at any time, thought that the U.S. Hispanic Chamber of Commerce might be an affiliate or subsidiary of the U.S. Chamber of Commerce because of the similarities of the names?

A. I would, at least, think they work together.

Q. What do you mean by that?

A. That they have some kind of interactive common ground that they share sponsorship opportunities or relationships.

Q. And I'm not sure I understand the interactive - I'm not sure if I understand what you mean by that.

A. A working relationship. A working relationship.

Q. A working relationship based on the commonality of interest or working relationship based upon some sort of probable affiliation -

A. Both.

Q. - on the organizational level?

A. Both.

When he was asked whether he knew of other chambers of commerce that are "affiliated" because they "work together," Mr. Ramos testified (Ramos Depo. at 32):

Q. Okay. You mentioned you know that Orlando Hispanic chamber of Commerce and Orlando Chamber of Commerce are affiliated?

A. I don't know how they're affiliated. I really don't - really don't know. I know they work together but I don't know how they're affiliated.

Q. How do you know they work together?

A. Because I've attended events where both names appear, I've seen their name jointly on printed material.

Also regarding these two Orlando chambers, Mr. Ramos testified: "There's direct affiliation with them and I don't know the definition of that affiliation but I know they work very closely together to do mutual projects." (Ramos Depo. at 11-12.)

We find that Mr. Ramos' testimony regarding his personal assumptions as to whether petitioner and

respondent are related based on their respective names is not persuasive evidence of actual confusion.

We find that Mr. Ramos, as director of a Hispanic-focused chamber of commerce, is a relevant purchaser for purposes of our actual confusion analysis.

However, we find his testimony to be very vague and speculative, and derived from highly suggestive and leading questioning by counsel.

Also, Mr. Ramos' alleged actual confusion was not based on the marks at issue in their entireties, i.e., as the result of comparing petitioner's mark, on one hand, with respondent's composite mark with its distinctive design feature, on the other hand. Rather, it clearly was based solely on what he perceived to be the similarity between the highly descriptive and inherently weak elements "U.S." or "United States," and "chamber of commerce" in both marks. "They both start with United States, they're both chamber of commerce"; and "[b]ecause one is United States and the other is United States and they're both chambers of commerce."

Moreover, his testimony that he would assume that there is an "affiliation" between petitioner and respondent must be considered in light of his apparent conception of what such an "affiliation" entails. Repeatedly, he indicated that he was assuming that two

chambers of commerce (like petitioner and respondent, or the two Orlando chambers) are "affiliated" if they have a "working relationship" or "work closely together to do mutual projects." His apparent assumption that two chambers, i.e., petitioner and respondent, would be "affiliated" because they have a "working relationship" or because they "work closely together to do mutual projects" does not prove that Mr. Ramos does not distinguish, or would not be likely to distinguish, based on the parties' marks, the two chamber organizations from each other as to the *source* of their respective services, which is the issue before us.⁸⁶

Actual Confusion: Conclusion.

We have carefully considered all of the evidence and testimony that petitioner has submitted in support of its claim that actual confusion has occurred. For all of the reasons discussed above, we are not persuaded by that evidence that legally cognizable actual confusion has occurred, or that any such confusion is more than merely *de minimis*.

Of course, petitioner is not required to establish the existence of actual confusion in order to support its

⁸⁶ See also the discussion below in connection with *du Pont* factor 10(d), regarding petitioner's and respondent's actual "working relationship."

likelihood of confusion claim. For that reason, we find that the seventh *du Pont* factor, "the nature and extent of any actual confusion" is neutral in our overall likelihood of confusion analysis in this case.

***Du Pont* Factor 10: Market Interface.**

One of the *du Pont* likelihood of confusion factors, factor 10(d), provides that one issue that can be relevant to the determination of likelihood of confusion is the "market interface between applicant and the owner of the prior mark" [who would be respondent and petitioner in this inter partes proceeding, respectively], including "laches and estoppel attributable to owner of prior mark and indicative of lack of confusion."

The record reveals the following facts with respect to the parties' relationship over the years which are relevant to *du Pont* factor 10(d).

Respondent has been a dues-paying member of petitioner since 1981. (Nino 41-42.)

Since 1990, Respondent's main office is within a mile of petitioner's headquarters in Washington, D.C. (Nino Depo. at 20-22.)

Shortly after he arrived in Washington, Mr. Nino, respondent's former president, visited petitioner's offices and introduced himself, as president and CEO of respondent,

to Mr. Workman, who was petitioner's "vice-President of International" and to Mr. Donohue, petitioner's president. Mr. Nino told them that respondent had moved nearby. Mr. Workman and Mr. Nino exchanged cards, and Mr. Nino left him a packet of information about respondent's upcoming convention in Chicago. (Nino Depo. at 39-41.)

Mr. Nino, in his capacity as respondent's president, and other of respondent's senior officials were regularly invited to petitioner's events. At several events, respondent "purchased an entire table, or even two tables, for petitioner's events, usually at a hefty price." (Nino 105-107.) "I'd also buy a table from them and I'd support the U.S. Chamber by doing that. I'd go and call my board members and I would sit my board chairman at the head table with Tom Donohue or with his predecessor." (Nino Depo. at 43-44, 60-63.)

"They would have events where they would invite different people. ... For example, when Vicente Fox became president... I was called because I was the former president of the U.S. Hispanic Chamber of Commerce. I was asked to be there. And even after I left, they would still call on me to participate in events, even after I left as president of the Chamber. That's how good our relationship was and all the friends that I had made there. Because they're real good people there." (Nino Depo. at 44-45.)

Petitioner's officials have regularly been invited to and have been frequent attendees at respondent's events. (Nino Depo. at 46, 51-52, 73-75, 92-93, 94-95, 95-96, 127-128.)

At respondent's first annual legislative conference, petitioner's "vice president Workman showed up. ... He showed up and supported us." He knew about the conference because "I sent him an invitation and called him and invited him." The invitation was addressed directly to Mr. Workman. Mr. Nino talked to Mr. Workman at the conference: "Sure, I introduced him to our people," including respondent's chairman of the board. (Nino Depo. at 45-47.)

Respondent's legislative conference was an annual event. "... And throughout them, members of the U.S. Chamber of Commerce have attended, whether it was Workman, whether it was some of the other guys. And at some of them, the employees or leadership of the U.S. Chamber of Commerce spoke. They addressed the convention or - they addressed the members of the U.S. Hispanic Chamber of Commerce and the attendees." (Nino Depo. at 51-52.)

Mr. Nino also testified, "It's not unusual for Hirschmann [another of petitioner's vice-presidents] to be a panelist to the organization. He had - was very aware of the organization, had been participating with us for quite some time, several years, as a matter of fact, and had

attended several of our conferences or annual events.”

(Nino Depo. at 76-77.)

At the third trilateral NAFTA conference in Banff, Alberta, Canada, Mr. Nino met petitioner’s chairman of the board, Mr. Little. Mr. Nino collaborated directly with Mr. Little, Mr. Workman, and Mr. Hirschmann: “We would sit around a big table, all the leadership of the chambers of commerce, and we would talk about how we’re supporting each other in different areas and what areas still needed more support from us.” At these sessions discussing NAFTA, Mr. Little knew who Mr. Nino was and that he represented respondent. (Nino Depo. at 57-60.)

In September 2004, William Kovacs, another of petitioner’s vice-presidents, was a speaker at respondent’s legislative conference at which then-President George W. Bush was also a speaker. (Nino 77-81.)

Likewise in 2006 and 2007, Mr. Kovacs spoke at respondent’s annual legislative conference, where respondent’s name and logo were prominently displayed. (Nino Depo. at 77-78.)

In 2004 and 2005, petitioner and respondent were heavily involved together in educational outreach regarding the Dominican Republic Central America Free Trade Agreement (DR-CAFTA). (Guzman Depo. at 32-33).

Generally, at the suggestion of petitioner, petitioner's and respondent's organizations collaborated on their outreach efforts. (Guzman Depo. at 33-35)

At the request of petitioner, petitioner and respondent collaborated on TeleCONSENSUS, a coalition initiative to educate lawmakers and the business community on issues of telecommunications technology. The coalition issued public comments on political developments, which identified petitioner and respondent as two of the four organizations leading the 190-member coalition. (Lopez Depo. at 130, 136-38); Guzman Exh. 8.)

In Spring 2006, at respondent's annual legislative conference, respondent sponsored a workshop that featured a presentation from a senior official of petitioner. (Lopez 130-131). Petitioner and respondent arranged for the filming of petitioner's official's presentation at the conference, which was then posted on respondent's foundation's website without objection from petitioner. (Lopez Depo. at 130-135.)

At the request and encouragement of petitioner, respondent filed a joint amicus brief in a 9th Circuit lawsuit challenging an Arizona immigration law in which petitioner was one of the plaintiffs. (Guzman Exh. 32-40, Exh. 9.)

At times, Petitioner's website has displayed Respondent's name and links to respondent's website. To this day, Petitioner identifies respondent as one of its "partners" on its website. (Guzman Depo. at 2-43, exh. 7 and 8.)

Mr. Nino testified that during the parties' longtime support of each other and collaboration, petitioner never objected to respondent's use of its name and logo. (Nino Depo. at 52.)

We have considered all of the evidentiary facts as set out above (the accuracy of which petitioner has not contested) as they pertain to *du Pont* factor 10(d) ("market interface" between the parties, including "laches and estoppel attributable to owner of prior mark and indicative of lack of confusion").

We find that respondent's evidence showing the parties' longtime and frequent collaboration with each other, and petitioner's failure during those years of interaction and collaboration to ever object to respondent's use of respondent's name and logo mark, is persuasive evidence which is "indicative of lack of confusion" under factor 10(d). *See Iodent Chemical Co. v. Dart Drug Corp.*, 207 USPQ 602, 608 (TTAB 1980) ("[I]f opposer [or petitioner in this case], over the years, was of the belief that the marks were

sufficiently different to avoid confusion in trade, there is no reason why this belief should now be disturbed").

Respondent's former president Mr. Nino frequently interacted with many of petitioner's top officials over the years, including petitioner's chairman of the board Mr. Little, petitioner's president Mr. Donohue, and petitioner's vice-presidents Mr. Hirschmann, Mr. Workman and Mr. Kovacs. Each of these top officials knew that Mr. Nino represented respondent, the U.S. Hispanic Chamber of Commerce, and at no time did they or apparently anyone else from petitioner object to respondent's use of its mark. We are persuaded by respondent's arguments that this past "market interface" between the parties over the years, during which petitioner's top officials clearly knew of and never objected to respondent's use of its mark, tends to support a conclusion that there is no likelihood of confusion now.

Petitioner's arguments with respect to this *du Pont* factor are largely based on a statement the Board made in the ex parte case of *In re Opus One*, 60 USPQ2d 1812, 1821 (TTAB 2001). That case involved a restaurant's application to register the mark OPUS ONE for restaurant services. The Examining Attorney refused registration based on a prior registration of the mark OPUS ONE for wine. In arguing against the refusal, the applicant cited *du Pont* factor 10(d), presenting evidence that it had a longtime close

relationship with the winery, that it featured the winery's OPUS ONE wine at its restaurant, and that the winery in fact had encouraged and assisted the restaurant in its activities featuring the wine at its restaurant. The applicant restaurant argued that this was evidence which supported a finding, under *du Pont* factor 10(d), that the prior registrant winery had no objection to the restaurant's use of the OPUS ONE mark, and that the winery believed that there was no likelihood of confusion arising from the restaurant's and the winery's concurrent use of the OPUS ONE mark.

The Board affirmed the Examining Attorney's refusal to register, finding that a likelihood of confusion existed. The Board acknowledged the applicant's evidence showing the past relationship between the winery and the restaurant and the winery's collaboration with the restaurant and failure to object to the restaurant's use of the mark. The Board held, nonetheless:

We cannot conclude, however, that registrant's actions and/or inaction with respect to applicant's use of the OPUS ONE mark, as detailed by applicant, are necessarily attributable to, and necessarily evidence of a business-driven belief on the part of registrant that there is no likelihood of confusion.

In re Opus One, 60 USPQ2d at 1821. Petitioner specifically relies on the Board's statement that the applicant had

failed to show that the registrant's failure to object to the applicant's use of its mark was based on a "business-driven belief" on the part of the prior user that there is no likelihood of confusion. Petitioner argues in this case that respondent likewise has failed to prove that petitioner's actions or inaction with respect to respondent's use of its mark was the result of a "business-driven belief" that there was no likelihood of confusion.

Petitioner argues that the evidence of record shows that petitioner did not actively begin to market to Hispanic businesses until 2002, so there have been few opportunities for any "market interface" between the parties to even have occurred.

The U.S. Chamber's supposed "failure to object" to Respondent's use of its mark [before 2002] cannot reasonably be construed as "a business-driven belief" that confusion was unlikely to occur when the parties began to compete with one another more directly. And indeed, it is quite telling that when the parties *did* begin to interact in the marketplace, the U.S. Chamber took action to oppose Respondent's mark as it had become clear by then that confusion was likely.

(Petitioner's Reply Brief at 19-20; emphasis in original.)

Petitioner argues that although respondent in fact has long been a member of petitioner, it has been treated like any one of petitioner's thousands of members, receiving all of the benefits its members receive, including invitations

to petitioner's events, some of the more choice of which respondent may have paid to attend.

Petitioner argues that the parties' "occasional interactions" as to "policy" issues, such as speaking at conferences, being listed as a resource on websites, participating in coalitions, and joining an amicus brief, are "unremarkable."

The U.S. Chamber's primary focus is to represent the interests of the business community before the federal government (including the federal courts), and in promoting international trade, and in furtherance of those core missions, the U.S. Chamber will team up with almost anyone who shares common beliefs, and its policy experts will speak to (or with) anyone who may be in a position to impact the public policy process. The most logical conclusion, therefore, is that any collaborations were merely for the purpose of advancing a common policy agenda.

(Petitioner's Reply Brief at 20-21.) Petitioner further argues: "Indeed, many of the coalition efforts cited by Respondent...occurred while the U.S. Chamber has been involved in these proceedings, thus confirming that the parties' interactions have been strictly business and cannot be interpreted as amounting to an admission that confusion cannot now exist." (*Id.*)

Leaving aside the question of whether a "strictly business" relationship between petitioner and respondent does not in fact suggest a "business-driven belief" on the part of petitioner, we find that petitioner's reliance on

the reference to "business-driven belief" in the *Opus One* case is misplaced. *Opus One* was an ex parte proceeding. The prior registrant was not a party and had no opportunity to appear and contest the applicant's contentions that it had no objection to applicant's obtaining the registration it was seeking. In contrast, the present case is an inter partes proceeding in which the prior registrant, petitioner, is a party and has had the opportunity to present evidence in opposition to respondent's evidence under *du Pont* factor 10(d).

We find in this inter partes case that respondent's persuasive factual showing regarding the parties' past relationship and petitioner's failure to object to respondent's use of its mark creates a presumption that petitioner in fact heretofore has believed that there is no likelihood of confusion. That presumption imposes a burden on petitioner to come forward with actual evidence sufficient to establish the contrary. Here, even if we were to accept as persuasive petitioner's mere assertions in its brief as to why it has never before objected to respondent's use of its mark, those assertions are not evidence, and we have found no such evidence in our review of this record.

For these reasons, we find that *du Pont* factor 10(d) tends to weigh in support of a conclusion that confusion is

unlikely. At best, it is neutral in our analysis; it certainly does not weigh in petitioner's favor.

Likelihood of Confusion: Conclusion.

Having carefully considered all of the parties' evidence and arguments with respect to the relevant *du Pont* factors (including any evidence and arguments not specifically addressed in this opinion), we conclude that there is no likelihood of confusion between respondent's mark, as used in connection with respondent's services, and petitioner's mark, as used in connection with petitioner's services. The parties' services and trade channels are similar, and petitioner's mark has achieved a degree of fame. However, we find that those facts are simply outweighed by the inherent weakness of petitioner's mark and the resulting narrow scope of protection it is entitled to. Respondent's mark and petitioner's mark are quite dissimilar when viewed in their entirety, and we find that the scope of protection to which petitioner's mark is entitled is not so broad as to preclude respondent from registering its fundamentally dissimilar mark.

CONCLUSION:

Respondent's genericness counterclaims to cancel petitioner's registrations are dismissed.

Cancellation No. 92045876

Petitioner's Section 2(d) petition to cancel respondent's registration is denied.⁸⁷

Respondent's Registration No. 2886207 remains cancelled under Trademark Act Section 8.

⁸⁷ In view of our denial of petitioner's petition to cancel, respondent's laches and acquiescence affirmative defenses are moot.