Exhibits

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Compass Holding BV, Compass Publishing BV, and Compass America, Inc. Opposers, v. VisionCompass, Inc. Applicant.	)	Opposition No. 121,332

OPPOSERS' BRIEF IN RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

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I. INTRODUCTION

Presently before the Board is Opposers' Motion for Summary Judgment, Applicant's Motion to Amend, Opposers' Response thereto and Applicant's Motion for Summary Judgment. This brief is submitted in response to Applicant's Motion for Summary Judgment.

As demonstrated below, no basis exists for granting summary judgment in Applicant's favor with respect to Opposers' §2(a) claim. Moreover, no basis exists for either granting Applicant's summary judgment motion as to Opposers' §2(d) claim, or for denying Opposers' motion for summary judgment on that claim. Accordingly, the Board is urged to deny Applicant's motion for summary judgment in its entirety and to grant summary judgment in favor of Opposers.

II. CONTRARY TO APPLICANT'S ASSERTIONS, SUBSTANTIAL AND INDISPUTABLE EVIDENCE ESTABLISHES THE EXISTENCE OF A LIKELIHOOD OF CONFUSION

A. The Parties' Marks

Applicant's two sentence discussion of this Du Pont factor ignores the similarities of the parties' marks and also the fact that Applicant's "VISIONCOMPASS" mark incorporates the "COMPASS" mark in its entirety. Also ignored by Applicant is the indisputable evidence of record which clearly establishes Applicant's use of "COMPASS" per se. (See, for instance, Ex. 4 in support of Opposers' Motion for Summary Judgment which provides representative instances in which Applicant refers to "The Compass Document.")[1] Also ignored by Applicant are Opposers' frequent uses of various prefixes in connection with "COMPASS." (See, for example, Opposers'

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[1] All exhibits referred to herein are either interrogatory answers or documents which were produced by the parties during discovery. For the Board's reference and convenience the production requests and related responses which prompted production of the exhibits referred to herein are produced collectively as Ex. 60. For the Board's convenience, exhibits referred to herein which have previously been provided to the Board as exhibits in support of Opposers' Motion for Summary Judgment are not separately produced in support of this brief in response to Applicant's Motion for Summary Judgment. Exhibits referred to herein which have not previously been provided to the Board as exhibits in support of Opposers' Summary Judgment Motion are submitted herewith bearing sequential exhibit numbers which start with Ex. 56. Exhibits previously submitted in support of Opposers' Motion for Summary Judgment bear numbers 1 - 55. Where relied upon in support of this brief, such exhibits are referred to by the exhibit number used in Opposers' summary judgment brief.

Summ. Judg. Ex. 19 which refers to "Banking Compass," "Insurance Compass," "Manufacturing Compass," "Data Center Compass," "Network Compass," "Client/Server Compass," "Development Compass," and "Help Desk Compass").

These marketplace realities serve to underscore the conclusion that the parties' marks are sufficiently alike so as to make confusion likely.

B. The Parties' Goods and Services

Applicant's four sentence discussion of this factor is predicated upon an extract from an interrogatory answer and a description of Applicant's goods which glosses over the identification of goods set forth in the application *sub judice*.

Specifically, Applicant cites Opposers' Answer to Interrogatory 2 as support for its assertion that "Opposers' mark is used in connection with offering and rendering consulting and advisory services for the analysis and improvement of Information Technology and business operations." (App. Summ. Judg. Br. at p. 3). Opposers' answer to Interrogatory 2, (Ex. 56 submitted herewith) unedited, reads:

> The "COMPASS" mark is used in connection with each of the goods and services recited and described in the '290 registration and the Notice of Opposition. Opposer's activities include the offering and rendering of a wide range of consulting and advisory services for the analysis and improvement of IT and business operations as evidenced by documentation produced in response to Applicant's production Requests 1 and 2. These activities include the tracking, measuring, and analyzing of key business performance indicators by computer. In addition, Compass America, Inc., uses "COMPASS" as a portion of its trade name in connection with all goods and services offered and provided by Opposer Compass America, Inc.

While Applicant's brief states that "Applicant's proposed mark is used to mark packaging and media containing a software package as set forth in Applicant's description of goods" (App. Summ. Judg. Br. p. 3), the identification, as published, reads:

> "Computer software for developing, managing and collaborating in the field of business performance measurement, namely, computer software for tracking, measuring, and analyzing key business performance indicators in International Class 9."[2]

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[2] As demonstrated in Opposers' response to Applicant's motion to amend its identification of goods, the proposed amendment, which has no bearing upon Applicant's goods, contains no

Applicant has ignored the relationship between the goods and services recited in the '290 registration and Opposers' activities conducted under the "COMPASS" mark and trade name on the one hand, and Applicant's recited goods on the other. This relationship was clearly and indisputably established in Opposers' summary judgment brief (pp. 3-9) which documents not only the close relationship between the parties' activities but also the striking similarities in the approaches used by the parties in collecting and analyzing data and key business performance indicators for the purpose of assessing and improving business performance. Given these indisputable facts, no basis exists for either granting Applicant's summary judgment motion or for denying Opposers' motion.

C. Channels of Trade

Neither the '290 registration nor the application *sub judice* contain a channels of trade restriction or limitation. Applicant admits that its business management activities under the "VISIONCOMPASS" mark, and Opposers' business management activities under the "COMPASS" mark, are both aimed at "companies, organizations and governmental entities and personnel of same." (App. Summ Judg. Br. at p. 4).

Both parties provide goods and services to these prospective purchasers, in part, through a direct sales force. (Opps. Ans. to Int. 3, submitted by Applicant in support of its summary judgment motion and submitted herewith as Ex. 57; see also App. Summ. Judg. Br. at p. 3). In addition, although not discussed by Applicant, it is indisputable that both parties also seek to promote sales through a website, advertisements, trade shows, the activities of consultants, and the publication of "white papers." (See Exs. 42-51 and Opps. Summ. Judg. Br. pp. 9-10). [3]

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restriction as to whom those goods are to be sold, and fails to fully reflect the full manner of how the sale of Applicant's goods is promoted, fails to negate or diminish the likelihood of confusion.

[3] As mentioned above and more fully discussed in Opposers' Response to Applicant's Motion to Amend, the amendment sought by Applicant in no way provides a channels of trade restriction of any consequence in that it attempts to address only by whom "VISIONCOMPASS" software is offered for sale. As Applicant and Opposers use a direct sales force, the proposed amendment does not minimize the likelihood of confusion and completely ignores the several

D. Purchaser Care and the Likelihood of Confusion

Much of Applicant's argument with respect to this factor is based upon the unsupported supposition that "most companies and government agencies have several levels of approval" prior to committing to the purchase of goods and services. (App. Summ. Judg. Br. at p. 4). Not only is this assertion unsupported by any evidence, but it ignores the fact that the identification of Applicant's goods, as published and opposed (and as Applicant would have amended), contains no restriction with respect to the types or sizes of purchasers, the sophistication of any prospective purchaser, or the existence of "several levels of approval" required by those purchasers. In addition, Applicant's assertions with respect to the expensive nature of its goods ignores the indisputable fact that to date Applicant's goods have simply been given away and no customer has paid anything for copies of Applicant's "VISIONCOMPASS" software. (Ex. 3, App. Ans. Int. 27).

Finally, and as fully discussed in Opposers' summary judgment brief (pp. 10-11 and cases cited therein), allegedly sophisticated purchasers are not immune from trademark infringement, especially in instances where similar marks are used in connection with the same or closely related goods and services and the channels of trade are essentially the same. In fact, as recognized by the Board in Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 U.S.P.Q. 119, 124 (T.T.A.B. 1976) it is possible that discriminating and careful individuals may, in certain situations, be more susceptible to confusion. Certainly one such situation, as discussed in Opposers' summary judgment brief (pp. 10-11) involves those situations in which initial contact between a potential buyer and a seller may have arisen because of confusion, or may result in confusion at a very early stage.

E. The Strength of the "COMPASS" Mark

In a four sentence discussion, based solely upon an excerpted portion of Opposers' answers to Interrogatory 11, Applicant concludes (App. Summ. Judg. Br. at p. 5) that the "COMPASS" mark

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additional common marketing methods referred to above and indisputably documented in exhibits submitted in connection with Opposers' summary judgment brief, as discussed at pp. 9-10 of that brief.

is not famous and consequently that no likelihood of confusion exists. The factual and legal deficiencies in this argument beg comment.

Applicant's entire argument is based upon Opposers' statement "that not all uses of 'COMPASS' or 'COMPASS' formative marks in connection with computer software and/or services related thereto will necessarily give rise to a likelihood of confusion." Omitted from the quoted interrogatory answers is the next sentence which reads:

> Instances in which 'COMPASS' or 'COMPASS' formative marks have been used, or have allegedly been intended to be used, in connection with computer software and/or services related thereto, and where such have been considered likely to give rise to a likelihood of confusion, are identified in response to Interrogatory 15.

Opposers' answers to Interrogatory 15 in turn identify several instances in which Opposers' "COMPASS" uses and the '290 "COMPASS" registration have successfully been asserted against attempts to register and/or use "COMPASS" formative marks in the area of business practice analysis and performance evaluation and enhancement.[4]

Accordingly, in no way have Opposers admitted weakness with respect to the "COMPASS" mark. To the contrary, the full text of the answers to Interrogatories 11 and 15, and the supporting documentation provided to Applicant in response to its related Document Request 7(see as representative of various policing efforts previously submitted Exs. 53-55 and Ex. 59 submitted herewith), evidence the strength of the "COMPASS" mark in its field, specifically consulting services and related goods dealing with the analysis and assessment of business practices for the purpose of increasing business effectiveness and efficiency.

Additionally, while Applicant's caption reads "The fame of the prior mark (sales, advertising, length of use)," (App. Summ. Judg. Br. p. 5). Applicant, having summarily concluded that Opposers' mark is not famous, then fails to provide a single word of discussion relating to "sales, advertising, length of use." As established in Opposers' summary judgment brief, (pp. 9 and 12) significant sales and advertising have occurred under the "COMPASS" mark and trade name over

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[4] Submitted herewith as Ex. 58 are Interrogatories 11 and 15 and Opposers' complete answers thereto.

the many years since trademark use of "COMPASS" commenced in the United States, and since trade name usage commenced by Opposer Compass America. (Exhibits evidencing these facts were submitted in support of Opposers' summary judgment brief and are identified as Exs. 1, 49 and 50).

Finally, Opposers' significant reputation under the "COMPASS" mark and trade name is further evidenced by the numerous representative publications and articles submitted in support of Opposers' summary judgment motion as Ex. 52.[5]

The pertinent question with respect to the likelihood of confusion standard is the strength of Opposers' mark. As discussed and established at pp. 12-14 of Opposers' summary judgment brief, the strength of the "COMPASS" mark is more than sufficient to bar Applicant's attempt to register a mark which includes Opposers' mark in its entirety, is used on virtually identical goods (and services), and is promoted for sale to the same persons through the same channels of trade and using the same sales methods. Opposers' long use, advertising expenditures, sales, trade recognition, and multiple successful policing efforts have been fully documented and are beyond dispute. Applicant has offered no evidence in support of any contention to the contrary. Consequently, no basis exists for granting Applicant's motion. No genuine issue of material fact exists which precludes the granting of Opposers' motion.

F. Summary - Likelihood of Confusion - §2(d)

No factual or legal basis exists for granting Applicant's motion for summary judgment with respect to Opposers' likelihood of confusion claim. Moreover, as demonstrated above and in Opposers' summary judgment brief, the consideration of indisputable facts in the context of relevant Du Pont factors clearly warrants the grant of summary judgment in Opposers' favor.

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[5] These representative publications and articles are not objectionable under the hearsay rule as they are not submitted for the truth of the matters asserted in the articles. Instead, the representative publications and articles of Ex. 52 are submitted for the purpose of showing the significant volume of press attention accorded Opposers, the "COMPASS" mark, and the services provided by Opposers under the mark.

III. NO BASIS EXISTS UPON WHICH SUMMARY JUDGMENT CAN BE GRANTED APPLICANT ON OPPOSERS' §2(a) CLAIM

A. The Parties' Marks

As shown and discussed above (§ II. A.) and in Opposers' summary judgment brief, Applicant's mark incorporates the "COMPASS" mark in its entirety and Applicant, on numerous occasions, refers to its mark in a shortened form. (See, for instance, Ex. 4). In addition, Opposers' use of "COMPASS" includes numerous uses of "COMPASS" preceded by a prefix. (See instances set forth at p. 1, supra, and Ex. 19). Accordingly, this §2(a) factor clearly does not favor Applicant.

B. The Reputation and Recognition of "COMPASS"

Applicant's argument is premised completely upon its contention that Opposers have admitted, through the cropped extract from Opposers' answers to Interrogatory 11, that the "COMPASS" mark is not famous and thus will not support a claim under §2(a). In fact, Opposers have made no such admission and the full text of Opposers' answers to Interrogatories 11 and 15 (Ex.58), discussed above at p. 5, evidence Opposers' repeated vigilance in policing the "COMPASS" mark in numerous situations where registration has been sought with respect to "COMPASS" formative marks for use in connection with computer software and/or related services where those goods or services have been akin to those offered by Opposers, such as the business performance analysis software identified by Applicant in the application *sub judice*. Representative documents relating to various policing activities are submitted as Exs. 53-55 and 59.

Moreover, the substantial evidence which has been provided evidencing the conclusion that the regard and reputation afforded the "COMPASS" mark, Opposers, and the activities of Opposers under the "COMPASS" mark and trade name, are more than sufficient to support Opposers' "false connection" claim. Specifically, as discussed above (§II.. E.), and as evidenced by exhibits discussed therein and in Opposers' summary judgment brief (pp. 9 -12), substantial advertising expenses and sales revenues have been generated in connection with Opposers' activities under the "COMPASS" mark and trade name. (Exs. 49, 50). In addition, it is beyond dispute that the "COMPASS" mark has been used in the United States for many years (see status and title copy of '290 registration

submitted with Notice of Opposition) and that it has also been used by Opposer Compass America as a portion of its trade name for many years. The "COMPASS" mark and services have successfully been introduced to, and accepted by, such well regarded "COMPASS" clients as J.P. Morgan, American Express, and Mobil Oil. (Ex. 42). Finally, the numerous articles recognizing Opposers, the "COMPASS" mark and trade name and the services provided by Opposers under the "COMPASS" mark and trade name (Ex. 52), all evidence the existence of a reputation more than sufficient to warrant a finding in favor of Opposers with respect to §2(a).

Given the factual showing made with respect to the use and extent of the "COMPASS" mark, the long usage of the mark, and the recognition and accolades bestowed in connection with the mark, trade name, and goods and services provided under the "COMPASS" mark, it may reasonably be concluded that a reputation has developed such that when used by Applicant for software for use in connection with the tracking and measuring of business data for the purpose of analyzing and improving business practices, "VISIONCOMPASS" would be recognized by those in the field as pointing uniquely to Opposers. Under these circumstances, Applicant's motion for summary judgment with respect to Opposers' §2(a) claim must be denied.

C. Summary - §2(a) - False Connection

As demonstrated above, substantial evidence exists which, at a minimum, demonstrates that summary judgment in favor of Applicant is not appropriate. Moreover, sustaining this Opposition through the grant of summary judgment in Opposers' favor with respect to the §2(d) claim will more than likely result in the resolution of this proceeding without the need to resolve the §2(a) claim. See Turner Entertainment Co. v. Nelson, 238 U.S.P.Q. 2d 1942 (T.T.A.B. 1996) (Summary judgment granted Opposer under §2(d) upon finding of confusion, including confusion with respect to association or sponsorship, resulted in Opposer subsequently forgoing its §2(a) claim.

IV. CONCLUSION

No showing has been made, or can be made, which warrants the grant of summary judgment in Applicant's favor with respect to either the §2(a) or §2(d) prongs of its summary judgment

motion. Moreover, as demonstrated herein and supported by the indisputable facts established above and in the brief accompanying Opposers' motion for summary judgment, no genuine issue of material fact exists with respect to Opposers' likelihood of confusion claim. Accordingly, the entry of summary judgment in Opposers' favor with respect to at least that claim is entirely justified. Consequently, the Board is urged to deny Applicant's motion in its entirety and to grant Opposers' motion for summary judgment.

Respectfully submitted,

Date: 12/31/01

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CERTIFICATE OF SERVICE

The undersigned, Thomas J. Vande Sande, attorney for Opposers, hereby certifies that one (1) copy of the foregoing "OPPOSERS' BRIEF IN RESPONSE TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT" and Exhibits 56 - 60 were this day served on Applicant by mailing same, via first class mail, to:

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