Mermelstein

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Opposition No. 91121332

Compass Holding BV
Compass Publishing BV
and
Compass America, Inc.
v.
VisionCompass, Inc.

Before Cissel, Hairston, and Bottorff, Administrative Trademark Judges.

By the Board:

Now before the Board are the following motions:

- Opposer's motion for summary judgment, filed November 21, 2001;
- Applicant's motion to amend the subject application, filed November 30, 2001;
- Applicant's cross-motion for summary judgment, also filed November 30, 2001; and
- Applicant's motion to strike the brief in support of opposer's motion for summary judgment, filed December 31, 2001.

All motions have been fully briefed.[1]

Pleadings/Procedural History

Applicant seeks registration of the mark VISIONCOMPASS.[2] On December 6, 2000, opposer filed a timely

[1] Opposer submitted a reply brief in support of its motion for summary judgment, which we have considered. Trademark Rule 2.127(a)(consideration of reply brief discretionary).

notice of opposition, alleging priority and a likelihood of confusion with opposer's pleaded Registration No. 1,678,290[3] and a "likelihood of deception ... by causing the public ... to believe that Applicant's goods are in reality Opposer[']s goods or services ...; that such is likely to interfere with or embarrass Opposer[, which] will result in damage to Opposer." Notice of Opp. ¶¶ 11, 24.

The Board instituted this proceeding on December 13, 2000, and applicant filed a timely answer on January 22, 2001, denying the salient allegations of the notice of opposition. As last extended, opposer's thirty-day testimony period was set to close on December 28, 2001.

PENDING MOTIONS

Opposer's Motion for Summary Judgment

By its motion, opposer moves for summary judgment on the issues of priority and likelihood of confusion. As for priority, opposer alleges both its pleaded registration and prior common-law use of the mark.

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[2] Application Serial No. 75/519,076 for "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," filed July 16, 1998, alleging a *bona fide* intent to use the mark in commerce.

[3] Registered March 10, 1992 (§§ 8 & 15 affidavits accepted and acknowledged December 24, 1997, § 8 affidavit accepted and § 9 renewal granted, May 9, 2002), for the mark COMPASS and covering various goods and services in International Classes 9, 16, 35, 41, and 42 (the complete identification of goods and services is set out in an appendix). Opposer submitted title and status copies of its pleaded registration as an exhibit to its notice of opposition. *See* Trademark Rule 2.122(d)(1).

As for likelihood of confusion, opposer argues a number of the *du Pont* factors, *see, E.I. du Pont de Nemours & Co.*, 177 USPQ 563 (CCPA 1973), and has proffered evidence in support of its argument. In particular, opposer urges that the marks at issue are "at least similar, if not substantially identical" and that the parties' respective services "are closely related and overlapping." Further, opposer argues that an analysis of the channels of trade, the strength of its mark, applicant's prior knowledge of opposer's mark and the extent of potential confusion all support its conclusion that confusion is likely.

In response, applicant argues that genuine issues of fact remain to be decided regarding the connotation of the parties' respective marks and the construction of their respective identifications of goods. Further, applicant asserts that the sophistication of the purchasers of both parties' goods and service make confusion unlikely.

Applicant's Motion to Amend and Cross-Motion for Summary Judgment

Applicant has filed a motion to amend the goods in the subject application and for summary judgment. By its amendment, applicant proposes to amend its identification of goods to add the underlined words:

> 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, sold only through a direct sales force and through value added resellers.

Motion to Amend at 2.

Applicant argues in its motion for summary judgment that the marks are dissimilar; that the goods (as amended) and their channels of trade are different; that the circumstances of their sale require careful consideration by sophisticated purchasers; and that opposer's mark is not entitled to broad protection as a result of fame. With respect to opposer's claim that applicant's mark suggests a false connection with opposer, applicant points out that the marks are not "the same as, or a close approximation of" opposer's name or identity; that the marks do not "point uniquely and unmistakably" to opposer; and that opposer's name or identity is not so famous that a connection with opposer would be presumed by those encountering applicant's mark.

In response to applicant's motion to amend, opposer argues that the amendment should be denied because it would not obviate the likelihood of confusion which opposer asserts. Opposer points out that the amendment does not narrow the goods or the customers to whom they are directed, but merely restricts the method of sale.[4]

[4] Opposer argues that "[t]he inadequacy of the proposed amendment is further evidenced by the fact that beyond the use of sales forces, the goods and services of Opposers and Applicant are promoted through other means such as websites, advertising, and

In response to applicant's motion for summary judgment, opposer argues that "substantial and indisputable evidence establishes the existence of a likelihood of confusion. Finally, with respect to its Trademark Act § 2(a) claim, opposer states that "no basis exists upon which summary judgment can be granted…."

Applicant's Motion to Strike

Applicant has moved to strike the brief in support of opposer's summary judgment motion. Applicant asserts that the evidence submitted in support of parts of opposer's motion is not self-authenticating and was not accompanied by an affidavit. Opposer disagrees with applicant's premise and points out that applicant has not identified or discussed its objections with respect to any particular piece of evidence.[5] In any event, as will be seen, in light

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trade shows." Nonetheless, the Board's analysis in this regard is constrained to an examination of the identification of goods for which applicant seeks registration, and any restrictions appearing therein. *Canadian Imperial Bank of Commerce N.A. v. Wells Fargo Bank*, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, whether applicant's goods are, in reality, restricted to direct sales or sales through value-added resellers is irrelevant in a Board proceeding.

[5] Although it is not entirely clear, opposer apparently admits that at least some of the exhibits subject to the motion to strike are its own documents which it produced during discovery. Response to Motion to Strike at 1 ("Finally, each of Opposers' documents used as exhibits was produced to Applicant during discovery….")

> For purposes of summary judgment only, … a document or thing produced in response to a request for production … will be considered by the … Board if any party files, with the party's brief on the summary judgment motion … a copy of the request for production and the documents or things produced in response thereto….

of our decision on the merits of the summary judgment motions, we need not consider applicant's motion to strike.

Applicable Law

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light most favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1993).

Amendment of an application during an opposition proceeding is governed by Trademark Rule 2.133. That rule provides that an application or registration subject to a Board proceeding may not be amended in substance "except with the consent of the other party .. and the approval of the … Board, or except upon motion." Trademark Rule 2.133(a). An unconsented amendment will generally be deferred until trial, or until consideration of a motion for summary judgment; the motion will be granted if the Board finds that the defendant would not be entitled to registration without the restriction set out in the amendment. *See,* e.g., Space Base Inc. v. Stadis Corp., 17

Trademark Rule 2.127(e)(2).

USPQ2d 1216, 1220 (TTAB 1990); *see generally*, TBMP § 514.03 (2d ed. June 2003), and cases cited therein.

Analysis

After consideration of the cross-motions for summary judgment, and the evidence and affidavits submitted in support thereof,[6] we find that neither party is entitled to summary judgment on this record. The parties' submissions demonstrate that there is a genuine issue of material fact with respect to (at least) the commercial impressions of the marks involved. Further, because the marks and the respective goods and services of the parties are neither so similar nor so dissimilar that we can make determinations on this factor as a matter of law, summary judgment to both parties is DENIED.[7]

We likewise defer consideration applicant's motion to amend its identification of goods until trial. We cannot find on this record that applicant would be entitled to registration as a matter of law if the amendment were entered. Nonetheless, because of the different standard of

[6] Because consideration of opposer's disputed evidence would not change the result, applicant's motion to strike is moot. In any event, the Board looks with disfavor on motions to strike briefs. Thus, even if the evidence complained of were not properly submitted, the Board would consider opposer's brief. The Board is capable of disregarding any argument which is not supported by evidence.

[7] Our discussion of the enumerated issues is not intended to imply that these are the only genuine issue of material fact at issue.

proof, applicant may revisit this issue at trial, if desired.

DATES RESET

Proceedings are RESUMED. Discovery is closed. Trial dates, including the close of discovery, are reset as follows:

DISCOVERY PERIOD TO CLOSE:	**CLOSED**
Thirty-day testimony period for party in position of plaintiff to close:	**January 6, 2004**
Thirty-day testimony period for party in position of defendant to close:	**March 6, 2004**
Fifteen-day rebuttal testimony period to close:	**April 20, 2004**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.

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Appendix

International Class 9:
Pre-Recorded Magnetic And Optical Discs For Use With Computers; Audiotapes And Videotapes Featuring Analysis And Assessment Of Data Processing Procedures, Performances And Efficiency; Computer Programs For Analyzing And Assessing Data-Processing Procedures, Performance And Efficiency.

International Class 16:
Computer program manuals and instructional materials for analyzing and assessing data-processing procedures, performance and efficiency.

International Class 35:
Business consultation services relating to data-processing procedures, selection, operation, analysis, performance and efficiency.

International Class 41:
Instruction services for selecting, analyzing, assessing and operating data-processing hardware and software.

International Class 42:
Consulting services for the selection, analysis, assessment and operation of data-processing hardware and software; consulting services in the field of computers.

New Developments at the Trademark Trial and Appeal Board

- Files of TTAB proceedings can now be viewed using TTAB Vue, accessible at http://ttabvue.uspto.gov. After entering the 8-digit proceeding number, click on any entry in the prosecution history to view that paper in PDF format. Papers filed prior to January 2003 may not have been scanned. Unscanned papers are available for public access at the TTAB. For further information on file access, call the TTAB at (703) 308-9330.

- Parties should also be aware of recent changes in the rules affecting trademark matters, including the rules of practice before the TTAB. *See* Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. R. 55,748 (September 26, 2003) (effective November 2, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr55748.pdf); Reorganization of Correspondence and Other Provisions, 68 Fed. Reg. 48,286 (August 13, 2003) (effective September 12, 2003) (www.uspto.gov/web/offices/com/sol/notices/68fr48286.pdf).

- The second edition (June 2003) of the Trademark Trial and Appeal Board Manual of Procedure (TBMP) has been posted on the USPTO web site at www.uspto.gov/web/offices/dcom/ttab/tbmp/.