Exhibits

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

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PATENT & TRADEMARK OFFICE

U.S. Patent & TMOfc/TM Mail Rcpt Cpt. #57
01-14-2002

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

OPPOSERS' REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

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I. INTRODUCTION

Opposers' Summary Judgment motion was filed and served on November 21, 2001. Applicant's Response to that motion was filed and served by mail on December 24, 2001. The Board is requested to consider this reply brief, restricted as it is to comments and observations relating to a limited number of matters as to which, in light of Applicant's Response brief, some further discussion is appropriate.

II. OPPOSERS' DEMONSTRATION OF THE ABSENCE OF GENUINE ISSUES OF MATERIAL FACT REMAINS UNREFUTED

The evidence presented by Opposers in connection with the various relevant Du Pont factors required Applicant to affirmatively respond with evidence establishing the existence of genuine issues of material fact. Applicant has failed to fulfill this obligation. Accordingly, the entry of summary judgment in Opposers' favor is fully warranted.

A. Applicant's Admissions

Applicant has admitted that there exists an overlap in channels of trade with respect to the parties' goods and services. (App. Resp. Br. at p. 4). Applicant also admitted that its goods and Opposers' goods and services are intended for the same purpose, specifically, "business management." (App. Resp. Br. at p. 6). Applicant has admitted that it possessed prior knowledge of Opposers' "COMPASS" mark. (App. Resp. Br. at p. 6).

Each of these admissions further buttresses the likelihood of confusion showing made in Opposers' Summary Judgment brief.

B. Matters Unaddressed by Applicant

Applicant has not addressed the issue of priority. As demonstrated in Opposers' brief, summary judgment in favor of Opposers is appropriate with respect to that issue. Moreover, Applicant has failed to address, through argument or evidence, the Du Pont factors of the extent of potential confusion and the strength of the "COMPASS" mark. Accordingly, Opposers' showing with respect to the extent of potential confusion, and its evidence with respect to the strength of the "COMPASS" mark remains uncontroverted. As no genuine issue of material fact has been shown to exist with respect to the ignored issues of priority, the extent of potential confusion, and the strength of Opposers' mark, those matters weigh convincingly in Opposers' favor.

C. No Evidence Was Presented by Applicant in Connection with Several Additional Matters

No evidence has been offered which controverts Opposers' showings with respect to the parties' uses of their marks and of course Applicant cannot dispute the fact that "VISION-COMPASS" incorporates the "COMPASS" mark in its entirety.

Applicant's argument with respect to the parties' goods and services is devoid of evidentiary support. Applicant was able to offer no refutation of any of the undisputed facts set forth in Opposers' Summary Judgment brief and Applicant again completely ignored the existence of the '290 "COMPASS" registration.

In addition, by ignoring the specific language used in the identification of Applicant's goods as published, and by considering only a portion of Opposers' answer to Interrogatory 2, Applicant would have the Board ignore the undisputable relationship between the goods and

services offered by Opposers and Applicant. Moreover, certain statements offered by Applicant, such as the statement concerning the activities of Applicant's consultants (App. Resp. Br. at p. 4), are not only unsupported by any evidence but, even if supported, would in no way lessen or eliminate the likelihood of confusion.

Finally, Applicant's discussion with respect to the parties' goods and services completely ignores the detailed showing of similarities clearly demonstrated in Opposers' Summary Judgment brief. (See for instance pp.4 - 8 of Opp. Summ. Judg. Br.)[1]

No evidence has been proffered by Applicant in support of its "sophisticated purchasers" argument, including Applicant's contentions with respect to the procurement procedures of governmental agencies and large corporations and Applicant's assertions with respect to the requirement of "several levels of approval required by such purchasers." (App. Resp. Br. at p. 5). Moreover, the identification of goods recited in the opposed application contains absolutely no restriction with respect to the types of persons, companies, or entities to whom Applicant's goods are to be sold. Accordingly, no basis exists for any assumption that prospective purchasers would be sophisticated, large, or demand "several levels of approval" in connection with the purchase of software.

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[1] As noted in Opposers' Response to Applicant's Motion to Strike, all documentation used to demonstrate the close relationship between the parties' goods and services consisted of documentation which was exchanged by the parties during discovery and thus was properly before the Board for purposes of Opposers' Summary Judgment motion. For the Board's convenience, previously submitted Ex. 60, which comprises the various document requests and responses which resulted in the production of such documentation is appended hereto.

Finally, as noted above, no evidence or argumentation has been offered to refute Opposers' showing with respect to priority, the extent of potential confusion, or the strength of the "COMPASS" mark.

D. A Comment Concerning Actual Confusion

Applicant is incorrect in asserting that Opposers' inability to establish actual confusion results in this Du Pont factor favoring Applicant and summary judgment in Opposers' favor being inappropriate. As noted in Opposers' brief (p. 14), Applicant has admitted that to date no copies of its software have been sold and that six copies of its software have been given away. This Du Pont factor does not favor Applicant because the law clearly acknowledges that the absence of actual confusion is of no moment where usage has been relatively limited. Alpha Industries, Inc. v. Alpha Microsystems, 220 U.S.P.Q. 67, 72 (T.T.A.B. 1983).

III. CONCLUSION

The arguments and evidence submitted in support of Opposers' Motion for Summary Judgment clearly establish the propriety of granting summary judgment in Opposers' favor. Applicant has failed to meet the burden imposed upon it by law if Applicant were to successfully defend against Opposers' Motion for Summary Judgment. Accordingly, Opposers' Motion for Summary Judgment should be granted.

Respectfully submitted,

Date: 1/14/02

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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' REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT and previously submitted EXHIBIT 60 were this day served on Applicant by mailing same, via first class mail, to:

Julie L. Reed, Esquire
Marger Johnson & McCollom
1030 SW Morrison Street
Portland, Oregon 97205

Date: 1/14/02

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OPPOSERS' RESPONSE TO APPLICANT'S MOTION TO STRIKE OPPOSERS' SUMMARY JUDGMENT BRIEF

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I. INTRODUCTION

Applicant has moved the Board to strike all, or in the alternative, a substantial portion, of Opposers' summary judgement brief. As no basis exists for striking any portion, let alone all, of the brief filed in support of Opposers' summary judgment motion, Applicant's Motion to Strike must be denied in its entirety.

II. APPLICANT'S MOTION TO STRIKE IS BOTH LEGALLY AND FACTUALLY FLAWED

A. No Factual Basis Exists for Granting Applicant's Motion to Strike

Applicant has requested the Board to strike all of Opposers' summary judgment brief, or at a minimum, the majority of that brief, specifically sections II., III. C. 3., III. C. 3.1 - C.3.11, III. D. and III. F.

Applicant boldly asserts that "The documents submitted in support of Opposer's Motion section II, section III.C.3, sections III.C.3.1 through III.C.3.11, section III.D, and section III.F are the Opposer's own answers and production items." (App. Br., p. 2) This statement is simply not true. While Applicant fails to address a single specific exhibit in its sweeping Motion to Strike, twenty-two (22) of the exhibits submitted in the sections referred to by Applicant are documents which Applicant produced during discovery. Moreover, three additional exhibits are Applicant's interrogatory answers. Finally, every page of each of Opposers' documents used as exhibits was produced to Applicant during discovery and the single interrogatory answer of Opposer Compass America submitted as an exhibit by Opposers (Opp. Ans. to Int. 3) has been submitted and relied upon by Applicant itself. (See pp. 3-4 of App. Summ. Judg. Motion Br.) Accordingly, Applicant

has mischaracterized the nature of the exhibits submitted by Opposers and has provided no basis for striking Opposers' summary judgment brief, nor any portion of that brief.

B. Applicant has Confused the Proper Legal Standard

As noted above, twenty-five (25) of the exhibits referred to in the summary judgment brief sections identified by Applicant are Applicant's documents and interrogatory answers and each of the exhibits referred to in those sections of Opposers' Summary Judgment brief are discovery generated documents and interrogatory answers. These materials are properly before the Board in support of Opposers' Summary Judgment motion.[1]

Applicant's reliance upon Glamorene Products Corp. v. Earl Grissmer Co., 203 U.S.P.Q. 1090 (T.T.A.B. 1979), Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1722 (T.T.A.B. 1999), and Gravel Cologne, Inc. v. Lawrence Palmer, Inc., 176 U.S.P.Q. 123 (C.C.P.A. 1972) is misplaced in that each of those cases concern evidentiary challenges, authentication issues, and issues relating to notices of reliance, during and following trial.[2] Here, there is no question

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[1] Interrogatories, and Applicant's related answers, used as exhibits have been submitted in accordance with Board practice as exhibits 3, 43 and 47. Opposers' answer to Interrogatory 3, as noted above, has also been submitted by Applicant in support of its Motion for Summary Judgment. In addition, copies of all production requests and responses have been submitted as Opposers' Exhibit 60. For the Board's convenience, a copy of Exhibit 60 is appended hereto.

[2] Of the cases cited by Applicant only Raccioppi v. Apogee, 47 U.S.P.Q.2d 1368 (T.T.A.B. 1998) involves an evidentiary issue in a summary judgment context. That case is relevant to the instant case only to the extent that it requires a party relying on Internet printouts to submit a supporting affidavit or declaration of the individual who conducted the related search. In accordance with Raccioppi, submitted herewith is the Declaration (along with Exhibit A) of Alex Kozlov, Director of Marketing for Compass America, Inc., who conducted the related Internet search which resulted in the Internet portion of Ex. 52. Finally, no hearsay issues arises with respect to any portion of Ex. 52 in that none of the publications or articles which comprise that exhibit (Internet and non-Internet articles) are offered for the truth of the matters asserted in the articles or publications. Instead, the articles and publications of Ex. 52 are offered,

concerning the propriety of Opposers submitting documents and interrogatory answers generated during discovery in support of a motion for summary judgment.

III. CONCLUSION

Applicant has incorrectly characterized the nature of the exhibits referred to in the briefing sections referred to by Applicant, has failed to recognize the proper evidentiary standard at this stage of an Opposition proceeding, and has provided no basis upon which any portion of Opposers' Summary Judgment brief can properly be stricken. Accordingly, the Board is asked to deny Applicant's Motion to Strike Opposers' Summary Judgment brief or any portion thereof.

Respectfully submitted,

Date: 1/14/02

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collectively, as a portion of Opposers' evidence establishing the trade recognition and reputation of Opposers, their services, and the "COMPASS" mark.

CERTIFICATE OF SERVICE

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

Julie L. Reed, Esquire
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Date: 1/14/02

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