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

Proceeding	91191683
Party	Defendant Louisiana Economic Development
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

TECHNICAL COLLEGE SYSTEM OF
GEORGIA, A GEORGIA STATE AGENCY,

OPPOSER,

v.

LOUISIANA ECONOMIC DEVELOPMENT,
A LOUISIANA STATE AGENCY,

APPLICANT.

OPPOSITION NO.
91191683

APPLICANT'S TRIAL BRIEF

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I. INTRODUCTION

Both parties agree that this opposition is unique from most in that it involves specific State services provided exclusively through State agencies, to varying degrees, by all or most of the fifty (50) states. (Opposer's brief, pg. 18.) This opposition involves the various tax and financial incentives, including most notably workforce training, that States offer to entice moderate or large sized companies seeking to expand or re-locate their operations. All of these incentives and services are directly and unmistakably tied to each State and the specific State agencies charged with administering them. As such, these services are uniquely and exclusively offered by the States, as opposed to broad commercial services widely offered by businesses across the country. Opposer readily admits at page 4 of its brief that "many states offer similar workforce training programs" and Applicant certainly agrees. For this reason, the number of potential competitors in this unique field is limited to the number of States. It is this unique factor that explains why a term like LOUISIANA, that might otherwise be deemed a trivial geographic element in a broad, unlimited commercial setting, becomes an important and crucial indication of source when uniquely referring to specific services provided only by States. Even Opposer is forced to admit and acknowledge at page 15 of its trial brief that "The LOUISIANA component of Applicant's mark merely describes that Applicant's services originate in, and are intended to attract business to, the State of Louisiana." Applicant obviously agrees, which explains why Applicant believes that it is virtually impossible for any customer to somehow confuse LOUISIANA FASTSTART with QUICK START.

At the core on this opposition is the issue of whether a company seeking to expand or re-locate its operations would be likely to confuse the QUICK START customized workforce training services provided exclusively in Georgia with the LOUISIANA FASTSTART customized workforce training services that are provided exclusively in Louisiana. Against this

unusual backdrop, the Board must consider that all States provide similar incentives and many of their programs also include the terms FAST or QUICK or START or similar suggestive terms to identify their programs. Moreover, it is common for these State programs to specifically include their State name in front of their program's name. In fact, as will be shown, QUICK START itself very often refers to itself as GEORGIA QUICKSTART.

Applicant submits that it is virtually impossible for a company facing the exorbitant costs and weight of a complex decision to expand or re-locate its company to somehow confuse Louisiana incentives for workforce training offered in Louisiana through its LOUISIANA FASTSTART program with specialized incentives for workforce training offered in Georgia through Georgia's QUICK START program, and this would likely hold true even if Louisiana's program was called Louisiana Quick Start.

II. OBJECTIONS TO OPPOSER'S EVIDENCE

Concurrently with the filing of this brief, Applicant is also filing objections to all of the testimony and evidence offered by Opposer ("Objections"). If those Objections are sustained, Opposer would be left in the position of having essentially no testimony and no evidence to support its opposition and/or to satisfy its legal burdens of proof.

As shown in the Objections, all of the Notices of Reliance filed by Opposer are legally defective and inadmissible due to Opposer's failure to properly file them with its testimony period. Applicant has also objected to the hearsay testimony, including attached exhibits, of Opposer's lone witness, who has never been employed with Opposer and therefore lacks personal knowledge of Opposer, its alleged educational services and/or its use of its QUICK START mark.

III. STANDING

The Board must consider an opposer's standing as a threshold issue in every case. As shown in Applicant's Objections, Opposer has failed to properly make its pleaded registrations of record. At page 4 of its trial brief, Opposer quickly glosses over this significant defect by citing an allegation made in its opposition. However, Opposer failed to file certified status and title copies of its registration with its opposition in compliance with Trademark Rule 2.122(d)(1). In addition, Opposer failed to attach its registration and current status information to the testimony of Ms. Green, who, as noted in the Objections, was not even an employee of Opposer. Instead, Opposer did attempt to file copies of a TARR printout in connection with a notice of reliance. However, as shown in the Objections, the notice of reliance was not timely filed during Opposer's testimony period and is therefore inadmissible. See Trademark Rule 2.122(d)(2).

The parties have not stipulated the effective registration and current status of Opposer's alleged registration and Applicant has not admitted such in its answer to the opposition. In response to Opposer's allegations regarding its registration, Applicant denied Opposer's registration allegations except to say "Applicant does however admit the existence of a registered trademark for QUICK START to a registrant other than Opposer and lacks knowledge regarding whether this mark has been validly assigned to Opposer." (Answer, Dkt. No. 4)

Opposer, Technical College System of Georgia, has failed to introduce the testimony of a single employee or officer. It is undisputed that Opposer's sole witness, Ms. Green, is employed by a completely separate state agency - the Georgia Department of Economic Development ("GDED"). Therefore, no direct testimony from Opposer appears in the record. Ms. Green verifies that the Georgia Department of Economic Development is a separate State agency and not part of the Technical College System of Georgia, stating at pages 59-60:

Q And is the Technical College System of Georgia under the Georgia Economic Development?

A No.

Q Okay. What, if any, what is the Technical College System of Georgia, who are they associated with or who do they operate under?

A The state. They're a state agency.

Q So would you say there an independent stand-alone state agency?

A Yes.

Q And is the Georgia Department of Economic Development also a separate state agency of Georgia?

A Yes.

See also the matching testimony of Jeff Lynn, who was actually employed by Opposer at one time (Lynn Depo. Test. Dep. at 6-7. Dkt. Nos. 12 and 14).

As a result, Ms. Green lacks personal knowledge of Opposer's registration and current status of its QUICK START mark and does not, in any event, offer any relevant testimony regarding Opposer's registration and current status of its QUICK START mark. In its Opposition, Opposer alleges that it owns the QUICK START registration for "educational services, namely, industrial training of managers and other employees of companies." The following exchange fairly dramatically exposes the fundamental problems with Ms. Green's testimony:

Q Do you have an opinion as to whether the following definition of -- encompasses or is related to the Quick Start services. Educational services, namely, industrial training of managers and other employees of companies?

A Yes.

Q Yes, it is?

A Yes, that is the def -- that is encompassing of the definition.

(Green Test. Dep. at 46-47)

While being blatantly led by Opposer's legal counsel, Ms. Green is essentially only able to weakly answer yes to this clearly leading question. This question is objectionable and the Board should give Ms. Green's responses no probative value as it has done in similar situations. Ms. Green offers no independent testimony regarding the "educational services" provided by Opposer and certainly does not claim that the GDED provides educational services. Since it is undisputed that Ms. Green has never been employed by Opposer, it is self-evident that any possible knowledge she has of its services and/or its use of its QUICK START mark is not based upon her independent personal knowledge. For these reasons, Opposer has failed to satisfy its burden of establishing its standing in this matter.

IV. RELEVANT FACTS

All or most States offer some form of customized incentives to entice companies to expand or re-locate their operations to their State, including work-force training. (Lynn Depo. Test. Dep. at 39-58, Dkt. Nos. 12 and 14); (Green Test. Dep. at 50-51)

More importantly, both parties agree that domestic companies would understand, when dealing with both programs, that QUICK START is associated with Georgia and LOUISIANA FASTSTART is associated with Louisiana. (Green Test. Dep. at 54-57; Lynn Depo. Test. Dep. at 82-88.)

In addition, both parties agree that independent professional consultants are often retained to assist companies in relocation decisions and these consultants would know that QUICK

START is associated with Georgia and LOUISIANA FASTSTART is associated with Louisiana. (Green Test. Dep. at 57-58; Lynn Depo. Test. Dep. at 82-88.)

Opposer has previously acquiesced and expressly consented to the use of the term “QUICK” in marks used to describe workforce training programs provided by other States, namely: QUICK CONNECT in Virginia and QUICK RESPONSE in Florida. (Rohosky Dep. at 66-68, Applicant’s Notice of Reliance, Dkt. No. 11.)

Individuals like Jeff Lynn, who actually have work experience in these State training programs, are familiar with and have personal knowledge of the workforce training programs in other States. These State agencies keep up with each other through trade journals and national conferences. (Lynn Depo. Test. Dep. at 42-47.) Not surprisingly, Opposer’s witness from the GDED only knew that these programs existed in other States, but didn’t know their names or much of anything else about them. She did however admit that “most everyone provides some form of training assistance to a company.” (Green Test. Dep. at 12-13.)

Drawing upon the “QUICK” theme, South Carolina’s workforce training program is called QUICKJOBS CAROLINA. Mr. Lynn testified that South Carolina’s workforce training program is similar to QUICK START and is likewise managed by the SC Technical College System, much the way QUICK START is run by the Technical College System of Georgia. (Lynn Depo. Test. Dep. at 42-44; Exhibit 5)

Continuing the QUICK theme, Virginia’s workforce training program is VWCC QUICK CONNECT and is provided through the Virginia Western Community College system. This program provides workforce training similar to the services provided by Applicant and Opposer. (Lynn Depo. Test. Dep. at 48-50; Exhibit 6; Rohosky Dep. at 66-68, Applicant’s Notice of Reliance, Dkt. No. 11.)

Substantially similar to QUICK START, Florida's customized workforce training program is known as QUICK RESPONSE and/or QUICK RESPONSE TRAINING and it provides services similar to the services provided by Applicant and Opposer. (Lynn Depo. Test. Dep. at 51-52; Exhibit 7; Rohosky Dep. at 66-68, Applicant's Notice of Reliance, Dkt. No. 11.)

Oklahoma has a FASTFORWARD and/or OKLAHOMA FASTFORWARD program that includes a customized workforce training program similar to the services provided by Applicant and Opposer. (Lynn Depo. Test. Dep. at 52-53; Exhibit 8.)

Tennessee's program is known as FASTTRACK TENNESSEE, which is substantially similar to LOUISIANA FASTSTART. The FASTTRACK TENNESSEE program includes customized workforce training similar to Applicant's and Opposer's services. (Lynn Depo. Test. Dep. at 53-54; Exhibit 9.)

Iowa offers a program known as RAPID RESPONSE, which is primarily charged with helping companies hire skilled employees being terminated from companies that are closing or down-sizing. Mr. Lynn testified that Louisiana and Georgia both offer similar "Rapid Response" programs that provide similar services. (Lynn Depo. Test. Dep. at 54-56; Exhibit 10.)

Utah offers a program known as RURAL FAST TRACK, which is a workforce incentive program similar to what is offered by other States. Through this program, Utah provides post-performance grants that allow companies to obtain reimbursement after creating high-paying jobs in certain rural counties. (Lynn Depo. Test. Dep. at 56-58; Exhibit 11.)

All of these workforce training programs involve similar highly suggestive terms with the distinguishing element often being the State's name. Despite any similarity, it would be virtually impossible for a company looking to re-locate to Georgia or Louisiana to somehow confuse QUICK START with LOUISIANA FASTSTART.

Much of the “Relevant Facts” cited in Opposer’s brief at pages 2-10 are heavily, disputed, inconclusive, inadmissible and/or not in evidence, namely including:

- Opposer cites Ms. Green testimony in support of its claim on page 2 of its brief that it has used the QUICK START mark since 1968. In fact, it is Opposer’s attorney that leads Ms. Green by asking if the mark has been continuously used since 1968. Ms. Green responds yes, despite her admission on page 9 of her testimony that she didn’t become involved with the GDED until 2009 and therefore had no personal knowledge of what happened before 2009 and never actually even worked for Opposer.
- On page 4 of its brief, Opposer refers to its registration for QUICK START but has failed to properly make its pleaded registration of record since its Notices of Reliance were all filed well after the close of its testimony period (and after close of its rebuttal period as well).
- At page 4 of its brief, Opposer heavily relies upon GDED documents attached to Ms. Green’s deposition that purportedly relate to money and jobs resulting from companies expanding or re-locating to Georgia. But, as shown in the Objections, this testimony and related GDED exhibits are inadmissible hearsay and Ms. Green has not testified that these documents have been kept in the ordinary course of GDED’s business. Nor has Ms. Green attempted to identify which companies came to Georgia for the generous financial and tax incentives offered to them through the GDED versus those that came because of Opposer’s workforce training program.
- At pages 4-6, Opposer refers to client testimonials, but those documents and information must likewise be excluded as inadmissible hearsay as shown in Applicant’s Objections.
- At page 6 of its brief, Opposer inadvertently reveals a fundamental evidentiary issue that plagues its entire case, mistakenly claiming: “To identify businesses to target in 2010,

Opposer attended 118 trade shows, 45 of which were international, including Cuba, Dubai and China. (Green Test. Dep. at 18, Ex.20).” However, as has been frequently stated, Ms. Green worked in the GDED and it is clear from her testimony that she is describing, as one would expect, what she, her Global Response Team and the GDED did, not Opposer, the Technical College System of Georgia. In fact, Ms. Green testifies: “It talks about the fact that the Department of Economic Development or the Global Commerce Team you know attended 118 trade shows, 45 of those were international, we ran major missions into Cuba, Dubai and China.” (Green Test. Dep. at 18, Ex.20).”

- In footnote 2 on page 2, Opposer attempts to gloss over the undisputed fact that the GDED and Opposer are two completely separate and independent State agencies, briefly concluding that the QUICK START program is “informally” part of GDED’s team. This association was more fully described in Ms. Green’s testimony as two agencies, with several other agencies, sharing the same building, stating:

Q Is there an entity within the Department of Economic Development that oversees this training program, this Quick Start training program?

A No. That is really overseen by Quick Start. It falls within the Georgia Technical College System. And, however, Quick Start is really considered part of the -- informally part of the Department of Economic Development's team, we actually are all in the same building. (Green Test. Dep. at 11-12)

- Opposer, presumably with great distaste, alleges at page 8 of its brief that Applicant’s “services are identical to Opposer’s workforce training services.” Mr. Lynn has never made such a claim and certainly no one with Opposer has or would ever admit to such. In fact, when Ms. Green was asked “Do you feel that Quick Start offers very unique services

compared to the workforce training services offered by other states,” Ms. Green’s answered “yes.” (Green Test. Dep. at 58.) Mr. Lynn only stated the QUICK START program and the LOUISIANA FASTSTART program, like many other similar programs, provide services that are “similar.” (Lynn Test. Dep. at 90)

- Opposer further alleges at page 8 of its brief that “Applicant’s services are offered to identical customers in the identical channels of trade as Opposer,” citing Mr. Lynn’s testimony at pages 24-28 and 90 of his deposition as its support. Again, this is inaccurate and misleading. There is no direct evidence in the record that shows Applicant and Opposer have ever actually “offered” their training services “to identical customers.” At pages 45-46, Ms. Green ambiguously testifies that “we absolutely compete for projects against Louisiana.” This statement is almost certainly true, but also meaningless. It is entirely probable that GDED and the Louisiana Department of Economic Development competed for relocation projects in prior years, well prior to formation of LOUISIANA FASTSTART program in 2009. But Ms. Green fails to provide any direct testimony regarding actual competition between the Opposer’s QUICK START program and the LOUISIANA FASTSTART program in 2009 or 2010 after LOUISIANA FASTSTART was finally launched. In addition, there is no evidence to support Opposer’s claim that the programs offer their services in identical channels of trade.
- Opposer alleges at page 8 of its brief: “It is undisputed that the respective services, customers, and channels of trade are identical” citing Mr. Lynn’s testimony at page 90 of his deposition as support. This claim is unsupported and heavily disputed by direct evidence in the record that refutes it entirely. Opposer has failed to prove that Opposer and LOUISIANA FASTSTART have ever solicited a single identical out of state customer since LOUISIANA

FASTSTART finally commenced operations in 2009. Mr. Lynn only stated that Applicant and Opposer “would go after the same companies” at least domestically. But even that testimony is limited by undisputed additional factors. First and foremost, it is essentially impossible for Opposer and Applicant to go after the same company unless that company is considering, or willing to consider, both Louisiana and Georgia as possible locations. Absent that qualifying restriction, the two companies could never compete since workforce training services are entirely irrelevant if a Company is simply not willing to consider moving its operations to your State. When specifically questioned about Ms. Green’s ambiguous statements, Mr. Lynn specifically testified that he didn’t know of “any project” in which LOUISIANA FASTSTART and QUICK START competed and went on to refute Ms. Green’s ambiguous testimony on this subject. Similar to Opposer, Mr. Lynn also verified that LOUISIANA FASTSTART is not involved in the recruitment of every company to Louisiana so a company may decide to re-locate to Louisiana without any involvement by the LOUISIANA FASTSTART program. (Lynn Test. Dep. at 73-82.)

- Applicant submits that the Board should carefully review Opposer’s alleged facts at page 9 of its brief and consider whether these “facts” represent a fair and accurate recitation of Mr. Lynn’s testimony. Opposer claims that Mr. Lynn stated that “he looked at what we did at Georgia” and used it as a model to form certain policies for Applicant. In truth, Mr. Lynn stated that he looked at what he did at Georgia and what is done in Alabama and “looked at many, many states to come up with those procedures and policies.” (Lynn Test. Dep. at 93.)
- Based primarily on the inadmissible deposition of Ms. Jackie Rohosky (See Applicant’s Objections), Opposer claims that Applicant modeled its workforce training program after Opposer’s program. However, Mr. Lynn, who was the only witness with direct, personal

knowledge, testified that he specifically look at Alabama and South Carolina's workforce training program and more briefly "at several other programs" when trying to establish a framework for Applicant's workforce training program. (Lynn Test. Dep. at 26-27.)

V. ARGUMENT

In *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973), the following factors were established as being determinative in considering whether likelihood of confusion exists under § 2(d): (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression; (2) The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use; (3) The similarity or dissimilarity of established, likely-to-continue trade channels; (4) The conditions under which buyers to whom sales are made, i. e. "impulse" vs. careful, sophisticated purchasing; (5) The fame of the prior mark (sales, advertising, length of use); (6) The number and nature of similar marks in use on similar goods; (7) The nature and extent of any actual confusion; (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) The variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (10) The market interface between applicant and the owner of a prior mark: (a) a mere "consent" to register or use; (b) agreement provisions designed to preclude confusion, i. e. limitations on continued use of the marks by each party; (c) assignment of mark, application, registration and good will of the related business; (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion; (11) The extent to which applicant has a right to exclude others from use of its mark on its goods; (12) The extent of potential confusion, i. e., whether de minimis or substantial; (13) Any other established fact probative of the effect of use.

However, not all of the *DuPont* 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.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). In fact, in *Citigroup Inc. v. Capital City Bank Group Inc.*, 98 USPQ2d 1253 (Fed. Cir. 2011), a case that is analogous in many ways to this opposition, the TTAB and appellant court agreed that no likelihood of confusion existed between the famous CITIBANK mark and CAPITAL CITY BANK even though four of the six applicable duPont factors favored the opposer and only two favored the applicant.

A. No Likelihood Of Confusion Exists.

The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. More than a mere possibility of confusion must be shown; instead, there must be demonstrated a probability or likelihood of confusion. See *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from *Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc.*, 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: “We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal.” See also, *Triumph Machinery Company v. Kentmaster Manufacturing Company Inc.*, 1 USPQ2d 1826 (TTAB 1987).

It is well settled that Opposer, as the plaintiff in this proceeding, bears the burden of proof with respect to its claim of priority of use and likelihood of confusion. See, e.g., *Bose Corp. v. QSC Audio Products Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) [“[t]he burden of proof rests with the opposer ... to produce sufficient evidence to support the ultimate conclusion of [priority of use] and likelihood of confusion”]; *Hoover Co. v. Royal Appliance Mfg. Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722 (Fed. Cir. 2001) [“[i]n opposition

proceedings, the opposer bears the burden of establishing that the applicant does not have the right to register its mark”]; *Champagne Louis Roederer S.A. v. Delicato Vineyards*, 143 F.3d 1373, 47 USPQ2d 1459, 1464 (Fed. Cir. 1998) (Michel, J. concurring).

Opposer has failed to show and is unable to satisfy its burden of proving that mid to large sized companies would likely confuse the QUICK START services offered by Opposer to companies considering possible relocation to Georgia with the LOUISIANA FASTSTART services available to companies considering possible relocation to Louisiana.

First and foremost, this opposition involves incentives and services provided exclusively by States through their respective State agencies. All or almost all fifty states offer some form of incentives to companies willing to relocate to their State. Both parties agree that, as a component of these significant tax and financial incentives, most every States offers some form of workforce training as part of their complex package of incentives. (Green Test. Dep. at 12-13, 50-51; (Lynn Depo. Test. Dep. at 39-58.) Companies looking to expand or relocate their companies are well aware of these incentives and that they are provided exclusively through the State agencies existing in each State.

By their nature, State governments and State agencies have a rich history of providing similar services and most citizens likely expect some measure of continuity in the various governmental services provided through similar State agencies of the various States. Like almost every State, Louisiana and Georgia offer incentives to lure companies to their respective states, including workforce training. Like Georgia and Louisiana, several states include some variation of the term FAST, QUICK, RAPID or START in indentifying their workforce training services.

There is simply no evidence in the record that could explain how a sophisticated company that is evaluating one of the most expensive and critical decisions any company can

possibly face, would likely confuse LOUISIANA FASTSTART services that are exclusively provided in Louisiana through the Louisiana Department of Economic Development with the QUICK START program offered by the Technical College System of Georgia in Georgia.

1. QUICK START Is A Weak Highly Suggestive Mark.

QUICK START is not a strong, arbitrary or fanciful mark. It is a highly suggestive mark and therefore a very weak indicator of source. In fact, the enabling legislation for this State educational program describes it as follows:

[T]here is hereby established within the State Department of Education, a supplemental program to provide special quick start training to meet the employment needs of new and expanding industry. The program shall be administered by the State Board of Education. (emphasis added) (See Lynn Test. Dep. at 21-23, Ex. 2.)

The QUICK START mark was adopted and is used by the Dept. of Education in the same suggestive manner used in its enabling legislation, to suggest that trained employees can quickly start work with relocated companies needing new employees.

Third-party registrations can be used in the manner of dictionary definitions, in order to show that a term has been adopted because it has significance within a particular industry. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243 (TTAB 2010). However, to show that an Opposer's mark is weak because it has a suggestive meaning, the third-party registrations must be for goods or services related to the goods or services in the Opposer's cited registration.

As one would expect with a highly suggestive mark, the same identical QUICK START mark has been federally registered by third parties as a service mark within the identical field of educational services, including two substantial similar registrations for PR QUICKSTART and DP QUICKSTART, both also for educational services. In addition, several other service mark registrations exist in the field of educational services for similar suggestive marks such as FASTART, FAST START, JUMPSTART, etc. (See Applicant's Notice of Reliance, Dkt. No.

13.) As a result, Opposer is not exclusively entitled to use the suggestive mark QUICK START within the field of educational services and there are various other registrations of similar suggestive terms. In the field of educational services, the suggestive terms “Quick Start” are used to suggest that a skill set is quickly mastered for use.

Unlike Opposer, Applicant does not purport to offer any “educational services” and Applicant’s services are not provided by an educational entity such as Opposer, the Technical College System of Georgia. Instead, Applicant provides “business training services” through its Louisiana Economic Development department. These are the expressly specified services for which Opposer and Applicant have sought registration.

Again, as one would expect with a highly suggestive mark, there are several other States that offer workforce training services using similar names and suggestive terms, including: (i) South Carolina - QUICKJOBS CAROLINA (Lynn Depo. Test. Dep. at 42-44; Exhibit 5); (ii) Virginia - VWCC QUICK CONNECT (Lynn Depo. Test. Dep. at 48-50; Exhibit 6); (iii) Florida - QUICK RESPONSE TRAINING (Lynn Depo. Test. Dep. at 51-52; Exhibit 7); (iv) Oklahoma - OKLAHOMA FASTFORWARD (Lynn Depo. Test. Dep. at 52-53; Exhibit 8); (v) Tennessee - FASTTRACK TENNESSEE (Lynn Depo. Test. Dep. at 53-54; Exhibit 9.); (vi) Iowa – RAPID RESPONSE (Lynn Depo. Test. Dep. at 54-56; Exhibit 10); and (vii) Utah - RURAL FAST TRACK (Lynn Depo. Test. Dep. at 56-58; Exhibit 11) All of these workforce training programs involve similar highly suggestive terms with the distinctive element often being the State’s name.

For the reasons shown above, it must also be noted that Opposer admits that it very often refers to itself as GEORGIA QUICKSTART. (Green Test. Dep. at 48) (Lynn Depo. Test. Dep. at 18.) Opposer’s website is <http://georgiaquickstart.org/> and Opposer’s title for a “Quick Start” search query results is “GEORGIA QUICK START. (Lynn Depo. Test. Dep. at 18.) On the

“About Us” webpage of Opposer’s website, the page title is “About Georgia Quick Start” and the address given to contact Opposer begins “Georgia Quick Start” with a contact email address listed as “marketing@georgiaquickstart.org.” (Lynn Depo. Test. Dep. at 18; Ex. 1, page 2)

The foregoing shows that QUICK START is not a strong mark entitled to great weight or protection. In addition to the fact that Opposer’s mark is weak, LOUISIANA FASTSTART is not similar to QUICK START. As previously noted, the State designation of LOUISIANA is especially relevant in the context of State agencies providing State services that emanate exclusively from the States, which explains why Opposer so often and consistently refers to itself as GEORGIA QUICKSTART.

2. LOUISIANA FASTSTART And QUICK START Are Not Similar.

When assessing the first *duPont* factor, “similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression,” it is clear that QUICK START and LOUISIANA FASTSTART are not similar. It is undisputed that neither mark sounds or appears the same and are spelled distinctly different. The Federal Circuit has found mark dissimilarity when the words are spelled differently. See, e.g., *Champagne Louis Roederer, S.A. v. Delicato Vineyards*, in which the court found mark dissimilarity between CRISTAL and CRYSTAL CREEK. 148 F.3d 1373, 1374-75 (Fed. Cir. 1998).

The test under the first *duPont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entireties, it is well-settled that one feature of a mark may be more

significant than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

In this case, LOUISIANA FASTSTART includes only the word START from Opposer's QUICK START mark, albeit as a combined single word with FAST, which is actually not a true word per se but a fanciful word combination. That is the extent of any direct connection, yet START can hardly be thought of as a strong or dominant mark.¹

The record in this case establishes that the terms QUICK and START are weak, highly suggestive terms in the field of educational services. In Applicant's Notice of Reliance, there are eight (8) third party registrations incorporating the term START, including one identical QUICK START registration and two registrations incorporating the terms QUICKSTART, and also including three FAST START or FASTART registrations. All of these registrations are in the same identical "educational services" class as Opposer's alleged registration (Applicant's Notice of Reliance, Dkt. No. 13.) See: *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 223 USPQ 1281, 1285-86 (Fed. Cir. 1984) (Third-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry).

Due to their common and highly suggestive nature, it would be improper to conclude that START or FAST dominates over the other element in Applicant's mark. In the context of the average purchaser of State services provided exclusively by State agencies, it is clear that the term LOUISIANA is the dominant element of Applicant's mark. For these reasons, the Board should accord the mark QUICK START a very limited scope of protection in connection with

¹ It should be noted that although Opposer makes some mention of the term QUICK in its similarity analysis, Opposer has previously acquiesced and expressly consented to the use of the term "QUICK" in marks used to describe workforce training programs provided by other States, namely: QUICK CONNECT in Virginia and QUICK RESPONSE in Florida. (Rohosky Dep. at 66-68, Applicant's Notice of Reliance, Dkt. No. 11.)

educational services. The fact that Applicant has disclaimed LOUISIANA is on no significance in this analysis. The technicality of a disclaimer in an application to register a mark has no legal effect on the issue of likelihood of confusion. *Specialty Brands, Inc. v. Coffee Bean Distributors, Inc.*, 748 F.2d 669, 672, 223 USPQ 1281, 1282 (Fed.Cir.1984); *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570, 218 USPQ 390, 395 (Fed.Cir.1983). The public is unaware of what words have been disclaimed during prosecution of the trademark application and such action cannot affect the scope of protection to which another's mark is entitled.

In general, where the dominant portion of the marks is similar, confusion may not be avoided by the addition of another term. However, in cases "where the conflicting marks in question are highly suggestive or merely descriptive or play upon commonly used or registered terms, the addition of a housemark and/or other material to one of the marks has been held sufficient to render the marks as a whole distinguishable." *In re Shawnee Milling Co.*, 225 USPQ 747, 749 (TTAB 1985)(GOLDEN CRUST for flour and ADOLPH'S GOLD'N CRUST for flour-based coating and seasoning not confusingly similar). See also *In re S.D. Fabrics, Inc.*, 223 USPQ 54 (TTAB 1984)(DESIGNERS/FABRIC (stylized) for retail fabric store services held not likely to be confused with DAN RIVER DESIGNER FABRICS and design for textile fabrics).

Similarly, In *In re Hunke & Jockheim*, 185 USPQ 188 (TTAB 1975), the Board found HIG-DURABLE not confusingly similar to DURABUL stating:

[T]his is significant because it is well established that the scope of protection afforded a merely descriptive or even a highly suggestive term is less than that accorded an arbitrary or coined mark. That is, terms falling within the former category have been generally categorized as "weak" marks, and the scope of protection extended to these marks has been limited to the substantially identical notation and/or to the subsequent use and registration thereof for substantially similar goods. Thus, unlike in the case of an arbitrary or unique designation, the addition of other matter to a highly suggestive or descriptive designation, whether such matter be equally suggestive or even descriptive, or possibly

nothing more than a variant of the term, may be sufficient to distinguish between them so as to avoid confusion in trade. See: *Milwaukee Nut Company v. Brewster Food Service*, 125 USPQ 399 (CCPA, 1960); *The Murray Corporation of America v. Red Spot Paint and Varnish Co., Inc.*, 126 USPQ 390 (CCPA, 1960); *The Fleetwood Company v. Hazel Bishop, Inc.*, 147 USPQ 344 (CA 7, 1965); *Ferro Corporation v. Ronco Laboratories, Inc.*, 148 USPQ 497 (CCPA, 1966); *Ferro Corporation v. Martin-Marietta Corporation*, 164 USPQ 137 (CCPA, 1969); and *Sure-Fit Products Company v. Saltzson Drapery Company*, 117 USPQ 295, 297 (CCPA, 1958). As stated in the last cited case:

“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. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.”

In view of the weakness of the suggestive common element START, and of Opposer's remaining term QUICK (plus the undisputed fact that Opposer has expressly consented to use of the term QUICK by other States for their workforce training programs) and the dominance, within this specific industry, of the term LOUISIANA in applicant's mark, any similarity as to the highly suggestive components of the Opposer's mark is outweighed and distinguish by the dominant dissimilarities. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)(confusion unlikely when marks are of such non-arbitrary nature that the public easily distinguishes slight differences in the marks under consideration). See also *Colgate-Palmolive Co. v. Carter-Wallace, Inc.*, 432 F.2d 1400, 167 USPQ 529 (CCPA 1970) (because common element in marks is a common noun or adjectival word of everyday usage in the English language and has a laudatory or suggestive indication, PEAK PERIOD for personal deodorants is not confusingly similar to PEAK for dentifrice); and *Sure-fit Products Co.*, 117 USPQ 295 (where a party has a weak mark, competitors may come closer to the mark than would be the case with a strong mark without violating the party's rights; marks SURE-FIT and RITE-FIT, both for slip-covers, held not confusingly similar).

Just as the Board and Federal Circuit found CAPITAL CITY to be the dominant element of the CAPITAL CITY BANK mark because it is located at the beginning of the marks. *Citigroup*, 94 U.S.P.Q.2d at 1664, the same logic applies with LOUISIANA FASTSTART. As the first word of the mark, LOUISIANA gives Applicant's mark a distinct look and sound from Opposer's mark. The fact that the term LOUISIANA has a geographic connotation does not, in the context of this opposition, weaken it just as the term "Capital City" with its geographic reference to the capital city of Florida did not dissuade the TTAB or Court from finding lack of similarity in the *Citigroup* opposition.

Based upon the foregoing analysis, it is clear that QUICK START and LOUISIANA FASTSTART are not similar and therefore the first *duPont* factor favors Applicant. Even if the marks were similar, which they are not, it would still be virtually impossible for a company looking to re-locate to Georgia or Louisiana to somehow confuse QUICK START with LOUISIANA FASTSTART.

3. The Number And Nature Of Similar Marks In Use On Similar Goods.

As already shown, the sixth *duPont* factor also heavily favors Applicant. Applicant's Notice of Reliance, Dkt. No. 13 shows a number of third party registrations incorporating the terms QUICKSTART, START, QUICK, FAST and FAST START, including a registration for Opposer's identical QUICK START mark in the identical educational services class.

In addition to the third party registrations, Applicant has shown that several other States offer workforce training services under highly suggestive terms and marks that are substantially similar to Opposer's mark, including: (i) South Carolina - QUICKJOBS CAROLINA (Lynn Depo. Test. Dep. at 42-44; Exhibit 5); (ii) Virginia - VWCC QUICK CONNECT (Lynn Depo. Test. Dep. at 48-50; Exhibit 6); (iii) Florida - QUICK RESPONSE TRAINING (Lynn Depo. Test. Dep. at 51-52; Exhibit 7); (iv) Oklahoma - OKLAHOMA FASTFORWARD (Lynn Depo.

Test. Dep. at 52-53; Exhibit 8); (v) Tennessee - FASTTRACK TENNESSEE (Lynn Depo. Test. Dep. at 53-54; Exhibit 9.); (vi) Iowa – RAPID RESPONSE (Lynn Depo. Test. Dep. at 54-56; Exhibit 10); and (vii) Utah - RURAL FAST TRACK (Lynn Depo. Test. Dep. at 56-58; Exhibit 11).

4. The Nature Of The Services, As Shown In The Registration and Application Are Not Similar.

At page 11 of its brief, Opposer claims that the services identified in the Applicant's application and the Opposer's registration are identical. Opposer and Applicant agree that "in determining whether services are related, the Board looks to the service as identified in the as-published application." See: *Octocom Sys., Inc., v. Houston Computer Services, Inc.*, 918 F.3d 937, 942, 16 U.S.P.Q. 2d 1783, 1787 (Fed. Cir. 1990) (Opposer's Brief, pg. 11.) Opposer has failed to properly plead its registration (See Applicant's Objections), but alleges in its brief that Opposer's QUICK START mark is registered for "educational services." Unlike Opposer, Applicant does not purport to offer any "educational services" and Applicant's services are not provided by an educational entity such as Opposer, the Technical College System of Georgia. Instead, Applicant provides "business training services" through its Louisiana Economic Development department. These are the expressly specified services for which Opposer and Applicant have sought registration and these services are not even similar, much less identical.

Opposer and Applicant agree that Applicant's services are identified as "business training services, namely, training in the fields of headquarters operations, call center operations, operation of distribution centers, technical training related to product manufacturing and team skills and leadership training."

Opposer's registration is not alleged to include any of Applicant's services. Opposer does not allege that its registration includes any: (i) "training in the fields of headquarters

operations;” (ii) “call center operations;” (iii) “operation of distribution centers,” (iv) “technical training related to product manufacturing; or (v) “team skills leadership training.”

Instead, Opposer alleges that it provides “educational services, namely including industrial training of managers and other employees of companies,” none of which is even mentioned in Applicant’s registration.

Based upon the services indentified in Applicant’s application and the alleged services described in Opposer’s registration, it is clear that the offered services are not related and this *duPont* factor heavily favors Applicant.

5. **The Conditions Under Which Customers Make Sophisticated Versus Impulse Decisions To Use Services Associated With The Marks In Question.**

Opposer correctly anticipates at page 18 of its brief that Applicant will likely argue that the parties’ customers are sophisticated decision-makers making very deliberate and calculated decisions. Indeed, they are. Opposer does not dispute the sophistication of the customers nor does it dispute the unique and complex conditions of the purchasing decisions. Relocating a business’ entire operations or deciding where to expand an existing business is a complex and expensive decision that is not hastily made without a measured analysis and careful evaluation of the myriad of factors associated with such a decision. Perhaps begrudgingly, Ms. Green admits the sophistication of the customers and, more importantly, admits that domestic companies would understand the difference between QUICK START and LOUISIANA FASTSTART, stating:

Q Would you agree that these decisions involve a significant amount of time?

A Yes.

Q And a significant amount of money or expense are involved?

A Yes.

Q Would you agree that when a company is involved in a decision to relocate or to expand its business and began dealing with Georgia Quick Start or Quick Start, and Louisiana Fast Start, that the company would understand that that Louisiana Fast Start is affiliated with the state of Louisiana and Quick Start is affiliated with the state of Georgia?

A Potentially. But I think potentially they could not. For example, if you -- you know, you deal with -- and I know I'm harping on China a lot.....

* * * * *

Q And what about with domestic companies, then, I'd like you to focus your attention on that and ask the same question again. Would you agree that domestic companies that are based in the United States would understand when dealing with Louisiana Fast Start and also Quick Start that Quick Start is associated with the state of Georgia and Louisiana Fast Start is associated with the state of Louisiana?

A I think primarily they would. (Green Test. Dep. at 54-57.)

See also the similar testimony of Jeff Lynn attesting to the complexity of the decision and of the decision makers themselves. (Lynn Depo. Test. Dep. at 82-88.) Based upon the undisputed evidence and record, it is clear that the decision to use QUICK START in connection with a company's relocation to Georgia or to use LOUISIANA FASTSTART in connection with a company's relocation to Louisiana is a complex and time-consuming decision that is only made after careful evaluation by sophisticated business people. Therefore, this fourth *DuPont* factor heavily favors the Applicant.

6. There Is No Proven Similarity Of Trade Channels Or Customers.

Opposer has neglected to prove any direct evidence of the various trade channels utilized

by the Applicant and Opposer. Instead, Opposer argues at page 16 of its brief that “where the parties’ services are identical, and there are no restrictions as to trade channels and purchasers, the Board may presume that the channels of trade and classes of purchasers are the same.” However, as previously shown, the parties’ services are not identical or even similar.

Opposer claims that both parties market their services to U.S. and international businesses. However, the record shows that only one company from the United Kingdom has made use of Applicant’s services and there is no evidence to suggest that Applicant actively markets LOUISIANA FASTSTART to any international businesses. Ms. Green, on the other hand, testified almost exclusively about GDED’s pursuant of international companies. Ms. Green lacked personal knowledge as to Opposer’s possible marketing of QUICK START, domestically or internationally.

Ms. Rohosky however was employed with Opposer and she testified in her deposition that in the twenty (20) years that she had worked there, Opposer had not paid for one single advertisement. (Rohosky Dep. at 42-43, Applicant’s Notice of Reliance, Dkt. No. 11.) Opposer has not commercially advertised its QUICK START mark and, in fact, does not even have an advertising budget. Moreover, Ms. Rohosky was quick to clarify that Applicant “heavily” advertises its QUICK START mark in trade journals whereas Opposer does not. Ms. Rohosky testified that Opposer’s promotion of its QUICK START mark is strictly limited to its website and its newsletter. (Rohosky Dep. at 42-43, 63, Applicant’s Notice of Reliance, Dkt. No. 11.) Through the deposition testimony of Opposer’s employee, it is clear that Applicant and Opposer do not, by any stretch, market their services through similar trade channels.

In addition to the lack of similarity as to marketing channels, there is no evidence in the record that shows that the QUICK START and LOUISIANA FASTSTART programs have ever

competed for the same customer or project. The parties agree that the only way the QUICK START program and LOUISIANA FASTSTART could ever possibly compete would be if a company was willing to consider both States as potential locations. (Green Test. Dep. at 54; Lynn Depo. Test. Dep. at 80.) For this reason, the potential risk for competition and confusion is very limited. There could be an infinite number of reasons to explain why a company would not be open to considering both Louisiana and Georgia in its relocation or expansion decision. Obviously, as will be later shown, for an expansion decision, the company would have to already be based in both Georgia and Louisiana. So, in those rare instances, it would be virtually impossible for a company already based in both Georgia and Louisiana to somehow confuse QUICK START with LOUISIANA FASTSTART.

At pages 16-18 of its brief, Applicant strenuously argues that the two programs have competed for the same customers previously, but the record does not support this claim. First, most of Ms. Green's testimony is devoted almost entirely to the GDED's very significant international focus. As to Applicant however, there is no testimony or evidence to show that Applicant has ever actively marketed LOUISIANA FASTSTART to international companies. Also, Ms. Green's testimony is obviously centered on the actions of her agency, the GDED, and the possible competition between GDED and the Louisiana Department of Economic Development for certain projects or customers. Ms. Green fails to provide any specific dates so it is impossible to know when any such projects allegedly occurred. Applicant has not attempted to investigate or verify if the GDED and the Louisiana Economic Development department have ever competed for certain projects. This opposition involves the QUICK START program and the LOUISIANA FASTSTART program, which was not even operational until 2009.

Opposer admits that Mr. Lynn's testimony refutes Ms. Green's claims, but Opposer again

very carefully claims in footnote 3 on page 17 that “Applicant and Opposer” competed for at least Graphic Packaging, IEM and Smuckers. Again, any possible competition between GDED and the Louisiana Economic Development department is irrelevant unless it involved the actual Opposer and its QUICK START mark and Applicant’s LOUISIANA FASTSTART mark.

As to Graphic Packaging, Mr. Lynn clarified that (i) this company was already heavily based in Louisiana for a long time; (ii) LOUISIANA FASTSTART did not meet with them until after the decision to expand its existing operations in Louisiana was already made; and (iii) LOUISIANA FASTSTART has never provided any services to Graphic Packaging. Again, this was an existing customer already based in both Georgia and Louisiana so there was no chance it could confuse QUICK START with LOUISIANA FASTSTART. (Lynn Depo. Test. at 74-76.)

Similarly, IEM is a company that was actually headquartered in Baton Rouge, Louisiana and still maintains a large presence in Louisiana. Ms. Lynn testified that IEM decided to move part of its operations to North Carolina and that he wasn’t aware of any alleged competition for IEM with QUICK START. Again, this was a company already based in Louisiana. (Lynn Depo. Test. at 78-79.)

Finally, as to Smuckers, Mr. Lynn did not mention any actual involvement by LOUISIANA FASTSTART but he did clarify that SMUCKERS was already based in Louisiana and decided to move some of its Kansas City operations to New Orleans to save money and move closer to a port. Again, Mr. Lynn made no mention whatsoever of any competition with the QUICK START program for Smuckers. (Lynn Depo. Test. Dep. at 77-78.)

It is undisputed that the only way these programs could ever possibly compete would be in those rare circumstances where a company, that is not currently based in either Georgia or Louisiana, is looking to relocate its operations to a slate of possible States that includes both

Georgia and Louisiana and also interested in workforce training assistance.

Given the absence of similar advertising and marketing channels, the GDED's divergent focus on international companies and the absence of any proof as to any similar customers and/or competition between the programs for relocation projects, this third *DuPont* factor heavily favors Applicant.

7. QUICK START Is Not A Famous Mark.

Opposer does not openly argue that its mark is famous, but it does briefly mention the concept at page 23 of its brief so this issue will be addressed out of an abundance of caution. Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks at issue, "by the length of time those indicia of commercial awareness have been evident," widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in certain circumstances to prove fame of a mark, raw numbers alone may be misleading. The context surrounding the raw statistics may be necessary (e.g., the substantiality of the sales or advertising figures as compared to those providing comparable products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

With regard to the burden of proving a mark is famous, the Board has stated "because of the extreme deference that we accord a famous mark in terms of the wide latitude of legal protection it receives, and the dominant role fame plays in the likelihood of confusion analysis, it is the duty of the party asserting that its mark is famous to clearly prove it. *Leading Jewelers Guild Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1904 (TTAB 2007); *Coach Services, Inc., v. Triumph Learning LLC*, 96 U.S.P.Q.2d 1600, 2010 WL 3798519 (TTAB 2010).

As already shown, Ms. Green spends an inordinate amount of time explaining and repeating the extensive international efforts of GDED. Opposer however improperly attempts to use this testimony to support a claim for the fame of Opposer's QUICK START mark. At page 6 of its brief Opposer mistakenly argues: "To identify businesses to target in 2010, Opposer attended 118 trade shows, 45 of which were international, including Cuba, Dubai and China. (Green Test. Dep. at 18, Ex.20)." This claim is essentially repeated at pages 21-23. However, as has been frequently stated, Ms. Green works in the GDED and it is clear from her testimony that she is describing, as one would expect, what she, her Global Response Team and the GDED did, not Opposer, the Technical College System of Georgia. In fact, Ms. Green testifies: "It talks about the fact that the Department of Economic Development or the Global Commerce Team you know attended 118 trade shows, 45 of those were international, we ran major missions into Cuba, Dubai and China. (Green Test. Dep. at 18, Ex.20)." As shown in Applicant's Objections, almost all of Ms. Green's testimony regarding the Opposer, Technical College System of Georgia, is inadmissible since it is hearsay and not based upon the witness' personal knowledge. In addition, all of the exhibits attached to Ms. Green's testimony are GDED documents and are therefore inadmissible hearsay since the GDED is not a party to this opposition and Ms. Green has failed to authenticate the documents or lay a foundation for the introduction of the documents as business records, as an exception to hearsay.

While the GDED and/or its Global Commerce Team may have spent extensive resources internationally promoting Georgia and/or the GDED, there is no admissible evidence showing any promotion or calculation of expenses spent by Opposer in promoting QUICK START. In fact, the only relevant evidence in the record on this point is Ms Rohosky's deposition testimony that in the twenty (20) years that she had worked there, Opposer had not paid for one single

advertisement. (Rohosky Dep. at 42-43, Applicant's Notice of Reliance, Dkt. No. 11.) Opposer does not commercially advertise QUICK START and, in fact, did not even have an advertising budget. Moreover, Ms. Rohosky was quick to clarify that Applicant "heavily" advertises its QUICK START mark in trade journals whereas Opposer does not. Ms. Rohosky testified that Opposer's promotion of its QUICK START mark is limited to its website and its newsletter. (Rohosky Dep. at 42-43, 63, Applicant's Notice of Reliance, Dkt. No. 11.)

Based upon the admissible evidence in the record, including the failure to properly plead its registration, Opposer has failed to satisfy its burden of proving that its QUICK START mark is famous and this *duPont* factor therefore favors Applicant.

8. There Is No Evidence Of Actual Confusion.

The parties agree that there is no evidence of actual confusion and therefore this factor favors Applicant. (Green Test. Dep. at 43) Applicant and Opposer have been using their LOUISIANA FASTSTART and QUICK START marks since 2009 with no evidence of any actual confusion. Since that time, it is clear that Applicant has extensively used its mark since LOUISIANA FASTSTART was ranked number 1 in Workforce Training Leaders by Business Facilities magazine in 2010. (Lynn Test. Dep. at 64-65, Ex.14, 16 and 19)

9. There Is No Risk Of Potential Confusion.

As previously shown, given the fact that almost every State offers some form of workforce training, with many of these in the same southeastern region using similar suggestive terms, combined with the fact that these decisions are being carefully made by sophisticated decision-makers that are fully aware of the various State incentives commonly offered by State agencies in almost every State, there is a almost no risk, or de minimis risk at best, of potential confusion in the future. Accordingly, this factor favors Applicant.

10. Applicant Has Not Adopted Its Mark In Bad Faith.

Opposer argues without support that Applicant has adopted its LOUISIANA FASTSTART mark in bad faith. This claim seems disingenuous at best. At page 6 of its brief, Opposer colorfully alleges that its mark has been referred to as the “much-imitated Quick Start” and admits that many States send representatives to study its program. Exhibit 3 to Mr. Lynn’s testimony is an email he and other QUICK START employees received to congratulate Mr. Lynn on his new position in Louisiana, stating, in part:

[T]his is an amazing opportunity for Jeff to build a new program from the ground up. It is a chance for him to use the experience he has gathered during his career in the private sector as well as with Quick Start, and to take his professional development to the next level.

Based upon the records, it can hardly be said that Opposer contested or took issue with Applicant’s formation of a workforce training program in Louisiana. Moreover, Opposer can not seriously take issue with Opposer’s use of the term LOUISIANA. In addition, as previously shown, Opposer has previously acquiesced and expressly consented to the use of the term “QUICK” in marks used to describe workforce training programs provided by other States, namely: QUICK CONNECT in Virginia and QUICK RESPONSE in Florida. (Rohosky Dep. at 66-68, Applicant’s Notice of Reliance, Dkt. No. 11.) As a result, Opposer can not seriously take issue if Applicant had used the term QUICK, which it didn’t, or FAST, which Opposer doesn’t use and which is less similar to the term QUICK, which Opposer has already acquiesced to for similar services.

Applicant respectfully submits that it makes no sense to consent to QUICK CONNECT and QUICK RESPONSE, but somehow take issue with LOUISIANA FASTSTART. Establishing bad faith requires a showing that applicant intentionally sought to trade on opposer's good will or reputation. See *Big Blue Products Inc. v. International Business Machines Corp.*, 19

USPQ2d 1072 (TTAB 1991). While such intent may be inferred from surrounding circumstances such as the copying of a competitor's product packaging, opposer is under the heavy burden to prove by clear and convincing evidence that applicant is guilty of bad faith. *Precision Foods, Inc., v. Major Products Co., Inc.*, OPPOSITION NO. 109,5, 2001 WL 1131865 (TTAB 2001). See also, for example, *LaBounty Manufacturing Inc. v. United States International Trade Commission*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992) and *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

Opposer argues, again without support and admissible evidence, that Applicant had originally adopted the name FAST START. However, the record shows that any possible reference to the term FAST START was prior to actual formation and launch of the program so any such discussions of a potential name at that time were irrelevant and meaningless. Even if it were true that Applicant was planning to call itself FAST START, the fact that Applicant actually adopted and used the name LOUISIANA FASTSTART would lend more probative support against a finding of bad faith since it would show that Applicant had apparently changed the proposed name in response to Opposer's requests.

Opposer has failed to introduce any direct evidence to support its claim and has not established that applicant's adoption of its mark was knowingly done with the intention of trading on the goodwill of opposer's mark. *Ra Brands, L.L.C., v. Pure Fishing Inc.*, 2002 WL 1022539 (TTAB 2002). For these reasons, this thirteenth *DuPont* factor also favors Applicant.

VI. SUMMMARY

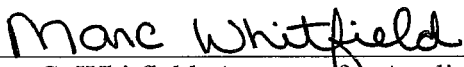
For the foregoing reasons, Applicant respectfully submits that it has established that there is no likelihood of confusion because:

1. Opposer has failed to prove likelihood of confusion;

2. QUICK START is a weak and highly suggestive mark entitled to minimal protection;
3. LOUISIANA FASTSTART and QUICK START are not similar in sound, appearance or commercial impression;
4. the extensive number and nature of identical and substantially similar marks in use on educational services identical to Opposer's mark and alleged classification of services;
5. the nature of the services, as shown in the registration and application are not similar;
6. the marks are used and the services are provided under complex conditions involve costly and prolonged decision-making by sophisticated decision-makers;
7. there is no proven similarity of trade channels or customers;
8. QUICK START is not a famous mark;
9. there is no evidence of actual confusion;
10. there is no risk of potential confusion; and
11. Applicant has not adopted its mark in bad faith.

Dated: September 2, 2011.

Respectfully submitted,



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Attorney for Applicant, Louisiana Economic Development

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

TECHNICAL COLLEGE SYSTEM OF
GEORGIA, A GEORGIA STATE AGENCY,

OPPOSER,

v.

LOUISIANA ECONOMIC DEVELOPMENT,
A LOUISIANA STATE AGENCY,

APPLICANT.

OPPOSITION NO.
91191683

CERTIFICATE OF SERVICE

I hereby certify that a copy of Applicant's Trial Brief has been served upon Opposer, by causing a true and correct copy thereof to be delivered in the manner indicated below and properly addressed to the following counsel of record:

By Hand
By Facsimile
By US Postal Service (First Class) X
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ATTORNEYS FOR OPPOSER

This 2nd day of September, 2011

By: Marc Whitfield
Marc S. Whitfield

**APPENDIX OF
CASES NOT
APPEARING IN
U.S.P.Q.**

Trademarks

Similarity Between Marks; Likelihood of Confusion

Defendant Health Insurer Service Mark
Absent Likelihood of Confusion

Precision Foods, Inc. 2001 WL 1131865 (Trademark Tr. & App. Bd.)
Trademark Trial and Appeal Board September 20, 2001

Return to list THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

PRECISION FOODS, INC.

v.

MAJOR PRODUCTS CO., INC.

Opposition No. 109,500

application Serial No. 75/252,641 filed on March 6, 1997

September 20, 2001

*1 Thomas P. Arden of McBride Baker & Coles for **Precision Foods, Inc.**

James C. Simmons of The Law Office of James C. Simmons for **Major Products Co., Inc.**

Before Walters, Bottorff and Holtzman

Administrative Trademark Judges.

Opinion by Holtzman

Administrative Trademark Judge:

An application has been filed by Major Products Co., Inc. to register the mark MAKE IT THICK for a "food thickeners."¹

Registration has been opposed by Precision Foods, Inc. As its ground for opposition, opposer asserts that applicant's mark when applied to applicant's goods so resembles opposer's previously used and registered mark THICK-IT for "food thickener" as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant, in its answer, has denied the salient allegations in the opposition.

The record includes the pleadings; the file of the involved application; and opposer's notice of reliance on evidence including a status and title copy of its pleaded registration, opposer's unanswered admission requests including an admission that the goods are competitive, and applicant's responses to interrogatories and document requests. Opposer also submitted the testimony (with exhibits) of opposer's vice-president Ronald M. Kirshbaum.² Applicant did not take any testimony or introduce any other evidence.

Both parties filed briefs and an oral hearing was held on June 7, 2001.

Opposer, Precision Foods, Inc., manufactures a "health care" food thickener under the mark THICK-IT which is designed for people who have a swallowing impairment called dysphagia. (Kirshbaum dep. p. 10). Opposer estimates that there are somewhere between ten and fifteen million people in the United States with this condition. The THICK-IT product was first introduced in the market in 1985 and at that time, it was the first of its type in any market, that is, an instant food thickener in powdered form where the consistency of the food could be easily controlled. Mr. Kirshbaum states that the product "revolutionized" the health care industry with regard to dysphagia and received "great acceptance" in the market. (Dep. pp. 23-24).

Mr. Kirshbaum explains that there are two primary markets for its food thickener, the food service market and the retail market. The food service market includes food service distributors and food service operator accounts. The operator accounts include hospitals, nursing homes, and convalescent centers. In this market, the product can be

sold to distributors for subsequent sale to the health care facilities or directly to the facilities themselves. On the retail side, the product is sold either to national drug wholesalers who in turn sell to their branch drug stores, or directly to drug stores by telephone, or by telephone directly to consumers. While some drugstores may sell the product off the shelf, that manner of sale, according to Mr. Kirshbaum, "is not the predominant situation." (Dep. p. 35). Mr. Kirshbaum states that it is more likely that the product would be recommended to the consumer by a pharmacist or health care professional and that the pharmacist would then place a special order for the product from his wholesaler. The product is sold in a variety of container sizes. When it is sold off the retail shelf to consumers, it usually appears in an eight-ounce container costing \$6.

*2 During its first couple of months on the market, the product was promoted with "a lot of word-of-mouth advertising through [health care professionals] personal letters and trade letters and trade journals...." (Kirshbaum dep. p. 24). Opposer has subsequently advertised the THICK-IT product to both the food service and retail markets by print advertisements in consumer and trade magazines, and promotional literature. Opposer has also been promoting the THICK-IT product at trade shows two to five times a year since 1985 and, for an unspecified period of time, has promoted the product on the Internet. Opposer has submitted reports of two university or hospital studies determining the effectiveness of certain food thickeners including THICK-IT food thickener.

Following two years of exclusivity, competitive products were introduced in the food service market. Mr. Kirshbaum estimates that there are now twelve such competitors in that market and he has identified Sysco, Diamond Crystal, and Thicken Up, as the main competitive products. According to Mr. Kirshbaum, opposer's product has no competitors in the retail market.

Mr. Kirshbaum testified that sales of THICK-IT food thickener experienced "triple-digit increases" the first couple of years on the market followed by "strong double-digit increases" in subsequent years. (Dep. p. 24). Opposer has submitted, subject to a protective order, sales figures for the years 1995 to 1999, advertising figures for 1999, and proposed expenditures for the year 2000. Mr. Kirshbaum estimates additional expenditures which are not reflected in those figures and media expenses for the "five to ten" years preceding 1999. (Kirshbaum dep. p. 58).

The discovery responses made of record by opposer indicate that applicant manufactures food products, including food thickener for dysphagia conditions. Applicant decided in late 1996 or early 1997 to "check on the feasibility of using the mark" and became aware of opposer's registration in February, 1997. (Rev. ans. int. 3). Applicant then filed its intent-to-use application for the mark MAKE IT THICK on March 6, 1997 and began using the mark on food thickener on or about May 22, 1998. Applicant has not yet advertised or promoted its food thickener but applicant intends to sell the product through food distributors to hospitals and nursing homes. Applicant, in fact, has already made one sale of its product consisting of 12 eight ounce cans totaling \$6,490 to a potential customer of opposer.

As indicated above, opposer has made of record a status and title copy of its pleaded registration. Thus, there is no issue with respect to opposer's priority. *King Candy co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

We turn then to a consideration of likelihood of confusion. Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue, including the similarity of the marks and the similarity of the goods. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The factors deemed pertinent in this proceeding are discussed below.

*3 The parties' goods are both identified as food thickeners. In view of the directly competitive nature of the goods, the channels of trade and classes of purchasers for the respective goods are deemed to be the same. See *In re Smith & Mehaffey*, 31 USPQ2d 1531 (TTAB 1994). Indeed applicant has admitted that the products are competitive (adm. req. ans. 5) and the evidence shows that the products are in fact identical, that

they are used for the same purpose, and that they are sold in the same food service market.

We turn then to the marks. Opposer argues that the marks are similar in sound, appearance and connotation in that applicant's mark MAKE IT THICK comprises the same words in opposer's mark THICK-IT arranged differently. Applicant, however, maintains that the different arrangement of the shared words plus the additional word MAKE in its mark results in significant differences in the sound and appearance of the marks. Applicant further argues that the marks' shared elements are "such common words" (brief, p. 12) and that opposer's mark is suggestive and entitled to only a narrow scope of protection.

The mere fact that applicant's mark incorporates the component words of opposer's mark does not necessarily mean that the two marks are similar. In determining the similarity or dissimilarity of the marks, we must consider the marks in their entireties, as to appearance, sound, connotation and commercial impression. *Cunningham v. Laser Golf Corp.*, 55 USPQ2d 1842 (Fed. Cir. 2000). We find that the marks THICK-IT and MAKE IT THICK when considered in their entireties, are not similar in sound, appearance or commercial impression. The marks are visually different. Opposer's mark consists of two words either joined or separated by a hyphen with the word THICK preceding the word IT. Applicant's mark includes the additional word MAKE and the order of THICK and IT are reversed in its three-word mark. The differences in the two marks are even more pronounced when the words are spoken. The marks do not have the same cadence or number of words. Moreover, the term THICK-IT is virtually identical in sound to the familiar dictionary word "thicket" whereas MAKE IT THICK would be articulated as three separate words sounding nothing like "thicket."

The transposition of THICK and IT also changes the commercial impressions conveyed by the marks. The word THICK in opposer's mark THICK-IT is used in the uncharacteristic manner of a verb, resulting in a somewhat unusual overall expression. The mark MAKE IT THICK, on the other hand, is an ordinary sentence where the words, including THICK, are used in their traditional, ordinary sense. In addition, because THICK-IT is an unfamiliar expression, it may call to mind the more familiar term "thicket," thereby further distinguishing the commercial impressions created by the two marks.

The marks have a similar overall meaning, but that meaning is highly suggestive of food thickener. The term "IT," common to both marks, is a suggestive reference to the food product to be thickened. The other shared word "THICK" is highly descriptive of one of the most important characteristics of food thickener and there is no doubt that the word is intended to convey this descriptive meaning in both marks.

*4 It is settled that highly suggestive marks are weak and are generally accorded a more limited scope of protection than an arbitrary mark. See *The Drackett Company v. H. Kohnstamm & Co., Inc.*, 160 USPQ 407 (CCPA 1969) ["The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods."]; and *Sure-Fit Products Company v. Saltson Drapery Company*, 117 USPQ 295 (CCPA 1958).

While, as opposer points out, there is no evidence of other third parties using the words THICK or IT on food thickeners, a primary competitor of opposer is using a variation of THICK in its mark, THICKEN UP, further indicating the relative weakness of opposer's own mark in relation to its goods.

In view of the weakness of THICK-IT and MAKE IT THICK, we find that the distinct differences in the marks, particularly in sound and appearance, are sufficient to distinguish one mark from another.

Opposer contends, however, that its mark is strong "due to opposer's dominance in the health care food thickening market and general market acceptance" of the product. (Brief, p. 11). The evidence shows that THICK-IT has been used on food thickener for approximately fifteen years and at least steady increases in sales volume since the introduction of the product on the market, nearly doubling in volume over the period 1995 to 1999. However, there is no information as to, for example, opposer's relative

share of the food service market or opposer's proportionate number of operator accounts, and the sales figures themselves, including number of units sold, do not seem particularly impressive on their face considering the vast number of people who, according to opposer, have this disorder. Nevertheless, Mr. Kirshbaum has testified essentially that THICK-IT food thickener is a leading brand in the food service market (dep. p. 25) and applicant admits that the product is successful in the marketplace.³ (Brief, p. 10). Opposer also points to the unsolicited use of THICK-IT food thickener in two professional studies and it appears that, according to Mr. Kirshbaum, such studies tend to focus on leading brands.⁴

The evidence demonstrates that opposer's mark has attained some, but not necessarily a tremendous degree of recognition in the field. Under the circumstances, and considering the highly suggestive nature of opposer's mark in connection with its goods, we remain convinced that opposer's mark is entitled to a more limited scope of protection. This scope of protection should not, in any event, extend to applicant's mark which, in all important respects, is dissimilar to opposer's mark.

Opposer also argues that "food products sold at retail" and "less expensive items" are not purchased with great care. (Brief, p. 16). The primary customers for the parties' goods, including operators of nursing homes and other health care facilities, are sophisticated professionals who would exercise a high degree of care in purchasing these products. Nevertheless, there is no restriction in the respective identifications as to purchasers, and it seems that at least some of opposer's customers are ordinary members of the public. While food thickener is a relatively low cost product, it is not an impulse product such as shampoo or a package of chewing gum. Given the seriousness of the disorder for which the food thickener is used and the fact that it would probably be recommended by a doctor or pharmacist rather than purchased off the shelf, the purchase of this product by the consumer would involve a more informed and thoughtful decision.

*5 Finally, opposer maintains that applicant adopted its MAKE IT THICK mark in bad faith. In particular, opposer claims that applicant adopted a mark comprising opposer's mark with knowledge of opposer's incontestable registration, thereby raising an inference that applicant intended to trade on opposer's good will. Opposer claims that the inference is made stronger because opposer's mark "is the leading brand in the market." Opposer points to the mixing instructions on applicant's product label which use the same consistency designations, i.e., "nectar," honey," and "pudding," as opposer uses on its own labels.⁵ Mr. Kirshbaum claims that opposer "invented" these designations and has long used these terms to designate the three levels of consistency for its products. (Dep. p. 72).

Applicant, aside from misconstruing the issue as one of trade dress violation, admits that it knew of opposer's registration at the time of filing its application, denies that the mark was adopted in bad faith, and maintains further that regardless of its intent, there is no likelihood of confusion in this case. Applicant contends that it is entitled to use those consistency designations arguing that the words are standard in the industry and are "functional characteristics which Applicant should now be free to use." (App. brief, p. 7).

The Board in *Roger & Gallet S.A. v. Venice Trading Co. Inc.*, 1 USPQ2d 1829 (TTAB 1987), stated that intent may, and ought to, be taken into account when resolving the issue of likelihood of confusion when that issue is not free from doubt. If confusion is not likely to result from the use of the marks, the motive of applicant cannot affect its right to the registrations sought. *Steak N Shake, Inc. v. Steak and Ale, Inc.*, 171 USPQ 175 (TTAB 1971).

In this case, we have no doubt concerning the likelihood of confusion. Even if we did have doubt, the evidence submitted by opposer would not assist us in resolving this issue. Establishing bad faith requires a showing that applicant intentionally sought to trade on opposer's good will or reputation. See *Big Blue Products Inc. v. International Business Machines Corp.*, 19 USPQ2d 1072 (TTAB 1991). While such intent may be inferred from surrounding circumstances such as the copying of a competitor's product packaging, opposer is under the heavy burden to prove by clear and convincing

evidence that applicant is guilty of bad faith. See, for example, *LaBounty Manufacturing Inc. v. United States International Trade Commission*, 958 F.2d 1066, 22 USPQ2d 1025 (Fed. Cir. 1992) and *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

The evidence relied on by opposer in this case is far from sufficient to meet that burden.⁶ In fact, a visual comparison of both labels makes it hard to believe that this is the part of opposer's label that applicant would choose to copy if applicant intended to create confusion or deception. Moreover, applicant has offered a very plausible "good faith" explanation for its use of those designations. We note that this identical wording is used generically in the hospital study report. The study, appearing on (unnumbered) page 2 of opposer's exhibit no. 33, is entitled *Using A Multidisciplinary Monitor To Assess Accuracy of Thickened Liquids For Hospital Patients With Dysphagia*. The report describes the protocol for the study as follows (emphasis added):

*6 Our initial protocol for thickening liquids included the following: 1)
Adhering to recommendations by the speech-language pathologists
regarding thickness level (**nectar, honey, pudding**)...

For the foregoing reasons, we conclude that notwithstanding the identity of the products in this case, the sophistication and/or care taken by purchasers of opposer's product together with the dissimilarities in the marks as well as the relative weakness of opposer's mark and the narrow scope of protection to which it is entitled makes confusion unlikely.

Decision: The opposition is dismissed.

Footnotes

- 1 Application Serial No. 75/252,641, filed March 6, 1997, alleging a bona fide intention to use the mark in commerce.
- 2 Applicant did not attend this deposition.
- 3 Because opposer has no competitors in the retail industry, it is understandable that the THICK-IT product would be, as described by opposer, *the* leading brand in the retail field. However, there is no indication as to, for example, what portion of opposer's sales relate to that market.
- 4 One other article relied on by opposer mentions opposer's company and the fact that it offers "various products for people with dysphagia, including... thickeners...." However, there is no mention of opposer's mark in this article.
- 5 Opposer, based on Mr. Kirshbaum's testimony, refers generally in its brief to applicant's adoption of "verbiage and instructions long used by opposer" in its packaging. (Brief, p. 14). However, opposer specifically addresses only applicant's alleged appropriation of the above consistency designations. In any event, opposer has failed to establish, and we do not find, that the other alleged similarities in packaging mentioned by Mr. Kirshbaum such as package size and generic language including "instant food thickener," "desired consistency," and "do not overmix" (which does not even appear on opposer's label as far as we can determine) are persuasive of wrongful intent. In fact, the labels are otherwise strikingly different.
- 6 The question of intent is heavily dependant on the particular facts and the facts in this case are distinguishable from those in cases such *Broadway Catering Corp. v. Carla Inc.*, 215 USPQ 462 (TTAB 1982) and *Roger & Gallet S.A. v. Venice Trading Co., Inc.*, 1 USPQ2d 1829 (TTAB 1987) on which opposer has relied. In *Broadway Catering*, for example, the finding of wrongful intent was not based on an allegation of similar trade dress copying but rather applicant's failure to provide any credible explanation for

its adoption of a mark which was identical to opposer's mark of "notoriety and renown."

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RELATED TOPICS

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Trademark Infringement Court Likelihood of Confusion Analysis

RA BRANDS, L.L.C. 2002 WL 1022539 (Trademark Tr. & App. Bd.)
Trademark Trial and Appeal Board May 15, 2002

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Trademark Trial and Appeal Board

Patent and Trademark Office (P.T.O.)

RA BRANDS, L.L.C.

v.

PURE FISHING, INC.¹

May 15, 2002

*1 Opposition No. 120,088 to application Serial No. 75/671,704 filed on March 31, 1999

Randel S. Springer of Womble Carlyle Sandridge & Rice, PLLC for **RA Brands, L.L.C.**

Lance G. Johnson of Roylance, Abrams, Berdo & Goodman, L.L.P. for **Pure Fishing, Inc.**

Before Seeherman, Walters and Wendel

Administrative Trademark Judges

Opinion by Wendel

Administrative Trademark Judge

Berkley, Inc. (by change of name to Pure Fishing, Inc.) has filed an application to register the mark BERKLEY CATCH MORE FISH and design, as depicted below,



for the following goods:

Class Battery-operated hook sharpening machines and fishing line strippers;

7:

Class Fishing hand tools, namely, pliers, fishing knives, scissors, hook files, crimpers, line cutters, and

8: manually-operated line spooling machines;

Class Fishing tools, namely, weigh scales;

9:

Class Printed matter in the form of labels and decals;

16:

Class Shirts, caps, hats, jackets, coats and windshirts;

25:

Class Embroidered emblems;

26:

Class Fishing rods; fishing reels; fishing line; artificial fishing lures; artificial fishing baits; fish attractants;

28: fishing tackle, namely, fishing hooks, leaders used for fishing, fishing leader kits, downriggers, swivels, snap swivels, snaps, knotless fasteners, connector sleeves; fishing rod racks; fishing rod holders; tackle boxes; fishing rod cases; sportsperson's fishing bags; and ice fishing strike indicators;

Class Financial sponsorship of fishing, golf and tennis tournaments.²

36:

*2 RA Brands, L.L.C. has filed an opposition to registration of the mark on the ground of priority of use and likelihood of confusion under Section 2(d) of the Trademark Act.³ In the notice of opposition, opposer alleges use since at least as early as January 1994 by opposer and its predecessor-in-interest, Remington Arms Company, of a design mark

for a stylized fish together with a stylized fishing line in connection with opposer's products which include fishing tackle, fishing line, fishing hooks, fishing leaders and flying discs, along with clothing and cloth patches for clothing; ownership of a registration for the mark,⁴ in which the design is shown as follows;



and likelihood of confusion with applicant's use of its mark, which opposer alleges is to be used with identical or closely related goods and which allegedly contains a stylized depiction of a fish that is strikingly similar to that of opposer's mark.

Applicant, in its answer, has denied the salient allegations of the notice of opposition.⁵

The Record

The record consist of the pleadings; the file of the involved application; opposer's testimony deposition, with accompanying exhibits, of Alfred D. Russo, Jr.; applicant's responses to certain of opposer's interrogatories, together with the exhibits provided as part of those responses, made of record by opposer's notice of reliance; and the stipulated testimonial declaration of applicant's witness Mark V. Sparacino, with accompanying exhibits.

Both parties filed briefs, but an oral hearing was not requested.

Facts

The evidence establishes that in the early to mid 1990s, opposer's predecessor, Remington Arms Company, hired an agency to redesign the packaging for the seven brands of fishing line which were Remington's only products at the time. One of the designs which the agency suggested as a single logo to distinguish all of Remington's fishing products was the stylized fish design which is the subject of this opposition. Mr. Russo testified that at the time the fish design was selected the agency reported, after making a competitive audit of stores and other brands of fishing line, that there was no one in the field using a stylized fish. (Deposition p. 49).

Remington began using the stylized fish design by at least October 1994. Since introduction of the design mark, Remington has not sold any of its STREN line of fishing products without the design mark. Remington does not use the fish design alone, but rather in conjunction with its STREN word mark. (Deposition p. 58). Remington obtained a registration for its design mark on March 18, 1997 and the registration was later assigned to opposer, an intellectual property holding company, which licensed the mark back to Remington.

Opposer sells its products, and particularly fishing line, in mass merchant outlets such as Wal-Mart and Kmart, in regional chains such as Dick's Sporting Goods, in small retail outlets such as tackle shops, in gas stations and through catalog merchants. The products for the most part are displayed on wall pegs in the stores. Opposer and applicant are direct competitors in the fishing line products market. Opposer and applicant share approximately 80% of the market for these products, with applicant being the market leader at 43-45% and opposer having 35-37% of the market. Applicant markets its products in the same manner as opposer and thus applicant's products are often displayed on pegs in the same stores side-by-side with opposer's products. Opposer's most popular-selling fishing line ranges in cost from \$5 to \$8 and the comparative products of applicant fall within the same price range.

*3 Opposer's main advertising of its products featuring its fish design mark is by means of magazines and television. The magazines are targeted towards fishermen or outdoorsmen, either on a national or regional level. The advertisements feature both the STREN word mark and the stylized fish design. Opposer's advertising budget runs several million dollars per year. Opposer also promotes its STREN line of fishing products at trade shows, consumer shows, tournament fishing shows, fishing clinics and the like.

Applicant filed its application on the basis of an intent to use the mark and, although it states in its brief that its mark has been in use since March 1999, applicant has introduced no evidence of actual use of the mark. Opposer, however, has introduced testimony that opposer became aware of applicant's use of its mark approximately 18 to 24 months prior to the taking of the deposition in July 2001.

Discussion

Priority is not an issue here in view of opposer's ownership of its pleaded registration.⁶ See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer's witness Mr. Russo has testified to the use of the stylized fish mark at least by October 1994, a date well prior to applicant's filing of its intent-to-use application on March 31, 1999.

Turning to the issue of likelihood of confusion, we take into consideration all of the *du Pont* factors which are relevant under the present circumstances and for which there is evidence of record. See *E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Insofar as the respective goods are concerned, we find a definite overlap in both the fishing products and the clothing items of the parties. The remaining goods and services of applicant are closely related to opposer's goods. Applicant has in fact acknowledged that its goods and services compete directly with those of opposer. Thus, for purposes of our analysis the goods and services are considered identical in part and otherwise closely related.

Furthermore, there are no restrictions in the goods and/or services as identified in the application and registration as to the channels of trade or the class of purchasers. Because there are no such limitations, it must be presumed that the goods and/or services of both would travel in all the normal channels of trade and be available to all the usual purchasers of goods and/or services of this type. See *Canadian Imperial Bank v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Mr. Russo has testified that applicant and opposer are the two top competitors in the field and that the goods of both are offered for sale in the same retail outlets and are often displayed side-by-side.

While applicant contends that this side-by-side display affords the prospective purchaser the opportunity for comparison and distinction of both the products and the marks associated therewith, we are not convinced that the purchasers of these types of fishing products, and particularly of fishing line, would take the time or effort to so carefully examine the marks being used by the competitors. Although Mr. Russo has testified as to the availability of different types of fishing line and different equipment according to regional fishing needs, these fishing products remain relatively inexpensive items which are purchased without any great degree of forethought or consideration, other than perhaps purchasing the right type of fishing line for a particular fisherman's need. While purchasers may have become more sophisticated as to the variety of products available in the field, we do not consider this sophistication sufficient to prevent likelihood of confusion as to the source of the goods if confusingly similar marks are used on the competing products.

^{*4} Thus, we come to the factor which is highly determinative in our analysis, namely, the similarity or dissimilarity of the respective marks. Opposer's basic argument is that its stylized fish design and the fish design of applicant's mark convey the same overall visual impressions and any small differences in the designs would not be remembered by purchasers. While acknowledging the additional presence of the words BERKLEY CATCH MORE FISH in applicant's mark, opposer argues that purchasers will still think that applicant's goods are sponsored by or are in some way related to opposer in view of the similarity of the two fish designs. Opposer cites the statement made by the predecessor of our present reviewing court (the CCPA) in its decision in *Finn v. Cooper's Inc.*, 292 F.2d 555, 130 USPQ 269 (CCPA 1961) that:

This court has expressly rejected the argument that one may imitate the picture part of a trademark of another, and avoid the likelihood of confusion, mistake, or deception of purchasers by using different word trademarks in association with the symbol mark.

130 USPQ at 273.

Applicant, in response, argues that the marks must be considered in their entireties.⁷ Applicant contends that opposer's comparison of the mutilated marks, looking only at the fish portion of applicant's mark, is not the proper basis for analysis.⁸ In making a detailed comparison of the marks, applicant points not only to differences such as the presence of fishing line in opposer's mark and not in applicant's and the facing of the fish in opposite directions, but also to many smaller differences in the depiction of the fish themselves. In addition, applicant notes the prominent appearance of the house mark BERKLEY in its mark, as well as the words CATCH MORE FISH.

Applicant also argues the suggestiveness of the fish design when consideration is given to the fishing products with which the marks are being used. Applicant refers to the declaration of Mark Sparacino which includes as exhibits packaging of eleven third-party fishing products in which a fish, either stylized or more photographic in nature, is depicted. In addition, applicant relies upon the over 400 trademark registrations and applications made of record by opposer's notice of reliance which show marks which consist of, either in whole or part, fish designs for fishing products and services. Applicant argues that given the common use of fish designs for fishing products and services, purchasers will look to the words STREN and BERKLEY that are featured, respectively, on opposer's and applicant's products as the indication of source.

When we compare the marks in their entireties, we find the overall commercial impressions of applicant's and opposer's marks to be entirely different. Opposer's mark consists solely of a stylized fish, together with a stylized fishing line. Applicant's mark is a composite mark featuring not only the house mark BERKLEY, but also the slogan, CATCH MORE FISH. The fish design element of applicant's mark is of minimal significance in the overall impression. Moreover, the fish design itself is clearly not a replica or imitation of opposer's particular design.

*5 Of even more importance is the fact that a fish design in general is highly suggestive when used in connection with fishing products, as demonstrated by the evidence of record. The exhibits attached to the declaration of Mark Sparacino specifically show use by third parties of similar fish designs in connection with fishing products. The third-party registrations, while not evidence of use of the marks or public familiarity therewith, are evidence that fish designs have appealed to others as a trademark element in the field of fishing products and services and that the designs are not particularly distinctive but rather have a suggestive significance in the field. See *Bost Bakery, Inc. v. Roland Industries, Inc.*, 216 USPQ 799, 801, n.6 (TTAB 1982). Contrary to opposer's contention that this third-party evidence is irrelevant because, opposer claims, most of these designs are not remotely similar to opposer's mark, we find this evidence highly persuasive of what little significance purchasers would attach to the fish design element of applicant's composite mark.

Moreover, the circumstances in the *Finn* case relied upon by opposer are distinctly different from those here. In that case the petitioner's design mark consisted of a representation of a jockey and respondent's mark consisted of the words JERRY FINN and a representation of a hitching post in the form of a jockey. Both marks were being used in connection with clothing. The Board, in *Cooper's Inc. v. Finn*, 124 USPQ 10 (TTAB 1959), found the jockey figure in respondent's mark to be entirely arbitrary as applied to wearing apparel and to be of such prominence as to create a commercial impression separate and apart from the name JERRY FINN. Thus, the Board determined the figure alone might well be relied upon by purchasers in identifying the source of the goods, and in view of the similarity to petitioner's figure mark, might lead purchasers to assume that respondent's goods originated with, or were in some way associated with, petitioner.

The CCPA upheld the decision of the Board. *Finn v. Cooper's Inc.*, *supra*. The Court emphasized the commercial significance which petitioner's mark had acquired well

before respondent's adoption of a similar symbol "as the dominant part of the registered mark." 130 USPQ at 273. It was under these conditions that the Court applied the principle cited by opposer that one could not "imitate" the symbol or "picture part" of another one's trademark and avoid likelihood of confusion by using a different word mark in conjunction with the symbol.

In this case, however, applicant's fish design is clearly not arbitrary when used in connection with fishing products and related services. Furthermore, applicant's fish design is but a small insignificant portion of its mark as a whole and does not create a commercial impression separate and apart from the composite mark. Thus, there is no reason for purchasers to attribute a common source to the fishing products of applicant and opposer based solely on any similarity of the fish designs.

*6 Despite opposer's arguments that its fish design is well-know and that millions of dollars have been spent advertising and promoting this mark, we cannot place opposer's stylized fish design per se in the category of a well-known mark. As acknowledged by Mr. Russo, the design mark is always used in conjunction with the STREN word mark. Although there may have been large advertising expenditures and extensive use of the composite mark of which the fish design is a part, there is no evidence of record of separate use or promotion of the fish design. There is no evidence to support any contentions that the fish design alone is well-known or would be recognized by purchasers as what opposer describes as "a unifying icon" for its products. In addition, as pointed out previously, applicant's fish design is not an imitation or close replica of opposer's fish design. All in all, no parallel can be drawn to the circumstances in the *Finn* case.

As a final factor for consideration, opposer raises the question of applicant's intent in adopting its mark, arguing that applicant intended to trade on the goodwill of opposer by selecting its similar fish design. While we would agree that applicant most certainly was aware of opposer's mark, which had been used since 1994 in the same markets and for the same type of fishing products, we can draw no further inferences as to applicant's intent in adopting its mark. Moreover, since we have found that applicant's fish design is neither an imitation of opposer's mark nor a significant element of applicant's mark, we have no basis upon which to conclude that there was bad faith on the part of applicant. Opposer, having failed to introduce any direct evidence to support its claim, has not established that applicant's adoption of its mark was knowingly done with the intention of trading on the goodwill of opposer's mark.

Accordingly, upon taking all the relevant *du Pont* factors into consideration, we find the balance to fall on the side of no likelihood of confusion. Regardless of the fact that the goods and/or services of the parties are either identical or closely related and the markets are the same, the marked differences in the commercial impressions created by the marks as a whole, taken in conjunction with the highly suggestive nature of a fish design when used with fishing products or related services, clearly tips the scale in applicant's favor.

Decision: The opposition is dismissed.

Footnotes

- 1 The caption of this proceeding was amended by the Board to reflect the change of name of the original applicant (Berkley, Inc.) which was recorded with the Assignment Branch of the Office at reel 2181, frame 814.
- 2 Serial No. 75/671,704, filed March 31, 1999, based on an allegation of a bona fide intention to use the mark in commerce.
- 3 Although opposer also makes a general allegation of dilution in the notice of opposition, opposer has failed to pursue this ground. Accordingly, we have given it no consideration.
- 4 Registration No. 2,046,114, issued March 18, 1997, for the mark shown above for the following goods:

Class Clothing and apparel, namely, shirts, hats and jackets;

25:

Class Cloth patches for clothing; and

26:

Class Sporting goods, namely, fishing tackle, fishing line, fishing hooks, fishing leaders

28: and flying discs.

The registration contains a description of the mark as "the design of a stylized fish and stylized fishing line artistically arranged to suggest the fish is chasing the line or is hooked by it."

- 5 We note that applicant has attached to its answer exhibits which are alleged to show widespread use of stylized fish images by others as, or in connection with, marks for goods used for fishing. No consideration has been given to these exhibits, inasmuch as exhibits to pleadings are not evidence on behalf of the party to whose pleading the exhibits are attached. See Trademark Rule 2.122 (c). Only those materials introduced by applicant during its testimony period have been taken into consideration.
- 6 In order to make a pleaded registration of record, an opposer must either make a status and title copy of the registration of record or introduce testimony as to the status and title of the registration. We note that during the testimony of Mr. Russo with respect to the pleaded registration, he specifically stated that the registration had been transferred from the original registrant, Remington Arms Company, to opposer RA Brands. Thus, current title was established. Mr. Russo gave no direct testimony as to the current status of the registration. In its brief, however, applicant has acknowledged the registration as being of record. Furthermore, the copy introduced as Exhibit 1 by Mr. Russo was taken from the U.S. Trademark Electronic Search System (TESS) and has the information on its face that the registration was "live" as of the last update of the system, which was July 10, 2001, the date of the deposition. Under these circumstances, we find that opposer has satisfied the requirement with respect to establishing both current title and status of the registration.
- 7 Applicant, in its arguments, has addressed not only the pleaded fish design of opposer, but also the composite of the fish design and the word STREN, this being the manner in which opposer uses the fish design. Opposer, however, has only pleaded use and registration of the fish design and thus for purposes of this opposition we consider only the fish design. It is well accepted that a party may use more than one mark at the same time and thus we find no reason to consider the fish design other than as a separate mark.
- 8 While applicant makes a point of demonstrating that small differences exist between the fish design as actually used by opposer and the registered mark, we find these differences insignificant in our comparison of applicant's and opposer's marks.

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