

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Out-of-Court Solutions

v.

Out of Court, Inc.

Opposition No. 100,530
to application Serial No. 74/644,265
filed on March 10, 1995

David R. Cross of Quarles & Brady for Out of Court
Solutions.

Edward F. McHale of McHale & Slavin for Out of Court, Inc.

Before Cissel, Seeherman and Hairston, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Out of Court, Inc. to
register the mark set forth below for "mediation and

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arbitration services."¹

Registration has been opposed by Out-of-Court Solutions, a California corporation, under Section 2(d) of the Trademark Act. Opposer alleges that since August 29, 1994 it has used OUT-OF-COURT SOLUTIONS as the trade name for its mediation and arbitration services; that since December 20, 1994 it has used OUT-OF-COURT SOLUTIONS alone and in the form depicted below,

¹ Application Serial No. 74/644,265 filed March 10, 1995, alleging a bona fide intention to use the mark in commerce. Applicant has disclaimed the right to use the international prohibition symbol apart from the mark as shown.

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as a service mark to identify its services; and that applicant's mark, if used in connection with the identified services, so resembles opposer's previously used trade name and service mark as to be likely to cause confusion.

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

The record consists of the pleadings; the file of the opposed application; opposer's notice of reliance on its Arizona Certificate of Trade Name and an Amendment to its Articles of Incorporation; the affidavit (with exhibits) of opposer's president, R. Oliver Ross, which was submitted pursuant to the parties' stipulation; and the testimony deposition of Mr. Ross. Applicant took no testimony and offered no other evidence herein. Both parties filed briefs on the case, but an oral hearing was not requested.

According to Mr. Ross, opposer is in the business of resolving disputes and litigation. Approximately three-fourths of opposer's business is divorce mediation. However, opposer also conducts business and real estate mediation. Mr. Ross testified that opposer has used OUT-OF-COURT-SOLUTIONS in connection with its business since about December 1994. Opposer advertises in the Yellow Pages and mails brochures concerning its services to therapists and attorneys in the Phoenix, Arizona area. Opposer receives referrals from therapists and attorneys and charges an

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hourly rate of between \$100.00 and \$180.00, depending upon the type of dispute.

In support of its claim of prior and continuous use of OUT-OF-COURT SOLUTIONS as a trade name and service mark, opposer introduced a number of exhibits, including copies of its Arizona Certificate of Trade Name and Amended Articles of Incorporation under notice of reliance. In addition, Mr. Ross avers in his affidavit that opposer has used OUT-OF-COURT SOLUTIONS as the service mark and name for its company since the fall of 1994. Accompanying Mr. Ross' affidavit is a copy of a brochure which describes opposer's services. This brochure bears OUT-OF-COURT SOLUTIONS and design on the front page as well as OUT-OF-COURT SOLUTIONS per se and OUT-OF-COURT SOLUTIONS and opposer's address on the back page. Copies of these pages are reproduced below:

In his affidavit, Mr. Ross avers that this brochure has been used since the fall of 1994 to market opposer's services. Also, opposer offered copies of several letters. Two of the

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letters, dated November 25 and November 30, 1994 respectively, bear the designation OUT-OF-COURT SOLUTIONS per se in the letterhead. Three of the letters, each dated December 20, 1998, bear the designation OUT-OF-COURT SOLUTIONS and design in the letterhead and indicate that a copy of opposer's brochure is enclosed to the addressee. Three other letters bear no letterhead, but Mr. Ross testified that these copies were printed from the computer on plain paper, and that the actual letters did bear the designation OUT-OF-COURT SOLUTIONS and design. These letters are dated January, 3, 1995; February 13, 1995; and March 20, 1995, respectively. Also, each of these letters indicates that a copy of opposer's brochure is enclosed to the addressee.

The record contains no information about applicant.

Turning first to the issue of priority, applicant contends that the evidence is unclear as to when opposer actually began using OUT-OF-COURT SOLUTIONS as a service mark. In particular, applicant notes that opposer's Arizona Certificate of Trade Name recites a first use date of August 29, 1994; that the Amendment to opposer's Articles of Incorporation indicates that opposer adopted the name OUT-OF-COURT SOLUTIONS on October 29, 1994; that opposer, in its brief, recites a first use date of December 1994; and that

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Mr. Ross testified that the corporation has been a business entity since January 1995.

Applicant apparently misapprehends what is required of opposer to establish its priority herein. Opposer must simply show use of OUT-OF-COURT SOLUTIONS either as a trade name or service mark prior to March 1995, the filing date of applicant's intent-to-use application. The affidavit of opposer's president, Mr. Ross, sets forth facts which establish opposer's use of OUT-OF-COURT SOLUTIONS both as a trade name and service mark since the fall of 1994. In particular, Mr. Ross avers that opposer has used the brochure, which bears the trade name and service mark OUT-OF-COURT-SOLUTIONS, since the fall of 1994 to market its services. This evidence, which is undisputed, is sufficient to establish opposer's priority herein.

Further, applicant argues that opposer's use of OUT-OF-COURTS SOLUTIONS has been de minimis. Applicant argues that noticeably absent from opposer's evidence are examples of "standard" advertising, i.e., yellow page listings, print advertisements, and the like. Also, applicant questions whether certain of the letters submitted by opposer are "real" evidence of service mark use, since the letters could also be considered social letters to friends. In addition, applicant notes that three of the

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letters offered by opposer do not bear OUT-OF-COURT SOLUTIONS in the letterhead.

First, opposer is not required to furnish copies of yellow page advertisements, print advertisements or the like to establish rights in OUT-OF-COURT SOLUTIONS as a service mark. Mr. Ross' affidavit, along with the brochure, are sufficient for this purpose. Further, Mr. Ross testified that several letters announcing opposer's services were sent to former clients, which may well account for the friendly tone. In any event, these letters make specific reference to opposer's services and indicate that a copy of opposer's brochure is enclosed. Thus, these letters are evidence that opposer distributed copies of the brochure which bears the mark OUT-OF-COURT SOLUTIONS per se. Finally, Mr. Ross has adequately explained why copies of three of the letters do not bear company letterhead. However, even if these three letters were somehow seen as less persuasive evidence, opposer's remaining evidence is more than sufficient to establish opposer's rights in the service mark OUT-OF-COURT SOLUTIONS prior to the filing date of applicant's intent-to-use application.

We turn then to the issue of likelihood of confusion. At the outset, we note that applicant, in its brief on the case, has conceded that the parties' services are identical and that the services are offered in the same channels of

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trade. Thus, if the services were to be offered under the same or substantially similar marks, confusion as to source or sponsorship would be likely to occur.

This brings us to a consideration of the marks. In this case, we find that applicant's mark OUT OF COURT and design is substantially similar to opposer's service mark OUT-OF-COURT SOLUTIONS in sound, appearance, and commercial impression. Although the marks must be compared in their entireties, there is nothing improper in giving more weight to a particular portion of a mark if it would be remembered and relied upon to call for the services. In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Thus, where a mark consists of both words and a design, the words are normally accorded greater weight because they would be used by persons in referring to the services. In this case, it is the literal portion of applicant's mark, i.e., OUT OF COURT, which would be used by individuals in referring to the applicant's services. The design element is subordinate and less likely to be remembered. Also, the presence of the word SOLUTIONS in opposer's mark is insufficient to distinguish the parties' marks. In finding that the parties' marks are substantially similar, we have kept in mind the normal fallibility of human memory over time and the fact that the average person retains a general

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rather than a specific impression of trademarks encountered in the marketplace.

We note applicant's contention in its brief on the case that the phrase OUT OF COURT is "highly descriptive," and thus marks which include this phrase are weak and entitled to a limited scope of protection. Although applicant offered no support for its contention, we recognize that OUT OF COURT is suggestive of mediation and arbitration services. However, this fact does not help to distinguish the parties' marks. The words OUT OF COURT, as used in both marks, convey the same suggestive significance. Moreover, even weak marks are entitled to protection against the registration by a subsequent user of a substantially similar mark for identical services. Given the identity of the services, the design in applicant's mark is not enough to distinguish the parties' marks. People may well assume that applicant's mark OUT OF COURT and design is just a variation of opposer's mark OUT-OF-COURT SOLUTIONS.

Also, we recognize that individuals would exercise care in the selection of mediation and arbitration services. However, this factor is outweighed by the identity of the services and the substantial similarity between the marks.

In sum, individuals familiar with OUT-OF-COURT SOLUTIONS for mediation and arbitration services would be likely to believe, upon encountering OUT OF COURT and design

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for the identical services, that the services originated with or were somehow associated with or sponsored by the same entity. We should add that for the same reasons set forth above, applicant's mark is likely to cause confusion with opposer's trade name OUT-OF-COURT SOLUTIONS.

Decision: The opposition is sustained.

R. F. Cissel

E. J. Seeherman

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial and
Appeal Board