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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

ICL, Ltd.
v.
Podango, LLC

Opposition No. 91178334
to Application Serial No. 78873796
filed on 5/1/2006

George Chakmakis of Chakmakis & Associates for ICL, Ltd.

Bradley D. Smith of Franchisesmith, LLC for Podango, LLC.

Before Zervas, Walsh and Cataldo, Administrative Trademark
Judges.

Opinion by Walsh, Administrative Trademark Judge:

ICL, Ltd. (opposer) has opposed the application by Podango, LLC to register the mark PODANGO in standard characters on the Principal Register for services identified as "electronic exchange of data stored in databases accessible via telecommunication networks; providing telecommunications connections to a global computer network, all of the foregoing limited to video and audio podcasting and blogs and community feedback functions relating to podcasting" in International Class 38 and "computer

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services, namely creating indexes of information, sites and other resources available on computer networks; hosting of digital content on the Internet, all of the foregoing limited to websites featuring podcasting and articles, downloads, links, and discussion blogs related to such podcasting" in International Class 42.¹

Opposer asserts priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), as the grounds for the opposition.² Specifically, opposer asserts priority and likelihood of confusion between applicant's PODANGO mark for the services identified above and opposer's BADONGO mark. Opposer asserts its prior rights (1) based on Registration No. 3193826 on the Principal Register for BADONGO in standard characters for services identified as "providing electronic transmission and distribution of data, documents, and messages for others; providing Internet bandwidth connectivity services for the files and data of others" in International Class 38, "electronic storage of data, text, images, video, audio, and

¹ Notice of Opposition, filed July 11, 2007, against Application Serial No. 78873796, filed May 1, 2006, claiming first use of the mark anywhere on January 15, 2006 and first use of the mark in commerce on February 2, 2006 in both classes.

² The Notice of Opposition also refers to a false suggestion of a connection claim under Section 2(a) and a dilution claim under Section 44(c). However, opposer failed to plead these claims sufficiently and opposer offered no evidence or argument in support of either of these claims. Accordingly, we deem these claims waived.

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other data, which may be accessed over a global computer network via a user's personal computer" in International Class 39, and "providing high capacity file hosting for the websites of others on the Internet" in International Class 42,³ and (2) based on opposer's earlier common law use of BADONGO at least as early as July 26, 2005, with respect to the services identified above in all three classes.

In its answer, applicant has denied most allegations in the notice of opposition. However, we note the following paragraphs in applicant's answer which include partial admissions:

7) Defendant admits that the information in the "Mark Cited by Opposer as Basis for Opposition" is correct.⁴

8) Defendant admits that Plaintiff owns the federally registered trademark, BADONGO. Defendant denies that Plaintiff uses the BADONGO mark for the same services described in defendant's registration application.

Applicant's Answer at ¶¶ 7 and 8.

Opposer filed a brief. In fact, opposer filed its brief, which is two paragraphs in length, only after the Board issued an order under Trademark Rule 2.128(a)(3), 37 C.F.R. § 2.128(a)(3), requiring opposer to show cause why

³ The application resulting in this registration was filed on March 6, 2006, and the registration issued on January 2, 2007.

⁴ This language appears to refer to the particulars of opposer's Registration No. 3193826 referenced in the electronic cover sheet for the notice of opposition. The information does not include the status of the registration.

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the Board should not dismiss the opposition as conceded by opposer due to opposer's failure to file a brief within the time allowed. In an order mailed on January 6, 2009, the Board discharged the show-cause order and accepted opposer's brief. In an opposition proceeding, the opposer bears the burden of proving its claim by a preponderance of the evidence. See *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957-1958 (TTAB 2008). Applicant did not file a brief. For the reasons stated below, we dismiss the opposition.

By rule the record includes the pleadings and the USPTO file for the opposed application. Trademark Rule 2.122, 37 C.F.R. § 2.122. Neither opposer nor applicant submitted any evidence during the trial phase of this proceeding.

Before proceeding further we clarify that opposer's attempt to make a copy of its pleaded registration of record was not successful. Apparently opposer attempted to attach an electronic copy of its pleaded registration from USPTO electronic records to its notice of opposition, but opposer failed to do so in accordance with the governing procedures. We will address the circumstances attendant to that attempt here because opposer's ultimate failure to make a status and title copy of its pleaded registration of record ultimately dictates the dismissal of the proceeding. In sum, the rules which were operative at the time opposer filed this

proceeding did not permit an opposer to make a pleaded registration properly of record by filing an electronic copy with the notice of opposition. However, amendments to the rules which govern proceedings filed on or after August 31, 2007, do permit an opposer to do so. Even if the current rules were in effect when applicant filed this proceeding, applicant's attempt to make its pleaded registration of record would still be of no avail because opposer failed to comply with the USPTO procedures for attaching electronic records to the notice of opposition.

Applicant filed this proceeding on July 11, 2007. The rules then in effect at that time specified the requirements for introducing evidence of a pleaded registration, and provided, in relevant part, as follows:

(1) A registration of the opposer ... pleaded in an opposition ... will be received in evidence and made part of the record if the opposition ... is accompanied by two copies ... of the registration prepared and issued by the [USPTO] showing both the current status of and current title to the registration.

(2) A registration owned by any party to a proceeding may be made of record ... by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy ... of the registration prepared and issued by the [USPTO] showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Trademark Rule 2.122(d), 37 C.F.R. § 2.122(d). Thus, the rules governing this proceeding did not permit an opposer to

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file a copy of a registration from USPTO electronic records, only status and title copies prepared by the USPTO. In this case opposer did not file such a copy. Also, as we indicated above, opposer filed no evidence related to its pleaded registration later in the proceeding under subsection (2) of the rule to remedy this omission. Nor did opposer submit any other evidence.

As we noted, the USPTO subsequently amended the Trademark Rules, including Trademark Rule 2.122(d). See *Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42,242 (Aug. 1, 2007). The amendment to Rule 2.122(d) only applies to proceedings commenced on or after August 31, 2007 and not to this proceeding. *Id.* at 42,242. The amendment changed subsection 2.122(d)(1) only, the subsection which is relevant here. That subsection now provides:

(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or cancellation is accompanied by an original or photocopy of the registration prepared and issued by the United States Patent and Trademark Office showing both the current status of and current title to the registration, or by a current printout of information from the electronic database records of the USPTO showing the current status and title of the registration.

Trademark Rule 2.122(d).

Opposer filed its Notice of Opposition electronically through the Trademark Trial and Appeal Board's ESSTA system. In the electronic cover sheet submitted with its Notice of Opposition, under "Attachments," opposer refers to "78830611#TMSN.jpeg (1 page)(bytes)."⁵ The instructions for filing a Notice of Opposition in electronic form through the ESSTA system state the following under the heading "Requirements For Electronic Filing":

Your pleading must be in a file stored on your computer in PDF (preferred), TIFF or TXT format. The pleading should be formatted for 8.5" x 11" paper in black and white text or graphics. TIFF or PDF filings should be in 300 dpi resolution. There is a limit of approximately 10 megabytes per file.

If applicant attempted to submit a copy of its registration in jpeg format, the format referenced in its filing, it was not received, either because it was not attached at all or because the jpeg format is not one of the acceptable formats. Consequently, even if this proceeding were governed by the amended rules, and it is not, opposer still did not provide any acceptable record related to its pleaded registration with its notice of opposition.

With that clarification of the content of the record, we will proceed with our analysis of the case. As we noted

⁵ The number 78830611 is the application serial number corresponding to opposer's pleaded Registration No. 3193826. However, because no document was received, we do not know what document opposer may have attempted to attach.

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above, opposer bears the burden of proving its claim by a preponderance of the evidence. *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d at 1959.

The Board must consider an opposer's standing as a threshold issue in every case. In *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999), the Federal Circuit has enunciated a liberal threshold for determining standing, i.e., whether one's belief that one will be damaged by the registration is reasonable and reflects a real interest in the case. See also *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987). In the notice of opposition opposer has adequately asserted its standing by claiming ownership of the referenced registration and prior common law rights in its BADONGO mark. The only issue is whether opposer has proven its standing. If opposer had introduced acceptable evidence of its ownership of the pleaded BADONGO registrations, that would have been adequate to show standing. As we noted, opposer failed to introduce any evidence bearing on its alleged standing.

In the alternative, we may look to the admissions in applicant's answer for this purpose. We have referenced the relevant admissions above. Even under the liberal standard for standing, we construe the language in applicant's admissions in paragraphs 7 and 8 as insufficient to show

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that the registration for the BADONGO mark is valid and subsisting. Thus, the admissions do not extend to the status of the registration. That is, applicant did not admit that opposer's registration is valid and subsisting. Accordingly, we conclude that opposer has failed to make the showing necessary to prove its standing. Our conclusion that opposer failed to prove standing is a sufficient basis, by itself, to dismiss the proceeding.

Next, for completeness sake, we will proceed to consider the issue of priority. An opposer must first show priority to prevail on a claim of likelihood of confusion. Here too, if opposer had introduced acceptable evidence of its ownership of, and the status of, the pleaded registrations, priority would not be an issue. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). We would proceed on the basis that opposer had priority. However, again as we discussed above, opposer failed to introduce acceptable evidence of its pleaded registrations. Accordingly, we must look for other evidence of opposer's priority.

We have no testimony or other evidence of opposer's use of its mark which opposer may rely on to show its priority. Therefore, here again, the admissions in applicant's answer are the only other available, potential "evidence" to show priority. The admissions relate specifically to opposer's

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pleaded registration. However, as we noted above, neither admission addresses the status of opposer's pleaded registration. That is, we have no admission or other evidence that the pleaded registration is valid and subsisting. Accordingly, in this instance, the admissions fail to establish opposer's priority. Accordingly, because opposer has failed to establish its priority its likelihood-of-confusion claim fails. Here again, our conclusion that opposer failed to show priority to support its likelihood-of-confusion claim, by itself, is a sufficient basis to dismiss the opposition.

However, even if we proceeded to consider opposer's likelihood-of-confusion claim on the merits, we would conclude that there is no likelihood of confusion. The differences between the marks alone dictate that conclusion.

The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1977) sets forth the factors to consider in determining likelihood of confusion. Here, as is often the case, the crucial factors are the similarity of the marks and the similarity of the goods and services in the application and the cited registration. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by Section 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods

[and services] and differences in the marks."). Also, as the *du Pont* decision notes, each case must be decided on its particular facts, and each of the factors may play a dominant role in a particular case. *In re E. I. du Pont de Nemours & Co.*, 177 USPQ at 567.

Here, based on the respective identifications of services, we conclude that the services are related, if not overlapping. Thus, the critical issue is the similarity or dissimilarity of the marks. In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005).

Applicant's entire argument regarding the marks states: "PODANGO is confusingly similar because it sounds and appears virtually the same as BADONGO. There is strong likelihood of confusion to consumers based on the substantial similarity of the marks, their sound, and appearance. A confusingly similar mark should not be granted registration." Opposer's Brief at 2.

While the marks may be similar in some superficial respects, for example, both end in NGO and each has seven letters, we find the differences between the marks to be more significant. The marks begin differently - BAD versus POD. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9

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USPQ2d 1895, 1897 (TTAB 1988) (“...[it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.”). More broadly, contrary to opposer’s arguments, the marks differ significantly in both appearance and sound. The marks also differ in connotation and commercial impression. Applicant’s mark begins with POD, and all of the services identified in the application relate to podcasting. Therefore, applicant’s PODANGO mark connotes a connection to podcasting. This likewise affects the commercial impression of applicant’s mark. We find no such connotation or commercial impression in opposer’s BADONGO mark.

Accordingly, based on this sparse record, even if we had not dismissed the proceeding because opposer failed to prove either its standing or its priority, on the merits we would conclude that the marks are not similar, and furthermore, that there is no likelihood of confusion between the marks as applied to the identified services.

Decision: We dismiss the opposition.