

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: September 11, 2012

Opposition No. 91196299

Connect Public Relations,
Inc.

v.

Digitalmojo, Inc.

Cancellation No. 92054395

Cancellation No. 92054427

Digitalmojo, Inc.

v.

Connect Public Relations,
Inc.

By the Trademark Trial and Appeal Board:

The February 23, 2012 order is modified as follows:
In the first full paragraph on page 8, delete "the Board will decide that motion on the merits," and substitute therefor "the Board declines to grant that motion as conceded."

Digitalmojo, Inc. ("Digitalmojo") seeks to register the mark CONNECT in standard character form for goods and services in International Classes 9, 35, 38, 42, and 45.¹

¹ Application Serial No. 77714693, filed April 15, 2009, based on an assertion of a bona fide intent to use the mark in commerce

under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The goods and services identified in that application are as follows: "audio recordings featuring music; video recordings featuring music; downloadable audio and video recordings featuring music; prerecorded music on CD, DVD and other media" in International Class 9; "[b]usiness marketing services in the nature of agency representation of companies marketing a variety of services to home owners and renters, namely, utility hook-ups, telecommunication services, home security services, home warranties, home and yard maintenance, furniture and appliance rental; comparative marketing and advertising services for providers of residential and business telecommunications services, namely, for providers of broadband cable, DSL, fiber-optic and satellite Internet access services, cable and satellite television, voice over IP, and long-distance telephone services; operation of telephone call centers for others; marketing of high speed telephone, Internet, and wireless access, and directing consumers to access providers; providing an online directory information service featuring information regarding, and in the nature of, classifieds; advertising and information distribution services, namely, providing classified advertising space via the global computer network; promoting the goods and services of others over the Internet; providing online computer databases and on-line searchable databases featuring classified listings and want ads; online business networking services; providing telephone directory information via global communications networks; providing an online interactive website obtaining users comments concerning business organizations, service providers, and other resources; providing information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to business organizations, service providers, and other resources using a global computer network; providing telephone directory information via global communications networks; arranging for others the initiation and termination of telecommunication services and utility services in the nature of water, gas and electricity and consultation rendered in connection therewith" in International Class 35, "providing online chat rooms for registered users for transmission of messages concerning classifieds, virtual community and social networking; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; providing email and instant messaging services" in International Class 38, "computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; computer software development; application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, tagging, blogging, sharing or otherwise providing electronic media or information over the Internet or other communications

In the amended notice of opposition, Connect Public Relations, Inc. ("Connect") opposes registration of Digitalmojo's mark in all five applied-for classes on the ground of likelihood of confusion with its previously used and registered marks CONNECT PUBLIC RELATIONS and CONNECTPR and its previously used mark CONNECT under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).² Digitalmojo, in

network; providing temporary use of non-downloadable software applications for classifieds, virtual community, social networking, photo sharing, video sharing, and transmission of photographic images; computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions; computer services in the nature of customized web pages featuring user-defined information, personal profiles and information" in International Class 42, and "on-line social networking services; internet based dating, introduction and social networking services" in International Class 45.

² Contact's pleaded registrations for the mark CONNECT PUBLIC RELATIONS in typed form are:

Registration No. 2362916 for "[p]rinted publications, namely, reports, press kits and brochures in the fields of market research and consulting, public and media relations, sales promotion, strategic marketing planning, development of market positioning and messaging, background editorial support of sales promotion material, and seminar creation and operation" in International Class 16, issued June 27, 2000, renewed;

Registration No. 2373504 for "[m]arketing and market research and consulting services; public and media relations services and sales promotion services" in International Class 35, issued August 1, 2000, renewed;

Registration No. 2373505 for "[p]rerecorded audio recordings, prerecorded video recordings, and prerecorded audio-visual recordings featuring topics in the fields of marketing and market research and consulting services, public and media relations services and sales promotion services; electronic publications featuring topics in the fields of marketing and market research and consulting services, public and media relations services and sales promotion services on computer discs and CD-ROMs" International Class 9, issued August 1, 2000, renewed; and

its answer, denied the salient allegations of the amended notice of opposition.

On August 22, 2011, Digitalmojo filed petitions to cancel Connect's pleaded Registration No. 2366850 for the mark CONNECTPR in typed form and Registration No. 2373504

Registration No. 2383778 for "[c]ommunications services, namely, delivery of messages by electronic transmission" in International Class 38, issued September 5, 2000, renewed.

Contact's pleaded registrations for the CONNECTPR mark in typed or standard character form are:

Registration No. 2365074 for "[c]ommunications services, namely, delivery of messages by electronic transmission" in International Class 38, issued July 4, 2000, renewed;

Registration No. 2366850 for "[m]arketing and market research and consulting services; public and media relations services and sales promotion services" in International Class 35, issued July 11, 2000, renewed;

Registration No. 2383777 for "[p]rerecorded audio recordings, prerecorded video recordings, and prerecorded audio-visual recordings featuring topics in the fields of marketing and market research and consulting services, public and media relations services and sales promotion services; electronic publications featuring topics in the fields of marketing and market research and consulting services, public and media relations services and sales promotion services on computer discs and CD-ROMs" in International Class 9, issued September 5, 2000, renewed;

Registration No. 2713692 for "[p]rinted publications, namely, brochures in the fields of market research and consulting, public and media relations, sales promotion, strategic marketing planning, development of market positioning and messaging, background editorial support of sales promotion material, and seminar creation and operation" in International Class 16, issued May 6, 2003, Section 8 accepted, Section 15 declaration acknowledged; and

Registration No. 3330353 for "[p]rinted publications, namely, reports, brochures and press kits comprised of brochures, flyers, and press releases, in the fields of market research and consulting, public and media relations, sales promotion, strategic marketing planning, development of market positioning and messaging, background editorial support of sales promotion materials, and seminar creation and operation" in International Class 16, issued November 6, 2007.

for the mark CONNECT PUBLIC RELATIONS in typed form, both for "[m]arketing and market research and consulting services; public and media relations services and sales promotion services" in International Class 35. Prior to filing answers thereto, Connect, on September 15, 2011, filed motions to dismiss the petitions to cancel as untimely compulsory counterclaims and for failure to state a claim under Fed. R. Civ. P. 12(b)(6).³ Following full briefing of the motions to dismiss, Digitalmojo, on November 8, 2011, filed motions for leave to file amended petitions to cancel, followed on February 6, 2012, by amended motions for leave to file amended motions for leave to file amended petitions to cancel.

Instead of waiting for the Board to decide its motions to dismiss, Connect, on October 25, 2011, filed a motion for partial summary judgment with regard to sixteen separate subsets of services in International Classes 35, 38, 42, and 45, and not for all of the services in those classes, based on likelihood of confusion with the CONNECT PUBLIC RELATIONS and CONNECTPR marks in its pleaded registrations. Following briefing of the motion for

³ Contrary to Connect's assertion in its reply brief in support of the motion to dismiss Cancellation No. 92054395, a motion to dismiss claims as insufficiently pleaded is indeed a motion to dismiss for failure to state a claim under Fed. R. Civ. P. 12(b)(6).

partial summary judgment, the Board, in a February 23, 2012, order, the Board consolidated the above-captioned proceedings, indicated that it was treating the first motions for leave to file amended petitions to cancel as having been withdrawn, and reset time for remaining briefing on the amended motions for leave to file amended petitions to cancel.⁴

The Board will consider the pending motions in the cancellation proceeding. An attack on the validity of a pleaded registration in an opposition proceeding must be raised by way of a compulsory counterclaim or separate petition to seek the cancellation of such registration. See Trademark Rule 2.106(b)(2)(ii). If grounds for the counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer; if grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. See Trademark Rule 2.106(b)(2)(i). A defendant that fails to

⁴ In that order, the Board noted, among other things, that, because the above-captioned cancellation proceedings are the equivalent of counterclaims in the opposition, one of the parties should have moved for suspension of the opposition pending the Board's decision on the motions to dismiss the cancellations and that Connect should not have filed the motion for partial summary judgment until after a decision was issued on the motions to dismiss the petition to cancel. See Trademark Rule 2.127(d).

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timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. See TBMP Section 313.01 (3d ed. rev. 2012).

Because Digitalmojo, in the petitions to cancel, seeks cancellation of Connect's pleaded Registration Nos. 2366850 and 2373504, the petitions to cancel are compulsory counterclaims. In response to the motions to dismiss, Digitalmojo states that it became aware of facts which give rise to the petitions to cancel during the course of the opposition proceeding through discussing legal theories with Contact's attorney, in reviewing Contact's responses to Digitalmojo's discovery requests, and in reviewing Connect's web site and other marketing materials in light of such discovery responses. In a declaration that was filed an exhibit to briefs in response to the motions to dismiss, Digitalmojo's attorney averred that he received from Contact more than 2,600 pages of discovery documents on April 5, 2011; that he reviewed those documents in conjunction with Connect's website and other marketing materials between June 1 and July 31, 2011, and, through such review, learned of the grounds for seeking cancellation of Connect's pleaded Registration Nos. 2366850 and 2373504. Because Digitalmojo filed the petitions to

cancel less than a month later, and prior to the close of the discovery period, the Board is satisfied that Digitalmojo filed the petitions to cancel promptly after learning the grounds therefor. Accordingly, to the extent that Connect's motion to dismiss the cancellation proceedings on the ground that they are untimely compulsory counterclaims is denied.

In view of Digitalmojo's filing of renewed motions for leave to file amended petitions to cancel, the motions to dismiss the petitions to cancel based on the allegedly insufficient pleaded claims set forth therein are moot. Rather, because the amended petitions to cancel were filed early in the cancellation proceedings⁵ and are intended to correct deficiencies in the original petitions to cancel, the motions for leave to file amended petitions to cancel are granted. See Fed. R. Civ. P. 15(a)(2); TBMP Sections 503.03 and 507.02.

The amended petitions to cancel are the operative pleadings in this proceeding. The Board will review the amended petitions, which are essentially identical, to determine their sufficiency. See Fed. R. Civ. P. 12(b)(6).

⁵ In the Board's February 23, 2012 order, the Board suspended the above-captioned proceedings retroactive to August 26, 2011, the filing date of Digitalmojo's motion to consolidate the above-captioned proceedings, which was granted in that order.

A complaint is legally sufficient where it contains allegations of sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of *inter partes* proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. In particular, a plaintiff need only allege "enough factual matter ... to suggest that [a claim is plausible]" and "raise a right to relief above the speculative level." *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

Digitalmojo's standing in the cancellation proceedings arises from its position as defendant in the above-

Opposition No. 91196299; Cancellation Nos. 92054395 and 92054427 captioned opposition proceeding, as described in paragraphs 1-6 of the amended petitions to cancel. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289 (TTAB 1999).

In the amended petitions to cancel, Digitalmojo seeks cancellation of Connect's pleaded Registration Nos. 2366850 and 2373504 on grounds that Connect committed fraud in the prosecution of those registrations based on alleged nonuse of the mark on some of the identified services (paragraphs 7-31), that Connect abandoned use of the involved marks in connection with all or some of the recited services (paragraphs 32-55), that Connect committed fraud in the maintenance of the involved registration (paragraph 56), and that the recitation of services in those registrations is indefinite (paragraph 57). All of these grounds are insufficiently pleaded.

The alleged indefiniteness of the recitation of services in paragraph 57 is an *ex parte* examination matter that is not a basis for opposing an application or canceling a registration. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989). Connect complied with all examination requirements regarding the recitation of services; had the Examining Attorney objected to the recitation during examination, Connect would have had an opportunity to amend that

recitation. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989). It would be unfair to penalize Connect based on a recitation of services that the Examining Attorney accepted. *Id.* Accordingly, Digitalmojo's claim based on the alleged indefiniteness of the recitation of services is unavailable.

Regarding Digitalmojo's fraud allegations, fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes specific false, material representations of fact in connection with an application to register or in a post-registration filing with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009). Intent is a required element to be pleaded for a claim of fraud. See *id.*

Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are also insufficient. *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009). Digitalmojo's fraud grounds are made "[o]n information and belief" with no recitation of specific facts upon which the beliefs are based.

Further, regarding the factual bases for the fraud grounds in the amended petitions to cancel, Digitalmojo alleges in paragraph 7 that Connect committed fraud in the prosecution of the involved registrations by stating that it was using the marks at issue on the recited services, i.e., "[m]arketing and market research and consulting services; public and media relations services and sales promotion services," because it was not using those marks in connection with those services in certain fields "prior to the time of filing its application or thereafter." However, Digitalmojo has not identified a submission to the USPTO in which Connect made the statement at issue, e.g., the statement of use under Trademark Rule 2.88.⁶ Further, the applications for Connect's registrations were filed under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b), based on assertions of a bona fide intent to use the marks in commerce, and Connect did not allege that it was using the marks at issue until it filed the statements of use in support of the applications for those registrations. Accordingly, any nonuse prior to the filing of the applications for those registrations is irrelevant.

⁶ The language that Digitalmojo quotes and relies upon in support of its allegations in paragraphs 7-57 of the amended petitions to cancel appears to be taken from the amended notice of opposition in Opposition No. 91196299.

In paragraph 56, Digitalmojo contends that Connect committed fraud in the maintenance of the registrations at issue by stating that it was using the marks at issue on the recited services, i.e., "[m]arketing and market research and consulting services; public and media relations services and sales promotion services," because it no longer uses those marks in connection with those services in certain fields. However, Digitalmojo has not identified a submission to the USPTO in which Connect made the statement at issue, e.g. the declaration of use under Trademark Act Section 8, 15 U.S.C. Section 1058, or the renewal application under Trademark Act Section 9, 15 U.S.C. Section 1059.

Digitalmojo also alleges in paragraphs 8-31 that Connect committed fraud by stating that it was using the marks at issue on the recited services, i.e., "[m]arketing and market research and consulting services; public and media relations services and sales promotion services," because it never used the marks at issue on certain goods and services that are identified in Digitalmojo's involved application. However, Digitalmojo has not identified any submission to the USPTO in which Connect made the statements at issue. Moreover, nearly all of the goods and services in Digitalmojo's involved application upon which

Digitalmojo relies in support of such allegations are not logically within the scope of Connect's recited services in the registrations at issue.⁷

Further, even if the Board assumes that Connect was not using those marks in connection with those services in certain fields or in connection with goods and services identified in Digitalmojo's application, such nonuse in those fields does not give rise to a fraud claim. So long as Connect was using the marks at issue in connection with activities that fit within all of the services as broadly defined in its Registration Nos. 2366850 and 2373504, i.e., "[m]arketing and market research and consulting services; public and media relations services and sales promotion services," when it filed the statements of use, declarations of use, and renewal applications for those registrations, there is no false statement upon which to base a fraud claim. See *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912 (TTAB 2007) (no fraud where identification was "wines and sparkling wines," but mark was only in use on sparkling wines, because wines include sparkling wines). Connect need not have used the marks at issue in connection with the recited services in

⁷ In determining the scope of an identification, the USPTO considers the ordinary meaning of the wording at issue. See TMEP Section 1402.07(a) (8th ed. 2011).

every conceivable field to properly allege use of the involved marks on those services. See TMEP Section 1402.03. Accordingly, Digitalmojo's pleaded fraud claims are insufficiently pleaded and further would appear to be without basis.

Regarding the pleaded abandonment grounds, an abandonment claim requires an allegation of at least three consecutive years of nonuse or must set forth facts that show a period of nonuse less than three years coupled with an intent not to resume use. See Trademark Act Section 45, 15 U.S.C. Section 1127; *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007). In paragraphs 32-55 of the amended petitions to cancel, Digitalmojo contends that Connect abandoned the marks in the registrations at issue because it no longer uses the marks on certain goods and services that are identified in Digitalmojo's involved application. Digitalmojo has not alleged at least three consecutive years of nonuse on the recited services or facts that show a period of nonuse less than three years coupled with an intent not to resume use. In addition, so long as Connect has continuously used the marks at issue in connection with activities that fit within all of the identified services, as broadly defined, i.e., "[m]arketing and market research and consulting services; public and

media relations services and sales promotion services," there is no abandonment of the marks with regard to these services. See Trademark Act Section 45. Cf. *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, *supra*. Moreover, to the extent that Digitalmojo intends to allege partial abandonment, it has not provided fair notice of that claim because it has not specified which services have been abandoned. See *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434 (TTAB 1995); TBMP Section 506.01. In addition, nearly all of the goods and services in Digitalmojo's involved application upon which Digitalmojo relies in support of such allegations are not logically within the scope of Connect's recited services in the registrations at issue. Accordingly, Digitalmojo's pleaded abandonment grounds are insufficiently pleaded. Based on the foregoing, Digitalmojo has failed to state a claim upon which relief can be granted in the amended petitions to cancel.

Notwithstanding the foregoing, the Board generally allows plaintiffs whose complaints have been found to be deficient, an opportunity to file a corrected complaint. See TBMP Section 503.03. Accordingly, in keeping with Board practice, Digitalmojo is allowed until twenty days from the mailing date set forth in this order to file

second amended petitions to cancel in the cancellation proceedings, failing which the cancellation proceedings will be dismissed with prejudice.⁸ Notwithstanding the consolidation of these proceedings, Digitalmojo should file the second amended petitions in the Board files for the

⁸ Digitalmojo may intend to seek restriction of Connect's Registration Nos. 2366850 and 2373504 under Trademark Act Section 18, 15 U.S.C. Section 1068. Section 18 gives the Board the equitable power to cancel registrations in whole or in part, "restrict the goods or services identified in an application or registration," or to "otherwise restrict or rectify ... the registration of a registered mark." 15 U.S.C. Section 1068; Trademark Rule 2.133(b); see also TBMP Section 309.03(d) (3d ed. rev. 2012) and cases cited therein. In *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co.*, 34 USPQ2d 1266, 1271 (TTAB 1994), the Board set forth the elements for stating a proper claim for partial cancellation or restriction of a registration under Section 18. Digitalmojo must plead that the proposed restriction will avoid a likelihood of confusion and that Connect is not using the mark on the goods or services being deleted or "effectively excluded" from the registration. *Id.* For pleading purposes, a Section 18 claim or defense must be specific enough in nature so that the adverse party has fair notice of the restriction being sought. *Id.*

In addition, Digitalmojo is advised that, under Trademark Rule 11.18(b),

[b]y presenting to the Office ... any paper, the party presenting such paper ... is certifying that ... [t]o the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, ... [t]he paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of any proceeding before the Office; ... [and t]he allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery.

See also Fed. R. Civ. P. 11(b); TBMP Section 527.02 (3d ed. rev. 2012). Accordingly, unless Digitalmojo knows of facts that support each claim it intends to raise herein or has a good faith belief that evidence showing the factual basis for those claims is likely to be obtained after a reasonable opportunity for discovery or investigation, it should not plead those claims.

cancellation proceedings and not in the file for the opposition proceeding. Proceedings herein otherwise remain suspended.

In deciding cases that include counterclaims, the Board decides the counterclaim first.⁹ See, e.g., *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881 (TTAB 2006). Accordingly, the Board must defer consideration of Connect's motion for partial summary judgment at least until it is determined whether or not the cancellations will go forward.¹⁰

The parties appear to have already undertaken considerable discovery in this case. Accordingly, the

⁹ By deciding the counterclaim first, the Board determines whether the plaintiff in an opposition or cancellation proceeding can rely upon the registration that is the subject of the counterclaim in support of the opposition or cancellation.

¹⁰ In the motion for partial summary judgment, Connect seeks entry of partial summary judgment on its Section 2(d) claim with regard to sixteen separate subsets of services in International Classes 35, 38, 42, and 45, rather than in those classes in their entirety, based on likelihood of confusion with the CONNECT PUBLIC RELATIONS and CONNECTPR marks in its pleaded registrations. In Board *inter partes* proceedings, likelihood of confusion may be found with respect to a particular international class based on any single item within the identification of goods or services for that class. See *Tuxedo Monopoly Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011). That is, if likelihood of confusion is found with respect to any item within a particular class, that finding applies to the entire class at issue. Accordingly, contrary to Connect's apparent belief, a finding of likelihood of confusion with regard to any item in a particular international class would apply to the entire class and not merely to the item(s) at issue.

parties should consider accelerated case resolution (ACR) of this entire case, once the pleadings herein are clarified.¹¹ The parties should review the Board website regarding ACR, <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>. If the parties agree to pursue ACR, they should notify the Board within thirty days of the mailing date set forth in this order.

¹¹ If the parties agree to pursue ACR, the motion for partial summary judgment will receive no consideration. The extent to which the Board will consider such motion will otherwise be determined once issues regarding the pleadings in the cancellation proceedings are resolved.