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

Proceeding	91196299
Party	Plaintiff Connect Public Relations, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Opposition No. 91196299 (Parent) CONNECT PUBLIC RELATIONS, INC., Opposer, v. DIGITALMOJO, INC., Applicant.	)	REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT
Cancellation Nos. 92054395 & 92054427 DIGITALMOJO, INC., Petitioner, v. CONNECT PUBLIC RELATIONS, INC., Respondent.	)	

Opposer Connect Public Relations, Inc. ("Connect") files this Reply In Support of Motion for Summary Judgment ("Reply") in rebuttal to Digitalmojo, Inc.'s ("Digitalmojo") Applicant's Response to Opposer's Motion for Summary Judgment ("Response").

I. DIGITALMOJO FAILED TO PROFFER COUNTERING EVIDENCE TO CREATE A GENUINE FACTUAL DISPUTE ON THE ISSUE OF ABANDONMENT

As basis for its abandonment allegations, Digitalmojo asserted in the Petitions to Cancel that Connect abandoned its CONNECT PUBLIC RELATIONS and CONNECTPR marks in its Class 35 Registrations ("Class 35 marks") when it "switched" to a new mark, CONNECT MARKETING. In its Motion, Connect disputed this contention by proffering evidence in the form of the Affidavit of Neil Myers ("Myers Aff." or "Myers Affidavit"), the founder and president of Connect, and the Affidavit of Dr. Glenn L. Christensen ("Christensen Aff." or "Christensen Affidavit") that explained in great detail that the adoption of the CONNECT MARKETING mark was not a "switch" but was instead an "expansion" of Connect's brand.

In its Response, Digitalmojo failed to proffer any countering evidence of its own on the issue of abandonment to dispute the facts alleged in the Myers and Christensen Affidavits. Instead, Digitalmojo argues that the Myers and Christensen Affidavits actually demonstrate the abandonment of Connect's Class 35 marks. Response, p. 9, ll. 15-17. However, Digitalmojo's attack on the Myers and Christensen Affidavits, without any support from countering evidence, is insufficient to generate a genuine factual dispute. *See Octocom Systems Inc. v. Houston Computers Services, Inc.,* 918 F.2d 937, 16 USPQ2d 1783, 1786 (Fed. Cir. 1990) ("The party opposing a motion for summary judgment must point to an evidentiary conflict created on the record at least by a counterstatement of facts set forth in detail in an affidavit by a knowledgeable affiant.").

Further, Digitalmojo failed to provide any countering evidence to establish the basic elements of its abandonment claims as Digitalmojo failed to (i) identify an alleged date on which Connect allegedly discontinued use of its Class 35 marks; and (ii) provide any evidence regarding

Connect's intent not to resume use, both of which are critical elements of its abandonment claim. *See On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000). Connect will now further address each of its Class 35 marks below in light of Digitalmojo's Response.

A. *CONNECT PUBLIC RELATIONS* (Reg. No. 2,373,504; Canc. No. 92054427)

In support of its Motion, Connect provided a graphic taken from its website showing the CONNECT PUBLIC RELATIONS mark being used side-by-side with its CONNECT MARKETING mark. *See* Myers Aff., ¶ 51 & Exhibit D, CPR003114. (This same graphic was also included on the web page specimen attached to Digitalmojo's Petitions to Cancel.) In its Response, Digitalmojo fails to present any countering evidence that would show a genuine dispute that the CONNECT PUBIC RELATIONS mark has been abandoned in view of this graphic.

Digitalmojo appears to concede in its Response that the graphic in question shows use of the CONNECT PUBLIC RELATIONS mark (and thus not abandonment) when it states: "Digitalmojo asserts that Myers' statement that ConnectPR is using CONNECT PUBLIC RELATIONS in this same graphic is an admission that the presentation of these three words together, regardless of the difference in size between "connect" and "public relations," <u>is a use of CONNECT PUBLIC RELATION</u> [sic], and not a use of CONNECT." Response, p. 8, ll. 9-12 (underlining added). For the foregoing reasons, Connect respectfully submits that there is no genuine dispute that Connect has <u>not</u> abandoned its CONNECT PUBLIC RELATIONS mark.

B. *CONNECTPR* (Reg. No. 2,366,850; Canc. No. 92054395)

Digitalmojo argues that the absence of the mark CONNECTPR in the new brand hierarchy under CONNECT MARKETING generates a genuine issue of material fact on the issue of

abandonment. This argument is incorrect as the Myers Affidavit validly establishes that the adoption of the CONNECT MARKETING mark is an "expansion" of Connect's brands and not an express abandonment of the CONNECTPR mark. Myers Aff. ¶ ¶ 51-55 & Exhibit D, CPR003114. In fact, the web page specimen relied upon by Digitalmojo is completely silent on whether Connect will or will not continue to use the CONNECTPR mark, and thus has little probative value on this issue. The Myers Affidavit, however, is crystal clear on this point. Thus, Connect respectfully submits that there is no genuine dispute that Connect has not abandoned its CONNECTPR mark.

C. *Connect's Other Registrations Can and Should Serve as a Basis for Granting Connect's Summary Judgment Motion*

Even if the Board were to find that there exists a genuine issue of material fact in regard to the abandonment of Connect's Class 35 registrations (which does not exist), Connect's other pleaded registrations for the marks CONNECT PUBLIC RELATIONS and CONNECTPR (Reg. Nos. 2,362,916; 2,373,505; 2,383,778; 2,365,074; 2,383,777; 2,713,692 and 3,330,353) can and should serve as a basis for granting Connect's Motion, as Digitalmojo failed to file a counterclaim challenging their validity.

II. CONNECT IS ENTITLED TO SUMMARY JUDGMENT ON THE ISSUE OF COMMON LAW RIGHTS IN ITS CONNECT MARK

Digitalmojo asserts that a genuine issue of material fact exists as to whether Connect has established common law rights in the mark CONNECT (single word). Digitalmojo goes so far as to argue that Connect "is not now using the mark CONNECT (single word), and ConnectPR may never have used the mark CONNECT (single word)." Response, pp. 9-10. However, Digitalmojo failed to proffer any countering evidence to support its arguments on these points.

Connect, in contrast, provided ample evidence in the form of the Myers Affidavit that establishes that Connect began using the mark CONNECT in 1998. Myers Aff. ¶¶ 5 and 16 . Myers testimony further establishes that Connect acquired common law rights in the mark CONNECT and uses this mark on the same goods and services as recited in its pleaded registrations for CONNECT PUBLIC RELATIONS and CONNECTPR. Myers Aff. ¶ 16. Exhibits A-C to Myers Affidavit even provide documentary evidence of Connect's early and later use in commerce of the mark CONNECT. Myers Aff. ¶¶ 23-25. Myers Affidavit also provides evidence that its customers and employees often refer to Connect as CONNECT. Myers Aff. ¶ 30. A printout of Connect's website demonstrates the continued and ongoing use of the mark CONNECT with use of the SM symbol in the year 2013. Myers Aff., Exhibit D (CPR003145-CPR003146). In light of this uncontroverted evidence of its past and continued use, there can be no genuine dispute that Connect owns common law rights in the mark CONNECT.

III. CONNECT IS ENTITLED TO SUMMARY JUDGMENT ON THE ISSUE OF LIKELIHOOD OF CONFUSION

A. *Strength of ConnectPR Marks (Sixth DuPont Factor)*

As evidence of the alleged weakness, dilution and narrow scope of the Connect Marks, Digitalmojo relies entirely upon the Declaration of Thomas Cook ("Cook Decl." or "Cook Declaration"), who is Digitalmojo's counsel in this proceeding. The Cook Declaration should not be deemed probative for the following reasons. First, the USPTO Rules of Professional Conduct require that "a practitioner shall not act as advocate at a proceeding before a tribunal in which the practitioner is likely to be a necessary witness ...." 37 C.F.R.§ 11.307(a). The purpose of this rule is "to avoid the predicament of a lawyer having to testify and then having to argue the credibility and effect of his own testimony." *In re Gray Inc.*, 3 USPQ2d 1558, 1560 (T.T.A.B. 1987). Second, as further expounded upon by the Board in *Gray*, the Cook Declaration should

not be given any weight as his statements represent an extremely biased opinion. *Id.* Finally, the Cook Declaration should not be given weight because Cook was neither disclosed as an expert witness nor did he provide an expert report in this matter as required by the Federal Rules of Civil Procedure. *See* Fed. R. Civ. P. 26(a)(2); *see also* 37 C.F.R. § 2.120(a)(2) and TBMP § 401.03.

In any event, the third-party registrations cited in the Cook Declaration have limited probative value as to likelihood of confusion. In terms of demonstrating the strength of a mark, absent evidence of actual use, third-party registrations have little probative value because they are not evidence that the marks are in use on a commercial scale or that the public has become familiar with them. *See Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462, 463 (CCPA 1973). Moreover, the cited registrations do not appear to be relevant to the case at hand. For example, the goods for one of the third-party registrations cited by Cook, Registration No. 2,836,079, are for "allograph implants comprising formerly living tissue for use in spinal surgery" which are clearly not relevant to a likelihood of confusion analysis in the present proceeding. Thus, Digitalmojo has failed to present counter evidence demonstrating that the Connect Marks are weak.

B. *Similarity of Connect Marks and the Opposed Mark (First DuPont Factor)*

As an initial matter, Digitalmojo actually admits in its Response that "[t]he Opposed Mark and the CPR Marks are similar ...." Response, p. 24, l. 16. With this understanding, Connect will address the similarity of each of its marks below to the Opposed Mark.

1. *There Is No Genuine Dispute That Connect's Common Law CONNECT Mark Is Identical to the Opposed Mark*

Instead of admitting that Connect's common law mark CONNECT and the Opposed Mark are identical, Digitalmojo attempts to avoid the issue by arguing that Connect does not have

common law rights in its CONNECT mark. As the marks are clearly identical, Digitalmojo has failed to establish a genuine issue of material fact on this point.

2. *There Is No Genuine Dispute That the Opposed Mark is Highly Similar to Connect's CONNECT PUBLIC RELATION Mark*

Digitalmojo argues that there is a genuine dispute as to the similarity of the Opposed Mark and the CONNECT PUBLIC RELATIONS MARK for two reasons. First, Digitalmojo asserts that the Opposed Mark conveys a different commercial impression than the CONNECT PUBLIC RELATIONS mark. Second, Digitalmojo contends that the matter in common to the marks is merely descriptive or diluted. Each of these will be addressed below.

In regard to commercial impression, Digitalmojo failed to proffer any evidence, as is required, that would establish a genuine issue of fact that the marks convey different commercial impressions. In regard to the matter in common to the marks being merely descriptive or diluted, Digitalmojo relies entirely upon the discredited Cook Declaration, which has no probative value in this proceeding. Without any counter evidence, Digitalmojo has failed to establish a genuine issue of material fact on this point.

3. *There Is No Genuine Dispute That the Opposed Mark is Highly Similar to Connect's CONNECTPR Mark*

Digitalmojo again attempts to avoid this issue by arguing that the CONNECTPR mark has been abandoned. However, this contention cannot be correct for at least the reason that only one of Connect's five registrations for the CONNECTPR mark have been challenged by Digitalmojo in this proceeding. Even if this contested registration is out of play (which it is not, because it was never abandoned and remains in use), Connect's other four registrations for CONNECTPR remain in this proceeding. (This same point applies to the CONNECT PUBLIC RELATIONS mark as well.)

Next, Digitalmojo relies on the Cook Declaration to show that there exists a genuine issue of fact due to the "distinctiveness of the word 'connect'" and the "question of the sophistication of ConnectPR's 'clients,' facts which have not been addressed by ConnectPR in its Motion ...." Again, Digitalmojo's reliance on the Cook Declaration to establish these facts is misplaced because the Cook Declaration has no probative value. Without any counter evidence, Digitalmojo has failed to establish a genuine issue of material fact on this point.

C. *Similarity of Services of Connect Marks and the Opposed Mark (Second DuPont Factor)*

In an attempt to avoid a likelihood of confusion, Digitalmojo argues that Connect's services are limited to "businesses" while its own services are limited to "consumers" even though neither its application nor the Connect Registrations contain any such limitations. In making these arguments, however, Digitalmojo runs afoul of one of the most basic principles of trademark practice before the Board, namely, that "the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchaser's to which the sales of goods are directed." *Octocom Systems*, 16 USPQ2d at 1797. Likewise, Connect, is entitled to the full, broad scope of its registrations free from arbitrary limitations imposed on its goods and services by Digitalmojo in an attempt to avoid a likelihood of confusion.

Moreover, Digitalmojo's attempt to limit its services to "consumers" only, runs directly afoul of the plain language in its application. For example, Digitalmojo's recited "<u>Business marketing services</u> 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"

are not services directed to "consumers," but are in fact services directed to "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." Clearly, these "companies" are businesses.

By way of another example, Digitalmojo's recited "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" are services explicitly for "providers of residential and business telecommunications services." Clearly, these "providers" are businesses that provide residential and business telecommunications services. In this regard, Digitalmojo fails to explain why a "consumer," as it defines that term, would need "comparative marketing and advertising services." Again, why would a "consumer" need Digitalmojo's "comparative marketing and advertising services"? A business would.

Still, by way of another example, Digitalmojo's recited "Promoting the goods and services of others over the Internet" is directed to "others." Clearly, the term "others" may include businesses as businesses often stand in need of a third-party, such as Digitalmojo and Connect, to promote their goods and services over the Internet.

Another problem with Digitalmojo's Response is that it failed to address all of the separate services in its application that were treated in Connect's Motion. In particular, Connect specifically identified seven (7) separate services listed in class 35 of Digitalmojo's application as being likely to cause confusion. *See* Motion, p. 19 (bullet list). In its Response, Digitalmojo only addresses one (1) of these services. As such, there can be no genuine issue of fact that the other

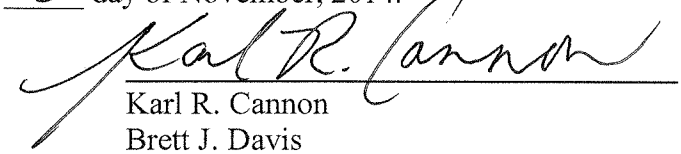
six (6) services are similar to Connect's services as set forth in its Motion as Digitalmojo failed to present any counter evidence.

Lastly, Digitalmojo argues that Connect was "mistaken" in comparing its class 16 goods with Digitalmojo's class 35 services, its class 38 services with Digitalmojo's class 38 services, its class 38 services with Digitalmojo's class 42 services, its class 38 services with Digitalmojo's class 45 services, and its class 9 services with Digitalmojo's class 9 services. Instead of proffering any counter evidence to show that the goods/services are dissimilar, as is required, Digitalmojo resorts to attacking the Myers and Christensen Affidavits. However, Digitalmojo's arguments attacking the Myers and Christensen Affidavits, without any support from countering evidence, is insufficient to generate a genuine factual dispute for trial. *See Octocom Systems,* 16 USPQ2d at 1786 ("The party opposing a motion for summary judgment must point to an evidentiary conflict created on the record ....").

IV. CONCLUSION

Connect submits that when all of the foregoing is considered, the Board will find there is no genuine issues of material and that Connect is entitled to summary judgement as a matter of law.

Respectfully submitted this 5 day of November, 2014.



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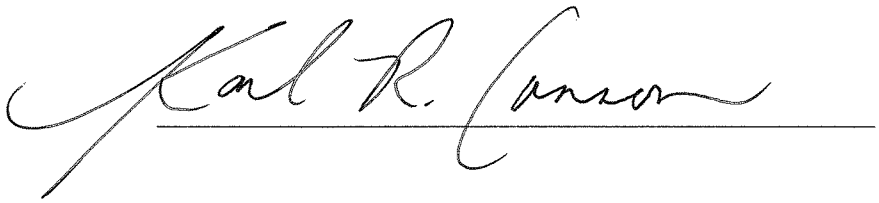
CERTIFICATE OF SERVICE

I hereby certify that I caused a true and correct copy of the foregoing **REPLY IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** to be served, via first class mail, postage prepaid, on this 5 day of November, 2014 to:

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