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T.T.A.B.

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

MBA

Mailed: June 11, 2012

Opposition No. 91198926

Google Inc.

v.

ACPS Global, Inc.

**Before Cataldo, Bergsman and Wolfson, Administrative
Trademark Judges.**

By the Board:

This case now comes up for consideration of opposer's motion for summary judgment, filed March 13, 2012. The motion is fully briefed.¹

Background

Applicant seeks registration of SOOGLE, in standard characters, in pertinent part, for "Arranging and coordinating travel arrangements for individuals and groups, namely ... Online trip and travel reservations services ..."²

¹ Applicant's "reply," filed May 7, 2012, has been given no consideration, because a nonmovant is only entitled to file an opposition to a motion, and is not entitled to file a "reply" brief or a surreply. See, Trademark Rule 2.127(a) (after the movant's reply brief, "[t]he Board will consider no further papers in support of or in opposition to a motion"); TBMP § 502.02(b) (3d ed. 2011).

² Application Serial No. 77909572, filed January 11, 2010, based on claimed first use dates of January 17, 2006. The application indicates that "[t]he wording 'SOOGLE' has no meaning in a foreign language." The description of services in its

In its amended notice of opposition, opposer alleges prior use and registration³ of GOOGLE, and variations thereof, for an Internet search engine and a wide variety of other goods and services, including business listings and "travel-related" and "transportation-related" services. Several of opposer's pleaded registrations are over five years old. As grounds for opposition, opposer alleges that use of applicant's mark is likely to cause confusion with, and dilute, opposer's marks and falsely suggest a connection with opposer, and that applicant is not the owner of its involved mark. In its answer, applicant admits that opposer is the owner of its pleaded registrations, that GOOGLE is a "coined term," "distinctive" and "famous," and that opposer has priority. Answer to Amended Notice of Opposition ¶¶ 3, 6, 11, 15, 20.

Applicant denies the remaining salient allegations in the notice of opposition.

The Parties' Contentions

entirety is "Arranging and coordinating travel arrangements for individuals and groups, namely, destinations stays, honeymoons, family vacations, and destination weddings; Arranging for travel visas, passports and travel documents for persons traveling abroad; Arranging travel tours; Booking of seats for travel; Coordinating travel arrangements for individuals and for groups; Escorting of travellers; Escorting travellers; Online trip and travel reservation services; Organisation (sic) of travel."

³ Registration Nos. 2806075, 2884502, 2954071, 3140793, 3570103, 3725612, 3962604, 3979983, 3990185, 4016470, 4058966, 4120012 and 4123471. Opposer also alleges ownership of application Serial Nos. 77082272, 7764401, 78698285 and 78941798.

Opposer seeks summary judgment on its claims of priority and likelihood of confusion, and that applicant is not the owner of the involved mark, relying in large part on the Declaration of Johanna Sistek ("Sistek Dec."), opposer's in-house trademark counsel. Ms. Sistek declared that opposer has used GOOGLE extensively since 1997 in connection with its search engine. Sistek Dec. ¶ 2. In addition, opposer has used the GOOGLE mark in connection with the Google Maps service since 2004, through which opposer "has provided travel and transportation information, such as maps, business locations, and trip planning," and has used GOOGLE for the Google Earth service since 2005, which enables "users to plan tours or engage in virtual sightseeing." Id. ¶¶ 4-5. Opposer argues that its mark is famous, that the parties' marks create similar overall commercial impressions, that the parties' services and channels of trade are similar or related, that there has been actual confusion and that applicant is engaged in a "bad faith effort to cash in on the success of the GOOGLE mark"

Applicant introduces no evidence in opposition to opposer's motion, with the exception of unauthenticated corporate minutes, and a "stock ledger and certificates," none of which appear to relate to applicant's involved mark. Applicant argues, however, that there are genuine disputes

as to material facts remaining for trial. Specifically, applicant argues that the "cadence," "pronunciation" and "the consumer's perception" of the parties' marks are dissimilar, especially because certain of opposer's pleaded registrations include color claims, and because applicant adopted its mark "based on its sound and meaning in Chinese." Applicant also points out that opposer does not rely on survey evidence. Applicant claims that its customers "are exclusively from mainland China with little English language ability," and that therefore the parties' services and channels of trade are distinct. According to applicant, opposer's purported evidence of actual confusion is unreliable and applicant "had every right" to seek registration of its mark, "[e]ven if Applicant was already familiar with" opposer.

Decision

Summary judgment is only appropriate where there are no genuine disputes as to any material facts, thus allowing the case to be resolved as a matter of law. Fed. R. Civ. P. 56(a). The party seeking summary judgment bears the burden of demonstrating the absence of any genuine dispute of material fact, and that it is entitled to a judgment under the applicable law. See Celotex Corp. v. Catrett, 477 U.S. 317, 323 (1986); Sweats Fashions, Inc. v. Pannill Knitting Co. Inc., 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir.

1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the non-moving party. See Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); Olde Tyme Foods, Inc. v. Roundy's, Inc., 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992).

The evidence on summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. Lloyd's Food Products, Inc. v. Eli's, Inc., 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); Opryland USA, supra. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. See Lloyd's Food Products, 25 USPQ2d at 2029; Olde Tyme Foods, 22 USPQ2d at 1542.

Standing and Priority

There is no genuine dispute as to any material fact relating to either standing or priority. Opposer's pleaded registrations establish both. See, e.g., Cunningham v. Laser Golf Corp., 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000) (party's ownership of pleaded registration establishes standing); Penguin Books Ltd. v. Eberhard, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing King Candy Company v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108,

110 (CCPA 1974)) (priority not at issue where opposer introduces registration into evidence). Furthermore, applicant concedes that opposer owns its pleaded registrations and has priority. Answer to Amended Notice of Opposition ¶¶ 3, 20.

Likelihood of Confusion

"We determine likelihood of confusion by focusing on ... whether the purchasing public would mistakenly assume that the applicant's goods originate from the same source as, or are associated with," opposer's goods. In re Majestic Distilling Co., Inc., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In considering the question on a motion for summary judgment, we analyze all probative facts in evidence which are relevant to the thirteen likelihood of confusion factors set forth in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), as well as whether there are genuine disputes as to any of these factors which would be material to a decision on the merits. In this case, opposer has introduced evidence concerning the fame of opposer's mark, the similarity between the parties' services and channels of trade, the similarity between the parties' marks, actual confusion and applicant's intent.

Turning first to the alleged fame of opposer's mark, it is well-settled that where fame exists, it "plays a 'dominant role in the process of balancing the DuPont

factors,' ... and '[f]amous marks thus enjoy a wide latitude of legal protection.'" Bose Corp. v. QSC Audio Products, Inc., 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002) (quoting Recot, Inc. v. Benton, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). Indeed, a strong mark "casts a long shadow which competitors must avoid." Kenner Parker Toys, Inc. v. Rose Art Industries, Inc., 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Furthermore, fame remains "a dominant factor in the likelihood of confusion analysis ... independent of the consideration of the relatedness of the goods." Recot, 214 F.3d 1322, 54 USPQ2d at 1898. In fact, "when a product reaches the marketplace under a famous mark, special care is necessary to appreciate that products not closely related may nonetheless be confused as to source by the consumer because of the fame of the mark." Bose Corp., 293 F.3d 1367, 63 USPQ2d at 1310.

While consumer surveys may provide direct evidence of fame, they are not necessary, and to the extent that applicant argues that the absence of a survey constitutes a genuine dispute as to a material fact, applicant is incorrect. Indeed, "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial

awareness have been evident." Id., 63 USPQ2d at 1305.

Other relevant factors include "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." Coach Services Inc. v. Triumph Learning LLC, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Here, opposer has introduced substantial evidence that GOOGLE is an exceedingly famous mark. Specifically, prior to applicant's claimed date of first use:⁴

- opposer's U.S. revenue exceeded \$342 million in 2002, exceeded \$1 billion in 2003, exceeded \$2.1 billion in 2004 and exceeded \$3.7 billion in 2005; Sistek Dec. ¶ 27 and Ex. 22;
- Interbrand Consultancy found the GOOGLE mark to be the "single most popular brand" in 2002, 2003 and 2005; id. ¶ 25;
- in 2001, PC Magazine listed opposer among the "Top 100 Web Sites;" id. Ex. 19;
- in 2006, opposer made Time magazine's list of "25 Sites We Can't Live Without;" id. Ex. 19;
- opposer's mark was mentioned in articles in the New York Times, USA Today, Wall Street Journal, Washington Post, and in reports by Reuters and United Press International, among many others; id.;

⁴ Applicant submits no evidence supporting its claimed date of first use.

- opposer's mark was mentioned in broadcasts on CNBC, CNN, NPR and Fox News; id.;
- in 2005 opposer was ranked No. 2 and in 2006 opposer was ranked No. 1 on Wired magazine's "The Wired 40" list, which identifies businesses with "strategic vision, global reach, killer technology," and the publication in 2006 described opposer as follows: "Less cuddly but more profitable than ever, the monster from Mountain View has rivals but no peers ...;" id. Ex. 21;
- a 2005 CNN poll found that "[t]he search engine Google is the most significant development in the 15-year history of the World Wide Web;" id.; and
- in 2006 Penn, Schoen and Berland Associates indicated that GOOGLE was the "best known brand name" in the United States. Id.

Since applicant's claimed date of first use and filing date, opposer's fame has only grown. In fact,

- in 2007, Millward Brown, a market research firm, indicated that GOOGLE was the world's "most powerful brand," and a Reuters article about the ranking stated that the ranking "underscores how quickly the Web search leader has become an everyday name;" id.;
- Nielsen Wire found that in November 2011, GOOGLE was "the most-visited Web brand" in the United States, ahead of second place Facebook; id. Ex. 17;
- the 2011 Interbrand Best Global Brands survey ranked GOOGLE No. 4,

behind only COCA COLA, IBM, and MICROSOFT, and ahead of GENERAL ELECTRIC and MCDONALD'S, stating: "[w]ith a 27 percent increase in brand value in the past year, Google's position as one of the world's pre-eminent brands is growing and nothing seems capable of stopping it;" id. Ex. 20;

- The Meriam-Webster dictionary indicates that the origin of the word "Google" is a "trademark for a search engine," and defines the verb "Google" as "to use the Google search engine to obtain information about (as a person) on the World Wide Web;" Declaration of Jedediah Wakefield, one of opposer's attorneys ("Wakefield Dec.") Ex. 5; and
- Opposer's U.S. revenue exceeded \$6 billion in 2006, exceeded \$8.6 billion in 2007, exceeded \$10.6 billion in 2008, exceeded \$11.1 billion in 2009, exceeded \$14 billion in 2010 and exceeded \$17.4 billion in 2011. Sistek Dec. ¶ 27.

In addition, applicant concedes that GOOGLE is famous.

Answer to Amended Notice of Opposition ¶ 15.

In short, the evidence of record establishes that opposer's GOOGLE mark is famous, and significantly so.

Moreover,

[t]he law has clearly been well settled for a longer time than this court has been dealing with the problem to the effect that the field from which trademarks can be selected is unlimited, and there is therefore no excuse for even approaching the well-known trademark of a competitor, that to do so raises "but one inference - that of gaining advantage from the wide

reputation established by appellant in the goods bearing its mark," and that all doubt as to whether confusion, mistake, or deception is likely is to be resolved against the newcomer, especially where the established mark is one which is famous and applied to an inexpensive product bought by all kinds of people without much care.

Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281, 1285 (Fed. Cir. 1984) (quoting Planters Nut & Chocolate Co. v. Crown Nut Co., Inc. 305 F.2d 916, 134 USPQ 504, 511 (CCPA 1962)); see also, Kenner Parker Toys, 963 F.2d at 350, 22 USPQ2d at 1456. In short, this du Pont factor weighs heavily in opposer's favor.

Turning next to the similarity of the parties' marks, we consider the similarities and dissimilarities of the parties' marks in appearance, sound, meaning, and commercial impression. Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). The test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in their entireties that confusion as to the source of the services 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, 108 (TTAB 1975). As the fame

of a mark increases, and here opposer's marks enjoy significant fame, the degree of similarity between the marks necessary to support a conclusion of likely confusion declines. Bose Corp. v. QSC Audio Products Inc., 293 F.3d 1367, 63 USPQ2d at 1311-12.

In this case, the parties' marks are identical but for a single letter, and they therefore look and sound quite similar, and rhyme. See, Interstate Brands Corp. v. McKee Foods Corp., 53 USPQ2d 1910, 1913 (TTAB 2000) ("Both marks are highly similar in sound, since YO-YO's directly rhymes with HOHOs. Similarity in either form, spelling or sound alone may be sufficient to support a finding of likelihood of confusion."). The similarities between the marks are more significant in this case than in many others, because here, as applicant admits, GOOGLE is "a coined term," and there is no evidence that SOOGLE has any meaning. Answer to Amended Notice of Opposition ¶ 6. To the extent that applicant now argues that SOOGLE has significance or a particular meaning in Chinese, there is no evidence supporting this argument, and in any event, applicant's involved application contradicts any such argument, as it indicates that SOOGLE "has no meaning in a foreign language." Finally, while certain of opposer's pleaded registrations include color claims, most do not, and GOOGLE is registered in standard character form for a wide variety

of goods and services. This factor therefore also weighs heavily in opposer's favor.

With respect to the similarity of the parties' services and channels of trade, we must compare the services identified in applicant's application to those opposer offers under its marks. Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002). Here, applicant seeks registration of its mark for, *inter alia*, "Arranging and coordinating travel arrangements" and "Online trip and travel reservation services." And applicant admits that "a customer can learn information about travel," "travel destinations" and "arranging for travel visas" using opposer's services. Wakefield Dec. Ex. 3 (applicant's responses to opposer's Requests for Admission Nos. 27-29). Applicant further admits that opposer's services "include travel planning services" and "map services," and that customers can use opposer's services for "online trip reservations," "travel reservations," "organization of travel" and "arranging and coordinating travel arrangements." Id. (applicant's responses to opposer's Requests for Admission Nos. 30-35). In other words, applicant admits that the parties' services are at the very least related. Opposer's evidence also makes clear that the parties' services are at least related, as opposer offers, *inter alia*, "travel and transportation information ...

trip planning," and images "enabling users to plan tours or engage in virtual sightseeing." Sistek Dec. ¶¶ 4, 5, 9, 11, 12.

Applicant's argument that its customers "are exclusively from mainland China with little English language ability" is misplaced, because the identification of services in the involved application is not restricted in this manner. Where, as here, applicant seeks a geographically unrestricted registration, the Board is constrained to consider likelihood of confusion in terms of nationwide markets. Bank of America National Trust & Savings Association v. The First National Bank of Allentown, 220 USPQ 892, 897 (TTAB 1984); Giant Food Inc. v. Nations Foodservice, Inc., 214 USPQ 641, 644 (TTAB 1982), reversed for other reasons, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Furthermore, because applicant's recitation of services is not limited to Chinese-speaking individuals, the Board cannot consider this asserted limitation.

The authority is legion 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 purchasers to which sales of the goods are directed.

Octocom Systems, Inc. v. Houston Computers Services, Inc.,
918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Accordingly, not only is there no genuine dispute as to any material fact regarding the similarity of the parties' services (they are at least related), but there is also no genuine dispute of material fact regarding the channels of trade for the parties' services or the classes of consumers. We must presume that those too are the same. Id. ("Because [applicant] seeks an *unrestricted* registration, such evidence as there is of a specific class of customers did not relate to a *material* fact.") (emphasis in original); see also, Hewlett-Packard, 62 USPQ2d at 1005; Genesco Inc. v. Martz, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). These factors also weigh in opposer's favor.

Turning finally to opposer's purported evidence of actual confusion and applicant's bad faith, we note

applicant's objection to the reliability of opposer's actual confusion evidence, and applicant's assertion (albeit without supporting evidence) that it did not act in bad faith. In any event, it is well-settled that the absence of evidence of actual confusion, or bad faith intent, does not raise a genuine dispute as to any material fact. "The test is likelihood of confusion not actual confusion ... It is unnecessary to show actual confusion in establishing likelihood of confusion." Weiss Associates, Inc. v. HRL Associates, Inc., 902 F.2d 1546, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990); Apple Computer v. TVNET.net, Inc., 90 USPQ2d 1393, 1397-98 & n.7 (TTAB 2007) ("applicant's arguments regarding the lack of actual confusion and its good faith adoption of its VTUNES.NET mark do not raise genuine issues of material fact that preclude entry of summary judgment").

Weighing all of the factors together, and after a careful review of all evidence of record and the parties' arguments, only some of which have been specifically addressed here, we find that there are no genuine disputes of material fact that a likelihood of confusion exists between opposer's marks and applicant's involved mark for the parties' respective services. Indeed, the fame of opposer's mark, and the similarities between the parties'

marks, services and channels of trade all weigh in favor of a finding of likelihood of confusion.

Conclusion

Because we find, based on the record herein and the applicable law, that there is no genuine dispute as to any material fact and that opposer has established its priority and likelihood of confusion as a matter of law, opposer's motion for summary judgment is hereby **GRANTED**. Accordingly, judgment is entered against applicant, the opposition is sustained and registration to applicant is refused.⁵

⁵ Because the opposition is sustained on the ground of priority and likelihood of confusion, there is no need to consider whether opposer is entitled to summary judgment on its claim that applicant is not the owner of the involved mark.