

This Opinion is not a
Precedent of the TTAB

Mailed: May 19, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Carole A. Faulkner and Christopher A. Faulkner
v.
Gary Domel

Opposition No. 91210234
to application Serial No. 85703135

Andy Nikolopoulos of David Goodman & Madole PC for Carole A. Faulkner and Christopher A. Faulkner.

Robert Voigt of Winstead PC for Gary Domel.

Before Kuhlke, Cataldo and Adlin,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

Gary Domel (“Applicant”) filed an application to register on the Principal Register the mark CI HOST, in standard characters with a disclaimer of “HOST” for

designing and implementing web sites for others on a global computer information network; hosting the web sites of others on a computer server for a global computer network; graphic art design; computer software design for others; and computer consultation

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in Class 42.¹

Carole A. Faulkner and Christopher A. Faulkner (collectively, “Opposers”) filed a notice of opposition to the registration of Applicant’s mark on the grounds of likelihood of confusion pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), and fraud, based on the allegation that Applicant knowingly made false statements of material fact, upon which the Examining Attorney relied, in connection with the involved application. In addition, on the ESTTA cover sheet comprising part of their notice of opposition, Opposers list as a third ground for opposition “Same as Opposers’, Carole A. Faulkner, individually and d/b/a C I Host, and Christopher Faulkner, individually and d/b/a C I Host, business entity name and common law trademark.”² We interpret this as an amplification of their assertion of likelihood of confusion as a ground for opposition.

Applicant, in his Answer, denied the salient allegations in the Notice of Opposition. In addition, Applicant asserted certain affirmative defenses, but did not pursue them at trial. Accordingly, they are deemed waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

¹ Serial No. 85703135 was filed on August 14, 2012, based upon Section 1(a) of the Trademark Act, 15 U.S.C. §1051(a), asserting April 1, 1995 as the date of first use of the mark anywhere and in commerce in connection with the services.

² 1 TTABVUE 2. Record citations are to TTABVUE, the Trademark Trial and Appeal Board’s publically available docket history system. *See Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014).

Evidentiary Issue

The parties submitted numerous exhibits with their notice of opposition and answer. However, with one exception not applicable here, exhibits to pleadings are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence. Trademark Rule 2.122(c), 37 CFR §2.122(c). *See, e.g., Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004). Accordingly, the exhibits submitted with the pleadings will be given no consideration.

The Record

In view of the foregoing, the record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), Applicant's application file. In addition, Opposers introduced the following testimony and evidence:

by notice of reliance pursuant to Rule 2.122(e),
TESS printout showing Opposers' now Cancelled Registration No. 2893070 for the C I Host mark;
TESS printout showing Opposers' current application Serial No. 85780225 for the C I Host mark;
GoDaddy.com printout showing opposer's ownership of the domain name "cihost.com";
Opposers' C I Host Press Releases and Articles;
Opposers' Texas Franchise Tax Public Information Reports, and Assumed Name Certificate;
Opposers' C I Host Copyright Information and Registrar Accreditations Agreement with ICANN;
Texas Secretary of State formation documents for C I Host, Inc.;
Texas Secretary of State formation documents for C I Host Corp.; and

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California Secretary of State formation documents for C I Host Corp.;³

by notice of reliance pursuant to Rule 2.120 (j), Applicant's Responses to Opposers' First Set of Interrogatories;⁴

by notice of reliance pursuant to Rule 2.120 (j), Transcript of discovery deposition of Applicant Gary Domel;⁵

by notice of reliance pursuant to FRE 201(b), "Request for Judicial Notice" of Ch. 9 of the Texas Business & Commerce Code;⁶ and

Transcript of trial testimony of Opposer Carole A. Faulkner.⁷

Applicant did not submit any testimony or evidence. Only Opposers filed a trial brief.

Issues in this Proceeding

As discussed above, Opposers, in their notice of opposition, plead likelihood of confusion and fraud as grounds for opposition. In their trial brief, Opposers further advance arguments that Applicant abandoned the mark in the involved application. However, abandonment was not pleaded by Opposers, nor is there any indication in the record that the issue of abandonment was tried by implied consent. In addition, we would be remiss not to observe that the record of this case clearly indicates there exists a history between the

³ 11 TTABVUE.

⁴ 9 TTABVUE.

⁵ 10 TTABVUE.

⁶ 12 TTABVUE.

⁷ 13 TTABVUE.

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parties. Indeed, Applicant's assertion of ownership rights in the mark CI HOST appears to stem from the terms of an agreement between the parties underlying his foreclosure on a loan to Opposers or entities controlled by Opposers.⁸ Again, however, the issue of ownership of the CI HOST mark was not pleaded by Opposers and there is no clear indication that the issue of ownership was tried by implied consent. We cannot infer from Applicant's silence that he consents to trial of unpleaded issues. *See, e.g., Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008) (unpleaded claims were not tried by express or implied consent of the parties such that pleadings could be treated as amended pursuant to Fed. R. Civ. P. 15(b)). Finally, and significantly, the types of documents upon which we might decide the issue of ownership were not properly made of record in this proceeding.

Accordingly, Opposers' arguments directed toward abandonment and ownership of the CI HOST mark will be given no consideration except to the extent that they serve to amplify arguments based on the pleaded grounds of likelihood of confusion and fraud.

Standing

Standing is a threshold issue that must be proved in every *inter partes* case. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). In order to meet the standing requirement, a plaintiff need only show that it has a real interest, *i.e.*, a personal stake, in the outcome of the proceeding. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023,

⁸ 4 TTABVUE 3-5.

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1026 (Fed. Cir. 1999); and *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2012, 2023-24 (Fed. Cir. 1987).

Opposers have proven they have made use of the term CI HOST as a mark to identify various Internet hosting and related computer services. Opposers' reasonable belief that Applicant's application for the identical mark for various computer and Internet related services is likely to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Trademark Act is sufficient to show that Opposers have a real interest in this proceeding and, therefore, have standing. *Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) ("Petitioner has established his common-law rights in the mark DESIGNED2SELL, and has thereby established his standing to bring this proceeding."); *Syngenta Crop Prot. Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 (TTAB 2009) (testimony that opposer uses its mark "is sufficient to support opposer's allegations of a reasonable belief that it would be damaged ..." where opposer alleged likelihood of confusion).

Priority

In his involved application, Applicant asserts April 1, 1995 as the date of first use of the CI HOST mark anywhere and in commerce. However, Applicant has not introduced any testimony or evidence to support his assertion of the first use dates in his application. In his discovery responses, Applicant appears to assert that he acquired rights in the CI HOST mark from predecessors-in-interest, namely, Opposers and/or entities controlled by

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Opposers, through foreclosure and that Opposers' dates of first use inure to his benefit.⁹ However, in his discovery deposition Applicant states "Be real clear. I – I have never publicly used the trademark"¹⁰ and provides conflicting and otherwise unsupported testimony regarding the extent, if any, to which Opposers are his predecessors-in-interest such that he may base his first use dates on their use of the CI HOST mark.¹¹ Further, Applicant has not properly made of record any documentary evidence in support of his contentions. In addition, Applicant's assertions that he is the successor-in-interest to Opposers or entities controlled by them are unequivocally denied by Opposer Carole A. Faulkner in her trial testimony.¹² Thus, we find inadequate support for Applicant's assertion of April 1, 1995 as his date of first use of the CI HOST mark.

Inasmuch as Applicant has not established use of his mark in connection with his services prior to the filing date of his application, the earliest date upon which Applicant may rely for priority purposes is August 14, 2012, which is his constructive use (filing) date. *Syngenta*, 90 USPQ2d at 1119 ("applicant may rely without further proof upon the filing date of its application as a 'constructive use' date for purposes of priority.").

⁹ 9 TTABVUE 6-8.

¹⁰ 10 TTABVUE 32.

¹¹ 10 TABVUE 29-68.

¹² 13 TTABVUE 20-71.

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We therefore must determine whether Opposers have established proprietary rights in their mark CI HOST prior to August 14, 2012. Because Opposers have not pleaded ownership of any live and subsisting registrations, Opposers must rely on their common-law use to establish priority.¹³

In order for a plaintiff to prevail on a claim of likelihood of confusion based on its ownership of common law rights in a mark, the mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981). “Thus, even if something is *used* as a trademark, if it is not distinctive, the user does not have a trademark because he has no existing trademark rights.” *Id.* at 44.

Under the rule of *Otto Roth*, a party opposing registration of a trademark due to a likelihood of confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through “whatever other type of use may have developed a trade identity.” *Otto Roth*, 640 F.2d at 1320, 209 USPQ at 43. The *Otto Roth* rule is applicable to trademark registration cancellation proceedings as well.

¹³ The filing date of Opposers’ pleaded application Serial No. 85723638 is September 19, 2012, which is subsequent to the filing date of Applicant’s involved application. In addition, Opposers’ pleaded Registration No. 2893070, cancelled on May 13, 2011 prior to the commencement of this proceeding, is not evidence of anything except that it issued. *See* TBMP §704.03(b) and cases cited therein. *See also Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Any benefits conferred by the registration, including the evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration expired. *See, e.g., Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973).

As a result, neither Opposers’ pleaded application nor their pleaded registration may form the basis for Opposers’ claim of priority.

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Towers v. Advent Software Inc., 913 F.2d 942, 16 USPQ2d 1039, 1042 (Fed. Cir. 1990). Accordingly, a party opposing the registration of another's mark on the basis of likelihood of confusion with its own unregistered mark must establish that the unregistered mark is distinctive of its goods or services either inherently or through the acquisition of secondary meaning. *Id.*

In this case, neither party addressed the issue of the distinctiveness of Opposers' unregistered CI HOST mark. Rather, it appears that because both parties purport to use the designation CI HOST as a mark, they view it as a distinctive mark, and the question of lack of distinctiveness never occurred to either. Inasmuch as the parties have treated their marks as being inherently distinctive, and have viewed the issue of priority as turning on when each party first began using the mark CI HOST, we will do the same in making our determination. *See, e.g., Giersch*, 90 USPQ2d at 1023 ("Respondent has not raised an issue as to the distinctiveness of petitioner's mark or otherwise put petitioner on notice of this defense, and therefore we find that the mark is distinctive.") (citing *Wet Seal Inc v. FD Mgmt., Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (absent argument or evidence from applicant, opposer's mark deemed distinctive)); *Chicago Corp. v. N. Am. Chicago Corp.*, 20 USPQ2d 1715, 1717 n. 5 (TTAB 1991) (rejecting applicant's argument that opposer failed to prove that its mark was distinctive where applicant failed to plead the issue or introduce evidence of non-distinctiveness).

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In her testimony, Opposer Carole A Faulkner testifies that she and Opposer Chris Faulkner, individually and as CI HOST, Inc. and CI HOST, Corp., began using CI HOST as a mark as early as 1995 in connection with web site design and hosting websites of their web design customers.¹⁴ Ms. Faulkner further testifies that Opposers have continuously used CI HOST as a mark, first to identify web hosting and design services, and later in connection with additional Internet-based services.¹⁵ Ms. Faulkner also testifies that she owns the Internet domain name cihost.com; that Opposer Chris Faulkner is regarded as an expert in the field of Internet hosting and has written a number of articles on the subject; that Opposers have used and promoted the CI HOST mark for 20 years, and that such promotions include NASCAR events, world boxing matches, Internet banner advertisements, and television advertisements.¹⁶ In support of her testimony, Ms. Faulkner has identified and made of record copies of advertisements for services provided by Opposers and their corporate entities under the mark CI HOST, including one from 1999, a press release dated October 9, 2006 naming CI HOST the ninth leading web-hosting company in the world and including a quote from Opposer Chris Faulkner, and additional articles and press releases

¹⁴ 13 TTABVUE 12.

¹⁵ 13 TTABVUE 12-14.

¹⁶ 13 TTABVUE 18-20.

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concerning Opposers' and their corporate entities' use of CI HOST as a mark from 2000, 2002, 2007 and 2008.¹⁷

The testimony of Ms. Faulkner establishes that Opposers, and/or corporate entities controlled by Opposers, began using the common law mark CI HOST in connection with web design and hosting services in 1995, and that the mark has been used continuously since then. In that regard, it is settled that oral testimony, even of a single witness, if "sufficiently probative," may be sufficient to prove priority. *Powermatics, Inc. v. Glebe Roofing Products Co.*, 341 F.2d 127, 144 USPQ 430 (CCPA 1965); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007). In this case, Ms. Faulkner's testimony is not "characterized by contradictions, inconsistencies and indefiniteness," but rather carries with it "conviction of its accuracy and applicability." *B.R. Baker Co. v. Lebow Bros.*, 150 F.2d 580, 66 USPQ 232 (CCPA 1945). *See also National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1993) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not been contradicted). As indicated, Applicant has not introduced any testimony or

¹⁷ 13 TTABVUE 138-158.

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evidence to cast doubt upon the accuracy of Opposers' assertion of 1995 as a date of first use based upon this testimony.¹⁸

The accompanying documentary exhibits further support Opposers' use of CI HOST since as early as 1999. Because Opposers do not provide an exact date in 1995 that they began using the CI HOST mark, for purposes of determining priority of use, Opposers' date of first use of the mark CI HOST is construed as December 31, 1995. *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 213 USPQ 597, 598 n.5 (TTAB 1982) (documentary evidence showed first use in 1977, the month and day were unknown, therefore, the Board could not presume any date earlier than the last day of the proved period). *See also Osage Oil & Transportation, Inc. v. Standard Oil Co.*, 226 USPQ 905, 911 n.22 (TTAB 1985) (evidence established first use in 1968-1969, therefore December 31, 1969 is date of first use).

As a result, we find on this record that Opposers have established use of the CI HOST mark as early as December 31, 1995, and that such use is prior to Applicant's constructive first use date of August 14, 2012.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476

¹⁸ Indeed, as discussed above, Applicant acknowledges use by Opposers of CI HOST as a mark as early as 1995 in his own assertions that Opposers are his predecessors-in-interest.

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F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

We turn to the first *du Pont* factor, i.e., whether Opposers' mark and Applicant's mark are similar or dissimilar when viewed in their entireties in terms of appearance, sound, connotation and overall 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). There is no dispute but that the parties' marks, CI HOST, are identical, which strongly supports a finding of likelihood of confusion. Furthermore, "even when goods or services are not competitive or intrinsically related, the use of identical marks can lead to an assumption that there is a common source." *Id.* at 1689. *See Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981) (When both parties are using or intend to use the identical designation, "the relationship between the goods on which the parties use their marks need not be as great or as close as in the situation where the marks are not identical or strikingly similar").

With respect to the parties' services, it is well-established that the goods or services of the parties need not be similar or competitive, or even offered through the same channels of trade, to support a holding of likelihood of confusion. It is sufficient that the respective goods or services of the parties are related in some manner, and/or that the conditions and activities surrounding the marketing of the goods or services are such that they would

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or could be encountered by the same persons under circumstances that could give rise to the mistaken belief that they originate from the same source. See *Hilson Research, Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). The issue, of course, is not whether purchasers would confuse the goods or services, but rather whether there is a likelihood of confusion as to the source thereof. *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984).

Opposer, Carole Faulkner, testifies that Opposers provide the following services under the CI HOST mark:

We do implementation and installation of the software on the colocation machines and the dedicated services as we need it. And are -- we have -- provide technical support for the equipment. We do web design and implementation, search engine optimization. It's a lot broader now than it was in 1999, on that last thing that you read. It's -- we do web hosting for U.S. customers and international, I have both. Let's see, web hosting -- creation of the web sites and web designs.¹⁹

As identified in his application, Applicant's services are

designing and implementing web sites for others on a global computer information network; hosting the web sites of others on a computer server for a global computer network; graphic art design; computer software design for others; and computer consultation.²⁰

¹⁹ 13 TTABVUE 8-9.

²⁰ We observe that Applicant's recitation of services is identical to the Class 42 services recited in CI HOST, Corp.'s cancelled Registration No. 2893070.

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Opposers have introduced testimony that they provide, *inter alia*, web site design and implementation, and web site hosting.²¹ Thus, as recited, the services in the involved application are identical in part to the services Opposers provide under their common-law CI HOST mark.²²

Because the services identified in the application and provided by Opposers are in-part identical, we must presume that the channels of trade and classes of purchasers are the same. *See 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”).

As a result, the second and third *du Pont* factors also strongly support a finding of likelihood of confusion.

²¹ 11 TTABVUE 46-63; 13 TTABVUE 8-9, 139-156.

²² We need not make a determination as to the relatedness of Applicant’s and Opposers’ remaining services, as it is sufficient for a finding of likelihood of confusion if relatedness is established for any item encompassed by the recitation of services within a particular class in the involved application. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981); *Inter IKEA Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1745 (TTAB 2014); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011), judgment set aside on other grounds, slip op. 91118482 (TTAB Jan. 22, 2014); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1847 n.9 (TTAB 2004).

Conclusion

We have carefully considered all of Opposers' testimony and evidence pertaining to standing, priority of use and the relevant *du Pont* factors, as well as all of the parties' arguments with respect thereto, including any evidence and arguments not specifically discussed in this opinion. Applicant failed to introduce any evidence whatsoever.

We conclude that Opposers have established priority of use and that consumers familiar with Opposers' services under their common law CI HOST mark would be likely to believe, upon encountering Applicant's CI HOST mark for its in-part identical services, that the parties' services originate with or are associated with or sponsored by the same entity. In making our determination, we have balanced the relevant *du Pont* factors. The factors of the identity of the marks and the identity in part of the services and presumed identity in trade channels and consumers weigh strongly in Opposers' favor.

Because we have found that there is a likelihood of confusion between Opposers' mark and Applicant's mark as applied to their respective services, we do not need to decide Opposers' fraud claim.

Decision: The opposition is sustained and registration to Applicant is refused.