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Filing date: **03/28/2014**

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

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|------------------------|--|
| Proceeding | 91212665 |
| Party | Defendant Rhapsody International Inc. |
| Correspondence Address | GIA L CINCONI KILPATRICK TOWNSEND & STOCKTON LLP TWO EMBARCADERO CENTER, 8TH FLOOR SAN FRANCISCO, CA 94111-3833 UNITED STATES mmchugh@kilpatricktownsend.com;vcordial |
| Submission | Reply in Support of Motion |
| Filer's Name | Gia L. Cincone |
| Filer's e-mail | gcincone@kilpatricktownsend.com, ltan@kilpatricktownsend.com |
| Signature | /Gia L. Cincone/ |
| Date | 03/28/2014 |
| Attachments | Reply on Motion to Suspend.pdf(3947603 bytes) |

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

RYAN LESTER,

Opposer,

v.

RHAPSODY INTERNATIONAL INC.,

Applicant.

Opposition No. 91212665

Serial No. 85/804,778

Mark: NAPSTER

**APPLICANT'S REPLY BRIEF IN
SUPPORT OF MOTION TO SUSPEND
OPPOSITION PROCEEDING PENDING
OUTCOME OF CIVIL ACTION**

Applicant Rhapsody International Inc. has moved to suspend this opposition proceeding in light of the civil action between the parties now pending in the Northern District of California, *Rhapsody International Inc. v. Lester, et al.*, N.D. Cal. Case No. CV13-5489 CRB (the "Civil Action"). Opposer Ryan Lester asserts that the Civil Action is "unrelated" to this opposition proceeding. This claim is demonstrably false.

1. Rhapsody's NAPSTER Mark Is Registered And In Use

Lester asserts, repeatedly, that Rhapsody's NAPSTER mark "is not registered at the U.S. Patent and Trademark Office and is not being used." (*E.g.*, Opp. at 2.) This is incorrect.

As set forth in Rhapsody's motion to suspend and in its complaint in the Civil Action, Rhapsody is the owner of numerous registrations for its NAPSTER mark, which have been renewed with the appropriate declarations of use. Those registrations include the following:

| Trademark | Reg. No. / Date | Class / Products | Use / Renewal |
|------------------|------------------------|--|---|
| NAPSTER | 3,055,515 1/31/2006 | Class 9: Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing text, data, and audio files; computer software for use in organizing, transmitting, manipulating, and reviewing text, data, and audio files on portable and handheld digital electronic devices | 10/19/2003 Section 8 Declaration of Use submitted 6/25/2012 |
| NAPSTER | 3,054,773 1/31/2006 | Class 9: Computer software for use in organizing, transmitting, manipulating, and reviewing audio, video, and data files on portable and handheld digital electronic devices | 10/16/2003 Sections 8/15 Declaration of Use submitted 11/7/2011 |
| NAPSTER | 2,841,431 5/11/2004 | Class 9: computer software for the transmission of audio, graphics, text, and data over communications networks; computer software for the streaming transmission of audio, video, graphics, text and data over communication networks; computer software for storage of audio, video, graphics, text and data on communications networks users; computer software for secure, encrypted electronic transfer of audio, video, graphics and data over communications networks; Class 42: licensing of intellectual property, computer services, namely, providing customized webpages featuring user-defined information, which includes search engines and online web links to news, weather, current events, reference materials, and customized email messages, all in a wide range of user-defined fields; computer services, namely, providing search engines for obtaining data via electronic communications network | 10/29/2003 Sections 8/15 Declaration of Use submitted 5/11/2010 |
| NAPSTER | 2,843,786 5/18/2004 | Class 35: Product merchandising; licensing of computer software and of entertainment products and services; retail store services featuring entertainment products and apparel; retail store services provided via communications networks featuring entertainment products and apparel; Class 38: Electronic transmission of audio and video files via communications networks; providing electronic bulletin boards; chat rooms and community for a transmission of messages among users concerning music, news, current events, entertainment and arts and leisure; Class 41: Providing databases and directories in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; providing information, audio, video, graphics, text and other multimedia content in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; music publishing services; publishing of text, | 10/29/2003 Sections 8/15 Declaration of Use submitted 5/12/2010 |

| | | | |
|--|------------------------|---|---|
| | | graphic, audio and video works via communications networks; matching users for the transfer of music, video, and audio recordings via communications networks; Class 42: Licensing of intellectual property; providing search engines for obtaining data via communications networks | |
| NAPSTER CAT HEAD LOGO | 2,843,405 5/18/2004 | Class 9: Computer software for the transmission of audio, graphics, text, and data over communications networks; computer software for the streaming transmission of audio, video, graphics, text and data over communications networks; computer storage to enable communications among computer or communications network users; computer software for secure, encrypted electronic transfer of audio, video, graphics and data over communications networks; Class 35: Product merchandising; licensing of computer software; retail store services featuring entertainment products and apparel; retail store services provided via communications networks featuring entertainment products and apparel; Class 38: Transmission of audio and video files via communications networks; providing electronic bulletin boards, chat rooms and community for a for the transmission of messages among users concerning music, news, current events, entertainment and arts and leisure; Class 41: Providing databases and directories in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; providing information, audio, video, graphics, text and other multimedia content in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; music publishing services; publishing of text, graphic, audio and video works via communications networks; matching users for the transfer of music, video, and audio recordings via communications networks; Class 42: Licensing of intellectual property; providing search engines for obtaining data via communications networks | 10/29/2003 Sections 8/15 Declaration of Use submitted 5/12/2010 |
| NAPSTER LINKS | 3,309,551 10/9/2007 | Class 9: Computer software, namely, computer software to enable the transmission of audio, graphics, text, and data over communications networks; computer software for the streaming transmission of audio, video, graphics, text and data over communication networks via hyperlinks | 5/1/2006 |

Rhapsody's ownership of these registrations for its NAPSTER mark is part of the file history of its Application Serial No. 85/804,778, which is the subject of this opposition proceeding. *See* Rhapsody's Response to Office Action dated 8/2/2013, attached as Exhibit A.

Moreover, Rhapsody's registrations have been cited by the PTO against Lester's application to register NAPSTER.FM (Serial No. 86/069,735). In its Office Action dated January 7, 2014, the examiner found that NAPSTER and NAPSTER.FM are "nearly identical." As to the services covered by Rhapsody's registrations and Lester's application, the examiner found, "The scope of the registrant's broadly-worded identification encompasses *all methods of* transmission of audio and video, including the applicant's more narrowly listed 'audio and video broadcasting' and 'streaming of' audio services." (Emphasis original.) The examiner concluded that the parties' services are "*legally identical*" (emphasis original), and therefore refused registration of NAPSTER.FM based on likelihood of confusion. A copy of the Office Action is attached as Exhibit B.¹

Thus, Lester's claim that Rhapsody's NAPSTER mark is not registered and is not being used by Rhapsody is baseless.

2. Rhapsody's Filing Of An Intent-To-Use Application Does Not Affect The Outcome Of Rhapsody's Motion To Suspend

In opposing Rhapsody's motion to suspend, Lester also focuses on the fact that Rhapsody's application, the subject of this opposition proceeding, was filed on an intent-to-use basis. That fact is, however, immaterial to the outcome of Rhapsody's motion. The filing of an

¹ Rhapsody has also applied to register NAPSTER MOBILE (Serial No. 78/431,602). That application, which was filed on June 8, 2004, also has priority over Lester's application to register NAPSTER.FM.

intent-to-use application is not an admission of non-use. *ZAO Gruppya Predpriyatij Ost v. Vosk International Co.*, Opp. No. 91168423, 2011 WL 3828709, *24 (TTAB 2011) (“The filing of an intent-to-use application is in no way an admission of non-use.”); *United Industries Corporation v. OMS Investments, Inc.*, Opp. No. 91158240, 2010 WL 4035138, *3 n.7 (TTAB 2010) (same). Contrary to Lester’s argument, this Board cannot conclude, based on Rhapsody’s intent-to-use application, that Rhapsody is not using its NAPSTER mark or that this proceeding is unrelated to the Civil Action. Rhapsody is in fact using its mark, and has renewed its registrations on that basis. Moreover, as discussed below, the standard for suspension is clearly met here.

3. The Civil Action Has A Direct Bearing On This Opposition Proceeding

Lester claims to be the owner of NAPSTER.FM. In his Notice of Opposition in this proceeding, Lester alleges that Rhapsody’s use of its NAPSTER mark will confuse consumers, stating, “[Rhapsody’s] NAPSTER mark so resembles [Lester’s] NAPSTER.FM mark and the goods/services thereof as to likely [sic], when used in connection with the services set forth in [Rhapsody’s] Application, to cause confusion, or to cause mistake, or to deceive.”²

In its First Amended Complaint in the Civil Action, Rhapsody alleges that Lester’s “use and potential registration of Napster.fm has caused and/or will cause a likelihood of confusion among consumers regarding the source of the Napster.fm music streaming service and whether

² Lester’s account of the dealings between the parties (Opp. at 2) is misleading. As alleged in Rhapsody’s First Amended Complaint, when Rhapsody discovered Lester’s infringement, Rhapsody sent a cease and desist letter. Lester originally agreed to stop his use of Napster.fm, but subsequently resumed his use of the infringing domain name and demanded \$775,000.00 from Rhapsody to relinquish the domain. (FAC ¶¶ 27-30.) This is the basis for Rhapsody’s cybersquatting claim in the Civil Action. Rhapsody never “sent an initial offer to Lester . . . to purchase the Napster.fm domain,” nor did Rhapsody push Lester’s counsel to negotiate such a purchase. In fact, Rhapsody’s main focus from the beginning has been to stop Lester’s infringement and dilution of Rhapsody’s trademark.

Rhapsody has sponsored, authorized or is affiliated with the Napster.fm website or its service.” (FAC ¶ 36.)³ Thus, the parties’ allegations of likelihood of confusion are virtually identical.⁴

As set forth in Rhapsody’s motion, the District Court’s resolution of the likelihood of confusion issue will clearly “have a bearing” on the issues before this Board, because Lester also has alleged likelihood of confusion as the basis for his opposition. *See New Orleans Louisiana Saints LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d 1550 (TTAB 2011); *Black Box Corp. v. Better Box Communications Ltd.*, Opp. No. 107,800, 2002 WL 484956 (TTAB 2002). While it is true that this Board is not addressing claims of trademark infringement, it is addressing an allegation of likelihood of confusion – as is the District Court in the Civil Action. Lester simply ignores the authorities cited by Rhapsody in its motion which hold that infringement and registrability are so closely related as to warrant suspension of a Board proceeding in favor of a pending infringement lawsuit.

The only case cited by Lester, *Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 U.S.P.Q.2d 1249 (TTAB 2011), does not support his position. *Zachry* addressed the application of *res judicata* in a Board proceeding where the district court had decided issues of acquired distinctiveness and genericness. In particular, the footnote cited by Lester discusses whether the district court had jurisdiction to decide a counterclaim under Section 37 of the Lanham Act when the mark at issue was not registered. Section 37 is not at issue here, nor does

³ As alleged in Rhapsody’s complaint, Lester effectively admitted that he adopted the Napster.fm domain name in order to take advantage of the fame of Rhapsody’s NAPSTER mark to attract consumers to his site. (FAC ¶ 28.)

⁴ The district judge presiding over the Civil Action has characterized Rhapsody’s claims, on the record, as a “clear-cut case of infringement,” and described Lester’s \$775,000.00 demand as “at least within the realm of possibility of being extortion.” Transcript of 2/21/14 Motion Hearing at 8, 14 (attached as Exhibit C).

Zachry address a situation where allegations of likelihood of confusion are pending before both the district court and this Board. In that circumstance – which is what the Board is facing here – the authorities cited by Rhapsody are clear that this Board should suspend its proceeding pending disposition of the litigation. *See Black Box, supra*, 2002 WL 484956, at *2 (“It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case.”); *see also Arcadia Group Brands Ltd. v. Studio Moderna SA*, Opp. No. 91169226, 2011 WL 3218630 (TTAB Jan. 6, 2011); *New Orleans, supra*, 99 U.S.P.Q.2d 1550 (TTAB 2011); 6 *McCarthy on Trademarks and Unfair Competition* § 23.47 (“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”).

For these reasons, Rhapsody respectfully requests that this proceeding be suspended pending disposition of the Civil Action.

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

Dated: March 28, 2014

By: /s/ Gia L. Cincone
GIA L. CINCONI
Attorneys for Applicant
RHAPSODY INTERNATIONAL INC.

EXHIBIT A

Response to Office Action

The table below presents the data as entered.

| Input Field | Entered |
|--|---|
| SERIAL NUMBER | 85804778 |
| LAW OFFICE ASSIGNED | LAW OFFICE 117 |
| MARK SECTION (no change) | |
| ADDITIONAL STATEMENTS SECTION | |
| PRIOR REGISTRATION(S) | The applicant claims ownership of U.S. Registration Number(s) 2843405, 2843786 |
| CORRESPONDENCE SECTION | |
| ORIGINAL ADDRESS | MARGARET MCHUGH KILPATRICK TOWNSEND & STOCKTON LLP 2 EMBARCADERO CTR FL 8 SAN FRANCISCO California (CA) US 94111-3833 |
| NEW CORRESPONDENCE SECTION | |
| NAME | MARGARET MCHUGH |
| FIRM NAME | Kilpatrick Townsend & Stockton LLP |
| INDIVIDUAL ATTORNEY DOCKET/REFERENCE NUMBER | 94033-859008 |
| STREET | Two Embarcadero Center, 8th Floor |
| CITY | San Francisco |
| STATE | California |
| ZIP/POSTAL CODE | 94111-3833 |
| COUNTRY | United States |
| PHONE | (415) 576-0200 |
| FAX | (415) 576-0300 |

| | |
|---------------------------------------|---|
| EMAIL | mmchugh@kilpatricktownsend.com;vcordial@kilpatricktownsend.com;tmadmin@ |
| AUTHORIZED EMAIL COMMUNICATION | Yes |
| SIGNATURE SECTION | |
| RESPONSE SIGNATURE | /Margaret C. McHugh/ |
| SIGNATORY'S NAME | Margaret C. McHugh |
| SIGNATORY'S POSITION | Attorney of Record, California bar member |
| DATE SIGNED | 08/02/2013 |
| AUTHORIZED SIGNATORY | YES |
| FILING INFORMATION SECTION | |
| SUBMIT DATE | Fri Aug 02 17:49:44 EDT 2013 |
| TEAS STAMP | USPTO/ROA-38.104.128.234- 20130802174944608620-8580 4778-5005d73c76e7efeeecfd 494535793bb4ad98659688e48 b60d1ebf422ea9a979b7-N/A- N/A-20130802171620502093 |

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85804778** has been amended as follows:

CORRESPONDENCE ADDRESS CHANGE

Applicant proposes to amend the following:

Current:

MARGARET MCHUGH
KILPATRICK TOWNSEND & STOCKTON LLP
2 EMBARCADERO CTR FL 8
SAN FRANCISCO
California (CA)
US
94111-3833

Proposed:

MARGARET MCHUGH of Kilpatrick Townsend & Stockton LLP, having an address of
Two Embarcadero Center, 8th Floor San Francisco, California 94111-3833
United States

mmchugh@kilpatricktownsend.com;vcordial@kilpatricktownsend.com;tadmin@kilpatricktownsend.com

(415) 576-0200

(415) 576-0300

The attorney docket/reference number is 94033-859008.

ADDITIONAL STATEMENTS**Claim of Prior Registration(s)**

The applicant claims ownership of U.S. Registration Number(s) 2843405, 2843786, 3054773, and others.

SIGNATURE(S)**Response Signature**

Signature: /Margaret C. McHugh/ Date: 08/02/2013

Signatory's Name: Margaret C. McHugh

Signatory's Position: Attorney of Record, California bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

Mailing Address: MARGARET MCHUGH

Kilpatrick Townsend & Stockton LLP

Two Embarcadero Center, 8th Floor

San Francisco, California 94111-3833

Serial Number: 85804778

Internet Transmission Date: Fri Aug 02 17:49:44 EDT 2013

TEAS Stamp: USPTO/ROA-38.104.128.234-201308021749446

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5793bb4ad98659688e48b60d1ebf422ea9a979b7

-N/A-N/A-20130802171620502093

EXHIBIT B

To: NAPSTER.FM LLC (dmcauley@brundidge-stanger.com)

Subject: U.S. TRADEMARK APPLICATION NO. 86069735 - NAPSTER.FM - 2868TM.870BS

Sent: 1/7/2014 6:47:24 PM

Sent As: ECOM113@USPTO.GOV

Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)
[Attachment - 6](#)
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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86069735

MARK: NAPSTER.FM

86069735

CORRESPONDENT ADDRESS:

CARL I BRUNDIDGE

BRUNDIDGE AND STANGER PLC

2318 MILL RD STE 1020

ALEXANDRIA, VA 22314-6834

CLICK HERE TO RESPOND TO

<http://www.uspto.gov/trademarks/teas/r>

APPLICANT: NAPSTER.FM LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

2868TM.870BS

CORRESPONDENT E-MAIL ADDRESS:

dmcauley@brundidge-stanger.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 1/7/2014

OPEN APPLICATION ISSUES THAT MUST BE ADDRESSED IN RESPONSE TO OFFICE ACTION:

The following are the open application issues that the applicant must address in order to have a complete response to this Office action:

-Refusal to Register Under Section 2(d) of the Trademark Act –Likelihood of Confusion

-Suspension Advisory

-Requirement for Submission of an Acceptable Specimen of Use

The assigned trademark attorney has reviewed the referenced application and has determined the following:

Refusal to Register Under Section 2(d) of the Trademark Act –Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in **U.S. Registration Nos. 2841431, 2843405, 2843786, 3054773 and 3309551**. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* All of the cited prior registrations are owned by Rhapsody International Incorporated. *See* the enclosed registrations.

Registration Number 2841431 is NAPSTER for:

“Computer software for the transmission of audio, graphics, text, and data over communications networks; computer software for the streaming transmission of audio, video, graphics, text and data over communication networks; computer software for storage of audio, video, graphics, text and data on communications networks users; computer software for secure, encrypted electronic transfer of audio, video, graphics and data over communications networks” and “Licensing of intellectual property; Computer services, namely, providing customized webpages featuring user-defined information, which includes search engines and online web links to news, weather, current events, reference materials and customized e-mail messages all in a wide ranges of user-defined fields; Computer services, namely, providing search engines for obtaining data via electronic communications network.”

Registration Number 2843405 is NAPSTER plus design for:

“Computer software for the transmission of audio, graphics, text and data over communications networks; Computer software for the streaming transmission of audio, graphics, text and data over communications networks; Computer storage to enable communications among computer or communications network users; Computer software for secure, encrypted electronic transfer of audio, video, graphics and data over communications networks,” “Transmission of audio and video files via communications networks;

Providing electronic bulletin boards, chat rooms and community for the transmission of messages among users concerning music, news, current events, entertainment and arts and leisure” and “Providing databases and directories in the fields of music, video, radio, news, games, cultural events, entertainment and arts and leisure via communications networks; Music publishing services; Publishing of text, graphic, audio and video works via communication networks; Matching users for the transfer and sharing of music, video and audio recordings via communications networks,”

Registration Number 2843786 is NAPSTER for:

“Electronic transmission of audio and video files via communications networks; providing electronic bulletin boards; chat rooms and community for a transmission of messages among users concerning music, news, current events, entertainment and arts and leisure;” and “Providing databases and directories in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; providing information, audio, video, graphics, text and other multimedia content in the fields of music, video, radio, news, games, cultural events, entertainment, and arts and leisure via communications networks; music publishing services; publishing of text, graphic, audio and video works via communications networks; matching users for the transfer of music, video, and audio recordings via communications networks.”

Registration Number 3054773 is NAPSTER for: “computer software for use in organizing, transmitting, manipulating, and reviewing audio, video, and data files on portable and handheld digital electronic devices.”

Registration Number 3309551 NAPSTERLINKS for: “Computer software, namely, computer software to enable the transmission of audio, graphics, text, and data over communications networks; computer software for the streaming transmission of audio, video, graphics, text and data over communication networks via hyperlinks.”

The mark sought in this application is NAPSTER.FM for:

“Subscription audio and video broadcasting via electronic communication networks, local and global computer networks and wireless communication networks; audio broadcasting, namely, broadcasting music, concerts, and radio programs via electronic communication networks, local and global computer networks and wireless communication networks; streaming of audio content via electronic communication networks, local and global computer networks and wireless communication networks; webcasting services; providing on-line chat rooms and electronic bulletin boards for transmission of messages, and audio and video playlists among users.”

In any likelihood of confusion determination, two key considerations are similarity of the marks and

similarity or relatedness of the goods and/or services. *Syndicat Des Proprietaires Viticulteurs De Chateauf-neuf-Du-Pape v. Pasquier DesVignes*, 107 USPQ2d 1930, 1938 (TTAB 2013) (citing *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976)); *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010); see TMEP §1207.01. That is, the marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression.

In re Viterra Inc., 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973)); TMEP §1207.01(b)-(b)(v). Additionally, the goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §1207.01, (a)(vi).

Comparison of the Marks

Cited Registration Numbers 2841431 [NAPSTER], 2843786 [NAPSTER] & 3054773 [NAPSTER]

The marks at issue are nearly identical, with all of the marks at issue sharing the identically spelled wording NAPSTER. Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 751 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Nat'l Data Corp.*, 753 F.2d at 1058, 224 USPQ at 751.

Attached to this Office action are pages from the online reference resource Wikipedia.org that shows the wording “.FM” is a Top Level Domain (“TLD”) whose significance is merely descriptive, indicating that the applicant’s identified services are provided via an online presence. It is well-established Trademark Law that the addition of TLDs is insufficient to differentiate marks in determining a likelihood of confusion analysis under Section 2(d). Top-level domains (TLDs), such as “.com” and “.net” (or “.fm” as in this case) are generic locators for Internet website addresses and provide no meaningful source-identifying significance. See *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1055, 50 USPQ2d 1545, 1558 (9th Cir. 1999); TMEP §§1215.02, 1215.09; cf. *In re Hotels.com, L.P.*, 573 F.3d 1300, 1301, 1304, 91 USPQ2d 1532, 1533, 1535 (Fed. Cir. 2009). Thus, a TLD is less significant in creating a commercial impression in the minds of consumers, and is generally given little weight when comparing marks. See TMEP §1215.09.

Registration Serial Number 2843405 [NAPSTER + design]

As discussed above, the marks at issue share the identical dominant wording NAPSTER and the applicant’s proposal to add the TLD “.FM” is non-distinctive, thus is insufficient to differentiate the

marks at issue here.

Additionally, the registrant's use of the design elements in the cited registration is insufficient to differentiate the nearly identical marks here. The word portions of the marks are nearly identical in appearance, sound, connotation, and commercial impression; therefore, the addition of a design element does not obviate the similarity of the marks in this case. *See In re Shell Oil Co.*, 992 F.2d 1204, 1206, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993); TMEP §1207.01(c)(ii).

Although marks must be compared in their entireties, the word portion is generally considered the dominant and most significant feature of a mark because consumers will request the goods and/or services using the wording. *See In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1247 (TTAB 2010). For this reason, greater weight is often given to the word portion of marks when determining whether marks are confusingly similar. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1431 (TTAB 2013) (citing *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999)); TMEP §1207.01(c)(ii).

Registration Serial Number 3309551[NAPSTERLINKS]

The applicant's proposal to substitute the non-distinctive wording "LINKS" used in the cited registration with the equally non-distinctive wording ".FM" is insufficient to differentiate the otherwise identical marks at issue here.

Marks may be confusingly similar in appearance where there are similar terms or phrases or similar parts of terms or phrases appearing in both applicant's and registrant's mark. *See Crocker Nat'l Bank v. Canadian Imperial Bank of Commerce*, 228 USPQ 689 (TTAB 1986), *aff'd sub nom. Canadian Imperial Bank of Commerce v. Wells Fargo Bank, Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (COMMCASH and COMMUNICASH); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB and "21" CLUB (stylized)); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re Collegian Sportswear Inc.*, 224 USPQ 174 (TTAB 1984) (COLLEGIAN OF CALIFORNIA and COLLEGIENNE); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983) (MILTRON and MILLTRONICS); *In re BASF A.G.*, 189 USPQ 424 (TTAB 1975) (LUTEXAL and LUTEX); TMEP §1207.01(b)(ii)-(iii).

The nearly identical sound, appearance and commercial meaning shared by the marks at issue combine to create an overall confusingly similar commercial impression that is shared by the marks in this case.

Comparison of the Goods and Services

Services Comparison for Registration Numbers 2843405 & 2843786

The registrant has broadly recited its services as the “transmission of audio and video files via communications network.” The scope of the registrant’s broadly-worded identification encompasses *all methods of* transmission of audio and video, including the applicant’s more narrowly listed “audio and video broadcasting” and “streaming of” audio services.”

The registrant has also broadly listed its services as “Providing ...chat rooms ...for the transmission of messages among users concerning music, news, current events, entertainment, arts and leisure.” The “chat room ...transmission of messages concerning music” language encompasses the more narrowly listed chat messages regarding “audio and video playlists” listed in the application. **Accordingly, these services legally identical in this case.**

With respect to applicant’s and registrant’s services, the question of likelihood of confusion is determined based on the description of the services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See, e.g., Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-70, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012); *Octocom Sys. Inc. v. Hous. Computers Servs. Inc.*, 918 F.2d 937, 942, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Absent restrictions in an application and/or registration, the identified services are “presumed to travel in the same channels of trade to the same class of purchasers.” *In re Viterra Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268, 62 USPQ2d 1001, 1005 (Fed. Cir. 2002)). Additionally, unrestricted and broad identifications are presumed to encompass all services of the type described. *See In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006) (citing *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981)); *In re Linkvest S.A.*, 24 USPQ2d 1716, 1716 (TTAB 1992).

In this case, the identification set forth in the application and registration has no restrictions as to nature, type, channels of trade, or classes of purchasers. Therefore, it is presumed that these services travel in all normal channels of trade, and are available to the same class of purchasers. Further, the registration uses broad wording to describe the services and this wording is presumed to encompass all services of the type described, including those in applicant’s more narrow identification.

Goods/Services Comparison for Registration Serial Numbers 2841431, 3054773 & 3309551

All of the cited registrations list their goods as “Computer software for the transmission of audio,

graphics, text and data over communications networks” and “Computer software for the streaming transmission of audio, video, graphics, text and data over communication networks;

Computer software for the secure, encrypted electronic transfer of audio, video, graphics and data over communications networks” are used in support of the type of audio and video broadcasting and streaming services recited in this application.

Consumers are likely to be confused by the use of similar marks on or in connection with goods and with services featuring or related to those goods. TMEP §1207.01(a)(ii); see *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) (holding BIGG’S for retail grocery and general merchandise store services likely to be confused with BIGGS for furniture); *In re United Serv. Distributions, Inc.*, 229 USPQ 237 (TTAB 1986) (holding design for distributorship services in the field of health and beauty aids likely to be confused with design for skin cream); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (holding 21 CLUB for various items of men’s, boys’, girls’ and women’s clothing likely to be confused with THE “21” CLUB (stylized) for restaurant services and towels); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (holding CAREER IMAGE (stylized) for retail women’s clothing store services and clothing likely to be confused with CREST CAREER IMAGES (stylized) for uniforms); *Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (holding STEELCARE INC. for refinishing of furniture, office furniture, and machinery likely to be confused with STEELCASE for office furniture and accessories); *Mack Trucks, Inc. v. Huskie Freightways, Inc.*, 177 USPQ 32 (TTAB 1972) (holding similar marks for trucking services and on motor trucks and buses likely to cause confusion).

Additionally, the software goods recited in the registrations are the type of goods that are used in support of and to enable the delivery of the type of services identified in this application, making the goods and services closely related in this case.

A likelihood of confusion results when the confusingly similar marks are used in the market for the legally identical services and closely related goods and services at issue here. Accordingly, registration of the mark sought in this application is hereby refused under Section 2(d) of the Trademark Act in this case. Applicant should note the following ground for suspension.

Search and Suspension Advisory –One Earlier-Filed Pending Application

Information regarding pending Application Serial No. 78431602 is enclosed, this listed owner of this earlier-filed application is Rhapsody International Incorporated. The filing date of the referenced application precedes applicant’s filing date. There may be a likelihood of confusion between the two marks under Trademark Act Section 2(d), 15 U.S.C. §1052(d). If the referenced application registers, registration may be refused in this case under Section 2(d). 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon entry of a response to this Office action, action on this case may be suspended pending final disposition of the earlier-filed application.

If applicant believes there is no potential conflict between this application and the earlier-filed application, then applicant may present arguments relevant to the issue in a response to this Office action. The election not to submit arguments at this time in no way limits applicant's right to address this issue at a later point. Although applicant's mark has been refused registration, applicant may respond to the Refusals to Register Under Section 2(d) of the Trademark Act and Suspension Advisory by submitting evidence and arguments in support of registration. The applicant must respond to the requirements set forth below.

Requirement for Submission of an Acceptable Specimen of Use

Registration is refused because the specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in the application. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Specifically, the applicant describes the specimen of record as a "webpage screenshot." The specimen of record consists of advertising for what appears to be a hosted peer-to-peer audio and and/or video digital content sharing portal. The specimen of record shows no description of any type of services, but does show the applicant stating that it provides "real-time synching" of the users' digital content and that the users' "music collection travels with you."

The applicant has identified its services as audio broadcasting, subscription audio and video broadcasting, webcasting and chat rooms. There is nothing in the specimen of record that would show any type of association between the identified services and the proposed mark. Thus registration is refused because the specimen does not show a direct association between the applied-for mark and the identified services; thus the specimen fails to show the applied-for mark in use in commerce. 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Specimens consisting of advertising or promotional materials generally must show a direct association between the mark and the services for which registration is sought. See *In re Universal Oil Prods. Co.*, 476 F.2d 653, 655, 177 USPQ 456, 457 (C.C.P.A. 1973); *In re HSB Solomon Assocs.*, 102 USPQ2d 1269, 1274 (TTAB 2012); TMEP §1301.04(b). While the exact nature of the services does not need to be specified in the specimen, there must be something which creates in the mind of the purchaser an association between the mark and the service. *In re Adair*, 45 USPQ2d 1211, 1215 (TTAB 1997) (quoting *In re Johnson Controls Inc.*, 33 USPQ2d 1318, 1320 (TTAB 1994)); see *In re Osmotica Holdings, Corp.*, 95 USPQ2d 1666, 1668 (TTAB 2010).

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. 15 U.S.C. §1051(a)(1); 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

Examples of specimens for services may include advertising and marketing materials, brochures, photographs of business signage and billboards, and website printouts that show the mark used in the actual sale, rendering, or advertising of the services. See TMEP §§1301.04 et seq.

Applicant may respond to this refusal by satisfying one of the following:

(1) Submit a different specimen (a verified “substitute” specimen) that (a) Was in actual use in commerce at least as early as the filing date of the application or prior to the filing of an amendment to allege use and (b) Shows the mark in actual use in commerce for the services identified in the application.

(2) Amend the filing basis to intent to use under Section 1(b), for which no specimen is required. This option will later necessitate additional fee and filing requirements such as providing a specimen at a subsequent date.

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to <http://www.uspto.gov/trademarks/law/specimen.jsp>.

If applicant has any questions about its application or needs assistance in responding to this Office Action please telephone the assigned trademark examining attorney directly at the number listed below.

/Amy C. Kean/

Trademark Attorney, Law Office 113

U.S. Patent & Trademark Office

Amy.Kean@USPTO.gov

Phone: 571-272-8854

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online

forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at <http://tsdr.uspto.gov/>. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/trademarks/teas/correspondence.jsp>.

DESIGN MARK

Serial Number

76137325

Status

REGISTERED

Word Mark

NAPSTER

Standard Character Mark

No

Registration Number

2843405

Date Registered

2004/05/18

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS AND/OR NUMBERS

Owner

RHAPSODY INTERNATIONAL, INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: [COMPUTER SOFTWARE TO ENABLE PEER-TO-PEER NETWORKING AND FILE SHARING; SEARCH ENGINE SOFTWARE;] COMPUTER SOFTWARE FOR THE TRANSMISSION OF AUDIO, GRAPHICS, TEXT, AND DATA OVER COMMUNICATIONS NETWORKS; COMPUTER SOFTWARE FOR THE STREAMING TRANSMISSION OF AUDIO, VIDEO, GRAPHICS, TEXT AND DATA OVER COMMUNICATIONS NETWORKS; COMPUTER STORAGE TO ENABLE COMMUNICATIONS AMONG COMPUTER OR COMMUNICATIONS NETWORK USERS; COMPUTER SOFTWARE FOR SECURE, ENCRYPTED ELECTRONIC TRANSFER OF AUDIO, VIDEO, GRAPHICS AND DATA OVER COMMUNICATIONS NETWORKS; [COMPUTER SOFTWARE FOR ENCRYPTION OF COMMUNICATIONS]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: LICENSING OF INTELLECTUAL PROPERTY; PROVIDING SEARCH ENGINES FOR OBTAINING DATA VIA COMMUNICATIONS NETWORK; [PROVIDING DATABASES AND DIRECTORIES VIA COMMUNICATIONS NETWORKS FOR OBTAINING DATA IN THE FIELD OF POLITICS

AND GENERAL NEWS; INTERNET SERVICES, NAMELY, CREATING INDEXES OF INFORMATION, SITES AND OTHER RESOURCES AVAILABLE ON COMMUNICATIONS NETWORKS FOR OTHERS; INTERNET SERVICES, NAMELY, PROVIDING USERS OF COMMUNICATIONS NETWORKS WITH MEANS OF IDENTIFYING, LOCATING, GROUPING, DISTRIBUTING, AND MANAGING DATA AND LINKS TO THIRD-PARTY COMPUTER SERVERS, COMPUTER PROCESSORS AND COMPUTER USERS;] INTERNET SERVICES, NAMELY, SEARCHING, BROWSING AND RETRIEVING INFORMATION, SITES, AND OTHER RESOURCES AVAILABLE ON COMMUNICATIONS NETWORKS FOR OTHERS; INTERNET SERVICES, NAMELY, ORGANIZING CONTENT OF INFORMATION PROVIDED OVER A COMMUNICATIONS NETWORKS ACCORDING TO USER PREFERENCE. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: [BUSINESS CONSULTATION;] PRODUCT MERCHANDISING; LICENSING OF COMPUTER SOFTWARE; [DISSEMINATION OF ADVERTISING FOR OTHERS VIA COMMUNICATIONS NETWORKS;] RETAIL STORE SERVICES FEATURING ENTERTAINMENT PRODUCTS AND APPAREL; RETAIL STORE SERVICES PROVIDED VIA COMMUNICATIONS NETWORKS FEATURING ENTERTAINMENT PRODUCTS AND APPAREL. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 038. US 100 101 104. G & S: TRANSMISSION OF AUDIO AND VIDEO FILES VIA COMMUNICATIONS NETWORKS; PROVIDING ELECTRONIC BULLETIN BOARDS, CHAT ROOMS AND COMMUNITY FORA FOR THE TRANSMISSION OF MESSAGES AMONG USERS CONCERNING MUSIC, NEWS, CURRENT EVENTS, [POLITICS,] ENTERTAINMENT AND ARTS AND LEISURE; [TRANSMISSION OF PEER TO PEER NETWORKING AND FILE SHARING INFORMATION VIA COMMUNICATIONS NETWORKS; TELECOMMUNICATIONS SERVICES, NAMELY, PROVIDING ONLINE CHAT ROOMS FOR TRANSMISSION OF MESSAGES AMONG COMPUTER USERS CONCERNING GENERAL INTEREST TOPICS]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: PROVIDING DATABASES AND DIRECTORIES IN THE FIELDS OF MUSIC, VIDEO, RADIO, [TELEVISION,] NEWS, [SPORTS,] GAMES, CULTURAL EVENTS, ENTERTAINMENT, AND ARTS AND LEISURE VIA COMMUNICATIONS NETWORKS; PROVIDING INFORMATION, AUDIO, VIDEO, GRAPHICS, TEXT AND OTHER MULTIMEDIA CONTENT IN THE FIELDS OF MUSIC, VIDEO, RADIO, [TELEVISION, ENTERTAINMENT] NEWS, [SPORTS,] GAMES, CULTURAL EVENTS, ENTERTAINMENT AND ARTS AND LEISURE VIA COMMUNICATIONS NETWORKS; MUSIC PUBLISHING SERVICES; PUBLISHING OF TEXT, GRAPHIC, AUDIO AND VIDEO WORKS VIA COMMUNICATIONS NETWORKS; MATCHING USERS FOR THE TRANSFER AND SHARING OF MUSIC, VIDEO, AND AUDIO RECORDINGS VIA COMMUNICATIONS NETWORKS; [PROVIDING EDUCATIONAL SYMPOSIA VIA COMMUNICATIONS NETWORKS IN THE FIELDS OF MUSIC, VIDEO, ENTERTAINMENT, NEWS, POLITICS, AND ARTS AND LEISURE]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Colors Claimed

Color is not claimed as a feature of the mark.

Print: Jan 7, 2014

76137325

Filing Date

2000/09/27

Examining Attorney

BENZMILLER, ANDREW

Attorney of Record

Margaret C. McHugh



DESIGN MARK

Serial Number

78014821

Status

REGISTERED

Word Mark

NAPSTER

Standard Character Mark

No

Registration Number

2843786

Date Registered

2004/05/18

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

RHAPSODY INTERNATIONAL, INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Licensing of intellectual property; providing search engines for obtaining data via communications networks; [providing databases and directories via communications networks for obtaining data in the fields of politics and general news]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: [Business consultation;] product merchandising; licensing of computer software and of entertainment products and services; [dissemination of advertising for others via communications networks;] retail store services featuring entertainment products and apparel; retail store services provided via communications networks featuring entertainment products and apparel. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 038. US 100 101 104. G & S: Electronic transmission of audio and video files via communications networks; providing electronic bulletin boards; chat rooms and community for a transmission of messages among users concerning music, news, current events, [politics,] entertainment and arts and leisure; [transmission of peer to peer networking and file sharing information via communications networks]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Providing databases and directories in the fields of music, video, radio, [television,] news, [sports,] games, cultural events, entertainment, and arts and leisure via communications networks; providing information, audio, video, graphics, text and other multimedia content in the fields of music, video, radio, [television,] news, [sports,] games, cultural events, entertainment, and arts and leisure via communications networks; music publishing services; publishing of text, graphic, audio and video works via communications networks; matching users for the transfer of music, video, and audio recordings via communications networks; [providing educational symposia via communications networks in the fields of music, video, entertainment news, politics, and arts and leisure]. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Filing Date

2000/06/28

Examining Attorney

BENZMILLER, ANDREW

Attorney of Record

Margaret C. McHugh

NAPSTER

TYPED DRAWING

Serial Number

78039019

Status

REGISTERED

Word Mark

NAPSTER

Standard Character Mark

No

Registration Number

2841431

Date Registered

2004/05/11

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(1) TYPED DRAWING

Owner

RHAPSODY INTERNATIONAL, INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Name Change

BY ASSIGNMENT; BY ASSIGNMENT

Original Owner

NAPSTER, INC. CORPORATION REDWOOD CITY CALIFORNIA 94063

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
computer software for the transmission of audio, graphics, text, and
data over communications networks; computer software for the streaming
transmission of audio, video, graphics, text and data over
communication networks; computer software for storage of audio, video,
graphics, text and data on communications networks users; computer
software for secure, encrypted electronic transfer of audio, video,
graphics and data over communications networks [; computer software
for encryption for communications]. First Use: 2003/10/29. First
Use In Commerce: 2003/10/29.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: LICENSING OF INTELLECTUAL PROPERTY, [COMPUTER CONSULTATION; COMPUTER NETWORK DESIGN SERVICE OR OTHERS; COMPUTER SYSTEMS DESIGN AND ANALYSIS SERVICES FOR OTHERS, COMPUTER SOFTWARE DESIGN FOR OTHERS; COMPUTER SOFTWARE CONSULTATION;] COMPUTER SERVICES, namely, PROVIDING CUSTOMIZED WEBPAGES FEATURING USER-DEFINED INFORMATION, WHICH INCLUDES SEARCH ENGINES AND ONLINE WEB LINKS TO NEWS, WEATHER, [SPORTS,] CURRENT EVENTS, REFERENCE MATERIALS, AND CUSTOMIZED EMAIL MESSAGES, ALL IN A WIDE RANGE OF USER-DEFINED FIELDS; COMPUTER SERVICES, namely, PROVIDING SEARCH ENGINES FOR OBTAINING DATA VIA ELECTRONIC COMMUNICATIONS NETWORK. First Use: 2003/10/29. First Use In Commerce: 2003/10/29.

Filing Date

2000/12/12

Examining Attorney

SMIGA, HOWARD

Attorney of Record

Margaret C. McHugh

DESIGN MARK

Serial Number

78431602

Status

THIRD EXTENSION - GRANTED

Word Mark

NAPSTER MOBILE

Standard Character Mark

Yes

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

RHAPSODY INTERNATIONAL, INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer software for the transmission of audio, graphics, text, and
data over communications networks; computer software for the streaming
transmission of audio, video, graphics, text and data over
communication networks; computer software for storage of audio, video,
graphics, text and data on communications networks users; computer
software for secure, encrypted electronic transfer of audio, video,
graphics, text and data over communications networks; computer
software for encryption for communications.

Filing Date

2004/06/08

Examining Attorney

SOMERVILLE, ARETHA

Attorney of Record

Margaret C. McHugh

NAPSTER MOBILE

DESIGN MARK

Serial Number

78561228

Status

SECTION 8 & 15-ACCEPTED AND ACKNOWLEDGED

Word Mark

NAPSTER

Standard Character Mark

Yes

Registration Number

3054773

Date Registered

2006/01/31

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

RHAPSODY INTERNATIONAL INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: [Portable and handheld digital electronic devices for recording, organizing, transmitting, manipulating, and reviewing audio, video, and data files;] computer software for use in organizing, transmitting, manipulating, and reviewing audio, video, and data files on portable and handheld digital electronic devices. First Use: 2003/10/16. First Use In Commerce: 2003/10/16.

Prior Registration(s)

2841431;2843405;AND OTHERS

Filing Date

2005/02/04

Examining Attorney

CAIN, CATHERINE

Print: Jan 7, 2014

78561228

Attorney of Record

Margaret C. McHugh

NAPSTER

DESIGN MARK

Serial Number

78686105

Status

SECTION 8-ACCEPTED

Word Mark

NAPSTER

Standard Character Mark

Yes

Registration Number

3055515

Date Registered

2006/01/31

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

RHAPSODY INTERNATIONAL INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Portable and handheld digital electronic devices for recording,
organizing, transmitting, manipulating, and reviewing text, data, and
audio files; computer software for use in organizing, transmitting,
manipulating, and reviewing text, data, and audio files on portable
and handheld digital electronic devices. First Use: 2003/10/19.
First Use In Commerce: 2003/10/19.

Prior Registration(s)

2841431;2843405;AND OTHERS

Filing Date

2005/08/04

Examining Attorney

CAIN, CATHERINE

Print: Jan 7, 2014

78686105

Attorney of Record

Margaret C. McHugh

NAPSTER

DESIGN MARK

Serial Number

78833373

Status

REGISTERED

Word Mark

NAPSTERLINKS

Standard Character Mark

Yes

Registration Number

3309551

Date Registered

2007/10/09

Type of Mark

TRADEMARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

RHAPSODY INTERNATIONAL INC. CORPORATION DELAWARE 1420 FIFTH AVENUE,
SUITE 1500 SEATTLE WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S:
Computer software, namely, computer software to enable the
transmission of audio, graphics, text, and data over communications
networks; computer software for the streaming transmission of audio,
video, graphics, text and data over communication networks via
hyperlinks. First Use: 2006/05/01. First Use In Commerce:
2006/05/01.

Prior Registration(s)

2575170;2843405;3080144;AND OTHERS

Filing Date

2006/03/09

Examining Attorney

BORSUK, ESTHER A.

Print: Jan 7, 2014

78833373

Attorney of Record

Margaret C. McHugh

NAPSTERLINKS

DESIGN MARK

Serial Number

85804778

Status

OPPOSITION PENDING

Word Mark

NAPSTER

Standard Character Mark

Yes

Type of Mark

TRADEMARK; SERVICE MARK

Register

PRINCIPAL

Mark Drawing Code

(4) STANDARD CHARACTER MARK

Owner

Rhapsody International Inc. CORPORATION DELAWARE 1420 5th Avenue,
Suite 1500 Seattle WASHINGTON 98101

Goods/Services

Class Status -- ACTIVE. IC 009. US 021 023 026 036 038. G & S: Computer software for use in the storage, organizing, review, delivery, distribution and transmission of digital music and entertainment-related audio, video, text and multimedia content; computer software that enables users to play and program music and entertainment-related audio, video, text and multimedia content; downloadable prerecorded digital, textual, audio and visual content via electronic communications networks, local and global computer networks and wireless communication devices; downloadable electronic publications over electronic communication networks, local and global computer networks and wireless communication devices, namely, newsletters in the field of entertainment.

Goods/Services

Class Status -- ACTIVE. IC 035. US 100 101 102. G & S: Online retail store services featuring pre-recorded audio, musical, and audiovisual works and related merchandise provided via electronic communication networks, local and global computer networks and wireless communication devices; advertising and marketing services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium.

Goods/Services

Class Status -- ACTIVE. IC 038. US 100 101 104. G & S: Subscription audio broadcasting via electronic communication networks, local and global computer networks and wireless communication networks; audio broadcasting, namely, broadcasting music, concerts, and radio programs via electronic communication networks, local and global computer networks and wireless communication networks; streaming of audio content via electronic communication networks, local and global computer networks and wireless communication networks; webcasting services; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest.

Goods/Services

Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Providing online databases in the field of music, radio, and entertainment; providing online information in the field of music, radio, and entertainment; providing online newsletters in the field of music, concerts, radio, news, and entertainment; Entertainment services, namely, providing non-downloadable prerecorded digital, textual, audio and visual content in the field of music, video, online radio, entertainment and cultural events via electronic communication networks, local and global computer networks and wireless communication devices and providing non-downloadable prerecorded digital, textual, audio and visual content in the field of music, video, online radio, entertainment and cultural events via electronic communication networks, local and global computer networks and wireless communication devices; providing electronic publications over electronic communication networks, local and global computer networks and wireless communication devices, namely, providing online magazines and newsletters in the field of music and entertainment.

Goods/Services

Class Status -- ACTIVE. IC 042. US 100 101. G & S: Providing an online network, via electronic communication networks, local and global computer networks and wireless communication devices, to enable users to program audio, video, movies, text and other multimedia content; providing a website featuring non-downloadable software to enable users to program audio, video, movies, text and other multimedia content in the field of music, video, online radio, entertainment and cultural events; providing search engines and search platforms for obtaining data and content via electronic communication networks, local and global computer networks and wireless communication devices; internet services, namely, creating indexes of information, sites and other resources available on electronic communication networks, local and global computer networks and wireless communication devices; searching, browsing and retrieving information, sites, and other resources available on electronic communication networks, local and global computer networks and wireless communication devices.

Print: Jan 7, 2014

85804778

Prior Registration(s)

2843405;2843786;3054773;AND OTHERS

Filing Date

2012/12/17

Examining Attorney

FAIRBANKS, RON

Attorney of Record

Margaret McHugh

NAPSTER



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Article Talk

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.fm

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This article includes a [list of references](#), related reading or [external links](#), but **its sources remain unclear because it lacks inline citations**. Please [improve](#) this article by introducing more precise citations. *(January 2013)*

.fm is the [country code top-level domain](#) (ccTLD) for the [Federated States of Micronesia](#), a group of islands located in the [Pacific Ocean](#).

Except for reserved names like [.com.fm](#), [.net.fm](#), [.org.fm](#) and others, any person in the world can register a [.fm](#) domain for a fee, much of the income from which goes to the government and people of the islands. The domain name is popular (and thus economically valuable) for [FM radio stations](#) and [streaming audio websites](#) (other similar ccTLDs are [.am](#), [.tv](#), [.cd](#), [.dj](#) and [.mu](#)); a notable example is [Last.fm](#), a social music website.

Social media use [edit]

The [.fm](#) domain extension has also been used by various companies outside of the audio streaming industry or the [Federated States of Micronesia](#). Examples include:

- [Ping.fm](#), centralized tool for users to manage social media
- [FastMail.FM](#), email provider
- [Last.fm](#), Internet radio streaming and statistics service
- [Smart.fm](#), online education tool
- [Tastebuds.fm](#), dating website for music fans
- [Turntable.fm](#), social media site for interactively sharing music
- [Ask.fm](#), a website through which people ask and answer questions.
- [favstar.fm](#), a website listing people's most favorited and retweeted twitter posts.
- [clarity.fm](#), a website providing on demand advice from proven entrepreneurs.

Many [commercial radio stations](#) also use the domain extension.

.fm



| | |
|----------------------------------|--|
| Introduced | 1995 |
| TLD type | Country code top-level domain |
| Status | Active |
| Registry | dotFM (BRS Media Inc.) |
| Sponsor | FSM Telecommunications Corporation |
| Intended use | Entities connected with Federated States of Micronesia |
| Actual use | Much use related to FM radio ; little related to FSM |
| Registration restrictions | None |
| Structure | Registrations are available directly at second level |
| Website | dotFM |

many Commercial radio stations also use the domain extension.

External links [edit]

- IANA .fm whois information
- dotFM, the domain registrar for .fm names

| | | |
|--|---------------------------------------|--------|
| V·T·E | Country code top-level domains | [hide] |
| | ISO 3166-1 | [hide] |
| A .ac .ad .ae .af .ag .ai .al .am .ao .aq .ar .as .at .au .aw .ax .az B .ba .bb .bd .be .bf .bg .bh .bi .bj .bm .bn .bo .br .bs .bt .bw .by .bz C .ca .cc .cd .cf .cg .ch .ci .ck .cl .cm .cn .co .cr .cu .cv .cw .cx .cy .cz D .de .dj .dk .dm .do .dz E .ec .ee .eg .er .es .et .eu F .fi .fj .fk .fm .fo .fr G .ga .gd .ge .gf .gg .gh .gi .gl .gm .gn .gp .gq .gr .gs .gt .gu .gw .gy H .hk .hm .hn .hr .ht .hu I .id .ie .il .im .in .io .iq .ir .is .it J .je .jm .jo .jp K .ke .kg .kh .ki .km .kn .kp .kr .kw .ky .kz L .la .lb .lc .li .lk .lr .ls .lt .lu .lv .ly M .ma .mc .md .me .mg .mh .mk .ml .mm .mn .mo .mp .mq .mr .ms .mt .mu .mv .mw .mx .my .mz N .na .nc .ne .nf .ng .ni .nl .no .np .nr .nu .nz O .om P .pa .pe .pf .pg .ph .pk .pl .pm .pn .pr .ps .pt .pw .py Q .qa R .re .ro .rs .ru .rw S .sa .sb .sc .sd .se .sg .sh .si .sk .sl .sm .sn .so .sr .ss .st .su .sv .sx .sy .sz T .tc .td .tf .tg .th .tj .tk .tl .tm .tn .to .tr .tt .tv .tw .tz U .ua .ug .uk .us .uy .uz V .va .vc .ve .vg .vi .vn .vu W .wf .ws Y .ye .yt Z .za .zm .zw | | |
| | Internationalized (IDN) ccTLD | [show] |
| | Proposed ccTLDs | [show] |
| | Others | [show] |
| See also Generic top-level domains | | |

Categories: [Country code top-level domains](#) | [Communications in the Federated States of Micronesia](#) | [Domain hacks](#)

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To: NAPSTER.FM LLC (dmcauley@brundidge-stanger.com)
Subject: U.S. TRADEMARK APPLICATION NO. 86069735 - NAPSTER.FM - 2868TM.870BS
Sent: 1/7/2014 6:47:25 PM
Sent As: ECOM113@USPTO.GOV
Attachments:

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
BEFORE THE HONORABLE CHARLES R. BREYER

| | | |
|---------------------------------|---|---------------------------|
| RHAPSODY INTERNATIONAL INC., |) | |
| |) | |
| Plaintiff, |) | NO. C 13-05489 CRB |
| |) | |
| VS. |) | |
| |) | San Francisco, California |
| RYAN LESTER & NAPSTER.FM., LLC, |) | Friday |
| |) | February 21, 2014 |
| Defendants. |) | 10:00 A.M. |
| |) | |

TRANSCRIPT OF PROCEEDINGS

APPEARANCES:

For Plaintiff: KILPATRICK TOWNSEND & STOCKTON LLP
Eighth Floor
Two Embarcadero Center
San Francisco, CA 94111

**BY: GIA L. CINCONI and
MEHRNAZ BOROUHAND SMITH**

For Defendant: Brundidge & Stanger, P.C.
2318 Mill Road
Suite 1020
Alexandria, VA 22314.

BY: CARL I. BRUNDIDGE

Reported By: Kelly Lee Polvi, CSR No. 6389, RMR, FCRR

1 THE COURT: Well, I don't think I actually, at this
2 point, have to get into all of this. I think it's sort of
3 by-the-by. I just wanted to try to figure out how this figure
4 of 700- -- three-quarters of a million dollars comes -- arises
5 out of what appears to be, if you accept Plaintiff's version, a
6 clear-cut case of infringement.

7 All of a sudden -- and then first your client says,
8 "Okay, I'll stop," and then he says, "Well, actually, I'd like
9 three-quarters of a million dollars so I could transfer it to
10 you."

11 And that is such a quantum leap in positions that I
12 was curious.

13 Nevertheless, I think that jurisdiction is clearly here,
14 it's clearly appropriate, I see nothing to be gained by
15 transferring it to Virginia, and if your client wants to --
16 well, your client has no choice. Your client is here, and
17 we'll litigate it, and the motion to dismiss or in the
18 alternative to transfer is denied.

19 And I'd like to set some dates here, so while I have you
20 in front of me, for further proceedings.

21 Where are we now procedurally in this?

22 MS. SMITH: So procedurally, Your Honor, we have now
23 amended our Complaint to include Napster.fm as well. Because
24 that was one of the issues. Defendants have filed another
25 Motion to Dismiss and in the alternative to transfer.

1 THE COURT: In which case?

2 MR. BRUNDIDGE: The *Panavision* case.

3 I think it's clear in all of the cases where a website is
4 being used that it does not rise to the level of minimum
5 contacts with the state of California.

6 Most of it -- all the cases that are decided by the Ninth
7 Circuit did not confer personal jurisdiction based upon a
8 website.

9 MS. SMITH: Your Honor, this is not an issue of personal
10 jurisdiction based upon a website, it's personal jurisdiction
11 based on the cybersquatting. And that comes out in the *Groupon*
12 case, as well as the *Panavision* case.

13 MR. BRUNDIDGE: I think that we have here, in those two
14 settings, they're making an argument that their cybersquatting
15 requires an attempt or some sort of extortion. They're
16 characterizing the counteroffer, which --

17 THE COURT: \$775,000?

18 MR. BRUNDIDGE: Well, let me explain. That -- we went to
19 a -- let me explain.

20 THE COURT: Well, you understand the question. When you
21 mention the word "extortion," and then I see your client is
22 demanding \$775,000, that strikes me -- though I don't know what
23 that's based on -- as being at least within the realm of
24 possibility of being extortion.

25 MR. BRUNDIDGE: I understand your reaction to the amount.