

ESTTA Tracking number: **ESTTA636572**

Filing date: **11/03/2014**

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

Proceeding	91217437
Party	Plaintiff Google Inc.
Correspondence Address	MATTHEW J SNIDER DICKINSON WRIGHT PLLC INTERNATIONAL SQUARE, 1875 EYE STREET NW SUITE 1200 WASHINGTON, DC 20006 UNITED STATES trade- mark@dickinsonwright.com,google@dickinson-wright.com,jnishi@dickinsonwright.com,msnider@dickinsonwright.com
Submission	Reply in Support of Motion
Filer's Name	Matthew J. Snider
Filer's e-mail	trade- mark@dickinsonwright.com,google@dickinson-wright.com,jnishi@dickinsonwright.com,msnider@dickinsonwright.com
Signature	/Matthew J. Snider/
Date	11/03/2014
Attachments	ANNARBOR-#184157 - Reply Brief (Opp 91217437).pdf(302596 bytes)

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

GOOGLE INC.

Opposer,

v.

HANGINOUT, INC.,

Applicant.

Opposition No. 91217437

App. Ser. No. 85/674,801

Mark: HANGINOUT

**GOOGLE’S REPLY TO HANGINOUT’S
RESPONSE TO MOTION TO SUSPEND OPPOSITION**

Google Inc. (“Google”), through its undersigned counsel, states as follows for its reply to Hanginout’s response to Motion to Suspend Opposition (“Applicant’s Brief”), filed by the applicant, Hanginout, Inc. (“Hanginout” or “Applicant”).

I. Introduction

Google’s motion to suspend raises no novel or complicated issues. Rather, it seeks suspension under the typical scenario of two parties disputing likelihood of confusion and validity of trademark rights in both a District Court and before the PTO. This easily satisfies the suspension standard that the parties “are engaged in a civil action . . . which *may have a bearing* on the case.” 37 C.F.R. § 2.117(a) (emphasis added). Accordingly, suspension is proper.

Applicant attempts to complicate this straightforward analysis by ignoring the issue of likelihood of confusion entirely, misrepresenting the scope of what remains at issue in the District Court concerning the validity of its trademark rights, incorrectly suggesting that not suspending this proceeding would be judicially economical, and by bizarrely arguing that

suspension would deprive Applicant of the right to pursue “pre-registration statutory damages” (Applicant’s Brief, Dkt. # 10 at 3), even though Applicant has alleged no claims in the District Court action that would entitle it to statutory damages. None of Applicant’s arguments justifies denial of Google’s motion to suspend.

II. The Likelihood of Confusion Issue in The District Court Bears Directly on The Likelihood of Confusion Issue Here.

Applicant’s Opposition Brief completely ignores the overlap of the likelihood of confusion issues in this proceeding and the District Court. It does not even *mention* the word “confusion.” But the likelihood of confusion issue unquestionably forms the foundation for Google’s opposition to registration. (Google’s Opposition, Dkt. #1, ¶¶ 5, 8.) Likewise, the likelihood of confusion issue is the core of the complaint Applicant filed in the District Court. (FAC, Dkt. # 5 App. A ¶¶ 43-46, 52.) Any District Court resolution of the likelihood of confusion issue, which is squarely before it, may not only “have a bearing on” this proceeding (37 C.F.R. § 2.117(a)), but also “be dispositive of” it. *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 U.S.P.Q.2d 1933, 1937 (T.T.A.B. 1992) (granting a motion to suspend where “[a] decision by the district court [would] be dispositive of the issues before the Board”).¹ If the District Court determines there is no likelihood of confusion, Google no longer has reason to oppose Applicant’s registration. That would unequivocally affect this proceeding.

III. The Priority Issue in The District Court Bears Directly on The Priority Issue Here.

Applicant concedes that Google raised a priority issue in the District Court action and

¹ Applicant’s Brief implies that the TTAB has held that the party moving for suspension must show that “a decision by the district court will be dispositive of the issues before the Board.” (Dkt. #10 at 1, Oct. 14, 2014) (quoting *General Motors Corp.*, 22 U.S.P.Q.2d at 1937 (emphasis in Applicant’s Brief). This mischaracterizes the law. *General Motors* held only that, because the district court’s decision in that case *would be* dispositive of the issues before the Board, the movant had satisfied the requirement of § 2.117(a) that the civil action *may* have a bearing on the Board’s case.

that priority is at issue in this proceeding as well. (Dkt. #10 at 2.) Applicant argues that the District Court’s rulings have mooted that issue, thus eliminating any reason for suspension. (*Id.*) Applicant misapprehends the effect of the District Court’s preliminary injunction denial, which is not a final fact finding. *Bursten v. Phillips*, 351 F.2d 616 (9th Cir. 1965) (“[T]he findings made on motion for preliminary injunction . . . are not determinative of those issues at trial.”) (emphasis added). (Notably, Applicant does not argue that the order’s conclusion that Hanginout is not likely to prove likelihood of confusion finally disposes of *that* issue.)

Even if the District Court’s ruling as to who used the mark first were final and binding, Applicant cites no authority that a motion to suspend should be denied once a District Court’s decision *has* had a bearing on the PTO proceedings. Moreover, even a final ruling on seniority would not moot other issues relating to priority. The District Court has not ruled on the date by which either party acquired common law rights in its disputed trademark. If the District Court determines that Google acquired trademark rights in HANGOUTS before Hanginout acquired common law rights or filed its application, and a likelihood of confusion is found, that would prevent the registration of HANGINOUT.² Again, this would bear directly on—and be outcome dispositive of—this proceeding. This ground thus independently merits suspension of the opposition under 37 C.F.R. § 2.117(a).

IV. Suspension Would Promote Judicial Economy.

Applicant’s suggestion that any judicial efficiencies would result from denying Google’s

² See 15 U.S.C. § 1115(b)(5); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:18.50 (4th ed.) (“Neither application for nor registration of a mark at the federal level wipes out the prior non-registered, common law rights of others. The nonregistered rights of a senior user continue and are not erased by the later federal registration of a junior user.”); *Allard Enters., Inc. v. Advanced Programming Resources, Inc.*, 249 F.3d 564, 572, 58 U.S.P.Q.2d 1710, 1715 (6th Cir. 2001) (“Federal registration of a trademark or service mark cannot create rights and priority over others who have previously used the mark in commerce.”).

motion to suspend is incorrect. If these proceedings are not stayed and yield a decision before the District Court's final judgment, the decision would not resolve the dispute in the District Court because any ruling by the Board would "not [be] binding upon the [district] court." *Soc'y of Mexican Am. Eng'rs & Scientists, Inc. v. GVR Pub. Rels. Agency, Inc.*, 2002 TTAB LEXIS 697, *11 (T.T.A.B. Nov. 6, 2002) (copy attached hereto as Appendix A per TBMP § 101.03); *see also Sonora Cosmetics, Inc. v. L'Oreal S.A.*, 631 F. Supp. 626, 629 (S.D.N.Y. 1986) ("[T]he Court notes that the Commissioner of Patents has held that, inasmuch as TTAB determinations of the validity of registration are merely advisory to the courts, it is preferable for the TTAB to stay its own proceedings where parallel litigation occurs in the district court."). Conversely, any final judgment on the merits in the District Court action would be binding on the Board and directly affect the rights of the parties in this proceeding. *Soc'y of Mexican Am. Eng'rs & Scientists, Inc.*, 2002 TTAB LEXIS at *11. Suspending these proceedings is thus the only way to avoid the possibility of the District Court and Board reaching inconsistent conclusions.

Further, if the opposition is not suspended, two tribunals would concurrently review parallel evidence, briefs, and motions, and would pass judgment on overlapping issues, including likelihood of confusion and priority. Avoiding this duplication alone warrants suspension. *See id.* (suspending proceeding "in the interest of judicial economy and . . . to avoid duplicating the effort of the court").

Applicant also conjures the specter of it bringing yet another action against Google for infringement of a registered trademark if it were able to obtain one. This effort to establish judicially inefficiency is an illusion. If the District Court determines there is no likelihood of confusion with regard to the unregistered HANGINOUT mark, Applicant could not prevail against Google on a claim for infringement of a registered HANGINOUT mark because both Section 1114 (registered marks) and Section 1125(a) (unregistered marks) use the same

likelihood of confusion test for determining infringement. *Compare* (PI Order, Dkt. # 5 App. B at 17) (analyzing *Sleekcraft* factors to assess infringement of unregistered mark), *with AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979) (analyzing infringement of a registered trademark). Collateral estoppel (i.e. issue preclusion)³ would bar such a suit.⁴ On the other hand, if the District Court were to find infringement of the unregistered HANGINOUT mark, Applicant would have no reason to sue Google for infringement of the registered HANGINOUT mark because the available remedies for trademark infringement or unfair competition under the Lanham Act are the same irrespective of whether a mark is registered or not. *See* 15 U.S.C. § 1117(a). Even if Hanginout could legitimately bring such a follow-on case, it could easily have avoided the supposed inefficiencies it fears by waiting to file its suit until it had a registered mark.

V. No Other Grounds Warrant Denial of Google's Motion.

Applicant fails to identify any other reason to deny Google's motion. Hanginout asserts that Google is attempting to hold Hanginout's application "hostage" in order to "exploit a potential bar on pre-registration statutory damages." (Dkt. #10 at 3.) But the District Court action has no potential for statutory damages. (FAC, Dkt. # 5 App. A.) The cases cited by Hanginout involve statutory damages arising from use of a *counterfeit mark* under 15 U.S.C. § 1117(c) or *cyberpiracy* under 15 U.S.C. § 1117(d). *New Name, Inc. v. The Walt Disney Co.*,

³ "[C]ollateral estoppel' bars relitigation of any issue that, 1) a party had a 'full and fair opportunity to litigate' in an earlier action, and that, 2) was finally decided in that action, 3) against that party, and that, 4) was essential to the earlier judgment." *DeCosta v. Viacom International, Inc.*, 981 F.2d 602, 605 (1st Cir. 1992) (*citing* Restatement (Second) of Judgments §§ 27, 29 (1982)).

⁴ Applicant cites *Juno Lighting v. Ruud Lighting*, 1995 U.S. Dist. LEXIS 197 (N.D. Ill. Jan. 11, 1995) to support its argument that it would be entitled to bring a second suit against Google for infringement of a registered trademark "even if it pertains to the same transactions." (Dkt. # 10 at 3.) *Juno Lighting*, however, stands only for the unremarkable proposition that *res judicata* does not bar an action against a *different* defendant involving *different* transactions concerning infringement of a *different* trademark. *See Juno Lighting*, 1995 U.S. Dist. LEXIS at *9-11.

2008 U.S. Dist. LEXIS 107203, *15 (C.D. Cal. July 23, 2008) (noting that “statutory damages are available in cases involving the use of a counterfeit mark”); *City of Carlsbad v. Shah*, 850 F. Supp. 2d 1087, 1116 (S.D. Cal. 2012) (“The ACPA [Anticybersquatting Consumer Protection Act] authorizes statutory damages.”). Neither of these theories is relevant to the District Court action, whether or not a registration ultimately issues. Indeed, Hanginout did not assert these theories even in its original complaint, which (improperly) alleged infringement of a registered trademark. (Compl.) (copy attached as Appendix B). Therefore, the “great and unwarranted injustice” Hanginout warns of (Dkt. #10 at 2) is unfounded.

VI. Conclusion

As in this opposition, only two issues are central in the parallel District Court action: (i) likelihood of confusion and (ii) priority of rights. The determination of both of those issues in the District Court action will have a direct effect on this opposition. Given the substantial overlap, suspension would promote judicial efficiency and avoid the potential of inconsistent rulings between the District Court and the Board. Accordingly, Google respectfully requests that the Board grant its motion to suspend this opposition proceeding.

Respectfully submitted,

DICKINSON WRIGHT PLLC

By: 

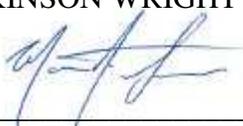
Matthew J. Snider (P76744)
Attorney for GOOGLE INC.
350 S. Main St., Suite 350
Ann Arbor, MI
(734) 623-1909
MSnider@dickinsonwright.com

Dated: November 3, 2014

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on November 3, 2014, a true copy of this document was served on counsel for the Applicant by delivering the same via First Class U.S. Mail, postage prepaid, to: Andrew D. Skale, MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C, 3580 Carmel Mountain Rd, Suite 300, San Diego, California 92130-6768.

DICKINSON WRIGHT PLLC

By: 

Matthew J. Snider (P76744)
Attorney for GOOGLE INC.
350 S. Main St., Suite 350
Ann Arbor, MI
(734) 623-1909
MSnider@dickinsonwright.com

Dated: November 3, 2014

Appendix A



Society of Mexican American Engineers and Scientists, Inc. v. GVR Public Relations Agency, Inc.

Opposition No. 121,723

Trademark Trial and Appeal Board

2002 TTAB LEXIS 697

November 6, 2002, Decided

JUDGES: [*1]

Before Simms, Hohein, and Hairston, Administrative Trademark Judges.

OPINION:

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

By the Board:

GVR Public Relations Agency, Inc. filed an application to register the mark shown below for "magazines on the subject of promoting education and careers in the fields of science, technology, engineering and mathematics." n1

[Link to Image](#)

n1 Application Serial No. 75/906,062 was filed on January 29, 2000, reciting April 1, 1992 as the date of first use of the mark on the goods anywhere and in commerce. Applicant has disclaimed the wording "NATIONAL MAGAZINE" apart from the mark as shown.

Registration has been opposed by the Society of Mexican American Engineers and Scientists, Inc. on the grounds of fraud, and that applicant's mark so resembles opposer's marks **MAES**, previously used in typed and stylized forms in connection with goods and services promoting Mexican Americans in scientific and technical careers, as to be likely to cause confusion, or to cause mistake or to deceive, and to dilute the distinctive quality of opposer's marks.

There are numerous motions currently pending in this [*2] proceeding, which the Board notes has become unduly contentious. These motions include: (1) opposer's motion for summary judgment; (2) applicant's motion to strike certain evidence submitted by opposer in support of its motion for summary judgment; (3) applicant's first and second motion to compel; and (4) applicant's motion for suspension of this proceeding pending the disposition of a civil action between the parties herein. n2 The above referenced motions are fully briefed.

n2 In addition, applicant has filed a petition to disqualify opposer's counsel pursuant to Trademark Rule 10.63. As indicated later in this order, petitions for disqualification filed in Board proceedings are determined by the Chief Administrative Trademark Judge. Accordingly, applicant's petition to disqualify will not be considered herein.

The Board has carefully considered the arguments of both parties with regard to the above motions. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of this matter.

Motion to Strike

The Board turns first to applicant's motion to strike certain evidence submitted by opposer in support of its motion for summary [*3] judgment.

In its motion, applicant raises the following objections: (1) with regard to the declaration of Ms. Maria Pizzaro, on the basis of her competence to testify on the subject of service marks, and on the basis of her personal knowledge of the activities of opposer prior to the time she became a member thereof; (2) with regard to the declaration of Mr. Keith Marracco, on the basis of hearsay; and (3) with regard to the declaration of Mr. Charles L. Thoeming, on the basis that, to the extent Mr. Thoeming seeks thereby to introduce a copy of the notice of opposition as evidence, "it is elementary law that pleadings are not evidence in a summary judgment proceeding."

We note that motions to strike in general are viewed with disfavor and matter will not be stricken unless it clearly has no bearing on the issues involved. Particularly in cases in which a party objects on substantive grounds to evidence submitted in support of a motion, the better practice is for the non-moving party to present such objections in its responsive brief on the motion, rather than by a motion to strike.

In this case, opposer has submitted in support of its summary judgment motion, evidence by declaration [*4] meeting the requirements of Trademark Rule 2.20. *See* Trademark Rule 2.20, and *Taylor Brothers, Inc. v. Pinkerton Tobacco Co.*, 231 USPQ 412 (TTAB 1986). Likewise, applicant has submitted evidence by declaration in support of its opposition to opposer's motion. The objections raised by both parties with regard to each others' declarations and evidence are noted, and have been considered by the Board in our consideration of the relative probative value thereof. Nonetheless, the Board will exercise its discretion to consider the matters asserted in these declarations in order to aid us in coming to a just determination of opposer's motion for summary judgment. n3

n3 We note however that had the Board declined to consider the objected to portions of the parties' declarations, our decision with regard to the motion for summary judgment would be the same.

In view thereof, applicant's motion to strike is **denied**. n4

n4 In further view thereof, the opposer's motion, raised in its reply brief, to strike applicant' response and declarations filed in support thereof, is denied.

Motion for Summary Judgment

The Board turns now to opposer's motion [*5] for summary judgment on the issue of likelihood of confusion.

It has often been stated that summary judgment is an appropriate method of disposing of cases in which there are no genuine issues of material fact in dispute, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating the absence of any genuine issue of material fact. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1986), and *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine, if, on the evidence of record, a reasonable finder of fact could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992), and *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992). The evidence must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993), [*6] and *Opryland USA*, *supra*.

In this case, after reviewing the arguments and supporting papers of the parties, we conclude that there are genuine issues of material fact which preclude disposition of this matter by summary judgment. We note, for example, that opposer has submitted photocopies of the covers of several copies of MAES NATIONAL MAGAZINE in support of its assertion that it uses the mark MAES on printed publications. However, applicant strenuously argues in response that these are examples of applicant's use of its applied-for mark on copies of the magazine it owns and publishes, and the supporting evidence does not conclusively support either. Accordingly, there exist at a minimum genuine issues of material fact with regard to the nature of the goods and/or services provided by opposer; the relatedness of the parties'

goods and/or services; and the extent, if any, to which applicant created either its applied-for mark or the publication MAES NATIONAL MAGAZINE as work for hire on behalf of opposer.

In view thereof, opposer's motion for summary judgment is **denied**. n5

n5 The parties should note that the evidence submitted in connection with the motion for summary judgment is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during their appropriate trial periods. *See Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *American Meat Institute v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

[*7]

Motions to Compel

Turning now to applicant's first and second, "renewed," motion to compel, the Board finds that both motions are procedurally deficient inasmuch as they fail to comply with the special requirements of Trademark Rule 2.120(e) which provides, in part, as follows:

The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement.

See Trademark Rule 2.120(e). *See also Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986), and *Envirotech Corp. v. Compagnie Des Lampes*, 219 USPQ 448 (TTAB 1979). It is well settled that motions to compel must comply with the special requirements of Trademark Rule 2.120(e) to receive favorable treatment by the Board. *See* TBMP § 523.02 and the authorities cited therein.

Moreover, the Board finds that applicant has not satisfied its obligation under Trademark Rule 2.120(e) to make a good faith effort to resolve discovery [*8] disputes prior to seeking the Board's intervention. In this case, applicant neither asserts nor introduces evidence to support a finding that it has made any attempt to contact opposer in an effort to resolve the current discovery dispute. It is clear from the total number of discovery requests at issue that applicant has failed to make a substantive effort to resolve by agreement the issues raised in its motions to compel. *See Id.*

In view of the foregoing, applicant's motions to compel are at best premature and, accordingly, are **denied**.

Further, with regard to applicant's first and second sets of interrogatories, the Board notes opposer's general objection thereto, under Trademark Rule 2.120(d) (1), on the ground that the two sets of interrogatories served by applicant are excessive in number. Opposer's objection is well taken.

Trademark Rule 2.120(d) (1) reads, in part, as follows: "the total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts...". After careful review of applicant's [*9] two sets of interrogatories, the Board has determined that the number of interrogatories exceeds seventy-five.

The parties will note that if the Board determines that the number of interrogatories propounded in a proceeding are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. *See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc.*, 19 USPQ2d 1636 (TTAB 1990); and *Pyttronic Industries, Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055 (TTAB 1990).

Accordingly, at such time as action on the instant proceeding is resumed, applicant may redraft and serve upon opposer in the place of its first and second set of interrogatories a revised set or sets of interrogatories not exceeding the prescribed numerical limit.

Motion to Suspend

The Board turns finally to applicant's motion to suspend action on the instant [*10] proceeding pending the outcome of a civil action between the parties herein. n6

n6 Civil Action No. H-01-4057, styled *GVR Public Relations Agency, Inc. v. Society of Mexican American Engineers and Scientists, Inc. and Martin Martinez* was filed on November 20, 2001 in the United States District Court for the Southern District of Texas, Houston Division.

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action, proceedings before the Board may be suspended until final determination of the civil action. *See* Trademark Rule 2.117(a); and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992). Suspension of a Board case is appropriate even if the civil case may not be dispositive of the Board case, so long as the ruling will have a bearing on the rights of the parties in the Board case. *See Martin Beverage Co. Inc. v. Colita Beverage Company.*, 169 USPQ 568, 570 (TTAB 1971).

In this case, the parties to the instant opposition include the parties to Civil Action H-01-4057. Further, because the issues under consideration in the civil action include trademark [*11] infringement; false designation of origin; and dilution, all with regard to opposer's asserted **MAES** marks, the decision in the civil case may include a determination of opposer's rights thereto. Any such determination of opposer's rights to its asserted mark in the civil action will have a bearing on the issues before the Board. Moreover, to the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the parties before the Board, while the decision of the Board with respect thereto is not binding upon the court. *See, for example, Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986).

In view of the foregoing, and in the interest of judicial economy and consistent with the Board's inherent authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, applicant's motion to suspend is hereby **granted** to the [*12] extent that proceedings herein are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

The parties will note that notwithstanding the suspension of action on the instant opposition, the proceeding file for this opposition is being forwarded to the Chief Administrative Trademark Judge for consideration of applicant's petition for disqualification of opposer's attorney. n7

n7 In view of the foregoing, opposer's motion to extend the close of discovery is moot.

The petition for disqualification will be decided in due course. *See* Trademark Rule 10.63. *See also Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992); and *Little Caesar Enterprises Inc. v. Domino's Pizza Inc.*, 11 USPQ2d 1233 (Comm'r 1989).

Legal Topics:

For related research and practice materials, see the following legal topics:
Trademark Law
Infringement Actions
General Overview
Trademark Law
Special Marks
Service Marks
General Overview
Trademark Law
U.S. Trademark Trial & Appeal Board Proceedings
Oppositions
Grounds

GRAPHIC:

Illustration, no caption

Appendix B

1 Andrew D. Skale (SBN 211096)
 askale@mintz.com
 2 Justin S. Nahama (SBN 281087)
 jsnahama@mintz.com
 3 MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO P.C.
 3580 Carmel Mountain Road, Suite 300
 4 San Diego, CA 92130
 Telephone: (858) 314-1500
 5 Facsimile: (858) 314-1501
 6 Attorneys for Plaintiff
 HANGINOUT, INC.

8 UNITED STATES DISTRICT COURT
 9 SOUTHERN DISTRICT OF CALIFORNIA

11 HANGINOUT, INC., a Delaware
 corporation,
 12
 Plaintiff,
 13
 vs.
 14 GOOGLE, INC., a Delaware
 corporation,
 15
 Defendant.

Case No. '13CV2811 JAH NLS

COMPLAINT FOR:

- 1) **TRADEMARK INFRINGEMENT;**
- 2) **FEDERAL UNFAIR COMPETITION; AND**
- 3) **STATUTORY AND COMMON LAW UNFAIR COMPETITION**

[JURY DEMANDED]

18 Hanginout, Inc. (“Hanginout” or “Plaintiff”) brings this suit for trademark
 19 infringement, federal unfair competition, and common law unfair competition against
 20 Google, Inc. (“Google” or “Defendant”) and alleges as follows:

THE PARTIES

22 1. Hanginout is a Delaware corporation with its principal place of business
 23 at 2712 Jefferson Street, Carlsbad, CA 92008.

24 2. Upon information and belief, Google is a Delaware corporation with its
 25 principal place of business at 1600 Amphitheatre Parkway, Mountain View, CA
 26 94043.

1 10. Hanginout was formally founded in 2011, but developed its products at
2 least as early as approximately 2009.

3 11. Hanginout developed an interactive video-response platform with real-
4 time analytic solutions under the brand HANGINOUT. The platform analyzes
5 website demographics, usage, and audience interests. The platform enable users to
6 more effective develop, promote, and sell their brands by engaging, educating, and
7 entertaining their customers.

8 12. The HANGINOUT application is a novel social-media application that
9 gives users the ability to easily build and publish personal video profiles
10 complimented with a video publishing tool to create mobile video content.

11 13. Utilizing the HANGINOUT application, a user can explore, find and
12 follow interesting people, celebrities and personalities, ask them questions and
13 receive instant personal video responses.

14 14. The HANGINOUT application also gives users the unique ability to
15 field questions from anyone in the application, record and publish responses, and
16 share them from anywhere at any time.

17 **Federal Trademark Applications for Hanginout**

18 15. Given the importance of the brand HANGINOUT, Hanginout filed for
19 U.S. trademark applications on July 12, 2012.

20 16. The U.S. Patent and Trademark Office assigned Hanginout Application
21 Serial No. 85674801 (attached hereto as **EXHIBIT A**) for the HANGINOUT word
22 mark and Application Serial No. 85674799 (attached hereto as **EXHIBIT B**) for the
23 HANGINOUT design mark (collectively HANGINOUT marks).

24 17. The pending trademark applications for the HANGINOUT marks covers
25 the following goods and services: “Computer application software for mobile devices
26 for sharing information, photos, audio and video content in the field of
27 telecommunications and social networking services” in International Class (“IC”) 009
28

1 and “Telecommunications services, namely, providing online and telecommunication
2 facilities for real-time and on-demand interaction between and among users of
3 computers, mobile and handheld computers, and wired and wireless communication
4 devices; audio, text and video broadcasting services over the Internet or other
5 communications networks, namely, electronically transmitting audio clips, text and
6 video clips; electronic messaging services enabling individuals to send and receive
7 messages via email, instant messaging or a website on the Internet in the field of
8 general interest; providing online forums for communication on topics of general
9 interest; providing an online forum for users to share information, photos, audio and
10 video content to engage in social networking” in IC 038.

11 **Google Launches Google Hangouts**

12 18. On information on belief, on May 15, 2013, Google officially launched
13 its new messaging platform titled “Hangouts.”

14 19. On information and belief, Google’s “Hangouts” is a social-media based
15 video-chat service that enables both one-on-one and group chats. Hangouts can be
16 accessed through the Gmail or Google+ websites, or through mobile applications
17 available for Android and iOS.

18 20. On April 26, 2013, Google filed an application to register the mark
19 “Hangouts,” Application Serial No. 85916316.

20 21. Google’s “Hangouts” mark is nearly identical to Hanginout’s
21 HANGINOUT mark in both appearance and sound.

22 22. On information and belief, mirroring Hanginout’s products, Google’s
23 “Hangouts” trademark application sought to cover nearly identical mobile-video
24 based communication products including:

- 25 a. “Downloadable software for publishing and sharing digital media and
26 information via global computer and communication network; instant
27 messaging software; communications software for electronically
28

1 exchanging voice, data, video and graphics accessible via computer,
2 mobile, wireless, and telecommunication networks; computer software
3 for processing images, graphics, audio, video, and text; computer
4 software development tools; computer software for use in developing
5 computer programs; video and audio conferencing software” (IC 009);

6 b. “Telecommunications services, namely, electronic transmission of data
7 and digital messaging via global computer and communication
8 networks; providing online forums, chat rooms and electronic bulletin
9 boards for transmission of messages among users in the field of general
10 interest; digital multimedia broadcasting services over the Internet,
11 namely, posting, displaying, and electronically transmitting data, audio
12 and video; providing access to computer databases in the fields of
13 general interest; instant messaging services; voice over ip (VOIP)
14 services; video and audio conferencing services conducted via the web,
15 telephone, and mobile devices; communications by computer terminals;
16 local and long distance telephone services; mobile telephone
17 communication services” (IC 038)

18 c. “Entertainment services, namely, providing temporary use of non-
19 downloadable interactive multiplayer and single player games played via
20 global computer and communication networks” (IC 041);

21 d. “Providing temporary use of on-line non-downloadable software for
22 publishing and sharing digital media and information via global
23 computer and communication networks; Providing temporary use of on-
24 line non-downloadable software development tools; Providing
25 temporary use of on-line non-downloadable software for use as an
26 application programming interface (API); Providing a web hosting
27 platform for others for organizing and conducting meetings, social
28

1 events and interactive text, audio, and video discussions; Providing an
2 on-line network environment that features technology that enables users
3 to share data; computer software consulting; application service provider
4 (ASP) services featuring computer software for transmission of text,
5 data, images, audio, and video by wireless communication networks and
6 the Internet; application service provider (ASP) services featuring
7 computer software for electronic messaging and wireless digital
8 messaging” (IC 042).

9 23. On July 30, 2013, the U.S. Patent and Trademark Office suspended
10 Google’s Hangout application because of the HANGINOUT mark. The suspension
11 notice is attached hereto as **EXHIBIT C**.

12 24. The suspension notice concluded that if the HANGINOUT mark
13 registers, Google may be prevented from receiving a trademark registration for
14 “Hangouts” based on likelihood of confusion with the HANGINOUT mark.

15 25. Google continues to aggressively market its Hangouts product.

16 26. Hanginout is informed and believes, and based thereon alleges, that
17 Google has advertised Google’s Hangouts to replicate Hanginout’s products’
18 capabilities. For example, Google has described its product capabilities as:

- 19 a. “Bring your conversations to life with photos, email, and video calls for
20 free.”
- 21 b. “Turn any Hangout into a live video call with up to 10 friends or simply
22 search for a contact to start a voice call from your computer.”
- 23 c. “Hangouts work the same everywhere- computers, Android, and Apple
24 devices – so nobody gets left out.”
- 25
26
27
28

FIRST CAUSE OF ACTION

TRADEMARK INFRINGEMENT

(15 U.S.C. § 1114 *et seq.* and Common Law)

1
2
3
4 27. Hanginout incorporates by reference all other paragraphs contained in
5 this Complaint.

6 28. Google's Hangout mark is identical or substantially similar in sound,
7 appearance and meaning to Hanginout's HANGINOUT marks.

8 29. Google has used the HANGINOUT marks or a confusingly similar
9 variation of them, in connection with the sale, offering for sale, distribution or
10 advertising of goods and/or services.

11 30. Google's wrongful use of the HANGINOUT marks constitutes
12 trademark infringement of Hanginout's HANGINOUT marks, has caused significant
13 confusion in the marketplace, and is likely to cause both confusion and mistake,
14 along with being likely to deceive consumers.

15 31. Google's infringement of Hanginout's marks was willful and with
16 knowledge that such its use of the "Hangout" mark would or was likely to cause
17 confusion and deceive others.

18 32. As a direct and proximate result of Google's trademark infringement,
19 Hanginout has been damaged within the meaning of 15 U.S.C. § 1114 *et seq.*

20 33. As a direct and proximate result of Google's trademark infringement,
21 Hanginout has been damaged within the meaning of 15 U.S.C. § 1125 *et seq.*

22 34. Hanginout has suffered damages in an amount to be established after
23 proof at trial.

24 35. Hanginout is further entitled to disgorge Google's profits for its willful
25 sales and unjust enrichment.

THIRD CAUSE OF ACTION

**STATUTORY (Cal. B&P 17200 *et seq.*) AND COMMON LAW UNFAIR
COMPETITION**

41. Hanginout incorporates by reference all other paragraphs contained in this Complaint.

42. Google has committed acts of unfair competition, including the practices and conduct referred to in this Complaint. These actions constitute unlawful, unfair or fraudulent business acts or practices, and/or unfair, deceptive, untrue or misleading business practices. The actions were done in connection with sales or advertising.

43. As a direct and proximate result of Google's wrongful acts, Hanginout has suffered and continues to suffer substantial pecuniary losses and irreparable injury to its business reputation and goodwill. As such, Hanginout's remedy at law is not adequate to compensate for injuries inflicted by Google. Accordingly, Hanginout is entitled to temporary, preliminary and permanent injunctive relief.

44. By reason of such wrongful acts, Hanginout is and was, and will be in the future, deprived of, among other damages, the profits and benefits of business relationships, agreements, and transactions with various third parties and/or prospective business relationship. Google has wrongfully obtained profit and benefits instead of Hanginout. Hanginout is entitled to compensatory damages and disgorgement of Google's said profits, in an amount to be proven at trial.

45. Such acts, as alleged above, were done with malice, oppression and/or fraud, thus entitling Hanginout to exemplary and punitive damages.

WHEREFORE, Plaintiff demands the following relief for each cause of action unless otherwise noted:

1. A judgment in favor of Hanginout and against Google on all counts;
2. A preliminary and permanent injunction from trademark infringement and unfair business practices by Google;

- 1 3. Damages in an amount to be determined at trial;
- 2 4. Google's unjust enrichment and/or disgorgement of Google's profits;
- 3 5. Trebling of damages for willful infringement and unfair competition;
- 4 5. Exemplary and punitive damages (except as to relief for Cal. B&P
- 5 17200 *et seq.*);
- 6 6. Pre-judgment interest at the legally allowable rate on all amounts owed;
- 7 8. Costs and expenses;
- 8 9 Attorney's fees and other fees under, among others, 15 U.S.C. § 1117(a)
- 9 *et seq.* as an exceptional case;
- 10 10. Restitution; and
- 11 11. Such other and further relief as this Court may deem just and proper.

12 Dated: November 26, 2013

MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO PC

14
15 By /s/Andrew S. Skale, Esq.
16 Andrew D. Skale
Justin S. Nahama

17
18 Attorneys for Plaintiff
HANGINOUT, INC.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a jury trial as to all issues that are so triable.

Dated: November 26, 2013

MINTZ LEVIN COHN FERRIS GLOVSKY
AND POPEO PC

By /s/Andrew S. Skale, Esq.

Andrew D. Skale

Justin S. Nahama

Attorneys for Plaintiff

HANGINOUT, INC.

25328999v.1