

ESTTA Tracking number: **ESTTA39890**

Filing date: **07/25/2005**

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

Proceeding	92044538
Party	Plaintiff Missiontrek Ltd. Co. Missiontrek Ltd. Co. 813 Palm Desert Drive Garland, TX 75044
Correspondence Address	SHERMAN D. PERNIA, PH.D, ESQ. SHERMAN D. PERNIA 1110 NASA ROAD ONE, SUITE 450 HOUSTON, TX 77058
Submission	RESPONSE TO REGISTRANT'S MOTION FOR SUMMARY JUDGMENT AND REQUEST FOR DISCOVERY
Filer's Name	Sherman D. Pernia, Ph.D, Esq.
Filer's e-mail	sherman@patentinfo.net
Signature	/sherman d pernia/
Date	07/25/2005
Attachments	ONFOLIO MUS-M001-002-C.pdf (14 pages)

I.

The Summary Judgment Standard:

According to Federal Rule of Civil Procedure (Rule) 56(c), Summary Judgment is properly granted where the pleadings and supporting materials "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." "In this regard, 'material' means that a contested fact has the potential to change the outcome of the suit under the governing law if the dispute over it is resolved favorably to the nonmovantBy like token, 'genuine' means that 'the evidence about the fact is such that a reasonable jury could resolve the point in favor of the nonmoving party'" *McCarthy v. Northwest Airlines, Inc.*, 56 F.3d 313, 315 (1st Cir. 1995) (citations omitted). Registrant has failed to show the absence of material facts and has failed to cite convincing case law such that a reasonable jury could resolve the point of likelihood of confusion in favor of Registrant.

II.

Evidence of Actual Confusion:

Survey results, averred to by John Moeteli in the affidavit attached as **Exhibit A**, entitled AFFADAVIT SUPPORTING EVIDENCE OF ACTUAL CONFUSION BASED ON SURVEY RESULTS, show a full 25% of respondents indicated that the products names were so similar that it is likely that the products come from the same source. This percentage greatly exceeds the typical 10% of actual confusion which the courts generally require to find likelihood of confusion and thus trademark infringement. See "Survey Evidence of Likelihood of Confusion in Trademark Cases: How Much Confusion is Enough? » by *James D. Nelson*, April 2002, URL : http://www.bpmlaw.com/publications/getPrintablePublication.asp?publication_id=48 . "Although evidence of actual confusion is not necessary to a finding of likelihood of confusion, it is nevertheless the best evidence of likelihood of confusion." *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 978 (11th Cir.1983) (quoting *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir.), cert. denied, 449 U.S. 899, 101 S.Ct. 268, 66 L.Ed.2d 129 (1980)). Actual confusion by a few customers is evidence of likelihood of confusion by many customers. See *Freedom Sav. and Loan Ass'n*, 757 F.2d at 1185. Consequently, a plaintiff usually will not have to prove more than a few incidents of actual confusion. See *id.* Therefore, considering the fact that Petitioner has presented the best

evidence of likelihood of confusion, Registrant's Motion for Summary Judgment should be denied forthwith.

III.

The Goods are Admitted to be Identical—Marks Similar, raises Material Fact

Questions:

Registrant's admission as to the relatedness of the goods, and the fact that, in Summary Judgment, all legitimate factual inferences must be made in favor of the nonmovant, require the Board to consider that the products are as identical as asserted by the Petitioner. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 255, 91 L. Ed. 2d 202, 216 (1986), *Cadle Co. v. Hayes*, 116 F.3d 957, 959 (1st Cir. 1997). In this case, consequently, it must be inferred for the sake of this Motion of Summary Judgment that the allegations made by the Petitioner are true, namely, that the products are not merely similar or related, but identical. Now, applying the rule that the more related the goods sold under the respective marks the more likely that confusion may result, requires the Board to dismiss this Motion for Summary Judgment, because, given that the products are identical, and include more than one similarity in the trademark, there is more than a *de minimus* material fact issue raised as to likelihood of confusion. *AMF, Inc. V. Sleekcraft Boats*, 599 F.2d 341, 350 (9th Cir. 1979).

IV.

Elements supporting Summary Judgment not Met—Failure to Well Plead:

According to Federal Rule of Civil Procedure (Rule) 56(c), Summary Judgment is properly granted where the pleadings and supporting materials "show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law." In *Celotex Corp. v. Catrett*, 477 U.S. 317, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986), the Supreme Court held that in a Summary Judgment motion, the moving party's burden in such situations is **simply to identify the elements** of its adversary's case with respect to which it considers there to be a deficiency in proof. Registrant has failed to make the elements for his claim of Summary Judgment. Completely lacking from the Motion is a listing of the elements necessary to support a Summary Judgment, one such element being the absence of any material fact sufficient to justify Petitioner's cancellation action. In addition, the party moving for Summary Judgment must demonstrate an absence of evidence to support

the nonmoving party's case. *Celotex Corp. v. Catrett*, 477 U.S. 317, 325 (1986). What has Registrant plead that shows the absence of any material fact? Even the facts alleged to be immaterial are not clearly identified. Consequently, Petitioner requests that this Motion be denied.

V.

Further claim of similarity:

In addition to the fact that the suffix "IO" is present in the two conflicting marks, and that, when written, Cartagio and Onfolio look similar, the beginning and the end having rounded letters (C/O vs O/O), and that when spoken aloud, the sound is very similar, the accent is identical (which goes to the *phonetic* similarity, a well-established characteristic for comparing trademarks), with essentially the same length, Petitioner wishes the Board to consider a further similarity, not yet articulated by Petitioner. When written in lower case letters, there are two letters in the middle portion of the marks having appendages that extend beyond the normal limits of a lower-case letter, namely the T and the G of Cartagio, and the F and the L of Onfolio. Such similarities further contribute to the overall impression that the marks are confusingly similar, particularly when viewed indirectly, peripherally, out of focus, or at a distance.

VI.

Onfolio is the Junior User—Subject to Newcomer Rule:

Regarding the well-established Newcomer Rule, "a newcomer or junior user who does not search prior uses and registrations before venturing forth, should not be surprised when conflict arises". "It is well-settled that one who adopts a mark similar to the mark of another for closely related goods acts at his peril and any doubt there might be must be resolved against him" *Carlisle Chemical Works, Inc., Hardman & Holden, Ltd.*, 58 CCPA 751, 434 F. 2d 1403, 168 USPQ 110 (1970). See *Tiffany v. National Gypsum Co.*, 59 CCPA 1063, 459 F. 2d 527, 173 USPQ 793 (1972)(rule applies in opposition proceedings). Applying the Newcomer Rule here, how much more cautious should a newcomer be if the goods are identical? Petitioner asserts that Registrant has not exercised good faith in avoiding the rights of others, particular those of his competitors' pre-existing products. The determination of good faith is a fact issue which is material as it will determine the efforts the standard that the

newcomer must take in this case, to avoid Petitioner's rights. Consequently, on this grounds as well, Petitioner requests that the Motion for Summary Judgment be denied.

VII.

Discovery is required and Requested:

Discovery is required on the issues of prior knowledge, intent, willfulness, and actual confusion, such being relevant to the determination of good faith under the Newcomer Rule and to the issue of confusion itself. In *Celotex Corp. v. Catrett*, 477 U.S. 317, 91 L. Ed. 2d 265, 106 S. Ct. 2548 (1986), the Supreme Court held that "the plain language of Rule 56(c) mandates the entry of Summary Judgment, *after adequate time for discovery* and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." *Id.* at 322. Therefore, discovery is required in this case to determine, *inter alia*, whether or not the author of the characterization of the Movant as « a newcomer ? » (see **Exhibit C** of Petitioner's Petition for Cancellation) indicate that the author was confused as to whether Onfolio was related to one of the already mentioned companies, Petitioner asserts, most likely the developer of Cartagio, which he characterized as an « established » product.

VIII.

Cartagio is a "Well-Established" Mark:

As indicated in **Exhibit C**, attached to the Petition for Cancellation, Cartagio is a "well-established" product and Onfolio is characterized as the newcomer. Petitioner does not know whether his mark CARTAGIO is a famous mark. Market surveys may be performed however, to ascertain Petitioner's status. Fame is a factor to consider in evaluating likelihood of confusion. Because the fame of Petitioner's mark must be established via such market surveys and consequently, on this grounds as well, Summary Judgment should not be granted.

IX.

Summary Judgment is Not Appropriate under these Circumstances:

Registrant seeks Summary Judgment, citing a variety of cases for the proposition that there is no likelihood of confusion. However, only one of the cited cases were determined on

Summary Judgment, namely the *Keebler* case, discussed below in more detail. In this case, the only arguable distinctive similarity at issue was the plural ending of the second part of compound marks. Thus, no comparison can properly be made here as the “IO” ending is much more distinctive than a common plural ending. Consequently, applying Registrant’s own precedent, Summary Judgment should not be granted here.

X.

Cited Case Law does not establish a Basis for Summary Judgment:

Registrant alleges that it has made out a case for Summary Judgment as there is no likelihood of confusion *as a matter of law*. However, a review of the cited cases shows that nothing could be further from the truth.

In said Motion for Summary Judgment, Registrant alleges that Petitioner’s mark and Applicant’s mark are dissimilar in appearance, sound, meaning and commercial impression, by citing *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin*, 396 F. 3d. 1369, “the legal test for similarity is based on the mark’s appearance, sound, meaning and commercial impression; “commercial impression” is sometimes used as a proxy for the ultimate conclusion of (similarity or cf. said case) dissimilarity based on appearance, sound and meaning”. First of all, in this cited case, the central issue was related to the presence of “Veuve” in the two marks, an arbitrary term for a champagne mark, so that the risk of confusion was high. The court in fact held that it was confusing. Based on this case, Registrant is quick to conclude that Petitioner’s and Registrant’s marks are not confusingly similar, but nothing in this case supports that inference. In fact, as Petitioner has already articulated, appearance is very similar. On the contrary, as in the cited *Veuve* case, not only is the suffix “IO” present in the two marks, but when written, Cartagio and Onfolio look similar, the beginning and the end having rounded letters (C/O vs O/O) and the “IO” suffix is exactly the same in the two marks. Besides these facts, when spoken aloud, the sound is very similar; the accent is identical, with essentially the same length. As mentioned above, another similarity not yet articulated by Petitioner is that, when written in lower case letters, there are two letters in the middle portion of the marks having appendages that extend beyond the normal limits of a lower-case letter, namely the T and the G of Cartagio, and the F and the L of Onfolio. This fact further supports a conclusion of visual similarity of the two marks. As already mentioned, the “IO” ending has no particular meaning in relation to computer software, so that this aspect of Cartagio is arbitrary and thus provides a basis for a strong mark for

computer software. Consequently, the use of a very similar word for the same product, by a *junior* user, a newcomer, the relatedness having been conceded by the Registrant, makes the likelihood of confusion rather high. Furthermore, because the products are conceded as being essentially identical, the commercial impression is clearly that the source of the goods are related and not the contrary. This combined with the fact that Missiontrek makes a strong claim of ownership of intellectual property, further contributes to the likelihood of confusion among potential purchasers, particularly when potential purchaser reads the firms' respective websites. Consequently, there being significant fact issues yet to be determined, Summary Judgment should be denied forthwith.

Further, Registrant argues dissimilarity of the two said marks citing *Keebler Company v. Murray Bakery Products*, 866 F. 2nd 1386 (CAFC 1989), a case in which the Court affirmed the Board's dismissal in Summary Judgment of an opposition by the owner of PECAN SANDIES to an application for the trademark PECAN SHORTEES. Indeed, both marks begin with an "s" and ends with an "ies". but, as mentioned above, this ending in this case is *not at all distinctive in that almost every noun in the English languages has a plural form ending in "s", "es" or "ies"*. On the contrary, "io" is not at all a common ending of the English language and for this reason is highly distinctive. In this case, the Court made it very clear that the presence of PECAN, a generic term, was incapable of creating a likelihood of confusion. One may be able to say the same for the "s" ending. Further, it should be mentioned that the Court affirmed the dismissal of appellant's opposition based on a conclusion that appellant was properly denied discovery under Fed. R. Civ. P. 56(f) because appellant failed to set forth reasons why facts essential to its opposition to appellee's Motion for Summary Judgment were not presented by affidavit. On the contrary, with this present response, Petitioner attaches **Exhibit A**, the affidavit of Moetteli, indicating the presence of actual confusion.

In addition, to assert that no similarity exists between Cartagio and Onfolio, Registrant cites *Quaker Oats Col. vs. General Mills, Inc.*, 134 F. 2nd 429 (7th Circ. 1943) as well. In this case, OATIES was held to not be confusingly similar to the famous mark WHEATIES, as the owner of WHEATIES could not appropriate the diminutive suffix "IES" which was already used by other makers of similar products. This case therefore supports Petitioner's argument that the reason for the decision in the *Keebler* case was the fact that the ending "ies" is used in so many marks, being the plural form that it is not at all distinctive. Furthermore, *Quaker Oats* was not a trademark case, but a unfair competition case. Nevertheless, it is very relevant to

mention that in this case the Court in fact refused to grant the petition of the plaintiff to register "Oaties".

In the case of *Polaroid Corporation v. Oculens, Ltd.*, 196 USPQ 836 (TTAB 1977), it is indeed true that the board found no confusing similarity between the registered mark POLAROID and that applicant's mark FILTEROID, even though both marks were used for sunglasses and even though the POLAROID mark was famous. However, what the Registrant forgets to mention is that the board concluded that the two marks were distinguishable because the case failed "to show a single instance of purchaser confusion from the contemporaneous use of the respective marks over such a long period of time (more than 20 years)". Cartagio's mark, on the other hand, has been used only since about September 2001 as the certificate of registration indicates, so that the instant facts lack this long period of peaceful coexistence present in *Polaroid*. Registrant quotes the Board's holding that "OID" is a common suffix which has the standard dictionary meaning of "likeness" or "resemblance" and which appears in a number of third party registrations. Petitioner, on the other hand, asserts that the suffix "IO" has no such common meaning, providing Registrant's mark with distinctivity. See Appendix A of Registrant's motion. Further, the Board concluded that because the words POLAR and FILTER have completely different connotations. In the instant case, neither CARTAG nor ONFOL have any meaning to an ordinary consumer---consequently, no one is likely to associate these portions of the mark with any known English meaning (and few will have any idea that CARTAG has anything to do with an ancient Roman city in the country of Tunisia).

Still further, in *Bulova Watch Company, Inc. v. Albert J. Miller*, 463 F. 2nd 1376 (CCPA 1972), which Registrant cites in his favor, the Court affirmed the Board's ruling that ACCUTRON and UNITRON were not confusingly similar, even though both marks were used for watches. Again Registrant fails to mention the real issue of said case, which is the fact that "TRON" designates a particular *type* of product, namely, an electronic product, but not an identical product. It is evident that because of that common use of "TRON" in the watch industry to designate *electronic* watches, any claim of distinctivity in this suffix should be denied. Further, not only does Registrant quote the Court's observation that "UNITRON and ACCUTRON just do not look alike, sound alike or connote alike", forgetting to mention that the Court mentions that the body of the respective marks indeed have meaning among consumers, not the case here, and the fact that *Bulova* cites *Bulova Watch Co., Inc. v. Waltham Watch Co.* concerning the marks ACCUTRON and AUTOCHRON, similar in sound as well as in form, but applying the well-established principle of trademark law of

resolving the doubt in favor of the first user to resolve this case. It is a fact that mark CARTAGIO is the senior user and that the newcomer, Onfolio, must therefore use extreme caution in selecting a mark to distinguish its goods from those of the senior user. Movant has utterly failed to take even the most basic caution here in naming their product ONFOLIO, essentially a functional copy of Petitioner's product CARTAGIO, and thus, all doubt should be assessed in the favor of senior user, the Petitioner. The standard is very similar to that of Summary Judgment in fact, and therefore, the inability of the Board to rule in Registrant's favor on its motion of Summary Judgment now presented, should be taken by Registrant as a strong indication of the ultimate outcome of this Cancellation action—Petitioner asserts again that the mark ONFOLIO should be cancelled.

Then later, Movant cites *Magnaflux Corp. vs. Sonoflux Corp.*, 231 F. 2nd 669 (CCPA 1956) for the proposition that those two marks were considered not confusingly similar, even though used on the same goods. Registrant forgets to mention, however, the grounds for that decision. First of all, FLUX and SON were considered as descriptive. "If a part of a mark is descriptive in nature, and has little or no trademark significance, it cannot be regarded as dominant and will generally be given less weight than more arbitrary portions of the marks." *Id* at 670. Cartagio as a whole is clearly distinctive because it essentially does not have a meaning, certainly not a meaning in the field of computer software. On the contrary, the ending "IO" is arbitrary, making it a highly distinctive portion of Petitioner's mark. In addition, Registrant does not mention that in the *Magnaflux* case, a factor considered by the CCPA is that the goods were expensive and sophisticated purchasers were involved which helped avoid any risk of confusion. It is not at all the same situation considered regarding CARTAGIO, selling at about \$75 per user license and ONFOLIO at about \$30 per user license. Neither the acquisition of nor the use of the products requires sophistication on the part of a purchaser beyond what is ordinarily required of the typical user of other generally available browser applications.

In *Cutter Laboratories, Inc. v. Air Products and Chemicals*, 189 USPQ 108 (TTAB 1975) cited by Registrant, the Board indicated that "these different products [STERI-FLEX and RESIFLEX] appear to be clearly of a type that would be expected to emanate from a single source or producer". This case does not fit the facts of this case. In *Cutter*, the suffix "FLEX" has a clear meaning, i.e, a characteristic of the product of being *flexible* and is used by many others as a type of goods. There is therefore no distinctivity in this suffix. Although not mentioned by the Board in *Cutter*, it is evident that this type of product is sold to sophisticated consumers in the field "physicians and/or hospital administrators and purchasing

agent” for whom technical language is a precise enough language such that it is known that “STERI” does not mean “RESI”. Further, “STERI” in the context of medical products, connotes something that is “sterile”. “Resi” connotes “resistant” or “resine”. Again, in the case of Petitioner’s registered mark CARTAGIO, the ending “IO” has no connotation in the computer software field and therefore should be considered arbitrary and thus highly distinctive.

Consequently, neither *Cutter* nor *Magnaflux* nor *Bulova* nor *Polaroid* nor *Quaker Oats* nor *Keebler* nor *Palm Bay Imports* support a dismissal of the instant Cancellation as a matter of law. Acknowledgement of this fact is respectfully requested.

XI.

Third Party Registrations Cited by Movant are not dispositive on the issue of likelihood of confusion:

Petitioner has reviewed the cited prior registrations including the suffix “IO” and can find none, other than PENOKIO, Serial No. 75220926 and PROVISIO, Serial No. 78027870, that include in their respective list of goods Internet browsing software. Further, a review of the products associated with the PENOKIO mark online, at www.penokio.com does not readily reveal that they are using the mark for any sort of Internet browser product. Still further, a review of the website for PROVISIO, at www.provisio.com, does not show any use of the mark PROVISIO in association with web browsing software. Rather, Provisio is the company name and their product trademark is SiteKiosk™. In any case, regarding the PENOKIO registration, this mark clearly brings to mind the wooden puppet of children’s stories in such a strong manner that no separate distinction is derived from the “io” suffix. Consequently, the prior registrations cited by Registrant are not at all dispositive on the issue of likelihood of confusion in this case.

§ § §

WHEREFORE, in consideration of the above arguments and attached Exhibits, Petitioner prays that said Motion for Summary Judgment be dismissed and that the case be opened for discovery and passed on for substantive consideration by the Board.

Petitioner submits herewith a duplicate copy of response to Motion for Summary Judgment and authorizes the Board to debit the account of MOETTELI & Associates SaRL. No. 502621, to cover any fees which may be due therefore.

Respectfully submitted,

Date: 25 July 2005

By 
Sherman D. Pernia, Ph. D., JD
Reg. No. 34,404
1110 NASA Road ONE, Suite 450
Houston, Texas 77058-3346
Phone: 281-333-0880
Fax: 281-333-9144

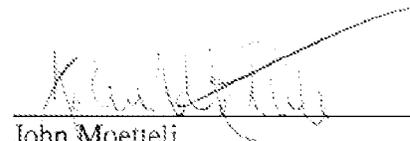
Enclosure: Exhibit A, with attachment

§ § §

I declare, under penalty of perjury under the laws of the United States of America, that that portion of the foregoing which is based on personal knowledge is true and correct and that portion which is based on knowledge or belief is believed by me to be true and correct.

Declarant's signature:

Date: July 21, 2005


John Moetteli

Enclosure: sample email survey result

John Moetteli

From: [REDACTED]
Sent: Mittwoch, 20. Juli 2005 02:56
To: John Moetteli
Subject: Re: Quick Cartagio User Survey-Onfolio

I answer "B".

Best [REDACTED]

John Moetteli wrote:

> Dear Power Internet User,

>
> You have been selected from a short list of less than one hundred
> recipients who have downloaded our CAPTRACIO product in the past and
> are frequent internet users. Thank you in advance for your
> participation in this single question survey, designed to serve you
> better.

>
> Simply respond to sender, answering the below question, immediately
> after your first read (i.e., we're after your first impression, not an
> answer given after having had a chance to research the issue):

>

> With respect to a recently released online research/knowledge
> management product, called ONFOLIO, which of the below statements is
> most likely to be true?

> A. Because the product names are similar, ONFOLIO is likely a licensee
> of Missiontrek, the developer of CAPTRACIO.

> B. Because the product names are similar, ONFOLIO is likely a product
> of Missiontrek, adapted for a particular niche.

> C. I see no similarity at all. Consequently, there is likely no
> relationship between the products.

>

> Thank you for your time. I will be personally grateful to all of you
> who participate in this important survey.

> Best regards,

> Ted Management

> Missiontrek Ltd. Co.