

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

MISSIONTREK LTD. CO.,  
Petitioner

v.

ONFOLIO, INC.,  
Registrant.

Cancellation No. 92044538

v.

Reg. No. 2,904,982

78/296,697  
78/163,187

**REGISTRANT'S REPLY TO PETITIONER'S RESPONSE TO REGISTRANT'S MOTION  
FOR SUMMARY JUDGMENT AND REQUEST FOR DISCOVERY**

Registrant, Onfolio, Inc., ("Registrant"), hereby replies to Petitioner's Response to Registrant's Motion for Summary Judgment and Request for Discovery ("Response").

**1. Petitioner has Failed to File a Motion under Rule 56(f) and is therefore Not Entitled to Discovery**

Petitioner characterizes its Response as being also a "Request for Discovery." However, if Petitioner wanted discovery, it was required to file a Motion for same under Federal Rule of Civil Procedure 56(f). 37 CFR §2.127(e)(1). Petitioner failed to file such a Motion, and instead filed a substantive Response. Consequently, Petitioner is not entitled to discovery. See *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F. 2<sup>nd</sup> 1560, 4 USPQ 2d. 1793, 1799 (CAFC 1987)("A party may not simply assert in its brief that discovery was necessary and thereby overturn summary judgment when it failed to comply with the requirement of Rule 56(f)"); *Avia Group International Inc. v. L.A. Gear California, Inc.*, 853 F.2d 1557, 7 UPSQ 2<sup>nd</sup> 1548, 1551 (CAFC 1988) (litigant's complaint that it needed discovery will not be heard when discovery was precluded by its own failure to seek Rule 56(f) protection); *Institut National Des Appellations d' Origine v. Brown- Forman Corp.*, 47 USPQ 2<sup>nd</sup> 1875, 1887 n. 13 (TTAB 1998) (opposers' statement that they intended to take discovery "is neither a proper request for discovery under Fed. R. Civ. P. 56 (f), nor does it constitute proper evidence in support of opposers' opposition to applicant's motion for summary judgment"); *Blansett Pharmacal Co. Inc. v. Carmrick Laboratories Inc.*, 25 USPQ 2<sup>nd</sup> 1473, 1476



(TTAB 1992)(failure of summary judgment respondent to move for discovery under Rule 56(f) constitutes presumption that discovery was not considered essential to response).

**2. Summary Judgment is Appropriate on the Issue of No Likelihood of Confusion, and Registrant has Adequately Stated the Grounds for Same**

Petitioner curiously argues that Registrant's summary judgment motion does not adequately "plead" the elements of a summary judgment claim. *Response* at 3-4. Of course, Registrant's Motion for Summary Judgment is not a "pleading," such as an Answer or a Counterclaim. In any case, the first paragraph of Registrant's Motion states as follows:

Registrant, Onfolio, Inc. ("Registrant"), hereby moves for summary judgment on the ground that, as a matter of law, its registered mark ONFOLIO is not confusingly similar in appearance, sound, meaning or commercial impression to the registered mark CARTAGIO, owned by Petitioner Missiontrek Ltd. Co. ("Petitioner").

Registrant's Motion then provides detailed arguments, supported by precedent, as to why the marks are not confusingly similar as a matter of law. Petitioner's objection is therefore groundless.

The CAFC has made it clear that likelihood of confusion issues may be resolved on summary judgment. *Sweats Fashions, Inc. v. Pannill Knitting Co., supra* at 1797 (CAFC 1987) ("The uniform precedent of this court is that the issue of likelihood of confusion is one of law....Thus, the Board may unquestionably resolve that issue on summary judgment"); *Keebler Co. v. Murray Bakery Products*, 866 F. 2<sup>nd</sup> 1386, 9 USPQ 2d 1736 (CAFC 1989) (confirming the Board's grant of summary judgment dismissing an opposition on the grounds that Petitioner's mark PECAN SANDIES and Registrant's mark PECAN SHORTEES were not confusingly similar in appearance, sound and meaning); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 951 F. 2<sup>nd</sup> 330, 21 USPQ 2d 1142 (CAFC 1991) (affirming Board's grant of summary judgment dismissing opposition on the grounds of no likely confusion between Petitioner's mark FROOT LOOPS and Registrant's mark FROOTEE ICE); *Pure Gold, Inc. v. Syntex (U.S.A.), Inc.*, 739 F. 2<sup>nd</sup> 624, 222 USPQ 741 (CAFC 1984) (affirming Board's summary judgment dismissal of opposition on grounds of no likely confusion).

**3. Petitioner's Arguments as to Confusing Similarity are Frivolous and Unsupported by Precedent**

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In its Petition for Cancellation, Petitioner provided inaccurate and specious arguments in support of its claim regarding the alleged similarity of the marks here at issue. Among other things, Petitioner mistakenly argued that ONFOLIO and CARTAGIO “have the same number of letters.” Having recognized its mistake, Petitioner is now reduced to arguing that the marks have “essentially the same length.” *Response* at 4. Petitioner concedes the lack of precedent for any of its arguments by failing to cite a single case in support of them. Instead, Petitioner offers the following novel and equally frivolous assertions:

When written in lower-case letters, there are two letters in the middle portions of the marks [Onfolio and Cartagio] 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.

*Id.* Once again, Petitioner cites no cases whatsoever to support these peculiar contentions, e.g., that confusing similarity should be judged from the viewpoint of a consumer who is visually impaired. Moreover, Petitioner provides no authority on what the “normal limits of a lower-case letter” are, and does not explain why particular letters, such as a lower-case “t”, can be said to “extend beyond” such “normal” limits.

**4. Petitioner's “Survey” is not Entitled to Any Consideration**

In support of its Response, Petitioner submits a document entitled “Affadavit [*sic*] Supporting Evidence of Actual Confusion Based on Survey Results.” This document has been signed by John Moetteli, who identifies himself as the “director” of Petitioner.

Mr. Moetteli states that on July 14, 2005 he prepared “an email survey of 42 persons who had recently downloaded our CARTAGIO software and who otherwise were believed to be able to provide Petitioner with an objective opinion on the issue of likelihood of confusion.” Mr. Moetteli does not indicate who the respondents were, nor why he thought they were “objective.” Moreover,

while his affidavit attaches a copy of his e-mail "survey," it does not attach copies of the actual responses.

The operative content of Mr. Moetteli's "survey" reads as follows:

"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 CARTAGIO.
- 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."

Mr. Moetteli states that of the 42 persons contacted, only eight responded. He claims (again without providing the actual evidence) that "of these eight responses, two indicated actual confusion and six indicated no confusion."

On the basis of these figures, Mr. Moetteli triumphantly proclaims that "a full 25% of those surveyed indicated confusion"--that is, two out of eight. This inflationary rhetoric cannot disguise the fact that, at best, only two persons allegedly indicated "confusion." However, when one looks at the actual "survey," one sees that it is devoid of any probative value, for the following reasons:

a. Inexpert and Biased Design And Administration

The "survey" was not designed or taken by a professional. Rather, it was designed and taken by Petitioner's director, John Moetteli, an individual who has provided no evidence showing that he is an expert or otherwise experienced in the creation and administration of surveys. Moreover, as Petitioner's director, Mr. Moetteli was hardly an independent or unbiased party. This lack of expertise and objectivity renders the "survey" effectively worthless. *Hilson Research Inc. vs. Society for Human Resource Management*, 27 USPQ 2<sup>nd</sup> 1423 (TTAB 1993) (survey deemed untrustworthy and not entitled to any probative value where, *inter alia*, the individuals who designed and administered the survey were not experts and where a survey interviewer was not an unbiased

person); *Hershey Foods Corporation v. Cerreta*, 195 USPQ 246 (TTAB 1997)(“the objectivity of the survey is at question since it was designed by one of opposer’s officials”).

b. Failure to specify or provide information regarding respondents

As noted above, Mr. Moetelli provides no information regarding the identity or affiliation of the respondents, other than that they were Petitioner’s customers. Thus, we do not know whether these customers were truly “objective,” or whether, on the contrary, they were people who might be deemed to favor Petitioner. See *Sheller-Globe Corporation v. Scott Paper Company*, 204 USPQ 329 (TTAB 1979)(survey entitled to no weight where, *inter alia*, “the selection of the sample was not adequately explained”).

c. Failure to Provide Actual Responses

Mr. Moetelli does not provide the eight responses received as a result of taking the survey, but instead summarizes them in conclusory fashion. By failing to provide the actual responses, he does not allow a determination as to whether the two responses that allegedly indicated “confusion” were definite and unqualified, or qualified and inconclusive.

d. No Approximation of Actual Market Conditions

The so-called “survey” did not approximate the actual market conditions in which the respondents would encounter Registrant’s mark. Purchasers who buy Registrant’s software must download it exclusively from Registrant’s website, or from a screen on a partner website featuring Registrant’s mark and graphics. However, the respondents to Petitioner’s “survey” were not directed or given links to either of those sites. If the two respondents who allegedly indicated “confusion” had seen the actual sites from which Registrant’s software must be downloaded, they might have decided that they were in no way “confused.”

Moreover, when products are not sold side-by-side, as is the case here, the marks themselves should not be displayed side-by-side as a survey stimulus. See *Marshall Field & Co. v. Mrs. Field’s Cookies*, 25 USPQ 2d 1321 (TTAB 1992) (side-by-side presentation deemed to be prejudicial since

the products were “unlikely to be seen in this mode in an actual encounter in the marketplace;” survey deemed to be “seriously flawed and the results to be of little probative value”).

e. Leading and Question-Begging Inquiries

The two statements in Petitioner’s “survey” which supposedly elicited responses of “confusion” are as follows:

- “A. Because the product names are similar, ONFOLIO is likely a licensee of Missiontrek, the developer of CARTAGIO.
- B. Because the product names are similar, ONFOLIO is likely a product of Missiontrek, adapted for a particular niche.”

Both of these statements begin with the phrase “Because the product names are similar....” In other words, the respondents were asked to assume the similarity of the marks before responding to the statements. Since the similarity of the marks was precisely the issue to be determined, these statements were not inquiries at all, but rather question-begging conclusions. Having read the opening phrases to these two statements, the respondents might well have assumed that they were meant to take the similarity of the marks for granted in providing their answers.

Even without the opening phrases, the questions were improperly leading, since they were couched as affirmative statements of source-identity or source-relationship, i.e., “ONFOLIO is likely a licensee of Missiontrek...”, “ONFOLIO is likely a product of Missiontrek...”

Such deficiencies have frequently led the Board to discount a proffered “survey.” In *Marshall Field & Co. v. Mrs. Field’s Cookies, supra* (TTAB 1992), the respondents were asked whether they believed that the parties had “a business connection or business association with one another, or not?” The Board noted that this inquiry

was indeed a leading question in that it clearly indicated the direction [in which] the responses would be expected to go... This question tends to deliberately plant in the respondent’s mind the idea that there is a connection between the [parties] . . . For these reasons we find the survey to be seriously flawed and the results to be of little probative value.

Similarly, in *Hilson Research Inc. vs. Society for Human Resource Management, supra* at 1437 (TTAB 1993) the Board concluded that a survey was “entirely lacking in trustworthiness and not entitled to any probative value” where the questions were both leading, in that “they unequivocally tell the interviewee the response [which the questioner] sought,” and were “framed as legal conclusions,” thereby raising “an issue as to whether the interviewees actually understood what was being asked.” In the same decision, the Board discounted another survey on the grounds that “it is improper to suggest a business relationship where the respondent may previously have no thought of any such connection.” *Id.* at 1438.

In short, Petitioner’s so-called “survey” consisted of leading inquiries which assumed the very result that they were supposedly seeking to determine. The “survey” did not even try to approximate the conditions under which the respondents would actually encounter Registrant’s mark. Petitioner has failed to provide the identity or affiliation of the respondents, or their actual responses, including the *de minimis* responses (two in number) which allegedly support its position. None of this is surprising, since the “survey” was prepared and administered by an amateur, and a biased one at that. Under Board precedent, these flaws, both individually and cumulatively, deprive the “survey” of any probative value whatsoever.

**5. Registrant has shown that “IO” is a Common Suffix which appears in Literally Hundreds of Registered Hardware and Software Marks**

Throughout its Response, Petitioner repeatedly and mistakenly claims that the suffix “IO” is “distinctive,” “arbitrary,” “not at all a common ending.” See, e.g., *Response* at 7. However, the evidence submitted by Registrant in its Motion for Summary Judgment proves conclusively that “IO” is a common suffix, which appears in literally *hundreds* of registered hardware and software marks. Petitioner neither addresses this evidence, nor submits any countervailing evidence of the suffix’s alleged “distinctiveness.”

**6. Petitioner Mischaracterizes Registrant's Evidence of Third-Party Registrations**

Having ignored Registrant's evidence of third-party registrations as it bears upon the commonness of the "IO" suffix, Petitioner tries to discount that evidence on other grounds. Briefly, Petitioner pretends that its registration of CARTAGIO is limited to Internet browser software, and then argues that not enough of the third-party registrations cover such goods. *Response* at 10.

In fact, Petitioner's registration covers not only (i) Internet browser software, but also (ii) database management equipment; (iii) Internet research and cost accounting software; and (iv) software for hosting computer servers. *See* U.S. Reg. No. 2,904,982. In short, Petitioner's products are used for Internet searching, server hosting, database management and other Internet functions.

The third-party registrations submitted by Registrant cover software that is identical or related to Petitioner's products. With respect to Petitioner's Internet browser software, Registrant has submitted at least four relevant third-party registrations (not two, as Petitioner mistakenly claims): namely, PROVISIO, Reg. No. 2,618,273; INPERIO, Reg. No. 2,342,192; PENOKIO, Reg. No. 2,802,880; and NETRIO, Reg. No. 2,694,733. With respect to Petitioner's database management products, Registrant has submitted the third-party registrations of INPERIO, *supra*; CELESIO, Reg. No. 2,943,655; PROTECTIO, Reg. No. 2,757,843; and RISKFOLIO, Reg. No. 2,377,087. With respect to Petitioner's server software, Registrant has submitted the third-party registrations of NETIO, Reg. No. 2,302,598; ENVIVIO, Reg. No. 820,509; CAPTIO, Reg. 2,589,679; and KEY2AUDIO, Reg. No. 2,840,700. With respect to all of Registrant's Web-related products, Registrant has submitted, *inter alia*, the third-party registrations of CAPTIO, *supra*; NADIO, Reg. No. 2,295,917; COFICIO, Reg. No. 2,790,210; CONSORTIO, Reg. No. 2,550,539; KERIO, Reg. No. 2,675,192; and others.

7. **Registrant's Position of No Likely Confusion is Supported by Ample and Relevant Precedent**

Finally, Registrant notes that the numerous cases discussed in its Motion for Summary Judgment found no confusing similarity between marks that shared far more letters than Registrant's and Petitioner's marks. (As previously noted, Registrant's and Petitioner's marks share *only* the ubiquitous suffix "IO"). Petitioner's attempts to distinguish or discount this precedent are not persuasive, and will not be discussed here.

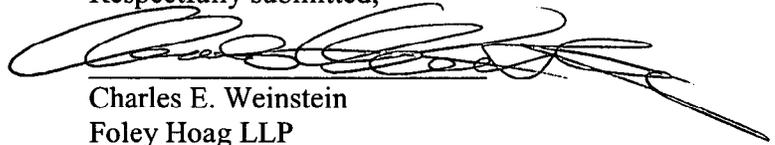
**CONCLUSION**

As Registrant noted in its Motion for Summary Judgment, the marks CARTAGIO and ONFOLIO "just do not look alike, sound alike or connote alike." *Bulova Watch Company, Inc. v. Albert J. Miller*, 463F 2<sup>nd</sup> 1376 (CCPA 1972). Other than the widely-used suffix "IO," the marks do not share any letters whatsoever. Registrant has acknowledged that its mark has "no known meaning, other than its being similar to an old Latin name of the city of Carthage, Tunisia." Registrant's mark has no such meaning, and indeed recognizably incorporates the distinguishable word "FOLIO." The marks are therefore completely different in appearance, sound, meaning and commercial impression. Petitioner has failed to provide any evidence or cite any cases which support its strained arguments for confusing similarity, and its slanted, inexpert, biased and fatally flawed "survey" is entitled to no consideration whatsoever.

Registrant therefore respectfully requests that its Motion for Summary Judgment be granted, and that the Petition for Cancellation be dismissed.

Date: August 9, 2005

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that the documents identified herein are being deposited with the United States Postal Service as first class mail under 37 CFR 1.8(a) in an envelope addressed to: Assistant Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451 on August 9, 2005.

Geraldine MacLellan  
Geraldine MacLellan

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the attached Registrant's Reply To Petitioner's Response To Registrants's Motion For Summary Judgment and Request for Discovery was served upon the attorney of record, Dr. Sherman D. Pernia, Sherman D. Pernia, Esq., P.C., 1110 Nasa Road One, Suite 450, Houston, Texas 77058-4505, by first class mail on this date of August 9, 2005.

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