

<p>This Opinion is not a Precedent of the TTAB</p>
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Mailed: August 31, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

IAC Search & Media, Inc.

v.

ASKBOT, Spa

Cancellation No. 92060041

Gerald J. Ferguson of Baker & Hostetler LLP for IAC Search & Media, Inc.

ASKBOT, Spa, *pro se*.

Before Taylor, Bergsman, and Shaw, Administrative Trademark Judges.

Opinion by Shaw, Administrative Trademark Judge:

IAC Search & Media, Inc. (“Petitioner”) has petitioned to cancel Registration No. 4323777, owned by ASKBOT, Spa (“Respondent”), for the mark ASKBOT, in standard characters, for:

Downloadable software program for collaboration and information management, namely, for collection of questions, answers and comments, receiving feedback and votes for ranking content and users; Software for embedding widgets with aforementioned functionalities on the websites, in International Class 9; and

Application service provider (ASP) providing to others temporary use of online non-downloadable software for collaboration and information management, namely, for collection of questions, answers and comments, receiving feedback and votes for ranking content and users and embedding widgets providing aforementioned functionalities on the websites of others; Software installation and support services, namely, technical support services in the nature of troubleshooting of computer software with aforementioned functionalities, in International Class 42.¹

As grounds for cancellation, Petitioner alleges priority and likelihood of confusion.


Petitioner pleaded ownership of the following registrations:²

- Registration No. 3525714 for the mark ASK (standard characters) for:

Downloadable computer software for use in providing search engine services which is provided through a browser tool bar, in International Class 9;

Providing consumer product information; providing comparison shopping information, providing online directory information services also featuring hyperlinks to other websites, dissemination of advertising for others via the internet; online advertising services for others, namely, providing advertising space on internet web sites, in International Class 35; and

Computer services, namely, providing search engines for obtaining data on a global computer network, in International Class 42.³


- Registration No. 2412106 for the mark  for: Computer services, namely, providing a search engine based on natural

¹ Issued April 23, 2013.

² Petitioner pleaded ownership of four additional registrations for ASK-formative marks but they were cancelled under Section 8 during these proceedings. We consider only the goods and services identified in Respondent's remaining registrations. *See Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014).

³ Issued October 28, 2008; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

language queries on a global computer network, in International Class 42.⁴

- Registration No. 3652770 for the mark  for:

Downloadable internet browser plug-ins and client server applications in the nature of multi-function tool bar plug-ins; downloadable computer software for use in providing search engine services which are provided through a browser tool bar, in International Class 9;


Business services, namely, providing links to the web sites of others, namely, retail service providers in the field of consumer electronics, computers, clothing, automobiles, toys and games and a wide variety of other general consumer products; providing links to the websites of others in the field of consumer products and services; promoting the goods and services of others by placing advertisements and promotional displays on electronic sites accessed through computer networks; providing consumer product information; providing comparison shopping information, providing online directory information services also featuring hyperlinks to other websites, dissemination of advertising for others via the internet; online advertising services for others, namely, providing advertising space on websites, in International Class 35;

Providing links to websites of others in the field of entertainment, in International Class 41; and

Providing customized on-line web pages featuring user-defined information, which includes search engines and online web links to other websites; providing on-line directories, indices and searchable databases of websites and computer networks; providing links to web sites of others in the field of computers and technology; computer services, namely, providing search engines for obtaining data on global computer network, in International Class 42.⁵

⁴ Issued December 12, 2000; renewed.

⁵ Issued July 7, 2009; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

- Registration No. 3593278 for the mark  for:

Downloadable Internet browser plug-ins and client server applications in the nature of multi-function tool bar plug-ins; downloadable computer software for use in providing search engine services which are provided through a browser tool bar, in International Class 9; and

Business services, namely, providing links to the websites of others, namely, retail service providers in the field of consumer electronics, computers, clothing, automobiles, toys and games and a wide variety of other general consumer products; providing links to the websites of others in the field of consumer products and services; promoting the goods and services of others by placing advertisements and promotional displays on electronic sites accessed through computer networks; providing consumer product information; providing comparison shopping information, providing online directory information services also featuring hyperlinks to other websites, dissemination of advertising for others via the Internet; online advertising services for others, namely, providing advertising space on websites; providing on-line directories, indices and searchable databases of websites and computer networks, in International Class 42.⁶

- Registration No. 2463252 for the mark ASK.COM (standard characters) for: Computer services, namely, providing a search engine based on natural language queries on a global computer network, in International Class 42.⁷

Respondent, in its Answer, denied the salient allegations of the petition and admitted that Petitioner owned the pleaded registrations. Both parties filed briefs and Petitioner filed a reply brief.

⁶ Issued March 17, 2009; Section 8 affidavit accepted and Section 15 affidavit acknowledged.

⁷ Issued June 26, 2001; renewed.

I. The Record and Evidentiary Objections

The record consists of the pleadings; by operation of Trademark Rule 2.122, 37 C.F.R. § 2.122, the file of the involved registration; and the following evidence submitted by the parties.

Petitioner's evidence:

1. Testimonial Deposition of Valerie Combs, Head of Global Communications for Petitioner, with exhibits;⁸
2. The following exhibits, made of record via notice of reliance:⁹
 - a. Printouts from Respondent's website;
 - b. Printouts from Petitioner's website;
 - c. Excerpts from Respondent's Brief in Opposition to Petitioner's Motion for Summary Judgment;
 - d. Certain of Respondent's responses to Petitioner's Requests for Admissions;
 - e. Respondent's Answers to Petitioner's First Set of Interrogatories;
 - f. A third-party conference abstract regarding the nature of Respondent's ASKBOT goods and services;
 - g. Third-party webpages purporting to be evidence of comparable services to Respondent's ASKBOT goods and services;
 - h. An internet video featuring Ask.com's former Vice President, Valerie Combs, discussing Ask.com's question and answer services; and
 - i. An internet video featuring Ask.com's former and current Chief Executive Officers discussing Ask.com's business and its question and answer services.

Respondent's evidence, made of record via notice of reliance:¹⁰

1. Printouts from Respondent's website;
2. Printouts from Petitioner's website;
3. News stories including the term "askcom" retrieved from the Lexis/Nexis database;

⁸ 37 TTABVUE.

⁹ 31 TTABVUE.

¹⁰ 35 TTABVUE.

4. Third-party U.S. trademark registrations of ASK-formative marks; and
5. Printouts from an opposition proceeding filed by Petitioner against a third party's application for the mark ASKVILLE.

Petitioner objects to consideration of certain evidence submitted under Respondent's Notice of Reliance, namely, ninety-seven news articles from the Lexis/Nexis database for the term "askcom," third-party registrations of ASK-formative marks, and excerpts from an unrelated opposition in which Petitioner opposed registration of the mark ASKVILLE.¹¹

Regarding Petitioner's objection to the articles from the Lexis/Nexis database on the grounds of hearsay, the Board routinely accepts printed publications obtained from the Lexis/Nexis database, when filed under notice of reliance, so long as the date and source of each article are clear. *See Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1759 (TTAB 2013). That said, printed publications would be hearsay if they were offered to prove the truth of the statements made therein. To the extent that Respondent seeks to rely on the printed publications as evidence of the statements made in the articles, Petitioner's objection is well taken. However, the articles are acceptable to show that the stories have been circulated to the public. *See Hard Rock Cafe Licensing Corp. v. Elsea*, 48 USPQ2d 1400 (TTAB 1998). We have considered these articles only for that purpose. We have not considered articles from foreign language publications absent evidence that they have been circulated in the United States. *Id.* at 1405. Petitioner's objection to the news articles is overruled.

¹¹ Petitioners' Br., p. 24, 40 TTABVUE 32.

Regarding Petitioner's objections to the third-party registrations on the grounds of relevance and a lack of evidence of use, the objections are overruled. *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") § 704.03(b)(1)(B) (June 2017). Respondent's objections to the third-party registrations go to the weight the registrations are to be given rather than their admissibility. Even without proof of use, third-party registration evidence may bear on conceptual weakness if a term is commonly registered for similar goods or services. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015).

Petitioner's objection on the grounds of relevance to selected printouts from its Opposition Proceeding No. 91178765 against registration of the third-party mark ASKVILLE is well taken. Respondent claims "[t]he documents are relevant because Petitioner's Opposition was Dismissed with Prejudice and Trademark ASKVILLE was permitted to mature into a fully registered record."¹² The fact that an unrelated opposition proceeding was dismissed by the consent of the parties has no relevance to the present proceeding inasmuch as the opposed mark is different from Respondent's mark, Respondent was not a party to the proceeding, there was no decision on the merits of the opposition, and there are no admissions against interest by Petitioner. Accordingly, Petitioner's objection is sustained and we have not considered the documents from the ASKVILLE opposition.¹³

¹² Respondent's Br., p. 7, 43 TTABVue 8.

¹³ A copy of the ASKVILLE registration was included separately in Respondent's submission of third party registrations containing the term ASK. 35 TTABVue 224-26. We have considered it along with the other third party registrations.

Petitioner also objects to Respondent's brief as untimely.¹⁴ Respondent's brief was due on July 21, 2017 and was filed on July 22, 2017, i.e., a day late. Given the minimal one-day delay, in the interest of completeness, and because it aids us in framing Respondent's position, we have exercised our discretion and considered Respondent's late brief. In view thereof, Petitioner's motion to strike is denied.

Respondent objects to consideration of Petitioner's deposition of Valerie Combs on the ground that Respondent did not receive a transcript of the deposition as required by Rule 2.125, 37 CFR § 2.125.¹⁵ The deposition of Combs took place on January 9, 2017.¹⁶ Respondent claims that it "was not aware of its existence until June 20th, 2017. Failure to receive this transcript on time hampered the ability of the Respondent to prepare its own evidence[.]"¹⁷

In response to the objection, Petitioner submitted a declaration and supporting evidence establishing that:

1. On November 23, 2016, "Petitioner served its Pretrial Disclosure Statement on Registrant [via email] identifying a corporate representative of Petitioner and topics that representative could speak on[.]"¹⁸
2. On December 21, 2016, Respondent was advised of the upcoming Combs deposition via an email between the parties discussing settlement. Petitioner's email advises Respondent: "As you are aware, the parties are

¹⁴ Petitioner's Reply Br., p. 13, 44 TTABVUE 17.

¹⁵ Respondent's Br., p. 4, 43 TTABVUE 5.

¹⁶ 37 TTABVUE 2.

¹⁷ Respondent's Br., p. 9, 43 TTABVUE 10.

¹⁸ Declaration of Kevin M. Wallace, ¶ 3, Exh. A, 44 TTABVUE 20, 22-25.

now in their testimony periods, and we shall be noticing the testimonial deposition of IAC's witness to be taken in California by the close of IAC's testimony period. . . . [W]e will be noticing a deposition for January 7[.]"¹⁹ Respondent replied to the email thus confirming it received it.²⁰

3. On December 22, 2016, Petitioner served via email a notice of trial deposition of Valerie Combs to take place on January 9, 2017.²¹
4. On February 8, 2017, the due date to serve Respondent with the Combs deposition transcript under rule 2.125, Petitioner emailed a copy of the Combs deposition transcript to Respondent's email address.²² The email included a ZIP compressed file attachment named "ASKBOT – Deposition of Valerie Combs with Exhibits.zip."²³

Given that Respondent was advised on at least three separate occasions that Petitioner intended to take testimony of its corporate representative, Respondent's claim that it was "was not aware of [the Combs' deposition's] existence until June 20th, 2017" strains credulity. If Respondent did not receive the Combs' deposition transcript until June 20, 2017, when it was filed with the Board, Respondent's remedy was "by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate." TBMP § 703.01(m) (June 2018); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 (TTAB 2009) (resetting

¹⁹ January 7, 2017 was a Saturday so the deposition was timely held on Monday, January 9, 2017. 37 C.F.R. § 2.196.

²⁰ Declaration of Kevin M. Wallace, Exh. B, 44 TTABVUE 27.

²¹ *Id.* at ¶ 5, Exh. A, 44 TTABVUE 21, 22-25.

²² *Id.* at ¶ 7, 44 TTABVUE 21.

²³ *Id.*, Exh. D, 44 TTABVUE 37.

adverse party's testimony and/or briefing periods). Respondent's objection to the Combs' testimony is overruled.

II. Standing and Priority

In the Board's December 16, 2015 order granting in part and denying in part Petitioner's motion for summary judgment on the grounds of likelihood of confusion, the Board granted summary judgment on Petitioner's standing and priority.²⁴ Accordingly, standing is not an issue. Priority also is not an issue with respect to the goods and services covered by Petitioner's five pleaded registrations, *supra*. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

III. Likelihood of Confusion

Our determination under Trademark Act Section 2(d), 15 U.S.C. § 1052(d), is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) ("*du Pont*"); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, key considerations include the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and

²⁴ 9 TTABVue. The Board denied Petitioner's motion for summary judgment on likelihood of confusion.

services] and differences in the marks.”). However, any single factor may play a dominant role in the likelihood of confusion analysis. *See Shen Mfg. Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350 (Fed. Cir. 2004); *Kellogg Co. v. Pack’em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Petitioner bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

We focus our likelihood of confusion analysis on Registration No. 3525714 for the mark ASK, in standard characters. This mark and the identified goods and services are the most similar to Respondent’s mark and goods and services. If we find that there is a likelihood of confusion with this mark, there is no need for us to consider the likelihood of confusion with Petitioner’s other marks. Conversely, if we find there is no likelihood of confusion with this mark, we would find no likelihood of confusion with Petitioner’s other marks as they comprise or incorporate the word ASK with additional matter and identify the same or less closely-related goods or services. *See In re Max Capital Grp. Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

We address each of the *du Pont* factors for which the parties submitted evidence or argument.

A. Similarity of the Goods and Services

We begin with the second *du Pont* factor, assessing the similarity or dissimilarity of the parties’ goods and services. It is settled that it is not necessary that the respective goods and services be identical or even competitive in order to find that they are related for purposes of our likelihood of confusion analysis. The respective

goods and services need only be “related in some manner and/or if the circumstances surrounding their marketing [be] such that they could give rise to the mistaken belief that they emanate from the same source.” *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)).

Although we consider the relatedness of the goods and services based on the respective identifications set forth in the registrations, “[w]hen identifications are technical or vague and require clarification, it is appropriate to consider extrinsic evidence of use to determine the meaning of the identification of goods [and services].” *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1355 (TTAB 2015) (citing *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1410 (TTAB 2010); *In re Trackmobile*, 15 USPQ2d 1152, 1154 (TTAB 1990)). Because the goods and services are technical and the respective identifications provide only general information, we consider extrinsic evidence provided by the parties to clarify the specific nature of the goods and services.

Respondent’s software and services are used for “collaboration and information management, namely, for collection of questions, answers and comments, receiving feedback and votes for ranking content and users.” According to Respondent’s website, ASKBOT is used to create “Q&A forums” for “efficient question and answer knowledge management.”²⁵ Respondent states that the “Askbot service enables its clients, mostly companies and educators to create new client-brandable Question and

²⁵ Petitioner’s Exh. A, 31 TTABVUE 8.

Answer (Q&A) community forums.”²⁶ An excerpt from Respondent’s web page, below, touts some of the features available to third parties seeking to create Q&A forums to answer questions. Users can create their own Q&A forums for “question and answer knowledge management,” choose topics for discussion, and prioritize answers.

Askbot - create your Q&A forum. +1 301 747 1533

Home | Pricing | Support Forum | Consulting Services | Documentation | Developers | Blog | Contact

Create your Q&A site now
Try it for 30 days free

Cultivate your Knowledge

- Efficient question and answer knowledge management
- Focused on-topic discussions
- Best answers are shown first
- Tag and categorize
- Follow-up in the comments
- Organize comments and answers by re-posting
- Everything is editable

<< Previous Next >>

Who's using Askbot?

fedora ROS ANSWERS SHAZAM Community

Askbot™ Pucon, Chile 2011-2016

Petitioner’s goods and services are:

Downloadable computer software for use in providing search engine services which is provided through a browser tool bar, in International Class 9;

²⁶ Respondent’s Br., p. 3, 43 TTABVUE 4.

Providing consumer product information; providing comparison shopping information, providing online directory information services also featuring hyperlinks to other websites, dissemination of advertising for others via the internet; online advertising services for others, namely, providing advertising space on internet web sites, in International Class 35; and

Computer services, namely, providing search engines for obtaining data on a global computer network, in International Class 42.

In essence, Petitioner is providing search engine services, including a specialized search engine service focused on shopping.²⁷ Although Petitioner offers software in the form of a “tool bar,” the purpose of the tool bar is to provide a dedicated link to Petitioner’s search engine, Ask.com. A search engine is defined as “computer software used to search data (such as text or a database) for specified information” and as “a site on the World Wide Web that uses such software to locate key words in other sites.”²⁸

Generally speaking, the parties’ goods and services both involve providing answers to questions, however, the respective goods and services differ regarding who uses the products and how the answers are provided. Respondent’s goods and services are a programming tool used by third parties to create online forums featuring questions and answers on a particular subject. The Q&A forums are then used by customers of the third parties. Once created, the forums may be on the users’

²⁷ Combs Test., p. 18, Exh. 11, 37 TTABVue 19, 79.

²⁸ <https://www.merriam-webster.com/dictionary/search/engine>. The Board may take judicial notice of dictionary definitions, *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 213 USPQ 594 (TTAB 1982), *aff’d*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983), including online dictionaries that exist in printed format or have regular fixed editions.

websites, generally do not appear under the ASKBOT mark, and are sometimes password protected.²⁹ Petitioner's software and services provide answers to individual questions on any subject, via Petitioner's Ask.com search engine. In other words, Respondent's goods and services allow users the ability to create, organize and save both questions and answers for others, whereas Petitioner's goods and services allow users to directly search the internet without any predetermined search parameters, and the results are neither organized nor saved. The parties' goods and services thus serve different functions within the context of asking and answering questions on the internet. Nevertheless, the goods and services of the parties are related because both enable end users the ability to obtain online answers to questions, albeit via different methods. Accordingly, despite the differences in the way in which the goods and services are used, we find that the parties' goods and services are related because they both provide the same end functionality: answering online questions for others.

The *du Pont* factor regarding similarity of the goods and services favors a finding of a likelihood of confusion.

B. Channels of Trade

We next consider the third *du Pont* factor regarding the similarity or dissimilarity of established, likely-to-continue trade channels. Neither registration is limited in any way as to channels of trade. Accordingly, the Board must assume that the goods and services are available in all the normal channels of trade to all the usual

²⁹ ASKBOT website, Petitioner's Exhs. A and B, 31 TTABVUE 7-11.

purchasers for such goods and services. *See Packard Press, Inc. v. Hewlett-Packard Co.*, 227 F.3d 1352, 56 USPQ2d 1351, 1357 (Fed. Cir. 2000); *Octocom Sys., Inc. v. Houston Computs. Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

Respondent states that its ASKBOT products are delivered online “via provision of a subscription-based service that allows to create [sic] client-owned Question and Answer online communities.”³⁰ ASKBOT products and services also are offered via third-party software development websites such as github.com and python.org.³¹ In contrast, Petitioner’s search engine services are offered for free at Petitioner’s Ask.com web site.³² Petitioner’s “ASK Toolbar is a free software plugin which is sometimes bundled with third-party software products and distributed by third parties such as Oracle.”³³

Both parties’ software and services are offered online. But “the mere fact that goods and services may both be advertised and offered through the Internet is not a sufficient basis to find that they are sold through the same channels of trade. The Internet is such a pervasive medium that virtually everything is advertised and sold through the Internet.” *Parfums de Couer Ltd. v. Lazarus*, 83 USPQ2d 1012, 1021 (TTAB 2007). The parties’ goods and services are not offered through the same online sources. Respondent’s products are offered through its website and through specialized third-party programming sites such as github.com and python.org.³⁴

³⁰ Respondent’s Br., p. 20, 43 TTABVUE 21.

³¹ Respondent’s answer to Interrogatory No. 3, 31 TTABVUE 45.

³² Combs Test., p. 11, Exh. 5, 37 TTABVUE 12, 61-62.

³³ Petitioner’s Br., p. 7, 40 TTABVUE 15.

³⁴ Respondent’s answer to Interrogatory No. 3, 31 TTABVUE 45.

Petitioner's services are offered through its website or bundled with third-party software.

The parties' goods and services also are offered at significantly different costs to users. Respondent's services are offered on a subscription basis with plans starting at \$15.00 per month and going up to \$45.00 or more per month.³⁵ Petitioner's goods and services are free. We recognize that users of Petitioner's Ask.com search engine who are looking for Q&A software could be directed to Respondent's ASKBOT products. However, this nexus between Petitioner's ASK search engine and Respondent's ASKBOT Q&A products is too tenuous to give rise to the mistaken belief that the goods and services of the parties emanate from the same source. *See Elec. Design & Sales Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992) ("We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with de minimis situations but with the practicalities of the commercial world, with which the trademark laws deal."). We find that the trade channels for the parties' goods and service are dissimilar.

The *du Pont* factor relating to channels of trade weighs in favor of a finding that confusion is not likely.

C. Consumer Sophistication

Turning to the fourth *du Pont* factor, the conditions under which and buyers to whom sales are made, Respondent argues that its customers are "sophisticated users and could not confuse services provided by Askbot with those provided by the

³⁵ Respondent's web page, Petitioner's Exh. C, 31 TTABVUE 13.

petitioner.”³⁶ Respondent stated that “Customers of Askbot are Corporations, Nonprofit Organizations, Teachers and Hobbyists.”³⁷ As discussed *supra*, Respondent’s website shows that its customers are providing information to others via Q&A forums. Petitioner’s customers are in the opposite position—they are seeking information on the internet.

Moreover, inasmuch as Respondent’s customers would need to be able to understand basic computer programming skills, we find it likely that they also would be able to distinguish the parties’ products. And given that Petitioner’s services are free and Respondent’s services require a monthly subscription, Respondent’s customers would be expected to exercise a higher degree of care in the purchasing decision.

This *du Pont* factor weighs in favor of a finding that confusion is not likely.

D. Strength of Petitioner’s Mark

We next consider the strength of Petitioner’s mark in order to evaluate the scope of protection to which it is entitled.

In determining strength of a mark, we consider both inherent strength, based on the nature of the mark itself, and fame or commercial strength. *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1476 (TTAB 2014); *see also In re Chippendales USA Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1686 (Fed. Cir. 2010) (“A mark’s strength is measured both by its conceptual strength (distinctiveness) and its marketplace strength (secondary meaning).”); MCCARTHY ON TRADEMARKS AND

³⁶ Respondent’s Br., p. 17, 43 TTABVUE 18.

³⁷ Respondent’s answer to interrogatory No. 29, 31 TTABVUE 51.

UNFAIR COMPETITION § 11:83 (5th ed. June 2018) (“The first enquiry focuses on the inherent potential of the term at the time of its first use. The second evaluates the actual customer recognition value of the mark at the time registration is sought or at the time the mark is asserted in litigation to prevent another’s use.”).

1. The inherent strength of Petitioner’s ASK mark.

Respondent argues that the term “ask’ is one of the most commonly used English verbs”³⁸ and submitted thirty-five third-party registrations for marks comprised solely or in part of the term ASK.³⁹

When assessing the inherent strength of a mark, third-party registrations for similar goods or services may be relevant to show the sense in which a mark is used in ordinary parlance; that is, an element common to both parties’ marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that the common element is relatively weak. *Jack Wolfskin* 116 USPQ2d at 1136.

All of the third-party marks comprised solely of the term ASK are of little probative value because they are registered for goods or services completely unrelated to those of the parties.⁴⁰ *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1751 (Fed. Cir. 2017) (disregarding third-party registrations for other types of goods where the proffering party had neither proven nor explained that they were related to the goods in the cited registration); *In re Thor Tech Inc.*, 90 USPQ2d 1634, 1639

³⁸ Respondent’s Br., p. 4, 43 TTABVUE 5.

³⁹ Respondent’s Exhs. E and F, 35 TTABVUE 190-279.

⁴⁰ Respondent’s Exh. E, 35 TTABVUE 190-223.

(TTAB 2009) (the third-party registrations are of limited probative value because the goods identified in the registrations appear to be in fields which are far removed from the goods at issue).

The following third-party marks comprised in part of the term ASK and registered for goods and services more closely related to the parties' goods and services are the relevant to determining the inherent strength of Petitioner's ASK mark:

Mark	Reg. No.	Goods or Services
ASK A CPA	4284114	Downloadable software . . . for use in financial and accounting database management and, accounting questions and answers, in International Class 9.
ASK ENERWIZ	4543915	Providing an internet website featuring information in the field of environmental science; providing a website featuring a search engine for obtaining information on energy efficiency, renewable energy, environmental science, natural resources and for obtaining energy efficient products, in International Class 42.
ASKJIM.BIZ & design	3355073	Providing the ability to search a database of business information and advice, namely, providing search engines for obtaining business information and advice on a global computer network, in International Class 42.
ASKBIG-QUESTIONS.ORG	3787908	Computer services, namely, creating an on-line community for users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking, in International Class 42.
ASK MARILYN	2640630	Providing information at the specific request of end-users by means of a global computer networks, in International Class 42.
ASKME	2495731	Computer services, namely, services allowing users of computer networks and global computer networks to conduct searches for information and obtain information and consultations on a wide variety of subject matters, in International Class 42.
ASK MR. ROBOT	4197446	Computer services, namely, creating an online community for computer users to participate in

Mark	Reg. No.	Goods or Services
		discussions, share information and scores, get feedback from peers, form virtual communities, and engage in social networking services in the field of computer games, in International Class 42.
ASKONLINE	2891359	Providing temporary use of on-line non-downloadable software for use in providing a distance learning environment for education via chat rooms, bulletin boards and electronic mail, in International Class 42.
ASK THE CAR PEOPLE	4385293	Computer services, namely, hosting online web facilities for others for organizing and conducting online meetings, gatherings, and interactive discussions, in International Class 42.
ASKVILLE	4428987	Computer services, namely, providing information at the specific request of end users by means of a global computer network, providing answers to natural language search engine queries made by customers via the internet on a variety of topics on a computer network, providing a website for users to supply information or perform services in response to requests from other users over a global computer network; providing specific information as requested by users via the Internet; providing on-line web pages featuring user-defined information, which includes search engines and on-line web links to other web sites; creating indices of information, sites and other resources available on computer networks, in International Class 42.
ASK REDDIT	4160112	Computer services, namely, providing a website featuring technology that enables users to submit, rate, share, bookmark, index, store, collect, and showcase content in electronic form in the nature and fields of current events, politics, news, gaming, comedy, relationships, technology, photos, videos, religion, science, movies, and music; providing customized on-line web pages featuring user-defined information, including search engines and on-line web links to other websites, in International Class 42.

All of the foregoing registrations include the term ASK used in connection with providing information to online users. These registrations establish that the term ASK has some inherent weakness when used in connection with the parties' goods and services. That is, given that one must "ask" a question in order to get an answer, "ask" is suggestive of the function of online information products. We find, therefore, that Petitioner's ASK mark is not inherently or conceptually strong when used in connection with Petitioner's goods and services.

2. The commercial strength of Petitioner's ASK mark.

Petitioner contends that "[i]t is undisputed that the ASK Marks are strong, and indeed, famous marks under a likelihood of confusion analysis, which should be entitled to broad protection."⁴¹ Fame, if it exists, plays a dominant role in the likelihood of confusion analysis because famous marks enjoy a broad scope of protection or exclusivity of use because they have extensive public recognition and renown. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002); *Recot Inc. v. M.C. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000).

"[L]ikelihood of confusion fame 'varies along a spectrum from very strong to very weak.'" *Joseph Phelps Vineyards, LLC v. Fairmount Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734 (Fed. Cir. 2017) (quoting *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694 (Fed. Cir. 2005) (internal citations omitted)). Fame may be measured indirectly by

⁴¹ Petitioner's Br., p. 16, 40 TTABVUE 24.

the volume of sales of and advertising expenditures for the goods and services identified by the mark at issue, “the length of time those indicia of commercial awareness have been evident,” widespread critical assessments and through notice by independent sources of the products identified by the marks, as well as the general reputation of the products and services. *Bose Corp. v. QSC Audio Prods. Inc.*, 63 USPQ2d at 1305-06 and 1309. Although raw numbers of product sales and advertising expenses sometimes suffice to prove fame, raw numbers alone may be misleading. Some context in which to place raw numbers may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Id.* at 1309.

Petitioner introduced evidence to establish that its ASK marks are famous. The following evidence is the most relevant:

- Testimony that the Ask.com website was launched in 1998 and has been in use since then.⁴²
- Testimony that Petitioner has spent “of millions and millions of dollars over the course of two decades” on advertising the “ASK brand,” including television commercials billboards, cinema advertising, and online advertising.⁴³

⁴² Combs Test., p. 7, 37 TTABVUE 8.

⁴³ *Id.* at 12, 37 TTABVUE 13.

- Confidential testimony regarding user traffic on the Ask.com website showing that between 2013 and 2016 the website received hundreds of millions of views each month.⁴⁴
- A “comScore” ranking of top search engines, showing that, as of February 2016, the “ASK Network” is the fourth most popular search engine in the U.S.⁴⁵

Petitioner’s evidence shows that it has been using ASK-formative marks since as early as 1995. Petitioner’s original search engine was launched under the name ASK JEEVES! but the “JEEVES!” portion was “retired” in 2006 and no longer appears on Petitioner’s website.⁴⁶ Petitioner also has used ASK.COM, ASK KIDS, and other ASK marks to identify its various services. Based on long use of the marks, number of searches conducted, and advertising expenditures, Petitioner concludes that “Millions of people know [the ASK brand], and the awareness around the brand is extremely high.”⁴⁷

Petitioner’s evidence regarding fame, however, has significant shortcomings. It does not distinguish between Petitioner’s uses of various ASK-formative marks. For example, Petitioner used ASK JEEVES! as a mark until 2006, but it is not clear whether consumers recognize the ASK portion of ASK JEEVES! as a separate mark. *See H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1727 (TTAB 2008) (“[T]here is no evidence from which to infer from opposer’s advertising expenses and revenues

⁴⁴ 39 TTABVUE.

⁴⁵ Combs Test., p. 17, Exh. 9, 37 TTABVUE 18, 69-74.

⁴⁶ Combs Test., p. 8, Exh. 2, 37 TTABVUE 9, 36-45.

⁴⁷ Combs Test., p. 12, 37 TTABVUE 13.

the extent to which consumers recognize the ONE TRUE FIT mark standing alone and outside the context of the LEE trademark.”). Similarly, the testimony regarding advertising of the “ASK brand” does not break out amounts for the different marks, particularly the ASK JEEVES! mark which has a very different commercial impression from ASK alone.

Although Petitioner’s internet traffic and share of searches are impressive and indicative of commercial success, we can only speculate about the actual impact of that success in creating brand awareness in the minds of consumers. That is, the evidence of internet traffic and share of searches fails to demonstrate that the successful marketing of ASK products translates into widespread recognition of the ASK mark among relevant consumers.

Regarding advertising expenditures, there is no testimony or evidence regarding whether the expenditures are large or small vis-à-vis other comparable internet search companies. And there are few recent examples of unsolicited media referring to the renown of Petitioner’s ASK-formative marks.

Accordingly, we find that Petitioner has failed to show that ASK, by itself, is famous.

Although the record does not support a finding of fame, such that it plays a dominant role, we find that Petitioner’s ASK mark nevertheless has attained some commercial strength for the identified goods and services despite the inherent weakness of the term ASK, discussed above. On balance, because ASK is inherently weak, third-parties frequently use the term ASK in connection with other information

websites, and Petitioner has not established the fame of ASK alone, the ASK mark cannot be regarded as particularly strong and entitled to broad protection.

E. Similarity of the Marks

We next consider the first *du Pont* factor, the similarity of the parties' marks. In a likelihood of confusion analysis, we compare the marks in their entireties for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imps.*, 73 USPQ2d at 1691. "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 101 USPQ2d at 1721.

Petitioner's mark is ASK and Respondent's mark is ASKBOT. Both marks are presented in standard character form, which encompasses use of the respective marks in any typeface or stylization. *Citigroup Inc. v. Capital City Bank Grp. Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011). Respondent has appropriated the entirety of Petitioner's mark and merely added the descriptive term BOT, which is defined as "a computer program that performs automatic repetitive tasks."⁴⁸ While there is no per se rule that the marks are similar where the junior user incorporates the entirety of the senior user's mark, the fact that Respondent's mark subsumes Petitioner's mark increases their similarity. *See China Healthways Inst. Inc. v. Xiaoming Wang*, 491 F.3d 1337, 83 USPQ2d 1123, 1125 (Fed. Cir. 2007)

⁴⁸ <https://www.merriam-webster.com/dictionary/bot>.

(CHI PLUS is similar to CHI both for electric massagers); *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1271 (TTAB 2009) (VANTAGE TITAN for medical magnetic resonance imaging diagnostic apparatus confusingly similar to TITAN for medical ultrasound diagnostic apparatus); *Broad. Network Inc. v. ABS-CBN Int’l*, 84 USPQ2d 1560, 1568 (TTAB 2007) (ABS-CBN is similar to CBN both for television broadcasting services).

Additionally, although we have considered the marks in their entirety, the term ASK is entitled to greater weight in our assessment of likelihood of confusion because it forms the entirety of Petitioner’s mark and comes first in Respondent’s mark. Consumers in general are inclined to focus on the first word or portion in a trademark, in this case, ASK. *Presto Prods., Inc. v. Nice-Pak Prods, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is likely to be impressed upon the mind of a purchaser and remembered”); *see also Palm Bay Imps.*, 73 USPQ2d at 1692.

Further, the descriptive term BOT in Respondent’s mark has less source-identifying significance and is clearly subordinate to ASK. *In re Nat’l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985) (“[I]n articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided that the ultimate conclusion rests on consideration of the mark in their entirety.”). In the context of Respondent’s goods and services, the term BOT conveys the impression that the software or service will perform repetitive search functions.

Consumers familiar with Petitioner's ASK search engine services would likely think that Respondent's ASKBOT Q&A software and services were related and merely performed automated repetitive search tasks.

Although we agree with Respondent that the word ASK is hardly a unique or arbitrary term when used with online Q&A services, we do not find that the term is without any trademark significance. As the cases above indicate, although a mark may not be strong, a junior party normally cannot appropriate another party's mark, add descriptive matter to it, and avoid a finding that the marks are similar.

In sum, we find that the marks are more similar than dissimilar in appearance, sound and meaning, and have substantially similar overall commercial impressions. The addition of the descriptive term BOT simply is insufficient to distinguish the marks ASK and ASKBOT.

F. Balancing the factors

Although the marks are similar and the goods and services are related, the term ASK is relatively weak when used in connection with the parties' goods and services. Moreover, the respective goods and services are offered in different channels of trade to different consumers, and consumers are likely to exercise a greater degree of care when purchasing Respondent's products. When we balance the relevant *du Pont* factors, we find that confusion is unlikely to occur among consumers in the marketplace.

Decision: The petition to cancel is dismissed.