

This Opinion Is Not a
Precedent of the TTAB

Mailed: December 1, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Smartling, Inc.
v.
Skawa Innovation Kft.

Cancellation No. 92063654

Heidi Howard Tandy, of Berger Singerman LLP, for Smartling, Inc.

Thomas P. O'Connell, of O'Connell Law Office, for Skawa Innovation Kft.

Before Heasley, Thurmon and Brock, Administrative Trademark Judges.

Opinion by Thurmon, Administrative Trademark Judge:

Smartling, Inc. (Petitioner) is the owner of a Principal Register registration for the mark SMARTLING, in standard characters, for “Nondownloadable software as a service (SAAS) namely, software for use by others for enabling multi-language translation of content,” in International Class 42.¹ Petitioner also asserts common

¹ Registration No. 4968464 was issued on May 31, 2016. The registration is based on an application filed October 9, 2015, under Trademark Act Section 1(a), 15 U.S.C. § 1051(a), alleging October 2009, as the date of first use anywhere and in commerce. Because no specific date of first use was asserted in the application, we treat the asserted first use date as October 31, 2009, the last day of the month given in the application. TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPE) § 903.06 (Nov. 2025) (“When a month and year are given

law rights in the same mark. Skawa Innovation Kft. (Respondent) owns a Principal Register registration for the mark EASYLING, in standard characters, for “information technology training; computer education training; training services concerned with the use of computer software,” in International Class 41 and “creating and maintaining web sites for others; information technology IT consulting services; software as a service (SAAS) services featuring non-downloadable software for language translation; web site design services; website development for others; updating of websites, for others; creating electronically stored web pages for online services and the internet; installing web pages on the internet for others; technological consultation in the technology field of computers,” in International Class 42.²

Petitioner alleges priority and likelihood of confusion under Section 2(d) of the Act, 15 U.S.C. § 1052(d), based on its registration and its asserted common law rights in the SMARTLING mark, which Petitioner alleges is likely to be confused with Respondent’s EASYLING mark. Respondent asserted certain affirmative defenses, but did not pursue any defense at trial, resulting in the waiver or forfeiture of these defenses. *In re Google Tech. Holdings LLC*, 980 F.3d 858, 862-63 (Fed. Cir. 2020) (holding that arguments not presented to the Patent Trial and Appeal Board were forfeited, while noting that the loss of such rights has been identified as “waiver” in

without a specified day, the date presumed for purposes of examination is the last day of the month.”).

² Registration No. 4766628 was issued on July 7, 2015. The registration is based on an International Registration of the mark under Trademark Act Section 66(a), 15 U.S.C. § 1141(f). A Section 71 declaration was accepted on April 14, 2025.

prior decisions); *see also Peterson v. Awshucks SC, LLC*, 2020 TTAB LEXIS 520, *2-3 at n.3 (party “did not present any evidence or argument with respect to these asserted defenses at trial, so they are deemed waived”). Petitioner’s Section 2(d) claim is, therefore, the sole claim before us.³ We deny the petition to cancel because Petitioner has failed to prove a likelihood of confusion.

I. The Record

The record consists of the pleadings and, pursuant to Trademark Rule 2.122(b)(1), the prosecution file for Respondent’s subject registration. The record also includes evidence submitted by the parties. Petitioner submitted the following:

- A testimonial declaration of John L. Welde, Jr., the founder and president of Petitioner, with exhibits;⁴
- A Notice of Reliance with a wide variety of evidence;⁵
- A Confidential Notice of Reliance, with another wide variety of evidence;⁶

³ The parties were engaged in district court litigation that resulted in suspension of this proceeding. Respondent prevailed in that litigation and moved for summary judgment based on the outcome of the court proceeding. Petitioner expressly sought cancellation of Respondent’s mark (Count IV in the amended complaint in the civil action), so this proceeding is a second bite at the cancellation apple for Petitioner. 32 TTABVUE 44-45. Respondent moved for summary judgment on all Petitioner’s claims on the basis of res judicata and collateral estoppel. *Id.* Summary judgment, based on claim preclusion, was granted as to Petitioner’s claims of a lack of bona fide intent to use the mark in commerce and the claim of abandonment. 35 TTABVUE 17, 20. Summary judgment was denied as to Petitioner’s Section 2(d) claim. *Id.* at 21. A denial of a motion for summary judgment is not a final judgment on the claims or defenses raised by the motion.

⁴ 84 TTABVUE.

⁵ 85 TTABVUE (Notice of Reliance with exhibits A – E); 86 TTABVUE (exhibits F – I); 87 TTABVUE (exhibits K – DD); 95 TTABVUE (exhibit J, with videos); 96 TTABVUE (exhibit EE, with videos). This notice of reliance included almost 2,400 pages.

⁶ 88 TTABVUE (Confidential Notice of Reliance with exhibits AA – part of exhibit HH); 89 TTABVUE (redacted confidential Notice of Reliance); 91 TTABVUE (more of exhibit HH, all confidential); 92 TTABVUE (the remainder of exhibit HH, all confidential). This notice of reliance included over 3,000 pages, all of it filed under seal.

- A testimonial declaration of Petitioner's counsel regarding the terms and conditions of Respondent's website;⁷
- A rebuttal Notice of Reliance, with a variety of evidence;⁸
- A rebuttal testimonial declaration of Petitioner's counsel regarding traffic to Respondent's website;⁹
- A second rebuttal Notice of Reliance with various evidence submitted to rebut testimony of a witness of Respondent;¹⁰ and,
- A second rebuttal testimonial declaration of Petitioner's counsel concerning Respondent's discovery obligations.

Respondent submitted the following evidence:

- A Notice of Reliance with third-party registration and use evidence and a variety of other evidence.¹¹

Before we move on to an analysis of Petitioner's entitlement to bring this action and the substance of its Section 2(d) claim, we feel compelled to comment on the record before us. Petitioner submitted almost 7,000 pages of evidence, much of it repetitive and most of it through Notices of Reliance that provide little helpful explanation of the evidence. The result leaves this Board with a relatively large record and almost no guidance on what parts of it are supposed to prove specific parts of Petitioner's claims. This practice should be avoided.

By way of example, Petitioner submitted copies of a professional trade magazine, Multilingual, but gave no clear explanation of why.¹² We found the magazine helpful

⁷ 93 TTABVUE.

⁸ 115 TTABVUE.

⁹ 116 TTABVUE (original); 117 TTABVUE (substitute with minor change to original).

¹⁰ 118 TTABVUE.

¹¹ 99 (public)/100 (confidential) TTABVUE.

¹² See, e.g., 84 TTABVUE 11 (Welde declaration) ("Smartling and Skawa regularly advertise in and are profiled by the same industry publications, journals, and websites, including Multilingual Magazine and Slator."). This is the only explanation of the relevance of this

to understand the market in which the parties operate, but Petitioner submitted certain editions as many as three times. The January/February 2015 edition, for example, was submitted, in full, as an exhibit to Mr. Welde's declaration, though he said very little about the magazine in his declaration.¹³ The same edition of this magazine was presented a second time with Petitioner's Notice of Reliance, again in full.¹⁴ Petitioner submitted the same edition a third time, this time as a confidential exhibit filed under seal, with its Confidential Notice of Reliance.¹⁵ Many other documents are repeated two and three times, as well.

One exhibit (HH to Petitioner's Confidential Notice of Reliance) contains almost 3,000 pages of evidence, much of it a repeat of submissions in Petitioner's nonconfidential Notice of Reliance. According to the Notice, this exhibit contains "documents entered as evidence during [a court case involving the same parties]."¹⁶ As best we can tell, Petitioner submitted the entire evidentiary record from a court case, all of it under seal, as a single exhibit, with no specific explanation of the relevance of any part of it. Again, such a practice is unhelpful and forces the Board to spend an undue amount of time reviewing the record.

But that is not all. In its Confidential Notice of Reliance, Petitioner identifies exhibits A – HH. The evidence with this Notice, however, begins with exhibit AA. The

publication, despite the fact that copies of editions of the Multilingual magazine were also provided with the notices of reliance Petitioner submitted.

¹³ 84 TTABVUE 11, 22-89.

¹⁴ 86 TTABVUE 382-449.

¹⁵ 88 TTABVUE 768-64 (only the first 64 of 68 total pages).

¹⁶ *Id.* at 16.

other twenty-six exhibits are described in the Notice, but are missing. Petitioner, however, did include with the massive exhibit HH a copy of an expert report of Neil J. Zoltowski, a damages expert, whose testimony this Board twice ordered Petitioner **not** to submit.¹⁷ As there are no monetary claims before us, and because we granted two separate motions to exclude this testimony, we have not considered it.

And now we come to Petitioner's objections to the evidence submitted by Respondent. In its Trial Brief, Petitioner makes vague objections to the third-party registration evidence submitted by Respondent "to the extent they were not properly made of record."¹⁸ No specific objectionable registration evidence is identified. Petitioner then objected to twelve exhibits that consist of Internet webpage screenshots "because they are not accurate or complete versions of such pages."¹⁹ We reject these objections as far too vague and lacking in merit to exclude any of the evidence Respondent submitted.

Petitioner then submitted, with its Rebuttal Brief, eleven pages of highly-detailed objections to specific evidence submitted by Respondent during its trial period.²⁰ We deny all of these objections as untimely in the extreme. Evidentiary objections are not a gotcha tool, but rather a tool to provide notice to the party offering the evidence that it may need to cure or fix some problem to ensure the evidence is considered.

¹⁷ 92 TTABVUE 1160-94. To be fair, Respondent also submitted this expert report, for reasons we also cannot comprehend. 100 TTABVUE (confidential) 454-67.

¹⁸ 121 TTABVUE 44.

¹⁹ *Id.*

²⁰ 126 TTABVUE 28-38.

Objections are a means to an end, and the desired end is a record with admissible evidence so that the dispute may be resolved on the merits. It is wholly improper to wait until the last brief that may be filed under our rules to submit a detailed list of objections to materials that were submitted almost one year earlier.²¹ *Grote Inds., Inc. v. Truck-Lite Co., LLC*, 2018 LEXIS 105, *5-6 (TTAB 2018) (“Objections raised for the first time in a reply brief are untimely because they effectively foreclose the adverse party from responding to the objections.”).

II. Entitlement to a Statutory Cause of Action

Entitlement to a statutory cause of action must be established in every inter partes case. *Curtin v. United Trademark Holdings, Inc.*, 137 F.4th 1359, 1364 (Fed. Cir. 2025); *see also Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 1303 (Fed. Cir. 2020). A party in the position of plaintiff may petition to cancel a registration when it demonstrates (i) an interest falling within the zone of interests protected by the statute, 15 U.S.C. §§ 1063 & 1064, and (ii) a reasonable belief in damage that is proximately caused by registration of the mark. *Corcamore*, 978 F.3d 1303 (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 120-37 (2014)); *id.* at 1305 (applying *Lexmark* to inter partes TTAB cases).

In this case, Petitioner relies upon common law rights in its SMARTLING mark and asserts a Section 2(d) claim (priority and likelihood of confusion) as the basis for cancelling Respondent’s registration of its EASYLING mark. Petitioner has shown

²¹ Respondent submitted its Notice of Reliance on August 22, 2024. Petitioner filed its Rebuttal Brief on August 15, 2025.

uses of its SMARTLING mark in commerce and the likelihood of confusion claim is not specious. *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 LEXIS 347, *13-14 (TTAB 2019) (entitlement to bring and maintain likelihood of confusion claim may be established based on prior common-law use of a similar mark); *Giersch v. Scripps Networks, Inc.*, 2009 LEXIS 72, *9-10 (TTAB 2009) (finding standing – now referred to as entitlement – based on common law use); *MyMeta Software, Inc. v. Meta Platforms, Inc.*, 2024 LEXIS 153, *9 (TTAB 2024). Petitioner has made a sufficient showing to establish its entitlement to bring this action, a point Respondent does not dispute.²²

III. Priority

Petitioner asserts both its registration and alleged common law rights in the SMARTLING mark, but does not claim priority based on its registration.²³ Respondent does not address the priority issue in its Trial Brief, but the record shows that Petitioner does not have priority based on its registration. Petitioner filed its application to register the SMARTLING mark on October 9, 2015, and obtained its registration on May 31, 2016.²⁴ Respondent filed its application to register the EASYLING mark on August 15, 2014, and obtained its registration on July 7, 2015. Under the Act, registration priority is based on the filing date, and Respondent's application was filed over a year **before** Petitioner's application. Trademark Act

²² 125 TTABVUE. Respondent makes no mention in its Trial Brief of Petitioner's entitlement to bring this action.

²³ 121 TTABVUE 21-23 (arguing priority based on common law rights alone).

²⁴ Registration 4968464.

Section 7(c), 15 U.S.C. § 1057(c), (filing date of application to register constitutes constructive use and confers a right of priority as against another person who has not used the mark prior to such filing).

Petitioner, however, claims common law rights in the SMARTLING mark, and has submitted un rebutted evidence of use dating back to 2009.²⁵ Respondent's earliest uses of the EASYLING mark occurred in 2011.²⁶ It is not clear whether Respondent's first uses occurred in the United States, but as the evidence appears to show the earliest uses of the EASYLING mark occurred in 2011, Petitioner's common law priority is established.

IV. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) involves an analysis of all of the probative evidence of record bearing on a likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973) (setting forth factors to be considered, hereinafter referred to as “*DuPont* factors”); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 1315 (Fed. Cir. 2003). A likelihood of confusion analysis often focuses on the similarities between the marks and the similarities between the goods or services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the

²⁵ 84 TTABVUE 4 (testimony of Welde). This shows that Petitioner was incorporated in 2009, and obtained the domain names smartling.com and smartling.net in 2009. Mr. Welde further testified that Petitioner began using the SMARTLING mark on its website in 2009 in connection with “translation proxy services,” which are some of the same services Petitioner provides today.

²⁶ 91 TTABVUE 499-505 (emails relating to a seedcamp program that involved Respondent in 2011), 510-11 (emails regarding Respondent's participation in a how-to-web event in 2011).

cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”); *see also In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017).

A. *DuPont* Factors Two and Three – The Similarity of the Services and Trade Channels

We begin with *DuPont* factors two and three because our analysis of these factors explore the nature of the services, which in this case are highly technical. This analysis will define the relevant consumer group--those consumers who make purchasing decisions regarding the services the parties offer. This analysis also allows us to explain what related services are used with those directly provided by the parties. These points will be important in our evaluation of other *DuPont* factors.

The parties are competitors and offer effectively identical services. The specific services offered by each party likely differ in certain technical respects, but the record makes it clear that the parties compete to provide the same type of services to the same customers. Indeed, there is evidence that Petitioner has lost some customers to Respondent, which is clear evidence that the parties compete.²⁷ Respondent does not dispute this fact, noting that the parties are “Operating in the same field of translation”²⁸ When the parties offer competing services, the risk of confusion

²⁷ 91 TTABVUE 681-94 (discussing Control4 moving its business from Petitioner to Respondent, via Lionbridge, a Language Services Provider); 695-98 (Moravia, a large language services provider considering Respondent as an alternative to Petitioner); 706-08 (lasvegas.com moved its business, provided through Lionbridge, from Petitioner to Respondent).

²⁸ 125 TTABVUE 32.

increases. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316 (Fed. Cir. 2003) (Likelihood of confusion established where products were competing). The second *DuPont* factor, therefore, weighs in favor of a finding that confusion is likely.

Not surprisingly, the parties offer their services through the same trade channels, another fact that is not in dispute. Respondent notes that the parties “invariably operate in the same channels....”²⁹ This overlap increases relevant consumers’ exposure to both marks in the same or similar settings, and therefore increases the risk of confusion. The third *DuPont* factor, therefore, also weighs in favor of a finding that confusion is likely.

The parties translate the original content of a website into many different languages. This can be accomplished using computer aided translation (CAT) technology, which has been around for many years, but has become much more accurate and reliable because of the increasing use of Artificial Intelligence (AI) in this process.³⁰ A machine-based translation can be performed very quickly, but it may not be sufficiently accurate in all cases. For that reason, the parties also use professional translation services, sometimes to check the CAT results and sometimes to translate original materials.³¹

²⁹ *Id.*

³⁰ 84 TTABVUE 49-51 (Multilingual magazine article about the use of machine translation and the cloud); *Id.* at 55 (Multilingual magazine article about translation technologies, that explains the use of freelance translators and use of the cloud); 99 TTABVUE 239-40 (marketing materials touting use of AI in translation services); *Id.* at 289-90 (another translation management services provider touting “AI-enhanced speech and translation tools”).

³¹ 85 TTABVUE 558 (Internet article about Smartling that states, “Smartling’s language services match professional translators with your content who are experienced with your

Translated versions of the website in many different languages are maintained by parties like those involved in this dispute, and these translated versions of the website can then be provided to a user in her preferred language almost instantaneously.³² The services provided by these parties operate in the background, meaning an Internet user who obtains a website in a desired language is “using” the services, but is rarely aware of what has happened to provide the website in the user’s local language or who has provided this service.³³ It is easy to see how important this type of service can be as Internet-based services become increasingly global. But it is also important, for our purposes, to understand who the relevant consumers are for these services. End Internet users are not typically within the relevant consumer group.

Rather, large companies and others who rely heavily on the Internet are the target customers of these services.³⁴ While these organizations are the relevant purchasers of these services, a highly-specialized IT professional, or a team of such professionals,

industry, manages their schedule, and ensures the quality and timeliness of delivery always meets your expectations.”).

³² 85 TTABVUE 526-27 (Tech Crunch article from 2010 explaining how Smartling combines “professional translators, machine translations, and crowdsourced translations,” all managed through Smartling’s software). In some cases, the translated content is stored on a server of the client of the Petitioner or Respondent. In either scenario, the translated content is stored and then presented to end Internet users as needed.

³³ 84 TTABVUE 6-7 (Welde testimony explaining, in general terms, how the parties’ services operate); 85 TTABVUE 620 (Nimdzi article on Translations Management Systems, stating “With the reality of continuous translated content delivery, there exist consumers and clients who don’t want to know (or who don’t care to know) how their products get localized into multiple languages. They just want to see it get done - and the sooner, the better.”).

³⁴ 85 TTABVUE 555 (Internet article stating, “Smartling is a leading provider of translation management software that aids brands in enhancing their global presence by adapting their content for international markets.”).

are likely the ones making the decisions concerning these services. The relevant consumers, that is, the persons making the purchasing decisions, are highly-specialized IT professionals with a background in translation services.³⁵ We will discuss this point more as we consider *DuPont* factor four in the next section of this decision.

**B. The Sophistication of the Relevant Consumers – the Fourth
DuPont Factor**

It has long been recognized that “confusion is less likely where goods are expensive and are purchased after careful consideration than where they are inexpensive and are purchased casually.” *Magnaflux Corp. v. Sonoflux Corp.*, 231 F.2d 669, 671 (1956). *See also Checkpoint Sys. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 284 (3d Cir. 2001) (“When consumers exercise heightened care in evaluating the relevant products before making purchasing decisions, courts have found there is not a strong likelihood of confusion. Where the relevant products are expensive, or the buyer class consists of sophisticated or professional purchasers, courts have generally not found Lanham Act violations.”); *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718 (Fed. Cir. 1992).

As we explained above when defining the relevant consumer, the services offered by these parties are highly technical in nature and the purchasers likely exercise

³⁵ 85 TTABVUE 624 (Nimdzi article stating “even the most technically minded members of a localization team may feel they’re not qualified enough to efficiently evaluate and compare all of the different integrations, supported workflows, etc., available in a range of TMS solutions.”); *Id.* at 555 (Internet article explaining that it takes a few months to implement a new TMS option and may take six to nine months to transition to a new option).

great care in making buying decisions. Petitioner's SMARTLING services have been quoted as reaching "well beyond \$100,000 per year" for large "enterprise-grade requirements."³⁶ Deciding which translation management system to adopt can be an extremely complex process that likely takes weeks or months to complete.³⁷

This case is not like *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1325 (Fed. Cir. 2014), where the investment services at issue were purchased by both sophisticated investors and ordinary consumers. When the goods or services are offered to a range of consumers, as in the *Stone Lion* case, the Board must focus on the degree of care exercised by the least sophisticated potential purchaser. *Id.*

This case is more like *Magnaflux Corp.*, 231 F.2d at 671, where both parties offered "a device for detecting flaws in magnetic bodies by magnetizing the bodies and applying to them a finely divided magnetic material which is caused to assume a form corresponding to any defect in the body." *Id.* at 670. Such goods were "relatively expensive and [were] sold to discriminating purchasers" *Id.* at 671. The same is clearly true in this case, where the relevant consumers are not only highly-specialized professionals, but typically engage in a prolonged process of working closely with the representatives of the translation management system they are evaluating or purchasing.³⁸ There is no evidence of a mixed market here, where less sophisticated

³⁶ 85 TTABVUE 558.

³⁷ *Id.* at 624 (Internet article about Petitioner's services stating, "Evaluating and migrating between technologies is a lot of work and there are always reasons not to do it. It might be the complexity of moving away from a familiar infrastructure, even if it isn't fit for the purpose, or the prospect of time, technical work, and costs involved.").

³⁸ Petitioner makes the argument that because Respondent provides free trials to some prospective customers, there can be little care exercised, suggesting that free services equal

purchasers are also involved. We are dealing with a case of highly sophisticated purchasers and a careful, protracted purchasing process. Such circumstances greatly reduce the risk of confusion, as this Board and the courts have consistently held. The fourth *DuPont* factor, therefore, weighs very heavily against a finding that confusion is likely.

C. Strength or Weakness of Petitioner’s SMARTLING mark – the Fifth and Sixth *DuPont* Factors

When evaluating the strength or weakness of a mark, we look at the mark’s inherent strength based on the nature of the term itself and its commercial strength in the marketplace. *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1353-54 (Fed. Cir. 2010) (measuring both conceptual and marketplace strength); *see also DuPont*, 476 F.2d at 1361. “[T]he strength of a mark is not a binary factor, but varies along a spectrum from very strong to very weak.” *In re Coors Brewing Co.*, 343 F.3d 1340, 1344 (Fed. Cir. 2003). *See also Joseph Phelps Vineyards, LLC v. Fairmont Holdings*, 857 F.3d 1323, 1325 (Fed. Cir. 2017); *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005).

1. Market Strength of Petitioner’s SMARTLING Mark

Petitioner’s SMARTLING mark has been in use for about fifteen years. Petitioner has won awards within its market segment and was ranked the fifth most “heard of”

less care or sophistication. 121 TTABVUE 35-36; 126 TTABVUE 21 (“There’s no sophistication for freebies.”). This argument completely ignores reality and the record. Free trials may be offered, but these trials are offered to highly specialized prospective purchasers as part of a lengthy evaluation process. Much of the evidence we cited above concerning the sophistication of the relevant consumers comes from Petitioner’s own evidence, which clearly refutes this argument.

translation management system in a survey conducted by a trade group.³⁹ Petitioner markets its SMARTLING software and services in trade publications, at trade shows and through its website.⁴⁰ Petitioner has not shown that the SMARTLING mark is famous and has provided little direct evidence of its market strength. Despite the somewhat thin record on this issue, we find the evidence shows that Petitioner's SMARTLING mark has achieved at least a moderate level of consumer recognition within its market segment. The market strength of the SMARTLING mark weighs slightly in favor of a likelihood of confusion finding.

2. Conceptual Strength of Petitioner's SMARTLING Mark

Conceptual strength is a measure of a mark's distinctiveness and may be placed "in categories of generally increasing distinctiveness: . . . (1) generic; (2) descriptive; (3) suggestive; (4) arbitrary; or (5) fanciful." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992). Respondent does not argue that the SMARTLING mark is descriptive, but does argue that the "ling" portion of the SMARTLING mark is generic or descriptive and commonly-used within the relevant market.⁴¹

Mr. Welde, Petitioner's principal witness, testified that the SMARTLING mark "is, conceptually, evocative of a diminutive that a parent, a teacher, or a friend might call another person for doing well in school or doing something smart."⁴² There is

³⁹ 84 TTABVUE 3-4 (Welde testimony of awards won by Petitioner); 85 TTABVUE 621 (Nimdzi survey finding that 66% of respondents had heard of Smartling).

⁴⁰ 84 TTABVUE 4-5.

⁴¹ 125 TTABVUE 23-24.

⁴² 84 TTABVUE 4.

dictionary evidence that the term “ling,” when used as a suffix, can refer to a small or diminutive person, such as a hireling or underling.⁴³ The meaning of the SMARTLING mark proposed by Petitioner, however, runs contrary to the evidence from the relevant market segment.

The parties offer competitive translation services, part of a broader field of linguistics. The term ling. is an abbreviation for linguistics.⁴⁴ Multilingual is the name of a leading trade publication, one that has featured ads by both parties in this dispute.⁴⁵ The articles and ads within this magazine routinely refer to linguistics and language translation. Indeed, the title of the publication, Multilingual, is likely understood within the relevant market as a reference to translation services. When we consider the market context in which Petitioner’s SMARTLING mark is used, the meaning of the “ling” portion of the mark is clear. It is a reference to linguistics, the very field in which Petitioner operates. The mark, as a whole, is suggestive of a translation management system that is smart.

Respondent presented evidence of third-party registrations and Internet uses of marks that contain the “ling” term or variants of that term. Such evidence can help us understand the meaning of a mark, or a part of a mark, in a manner similar to dictionary evidence. *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 1338-39 (Fed. Cir. 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH v. New*

⁴³ 99 TTABVUE 174.

⁴⁴ *Id.* at 177.

⁴⁵ 84 TTABVUE 11; *id.* at 58 (EASYLING ad on p.37 of a Multilingual magazine); 59 (SMARTLING ad in Multilingual magazine at p.38 of the publication).

Millennium Sports, S.L.U., 797 F.2d 1363, 1373 (Fed. Cir. 2015). We find the third-party evidence is compelling and confirms that the term “ling” when used in marks within the relevant market is a reference to linguistics or language, the very field of services offered by the parties. The term, therefore, is descriptive of the parties’ services, and many related services within the broader translation services market.

Respondent provided active federal trademark registrations of the following marks, all for translation services in International Class 41 or 42:

- MULTILING⁴⁶
- ILING⁴⁷
- LINGQ⁴⁸
- WORLDLINGO⁴⁹
- inlingua⁵⁰
- LINGPERFECT⁵¹
- LINGVO⁵²
- AMERILING⁵³

⁴⁶ 99 TTABVue 91 (Registration 3094863). This registration provides a first use date from 1988.

⁴⁷ *Id.* at 95 (Registration 5211282).

⁴⁸ *Id.* at 98 (Registration 3767876).

⁴⁹ *Id.* at 101 (Registration 2511796).

⁵⁰ *Id.* at 104 (Registration 1099859). This registration provides a first use date from 1972.

⁵¹ *Id.* at 107 (Registration 4755098).

⁵² *Id.* at 110 (Registration 4089352).

⁵³ *Id.* at 113 (Registration 6141867).

- ILINGO2.COM⁵⁴
- LINGTECH.⁵⁵

In addition to the third-party registrations, Respondent also offered Internet screenshots showing uses of the following marks for translation services:

- POWERLING⁵⁶
- LINGARCH⁵⁷
- LINGSOFT⁵⁸
- LINGSOM⁵⁹
- LINGVANEX.⁶⁰

In addition to these uses, the record contains an edition of the Multilingual magazine showing uses of the following trademarks or trade names for professional translation services that use the term “ling” or a variant:⁶¹

- LingoTM⁶²

⁵⁴ *Id.* at 126 (Registration 5479478).

⁵⁵ *Id.* at 138 (Registration 6996398). This registration is owned by the same entity that owns the registration of the LINGPERFECT mark, shown above.

⁵⁶ *Id.* at 48-51 (the evidence shows versions of a POWERLING website from 2009, 2013 and 2023).

⁵⁷ *Id.* at 268-70.

⁵⁸ *Id.* at 280-81.

⁵⁹ *Id.* at 284-85.

⁶⁰ *Id.* at 289-91.

⁶¹ We rely on these listings only for what is shown on the face of the exhibits, not for the truth of any matters asserted in connection with these trademark uses.

⁶² 84 TTABVue 38 (this business provides a translation memory (TM) software product).

- Lingotek⁶³
- Medilingua⁶⁴
- Lingualinx⁶⁵
- Lingvistica⁶⁶
- Afrolingo⁶⁷
- Eurolingo⁶⁸
- Prolinguo⁶⁹

Given this evidence, it is clear that the term “ling” and its variants are used within the relevant market segment as a reference to linguistics, which is perhaps the broadest term that encompasses the range of translation services offered with the relevant market.⁷⁰ Not all these uses are of the term “ling” as suffixes, as it is used in both the SMARTLING and EASYLING marks. But the varied uses are telling,

⁶³ *Id.* at 39. This is not the same business that owns the registration of LINGTECH.

⁶⁴ *Id.* at 68 (providing medical translation services).

⁶⁵ *Id.* at 85.

⁶⁶ *Id.* at 213 (translation dictionary and grammar checking software).

⁶⁷ *Id.* at 224.

⁶⁸ *Id.* at 226.

⁶⁹ *Id.* at 230.

⁷⁰ While the professional translation service providers are not direct competitors with the parties in this proceeding, professional translators are involved in the process used by the parties. Some of the uses listed above provide localization services, one core service provided by both parties in this dispute. 84 TTABVUE 78 (Multilingual magazine article from the January/February 2015 edition, with “Basic Terms,” defining “localization” as “the process of adapting a product or software to a specific international language or culture so that it seems natural to that particular region. True localization considers language, culture, customs and the characteristics of the target locale.”); *id.* at 164 (a Multilingual magazine listing SMARTLING as a “localization tool”).

because this record shows a pattern in which many parties make reference to linguistics in a descriptive manner. In each of these examples, even those showing marks with “lingua” or “lingo,” the root “ling” is present and conveys the message that the services or software offered involve the field of linguistics. Indeed, it is partly the breadth of the uses of these terms that makes it so clear that they are all descriptive references to the linguistics field, and in particular, to the translation services field, in which these varied businesses operate.

Petitioner’s SMARTLING mark will convey the same meaning within the relevant market. To the highly sophisticated translation professionals within this market, who knows Petitioner’s services, Petitioner’s mark will suggest a translation management system that is smart. In this context, the word “smart” conveys its ordinary meaning, of clever or intelligent.⁷¹ The term “ling” within Petitioner’s mark conveys a descriptive message about the field in which Petitioner operates. The professionals within this market will immediately understand this meaning.

Petitioner complains that Respondent is improperly dissecting the SMARTLING mark when it focuses on the term “ling.”⁷² We disagree. While Petitioner’s mark is a single word, it is a compound word that contains two terms that have established meanings. In such a situation, it can be appropriate to consider each term to help understand the meaning of the mark as a whole. *Minn. Mining & Mfg. v. Addressograph-Multigraph Corp.*, 1967 LEXIS 152, at *5 (TTAB 1967) (“It is almost

⁷¹ 99 TTABVUE 142-43.

⁷² 126 TTABVUE 10-11.

too well established to cite cases for the proposition that an otherwise merely descriptive term is not made any less so by merely omitting spaces between the words....”). Moreover, the only common element of the parties’ marks is the term “ling,” showing the importance of considering whether this term has an established meaning within the relevant market. *See, e.g., Jack Wolfskin*, 797 F.2d at 1374 (noting that third-party evidence may show that “some segment that is common to both parties’ marks may have a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak”) (internal quotations omitted). That is precisely what we find here. The “ling” segment of the parties’ marks has a well-recognized descriptive meaning within the relevant market, and, therefore, this segment of Petitioner’s mark is weak.

Petitioner’s mark is SMARTLING, a mark that we find suggestive, taken as a whole. *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 146 (Fed. Cir. 2021) (a mark registered on the Principal Register without a showing of acquired distinctiveness is presumed to be inherently distinctive). But the “ling” segment of this mark is weak and will not be viewed as a distinctive source-identifying element of the mark. It is only the mark as a whole that has some conceptual strength. Given this marginal conceptual strength, we find the sixth *DuPont* factor is neutral, but we do so with the express reservation that the “ling” segment of Petitioner’s mark is not distinctive.

D. The Similarity of the Marks – The First *DuPont* Factor

Under the first *DuPont* factor, we determine the similarity or dissimilarity of Petitioner's and Respondent's marks in their entireties, taking into account their appearance, sound, connotation and commercial impression. *DuPont*, 476 F.2d at 1361. "[S]imilarity is not a binary factor but is a matter of degree." *In re St. Helena Hosp.*, 774 F.3d 747, 752 (Fed. Cir. 2014) (citation omitted). "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." *i.am.symbolic*, 866 F.3d at 1323 (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (internal quotation marks omitted)).

The marks are not similar. They do not appear similar, sound similar or have similar meanings. The only point of similarity is the common use of the term "ling" as the second part (or suffix) of each mark. But as we explained above when evaluating the conceptual strength of the SMARTLING mark, the term "ling," when used in the relevant market, is a common reference to linguistics. The parties are competitors in the translation management system market, and the services the parties provide involve linguistics. Given that the only shared element of the marks is descriptive of the parties' services, that element will have minimal source-identifying impact on the relevant purchasers. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305 (Fed. Cir.) ("[T]here is nothing improper in stating that, for rational

reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties.”).⁷³

We find these marks are likely to create different commercial impressions within the relevant market. The SMARTLING mark likely suggests a smart translation management system, one that performs complex functions for its users. The EASYLING mark, on the other hand, suggests an easier-to-use translation management system. The words “smart” and “easy” have wholly distinct meanings, and when used in these marks, lead to different meanings and commercial impressions for each mark.⁷⁴ This is particularly true in this case, where the purchasers are highly sophisticated.

Because the marks are not similar, the first *DuPont* factor weighs heavily against a finding the confusion is likely.

E. Actual Confusion or the Lack Thereof – The Seventh and Eighth *DuPont* Factors

Petitioner argues that there has been actual confusion, but the evidence it relies upon does not support its argument.⁷⁵ Petitioner’s primary piece of evidence comes from a 2019 blog post about a professional translation provider conference held in

⁷³ Petitioner focuses on the shared “ling” element when it argues the marks are similar, an approach at odds with Petitioner’s complaints about Respondent’s focus on the “ling” element when evaluating the conceptual strength of the SMARTLING mark. 121 TTABVUE 26 (“Confusion is likely as Opposer’s [Petitioner’s] and Applicant’s [Respondent’s] marks each have the suffix ‘-LING’”). But it is not improper dissection of a mark to note that one element of a mark is more distinctive than another.

⁷⁴ 99 TTABVUE 142-52 (definitions of “smart”), 158-63 (definitions of “easy”).

⁷⁵ 121 TTABVUE 37-38.

Amsterdam.⁷⁶ David Grunwald, a consultant in the translation services field, attended the conference and posted the blog about it.⁷⁷ At one point in the blog, Mr. Grunwald discussed a panel on enterprise and ecommerce localization, which is one of the services provided by both parties' translation management systems. Balazs Benedek, of Easyling, was a member of this panel, together with representatives of Nike, Bose and Kayak.⁷⁸ This part of the blog correctly identified Mr. Benedek with Respondent Easyling.

In a later part of the blog, Mr. Grunwald stated that he "connected in a meaningful way with [Mr. Benedek] and Peter Farago of Smartling due to the Hungarian connection (my Mother was born in Budapest and Hungarian was my first language as a baby)."⁷⁹ The blog was corrected when Mr. Grunwald was informed of his mistaken reference to Smartling in this part of the blog post, so the current version correctly refers to Mr. Benedek and Mr. Farago as being with Easyling.⁸⁰ Mr. Grunwald testified that he was not confused, but simply made a mistake in the initial version of the blog.⁸¹

It is clear from the record that Mr. Grunwald made a mistake, but was never confused. He had previously connected Mr. Benedek correctly with Easyling, a

⁷⁶ 99 TTABVue 20-27. Petitioner also submitted evidence of the blog post, but Respondent provided a declaration by the author of the post. We cite to the Respondent's submission here because it provides a more complete account of what happened.

⁷⁷ *Id.* at 20-21.

⁷⁸ *Id.* at 26.

⁷⁹ *Id.* at 21.

⁸⁰ *Id.* (Grunwald declaration); *Id.* at 27 (current corrected version of the blog).

⁸¹ *Id.* at 21.

business in Budapest, Hungary. He later referred to this location, but mistakenly connected the Easyling representatives with Petitioner, Smartling. And while Mr. Grunwald has explained his mistaken reference to Smartling, rather than Easyling in this part of the blog, readers of the blog post might have been confused. But such readers would have seen both the correct reference to Easling in connection with the panel discussion and the later incorrect reference to Smartling. What would relevant consumers make of this post? We have no evidence showing how many persons accessed this post or whether it led to any actual confusion in the market. On balance, this evidence appears to show a simple mistake, not actual confusion.

Petitioner's other example of alleged actual confusion was also a mistake. A Mr. Zydron was assisting Respondent with the marketing of its EASYLING services.⁸² In one draft marketing release, Mr. Zydron referred to SMARTLING, when talking about Respondent's services.⁸³ This error was corrected and the erroneous email was never sent.⁸⁴

While neither of these two incidents reflects an actually confused consumer, the mistakes likely occurred because the SMARTLING and EASYLING marks have some similarity. It is worth noting that in making these mistakes, neither person referred to a competing business with a completely different trademark. So, while this evidence does not show actual confusion, it does show mistakes that are likely due to

⁸² *Id.* at 18-19 (Benedek declaration).

⁸³ *Id.*

⁸⁴ *Id.*

the similar part of these two marks. This fact is probative of some risk that others in the market might make the same mistake, but we cannot take this point too far.

These parties have been direct competitors in the relevant market for about fifteen years. They have run ads on consecutive pages in a leading industry publication.⁸⁵ And the blog post with the mistaken reference to Smartling also shows that Mr. Benedek of Respondent was a member of a panel discussion that included representatives of Nike, Bose and Kayak.⁸⁶ Given such a long period of direct competition, one would have expected some actual confusion to have occurred if confusion is likely.

Petitioner tries to avoid this obvious conclusion by contending that Respondent has a small presence in the market.⁸⁷ The evidence, however, refutes this contention. Respondent has taken customers like General Mills, Discovery card, and lasvegas.com away from Petitioner.⁸⁸ Petitioner argues that Respondent's services are white-labeled, meaning Respondent's EASYLING mark is not presented when the services are running.⁸⁹ But this point is a red herring. We explained above that these parties' services benefit Internet end users, but such users are not the relevant consumers. The IT professionals with the businesses that select such services are the

⁸⁵ 84 TTABVUE 58 (SMARTLING ad in Multilingual magazine), 59 (EASYLING ad in the same publication).

⁸⁶ 99 TTABVUE 26.

⁸⁷ 121 TTABVUE 39-40.

⁸⁸ 99 TTABVUE 14 (Benedek declaration); *see also Id.* at 471 (confidential).

⁸⁹ 121 TTABVUE 17, 39-40.

relevant consumers. And these professionals know which party is providing their services.

There is evidence, for example, that after Petitioner lost the lasvegas.com business, it communicated with this former customer and made direct statements (mostly derogatory) about Respondent's EASYLING services.⁹⁰ Petitioner cannot credibly contend that customers (e.g., like lasvegas.com) are unaware that they are using Respondent's EASYLING services, when Petitioner directly notes this fact in its own communications with such customers. The record makes it clear that these parties have been competing for many years for the same customers. These are exactly the sort of circumstances in which actual confusion could have occurred. *CDOC, Inc. v. Liberty Bankers Life Ins. Co.*, 844 F. App'x 357, 363 (Fed. Cir. 2021) (when we "determine if the absence of actual confusion is indicative of the likelihood of confusion, the fact finder looks to real market conditions to evaluate consumer exposure to the marks at issue, assessing the length of time of any concurrent use; the similarity of the services, customers, and trade channels.").

The absence of probative actual confusion evidence, therefore, suggests that the relevant purchasers were never confused by these two marks. The seventh and eighth *DuPont* factors, taken together, weigh somewhat against a finding that confusion is likely.

⁹⁰ 92 TTABVue 877-85. Mr. Welde, then CEO of Petitioner, stated in one email, "I believe Lionbridge has misled you into thinking that Easyling is an acceptable replacement for Smartling." *Id.* at 884.

F. Weighing the *DuPont* Factors

When we consider the overall impact of the *DuPont* factors, it is clear that Petitioner has failed to prove a likelihood of confusion. While the parties are competitors and operate in the same trade channels, the marks, taken in their entireties, are not similar. In addition, this case involves a highly-sophisticated class of relevant purchasers, a buying process that takes weeks or months, and expensive services. Finally, the parties have competed for about fifteen years without any real actual confusion. We place great weight on the dissimilarity of the marks (*DuPont* Factor One) and the purchasing conditions (*DuPont* Factor Four), which together easily outweigh the fact that the parties compete. Petitioner may have lost business to Respondent, but the record shows that is a result of competition, not because of confusion in the market.

Decision: The petition to cancel is **denied**.