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

Proceeding	91174770
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

VIASAT, INC.,

Opposer,

v.

VIEWTECH INCORPORATED,

Applicant.

In re App. Serial No. 78/652,657 (parent)
Mark: VS VIEWSAT
Filing Date: June 16, 2005
Publication Date: August 1, 2006

In re App. Serial No. 78/855,361
Mark: VIEWSAT
Filing Date: April 6, 2006
Publication Date: November 28, 2006

In re App. Serial No. 78/855,580
Mark: VIEWSAT LITE
Filing Date: April 6, 2006
Publication Date: December 5, 2006

Consolidated Opposition No.: 91174770

REPLY IN SUPPORT OF TRIAL BRIEF OF OPPOSER VIASAT, INC.

TABLE OF CONTENTS

Page(s)

I. INTRODUCTION 1

II. ARGUMENT 3

A. The VIASAT Marks are Strong 3

B. The Parties' Respective Marks are Similar in Appearance, Sound, Connotation and Commercial Impression 5

C. The Parties' Consumer-Oriented Goods And Services Are Highly Similar And Related, And Are Sold To Overlapping Groups Of Customers 8

D. The Remaining DuPont Factors All Support a Finding of Likelihood of Confusion 11

III. OBJECTION TO ADMISSION OF EVIDENCE AND DISCUSSION REGARDING UNRELATED FOREIGN MARKS 15

A. The Disputed Evidence Is Irrelevant And Prejudicial 16

B. The Disputed Evidence is Hearsay and Lacks Foundation 17

VI. CONCLUSION 18

TABLE OF AUTHORITIES

Page(s)

FEDERAL CASES

Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.,
944 F.2d 1446 (9th Cir. 1991) 14

AMF Inc. v. Sleekcraft Boats,
599 F.2d 341 (9th Cir. 1979) 9

CBS, Inc. v. Morrow,
708 F.2d 1579 (Fed. Cir. 1983) 8

Century 21 Real Estate Corp. v. Sandlin,
846 F.2d 1175 (9th Cir. 1988) 14

Communications Satellite Corp. v. Comcet, Inc.,
429 F.2d 1245 (4th Cir. 1970) 9

Earthquake Sound Corp. v. Bumper Industries,
352 F.3d 1210 (9th Cir. 2003) 5

Florence Mfg. Co. v. J. C. Dowd & Co.,
178 F. 73 (2d Cir. 1910) 13

GoTo.com, Inc. v. Walt Disney Co.,
202 F.3d 1199 (9th Cir. 2000) 4

Hewlett-Packard Co. v. Packard Press Inc.,
281 F.3d 1261 (Fed. Cir. 2002) 8

In re Bayer Aktiengesellschaft,
488 F.3d 960 (Fed. Cir. 2007) 17

International Star Class Yacht Racing Ass'n v. Tommy Hilfiger U.S.A., Inc.,
80 F.3d 749 (2d Cir. 1996) 15

ITC Ltd. v. Punchgini, Inc.,
482 F.3d 135 (2d Cir. 2007) 16

J & J Snack Foods Corp. v. McDonald's Corp.,
932 F.2d 1460 (Fed. Cir. 1991) 15

John H. Harland Co. v. Clarke Checks, Inc.,
711 F.2d 966 (11th Cir. 1983) 6

Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.,
963 F.2d 350 (Fed. Cir. 1992) 6

Kimberley-Clark Corp. v. H. Douglas Enter., Ltd.,
774 F.2d 1144 (Fed. Cir. 1985) 15

KOS Pharm., Inc. v. Andrx Corp.,
369 F.3d 700 (3d Cir. 2004) 5

Mead Data Central, Inc. v. Toyota Sales U.S.A., Inc.,
875 F.2d 1026 (2d Cir. 1989) 7

Nautilus Group, Inc. v. Icon Health and Fitness, Inc.,
308 F.Supp.2d 1208 (W.D.Wash. 2003) 14

Nikon Inc. v. Ikon Corp.,
987 F.2d 91 (2d Cir. 1993) 5

On-Line Careline Inc. v. Am. Online Inc.,
229 F.3d 1080 (Fed. Cir. 2000) 9

Person's Co. v. Christman,
900 F.2d 1565 (Fed. Cir. 1990) 16

Specialty Brands, Inc. v. Coffee Bean Distrib., Inc.,
748 F.2d 669 (Fed. Cir. 1984) 15

Synergistic Intern., LLC v. Korman,
470 F.3d 162 (4th Cir. 2006) 6

Trump v. Caesars World, Inc.,
645 F. Supp. 1015 (D.N.J. 1986) 6

United States v. Sun-Diamond Growers of California,
138 F.3d 961 (Fed. Cir. 1999) 7

TRADEMARK TRIAL AND APPEAL BOARD CASES

Blansett Pharmacal Co. v. Carmrick Laboratories, Inc.,
25 U.S.P.Q.2d 1473 (T.T.A.B. 1992) 6

Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.,
434 F.2d 1403 (C.C.P.A. 1970) 15

Double J of Broward, Inc. v. Skalony Sportswear GmbH,
21 U.S.P.Q.2d 1609 (T.T.A.B. 1991) 16

Glamorene Prods. Corp. v. Procter & Gamble Co.,
538 F.2d 894 (C.C.P.A. 1976) 12

Hard Rock Cafe International (USA), Inc. v. Elsea,
56 U.S.P.Q.2d 1504 (T.T.A.B. 2000) 7

Hard Rock Cafe Licensing Corp. v. Elsea,
48 U.S.P.Q.2d 1400 (T.T.A.B. 1998) 16

Henry Siegel Co. v. M & R International Mfg. Co.,
4 U.S.P.Q.2d 1154 (T.T.A.B. 1987) 6

In re Melville Corp.,
18 USPQ2d 1386 (T.T.A.B. 1991) 9

Magnavox Co. v. Multivox Corp. of Am.,
341 F.2d 139 (C.C.P.A. 1965) 5, 6

Penguin Books Ltd. v. Eberhard,
48 USPQ2d 1280 (T.T.A.B. 1998) 12

Wella Corp. v. California Concept Corp.,
558 F.2d 1019 (C.C.P.A. 1977) 12

STATUTES

15 U.S.C. § 1063 18

15 U.S.C. § 1065 3

15 U.S.C. § 1115 3

15 U.S.C. § 1117 15

OTHER AUTHORITIES

Fed. R. Evid. 401 16

Fed. R. Evid. 403 16

Fed. R. Evid. 602 and 901 16

Fed. R. Evid. 802 16

I. INTRODUCTION

Opposer ViaSat, Inc. ("ViaSat" or "Opposer") believes that applicant ViewTech Incorporated ("Applicant") should not be entitled to register the VIEWSAT Marks because of the likelihood of confusion between such marks and the VIASAT Marks.[1] Simply put, all of the relevant *DuPont* factors demonstrate that consumers are likely to be confused as to the source of the products offered by the parties under their respective marks. This conclusion remains unchanged by Applicant's responsive brief, which attempts to distract the Board from the core issues at hand by creating and then arguing against several irrelevant "straw man" issues relating to the existence of an unrelated European entity which does not conduct business in the United States[2], and unrelated products manufactured by ViaSat's military and government divisions. Applicant seeks to further distract the Board with prominent color diagrams comparing Applicant's product with outdated versions of ViaSat's modems which have not been used since 2006, and by focusing a disproportionate amount of attention on the parties' design logos. Such tactics are inapposite, and purely designed to draw the Board away from the singular issue at hand, which is whether VIEWSAT is confusingly similar to VIASAT in the context of the goods and services listed in the parties' respective applications and registrations. In view of the evidence adduced in ViaSat's trial brief as well as herein, ViaSat respectfully submits that the VIEWSAT Marks are confusingly similar to the VIASAT Marks.

Notwithstanding Applicant's efforts to cloud the picture with immaterial (and inadmissible) evidence, the analysis can be boiled down as follows. VIASAT is a strong, registered and incontestable mark that serves as the primary brand of an international company

[1] ViaSat incorporates by reference the definitions adopted in its trial brief for the VIEWSAT Marks and the VIASAT Marks.
[2] The inadmissibility of such evidence is addressed in Section III, *infra*.

that has invested millions of dollars in the marketing and promotion of the brand. The parties' marks are similar in their entireties as to appearance, sound, and commercial impression. Not only is this fact apparent on its face, but it is corroborated by an expert linguist and supported by the applicable case law. The parties' *consumer-oriented* goods and services are highly similar and related, and are sold to overlapping groups of customers. Moreover, ViaSat's current modems are clearly and prominently labeled with its mark on both sides, as shown below, thus creating an unmistakable association of home satellite products with ViaSat in the minds of end-users.

All of these factors point toward a finding of likelihood of confusion and a refusal of registration of the VIEWSAT Marks.

II. ARGUMENT

A. The VIASAT Marks are Strong

It is undisputed that the VIASAT Marks are registered and incontestable, which *conclusively* establishes the distinctiveness and validity of the registered marks as well as ViaSat's exclusive right to use the marks in commerce. 15 U.S.C. § 1115; 15 U.S.C. § 1065. Moreover, the VIASAT Marks have been in continuous use for over two decades[3], during which time ViaSat has spent considerable time and money promoting and developing customer recognition and goodwill in its VIASAT Marks nationwide.[4] Indeed, in the fiscal year ended March 28, 2008, ViaSat earned ***$574,650,000*** in gross revenues, the majority of which involved the sale of goods and services under the VIASAT name and mark.[5] Thus, ViaSat is a major international corporation with substantial marketing expenditures and revenues, and the VIASAT mark serves as the "core brand" for each and every satellite product and service offered by the company.[6]

Applicant attempts to refute the strength of the VIASAT Marks in several ways, all of which are inappropriate for the purposes of this proceeding. First, Applicant asserts that its own employees had never heard of ViaSat prior to the initiation of this proceeding.[7] This is not only rather implausible due to the close geographic proximity of the two companies, but it is also untrue. At his December 12, 2007 deposition, Applicant's President testified that he had known of ViaSat for five years, which is *four years* in advance of the Notice of Opposition for this

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[3] U.S. Registration Nos. 1,996,891, 1,888,961 and 3,201,013, attached to Notice of Reliance, August 8, 2008; Trial Testimony of H. Stephen Estes, July 2, 2008 (hereinafter, "Estes Test."), at 15-17.
[4] Estes Test., at 17-18.
[5] Estes Test., at 9-10; ViaSat's Form 10-K – Annual Report Pursuant to Section 13 or 15(d) of the Securities Exchange Act of 1934 for the Fiscal Year ended March 28, 2008 attached to Notice of Reliance, August 8, 2008.
[6] Estes Test., at 18-21.
[7] Applicant's Trial Brief, at 7.

case.[8] In any event, self-serving claims by Applicant's other employees as to their lack of awareness of ViaSat should be considered with skepticism in making a determination as to the overall strength and renown of a mark that is well established by incontestable federal registrations and financial figures.

Applicant also attempts to improperly insinuate that the existence of an unrelated European entity with no commercial presence in the United States has an impact on the strength of ViaSat's U.S. trademark rights.[9] As will be set forth in Section III, *infra*, such discussion is irrelevant and prejudicial, and should not be considered by the Board.

Finally, Applicant relies heavily on the fact that other marks exist which utilize the common suffix "sat."[10] This is again, a misleading and misplaced argument. While it is not surprising that numerous companies have chosen to utilize the term "sat" in connection with goods and services relating to satellites, ***none*** (except for Applicant) have adopted brands which call to mind the distinctive look and sound of the VIASAT Marks, namely, an emphasis on the "V" prefix in conjunction with the "sat" suffix.

Accordingly, the strength of the VIASAT Marks is unaffected by the claims raised in Applicant's responsive brief. Indisputably, the VIASAT Marks are legally "strong" marks which merit a wide scope of protection. *See GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1207 (9th Cir. 2000) (the stronger the mark "the greater protection the mark is accorded by trademark laws").

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[8] Deposition transcript of the deposition of Rob Rhine, taken on December 12, 2007 ("Rhine Depo."), at 79.
[9] Applicant's Trial Brief at 7, 29-30, 36.
[10] *Id.*, at 35-36.

B. The Parties' Respective Marks are Similar in Appearance, Sound, Connotation and Commercial Impression

As set forth in detail in ViaSat's trial brief, the overall impression created by the respective marks, viewed in their entireties, is objectively similar. Both VIASAT and VIEWSAT begin with "VI" and end with the suffix "sat," with the second portion of the marks being identical and the first element beginning with the same two letters, "VI." Not only is this similarity patently clear on its face, but there is significant precedent in the TTAB and federal courts for a finding of likelihood of confusion under such circumstances, where the marks in dispute share a common suffix and vary only by several letters in the initial portion of the mark. In its trial brief, ViaSat cited *KOS Pharm., Inc. v. Andrx Corp.*, 369 F.3d 700 (3d Cir. 2004) (finding ADVICOR and ALTOCOR confusingly similar for pharmaceutical products); *Earthquake Sound Corp. v. Bumper Industries*, 352 F.3d 1210 (9th Cir. 2003) (CARQUAKE and EARTHQUAKE confusingly similar for auto audio equipment); *Nikon Inc. v. Ikon Corp.*, 987 F.2d 91 (2d Cir. 1993) (NIKON and IKON confusingly similar for cameras); and *Magnavox Co. v. Multivox Corp. of Am.*, 341 F.2d 139 (CCPA 1965) (MAGNAVOX for consumer electronics confusingly similar to MULTIVOX for electric reed organs). Of these cases, all of which contain an identical *suffix* and different beginning portion, Applicant only made an attempt to distinguish the *Magnavox* case by speculating, without any foundation, that the "decision may have been influenced by an anti-dilution rationale."[11] In doing so, Applicant chose to ignore the obvious symmetry between the current facts and the determinative factor in that case:

> [both marks] begin with the letter 'M'; both have eight letters, and the suffix of both is 'VOX,' [a term with an acknowledged meaning that was suggestive of the parties goods and a suffix contained in 33 other third-party registrations.] They present in their entirety the same general appearance to the purchaser such that confusion, mistake or deception is likely.

[11] Applicant's Trial Brief, at 46, citing: REDI-SET v. REDI-ARC; PETRO SHOPPING CENTERS v. PETRO TRAVEL PLAZA and PETRO CARD, CAREFIRST and FIRST CARE; BLISS WORLD v. BLISS SALON; and NUTRI/SYSTEM v. NUTRI-TRIM.

Magnavox Co., 341 F.2d at 141. Applicant then lists a number of cases which it argues are more applicable than the cases cited by ViaSat. Notably, ***none*** of the cases referenced by Applicant involve common *suffixes*, as is the case here and in all of the cases cited by ViaSat.[12] It is simply not credible that any of these disputes have more in common with VIASAT v. VIEWSAT than MAGNAVOX v. MULTIVOX. Indeed, the reason that Applicant must resort to dissimilar cases involving common *first portions* (as opposed to suffixes or latter portions) is that it cannot locate any parallel cases with results that favor its position. In addition to the numerous cases already cited by ViaSat, an overwhelming body of case law supports ViaSat's theory that there generally exists a likelihood of confusion where the marks in dispute share a common suffix and vary only by several letters in the initial portion of the mark. A survey of these cases reveals that many of the marks incorporate merely descriptive suffixes or latter portions, thus disproving Applicant's theory that such marks are not likely to be found confusingly similar.[13] *See e.g. Trump v. Caesars World, Inc.*, 645 F. Supp. 1015 (D.N.J. 1986), *aff'd without op.*, 2 U.S.P.Q.2d 1806 (3d Cir. 1987) (CAESAR'S PALACE confusingly similar to TRUMP'S PALACE); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 862 (1992) (PLAY-DOH confusingly similar to FUN DOUGH); *Synergistic Intern., LLC v. Korman*, 470 F.3d 162 (4th Cir. 2006) (affirming summary judgment of infringement in GLASS DOCTOR versus WINDSHIELD DOCTOR); *Blansett Pharmacal Co. v. Carmrick Laboratories*, Inc., 25 U.S.P.Q.2d 1473 (T.T.A.B. 1992) (summary judgment that confusion was likely between NALEX and NOLEX); *Henry Siegel Co. v. M & R International Mfg. Co.*, 4 U.S.P.Q.2d 1154 (T.T.A.B. 1987) (L.A. CHIC confusingly similar to CHIC); *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966 (11th Cir. 1983) (MEMORY STUB confusingly similar

[12] *Id.*
[13] Applicant's Trial Brief, at 46.

to ENTRY STUB); *Hard Rock Cafe International (USA), Inc. v. Elsea*, 56 U.S.P.Q.2d 1504 (T.T.A.B. 2000) (HARD ROCK CAFÉ confusingly similar to COUNTRY ROCK CAFÉ).

Accordingly, the VIASAT and VIEWSAT marks are confusingly similar on their face, *and* this assessment is also firmly supported by the existing case law. It is also confirmed by the report of an expert linguist, Professor David M. Yerkes, who has been qualified as an expert on the English language by numerous U.S. courts in connection with trademark infringement cases, including The United States Court of Appeals for the Second Circuit in the well-known case of *Mead Data Central, Inc. v. Toyota Sales U.S.A., Inc.*, which quoted his expert report at length, and the U.S. Supreme Court in *United States v. Sun-Diamond Growers of California*, which adopted his analysis unanimously.[14] Professor Yerkes concludes here that "***the names VIASAT and VIEWSAT are very likely to be confused: VIASAT and VIEWSAT are confusingly similar – or even are identical – in sight, sound, and meaning***."[15] Applicant does not counter with any expert testimony, but merely sets forth self-serving arguments from its legal counsel in its responsive brief that are unsupported by any tangible authority.[16] Moreover, Applicant only attempts to rebut Professor Yerkes' conclusions with respect to the pronunciation of the respective marks. Applicant does not, and cannot, refute the following expert testimony relating to appearance:

> the names VIASAT and VIEWSAT look almost the same: five of the six letters in VIASAT reappear in VIEWSAT – V, I, and S, A, T – in exactly the same order, and the five letters include both the beginning letters and the ending letters of each name. The names VIASAT and VIEWSAT have everything in common except that one name has a letter A where the other has EW:
>
> VI A SAT

[14] Trial Testimony of David Yerkes, Exhibit 1 thereto, July 21, 2008, at ¶ 2.
[15] *Id.*, at ¶ 4, emphasis added.
[16] Applicant's Trial Brief, at 37-38.

VI EW S A T[17]

> Though VIASAT has an A where VIEWSAT has EW, the names can seem identical. Very few words or names in English begin with the letters VI followed by any of the five letters that normally stand for a vowel sound: A, E, I, O, or U. Because instances of any of these five letters coming after VI are so few, when one of the five does appear after VI, that letter calls the other four to mind and is confused with them.[18]

The foregoing analysis clearly points toward a finding of likelihood of confusion and a refusal of registration of the VIEWSAT Marks.

C. The Parties' Consumer-Oriented Goods And Services Are Highly Similar And Related, And Are Sold To Overlapping Groups Of Customers

In examining the similarity of the parties' goods and services in an inter partes proceeding before the Board, the Board must compare the goods described in the applicant's *application* with the goods in the opposer's *registrations* and the goods with which the opposer has used its marks. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267 (Fed. Cir. 2002) (citing *CBS, Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983)) (emphasis added). ViaSat's two incontestable federal trademark registrations (U.S. Registration Nos. 1,996,891 and 1,888,961) for the word mark VIASAT are broadly protected in connection with "communication terminal equipment, namely modems, receivers, radios, simulators and networks for satellite and terrestrial communication terminals" and with "designing communication systems to the customer order and specification of others."[19] There is no reference or limitation to military or governmental use, as improperly implied throughout Applicant's brief. While it is certainly expedient for Applicant to focus primarily on ViaSat's military and government contracting divisions, such discussion is irrelevant and serves only to

[17] Trial Testimony of David Yerkes, Exhibit 1 thereto, July 21, 2008, at ¶ 6.
[18] *Id.*, at 7.
[19] U.S. Registration Nos. 1,996,891 and 1,888,961 attached to Notice of Reliance, August 8, 2008.

distract the Board from the central inquiry at hand: whether the broad categories of goods and services listed in ViaSat's registrations relate *in some manner* to the categories of goods listed in Applicant's applications – "satellite receivers, namely, integrated receiver/decoder set-top-boxes that receive only one-way direct-to-home free-to-air satellite television broadcasts, and excluding two-way broadband satellite communications" – such that they may give rise to the mistaken belief that the goods and/or services come from a common source.[20] In other words, are the VIASAT satellite modems and other communication terminal equipment, including ***receivers***, related to the VIEWSAT satellite receivers for home television broadcasts? The answer is clear on its face, and ViaSat's position is supported by the weight of the facts and authority.

Applicant's immaterial discussions regarding ViaSat's military and government division give short shrift to ViaSat's considerable commercial product sector, which earned ***$248.3 million*** in the fiscal year ended March 28, 2008.[21] In fact, Applicant makes a blanket statement that "Opposer has never sold anything to the home/consumer market..."[22] This is absolutely false. As set forth in ViaSat's Form 10-K Annual Report, this "commercial networks segment revenue growth was primarily derived from higher consumer broadband sales of approximately $23.7 million [in FY2008 as opposed to FY2007]."[23] "Consumer broadband" relates to ViaSat's "Home System" (defined on p. 6 of ViaSat's trial brief), the consumer-oriented product that is closest in function to Applicant's satellite receivers. Notwithstanding Applicant's efforts to bury any discussion relating to these products, ViaSat's commercial product sector and consumer

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[20] *See* p. 21 of ViaSat's trial brief, *citing On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87 (Fed. Cir. 2000); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(i); *see also AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 n.10 (9th Cir. 1979) ("Related goods are those 'products which would be reasonably thought by the buying public to come from the same source if sold under the same mark'"); *Communications Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245 (4th Cir. 1970), *cert. denied*, 400 U.S. 942 (1970) (COMSAT for communications found confusingly similar to COMCET for computers.)

[21] ViaSat's Form 10-K – Annual Report Pursuant to Section 13 or 15(d) of the Securities Exchange Act of 1934 for the Fiscal Year ended March 28, 2008, at p. 38.

[22] Applicant's Trial Brief, at 20.

[23] *Id*

broadband products are significant aspects of its overall satellite-based business, and it is crucial that its trademark rights in this sector not be infringed.

As set forth above, the standard for finding similarity in the parties' goods and services is mere "relatedness." There is no requirement that the goods and services must be identical or competitive.[24] In examining the identification of goods in Applicant's applications, there are no discernible distinctions which cause the parties' respective goods and services to be unrelated. At best, Applicant can attempt to point to its amendment that was made subsequent to the initiation of this proceeding, which categorizes its satellite receivers as "one-way." However, this mere technicality does not suffice to mitigate potential consumer confusion. Regardless of the minor logistical distinctions between one-way and two-way satellite receivers, the technology and function are still remarkably similar.

From a purely technological standpoint, both one-way and two-way receivers share an identical purpose, to receive digital satellite signals, and are thus made up of the same building "blocks."[25] Additionally, from a functional standpoint, with ViaSat's Home System, individual consumers may access the same types of satellite or cable programming online, through the demodulation of television signals, that are otherwise provided through free-to-air broadcast channels.[26] Indeed, many individual consumers today view television programming on screens with no integrated television receiver, and this number is rapidly increasing.[27] With the impending launch of the ViaSat-1 high-capacity, high-speed Ka-band spot-beam satellite, this existing competition between the parties will *further* increase, as the satellite's enormous bandwidth and capability to stream hundreds of video channels will allow ViaSat to manufacture

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[24] *See* fn. 20.
[25] Estes Test., at 34-35.
[26] Estes Test., at 36-39.
[27] Notice of Reliance, November 24, 2008, Exhibits 1, 2, 4, 6.

and distribute devices that receive ***one-way*** direct-to-home satellite broadcasts (the very broadcasts received by Applicant's VIEWSAT products).[28] Such devices would facilitate access to television programming, and compete even more directly with Applicant's VIEWSAT receivers.[29]

Applicant's only rebuttal is that any "natural expansion" theory must rely upon expansion that was foreseeable at the time of the junior user's first use of its mark. This premise does not affect ViaSat's claims, as the launch of the ViaSat-1 satellite was first planned in 2004, well before the first use of the VIEWSAT Marks. Moreover, as of 2005, high-speed broadband Internet certainly existed, and individual consumers were already viewing significant amounts of television programming on screens with no integrated television receiver. As such, Applicant's arguments are once again inapt.

Accordingly, the record evidence concerning the parties' respective products supports the conclusion that the goods are already highly related and competitive. In addition, the doctrine of natural expansion leads to the conclusion that such relatedness and competitiveness will increase even further in the foreseeable future.

D. The Remaining DuPont Factors All Support a Finding of Likelihood of Confusion

The foregoing evidence and arguments present a boiled down analysis of the core issues at stake in this proceeding. Such an analysis is necessary to cut through Applicant's efforts to distract the Board by inserting and discussing numerous "straw man" issues, such as the existence of an unrelated European entity and the fact that ViaSat maintains military and government divisions. Moreover, Applicant has also attempted to lead the Board astray with

[28] Estes Test., at 42-45.
[29] Estes Test., at 45-46.

large color diagrams featuring the parties' respective design logos and outdated versions of ViaSat's modems which have not been used since 2006.

Notwithstanding such efforts, the crucial and dispositive issues remain clear: (1) VIASAT is a strong, registered and incontestable mark; (2) the parties' marks are similar in their entireties as to appearance, sound, and commercial impression; and (3) the parties' consumer-oriented goods and services are highly similar and related, and are sold to overlapping groups of customers. In addition, as discussed in greater detail in ViaSat's trial brief, the other *DuPont* factors also weigh heavily in favor of a finding of a likelihood of confusion.

The parties' respective channels of trade and classes of purchasers are unrestricted and *thus deemed identical* for the purposes of this opposition. In the absence of any express limitations in the involved applications or registrations (as is the case here), the Board assumes that the channels of trade for the goods or services are those normal for such goods or services, and that the purchasers are the same.[30] In any event, in the actual marketplace for this dispute, there *is* significant overlap in these areas. The vast majority – over 90% - of the terminals manufactured by ViaSat for the commercial sector are intended for home Internet access by individual end-users.[31] A significant percentage of these individuals are likely to also be potential purchasers of satellite receivers for home television viewing – Applicant's targeted consumer base.[32] Contrary to Applicant's assertions, these individual consumers *are* likely to

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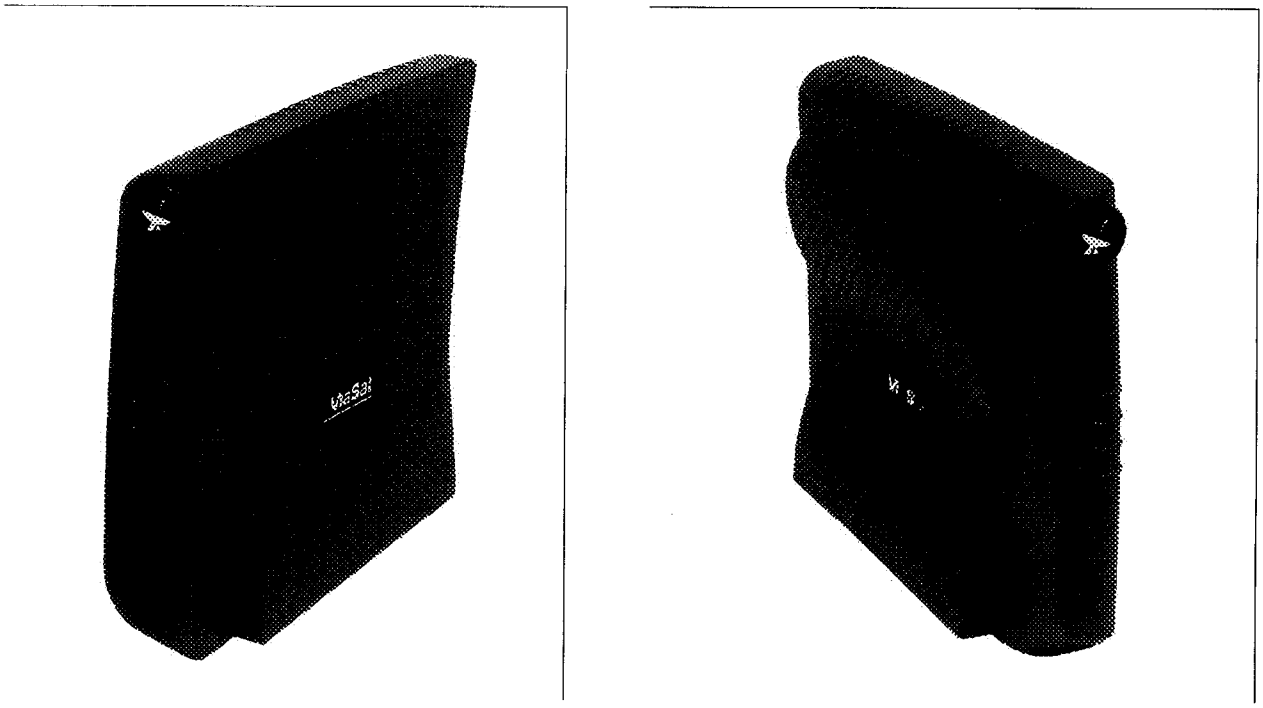
[30] *See* cases cited on p. 25 of ViaSat's trial brief: *Glamorene Prods. Corp. v. Procter & Gamble Co.*, 538 F.2d 894, 896 (CCPA 1976); *Wella Corp. v. California Concept Corp.*, 558 F.2d 1019, 1021 (CCPA 1977); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286-87 (TTAB 1998), *app. dismissed*, 178 F.3d 1306 (Fed. Cir. 1998) ("While applicant has argued that his computer programs are relatively costly and designed for engineers and maintenance managers, such conditions and limitations are also not reflected in the description of goods in applicant's applications and must be ignored").

[31] Estes Test., at 22-23.

[32] (Response No. 15 to Applicant's Amended Answers to Opposer's First Set of Interrogatories, served September 26, 2007; Rhine Depo., at 26-27.)

recognize ViaSat and associate it with their home satellite products due to the prominent labeling of the Home System with VIASAT mark, as shown below[33]:



With respect to the sophistication of the consumers, it is undisputed that consumers encountering the parties' respective goods are ordinary end-users, as opposed to sophisticated corporate or professional buyers.[34] *See Florence Mfg. Co. v. J. C. Dowd & Co.*, 178 F. 73, 75 (2d Cir. 1910) (providing the classic and oft-cited description of the ordinary consumer as "that vast multitude which includes the ignorant, the unthinking and the credulous, who, in making purchases, do not stop to analyze, but are governed by appearance and general impressions.") Regardless of Applicant's attempts to characterize its customers as "fans" of particular satellite products, this is pure speculation, at best. The fact remains that individual end-users, as opposed to corporate or

[33] VIASAT 11889-11890, attached to Notice of Reliance, August 8, 2008.
[34] Estes Test., at 22-23; Response No. 15 to Applicant's Amended Answers to Opposer's First Set of Interrogatories, served September 26, 2007; Rhine Depo., at 26-27.

professional buyers, are far more likely to experience confusion between similar marks, especially where many of the purchases are made over the Internet.[35]

When considering bad faith intent, "[c]ircumstantial evidence of copying, particularly the use of a contested mark with knowledge of the protected mark at issue, is sufficient to support an inference of intentional infringement where direct evidence is not available." *Nautilus Group, Inc. v. Icon Health and Fitness, Inc.*, 308 F.Supp.2d 1208, 1213 (W.D.Wash. 2003) (finding CROSSBOW and BOWFLEX to be confusingly similar); *see also Century 21 Real Estate Corp. v. Sandlin*, 846 F.2d 1175, 1182 (9th Cir. 1988) ("A newcomer who has...'a whole dictionary full of words, an encyclopedia full of proper names, or a world atlas full of place names,' from which it could have chosen its name and mark, has the duty to avoid the use of a mark similar to an established one."); *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991) (when a junior user selects a mark similar to another, a court can properly presume that it intends to confuse and will accomplish its purpose).

Here, there is significant circumstantial evidence to suggest Applicant's bad faith intent in adopting such a similar mark to the well-known VIASAT Marks in the satellite field. In view of the fact that the parties are in overlapping fields, have offices in the same geographic area, and encounter many of the same consumers, it is certainly advantageous for Applicant to imply an affiliation with ViaSat and its leading satellite products. This is especially true given ViaSat's solid reputation as compared with the common association of free-to-air receivers with illegal activities.[36] Moreover, whether or not Applicant possessed *actual* knowledge of ViaSat's

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[35] Response No. 12 to Applicant's Amended Answers to Opposer's First Set of Interrogatories, served September 26, 2007; Rhine Depo., at 39 ; Rhine Depo., at 77 .

[36] *See* District Court for the Southern District of California, case number 3:07-cv-01273-W-AJB in which Applicant has been accused of facilitating the piracy of satellite and television content; Rhine Depo., at 70-72

trademark rights is irrelevant, as it possessed constructive knowledge due to the existence of ViaSat's federal registrations. Lanham Act § 35, 15 U.S.C.A. § 1117. Given these factors and Applicant's reckless refusal to conduct formal trademark searching[37], this element also leans toward a finding of likelihood of confusion. *See International Star Class Yacht Racing Ass'n v. Tommy Hilfiger U.S.A., Inc.*, 80 F.3d 749, 753-754 (2d Cir. 1996) (failure to conduct a proper trademark search before product launch constituted "bad faith" – "[s]uch willful ignorance should not provide a means by which [defendant] can evade its obligations under trademark law.").

Though the pertinent facts and authority all support ViaSat's position, should the Board possess any remaining doubt, such doubts as to likelihood of confusion must be resolved against the newcomer.[38] Accordingly, Applicant's VIEWSAT Marks should be refused.

III. OBJECTION TO ADMISSION OF EVIDENCE AND DISCUSSION REGARDING UNRELATED FOREIGN MARKS

ViaSat hereby objects to the consideration or entry into the record of the following items:

1. Trial Testimony of Jung Kwak taken September 25, 2008, pp. 7:2-11:13 and Exhibit 1 thereto.
2. VIEWTECH00399 (Filed as ViaSat's August 12, 2008 Notice of Reliance, Exhibit 9).
3. Discussions of use of VIASAT mark in Europe in Applicant's Trial Brief, pp. 7, 29-30, 36, fn. 48.

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[37] Deposition transcript of the deposition of Jung Kwak, taken on December 12, 2007 ("Kwak Depo."), at 36.
[38] *See* cases cited on pp. 30-31 of ViaSat's trial brief: *Carlisle Chem. Works, Inc. v. Hardman & Holden Ltd.*, 434 F.2d 1403, 1405 (CCPA 1970); *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 1464 (Fed. Cir. 1991); *Kimberley-Clark Corp. v. H. Douglas Enter., Ltd.*, 774 F.2d 1144, 1147 (Fed. Cir. 1985); *Specialty Brands, Inc. v. Coffee Bean Distrib., Inc.*, 748 F.2d 669, 674 (Fed. Cir. 1984).

4. VIEWTECH00587-588 (Filed as ViaSat's August 12, 2008 Notice of Reliance, Exhibit 9: http://en.wikipedia.org/wiki/ViaSat%2C_Inc. (as of 8/4/2007)) and discussion relating thereto on p. 19 of Applicant's Trial Brief.

ViaSat moves that these documents and discussions be stricken from the record pursuant to Fed. R. Evid. 401 as irrelevant; Fed. R. Evid. 403 as prejudicial; Fed. R. Evid. 802 as hearsay; and Fed. R. Evid. 602 and 901 as lacking authentication and foundation.

A. The Disputed Evidence Is Irrelevant And Prejudicial.

Under the territoriality doctrine, a trademark is recognized as having a separate existence in each sovereign territory in which it is registered or legally recognized as a mark. *Person's Co. v. Christman*, 900 F.2d 1565, 1569-1570 (Fed. Cir. 1990) ("The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country's statutory scheme."). In the United States, the rule of territoriality of marks "is basic to American trademark law." *ITC Ltd. v. Punchgini, Inc.*, 482 F.3d 135, 155 (2d Cir. 2007).

Thus, it is well settled that when trademark rights within the United States are being litigated in a United States forum, evidence concerning foreign trademarks are irrelevant and inadmissible. *See Double J of Broward, Inc. v. Skalony Sportswear GmbH*, 21 U.S.P.Q.2d 1609, 1612 (T.T.A.B. 1991) ("Information concerning...foreign trademark applications and/or registrations, is not relevant to the issues in an opposition proceeding"); *Hard Rock Cafe Licensing Corp. v. Elsea*, 48 U.S.P.Q.2d 1400, 1405 (T.T.A.B. 1998) (perception of foreign public to opposer's marks is irrelevant).

Further, evidence of other trademark registrations in foreign nations is utterly irrelevant to the issue of consumer perception of a term in the United States. As the Federal Circuit observed: "Each country that recognizes some form of trademark protection will have its own

body of law and will evaluate a registration request in light of evidence of consumer perception in that country." *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 970 (Fed. Cir. 2007) (Fact that "aspirina" was registered in Spanish-speaking countries was not relevant to the significance of the term in the United States.).

The foregoing authority is unequivocal black-letter trademark law – foreign trademarks are immaterial to United States trademark disputes, and United States trademark rights are unaffected by foreign consumer perception. Even Applicant's own witness acknowledges that this legal proceeding only addresses United States trademark rights, and that he is unaware of *any* use in the United States of the VIASAT trademark by the European entity.[39] Accordingly, Applicant's efforts to extrapolate pure conjecture regarding the status of ViaSat's trademark rights in Europe into a theory on ViaSat's ability to enforce its marks against Applicant in the United States is inappropriate, and highly prejudicial.

B. The Disputed Evidence is Hearsay and Lacks Foundation

Not only is the disputed evidence entirely irrelevant, but it should also be stricken on the grounds that Applicant cannot properly authenticate or establish the documents and information sought to be entered into the record. While the parties stipulated to a presumption of authenticity of all documents originating from the parties themselves as "business records," there is no such stipulation regarding third-party documents. Here, Applicant is attempting to make of record web pages relating to an unrelated European company, a Wikipedia article regarding this same company, and a Wikipedia article regarding ViaSat. Applicant has no personal knowledge of what these documents represent, and cannot speak to the authenticity or truth of the substance contained therein.

[39] Trial Testimony of Jung Kwak taken September 25, 2008, at 11-12.

Further, Applicant's explanations as to the significance of these documents is pure speculation with absolutely no evidentiary support. On pp. 29-30, Applicant asserts emphatically that there have been no incidences of actual confusion between ViaSat and the unrelated European entity. Yet, absolutely no discovery has been conducted on this issue (because it is irrelevant), and Applicant has no personal knowledge regarding the interaction between ViaSat and the European entity. Thus, Applicant's point is a reckless fabrication that is without foundation.

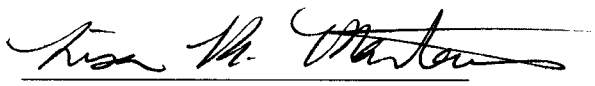
For the foregoing reasons, ViaSat respectfully requests that the disputed evidence and discussion be stricken from the record and not considered by the Board.

VI. CONCLUSION

For the reasons and evidence set forth herein as well as in ViaSat's trial brief, ViaSat respectfully requests that, pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, its opposition be sustained, that Application Serial Nos. 78/652,657, 78/855,361, and 78/855,580 be rejected, and that registration of the marks therein in connection with the goods therein specified be refused.

Respectfully Submitted,

Date 3-17-09



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ATTORNEYS FOR VIASAT, INC.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the following document:

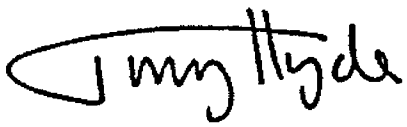
REPLY IN SUPPORT OF TRIAL BRIEF OF OPPOSER VIASAT, INC.

has been served upon the following parties on the 17th day of March, 2009, directed to said parties at the following addresses and in the below manner:

VIA EMAIL & FIRST CLASS MAIL

John Roberts
The Law Offices of Manuel de la Cerra
4155 West Reece Lane
Columbus, IN 47201-9658
john@robertsiplaw.com

Respectfully submitted,



Anthony D. Hyde