

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

Hearing:  
June 26, 2013

Mailed:  
July 23, 2013

UNITED STATES PATENT AND TRADEMARK OFFICE

---

Trademark Trial and Appeal Board

---

*Facebook, Inc.*  
*v.*  
*Think Computer Corporation*

---

Opposition No. 91198355

---

Jeffery T. Norberg of Cooley LLP for Facebook, Inc.

Think Computer Corporation *pro se*.

---

Before Bergsman, Adlin and Gorowitz, Administrative Trademark Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Think Computer Corporation (“applicant”) filed an intent-to-use application to register the mark FACEMAIL, in standard character form, for “E-mail data services; Providing e-mail and instant messaging services; Providing e-mail services; Secure e-mail services,” in Class 38.

Facebook, Inc. (“opposer”) opposed the registration of applicant’s mark on the grounds of likelihood of confusion and dilution. Specifically, opposer alleged

ownership of numerous registrations for the mark FACEBOOK, in standard character form and with a design, shown below,



including Registration No. 3801147 for the mark FACEBOOK, in standard character form, for *inter alia* “electronic transmission of instant messages and data,” in Class 38.<sup>1</sup>

Applicant, in its answer, denied the salient allegations in the notice of opposition and asserted several affirmative defenses, including unclean hands, “opposer is well-known as a ‘trademark bully,’” and, opposer’s mark is not a strong mark because of “widespread uses of the words ‘face’ and ‘book’ in trademarks.” Applicant did not file a counterclaim to cancel any of opposer’s pleaded registrations.

---

<sup>1</sup> Registered June 8, 2010. Opposer also pleaded ownership of application Serial No. 77896381 for the mark FACEBOOK and design for *inter alia* “telecommunications services, namely, electronic transmission of data, messages and information,” in Class 38, which issued as Registration No. 4099518 on February 14, 2012, after the close of opposer’s testimony period. While the pleading of the application provides notice to the applicant that opposer would rely on a registration from the application for the likelihood of confusion claim, it does not excuse opposer from the need to make the registration of record. See *UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009). Because opposer did not make the registration of record, we cannot give it any consideration.

Preliminary Issues

A. Applicant's motion for sanctions.

Pursuant to the trial order dated April 28, 2011, discovery closed on October 3, 2011 and opposer's testimony period ended January 1, 2012 (opening thirty days prior thereto or December 2, 2011).

On December 22, 2011, opposer took the testimony deposition of Larry Yu, opposer's Director of Corporate Communications. On February 24, 2012, applicant filed a motion for sanctions because opposer "failed to respond in a timely manner to a discovery request." Essentially, applicant complains that opposer's counsel instructed opposer's witness not to answer certain of applicant's questions which applicant alleged were "totally reasonable" during applicant's cross examination of Mr. Yu during his testimony deposition.

This is not a motion for sanctions for failure to comply with a discovery order by the Board. This is instead a motion based on opposer's alleged improper refusal to answer a question on cross examination during a testimony deposition. Where the witness in a testimony deposition refuses to answer a particular question and the Board at final hearing overrules the objection to the question, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. *See Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983) (no error in drawing adverse inference where witnesses inappropriately refused to

answer relevant questions), *aff'g* 213 USPQ 594 (TTAB 1982); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1467 (TTAB 1993) (where opposer's objections were found to be not well taken, Board presumed that the answers would have been adverse to opposer's position); *Health-Tex Inc. v. Okabashi (U.S.) Corp.*, 18 USPQ2d 1409, 1411 (TTAB 1990).

Applicant's motion is granted in part, to the extent that as we review and analyze the testimony, we will specifically note where opposer's witness improperly refused to answer a question and the adverse inference that we will draw from that refusal.

B. Applicant's motion challenging opposer's designations of evidence and testimony as confidential.

On June 15, 2012, applicant filed a motion requesting the Board to review all of opposer's designations of testimony and evidence as confidential under the Board's Standard Protective Order ("SPO") because opposer allegedly over-designated testimony and evidence as confidential. Parties in Board proceedings often over-designate testimony and evidence as "confidential" or "confidential attorneys' eyes only" for no apparent reason. When this happens, it is not clear to us what is intended to be truly "confidential" or "confidential attorney's eyes only." Therefore, in rendering our decision, we will not be bound by the parties' designation. Board proceedings are designed to be publicly available and the improper designation of materials as confidential thwarts that intention. It is more difficult to make findings of fact, apply the facts to the law, and write decisions that make sense when the facts may not be discussed. The Board needs to be able to

discuss the evidence of record, unless there is an overriding need for confidentiality, so that the parties and a reviewing court will know the basis of the Board's decisions.

Applicant's motion is granted in part, to the extent that as we review the testimony and evidence, we will treat only testimony and evidence that is truly confidential and commercially sensitive as confidential.

The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), applicant's application file.<sup>2</sup> In addition, the parties introduced the following testimony and evidence:

A. Opposer's testimony and evidence.

1. Notice of reliance on copies of opposer's pleaded registrations printed from the electronic database records of the USPTO showing the current status and title of the registrations;

2. Notice of reliance on applicant's responses to opposer's first sets of interrogatories and requests for admission;

3. Notice of reliance on news articles posted on Internet websites pursuant to *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d 1031 (TTAB 2010);

4. Notice of reliance on official records pursuant to Trademark Rule 2.122(e), 37 CFR § 2.122(e);

---

<sup>2</sup> Accordingly, opposer did not have to introduce applicant's answer through a notice of reliance.

5. Testimony deposition of Dr. Gerald L. Ford, a partner of Ford Bubala & Associates, a marketing research and consulting firm, with attached exhibits; and

6. Testimony deposition of Larry Yu, opposer's Director of Corporate Communications, with attached exhibits.

B. Applicant's evidence.

1. Opposer's responses to applicant's requests for admission; and

2. Applicant's notice of reliance on third-party registrations.

Standing and Priority

Because opposer has properly made its pleaded registrations of record, opposer has established its standing, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); and Section 2(d) priority is not an issue in this case as to the marks and the services covered by the pleaded registrations made of record. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the 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). *See also, In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003).

A. The fame of opposer's mark.

This *du Pont* factor requires us to consider the fame of opposers' marks. 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. A famous mark has extensive public recognition and renown. *Bose Corp. v. QSC Audio Products 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); *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Fame may be measured indirectly by the volume of sales and advertising expenditures of the goods and services identified by the marks 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 Products Inc.*, 63 USPQ2d at 1305-1306 and 1309. Although raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, raw numbers alone may be misleading. Some context in which to place raw statistics may be necessary (*e.g.*, the substantiality of the sales or advertising figures for comparable types of products or services). *Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309.

Applicant has admitted the averments in Paragraph No. 19 of in the notice of opposition set forth below:

Facebook had been the subject of thousands of unsolicited stories in television, radio and print media, highlighting Facebook's innovative and successful efforts in online networking communities. Facebook has also received numerous awards and recognitions, including a listing in Nielsen's Top 10 Web Brands (ranking Facebook 4th overall and 1st by hours spent on the site per day) in September 2009; The Webby "People's Voice Winner" for Social Networking in 2007 and 2008; Harvard's Business School's "Entrepreneurial Company of the Year" in June 2008; *BusinessWeek's* "The World's 50 Most Innovative Companies" in 2008; Business Insider's "Most Likely to Change the World" award in 2009; and The Crunchie Award for Best Overall Startup in 2007, 2008 and 2009.

This is corroborated by news articles introduced into evidence through the testimony deposition of Larry Yu. We note that these articles are not probative of the truth of the matter asserted therein; they are probative of the perception of the author and the readers. *Safer, Inc. v. OMS Invs., Inc.*, 94 USPQ2d at 1040 (the documents "are admissible only to show what has been printed, not the truth of what has been printed."). The following news articles are representative:

1. December 27, 2010 issue of *Time* magazine featuring "Facebook's Mark Zuckerberg" on the cover as its "Person of the Year."<sup>3</sup>
2. December 6, 2010 news article posted on the FT Magazine website (*FT.com*) "Facebook's grand plan for the future."<sup>4</sup> The author writes the following about opposer (emphasis supplied):

---

<sup>3</sup> Yu Dep., Exhibit 4 (TTABVue 47, pp. 11-30). The Yu deposition exhibits Nos. 2-5 (TTABVue 47) and Exhibit Nos. 6-10 (TTABVue 48) were improperly designated as confidential because they are publicly available documents. The documents in TTABVue 47 and 48 will be made publicly available.

<sup>4</sup> Yu Dep., Exhibit 5 (TTABVue 47, pp. 32-39).



Facebook is no longer merely a social network, where users check out updates from friends, glance at photos and play some games. Rather, it is making moves to be an essential part of the entire online experience. The company is becoming people's homepage, **e-mail system** and more. Much in the way Google extended its capabilities from search to include e-mail, maps and books. Facebook is becoming a part of ever more daily service on the web. The company is also making strides to achieve one thing Google has not: it is well on its way to becoming the de facto identity platform for the internet.<sup>5</sup>

3. May 31, 2010 issue of *Time* magazine featuring FACEBOOK on the cover with the headline "... and how it's redefining privacy. With nearly 500 million users, Facebook is connecting us in new (and scary) ways."<sup>6</sup>

4. An article posted on *CNNMoney.com* dated March 11, 2000 entitled "How Facebook is taking over our lives."<sup>7</sup> In describing opposer's renown, the author recounted the story of a friend who would only post his photos on FACEBOOK. "The friend's assumption: Duh – everyone's on Facebook."

Indeed, sometimes it seems as if everyone but Facebook is capitalizing on the platform. The Democratic Party in Maine is using it to organize regular meetings. Accounting firm Ernst & Young relies on the site to recruit new hires, and Dell (DELL, Fortune 500) will soon do the same. Microsoft's new operating system has a slew of features lifted straight from Facebook's playbook.<sup>8</sup>

---

<sup>5</sup> *Id.* at TTABVue 47, p. 33.

<sup>6</sup> Yu Dep. Exhibit 8 (TTABVue 48, pp. 9-13).

<sup>7</sup> Yu Dep. Exhibit 10 (TTABVue 48, pp. 19-24).

<sup>8</sup> *Id.* at TTABVue 48, p. 20.

5. The August 27, 2007 issue of *Newsweek* magazine featuring FACEBOOK on the cover with the headline “The Facebook Effect.”<sup>9</sup>

Applicant has admitted that opposer “and the FACEBOOK Marks have been the subject of extensive and continuous media attention”<sup>10</sup> and that “[a]s a result of the considerable publicity afforded the FACEBOOK Marks and the enormous and loyal base of customers that FACEBOOK has for its services, the FACEBOOK Marks have extensive consumer recognition within the United States.”<sup>11</sup>

Moreover, Larry Yu, opposer’s Director of Corporate Communications, testified that FACEBOOK was used by over 800 million people worldwide as of December 22, 2011, the deposition date.<sup>12</sup> Approximately 25 percent of opposer’s users are in the United States (200 million people).<sup>13</sup> On cross examination, applicant established that FACEBOOK users could sign up multiple times and have multiple accounts.<sup>14</sup> However, an unknown number of users with multiple accounts does not change the fact that opposer has a large presence on the Internet.

Opposer authorized Dr. Gerald L. Ford, a partner in Ford Bubala & Associates, a marketing research and consulting firm, to conduct a survey to

---

<sup>9</sup> Yu Dep. Exhibit 11 (TTABVue 49, p. 3-10).

<sup>10</sup> Applicant’s answer to Paragraph No. 39 of the notice of opposition.

<sup>11</sup> Applicant’s answer to Paragraph No. 41 of the notice of opposition.

<sup>12</sup> Yu Dep., pp. 5 and 7 (TTABVue 38, p. 6 and 8).

<sup>13</sup> Yu Dep. p. 7 (TTABVue 38, p. 8).

<sup>14</sup> Yu Dep., p. 21-23 (TTABVue 38, p. 22-24). We find that opposer improperly designated this portion of the Yu testimony deposition as confidential.

determine the extent to which the mark FACEBOOK is recognized.<sup>15</sup> “The fame survey is a traditional measure of the recognition, both unaided and aided recognition, of the Facebook mark.”<sup>16</sup>

Dr. Ford supervised a telephone survey interviewing 406 respondents. The survey employed a random digit telephone protocol of telephone numbers from working telephone exchanges throughout the United States including both landlines and cell phones.

Q. Dr. Ford, what methodology did you employ in the execution of the fame survey you conducted?

A. The fame survey was a telephone survey that was based upon what they call random digit telephone dial in. So it’s a telephone survey where telephone numbers were created really by computer, using all working telephone exchanges in the United States, both - - so you would get both listed and unlisted numbers for both landlines and for cell phone numbers.<sup>17</sup>

\* \* \*

Q. And was there a particular demographic that was targeted for this survey?

A. Well, because of the statute talking about degree of recognition among the general consuming public, there were quotas that were established so that the

---

<sup>15</sup> Based on our review of the Ford deposition transcript with its accompanying exhibits, we find that Dr. Ford is a competent expert in the field of market research, including the particular kind of research which is relevant to the renown of a mark and likelihood of confusion.

<sup>16</sup> Ford Dep., p. 11 (TTABVue 25, p. 12).

<sup>17</sup> Ford Dep., p. 12 (TTABVue 25, p. 13).

sample would be representative of all adults by age and gender 13 years of age and older.<sup>18</sup>

\* \* \*

A. Who were the survey respondents for the fame survey?

Q. They were males and females 13 years of age or older who were randomly selected from a household if reached on a landline or were randomly selected from a cell phone sample.<sup>19</sup>

After a survey candidate was properly screened to confirm that the survey candidate was an appropriate subject for the survey, the person conducting the survey read the following statement:

In a moment, I am going to ask you some questions about social networking sites on the internet.

Please understand that we are only interested in your opinions; and if you don't have an opinion or don't know the answer to a question, that is an acceptable answer.<sup>20</sup>

The questioner then asked the following questions:<sup>21</sup>

4.0 Now, thinking about social networking sites on the internet ... PAUSE ... would you please tell me the names of the social networking sites that you can think of?

Record responses.<sup>22</sup>

---

<sup>18</sup> Ford Dep., pp. 12-13 (TTABVue 25, pp. 13-14). Larry Yu, opposer's Director or Corporate Communications identified opposer's target market as persons over 13. (Yu Dep., p. 5 (TTABVue 38, p. 8)).

<sup>19</sup> Ford Dep., p. 13 (TTABVue 25, p. 14).

<sup>20</sup> Ford Dep., Exhibit 1(A), p. 7 (TTABVue 27, p. 16). Ford Deposition Exhibit 1 (TTABVue 26) is a declaration by Dr. Ford supplementing and explaining his survey results. Ford Deposition Exhibit 1(A) (TTABVue 27) is the fame survey report. Ford Deposition Exhibit 1(B) (TTABVue 42) is the likelihood of confusion survey report.

<sup>21</sup> Ford Dep., Exhibit 1(A), pp. 7-8 (TTABVue 27, pp. 16-17).

4.1 What other names of social networking sites, if any, can you think of?

Record responses.

5.0 Now I am going to read you some additional names that may or may not be names used for social networking sites on the internet ... PAUSE ... Have you ever heard of INSERT NAME(S) NOT MENTIONED IN Q4.0 or Q4.1? RANDOMIZE LIST

FACEBOOK?

TWITTER?

CLASSMATES?

DIGG?

BEBO?

GATHER?

HELIUM?

GOODREADS?

BROADMORE?

“In this survey, the in-treatment control was a fictitious mark (i.e., BROADMORE) that is not the name of a social networking site but rather a fictitious mark to provide an estimate of mismeasurement error (sometimes referred to as ‘noise’) resulting from such respondent behaviors as ‘yea saying’ agreement bias or acquiescence.”<sup>23</sup>

---

<sup>22</sup> If the respondent could not identify any social networking sites, the questioner moved to Question No. 5.1, a modified version of Question No. 5.0 above. (Ford Dep., Exhibit 1(A), p. 7 (TTABVue 27, p. 16)).

<sup>23</sup> Ford Dep., Exhibit 1, p. 8 (TTABVue 26, p. 9).

“The FACEBOOK mark for a social networking site was identified by approximately seventy-four percent (73.65%) of the general public in response to the unprompted or unaided recall questions (i.e., ‘...would you please tell me the names of social networking sites that you can think of?’ and ‘What other names of social networking sites, if any, can you think of?’).”<sup>24</sup> FACEBOOK was far and away the most recognized social networking site. MYSPACE, the second most recognized mark, was identified by 45% of the general public and TWITTER, the third most recognized mark, was identified by 39% of the general public.<sup>25</sup>

“[I]n response to the unaided and aided questions combined, approximately ninety-seven percent (97.29%) of the general public reported recognition of the FACEBOOK mark for a social networking site.”<sup>26</sup> “This level of recognition of the FACEBOOK mark for a social networking site exceeds the level of recognition of every other social networking site tested with the exception of TWITTER.”<sup>27</sup> TWITTER was recognized by 97% of the respondents when calculating the unaided (Q4.0 and Q4.1) and aided (Q5.0) questions.<sup>28</sup> Therefore, FACEBOOK and TWITTER were in a statistical tie.

BROADMORE was recognized by 2.7% of the respondents in response to the aided question (Q5.0) so that should be subtracted from the totals noted above. “Thus, in total, on a net basis, after adjusting the survey data for mismeasurement

---

<sup>24</sup> Ford Dep., Exhibit 1, p. 10 (TTABVue 26, p. 11).

<sup>25</sup> Ford Dep., Exhibit 1, p. 12 (TTABVue 26, p. 13).

<sup>26</sup> Ford Dep., Exhibit 1, pp. 10-11 (TTABVue 26, pp. 11-12)

<sup>27</sup> Ford Dep., Exhibit 1, pp. 11-12 (TTABVue 26, pp. 12-13).

<sup>28</sup> Ford Dep., Exhibit 1, p. 12 (TTABVue 26, p. 13)

or agreement bias, approximately ninety-five percent (i.e.,  $97.29\% - 2.71\% = 94.58\%$ ) of the general public recognizes the FACEBOOK mark for a social networking site.”<sup>29</sup>

The survey also included a series of questions about internet usage to determine the recognition of the mark by internet users and by social network users as opposed to the general public. With respect to internet users, “after adjusting the survey data for mismeasurement or agreement bias, the net level of recognition of the FACEBOOK mark for a social networking site among past and potential internet users ranges from approximately ninety-seven percent for past internet users ( $99.71\% - 2.86\% = 96.85\%$ ) to approximately ninety-six percent for potential internet users ( $99.16\% - 2.80\% = 96.36\%$ ) (i.e., the general consuming public).”<sup>30</sup>

With respect to social network users, “after adjusting the survey data for mismeasurement or agreement bias, the net level of recognition of the FACEBOOK mark for a social networking site among past and potential social networking users is approximately ninety-eight percent for both past users of social networking sites ( $100.00\% - 1.69\% = 98.31\%$ ) and potential users of social networking sites ( $100.00\% - 2.07\% = 97.93\%$ ) (i.e., the general consuming public).”<sup>31</sup>

Applicant argues that the survey is flawed because it asks the respondents to identify social networking sites and applicant’s application is for email and instant

---

<sup>29</sup> Ford Dep., Exhibit 1, pp. 12-13 (TTABVue 26, pp. 13-14).

<sup>30</sup> Ford Dep., Exhibit 1, p. 13 (TTABVue 26, p. 14).

<sup>31</sup> Ford Dep., Exhibit 1, pp. 15-16 (TTABVue 16, pp. 16-17).

messaging services, not social networking services.<sup>32</sup> However, the purpose of the survey was to determine the fame of opposer's mark, not applicant's mark. Thus, the survey questions asking respondents to identify social networking sites was appropriate.

In view of the foregoing, we find that opposer's FACEBOOK mark is famous. The fame of opposer's mark is particularly significant because the evidence shows that it is well known to the general public, as well as to users of social networking services. Thus, opposer's mark is "accorded more protection precisely because [it is] more likely to be remembered and associated in the public mind." *Recot*, 54 USPQ2d at 1897 (Fed. Cir. 2000) *citing Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 22 USPQ2d at 1457 and *Specialty Brands, Inc. v. Coffee Bean Distribs., Inc.*, 748 F.2d 669, 675, 223 USPQ 1281, 1284 (Fed. Cir. 1984). *See also, Bose Corp. v. QSC Audio Products Inc.*, 63 USPQ2d at 1309 (public discussion of trademarked product provides confirmation of context of use of mark and evidence that efforts to promote marked product have been successful).

B. The similarity or dissimilarity and nature of the services, established likely-to-continue channels of trade and classes of consumers.

Applicant is seeking to register FACEMAIL for "e-mail data services; providing e-mail and instant messaging services; providing e-mail services; secure e-mail services." Opposer has registered FACEBOOK for, *inter alia*, "electronic transmission of instant messages and data." Because both parties have identified

---

<sup>32</sup> Applicant's Brief, p. 26 (TTABVue 55, p. 33).



their services as transmitting/providing instant messaging services, the services are in part identical.

Because the services described in the application and opposer's registration are in part identical, we must presume that the channels of trade and classes of purchasers are the same. *See American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers."). *See also In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion).

To the extent that both registrant's recitation of services and applicant's recitation of services include more than instant messaging, likelihood of confusion may be found based on any item that comes within the recitation of services of goods in the involved application and registration." *In re La Peregrina Ltd.*, 86 USPQ2d 1645, 1647 (TTAB 2008). Thus, we may find that there is a likelihood of confusion under Section 2(d) if there is a likelihood of confusion involving any of the goods set forth in the application and opposer's pleaded registrations. *See, e.g., Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); and *Shunk Mfg. Co. v. Tarrant Mfg. Co.*, 318 F.2d 328, 137 USPQ 881, 883 (CCPA 1963).

Also, while applicant contends that its services are related to “secure electronic mail,”<sup>33</sup> applicant’s recitation of services is not so limited. Because the scope of the registration applicant seeks is defined by its application (and not by its actual use), it is the application that we must look to in determining applicant’s right to register:

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed.

*Octocom Syst. Inc. v. Houston Computers Svcs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). Thus, applicant’s arguments that its services are different than opposer’s services and that they move in different channels of trade and are sold to different classes of consumers fails because those purported differences are not reflected in either applicant’s or opposer’s recitation of services.<sup>34</sup>

In any event, Larry Yu testified that instant messaging is a part of opposer’s social networking system.

Q. What about messaging?

A. Yes, there’s also a message product, where, effectively it’s a private mode of [sic] method [sic] communication between two individuals - - where that’s one mode. Another mode is what I described earlier where some people may post on their Timeline, or what formally known as their wall, a photo album or a video. And a private message is

---

<sup>33</sup> Applicant’s response to opposer’s interrogatory No. 11 (TTABVue 15, p. 10).

<sup>34</sup> Applicant’s Brief, pp. 15-17 (TTABVue 55, pp. 22-24).

really kind of a private communication between one or even a couple of individuals.

Q. What about instant messaging?

A. Yes, Facebook also has instant messaging capability.

Q. And has Facebook had all these capabilities since you started working for Facebook?

A. For the most part, with the exception of Timeline and Places. The core functionality of sharing photos and video, for example, and instant messaging and messages have been around as long as I've had an account, which has been 2007, and certainly as long as I've been with the company.<sup>35</sup>

Also, applicant admitted that “[t]he types of service identified in the FACEMAIL Application and the types of services offered by Facebook under the FACEBOOK Marks are offered through the same channels of trade, namely, through the internet.”<sup>36</sup>

We find that the services are in part identical and, therefore, we presume, and applicant admits, that they move in the same channels of trade and are sold to the same classes of consumers.

C. The similarity or dissimilarity of the marks in terms of appearance, sound, connotation and commercial impression.

We now turn to the *du Pont* likelihood of confusion factor focusing on the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation and commercial impression. *In re E. I. du Pont De Nemours & Co.*, 476

---

<sup>35</sup> Yu Dep. p. 6 (TTABVue 47, p. 7). Mr. Yu started working at opposer in 2008.

<sup>36</sup> Applicant's answer to paragraph No. 31 of the notice of opposition. We are not finding that the internet is a monolithic entity and that just because both parties render their services through the internet means that the services move in the same channels of trade.

F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). In a particular case, any one of these means of comparison may be critical in finding the marks to be similar. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987). In comparing the marks, we are mindful that where, as here, the services are in part identical, the degree of similarity necessary to find likelihood of confusion need not be as great as where there is a recognizable disparity between the services. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1108 (TTAB 2007); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1325 (TTAB 2007).

Moreover, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression so that confusion as to the source of the goods offered under the respective marks is likely to result. *San Fernando Electric Mfg. Co. v. JFD Electronics Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Restaurants Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991), *aff'd unpublished*, No. 92-1086 (Fed. Cir. June 5, 1992). The proper focus is on the recollection of the average customer, who retains a general rather than specific impression of the marks. *Winnebago Industries, Inc. v. Oliver & Winston, Inc.*, 207 USPQ 335, 344 (TTAB 1980); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Since the users and prospective

users of opposer's services are males and females 13 and older, we are dealing with ordinary consumers.

Applicant is seeking to register the mark FACEMAIL and opposer's mark is FACEBOOK. The marks are similar to the extent that they both start with the word "Face." In this regard, we note that opposer is not, as applicant argues, claiming the exclusive right to use the word "Face" or for that matter the word "Book"; rather, opposer claims the exclusive right to use the mark FACEBOOK in connection with social networking services, including email and instant messaging services. Moreover, because opposer has registered FACEBOOK and there are no counterclaims for cancellation, opposer is entitled to the presumptions provided by Section 7(c) of the Trademark Act, 15 U.S.C. § 1057(c) (*i.e.*, a certificate of registration is prima facie evidence of the validity of the registered mark and of the registration of the mark, the opposer's ownership of the mark, and of the opposer's exclusive right to use the registered mark in commerce on or in connection with services recited in the registration).

Because the similarity or dissimilarity of the marks is determined based on the marks in their entireties, the analysis cannot be predicated on dissecting the marks into their various components; that is, the decision must be based on the entire marks, not just part of the marks. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). *See also Franklin Mint Corp. V. Master Mfg. Co.*, 667 F.2d 1005, 212 USPQ 23, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a

whole in determining likelihood of confusion”). On the other hand, different features may be analyzed to determine whether the marks are similar. *Price Candy Company v. Gold Medal Candy Corporation*, 220 F.2d 759, 105 USPQ 266, 268 (CCPA 1955). In fact, 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 the ultimate conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 224 USPQ at 751.

With respect to the FACEBOOK and design marks displayed above, the word FACEBOOK is the dominant element of the mark. The design element is merely a border used to display the mark and has little, if any, source indicating significance. In the case of marks consisting of words and a design, the words are normally given greater weight because they would be used by consumers to request the services. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1596 (TTAB 1999); *In re Appetito Provisions Co.*, 2 USPQ2d 1553, 1554 (TTAB 1987). *See also Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1798 (Fed. Cir. 1987); *Giant Food, Inc. v. Nation’s Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983)

The significance of the word “Face” as the dominant element of the parties’ marks is reinforced by its location as the first part of the mark. *See Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (“[I]t is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered”). *See also Palm Bay Imports Inc. v. Veuve Clicquot*

*Ponsardin Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

In addition, because the word “Mail” is descriptive when used in connection with applicant’s email and instant messaging services, the word “Face” in applicant’s mark is the significant source identifying element. It is well-settled that descriptive matter may have less significance in likelihood of confusion determinations. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), *quoting, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1983) (“Regarding descriptive terms, this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on the likelihood of confusion”); *In re Dixie Rests. Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

Finally, the Board has found, albeit rarely, that even if a company itself has not made use of a term, it may have “a protectable property right in the term’ if the public has come to associate the term with the company or its goods or services.” *Big Blue Products, Inc. v. International Business Machines Corporation*, 19 USPQ2d 1072, 1074 (TTAB 1991) (finding a genuine dispute of material fact as to whether prior to opposer’s first use of BIG BLUE, the public or trade had come to identify

BIG BLUE with typewriter ribbons or related goods as emanating from IBM), citing, as an example, *American Stock Exchange, Inc. v. American Express Co.*, 207 USPQ 356, 364 (TTAB 1980) (“it has been held that where the public has come to associate a term with a particular company and/or its goods or services as a result, for example, of use of the term in the trade and by the news media, that company has a protectable property right in the term even if the company itself has made no use of the term.”).

In this case, the record shows that the term “Facemail” has been used by industry writers to identify opposer’s email and instant messaging applications.<sup>37</sup>

For example,

1. A news article posted on *CNNMoney.com* on November 16, 2010.<sup>38</sup>

**Analysts weigh in on effect of FaceMail on Google, Yahoo, others**

Facebook’s “don’t call it email” email will have some effect on major email players, with Yahoo and MSN being exposed more than Google.

2. A news article posted on the eDiscovery Daily Blog (*ediscoverydaily.com*) on November 22, 2010.<sup>39</sup>

**eDiscovery Trends: Facemail and eDiscovery**

\* \* \*

Facebook announced last week that it’s rolling out a new messaging system, including chat, text messaging, status updates and email (surprise!). ... Will the integrated

---

<sup>37</sup> Opposer’s notice of reliance on Internet materials (TTABVue 16).

<sup>38</sup> TTABVue 16, p. 9.

<sup>39</sup> TTABVue 16, p. 14.



product (informally dubbed “Facemail”) that some have called “Gmail Killer” be a serious threat to Gmail, MSN and Yahoo Mail? Maybe. With 500 million plus users, Facebook certainly has a head start towards a potentially large user base.

3. A news article posted on Just A Tech Blog (*justatechblog.com*) on November 17, 2010.<sup>40</sup>

Facemail – Facebook’s Brand new Email Service – Get Your Invites

Facemail is the brand new rumored email serve from Facebook which is already rolled to a small number of users in form of invites. This so called Facemail or Facebook Mail Isn’t [sic] a Gmail Killer, but is surely going to make an impact. Project Titan being the code name for this Facemail project will allow users to have a @fb.com email address.

This evidence leads us to the conclusion that the word “Face” is the dominant element of the marks at issue and that consumers are likely to refer, and writers have referred, to opposer’s email and instant messaging services as “FaceMail.”

In view of the foregoing, we find that when we compare the marks in their entireties in terms of appearance, sound, connotation and commercial impression, the marks are more similar than dissimilar.

D. Opposer’s likelihood of confusion survey.

Because applicant has not used its mark, there has been no opportunity for actual confusion to have occurred. However, opposer introduced the testimony of Dr. Gerald Ford who supervised a likelihood of confusion survey. Survey evidence is circumstantial, not direct evidence, of actual confusion because it predicts consumer perceptions measured with scientific controls, projectable with statistical

---

<sup>40</sup> TTABVue 16, p. 27.

accuracy, as opposed to testimony of someone that he or she was confused or evidence of misdirected telephone calls or mail. *See Helene Curtis Indus., Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1626 (TTAB 1989) (“Surveys are statistical evidence that can be an aid to the Board.”).

The likelihood of confusion survey was an email survey. Dr. Ford selected the universe of respondents from a panel of individuals created and maintained by Knowledge Networks, “a probability-based internet panel generally representative of the U.S. population based on the U.S. census.”<sup>41</sup>

34. ... Knowledge Networks’ panel consists of approximately fifty thousand U.S. residents eighteen years of age or older, including cell phone-only households.

35. Potential survey respondents were randomly selected from members of the Knowledge Networks panel.

36. The survey results are representative and statistically projectable to all adults in the U.S. eighteen (18) years of age or older who currently use email and/or instant messaging, and who also met the other conditions of the survey universe.<sup>42</sup>

The respondents who qualified for the likelihood of confusion survey were people eighteen (18) years of age or older who (1) use email or instant messaging, (2) agreed to answer the survey questions themselves without any assistance, and (3) if they wore contact lenses or eyeglasses when looking at a computer monitor, would wear them when filling out the survey.<sup>43</sup>

---

<sup>41</sup> Ford Dep., Exhibit 1, p. 20 (TTABVue 26, p. 21).

<sup>42</sup> Ford Dep., Exhibit 1, p. 20 (TTABVue 26, p. 21).

<sup>43</sup> Ford Dep., Exhibit 1, p. 19 (TTABVue 26, p. 20).

The survey consisted of two survey cells: (1) a test cell designed “to measure likelihood of confusion, if any, with respect to the source, authorization/approval of, or business affiliation/connection of Applicant’s business provided under the proposed FACEMAIL mark;” and (2) a control cell to measure the extent of mismeasurement in the test cell.<sup>44</sup>

The respondents in both cells were given the following instructions:<sup>45</sup>

In this survey, you are going to be shown a survey exhibit, and then you will be asked a few questions.

Please understand that we are only interested in your opinions or beliefs; and if you don’t have an opinion or belief or don’t know the answer to a question, that is an acceptable answer.

Please feel free to take as much time as you like looking at the survey exhibit before moving on to the survey questions.

The marks were displayed for the respondents. The survey respondents in the test cell were shown applicant’s mark on their computer screen as displayed below.<sup>46</sup>



---

<sup>44</sup> Ford Dep., Exhibit 1, p. 20 (TTABVue 26, p. 21).

<sup>45</sup> Ford Dep., Exhibit 1, pp. 21-22, (TTABVue 26, pp. 22-23) and Exhibit 1(B), pp. 8 and 57 (TTABVue 42, pp. 17 and 70 ).

<sup>46</sup> Ford Dep., Exhibit 1, p. 21, (TTABVue 26, p. 22) and Exhibit 1(B), p. 6 (TTABVue 42, p. 15).

The survey respondents in the test cell were shown the mark THINKMAIL on their computer screen as displayed below.<sup>47</sup>



The survey respondents were then asked the following questions:<sup>48</sup>

4.0 Who, or what company, do you believe is offering these services with this name? ...

4.1 Why do you say that? ...

If the respondent did not know the answer to the first question, they were asked the following questions:<sup>49</sup>

5.0 Do you believe that the services with this name ...

CHOOSE ONE:

\* \* \*

\_\_\_1. one, are being offered with the authorization or approval of any other company or companies;

\_\_\_2. two, are not being offered with the authorization or approval of any other company or companies; or

\_\_\_3. three, don't know or have no opinion?

---

<sup>47</sup> Ford Dep., Exhibit 1, p. 21, (TTABVue 26, p. 22) and Exhibit 1(B), p. 55 (TTABVue 42, p. 68).

<sup>48</sup> Ford Dep., Exhibit 1, p. 21, (TTABVue 26, p. 22) and Exhibit 1(B), pp. 8 and 57 (TTABVue 42, pp.17 and 70).

<sup>49</sup> Ford Dep., Exhibit 1, p. 21, (TTABVue 26, p. 22) and Exhibit 1(B), p. 9-10 and 58-59 (TTABVue 42, pp. 18-19 and 71-72).

IF ... USED WITH AUTHORIZATION ...  
CONTINUE;

OTHERWISE, GO TO →Q6.0

5.1 With what other company or companies? ...

5.2 Why do you say that?

6.0 Do you believe that the company that offers these services with this name ...

CHOOSE ONE. ...

\_\_\_\_1. one, has a business affiliation or business connection with any other company or companies;

\_\_\_\_2. two, does not have a business affiliation or business connection with any other company or companies; or

\_\_\_\_3. three, don't know or have no opinion?

IF ... HAS A BUSINESS AFFILIATION ...  
CONTINUE;

OTHERWISE, GO TO →Q7.0

6.1 With what other company or companies? ...

6.2 Why do you say that?

Dr. Ford supervised 551 interviews: 270 in the test cell and 272 in the control cell.<sup>50</sup> The test cell survey results are summarized below.

1. Approximately 30% of the respondents (85) identified Facebook as the source of the email and/or instant messaging services (Answer to Q4.0);<sup>51</sup>

---

<sup>50</sup> Ford Dep., Exhibit 1, p. 23 (TTABVue 26, p. 24).

<sup>51</sup> Ford Dep., Exhibit 1, p. 27 (TTABVue 26, p. 28).

2. An additional 1% of the respondents (3) reported that they believed that the FACEMAIL email or instant messaging services would be offered by Facebook (Q5.0);<sup>52</sup> and

3. An additional 4.3% of the respondents (12) reported that they believed that the company offering FACEMAIL email or instant messaging services has a business affiliation or connection with Facebook (Q6.0).<sup>53</sup>

None of the respondents in the control cell survey reported that they believed that there was any connection or affiliation between THINKMAIL and Facebook.<sup>54</sup>

According to the survey results, approximately 36.2% “of the relevant universe of potential consumers of email and/or instant messaging services expressed a belief that Applicant’s business provided under the proposed FACEMAIL mark is either offered by Facebook, that the name is being used with the authorization/approval of Facebook, or that the company that uses the name has a business affiliation/connection with Facebook.”<sup>55</sup> The responses to the follow-up questions – “Why do you say that?” – made specific reference to the similarities between the names FACEMAIL and FACEBOOK.<sup>56</sup>

Keeping in mind that there is no such thing as a perfect survey, we find that there were no serious flaws in the likelihood of confusion survey that would

---

<sup>52</sup> Ford Dep., Exhibit 1, p. 28 (TTABVue 26, p. 29).

<sup>53</sup> Ford Dep., Exhibit 1, p. 29 (TTABVue 26, p. 30).

<sup>54</sup> Ford Dep., Exhibit 1, pp. 30-32 (TTABVue 26, pp. 31-33).

<sup>55</sup> Ford Dep., Exhibit 1, pp. 32-33 (TTABVue 26, pp. 33-34).

<sup>56</sup> Ford Dep., Exhibit 1, pp. 33-40 (TTABVue 26, pp. 34 -41). See also Ford Exhibit 1(B), pp. 13 -26 (TTABVue 42, pp. 23-36).

undermine the reliability of its results.<sup>57</sup> The manner in which the survey was conducted was in keeping with standard survey formats. Under such circumstances, the Board has previously found that “a 29 percent level of confusion is significant” and that “[f]indings of likelihood of confusion have been based on survey results indicating substantially lower percentages of confusion.” *Miles Laboratories v. Naturally Vitamin Supplements*, 1 USPQ2d 1445, 1457 (TTAB 1987). Accordingly, we find that opposer’s survey results support a finding that there will be a likelihood of confusion.

E. Balancing the factors.

Because opposer’s mark FACEBOOK is famous and because the marks are similar and the services are in part identical and there is a presumption that the services move in the same channels of trade and are sold to the same classes of consumers, we find that applicant’s mark FACEMAIL for “e-mail data services; providing e-mail and instant messaging services; providing e-mail services; secure e-mail services” is likely to cause confusion with opposer’s FACEBOOK marks. The finding of likelihood of confusion is corroborated by the likelihood of confusion survey authorized by opposer.

With respect to applicant’s affirmative defenses, there is no evidence or testimony upon which we could rely to change our decision. Applicant argues that

---

<sup>57</sup> We note applicant’s argument that Dr. Ford should have used a mark with a FACE-prefix as a control. (Applicant’s Brief, p. 24; TTABVue 55, p. 31). We disagree because the purpose of a control cell is to measure “noise” by accounting for responses by people who are providing the answers they think the survey taker wants rather than what the respondent truly thinks. Dr. Ford’s use of THINKMAIL as the control term achieves its purpose.

opposer is a legal bully “using fraud, deceit, and an army of well-paid litigators to effectively crush any entity deemed a threat by its megalomaniacal leadership” and that opposer’s history in this regard “has been heavily documented in the public domain, and needs no further exposition here.”<sup>58</sup> However, we may not take judicial notice of the facts underlying applicant’s allegations and without evidence of the same, this “defense,” such as it is, fails. Moreover, our review of the record does not reveal any egregious conduct on the part of opposer to support applicant’s claims that opposer is a “trademark bully” or has acted unconscionably in prosecuting the opposition.

Likewise, applicant’s argument that “The Facebook” is the name of an electronic directory of Harvard University students is not supported by any testimony or evidence.<sup>59</sup>

Because we have found that there is a likelihood of confusion, we do not address the dilution claim.

**Decision:** The opposition is sustained and registration to applicant is refused.

The documents identified in TTABVue 47 and 48 are to be made publicly available.

---

<sup>58</sup> Applicant’s Brief, p. 1 (TTABVue 55, p. 8).

<sup>59</sup> Applicant’s Brief, p. 2 (TTABVue 55, p. 9).