

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed: July 7, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Box, Inc.

v.

Hakem Ikbariyeh

Opposition Nos. 91202576

Nigamnarayan Acharya and Joseph V. Myers III of Seyfarth Shaw LLP for Box, Inc.
Hakem Ikbariyeh, *pro se.*

Before Taylor, Wellington and Adlin, Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Hakem Ikbariyeh (“Applicant”) seeks registration of BOXME, in standard characters, for “storage services for archiving databases, images and other electronic data.”¹ In its notice of opposition, Box, Inc.² (“Opposer”) alleges prior use and

¹ Application Serial No. 85213301, filed January 7, 2011, originally based on use in commerce under Section 1(a) of the Trademark Act, but later amended to allege as the filing basis a bona fide intent to use the mark under Section 1(b) of the Act.

² Opposer identified itself as “Box.net, Inc.” in its initial pleading but later began referring to itself as “Box, Inc.” The evidence reveals that “Box.net is the original company name of what is now known as Box Inc.” 51 TTABVue 12.

registration of BOX and variations thereof for “on-line content storage, archival, management and collaboration services” offered “in the cloud,” including through mobile apps and Opposer’s website accessible at “box.net.” As the sole ground for opposition, Opposer alleges that use of Applicant’s mark would be likely to cause confusion with Opposer’s marks. In his answer, Applicant denies the salient allegations in the notice of opposition and asserts a number of “Affirmative Defenses.” Many of Applicant’s “Affirmative Defenses” are in fact merely amplifications of his denials, and others were not pursued at trial and are accordingly waived. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. American Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012). Applicant also counterclaimed to cancel Opposer’s pleaded Registration No. 3429191 (the “191 Registration”) only, on the grounds of genericness and descriptiveness. Opposer denies the salient allegations of the counterclaim.

The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the files of Applicant’s involved application (subject to the opposition) and Opposer’s ‘191 Registration (subject to Applicant’s counterclaim). The record also includes Opposer’s pleaded applications and registrations, printouts of which from an Office database showing their current status and title were attached to the notice of opposition under Trademark Rule 2.122(d)(1), as well as the following trial evidence:

Opposer’s First Notice of Reliance (“Opposer’s NOR 1”), 41 TTABVue, on Internet printouts;³

³ Citations to the record reference TTABVue, the Board’s online docketing system. Specifically, the number preceding “TTABVue” corresponds to the docket entry number(s),

Opposer's Second Notice of Reliance ("Opposer's NOR 2"), 40 TTABVue, on certain of Applicant's responses to Opposer's interrogatories and requests for admission;

Opposer's testimonial deposition of Maninder Sagoo, 51 TTABVue, a member of its legal team, and the exhibits thereto;

Opposer's testimonial deposition of Kate Orrin, 52 TTABVue, a member of its product marketing team, and the exhibits thereto;

Applicant's First Notice of Reliance ("Applicant's NOR 1"), 60 TTABVue, on a third party registration and its file history; and

Applicant's Second Notice of Reliance ("Applicant's NOR 2"), 61-62 TTABVue, on third party registrations and their file histories, and Internet printouts.

Applicant's untimely Third Notice of Reliance was stricken from the record on that basis by the Board's order of January 6, 2016, and has been given no consideration.

The Parties

Opposer was founded in 2005. According to Mr. Sagoo, Opposer offers "a cloud-based sync and share content collaboration product and platform." 51 TTABVue 10. According to Ms. Orrin, BOX is Opposer's "main" trademark, which it uses for "cloud software and sharing solutions," including "the core Web application that you access at Box.com," as well as mobile and desktop applications and "partner integrations." 52 TTABVue 13-14.

and any number(s) following "TTABVue" refer to the page number(s) of the docket entry where the cited materials appear.

Opposer has been using the BOX mark since at least as early as 2010. 52 TTABVue 15-17, 21, 47-48, 54-55, 59-60, 84-85. Opposer also uses “extensions” of the BOX mark, “for events such as BoxWorks or our products names like Box Sync.” For example, Opposer offers the BoxWorks and Boxdev user and developer conferences, Box for Android, Box Edit, etc. 52 TTABVue 13, 31.⁴ Opposer has proven its ownership of the following registrations:

<u>Mark</u>	<u>Reg. No./Issue Date/Status</u>	<u>Goods/Services</u>
BOX (standard characters)	3429191 May 20, 2008 Section 8 Affidavit Accepted	Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information
BOX (standard characters)	3722965 December 8, 2009 Section 8 Affidavit Accepted; Section 15 Affidavit Acknowledged	Advertising the goods and services of others via the Internet
BOX (standard characters)	3612423 April 28, 2009 Section 8 Affidavit Accepted	On-line journals, namely, blogs discussing technology and business

⁴ Opposer did not plead, argue or establish that it owns a “family” of marks; the issue was not tried. *Cf. Productos Lacteos Tocumbo S.A. de C.V. v. Paeteria La Michoacana Inc.*, 98 USPQ2d 1921, 1927 (TTAB 2011) (“Petitioner’s reference to a family of marks in its brief will not be considered because this claim was neither pleaded nor tried by the parties.”).

<p>BOX.NET (standard characters)</p>	<p>3618747 May 12, 2009</p>	<p>On-line journals, namely, blogs discussing technology and business Computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information</p>
<p>FETCHBOX (typed)</p>	<p>2650384 November 12, 2002 Renewed</p>	<p>Electronic storage of remote computer data</p>

Notice of Opposition Exs. A-D, F.⁵

The following advertisement from Opposer’s reseller AT&T provides an overview of the “AT&T resale Box application,” and is in many ways similar to how Opposer itself promotes its “cloud-based sync and share content collaboration” products and services:

⁵ Opposer did not introduce evidence that any of its pleaded applications issued as registrations after the filing of the notice of opposition. *See UMG Recordings Inc. v. O’Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009). Following the trial, one of Opposer’s pleaded registrations was cancelled and one of its pleaded applications was abandoned.

Box from AT&T simple, highly secure sharing

Manage and access your content from virtually anywhere

Box from AT&T is a scalable and highly secure solution that allows businesses of all sizes to share and store content online. This enables easy collaboration with anyone both inside and outside of your company, plus access to content from virtually anywhere, using smartphones, tablets, the web, and desktop computers.

- Extends content to the places your business is already working
- Provides high security for your content
- Enhances collaboration and increases productivity among your end users



Manage Your Content In The Cloud
By combining rich administrative and security features with the ease of use typical of mobile apps and online collaboration software, Box is reinventing how businesses share, manage, and access all of their files with cloud-based content management.

Result: Users are more productive than ever before and can quickly and easily access mission-critical files from virtually anywhere.

Capture

Put your content in the cloud for access virtually anywhere, anytime.

- Create and organize multiple layers of folders with various levels of user permissions
- Download, view and edit any type of file on any web browser with high security
- Use any cross platform environment, from Windows and Mac OS to Linux
- Access and view files on-the-go with compatible Smartphones, Tablets, and other mobile devices
- Brand Box with your logo and color scheme to keep your company's look and feel consistent inside Box

Potential Benefits

- **Drive mobile productivity:** Box enables businesses to make quick decisions, finish projects fast and keep teams up-to-date
- **Both users and IT love and adopt Box:** Users collaborate easily, while IT maintains security and oversight
- **Simple to deploy and maintain:** Box lowers total cost of ownership compared to traditional IT infrastructure. No software to install or hardware to buy
- **Oversight at every level:** Delivers enterprise grade security, robust administrative controls and audit trails

Features

- **Share and Collaborate:** Create, edit and share your content with everyone
- **Sync:** Sync desktop files to your Box account
- **Mobility:** Access content on Box mobile apps for iOS, Android, and more
- **Platform Integrations:** Access Box from other leading business apps
- **Admin and Security:** Secure content with admin controls and permissioning

52 TTABVue 22, 86.

Opposer has been successful, and increasingly so. For example, it had more than 3.5 million users of its cloud content management services in 2009, more than 5 million users in 2010 and more than 25 million users in January 2014. It currently has “over 32,000 paying business customers,” including eBay and Proctor & Gamble. 52 TTABVue 29-30, 128, 131; 51 TTABVue 14, 23. Opposer’s “number of users have increased year on year since we were founded.” 51 TTABVue 14. Opposer’s app was

reviewed more than 52,000 times on Google Play in the two months preceding Ms. Orrin's deposition. 52 TTABVue 13.

Applicant has not sold or promoted any products or services under his BOXME mark and has not used the mark in commerce. 40 TTABVue 7-10, 16-21. However, when asked to admit that the services identified in his application "perform similar function to" Opposer's identified services, Applicant asserted that "there is functionality available to customers of each service in which similar tasks may be carried out such as storing information onto remote computers for later access." *Id.* at 18, 20-21.

**The Meaning of "Box" in the Context of Cloud and
Computer-Related Products and Services**

Applicant introduced the following definitions of the term "box" and related terms used in connection with computers and the cloud:

Box—(in technology)—A computer; especially in the construction "foo box" where foo is some functional qualifier, like "graphics", or the name of an operating system (thus, "Unix box", MS-DOS box", etc.) ...⁶

Dropbox folder—The shared network location where a Synchronizer can leave or pick up design and data changes.⁷

Lightbox—In digital asset management (DAM) systems, a Lightbox is the term used to describe an area within the Web site (or Web service) or other internal DAM where users can create and store a list of assets they want to reference or use at a later time. Lightboxes are common

⁶ 62 TTABVue 46 (dictionary.com).

⁷ 62 TTABVue 55 (dictionary.babylon.com).

on stock photo Web sites where registered users can store images until they are ready to download them.⁸

Web Box—a network computer used exclusively for access to the Internet, or designed for such use.⁹

In addition, Applicant relies on dictionary definitions of variations of the term “box,” including “inbox” (“a place on a computer where email messages arrive”),¹⁰ “outbox” (“where outgoing e-mail messages are temporarily stored”),¹¹ “dialog box” (“a window that pops up on the screen with options that the user can select”)¹² and “search box” (“a box for entering text which will be used for a search in a database, on the Internet, etc.”).¹³ Applicant introduced an article entitled “What is ‘ASP’ (Application Service Provider)?,” which indicates that: ASP refers to “remote software that you access through a web browser;” and “With the one exception of printing, all the software work is performed through the wire and on the distant ASP box.” 62 TTABVue 76 (netforbeginners.about.com).

The term “box” is also used for cloud-based activities in the education field. For example, one book on education defines “Digital Drop-Box” as “A tool that the instructor and students can use to exchange files. It works by uploading a file from a disk or a computer to a depository ...;” another defines “Drop box” as “a feature of

⁸ 62 TTABVue 66 (webopedia.com).

⁹ 62 TTABVue 73 (dictionaryofengineering.com).

¹⁰ 62 TTABVue 47(Cambridge Dictionaries Online) and 63 (pc.net).

¹¹ 62 TTABVue 67 (pc.net).

¹² 62 TTABVue 49 (pc.net).

¹³ 62 TTABVue 61 (dictionary.com).

some learning management system software programs that allows users to submit assignments, eliminating the need to mail, fax, or e-mail them;” and a third indicates that “there are collaboration tools such as a ... drop box (a shared repository for files).”¹⁴ The “Online Courses & Degrees” section of a University of Colorado website provides instructions on “navigating the dropbox” through which assignments are submitted and receive instructor comments,¹⁵ and another education website, under “Course Tools,” includes a “Dropbox” page which states that it “provides a central location where you and your students can submit and retrieve assignments and graded activities.”¹⁶

Third-Party Use and Registration of BOX Marks

Applicant introduced the following “live” third-party registrations for marks containing BOX which are used for products or services which are identical, similar or closely related to those at issue in this case¹⁷:

<u>Mark</u>	<u>Owner</u>	<u>Reg. No./Issue Date</u>	<u>Goods/Services</u>
DROPBOX (standard characters)	Dropbox, Inc.	4478345 Feb. 4, 2014	Computer software and downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and

¹⁴ 62 TTABVue 50 (*Distance Education: Definitions and Glossary of Terms*) ,53 (*Creating a Sense of Presence in Online Teaching: How to ‘Be There’ for ...*) and 54 (*Problem-Based Learning Online*).

¹⁵ 62 TTABVue 81 (ucdenver.edu).

¹⁶ 62 TTABVue 82 (help.college.com).

¹⁷ We have not included many third-party registrations which contain BOX and are used in the computer hardware, software or application service provider fields generally, and have instead only listed those registered for cloud computing or similar products or services.

			<p>multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of life sciences research or software for uploading or transferring advertising programs and media advertising communications</p> <p>Storage of electronic media, namely, data, documents, files, text, photos, images, graphics, music, audio, video, and multimedia content</p> <p>Providing temporary use of non-downloadable computer software used to store and share data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content with others via global computer networks, mobile telephones, and other communications networks for the purpose of file back up and synchronization, not including software for use in database management in the field of biomedical research or software for uploading or transferring advertising programs and media advertising communications; hosting of digital content on the internet</p>
BLUE BOX (standard characters)	Blue Box Group, Inc.	4357847 June 25, 2013	... consulting services in the field cloud computing solutions... computer services, namely, cloud hosting provider services ... hosting of digital content on the internet
BOMGAR BOX (standard characters)	Bomgar Corp.	3558117 Jan. 6, 2009	... computer hardware and software for use in delivering and deploying software applications and data over the Internet and/or to remote users ...

“BOX” disclaimed			
DATABOX (standard characters)	Zeppelin, Inc.	4625785 Oct. 21, 2014	Computer application software for portable electronic devices, namely, software for monitoring, analyzing, viewing, visualizing, storing, organizing, and sharing information ... Software as a service (SAAS) services featuring software for portable electronic devices, namely, software for monitoring, analyzing, viewing, visualizing, storing, organizing, and sharing information ...
ANYWHERE BOX (standard characters) “BOX” disclaimed	Vonage Marketing LLC	3982249 June 21, 2011	... computer software and hardware for providing transmission and exchange of voice, video, data, images and graphics in the field of telecommunications ...
RECEIPT BOX (standard characters)	RetailGreen	4625477 Oct. 21, 2014	Computer software for reading, writing, accessing, and storing financial data, commercial transaction data, and retail transaction data
CLOUD IN THE BOX (standard characters) “CLOUD” disclaimed	Toss Corp.	4234716 Oct. 30, 2012	... Cloud computing featuring software for document storage and retrieval and hosting services; Computer service, namely, acting as an application service provider in the field of information management to host computer application software for the purpose of document storage and retrieval and hosting services ... Computer service, namely, acting as an application service provider in the field of knowledge management to host computer application software for searching and retrieving information from databases and computer networks; Computer service, namely, acting as an application service provider in the field of knowledge management to host computer

			application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer services, namely, cloud hosting provider services ... Computer services, namely, hosting and maintaining an on-line web site for others for document storage and retrieval and hosting services; Computer services, namely, integration of private and public cloud computing environments ... Consulting services in the field of cloud computing ... Hosting an online website featuring document storage and retrieval and hosting services ... Software as a service (SAAS) services, namely, hosting software for use by others for document storage and retrieval and hosting services ...
CUSTOMER TOOLBOX (standard characters) Supplemental Register "TOOLBOX" disclaimed	EFA Processing, LP	3952855 April 26, 2011	Software as a service (SAAS) services, featuring on-line software for compiling, tracking, and managing customer account information and worksheets for use in connection with business process outsourcing and customer relationship management for debt negotiation and debt settlement services provided by others
iFilebox (standard characters)	Daniel A. Warfield	3931667 March 15, 2011	Downloadable computer application software for mobile phones, portable media players, handheld computers for the collection, editing, organization, modifying, book marking, transmission, storage and sharing of data and information
POSTBOX (standard characters)	Postbox, Inc.	3886819 Dec. 7, 2010	Downloadable software to facilitate data sharing among computer users and for managing digital messages and electronic data and content

<p>MY MAILBOX (standard characters) “MAILBOX” disclaimed</p>	<p>My MailBox.com, LLC</p>	<p>4283313 Jan. 29, 2013</p>	<p>... application service provider (ASP) featuring software to enable uploading, posting, showing, displaying, sharing or otherwise providing electronic media or information over the Internet or other communications network; provided, however, that the provision of any or all of the above services is not directed to educators or teachers in the field of education</p>
<p>VAULT-IN-A-BOX (standard characters)</p>	<p>Eoriginal, Inc.</p>	<p>3158136 Oct. 17, 2006</p>	<p>computer software and hardware for the electronic transmission, storage, transfer, syndication and securitization, retrieval and destruction of authenticated electronic information objects using sophisticated cryptographic technology and providing access version and distribution controls together with a secure electronic storage facility, all for use in the control of documentation or other information objects in mortgage, leasing, healthcare, shipping/transportation and other business applications</p>
<p>cloud outside the box. (standard characters) “CLOUD” disclaimed</p>	<p>Entreda, Inc.</p>	<p>4163716 June 26, 2012</p>	<p>Cloud computing featuring software for use in data back-up, data-base management and application failover; Cloud seeding; Computer services, namely, cloud hosting provider services; Providing virtual computer systems and virtual computer environments through cloud computing</p>
<p>TREASURE BOX (standard characters)</p>	<p>Fuhu Holdings, Inc.</p>	<p>4574535 July 29, 2014</p>	<p>Computer application software for a handheld mobile digital electronic device comprising of a full featured tablet computer, electronic book reader, digital audio and video player, electronic personal organizer, personal digital assistant, electronic calendar, and global positioning system that contains a dedicated homepage for</p>

			receipt and sending of messages and content related to children's issues, is preloaded with children's publications, websites that contain news and information feeds related to children's issues, and unique filters related to children's content on the Internet, and allows users to browse the Internet as well as send, receive, and store messages and other data, namely, software for allowing users to purchase and download software applications, computer game programs, audio content, audiovisual content, music, multimedia and video content using virtual currency via a global computer network; Computer software and firmware, namely, operating system programs and data synchronization programs for personal and handheld computers; database synchronization software; computer programs for accessing, browsing and searching online databases
OUTBOX SYSTEMS (standard characters) "SYSTEMS" disclaimed	Outbox Systems, LLC	4646077 Nov. 25, 2014	Business consulting services, in the field of cloud solutions ... Consulting in the field of cloud computing; Computing services, namely, cloud hosting provider services ...
Internet-in-a-Box (standard characters)	Humane Informatics LLC	4501430 March 25, 2014	Computer hardware and software systems for dissemination and display of data; Computer software for dissemination and display of data

61 TTABVue.

Applicant also introduced examples of third-party use of the term BOX in connection with cloud computing and related products and services. For example, the Office uses the term for a repository of digital images:

**U.S. Patent and Trademark Office
Electronic Information Products Division**

Daily Trademark Application Image 24 Hour Box*

The U.S. Patent and Trademark Office (USPTO) provides an electronic Trademark Application 24 Hour Box of JPEG (black and white, grey-scale, or color) and TIFF (black and white) images processed through the Trademark Image Capture and Retrieval System (TICRS) and viewable using any standard image viewer. With the JPEG images there will also be an XML file that contains text information about the application.

Beginning November 2, 2003, the USPTO began accepting electronic submissions of Trademark applications from the International Bureau (IB) and will continue accepting electronic submissions of Trademark applications from the Trademark Electronic Application System (TEAS). The images received in electronic submissions of Trademark applications from the IB and TEAS will be in the JPEG format and can be black and white, grey-scale, or color. The USPTO will also continue to receive paper submissions of Trademark applications and will capture the black and white images in TIFF format.

62 TTABVue 43-44. Dropbox, Inc., the owner of the DROPBOX registration, offers a productivity app described as follows on the Google Play Store:

Description

01/28/15 <https://play.google.com/store/apps/details?id=com.dropbox.android&hl=en>

Dropbox is a free service that lets you bring all your photos, docs, and videos anywhere. After you install Dropbox on your computer, any file you save to your Dropbox will automatically save to all your computers, your Android device, and even the Dropbox website! With the Dropbox app, you can take everything that matters to you on the go.

Read your docs or flip through your albums when you're out and about. Save photos or videos to your Dropbox and share them with friends in just a couple taps. Even if you accidentally leave your Android in a taxi, your stuff is always safe on Dropbox.

Features:

- Always have your stuff with you, no matter where you are.
- Save photos and videos to your Dropbox.
- Share your photos and docs with family and friends.
- Save email attachments straight to your Dropbox.
- Easily edit docs in your Dropbox.

Terms of Service: <https://www.dropbox.com/terms?mobile=1>

62 TTABVue 56. An article in Fortune magazine entitled “How to tell the difference between Box and Dropbox” suggests, on its face, that consumers are aware of multiple uses of “box” in the cloud computing industry:

Quick – name a cloud-based, file-sharing provider that’s expected to go public later this year and has the word ‘box’ in its name. (Hint: there’s more than one right answer). Whether you guessed Box or Dropbox, you’re correct. That’s because, on the surface, the two appear to be very similar companies ... bottom line, both companies have similar offerings: web-based storage, synching and sharing for photos, documents, and other files.

62 TTABVue 59. The company 6xW targets a “Digital Evidence Box” to law enforcement and other organizations:

Digital Evidence Box

The burden on police forces and other organisations such as transport authorities (e.g. TfL) is mounting rapidly as public pressure increases on these organisations to implement more video-based crime detection methods or to use video to ensure accountability and compliance.

In conjunction with our partners, Aiazon, 6xW are developing Digital Evidence Box, a platform that facilitates ingestion, management and syndication of evidence related digital media from multiple sources including body worn video, CCTV, vehicle cameras and video submitted by the public (e.g. via an app or YouTube) that could constitute vicare evidence. This can also include other digital assets such as audio and still images.

Digital Evidence Box provides the ability to manage huge amounts of video data and to securely control its distribution.

Benefits and Features

- Built on an enterprise-class digital asset management system proven across wide client base (used by many of the world's top content originators and broadcasters)
- Automated media ingestion via feed readers or watch folders
- Multiple sources including body worn video, CCTV, vehicle cameras, video submitted by the public, audio (e.g. interview files) and images
- Integration of inbound syndicated media e.g. from public transport authorities such as TfL
- Ability to ingest legacy media (including digitising of analogue video footage)
- Multiple transcoding for different file formats that are required to be distributed – media can be distributed across many touch points including web, mobile and TV
- Just in time video encoding – potentially reduce cost through reduction in processing time and storage
- Ability to add metadata during ingestion phase and post ingestion
- Media management workflow – provides control of entire process from ingestion to distribution
- Video editing and chapter points creation (linked to unrefined video)
- Media publishing and content management – provides easy mechanism to build and publish to video orientated web sites (e.g. Crimnetzappers). Automated online channel updates
- Live event capability e.g. for online appeal web broadcasts
- Integrated video enhancement capability
- Multiple streaming platforms and protocols
- Variety of video players that can be embedded across different platforms
- Extensive metadata features providing deep search capability

62 TTABVue 51-52. Another company, Inbox.com, offers a cloud-based “sync and share” product called “inboxstorage”:

http://storage.inbox.com/ 01/28/15

Sign Up | Log In

Home Features How It Works Download Support

> Sync and Share Your Files

Synchronize Your Digital Life

Access your files from anywhere

Start with Inbox Storage

Centralize and Synchronize Files

Securely store, manage and share all of your music, videos, photos and documents in your cloud account.

2GB Free Online Cloud Storage

Upload your files to a free 2GB web account and access it from anywhere.

Easy File Sharing

Share files and folders privately and securely with people you invite and set their sharing permissions.

Mobile Access

Access and synchronize your stored files using mobile apps for Android™, iOS or Windows Phone™.

File History

Protect yourself from "digital disasters" with file versioning and easy restoration.

Trusted and Secure

Your data is securely transferred to and from your cloud account using advanced security protocols.

Start Syncing Your Digital Life Now. → Get Inbox Storage for Free

http://storage.inbox.com/ 01/28/15

English

Products

- [Get 2 GB Free Account](#)
- [How It Works](#)
- [Check out the Features](#)
- [Explore Pricing](#)
- [Earn Bonus Storage Space](#)

Get The App

- [Windows](#)
- [iPhone/iPad](#)
- [Android](#)
- [Windows Phone](#)

About

- [Get Support](#)
- [Terms of Use](#)
- [Privacy Policy](#)
- [Partners](#)
- [News](#)

Connect With Us

- [Facebook](#)

inboxstorage

http://storage.inbox.com/ 01/28/15

62 TTABVue 65. A similar cloud-based file sharing tool is called OneTimeBox:

OneTimeBox^{beta} [Sign in](#)

<http://www.onetimebox.org/>
01/28/15

OneTimeBox

Easily create and share single-use, live web folders.

[Create your Box](#)

Powered by: *Filepicker*

1. Get a hold of a box



Get yourself a free, disposable box.

2. Put your junk in that box



I'm sure you have a lot of junk. Put it in that box.

3. Make them open the box



And that's the way you do it.

01/28/15
<http://www.onetimebox.org/>

1 GB

filesize limit

1 week

box lifetime

Unlimited

files per box

Open Source

OneTimeBox is an open source project, operating under the MIT license. If you would like to contribute, or want to host your own OneTimeBox service, check out the [Github repo](#) for detailed instructions on registering, building, and deploying your own instance for free.

01/28/15
<http://www.onetimebox.org/>

As seen on...

lifehacker

 digital inspiration
let's create

... **mindme** tips



62 TTABVue 83.

Applicant's Counterclaim¹⁸

“Because a trademark owner’s certificate of registration is ‘prima facie evidence of the validity of the registration,’” the petitioner seeking cancellation of the registration, in this case Applicant by way of his counterclaim, bears the burden of proof, and must establish its grounds for cancellation by a preponderance of the evidence. *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *see also, On-line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *7-11 Sales, Inc. v. Perma, S.A.* 225 USPQ 170 (TTAB 1984).

Genericness

We turn first to Applicant’s counterclaim that BOX is generic for the services identified in Opposer’s ‘191 Registration.

As the Supreme Court has held, “[g]eneric terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.” *Park ’N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1985) (citing 15 U.S.C. §§ 1052, 1064). This is so because “[g]eneric terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status.” *In re Merrill Lynch, Pierce, Fenner, & Smith, Inc.*, 828 F.2d 1567, 1569 (Fed. Cir. 1987); *see also Princeton Vanguard, LLC v. Frito-Lay N. Am., Inc.*, 786 F.3d 960, 965 (Fed. Cir. 2015).

¹⁸ Applicant has standing to seek cancellation of Opposer’s ‘191 Registration because it is the defendant in the opposition (in which Opposer relies on the ‘191 Registration). *Bd. Of Regents, Univ. of Tex. Sys. v. S. Ill. Miners, LLC*, 110 USPQ2d 1182, 1196-97 (TTAB 2014).

“A generic term ‘is the common descriptive name of a class of goods or services.’” *Princeton Vanguard*, 786 F.3d at 965 (quoting *H. Marvin Ginn Corp. v. Int’l Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 989 (Fed. Cir. 1986)). “The critical issue in genericness cases is whether members of the relevant public primarily use or understand the term sought to be protected to refer to the genus of goods or services in question.” *Ginn*, 782 F.2d at 989–90. Under *Ginn* a two-step test is applied to determine whether a given term is generic. *Id.* at 990. “First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?” *Id.*; see also *Princeton Vanguard*, 786 F.3d at 965; *Reed Elsevier*, 482 F.3d at 1378. “Evidence of the public’s understanding of the mark may be obtained from ‘any competent source, such as consumer surveys, dictionaries, newspapers and other publications.’” *Princeton Vanguard*, 786 F.3d at 965 (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 1559 (Fed. Cir. 1985)).

In re Cordua Rests., Inc., ___ F.3d ___, 118 USPQ2d 1632, 1634 (Fed. Cir. May 13, 2016).

Here, as is often the case, the appropriate genus is adequately defined by Opposer’s identification of services: “computer services, namely, acting as an application service provider in the field of knowledge management to host computer application software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information.” *Id.* at 1636 (quoting *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991)). Indeed, there is no dispute that Opposer uses its BOX mark for, as Opposer variously

refers to its identified services: “cloud storage software¹⁹ and services,” a “cloud-based sync and share content collaboration product and platform” and “cloud software and sharing solutions.” 74 TTABVue 8 (Opposer’s Combined Trial Brief as Respondent in the Counterclaim and Reply Brief as Plaintiff in the Opposition); 51 TTABVue 10; 52 TTABVue 13-14. For that matter, Applicant concedes that his services are essentially the same. 40 TTABVue 18, 20-21.

As for the “relevant public,” it consists of both ordinary consumers and businesses in need of cloud-based storage and sharing solutions. 51 TTABVue 27 (offering Opposer’s services “for Personal,” “for Business” and “for Enterprise IT”) and 31. Indeed, neither party’s identification of services contains any limitation on the type of customer for the services.

The evidence does not establish that this relevant public understands BOX primarily to refer to cloud-based storage, sharing and syncing services or software. In fact, the overwhelming majority of the evidence reveals use of terms or phrases which merely *include* BOX, as but one of the terms comprising the mark, or as a suffix, rather than use of Opposer’s actual mark in its entirety, i.e. the term BOX by itself. *See, In re Merrill Lynch*, 4 USPQ2d at 1143 (Office did not show “by clear evidence, that the financial community views and uses the term CASH MANAGEMENT ACCOUNT as a generic, common descriptive term for the brokerage

¹⁹ While Opposer’s BOX mark is technically registered for computer services rather than computer software, its identification of services references “acting as an application service provider” and hosting “computer application software.” This makes any distinction between software and services essentially irrelevant, at least for purposes of defining the genus in this case. *See generally In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1601-1602 (TTAB 2014) (defining the genus for cloud-based goods and services).

services to which Merrill Lynch first applied the term”); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1763 (TTAB 2013), *aff’d* 565 Fed. Appx. 900 (Fed. Cir. 2014) (“Petitioner submitted no evidence of use from a printed publication of the phrase ‘Annapolis tours’ per se as a generic designation for respondent’s services.”). *See also Princeton Vanguard*, 114 USPQ2d at 1832 (“the Board must consider the record evidence of the public’s understanding of the mark as a whole” and “the Board must consider the mark in its entirety”); *cf. In re Cordua Rests.*, 118 USPQ2d at 1635 (“The presumption of validity of 15 U.S.C. § 1057(b) does not carry over from registration of the older mark to a new application for registration of another mark that happens to be similar (or even nearly identical).”).

In fact, the *only* evidence that arguably shows use of the term BOX by itself, without modifiers, additional terms or other elements is a dictionary definition indicating that *in the technology field* the term refers to a computer. This definition does not establish how the relevant public, which includes general consumers without a background in technology, understands the term BOX, much less establish that the relevant public understands the term to refer to cloud storage, sharing and syncing services or software, as opposed to computers. Similarly, even if we were to consider the Office’s Daily Trademark Application Image 24 Hour Box and 6xW’s Digital Evidence Box as revealing use of BOX alone, and we do not, neither use indicates how the relevant public understands the term, as opposed to trademark professionals or law enforcement personnel. The terms and marks for which Applicant submitted evidence, including for example, “lightbox,” “inbox,” “dropbox,” BOMGAR BOX,

RECEIPT BOX, POST BOX and OneTimeBox, do not establish that BOX by itself is generic. *See Magic Wand*, 19 USPQ2d at 1553 (affirming dismissal of petition to cancel registration of TOUCHLESS for automobile washing services, based on Board's finding that "the evidence demonstrates limited generic use of the term 'touchless' before members of the relevant purchasing public"); *In re Homes & Land Publishing Corp.*, 24 USPQ2d 1717, 1718 (TTAB 1992) (finding RENTAL GUIDE not generic for a real estate listing magazine for rental properties, where the Examining Attorney submitted only dictionary definitions of "rental" and "guide" and three articles using the term, one of which referred to applicant).

Applicant's argument that Opposer uses BOX as "a metaphor for a computer-based online storage tool," or a "folder where files are easily accessed, stored, edited and manipulated" is not sufficient to establish that the term is generic. There is simply no evidence that the relevant public understands this "metaphor." *See In re Seats, Inc.*, 757 F.2d 274, 225 USPQ 364, 367-68 (Fed. Cir. 1985) (finding SEATS not generic for ticket reservation and issuing services for various events by means of a computer, stating "[t]he term 'seats' may be generic in relation to chairs or couches or bleachers. It is clearly not generic to reservation services ... Seats is not selling seats, as would for example a furniture merchant, but is selling a reservation service ...") and *Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USQ2d 1458, 1471 (TTAB 2014) (finding PERKS and related terms not generic for a volume discount buying service, even though "a volume discount buying program may be offered to an employee or customer as a 'perk'"). *See also In re American Fertility*

Society, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999) (“Aptness is insufficient to prove genericness.”). Here, Opposer is not selling a “box.”

It is Applicant’s burden to establish that BOX is generic for cloud-based storage, sharing and syncing services or software. *Couch/Braunsdorf*, 110 USPQ2d at 1462. However, Applicant’s evidence of how the relevant public understands the term in question – BOX by itself -- is quite limited, and insufficient to meet that burden. Accordingly the counterclaim to cancel Opposer’s ‘191 Registration on the ground of genericness is dismissed.

Descriptiveness

Turning to Applicant’s counterclaim on the ground of descriptiveness, a mark is deemed to be merely descriptive, within the meaning of Section 2(e)(1), if it immediately conveys knowledge of a quality, feature, function, characteristic or purpose of the services for which it is used. *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (quoting *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and *In re Abcor Development*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). A mark need not immediately convey an idea of each and every specific feature of the services in order to be considered merely descriptive; rather, it is sufficient that the mark describes one significant attribute, function or property of the services. *In re Chamber of Commerce of the United States of America*, 675 F.3d 1297, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012); *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); and *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Applicant's evidence comes much closer to establishing that BOX is merely descriptive of Opposer's services, but still falls short. On the one hand, there is significant third-party use of the term BOX in connection with cloud-based storage, sharing and synching software and services, and a number of "live" third-party registrations for cloud-based products and services include the term. The evidence of third-party use of the term for services similar to those involved here weighs in favor of a finding of mere descriptiveness. *See Remington Products Inc. v. North American Philips Corp.*, 892 F.2d 1576, 13 USPQ2d 1444, 1449 (Fed. Cir. 1990) ("It is very easy for marks consisting of common, simple English words having connotations related to the products on which they are used, their properties, or uses to slip out of their origin-indicating role into the vernacular as descriptive terms and once that happens the possibility of registration as trademarks under the Lanham Act vanishes."). Moreover, the third-party registrations "show the meaning of a mark in the same way that dictionaries are used." *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693, 694-95; *Couch/Braunsdorf*, 110 USPQ2d at 1471. Here, the third-party uses and registrations tend to show that BOX is not arbitrary, or particularly distinctive, but instead reveals something about cloud-based storage, sharing and synching solutions, at least metaphorically, in that these types of cloud-based solutions serve as a figurative "box" in which content is stored and from which it is accessed.

On the other hand, the evidence does not establish that BOX *immediately* conveys knowledge about the services at issue. In the context of Opposer's services, "box" is

defined as a “computer,” which while obviously related to cloud-based storage, sharing and syncing, is merely an indirect indication of the means by which not only Opposer’s services, but an untold number of other products and services in modern society, are performed. Indeed, most of Applicant’s evidence shows that “box” is normally combined with generic, descriptive or suggestive terms to convey a more precise meaning, such as “dialog box,” “drop box,” “ASP box” or “outbox,” or arbitrary terms such as “Bomgar” or “Blue” to identify source. The evidence simply does not establish use of “box” alone to identify cloud-based storage, sharing or syncing. Moreover, in most of the third-party registrations containing the word “box” *per se* (rather than those in which the word is “telescoped” with another term such as in “iFilebox”), the term “box” is not disclaimed.

While a different record might very well yield a different result, based on the record in this case we cannot find that Applicant has met his burden of establishing that BOX is merely descriptive of Opposer’s services. The dictionary definition of “box” in the context of technology does not support such a finding, the Office does not generally require that the term be disclaimed when used in connection with cloud-based products and services, and, although the evidence reveals that the “box” metaphor in the field of cloud computing is fairly common, it does not establish that the term immediately conveys information about Opposer’s services. Rather, the “box” metaphor is indirect and requires a “mental leap” to connect the word “box,” which typically conveys a physical container for storing physical goods, or at most a type of computer, with the remote storage of and access to digital content.

Accordingly, the counterclaim to cancel Opposer's '191 Registration on the ground of descriptiveness is also dismissed.

Opposer's Claim

Because we have dismissed Applicant's counterclaim, Opposer is entitled to rely on its pleaded '191 Registration.

Standing and Priority

Opposer's '191 Registration establishes Opposer's standing. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 945, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000). And priority is not at issue with respect to the services identified in the '191 Registration. *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). In any event, Opposer began using its mark before the filing date of the involved application. 52 TTABVue 15-17, 21, 47-48, 54-55, 59-60, 84-85.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA

1976). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which the parties introduced evidence, and treat the remaining factors as neutral.

We focus our analysis on the '191 Registration for BOX in standard characters, because if we find confusion likely between that mark and Applicant's mark, we need not consider the likelihood of confusion between Applicant's mark and Opposer's other pleaded marks. On the other hand, if we find no likelihood of confusion between Applicant's mark and the mark in Opposer's pleaded '191 Registration, we would not find confusion between Applicant's mark and Opposer's other pleaded marks, which are either used for different goods and services than Applicant's mark, or are less similar to Applicant's mark in overall commercial impression than BOX in standard characters. *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

The Services and Channels of Trade

Applicant's "storage services for archiving databases, images and other electronic data" encompass Opposer's application service provider services "for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information." Applicant concedes that through the parties' services "similar tasks may be carried out such as storing information onto remote computers for later access." 52 TTABVue 18, 20-21. Therefore, the services are identical. Furthermore, because the services are identical, we must presume that the channels of trade and classes of purchasers for those services are too. *See 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); *In re Yawata Iron & Steel Co.*, 403 F.2d 752, 159 USPQ 721, 723 (CCPA 1968) (where there are legally identical goods, the channels of trade and classes of purchasers are considered to be the same); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011). The identical services and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of a finding of likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); *In re Max Capital Group*, 93 USPQ2d at 1248.

The Marks and the Strength of Opposer's Mark

Applicant's mark begins with "BOX," the entirety of Opposer's mark, which is an obvious and important similarity, because the first part of Applicant's mark looks exactly the same, and would likely be pronounced the same, as Opposer's mark. In fact, the first part of a mark is often its most prominent and dominant feature. *Presto Prods. Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it 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 Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir.

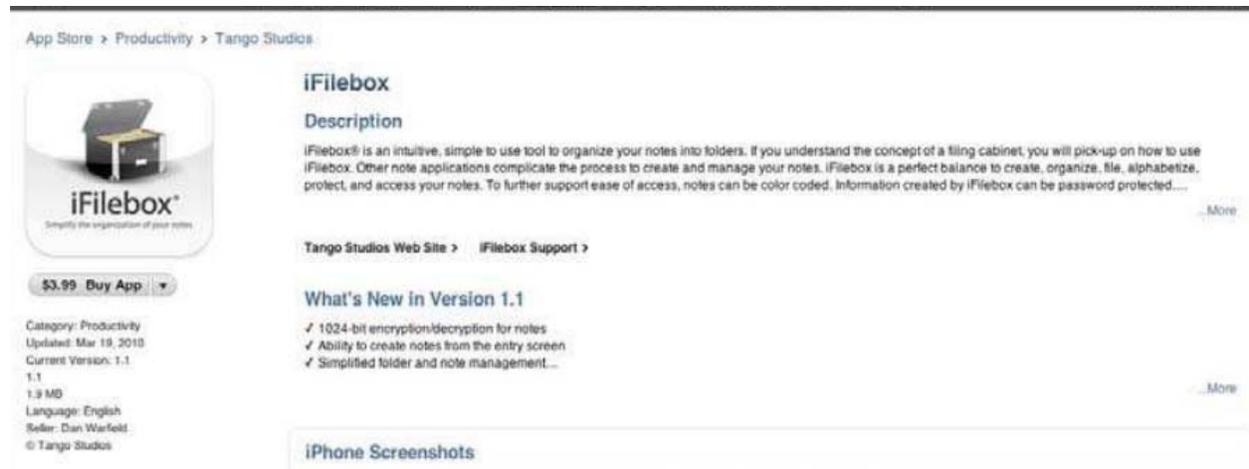
2005); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

On the other hand, Opposer's mark consists of a commonly used word with a well understood meaning, which has been shown to be suggestive of and commonly used for the parties' services. Applicant's mark, by contrast, is not a word, and thus has no meaning at all. To the extent that consumers understand Applicant's mark as a composite of the two words "box" and "me," we find that this creates a different commercial impression than BOX alone. Opposer's mere argument that "customers could believe that Applicant's mark is intended to be a personalized version of Opposer's mark," 63 TTABVue 16, is not well taken. Opposer's services offered under its BOX mark are not only "for Business" and "for Enterprise IT," but also "for Personal," 51 TTABVue 27, so there is already a "personalized version" of Opposer's services, and it is offered under the mark BOX alone. *Id.* at 31 ("Today, we're announcing 5GB of free web storage *for our personal subscription plans.*"). In any event, there is no evidence or basis upon which to conclude that consumers would associate Applicant's mark with Opposer or Opposer's mark; it seems more likely that consumers could perceive Applicant's services as one more offering by another distinct source under a mark which contains the word "box." In short, the marks convey different meanings, which is a meaningful distinction.

Nevertheless, if Opposer's mark was entitled to an average scope of protection, the marks would be similar enough in overall commercial impression for this factor to weigh in Opposer's favor. But Applicant argues that Opposer's mark is at best weak,

and so we next consider the mark's commercial and conceptual strength. Indeed, "[t]he weaker an opposer's mark, the closer an applicant's mark can come without causing a likelihood of confusion and thereby invading what amounts to its comparatively narrower range of protection." *Juice Generation, Inc. v. GS Enterprises, LLC*, 794 F.2d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015).

As indicated in our discussion of Applicant's counterclaim, the 16 third-party registrations which include the term "box" and are used for cloud-based storage, sharing and syncing solutions essentially function as a dictionary in this situation, and establish that the term "box" has a meaning in the industry. *Tektronix*, 189 USPQ at 694-95; *Couch/Braunsdorf*, 110 USPQ2d at 1471; *see also, Juice Generation*, 115 USPQ2d at 1675 ("[a] real evidentiary value of third party *registrations* per se is to show the sense in which ... a mark is used in ordinary parlance.' 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4th ed. 2015) (emphasis added). 'Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.' *Id.*"). Here, the word "box" is registered not only by Opposer, but also by numerous third-parties, and is used as a metaphor for the hardware and software which stores digital content and from which the content may be accessed remotely, just as cardboard boxes store physical goods for later access. This specimen from the iFilebox Registration No. 3931667 is illustrative, as it depicts a box which is analogized to a filing cabinet:



61 TTABVue 519. The other third-party uses depicted in this decision, by the Office, Dropbox, 6xW, Inbox.com and OneTimeBox further establish that when used in connection with the parties' services, "box" is quite suggestive, which reduces the scope of protection to which Opposer's mark is entitled, especially because Opposer's mark is BOX alone, without any additional arbitrary or more distinctive features.²⁰ In fact, as Applicant points out, we previously found, albeit on a partially different record, "that BOX is a weak term in the computer industry in that it signifies a computer or computer related device." *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1957 (TTAB 2006). Moreover, Opposer has admitted that its mark is suggestive: in arguing that there is no likelihood of confusion between the mark in its '191 Registration (BOX) and the mark BOXXET, Opposer argued that its mark "BOX suggests a creative manner of storing data, in a way that a traditional box might store, e.g., books." Office Action Response of Dec. 5, 2007 for the '191 Registration at

²⁰ The conceptual weakness of Opposer's mark is further established by many additional third-party uses and registrations of BOX marks for computer hardware or software or application service provider services which are not discussed in this decision but nevertheless part of the record.

3. *See generally Juice Generation*, 115 USPQ2d at 1675 (“Although estoppel based on prosecution of an application has played a more limited role for trademarks than for patents ... we have recognized that such comments have significance as ‘facts ‘illuminative of shade and tone in the total picture confronting the decision maker.’”).

“Box” not only has a recognized suggestive meaning in connection with the parties’ services, but we assume it is not a coincidence that the term is also widely used by third-parties for those services. While Applicant has not presented specific evidence concerning the extent and impact of these uses, it nevertheless presented “evidence of these marks being used in internet commerce” for the parties’ services and related services.²¹ *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millenium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1136 (Fed. Cir. 2015); *see also Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (Internet printouts “on their face, show that the public may have been exposed to those internet websites and therefore may be aware of the advertisements contained therein”). We find this evidence and the voluminous other evidence in the record to be “powerful on its face. The fact that a considerable number of third parties use similar marks was shown,” *Juice Generation*, 115 USPQ2d at 1674, and Opposer did not contradict this showing with evidence. The evidence that BOX is commercially weak for cloud-based storage, sharing and synching services is further supported by

²¹ As with Applicant’s showing of conceptual weakness, his showing of commercial weakness is bolstered by additional third-party uses of BOX marks for computer hardware or software or application service provider services which are not discussed in this decision but nevertheless part of the record.

the evidence that BOX also has a more general meaning in the field of computers. *See In re Box Solutions*, 79 USPQ2d at 1957-58 (“BOX is, at a minimum, highly suggestive of computers and we accord this term a very narrow scope of protection.”).

While we acknowledge that Opposer has been successful, attracting an increasingly large number of users, at the same time: (1) there is no evidence concerning how much Opposer has spent in marketing or promoting its BOX mark, or how many consumers have been exposed to Opposer’s advertising; (2) the (apparently) unsolicited media attention in the record,²² much of it from blogs, does not support a finding that the BOX mark is particularly well known and because Opposer employs a “freemium” business model, it is unclear how many of Opposer’s users try Opposer’s services on a “one-off” basis or how much exposure they have had to Opposer’s BOX mark; and (3) while Opposer’s large user base is impressive, the numbers provided include international users, and there is no indication of how many users are in the United States, other than testimony that “our largest user base is domestically in the U.S.” 51 TTABVue 13, 14, 27, 30-31, 45, 53, 54; 52 TTABVue 48, 121-122, 127.

In any event, any consumer recognition of Opposer and its BOX mark is offset by the widespread use of the term “box” and the box metaphor in the parties’ industry.

Jack Wolfskin’s evidence demonstrates the ubiquitous use of paw prints on clothing as source identifiers. Given the volume of evidence in the record, consumers are conditioned to look for differences between paw designs

²² Opposer did not provide circulation figures, specific information about the number of consumer impressions or other evidence about the extent of public exposure to Opposer’s BOX mark.

and additional indicia of origin to determine the source of a given product. Jack Wolfskin's extensive evidence of third-party uses and registrations of paw prints indicates that consumers are not as likely confused by different, albeit similar looking, paw prints.

Jack Wolfskin, 116 USPQ2d at 1136.

In short, we agree with Applicant that Opposer's BOX mark is conceptually weak, and that the evidence of commercial weakness is stronger than the limited evidence Opposer has offered to show consumer recognition or marketplace strength. Accordingly, while the parties' marks are in some ways similar, we find that they are different enough, given the weakness of Opposer's mark, that consumers will be able to distinguish between them. Indeed, given the coexistence Opposer's BOX mark with the directly competitive DROPBOX mark, as well as several other BOX marks for cloud-based storage, sharing and synching services, there is no reason to expect that use of Applicant's BOXME mark will result in confusion where none existed before.

It seems both logical and obvious to us that where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection afforded the owners of strong trademarks. Where a party uses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of all we have said is that in the former case there is not the possibility of confusion that exists in the latter case.

Sure-Fit Products Co. v. Saltzson Drapery Co., 254 F.2d 158, 117 USPQ 295, 297 (CCPA 1958). *See also, Couch/Braunsdorf*, 110 USPQ at 1476-78 (finding, based on this principle, "that the mark PERKSPOT is sufficiently different from the marks PERKS and PERKSCARD to avoid a likelihood of confusion" even though the marks

were used for legally identical services); *Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 779-80 (TTAB 1979) (allowing registration of NATURE'S PLUS for vitamins despite prior registration of PLUS for vitamins given coexistence of a number of registrations containing PLUS for similar goods). Applicant itself successfully argued, in prosecuting the application which issued as its '191 Registration, that its mark BOX is not likely to be confused with BOXXET for related services, in part because of "the fact that others are using similar marks in the market place without confusion," which "suggests that no confusion will in fact occur in the future." Office Action Response of Dec. 5, 2007 for the '191 Registration at 3. See generally *Juice Generation*, 115 USPQ2d at 1675 (response to Office Action "illuminative of shade and tone in the total picture confronting the decision maker.").

Conclusion

Although Applicant has not met his burden of establishing that the mark in Opposer's '191 Registration is generic or descriptive, and its counterclaim is therefore dismissed, the record as a whole makes clear that Opposer's BOX mark is conceptually and commercially weak, such that the differences between BOX and BOXME are sufficient, despite the identical services and channels of trade, that consumer confusion is unlikely. In fact, as a result of the large number of marks containing BOX which are used for the parties' services and related products and services, consumers have learned to look for differences between the marks and additional indicia of origin to distinguish the source of those services.

Decision: Applicant's counterclaim and the opposition are both dismissed.