Goodman

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: October 15, 2013

Opposition No. **91207409**

The PNC Financial Services Group, Inc.

v.

Keith Alexander Ashe dba Spendology and Spendology LLC joined as party defendant

Before Quinn, Cataldo and Masiello, Administrative Trademark Judges.

By the Board:

Spendology LLC (hereinafter "applicant")[1] seeks to register in standard character form the mark SPENDOLOGY for the following services in International Class 36: "Web-based personal finance tools, namely, providing a website featuring non-downloadable instructional videos in the field of finance, online financial calculators, and online information in the field of finance."[2] The PNC Financial

[1] Although Keith Alexander Ashe remains joined to this proceeding, see Board's order of April 17, 2013, the involved application was assigned to Spendology LLC as of January 30, 2013, and recorded in the Office's Assignment Branch at Reel 4950, Frame 0611.

[2] Application Serial No. 85456136, filed October 25, 2011, under Section 1(a), amended to Section 1(b) by response to Office Action, April 9, 2012.

Services Group, Inc., (hereinafter "opposer") has opposed registration on the grounds of priority and likelihood of confusion. Opposer alleges ownership of an application for the mark SPENDOLOGY for Class 36: "an online money management tool that allows account holders to track balances, budgets, and expenses, by category and time period."[3] Opposer also relies on its common-law rights through use of the mark SPENDOLOGY.

Applicant, in its answer, has denied the salient allegations of the notice of opposition and asserted affirmative defenses.[4]

Now before the Board are the parties' cross-motions for summary judgment on the priority and Section 2(d) ground, filed May 14, 2013, (applicant) and June 18, 2013, (opposer), respectively. In essence, each party argues that it has priority based on either actual trademark use or use analogous to trademark use. Although applicant did not respond to opposer's cross-motion for summary judgment,

[3] Application Serial No. 85650817, filed June 13, 2012, under Section 1(a), claiming a date of first use and first use in commerce of August 2010.

[4] Applicant's affirmative defenses nos. 1-3 and 5-8 are not true affirmative defenses but amplifications of its denial to opposer's priority and likelihood of confusion claim. Applicant's affirmative defense no. 4 which asserts "res judicata" based on the examining attorney's Office action is insufficient. It is well-settled that actions by examining attorneys are not binding on the Board and have no precedential value. *See In re Medical Disposables Co.*, 25 USPQ2d 1801, 1805 (TTAB 1992).

due to the dispositive nature of the motion, we exercise our discretion and will consider both cross-motions on their merits. *SFW Licensing Corp. v. Di Pardo Packing Ltd.*, 60 USPQ2d 1372, 1375 (TTAB 2001).

A party is entitled to summary judgment when it has demonstrated that there is no genuine dispute as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(a). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). When cross-motions for summary judgment are presented, the Board evaluates each motion on its own merits and resolves all doubts and inferences against the party whose motion is being considered. *Mingus Constructors, Inc. v. United States*, 812 F.2d 1387, 1390-91 (Fed. Cir. 1987)).

Opposer's motion for summary judgment is supported by the declaration of Bryan L. Mackrell, Product Manager of

Payments & eBusiness, PNC Financial Group, Inc. (Mackrell declaration), and accompanying exhibit; and applicant's interrogatory responses.

Applicant's motion for summary judgment is supported by exhibits and applicant's and opposer's discovery responses.[5]

Standing

Before we consider the merits of the cross-motions for summary judgment, we must first consider whether opposer has demonstrated that there is no genuine dispute of material fact as to its standing to bring this opposition proceeding. Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

[5] Applicant's exhibits are not accompanied by any authenticating affidavit or declaration. However, the 2010 amendments to Fed. R. Civ. P. 56(c)(2), "'eliminated the unequivocal requirement that documents submitted in support of a summary judgment motion must be authenticated.'" *Akers v. Beal Bank*, 845 F.Supp.2d 238, 243 (D.D.C. 2012)). The lack of authentication is now grounds for objection, but only on the basis that the evidence *cannot* be admissible. Rule 56(c)(2); *Foreword Magazine, Inc. v. Overdrive, Inc.*, No. 1:10-cv-1144, 2011 WL 5169384, at *2 (W.D. Mich. Oct. 31, 2011). Here, opposer has not raised any objection to applicant's exhibits. Accordingly, the exhibits will be considered as being what they purport to be. *See e.g., Slate v. Byrd*, No. 1:09CV852, 2013 WL 1103275, at * 2 (M.D.N.C. 2013) ("Because [defendant] has not filed an objection contending that the cited material 'cannot be presented in a form that would be admissible in evidence,' no basis exists for the Court to decline consideration of the material at issue.").

The Mackrell declaration states that opposer has been offering SPENDOLOGY money management tools to the general public since August 26, 2010. The Mackrell declaration, which declares opposer's use of SPENDOLOGY in connection with online money management tools, is sufficient to establish opposer's standing to bring this opposition proceeding. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000) (direct commercial interest satisfies the "real interest" test). Moreover, applicant does not contend otherwise. Accordingly, we find no genuine dispute of material fact exists regarding opposer's standing.

Likelihood of confusion

In determining likelihood of confusion, we are guided by the factors set out in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

For purposes of their motions, the parties are essentially in agreement that likelihood of confusion is not in dispute in this case because the parties' marks are identical and the services are related. Opposer's notice of opposition, paragraph 10; opposer's response to applicant's interrogatory no. 6; applicant's response to opposer's interrogatory no. 8. Applicant's summary judgment brief, p. 3; Opposer's summary judgment response

and brief p. 10. *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393, 1395 (TTAB 2007) (considering certain facts undisputed based on discovery responses and on concessions made in the brief in response to a motion for summary judgment).

Accordingly, we find there is no genuine dispute of material fact that the parties' contemporaneous use of the mark at issue is likely to cause confusion.

Priority

To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party must prove that, vis-à-vis the other party, it owns "a mark or trade name previously used in the United States ... and not abandoned...." Trademark Act § 2, 15 U.S.C. § 1052. Opposer does not own an existing registration upon which it can rely for purposes of priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). In addition, opposer cannot rely on the filing date of its pleaded application as a constructive use date for purposes of priority because its pleaded application has a later filing date (June 13, 2012) than applicant's Section 1(b) application, which has a filing and constructive use date of October 25, 2011.

Therefore, in order for opposer to prevail on its priority claim, opposer must prove that it has a proprietary interest in the mark SPENDOLOGY and that the interest was obtained prior to the filing date of applicant's application, October 25, 2011, or prior to any date of use on which applicant may rely, including any use analogous to trademark use. *Herbko International Inc. v. Kappa Books Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Otto Roth & Co., Inc. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *L.& J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1966 (TTAB 2007); *Dyneer Corp. v. Automotive Products plc*, 37 USPQ2d 1251, 1254 (TTAB 1995).

In support of its motion, applicant has submitted evidence so as to establish an earlier priority date than its constructive use date of October 25, 2011, based on use analogous to trademark use. Applicant does not claim, nor does any evidence support any other use, e.g., trade name use[6], that might give it priority.

[6]Prior use of a trade name in connection with the sale or advertising of goods or services, if of such a nature and extent to create an association by the purchasing public of the goods or services with the user, is sufficient to establish priority in an inter partes dispute. *TuTorTape Laboratories, Inc. v. Halvorson*, 155 USPQ 268, 270 (TTAB 1967).

In order to demonstrate that use analogous to trademark use has given rise to proprietary rights, a party must show that such prior use was sufficient to create an association in the minds of the purchasing public between the mark and the goods. *Malcolm Nicol & Co. v. Witco Corp.*, 881 F.2d 1063, 11 USPQ2d 1638, 1639 (Fed. Cir. 1989). We may infer the fact of identification of the mark with the party on the basis of indirect evidence regarding the party's use of the word or phrase in advertising brochures, catalogs, newspaper ads, articles in newspapers, trade publications and Internet websites which create a public awareness of the designation as a trademark identifying the party as a source. *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1882 (Fed. Cir. 1996) vacating *Pactel Teletrac v. T.A.B. Systems*, 32 USPQ2d 1668 (TTAB 1994); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009).

We find that taken as a whole, applicant's exhibits do not establish proprietary rights arising before its October 25, 2011 constructive use date. *West Florida Seafood, Inc. v. Jet Restaurants*, 31 F.3d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994).

The personal budgeting survey created on June 15, 2010, and an undated budget presentation are not evidence

of use analogous to trademark use as neither document references the mark SPENDOLOGY.[7]

Applicant's securing of the spendology.net web domain from hostgator.com on July 24, 2010 does not by itself establish use analogous to trademark use in connection with the services. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ2d 1545, 1556 (9th Cir. 1999) (registration of a domain name does not by itself constitute use for purposes of establishing priority of use).

With regard to the SPENDOLOGY website itself, applicant has provided two SPENDOLOGY "beta" website pages which are not self-authenticating as they do not include the date and URL on the printout, although one page includes a copyright notice dated 2010. Neither page references the services identified in the involved application.[8] We note that even if the pages had been authenticated, they could only be considered for what they show on their face and not for the truth of matters

[7] The survey was sent to six individuals; the presentation was not sent to any customers. Applicant's interrogatory responses, 5 and 6.

[8] The page www.spendology.net/archiveindex.php states that "Spendology is a web app that combines event planning and budgeting to help you plan and prioritize your expenses." Applicant has submitted the web pages under a confidential filing. If applicant regards the beta website as a secret, it implies that applicant has not yet made the website public.

asserted therein, as no declaration testimony has been provided regarding how many persons viewed or were exposed to the website. Therefore, the website evidence fails to establish use analogous to trademark use in connection with applicant's services.

As to applicant's use of social media, the act of joining Twitter on April 25, 2011, or Facebook on May 21, 2011, (applicant's interrogatory response no. 7) does not by itself establish use analogous to trademark use. Cf. *Brookfield Commc'ns, Inc.,* 50 USPQ2d at 1556 (registration of domain name does not by itself constitute use for purposes of priority). With regard to the social media evidence, which includes URL and dates of publication, there is no declaration testimony as to consumer exposure to applicant's blog posts, twitter page, tweets, or Facebook page. None of this evidence shows use in connection with applicant's identified services. In particular, the blog postings at spendology.wordpress.com, "a discussion at the intersection of behavior economics, innovation, and personal finance" published on July 21, 2010, July 26, 2010, August 3, 2010, and August 25, 2010, do not reference applicant's services. Although the "About" page on the blog identifies SPENDOLOGY as "a software company that is making budgeting super easy" this

reference does not relate to the services as identified in the involved application. Applicant's printout of its SPENDOLOGY TWITTER page shows a "tweet" asking "Are you a smart spender?" on April 25, 2011, which makes no reference to opposer's services. The SPENDOLOGY Facebook cover page makes no reference to applicant's services, and the June 2, 2011 Facebook posting shares links to articles by NPR and Vanguard, but provides no information in connection with applicant's services. Thus, this evidence fails to establish use analogous to trademark use.

With regard to the remaining exhibits, the e-mail reminder dated August 31, 2010, for the "Spendology kickoff" on September 1, 2010, is not in the nature of advertising and does not reference the services identified in the application. The June 27, 2011 press release does not show use in connection with the identified services as it discusses Spendology in connection with a web application for budgeting. Applicant's receipt, dated October 18, 2011, evidencing its attendance at the Bloomberg Empowered Entrepreneur conference under the company name of "Spendology" is not evidence of services being offered to the public. Applicant also has submitted evidence dated after applicant's constructive use date of October 25, 2011: Google Adwords campaigns for the dates

of November 1, 2011-December 31, 2011 and May 1, 2012-June 2012, which do not identify the Adwords purchased[9], a January 2, 2012 press release regarding the Spendology Budgetizer which web application relates to services other than those identified in the involved application, and an e-mail for an event on March 15, 2012, regarding "How the Ideas Economy are Fueling the Global Economy" with a bcc: to keithashe@spendology.net, but otherwise containing no reference to applicant or its services.

We find that applicant's indirect evidence fails to establish use analogous to trademark use as it does not support an inference of identification in the mind of the consuming public. *See T.A.B. Systems*, 37 USPQ2d at 1881 (analogous use must be "of such a nature and extent as to create public identification of the target term with the . . . product or service").

[9] Applicant's interrogatory response no. 7 also indicates a Google Adword campaign for the dates of June 14, 2011-June 19, 2011, which is not supported by an exhibit. While purchase or use of keywords to trigger pop-up or banner advertisements may amount to use in commerce, these purchases are not supported by declaration testimony as to the nature of the "Adwords" purchased and, as noted above, two of the Adword campaigns are subsequent to applicant's filing date. *See, e.g., Rescuecom Corp. v. Google, Inc.*, 562 F.3d 123, 130 (2d Cir. 2009) (holding that use of trademarks as keywords constitutes use in commerce); *Hearts on Fire Co., LLC v. Blue Nile, Inc.*, 603 F. Supp.2d 274, 282 (D.Mass. 2009) (finding the purchase of trademarks to trigger pop-up or banner advertisements is use in commerce).

Accordingly, we find that the earliest date upon which applicant is entitled to rely for priority purposes is the filing date of its application, October 25, 2011, contingent upon its registration.

Opposer, in its cross-motion, is relying on its common law rights to prove its priority and a use date of August 26, 2010. Opposer has submitted, as evidence of its prior rights, the Mackrell declaration in which Mr. Mackrell declares that opposer's first use of SPENDOLOGY in the United States was August 26, 2010, in connection with money management tools for tracking and managing expenses located at the website www.pncvirtualwallet.com. Mr. Mackrell further declares that opposer has used the SPENDOLOGY mark continuously in commerce since that time. To corroborate this statement in his declaration, Mr. Mackrell has included website printouts showing use of the mark in connection with the services. Mr. Mackrell declares that opposer used the mark in "substantially the same" form in 2010 as its current use, as reflected on the website printout. The website printout exhibit on the first page states: "Spending Zones Spendology℠ tools provide a simple way to see exactly what you're spending your money on each month . . . Broken down into categories . . . it allows you to set a budget for each." The second page of the exhibit

shows a user's budget graph and expenses with "Spendology℠ Tools" and "Track Budget" displayed in the upper left hand corner of the page.

We find therefore, that based on the Mackrell declaration and accompanying exhibit, the earliest date on which opposer is entitled to rely for purposes of priority is August 26, 2010. *See National Bank Book Co. v. Leather Crafted Products, Inc.*, 218 USPQ 826, 828 (TTAB 1983) (oral testimony may be sufficient to prove the first use of a party's mark when it is based on personal knowledge, it is clear and convincing, and it has not be contradicted); *Liqwacon Corp. v. Browning-Ferris Industries, Inc.*, 203 USPQ 305, 316 (TTAB 1979) (oral testimony may be sufficient to establish both prior use and continuous use when the testimony is proffered by a witness with knowledge of the facts and the testimony is clear, convincing, consistent, and sufficiently circumstantial to convince the Board of its probative value); *GAF Corp. v. Anatox Analytical Services, Inc.*, 192 USPQ 576, 577 (TTAB 1976) (oral testimony may establish prior use when the testimony is clear, consistent, convincing, and uncontradicted).

As we stated supra, applicant failed to respond to opposer's cross-motion. The documents attached to applicant's brief in support of applicant's motion for

summary judgment do not reveal the existence of any genuine dispute of material fact with regard to priority.

Inasmuch as opposer is entitled to rely on August 26, 2010, as its priority date which is a date earlier than applicant's October 25, 2011 constructive use date, we find there is no genuine dispute of material fact that opposer has established its prior use of the mark SPENDOLOGY for an "online money management tool that allows account holders to track balances, budgets, and expenses, by category and time period" over applicant.

Decision

We find, based on the record herein and the applicable law, that there is no genuine dispute of material fact that opposer has established its standing, priority, and likelihood of confusion as a matter of law. Opposer's motion for summary judgment is granted and applicant's motion for summary judgment is denied.

The opposition is sustained, and registration to applicant is refused.