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

Proceeding	91217436
Party	Defendant Hanginout, Inc.
Correspondence Address	MATTHEW A BECKER THE LAW OFFICE OF MATTHEW A BECKER 1003 ISABELLA AVENUE CORONADO, CA 92118 UNITED STATES matt@beckerlawfirm.com
Submission	Motion for Summary Judgment
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Attachments	MSJ and Exhibits.pdf(3554161 bytes)

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

GOOGLE INC.,	)	Opposition No. 91217436 (parent)
	)	Opposition No. 91217437
	)	
Opposer,	)	Application Ser. Nos. 85/674,799
	)	and 85/674,801
v.	)	
	)	
HANGINOUT, INC.	)	
	)	
	)	
Applicant.	)	
	)	

APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, applicant Hanginout, Inc. ("Applicant" or "Hanginout") through its undersigned attorneys, submits this motion for summary judgment, and respectfully requests that the Trademark Trial and Appeal Board deny Google Inc.'s ("Opposer" or "Google") opposition and grant registration of Applicant's mark "HANGINOUT" in connection with "a software platform and service for facilitating live interactions among its users, including instant messaging and real-time video conferencing" on the grounds that there are no genuine issues of material fact that Applicant has priority in and to the mark "HANGINOUT." Furthermore, there are no genuine issues of material fact that Applicant submitted specimens to the United States Patent and Trademark Office ("USPTO") that, contrary to the contentions of Opposer, do not amount to inequitable conduct. Accordingly, Applicant is entitled to judgment as a matter of law.

This motion is based upon the attached brief, Opposer's Notice of Opposition and the attached exhibits, all facts of which the Board may take judicial notice, and such other argument and evidence as may be presented to the Board on this motion.

APPLICANT'S BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT

INTRODUCTION

This motion presents and answers a straightforward question: Is Applicant entitled to priority in and to the mark HANGINOUT? After lengthy briefing, the U.S. District Court for the Southern District of California has already decided the issue in the affirmative. Applicant urges the Board to answer in the affirmative and grant Applicant's motion for summary judgment.

STATEMENT OF UNDISPUTED, MATERIAL FACTS

APPLICANT'S FEDERAL TRADEMARK APPLICATION '799

On or about July 12, 2012, Applicant filed a use-based Application Serial No. 85/675,799 ("the '799 Application") for the mark HANGINOUT & Design () in International Classes 9 and 38 for:

- Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services, in Class 9, with a date of first use anywhere and in commerce of June 6, 2012; and

- Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking, in Class 38, with a date of first use anywhere and in commerce of June 6, 2012.

Exhibit 1, at ¶ 4.

In addition to the '799 Application, Applicant submitted to the USPTO a specimen of use consisting of a screenshot of an iPhone screen displaying a demo of Applicant's Hanginout application featuring a celebrity known as "Diddy." *See* Exhibit 1-A. The '799 Application

included a statement that "The applicant is submitting one (or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots [*sic*]." Exhibit 1-B. The '799 Application further included a Declaration, dated July 11, 2012, signed by Justin Malone ("Mr. Malone"), Applicant's founder and Chief Executive Officer, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." *Id.*

On or about May 28, 2013, the USPTO issued an Office Action against the '799 Application wherein it refused registration in International Class 38 on the ground that the "specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable." Exhibit 1-C.

On or about November 25, 2013, Applicant filed a Request for Reconsideration after the Final Action for the '799 Application ("799 Request for Reconsideration"), wherein Applicant submitted to the USPTO a substitute specimen consisting of a screenshot of a website describing Applicant's services. *See* Exhibit 1-D. Applicant's '799 Request for Reconsideration included a statement that "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application," namely, July 12, 2012. *See id.* The '799 Request for Reconsideration further included a declaration, dated November 25, 2013, signed by Mr. Malone stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on

information and belief are believed to be true." *See id.*

APPLICANT'S FEDERAL TRADEMARK APPLICATION '801

On or about July 12, 2012, Applicant filed use-based Application Serial No. 85/674,801 ("'801 Application") for the mark HANGINOUT in International Classes 9 and 38 for:

- Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services, in Class 9, with a date of first use anywhere and in commerce of June 6, 2012; and
- Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking, in Class 38, with a date of first use anywhere and in commerce of June 6, 2012.

Exhibit 1, at ¶ 8.

In addition to the '801 Application, Applicant submitted to the USPTO a specimen of use consisting of screenshots of an iPhone displaying an application square and a loading screen of a demo of Applicant's Hanginout application featuring the celebrity known as "Diddy." *See* Exhibit 1-E. The '801 Application included a statement that "The applicant is submitting one(or more) [*sic*] specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots [*sic*]." *See* Exhibit 1-F. The '801 Application further included a declaration, dated July 11, 2012, signed by Mr. Malone, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." *Id.*

On or about May 28, 2013, the USPTO issued an Office Action against the '801 Application wherein it refused registration in International Class 38 on the ground that the "specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable." *See* Exhibit 1-G.

On or about November 25, 2013, Applicant filed a Request for Reconsideration after the Final Action for the '801 Application (the "'801 Request for Reconsideration") wherein Applicant submitted to the USPTO a substitute specimen allegedly consisting of a screenshot of a website describing Applicant's services. *See* Exhibit 1-H. Applicant's '801 Request for Reconsideration included a statement that "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application," namely, July 12, 2012. *See id.* The '801 Request for Reconsideration further included a Declaration, dated November 25, 2013, signed by Mr. Malone, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true." *Id.*

OPPOSER'S FEDERAL TRADEMARK APPLICATION '316

Opposer filed Application Serial No. 85/916,316 ("'316 Application") for the mark HANGOUTS on April 26, 2013 in International Classes 9, 38, 41, and 42 for the following goods and services:

- Downloadable software for publishing and sharing digital media and information via global computer and communication network; instant messaging software; communications software for electronically exchanging voice, data, video and graphics accessible via computer, mobile, wireless, and telecommunication networks; computer software for processing images, graphics, audio, video, and text; computer software

development tools; computer software for use in developing computer programs; video and audio conferencing software, in Class 9;

- Telecommunications services, namely, electronic transmission of data and digital messaging via global computer and communication networks; providing online forums, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; digital multimedia broadcasting services over the Internet, namely, posting, displaying, and electronically transmitting data, audio and video; providing access to computer databases in the fields of general interest; instant messaging services; voice over ip (VOIP) services; video and audio conferencing services conducted via the web, telephone, and mobile devices; communications by computer terminals; local and long distance telephone services; mobile telephone communication services, in Class 38;

- Entertainment services, namely, providing temporary use of non-downloadable interactive multiplayer and single player games played via global computer and communication networks, in Class 41; and

- Providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for use as an application programming interface (API); Providing a web hosting platform for others for organizing and conducting meetings, social events and interactive text, audio, and video discussions; Providing an on-line network environment that features technology that enables users to share data; computer software consulting; application service provider (ASP) services featuring computer software for transmission of text, data, images, audio, and video by wireless communication networks and the Internet; application service provider (ASP) services featuring computer software for electronic messaging and wireless digital messaging, in Class 42.

Exhibit 1, at ¶ 1-2.

In a Suspension Notice issued during the USPTO's ex parte examination of Opposer's '316 Application, the Examining Attorney cited Applicant's '799 and '801 Applications, and stated that the effective filing dates of the pending applications precede the filing date of Opposer's '316 Application, and if one or more of the referenced applications registers, Opposer's "mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark."

DISTRICT COURT PROCEEDINGS

On November 26, 2013, Applicant filed a civil action against Opposer in the United States District Court for the Southern District of California ("the district court") alleging trademark infringement, federal unfair competition, and California statutory and common law unfair competition. *See* Exhibit 3, page 1, lines 19 - 21. Applicant filed a motion for preliminary injunction with the court on January 22, 2014, seeking to enjoin Opposer from using the HANGOUTS mark on the internet in connection with its social media platform, either nationwide or limited to California. *See* Exhibit 3, page 2, lines 1 - 5. Opposer responded with a Rule 12(b)(6) motion. *See* Exhibit 3, page 2, lines 1 - 8. On May 12, 2014, the court denied Applicant's motion for preliminary injunction and Opposer's Rule 12(b)(6) motion. *Id.* In its order denying the motions, the court conclusively held Applicant to be "**the senior user of the marks based** on the totality of the circumstances–number of registered users, marketing via social media, and launch of iTunes app in the Apple store[,]" all of which the court acknowledged as "evidence of [Hanginout's] actual use and marketing of the HANGINOUT mark, in commerce, prior to the first use date of Google's HANGOUTS mark." *See* Exhibit 3, page 9, lines 20 – 24, and page 10, lines 1 – 21.

ARGUMENT

I.

THERE IS NO GENUINE ISSUE OF MATERIAL FACT THAT APPLICANT ACTUALLY USED THE "HANGINOUT" MARK IN COMMERCE AS EARLY AS OF ITS FILING DATE SUCH THAT APPLICANT IS ENTITLED TO SUMMARY JUDGMENT

Summary judgment is appropriate where "there is no genuine issues as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(c). "Where a movant has supported its motion with affidavits or other evidence, which, unopposed, would establish its right to judgment, the non-movant may not rest upon general denials in its pleadings or otherwise, but must proffer countering evidence sufficient to create a genuine factual dispute. A dispute is *genuine* only if, on the entirety of the record, a reasonable jury could resolve a factual matter in favor of the non-movant." *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987) (emphasis in original).

To apply for registration under Lanham Act § 1(a), a mark must be, *inter alia*, "used in commerce." 15 U.S.C. § 1051(a)(1). "A mark is used in commerce on services when [1] it is used or displayed in the sale or advertising of services and [2] the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services." *Id.* § 1127; *Couture v. Playdom, Inc.*, 778 F.3d 1379, 1380-81 (Fed. Cir.) *cert. denied*, 136 S. Ct. 88, 193 L. Ed. 2d 35 (2015) (internal citation omitted). Further, the mark must be used in commerce "as of the application filing date." 37 C.F.R. § 2.34(a)(1)(i). "The term 'use in commerce' means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127. "[A]n applicant's preparations to use a mark in commerce are insufficient to constitute use in commerce. Rather, the mark must be actually used in conjunction with the services described in the application for the mark." *Couture*, 778 F.3d at 1381 (internal citation omitted). "Without question, advertising or publicizing a service that the applicant intends to perform in the future will not support

registration"; the advertising must instead "relate to an *existing service* which has already been offered to the public." *Id.* (internal quotation marks and citations omitted) (emphasis in original).

Opposer asserts that the submitted specimen of Applicant's website depicting in part an iPhone ("the website specimen"), *see* Exhibits 1-D and 1-H, does not show use of the HANGINOUT mark in commerce at least as early as of July 12, 2012, the filing date of the '799 and '801 Applications. Opposer bases its theory on the assertion that the iPhone is the "5s" version, which was released on or about September 20, 2013, and thus the website specimen could not possibly show use of the HANGINOUT mark in commerce as of July 12, 2012. Opposer's contentions, however, are meritless and an intentional misinterpretation of the facts.

First, after much litigation and analysis of the facts and legal issues, the Court **already decided the issue in Applicant's favor**. Next, Opposer fails to proffer any evidence that the mark was not used in commerce as of Applicant's filing date. Put simply, Opposer's contentions amount to conjecture. Applicant well knows that the specimen photo of APP in question was used in commerce at the date claimed and likely much earlier.

On the other hand, Applicant's CEO Mr. Malone signed declarations in both Requests for Reconsideration, which stated in part, "the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use." The examining attorney found the Requests for Reconsideration sufficient to publish in the Official Gazelle, and Opposer provides no evidence supporting its contention that such a finding was erroneous. The Board should therefore defer to the examining attorney's judgment rather than entertain Opposer's contentions lacking factual support.

Second, the specimens submitted show that as early as of the Applicant's filing dates, Applicant made bona fide use of the mark in the ordinary course of the relevant trade, i.e., online and telecommunication facilities for real-time and on-demand interaction among and between users. The website specimen, *see* Exhibits 1-D and 1-H, show Applicant's HANGINOUT mark at the top left of Applicant's website. The website describes the features of Applicant's services and provides an "App Store" link for interested parties to select, whereby they are directed to the App Store page so that they may download Applicant's HANGINOUT application. Applicant's website also presents links to Applicant's Facebook and Twitter pages, which further describe the services and provide a means for keeping consumers informed on improvements and other news regarding Applicant's services. Therefore, Applicant has "actually used [the mark] in conjunction with the services described in the application for the mark[,]" and such use "relate[s] to . . . *existing service[s]* which [have] already been offered to the public." *Couture*, 778 F.3d at 1381.

Third, Applicant has already proffered evidence before the district court establishing its status as the senior user prior to its federal trademark application filing date. Prior to June 28, 2011, Hanginout had already "used or displayed [its mark] in the . . . advertising of services" extensively on YouTube, Facebook, and Twitter, engaged news outlets that released related articles, and direct marketed hundreds of contacts – all of which advertised the services with the HANGINOUT service mark. 15 USC §1127; *See* Exhibit 6, Exhibit 7. Also, the services were actually "rendered in commerce." Specifically, of the hundreds of customers advertised to, more than 200 were registered for and actually using Version 1.0 of the Q&A platform by May 2011. *See* Exhibit 3, page 3, lines 8 – 10, and Exhibit 5, at ¶ 17. This was part of ongoing activity, as use continued to grow over the coming year, culminating with a very popular application.

Hanginout's prior use goes far beyond an attempt "to reserve a right in a mark." 15 U.S.C. §1127. This is particularly so, given that even test marketing or demonstration units are sufficient to show a bona fide use in commerce. 1-3 Gilson on Trademarks 3.02 n.59.3-4. A conversion ratio shows that of the ~300 YouTube views, Hanginout generated over 200 customers by the end of May 2011. *Id.* A near 65% conversion ratio is further evidence that the HANGINOUT mark was actually used in commerce *as early as of* Applicant's filing date. *Id.*

In sum, Opposer's contentions are meritless. Applicant's '799 and '801 Request for Reconsideration Applications show the HANGINOUT mark used in commerce as early as of June 12, 2012. Moreover, Applicant has proffered ample evidence establishing its use of the HANGINOUT mark in commerce as early as of its filing date. Thus, Applicant is entitled to judgment as a matter of law.

II.

THERE IS NO GENUINE ISSUE OF MATERIAL FACT THAT APPLICANT DID NOT ENGAGE IN INEQUITABLE CONDUCT AND THUS APPLICANT IS ENTITLED TO JUDGMENT AS A MATTER OF LAW

"Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application." *In re Bose Corp.*, 580 F.3d 1240, 1243 (Fed. Cir. 2009) (quoting *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 48 (Fed. Cir, 1986)). "If it can be shown that the statement was a 'false misrepresentation' occasioned by an 'honest' misunderstanding, inadvertence, negligent omission or the like rather than one made with a willful intent to deceive, fraud will not be found." *Smith Int'l, Inc. v. Olin Corp.*, 209 U.S.P.Q. (BNA) ¶ 1033 (P.T.O. Jan. 23, 1981) (internal citation omitted). Opposer must prove Applicant subjectively intended to deceive the

USPTO or, "because direct evidence of deceptive intent is rarely available, such intent can be inferred from indirect and circumstantial evidence. But such evidence must still be clear and convincing, and inferences drawn from lesser evidence cannot satisfy the deceptive intent requirement." *In re Bose Corp.*, 580 F.3d at 1245. Mere negligence will not suffice to infer fraud. *See id.* at 1244. "There is no room for speculation, inference or surmise and, obviously, any doubt must be resolved against the charging party." *Smith Int'l, Inc.*, 209 U.S.P.Q. at ¶ 1033.

Opposer's allegations against Applicant for inequitable conduct are unfounded. Opposer neither points to any evidence that Applicant subjectively intended to deceive the USPTO, nor does Opposer proffer any circumstantial evidence of such a subjective intent to deceive the USPTO. On the other hand, Applicant offered specimens with the '799 and '801 Application depicting the HANGINOUT mark and its use in the Diddy demo application as well as the HANGINOUT application. *See* Exhibit 1-B and 1-F. In its Amended Notice of Opposition, Opposer attached Mr. Malone's deposition presumably to highlight the fact that Applicant did not offer the Diddy demo to consumers. *See* Exhibit 2, at line 6 on "page 249" of deposition. Applicants seeking registration, however, do not need to offer solely specimens depicting sales or offers of services to consumers, but applications may also contain advertisements showing use of the mark in commerce. The Diddy demo constitutes an advertisement of Applicant's services displaying the HANGINOUT mark in accordance with "use in commerce" definition. *See* 15 United States Code § 1127 ("[A] mark shall be deemed to be in use in commerce–(2) on services when it is [a] used or displayed in the sale or advertising of services and [b] the services are rendered in commerce..."). In support of this notion, Diddy himself referenced applicant's services when he wished Mr. Malone a happy birthday. *See* Exhibit 4. Even if, *arguendo*, Applicant sought to deceive the USPTO, such an attempt would clearly be deemed a failure

because Applicant received an office action in response to the '799 and '801 Application. Therefore, Opposer cannot prove the materiality prong of inequitable conduct either.

Opposer's allegations of inequitable conduct with regard to the specimens Applicant submitted with the Requests for Reconsideration are also doomed to fail under the inequitable conduct standard. Opposer fails to proffer evidence of a specific intent to deceive the USPTO. Applicant merely made a good faith attempt to satisfy the examining attorney's request for substitute specimens after the examining attorney rejected the original specimens on the grounds that they do not show Applicant provided all of the telecommunication services recited in its '799 and '801 Applications. *See* Exhibits 1-C and 1-G. As previously argued in this motion, Opposer does not proffer any evidence that the iPhone version is relevant, iPhone depicted in the website specimen is the 5s version, and thus such an assertion lacking evidentiary support cannot assist Opposer in carrying the heavy burden of proving a specific intent to deceive the USPTO. For the Board to entertain Opposer's inequitable conduct claim on such grounds would require the Board to engage in speculation to say the least, and speculation, of course, does not suffice to make a showing of specific intent to deceive. Therefore, Applicant is entitled to summary judgment as a matter of law with regard to Opposer's claim of inequitable conduct.

CONCLUSION

The Court has already held and Applicant has already established priority in the mark HANGINOUT. In addition, Opposer's claim regarding a website specimen is nothing more than smoke and mirrors. Applicant is entitled to priority in light of its showing that it used the mark in commerce as of its filing date. Moreover, Applicant is entitled to priority because it proffered sufficient evidence establishing Applicant's prior use of the HANGINOUT mark in commerce first before the district court and now before the Board. Lastly, Applicant has proven Opposer

cannot carry its burden to make a showing of inequitable conduct on the part of Applicant. Therefore, Applicant is entitled to summary judgment as a matter of law, and the Board should grant Applicant's motion in its entirety.

Dated: October 4, 2016

Respectfully submitted,

/s/ Matthew A. Becker_____

MATTHEW A. BECKER
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PROOF OF SERVICE BY MAIL

I hereby declare:

I am over the age of 18 years and am not a party to this action. I am employed in San Diego, County. My business address is 1003 Isabella Avenue, Coronado, CA 92118.

On the date first written below, I served a true and correct copy of the attached document entitled:

1. APPLICANT'S MOTION FOR SUMMARY JUDGMENT

2. TABLE OF EXHIBITS TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

3. EXHIBITS 1, 1-A, 1-B, 1-C, 1-D, 1-E, 1-F, 1-G, 1-H, 2, 3, 4, 5, 6 and 7.

by causing it to be placed in a sealed envelope and deposited in the United States mail, first class postage fully prepaid and addressed to the following:

Matthew J. Snider
DICKINSON WRIGHT PLLC
International Square
1875 Eye Street, NW
Suite 1200
Washington, DC 20006

John C. Blattner
DICKINSON WRIGHT PLLC
350 S. Main Street
Suite 300
Ann Arbor, MI 48104

Dated: October 4, 2016

/s/ Matthew A. Becker
_____
Matthew A. Becker

TABLE OF EXHIBITS TO
APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Exhibit	Description	Pages
1	First Amended Combined Notice of Opposition	10 pages
1-A	Screenshot of iPhone screen displaying a demo of Applicant's Hanginout application (85674799) Featuring a celebrity known as "Diddy."	4 pages
1-B	85674799 Application Statement, Filing Date 07/12/2012	12 pages
1-C	USPTO Office Action against Application 85674799, Dated 05/28/2013	7 pages
1-D	85674799 Application Request for Reconsideration, Dated 11/25/2013	8 pages
1-E	Screenshot of iPhone Screen Displaying Application Square and Loading Screen of a Demo of Applicant's Hanginout Application (85674801) featuring a celebrity known as "Diddy."	7 pages
1-F	85674801 Application Statement, Filing Date 07/12/2012	15 pages
1-G	USPTO Office Action against Application 85674801, Dated 05/28/2013	7 pages
1-H	85674801 Application Request for Reconsideration, Dated 11/25/2013	8 pages
2	Deposition of Justin Malone, pages 248 – 249	3 pages

TABLE OF EXHIBITS TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

3	Order in Case No. 13cv2811 AJB (NLS) Hanginout, Inc. v. Google, Inc., Filing Date 05/13/2014.	36 pages
4	Twitter message from Sean "Puff Daddy" Combs To J. Malone.	2 pages
5	Declaration of Justin Malone in Support of Plaintiff Hanginout, Inc.'s Motion for Preliminary Injunction	9 pages
6	A copy of the Hanginout webpage, available at: https://www.hanginout.com/features.	3 pages
7	A printout of the webpage that contains the Hanginout YouTube video available at: http://www.youtube.com/watch?v=BWo_x5YviAM.	3 pages

Exhibit 1

Docket Nos. 28155-9013
28155-9014

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

GOOGLE INC.,	
Opposer,	Opposition No. 91217436 (parent) Opposition No. 91217437
v.	Application Ser. Nos. 85/674,799 and 85/674,801
HANGINOUT, INC.	
Applicant.	

FIRST AMENDED COMBINED NOTICE OF OPPOSITION

Opposer Google Inc., a Delaware corporation having its principal place of business at 1600 Amphitheatre Parkway, Mountain View, CA 94043 ("Opposer"), believes that it will be damaged by registration of the marks shown in Application Serial Nos. 85/674,799 in International Classes 9 and 38, and 85/674,801 in International Classes 9 and 38, and opposes the same. As grounds for the opposition, Opposer alleges as follows:

1. Opposer is the owner of the mark HANGOUTS, which it has used and uses for, *inter alia*, a software platform and service for facilitating live interactions among its users, including instant messaging and real-time video conferencing, since at least as early as June 28, 2011.

2. Opposer filed Application Serial No. 85/916,316 ("'316 Application") for the mark HANGOUTS on April 26, 2013 in International Classes 9, 38, 41, and 42 for the following goods and services:

- Downloadable software for publishing and sharing digital media and information via global computer and communication network; instant messaging software; communications software for electronically exchanging voice, data, video and graphics accessible via computer, mobile, wireless, and telecommunication networks; computer software for processing images, graphics, audio, video, and text; computer software development tools; computer software for use in developing computer programs; video and audio conferencing software, in Class 9;

- Telecommunications services, namely, electronic transmission of data and digital messaging via global computer and communication networks; providing online forums, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; digital multimedia broadcasting services over the Internet, namely, posting, displaying, and electronically transmitting data, audio and video; providing access to computer databases in the fields of general interest; instant messaging services; voice over ip (VOIP) services; video and audio conferencing services conducted via the web, telephone, and mobile devices; communications by computer terminals; local and long distance telephone services; mobile telephone communication services, in Class 38;

- Entertainment services, namely, providing temporary use of non-downloadable interactive multiplayer and single player games played via global computer and communication networks, in Class 41; and

- Providing temporary use of on-line non-downloadable software for publishing and sharing digital media and information via global computer and communication networks; Providing temporary use of on-line non-downloadable software development tools; Providing temporary use of on-line non-downloadable software for use as an application programming interface (API); Providing a web hosting platform for others for organizing and conducting meetings, social events and interactive text, audio, and video discussions; Providing an on-line network environment that features technology that enables users to share data; computer software consulting; application service provider (ASP) services featuring computer software for transmission of text, data, images, audio, and video by wireless communication networks and the Internet; application service provider (ASP) services featuring computer software for electronic messaging and wireless digital messaging, in Class 42.

3. Upon information and belief, Applicant Hanginout, Inc. is a Delaware corporation domiciled in Carlsbad, California ("Applicant").

4. On or about July 12, 2012, Applicant filed use-based Application Serial No. 85/674,799 ("the '799 Application") for the mark HANGINOUT & Design () in International Classes 9 and 38 for

- Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services, in Class 9, with a date of first use anywhere and in commerce of June 6, 2012; and

- Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking, in Class 38, with a date of first use anywhere and in commerce of June 6, 2012.

5. Along with the '799 Application, Applicant submitted to the PTO a specimen of use allegedly consisting of a screenshot of an iPhone loading screen displaying a demo of Applicant's Hanginout application featuring a celebrity known as "Diddy." See Exhibit A. The '799 Application included a statement that "The applicant is submitting one (or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots." See Exhibit B. The '799 Application further included a Declaration, dated July 11, 2012, signed by Justin Malone ("Mr. Malone"), Applicant's founder and Chief Executive Officer, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." *Id.*

6. On or about May 28, 2013, the PTO issued an Office Action against the '799 Application wherein it refused registration in International Class 38 on the ground that the "specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable." See Exhibit C.

7. On or about November 25, 2013, Applicant filed a Request for Reconsideration after Final Action for the '799 Application ("'799 Request for Reconsideration"), wherein Applicant submitted to the PTO a substitute specimen allegedly consisting of a screenshot of a website describing Applicant's services. See Exhibit D. Upon information and belief, the substitute specimen shows an image of an iPhone 5s mobile device which, upon information and belief, was released on or about September 2013. Applicant's '799 Request for Reconsideration included a statement that "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application," namely, July 12, 2012. See Exhibit D. The '799 Request for Reconsideration further included a Declaration, dated November 25, 2013, signed by Mr. Malone stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true." *Id.*

8. On or about July 12, 2012, Applicant filed use-based Application Serial No. 85/674,801 ("'801 Application") for the mark HANGINOUT in International Classes 9 and 38 for

- Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services, in Class 9, with a date of first use anywhere and in commerce of June 6, 2012; and

- Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking, in Class 38, with a date of first use anywhere and in commerce of June 6, 2012.

9. Along with the '801 Application, Applicant submitted to the PTO a specimen of use allegedly consisting of screenshots of an iPhone displaying an application square and a loading screen of a demo of Applicant's Hanginout application featuring "Diddy." See Exhibit E. The '801 Application included a statement that "The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots." See Exhibit F. The '801 Application further included a Declaration, dated July 11, 2012, signed by Mr. Malone, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true." *Id.*

10. On or about May 28, 2013, the PTO issued an Office Action against the '801 Application wherein it refused registration in International Class 38 on the ground that the "specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable." See Exhibit G.

11. On or about November 25, 2013, Applicant filed a Request for Reconsideration after Final Action for the '801 Application (the "'801 Request for Reconsideration") wherein Applicant submitted to the PTO a substitute specimen allegedly consisting of a screenshot of a

website describing Applicant's services. See Exhibit H. Upon information and belief, the substitute specimen shows an image of an iPhone 5s mobile device which, upon information and belief, was released on or about September 2013. Applicant's '801 Request for Reconsideration included a statement that "The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application," namely, July 12, 2012. See Exhibit H. The '801 Request for Reconsideration further included a Declaration, dated November 25, 2013, signed by Mr. Malone, stating that the signatory is "authorized to execute this application on behalf of the applicant," and that "all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true." *Id.*

12. On January 13, 2015, when questioned by Opposer's attorney, Ms. Caruso, Mr. Malone testified under oath in a deposition (taken in the course of a civil action between Opposer and Applicant concerning their respective marks that are the subjects of this Opposition[1]) as follows:

BY MS. CARUSO:	17:33:47
Q Did Hanginout ever offer a Diddy app?	17:33:48
A No.	17:33:54
Q If you'd turn to the next page and the one after that. What do you understand that to be?	17:33:58
A That's a screen grab of a loading screen from the Diddy demo.	17:34:16
Q The Diddy demo was not offered to consumers; is that correct?	17:34:23

[1] The civil action brought by Applicant on November 26, 2013 in the in the United States District Court for the Southern District of California, Case No. 3:13-CV-02811-AJB-NLS, was dismissed with prejudice by the Court on June 30, 2015. (See Applicant's Motion to Resume Proceedings, Dkt # 11 Ex. A).

A	Correct.	17:34:28

Exhibit I.

13. Upon information and belief, the specimen of use filed by Applicant on or about July 12, 2012, in support of the '799 Application does not show use of the mark in commerce at least as early as the filing date of the '799 Application.

14. Upon information and belief, the alleged specimen of use filed by Applicant on or about November 25, 2013 in support of the '799 Request for Reconsideration does not show the mark as used in commerce at least as early as the filing date of the '799 Application.

15. Upon information and belief, the specimen of use filed by Applicant on or about July 12, 2012 in support of the '801 Application does not show use of the mark in commerce at least as early as the filing date of the '801 Application.

16. Upon information and belief, the alleged specimen of use filed by Applicant on or about November 25, 2013 in support of the '801 Request for Reconsideration does not show the mark as used in commerce at least as early as the filing date of the '801 Application.

17. Upon information and belief, Applicant made false representations that the specimens of use submitted to the PTO in support of the '799 Application and the '799 Request for Reconsideration show use of the mark in commerce at least as early as the filing date of the '799 Application. Applicant's false representations concerning the '799 Application are material because proper specimens showing use of a mark in commerce are required for registration. Applicant knew when the false representations were made that the representations were not true. Applicant made the false representations with the intent to deceive the USPTO as to the use of the mark in commerce in order to procure a registration to which Applicant was not entitled. The

PTO relied on Applicant's false representations and Applicant was successful in procuring favorable examination and publication of the '799 Application.

18. Upon information and belief, Applicant made false representations that the specimens of use submitted to the PTO in support of the '801 Application and the '801 Request for Reconsideration show use of the mark in commerce at least as early as the filing date of the '801 Application. Applicant's false representations concerning the '801 Application are material because proper specimens showing use of a mark in commerce are required for registration. Applicant knew when the false representations were made that the representations were not true. Applicant made the false representations with the intent to deceive the USPTO as to the use of the mark in commerce in order to procure a registration to which Applicant was not entitled. The PTO relied on Applicant's false representations and Applicant was successful in procuring favorable examination and publication of the '801 Application.

19. In a Suspension Notice issued during the PTO's ex parte examination of Opposer's '316 Application, the Examining Attorney cited Applicant's '799 and '801Applications, and stated that the effective filing dates of the pending applications precede the filing date of Opposer's '316 Application, and if one or more of the referenced applications registers, Opposer's "mark may be refused registration under Section 2(d) because of a likelihood of confusion with that registered mark."

20. If, as the Examining Attorney for the '316Application contends, Opposer's mark so resembles Applicant's marks as to be likely to cause confusion when applied to Opposer's goods and services, then Opposer will be damaged by the improper granting of trademark registrations for the '799 and '801 Applications, which would have been procured through Applicant's false representations and which have been cited as obstacles to registration of Opposer's mark.

WHEREFORE, Opposer believes that it will be damaged by registration of the marks shown in Application Serial Nos. 85/674,799 and 85/674,801in International Classes 9 and 38, and opposes registration thereof on the grounds set forth above. Opposer further prays that Application Serial Nos. 85/674,799 and 85/674,801be rejected, and that registration of Applicant's marks be refused.

The $600 fee for two classes required under 2.6(a)(17) is enclosed herewith.

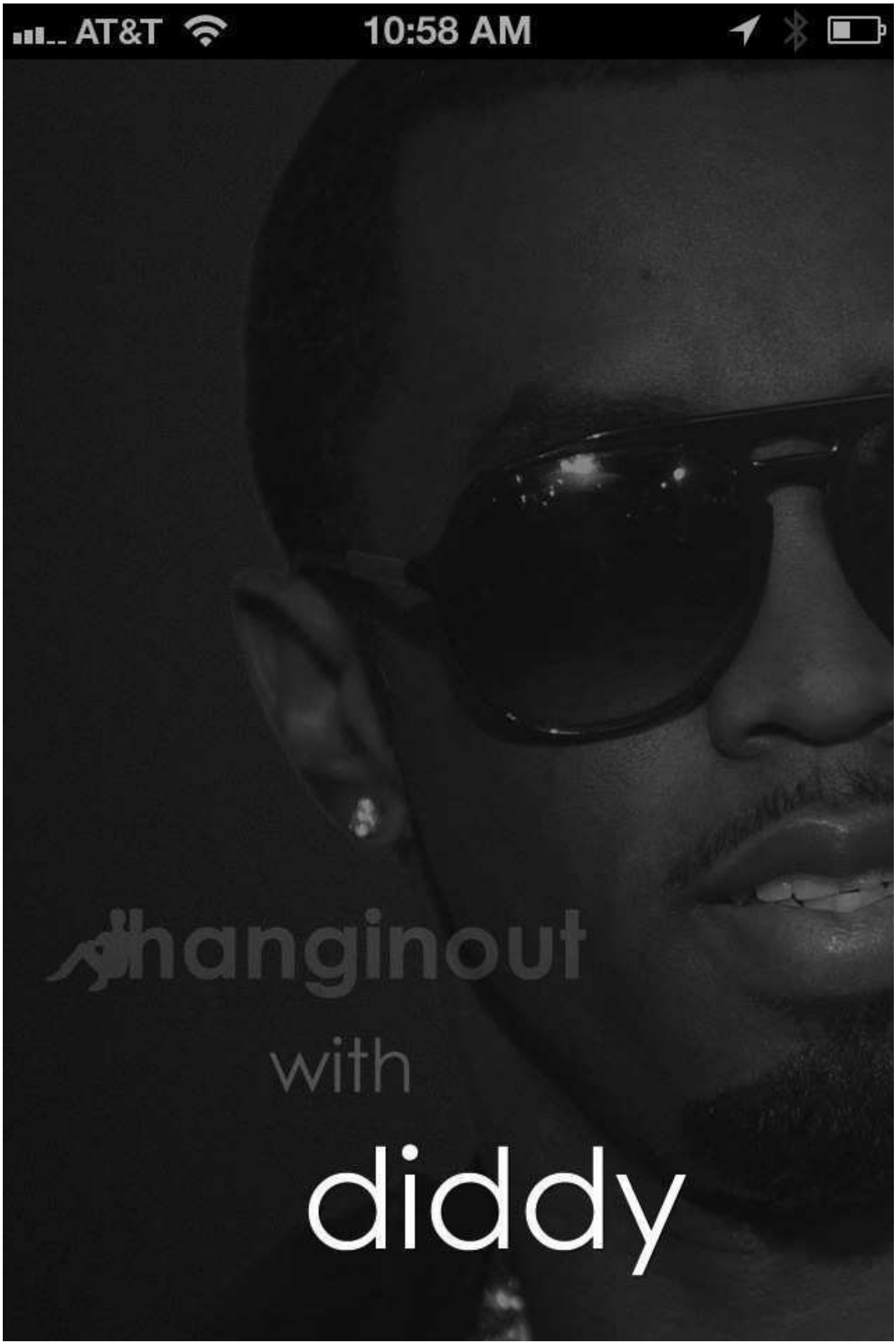
DICKINSON WRIGHT, PLLC

October 27, 2015

By: /s/ Matthew J. Snider

Matthew J. Snider
350 S. Main Street, Suite 300
Ann Arbor, MI 48104
Tel. 734.623.1909
msnider@dickinsonwright.com
Attorney for Opposer, Google Inc.

Exhibit 1-A


AT&T
10:58 AM
#hanginout
with
diddy


AT&T
10:58 AM
hanginout

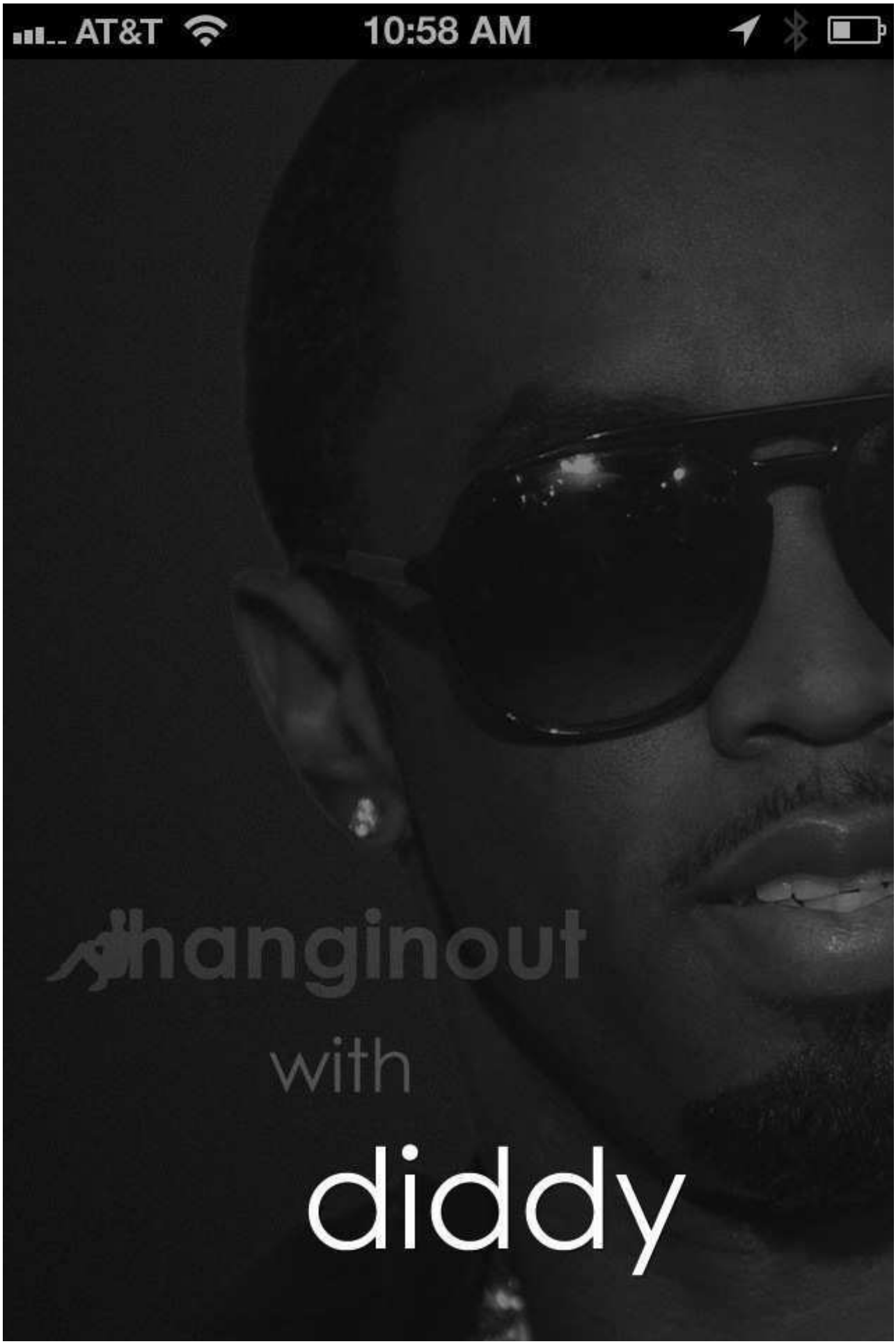

AT&T
10:58 AM
#hanginout
with
diddy

Exhibit 1-B

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 85674799
Filing Date: 07/12/2012

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85674799
MARK INFORMATION	
***MARK**	\\TICRS\EXPORT16\IMAGEOUT 16\856\747\85674799\xml1\ APP0002.JPG
SPECIAL FORM	YES
USPTO-GENERATED IMAGE	NO
LITERAL ELEMENT	HANGINOUT
COLOR MARK	NO
***DESCRIPTION OF THE MARK (and Color Location, if applicable)**	The mark consists of a human figure sitting down with the word HANGINOUT besides it.
PIXEL COUNT ACCEPTABLE	YES
PIXEL COUNT	921 x 298
REGISTER	Principal
APPLICANT INFORMATION	
***OWNER OF MARK**	Hanginout, Inc.
***STREET**	2712 Jefferson Street
***CITY**	Carlsbad
***STATE (Required for U.S. applicants)**	California
***COUNTRY**	United States
***ZIP/POSTAL CODE (Required for U.S. applicants only)**	92008
LEGAL ENTITY INFORMATION	
TYPE	corporation

STATE/COUNTRY OF INCORPORATION	Delaware
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	009
***IDENTIFICATION**	Computer application software for mobile devices in the field of telecommunications and social networking services
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\747\85674799\xml1\ APP0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\856\747\85674799\xml1\ APP0004.JPG
SPECIMEN DESCRIPTION	Screenshots
INTERNATIONAL CLASS	038
***IDENTIFICATION**	Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online community forum for users to share information, photos, audio and video content to engage in social networking
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\747\85674799\xml1\ APP0005.JPG

SPECIMEN DESCRIPTION	Screenshot
ATTORNEY INFORMATION	
NAME	Andrew D. Skale
ATTORNEY DOCKET NUMBER	44467-402
FIRM NAME	Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
INTERNAL ADDRESS	Suite 300
STREET	3580 Carmel Mountain Road
CITY	San Diego
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92130
PHONE	858-314-1506
FAX	858-314-1501
EMAIL ADDRESS	adskale@mintz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Susan Neuberger Weller, Rosemary M. Allen, Heidi F. Aston, Christine M. Baker, Ingrid A. Beattie, Emma Bevan, James P. Cleary, James Conley, Micha Danzig, John M. Delehanty, Joseph DiCioccio, Ivor R. Elrifi, Heidi A. Erlacher, Richard G. Gervase, Jr., Marvin S. Gittes, John Giust, Jeremy Glaser, Geri Haight, Fred C. Hernandez, Brian P. Hopkins, Jennifer Karnakis, Cynthia A. Kozakiewicz, Carl A. Kukkonen III, Muriel M. Liberto, Boris A. Matvenko, A. Jason Mirabito, Matthew Pavao, Brad M. Scheller, Timur Slonim, Peter F. Snell, Christina K. Stock, Pedro Suarez, Michael Van Loy, and all attorneys with the firm of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
CORRESPONDENCE INFORMATION	
NAME	Andrew D. Skale
FIRM NAME	Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
INTERNAL ADDRESS	Suite 300

STREET	3580 Carmel Mountain Road
CITY	San Diego
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92130
PHONE	858-314-1506
FAX	858-314-1501
EMAIL ADDRESS	adskale@mintz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	2
FEE PER CLASS	325
***TOTAL FEE DUE**	650
***TOTAL FEE PAID**	650
SIGNATURE INFORMATION	
SIGNATURE	/Justin Malone/
SIGNATORY'S NAME	/Justin Malone/
SIGNATORY'S POSITION	/CEO/
DATE SIGNED	07/11/2012

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 85674799
Filing Date: 07/12/2012

To the Commissioner for Trademarks:

MARK: HANGINOUT (stylized and/or with design, see mark)

The literal element of the mark consists of HANGINOUT.
The applicant is not claiming color as a feature of the mark. The mark consists of a human figure sitting down with the word HANGINOUT besides it.
The applicant, Hanginout, Inc., a corporation of Delaware, having an address of
2712 Jefferson Street
Carlsbad, California 92008
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Computer application software for mobile devices in the field of telecommunications and social networking services

In International Class 009, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 06/06/2012, and first used in commerce at least as early as 06/06/2012, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots.
Specimen File1
Specimen File2

International Class 038: Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online community forum for users to share information, photos, audio and video content to engage in social networking

In International Class 038, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 06/06/2012, and first used in commerce at least as early as 06/06/2012, and is now in use in such commerce. The applicant is submitting one(or more)

specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshot.
Specimen File1

The applicant's current Attorney Information:
Andrew D. Skale and Susan Neuberger Weller, Rosemary M. Allen, Heidi F. Aston, Christine M. Baker, Ingrid A. Beattie, Emma Bevan, James P. Cleary, James Conley, Micha Danzig, John M. Delehanty, Joseph DiCioccio, Ivor R. Elrifi, Heidi A. Erlacher, Richard G. Gervase, Jr., Marvin S. Gittes, John Giust, Jeremy Glaser, Geri Haight, Fred C. Hernandez, Brian P. Hopkins, Jennifer Karnakis, Cynthia A. Kozakiewicz, Carl A. Kukkonen III, Muriel M. Liberto, Boris A. Matvenko, A. Jason Mirabito, Matthew Pavao, Brad M. Scheller, Timur Slonim, Peter F. Snell, Christina K. Stock, Pedro Suarez, Michael Van Loy, and all attorneys with the firm of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.

Suite 300
3580 Carmel Mountain Road
San Diego, California 92130
United States
The attorney docket/reference number is 44467-402.

The applicant's current Correspondence Information:
Andrew D. Skale
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Suite 300
3580 Carmel Mountain Road
San Diego, California 92130
858-314-1506(phone)
858-314-1501(fax)
adskale@mintz.com (authorized)

A fee payment in the amount of $650 has been submitted with the application, representing payment for 2 class(es).

Declaration

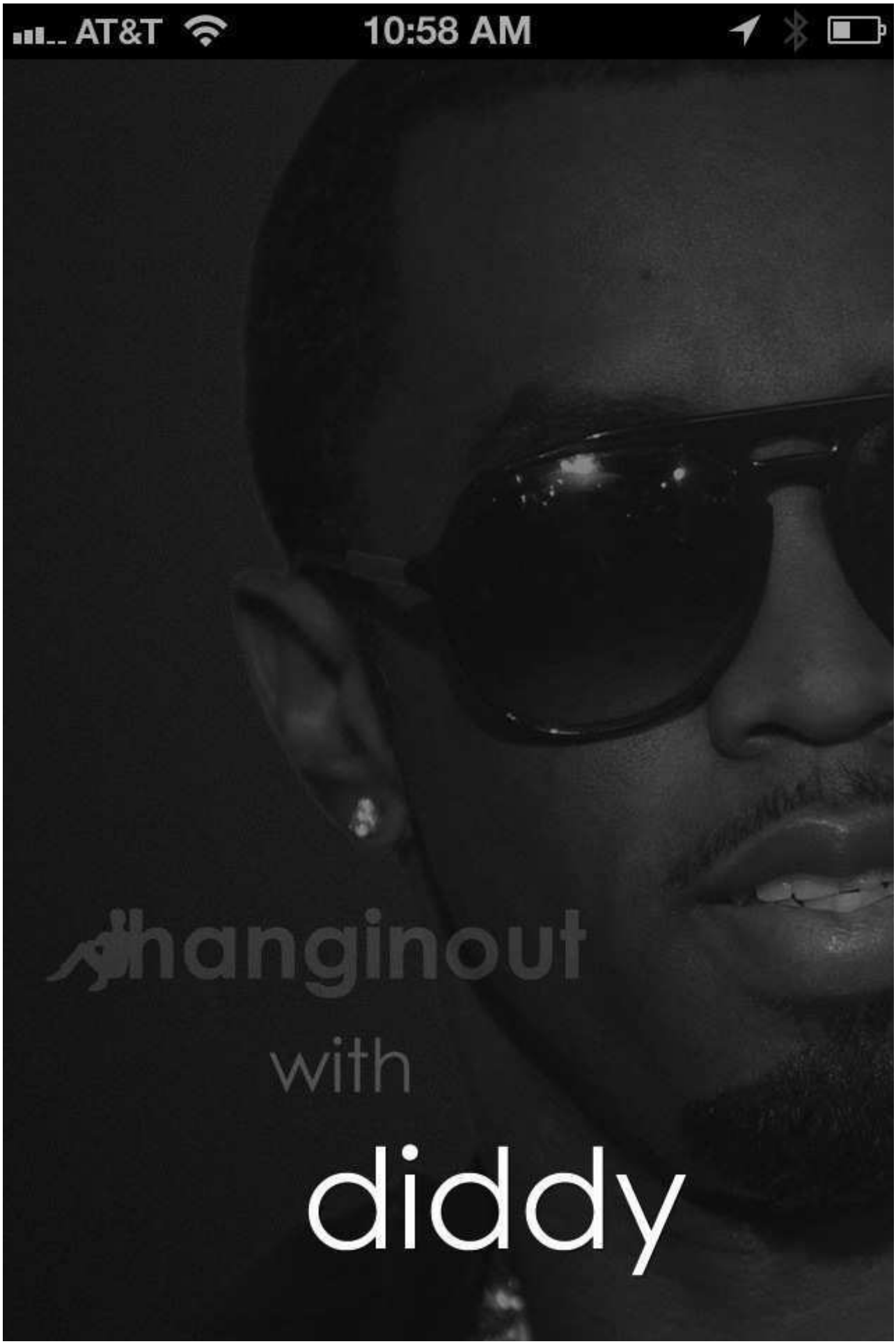
The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Justin Malone/ Date: 07/11/2012
Signatory's Name: /Justin Malone/
Signatory's Position: /CEO/
RAM Sale Number: 9832
RAM Accounting Date: 07/12/2012

Serial Number: 85674799
Internet Transmission Date: Thu Jul 12 08:22:02 EDT 2012
TEAS Stamp: USPTO/BAS-38.97.105.2-20120712082202361138-85674799-490464a307aa917b697452765836
7548c49-CC-9832-20120711101424293434


hanginout


AT&T
10:58 AM
#hanginout
with
diddy


AT&T
10:58 AM
hanginout

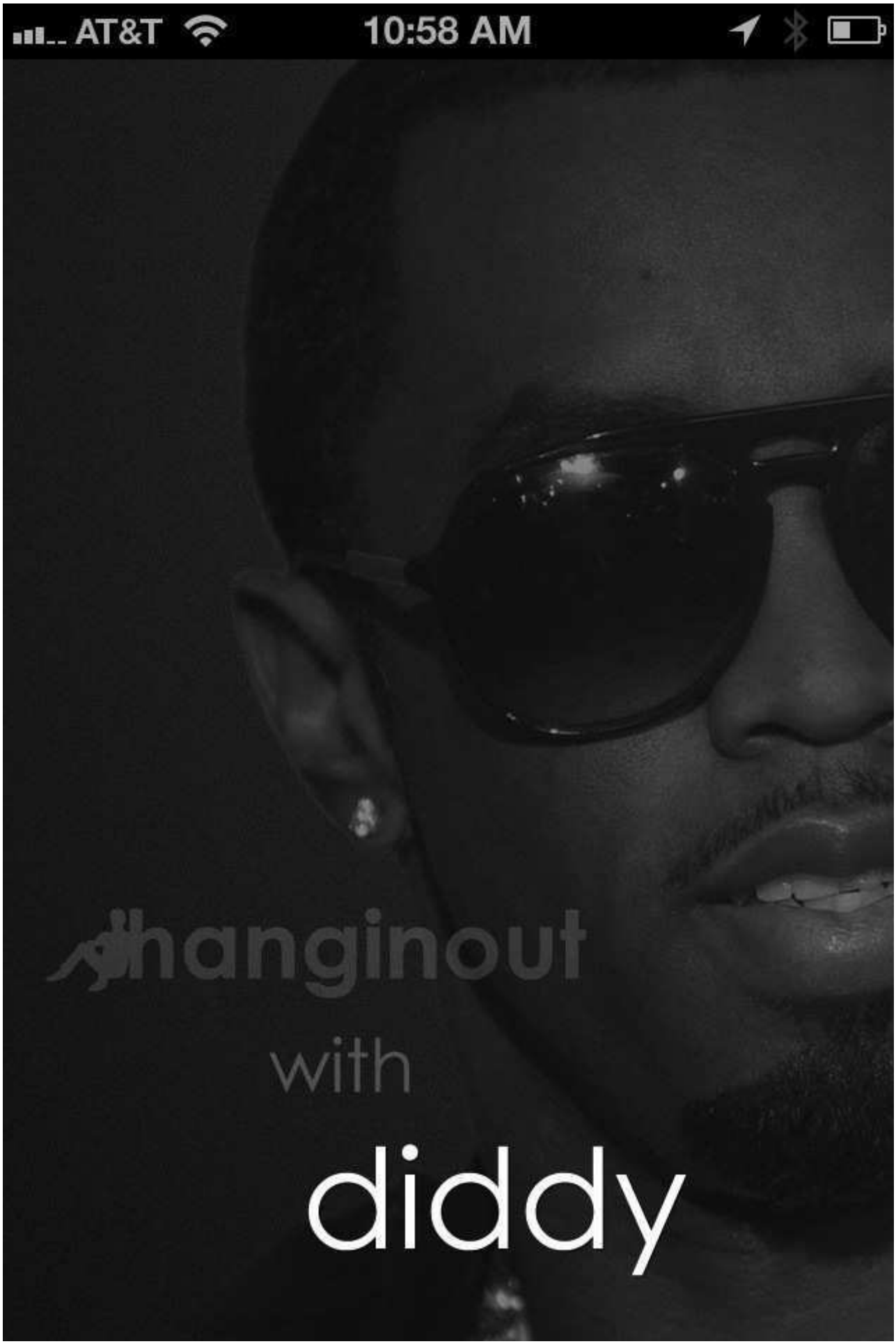

AT&T
10:58 AM
#hanginout
with
diddy

Exhibit 1-C

To:	Hanginout, Inc. (adskale@mintz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85674799 - HANGINOUT - 44467-402
Sent:	5/28/2013 1:00:44 PM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85674799

MARK: HANGINOUT

85674799

CLICK HERE TO RESPOND TO
http://www.uspto.gov/trademarks/teas/r

CORRESPONDENT ADDRESS:
ANDREW D. SKALE
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND
3580 CARMEL MOUNTAIN RD STE 300
SAN DIEGO, CA 92130-6768

APPLICANT: Hanginout, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :
44467-402
CORRESPONDENT E-MAIL ADDRESS:
adskale@mintz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 5/28/2013

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 2, 2013.

In light of the Trademark Trial and Appeal Board's granting of applicant's Petition to Cancel U.S. Registration No. 3857338, the previously issued Section 2(d) refusal is now rendered moot.

The applicant's amended identification of goods and services is accepted and made of record.

However, the substitute specimens for Class 38 are still unacceptable. The refusal of registration based on the failure to provide a specimen that shows the applied-for mark in use in commerce as a service mark is now made final. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07(a).

Specimen Requirement

The specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable. Specifically, the substitute specimens and original specimens show that the mark is used in connection with a downloadable software application that involves some of the functionalities described in the applicant's Class 38 recitation. The specimens do not, however, show that applicant provides all of the telecommunications services recited in the application.

Just because the applicant is conducting an activity that may involve transmission of data on the Internet does not mean the applicant's service is a Class 38 service. For example, an applicant who merely has a website is not conducting "electronic transmission of messages and data," in Class 38. The companies providing the Internet connections are conducting the actual transmissions; the applicant is merely making the information available. TMEP § 1402.11(a). The applicant's downloadable software application *involves* or features the technology that enables the (1) interaction between and among users of computers, mobile and handheld computers, and wire and wireless communication devices, (2) transmission of audio clips, text, and video clips, and (3) transmission and receipt of messages via email, instant messaging, or website. The applicant makes the information available to the customers who download the software application. It does not provide the Internet connections that conduct the actual transmissions of data.

Furthermore, the substitute specimens and original specimens only show screenshots of the downloadable application, which do not support the services of "providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking."

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Therefore, applicant must satisfy one of the following, as appropriate:

> (1) Submit a different specimen (a verified "substitute" specimen) that (a) was in actual use in commerce at least as early as the filing date of the application (or prior to the filing of an amendment to allege use) and (b) shows the mark in actual use in commerce for the services identified in International Class 38.
>
> (2) Amend the filing basis to intent to use under Section 1(b). This option will later necessitate additional fee(s) and filing requirements.

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a service mark for the identified Class 38 services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/specimen.jsp.

Response to Final Action

Applicant must respond within six months of the date of issuance of this final Office action or the following class to which the final requirement(s) apply will be **deleted** from the application by Examiner's Amendment: Class 38. 37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

The application will then proceed for the following class: Class 9.

Applicant may respond by providing one or both of the following:

(1) A response that fully satisfies all outstanding requirements;

(2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of $100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is $100. 37 C.F.R. §2.6(a)(15).

/Yatsye I. Lee/
Trademark Examining Attorney
Law Office 107
Phone: 571-272-3897
yatsye.lee@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

To:	Hanginout, Inc. (adskale@mintz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85674799 - HANGINOUT - 44467-402
Sent:	5/28/2013 1:00:45 PM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **5/28/2013** FOR U.S. APPLICATION SERIAL NO. 85674799

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **5/28/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see http://www.uspto.gov/trademarks/basics/abandon.jsp**.**

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

Exhibit 1-D

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85674799
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK FILE NAME	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85674799
LITERAL ELEMENT	HANGINOUT
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
GOODS AND/OR SERVICES SECTION (009)(current)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
GOODS AND/OR SERVICES SECTION (009)(proposed)	
INTERNATIONAL CLASS	009
DESCRIPTION	
Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN	

COMMERCE DATE	At least as early as 06/06/2012
STATEMENT TYPE	**"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application"***[for an application based on Section 1(a), Use in Commerce] OR* **"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use"** *[for an application based on Section 1(b) Intent-to-Use]. OR* **"The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use"** [for an illegible specimen].
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\747\85674799\xml8\ RFR0002.JPG
SPECIMEN DESCRIPTION	Website printout
GOODS AND/OR SERVICES SECTION (038)(no change)	
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Justin Malone/
SIGNATORY'S NAME	Justin Malone
SIGNATORY'S POSITION	CEO
DATE SIGNED	11/25/2013
RESPONSE SIGNATURE	/Andrew D. Skale/
SIGNATORY'S NAME	Andrew D. Skale
SIGNATORY'S POSITION	Attorney of record
SIGNATORY'S PHONE NUMBER	858-314-1506
DATE SIGNED	11/25/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Nov 25 13:03:19 EST 2013
TEAS STAMP	USPTO/RFR-38.97.105.2-201 31125130319212155-8567479 9-5007b996fa84a99df31f51b b8b5645749f8811014252bb41

	a454b232477f3b-N/A-N/A-20 131125125947573542

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **85674799** HANGINOUT (Stylized and/or with Design, see http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85674799) has been amended as follows:
CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 009 for Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/06/2012 and first used in commerce at least as early as 06/06/2012 , and is now in use in such commerce.

Proposed: Class 009 for Computer application software for mobile devices for sharing information, photos, audio and video content in the field of telecommunications and social networking services
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/06/2012 and first used in commerce at least as early as 06/06/2012 , and is now in use in such commerce.
Applicant hereby submits one(or more) specimen(s) for Class 009 . The specimen(s) submitted consists of Website printout .
"**The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application"***[for an application based on Section 1(a), Use in Commerce] OR* "**The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use**" *[for an application based on Section 1(b) Intent-to-Use]. OR* **"The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use"** [for an illegible specimen]. Specimen File1

SIGNATURE(S)
Declaration Signature
If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has

had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Justin Malone/ Date: 11/25/2013
Signatory's Name: Justin Malone
Signatory's Position: CEO

Request for Reconsideration Signature
Signature: /Andrew D. Skale/ Date: 11/25/2013
Signatory's Name: Andrew D. Skale
Signatory's Position: Attorney of record

Signatory's Phone Number: 858-314-1506

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85674799
Internet Transmission Date: Mon Nov 25 13:03:19 EST 2013
TEAS Stamp: USPTO/RFR-38.97.105.2-201311251303192121
55-85674799-5007b996fa84a99df31f51bb8b56
45749f8811014252bb41a454b232477f3b-N/A-N

/A-20131125125947573542

hanginout

Interesting People

Interesting people are all around us, and now you can interact with and follow these people on Hanginout. Photos are great, but the best way to get to know them is interacting and listening to them talk about the things they are patiionate about.

Download on the App Store

Just Ask.

In Hanginout the content is driven by users interacting with each other. If you want to know something about someone or have an expert give you advise, just ask.

Record Responses.

Whether you are connecting with family and friends in different timezones or archiving your families legacy for the future, Hanginout makes it easy. Right from your iPhone create and manage a dynamic interactive video profile.

Auto Responeses

Auto Responses are little videos you record that make your profile feel like people are really hanginout with you. Add welcome clips, waiting clips, and a custom video that will play when a user asks you some thing you haven't asnwered yet.

Notifications

Recieve important notifications right on your phone when other users interact with you. Know instantly when your questions to other users have been created and published.

Interviews

Interviews are an easy way to find questions organized by categories. Choose a question, record a response and build an amazing profile.

Inbox

Your inbox makes it easy to find the questions other have asked you in one easy place. Answer their question if you like or delete it.

Search

Search users and responses to find people and video responses.

 Features Support Questions Terms Privacy

hanginout

Interesting People

Interesting people are all around us, and now you can interact with and follow these people on Hanginout. Photos are great, but the best way to get to know them is interacting and listening to them talk about the things they are patiionate about.

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Recieve important notifications right on your phone when other users interact with you. Know instantly when your questions to other users have been created and published.

Interviews

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Inbox

Your inbox makes it easy to find the questions other have asked you in one easy place. Answer their question if you like or delete it.

Search

Search users and responses to find people and video responses.

 Features Support Questions Terms Privacy

Exhibit 1-E


AT&T
10:57 AM
Messages
Photos
Newsstand
Camera
Productivity
Maps
280
Weather
73°
Settings
iTunes
iTC Mobile
App Store
18
Hanginout
Mitchie
Diddy
Fancy
Twitter
79
37
Phone
Mail
Safari
Hanginout


AT&T
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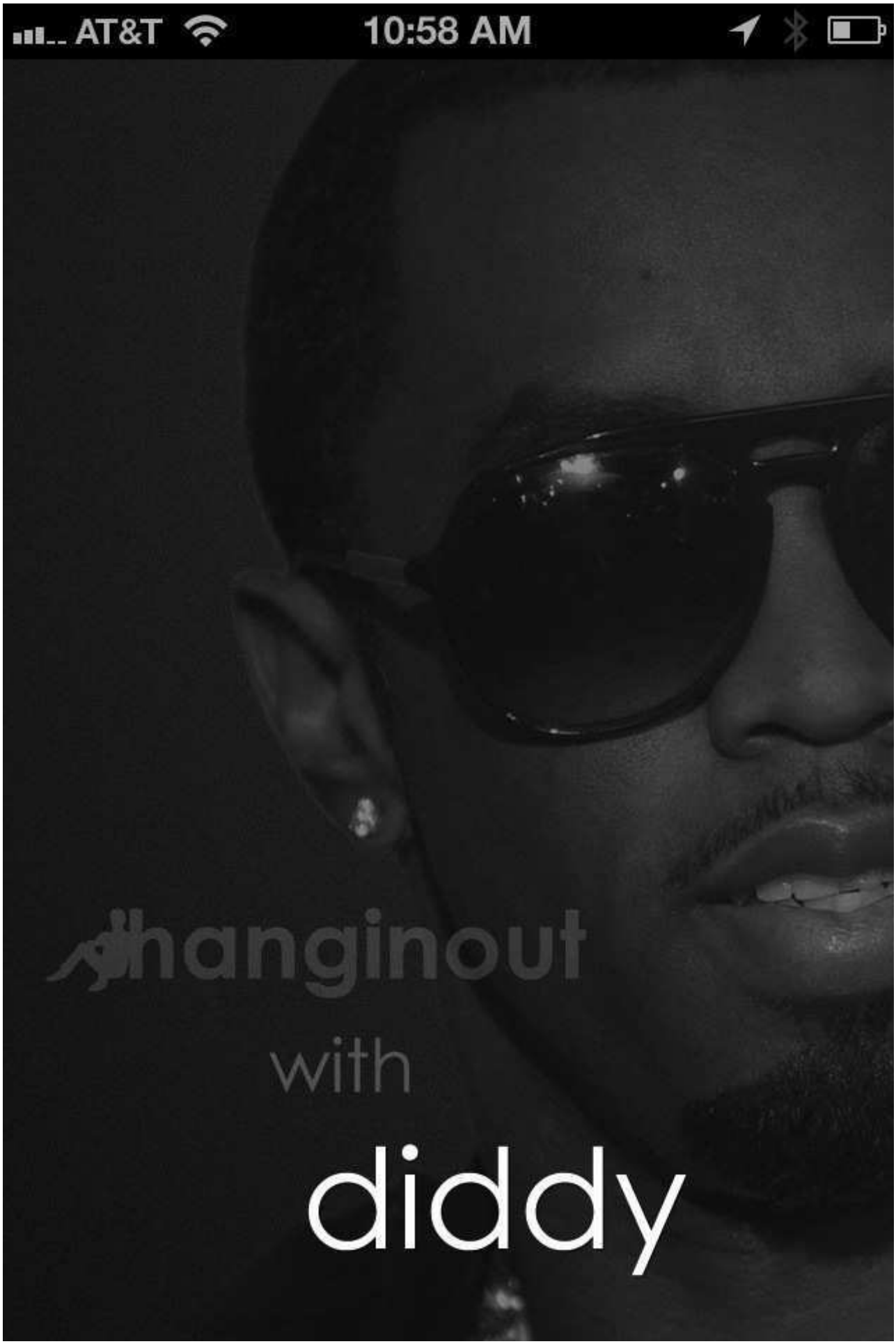
hanginout


AT&T
10:58 AM
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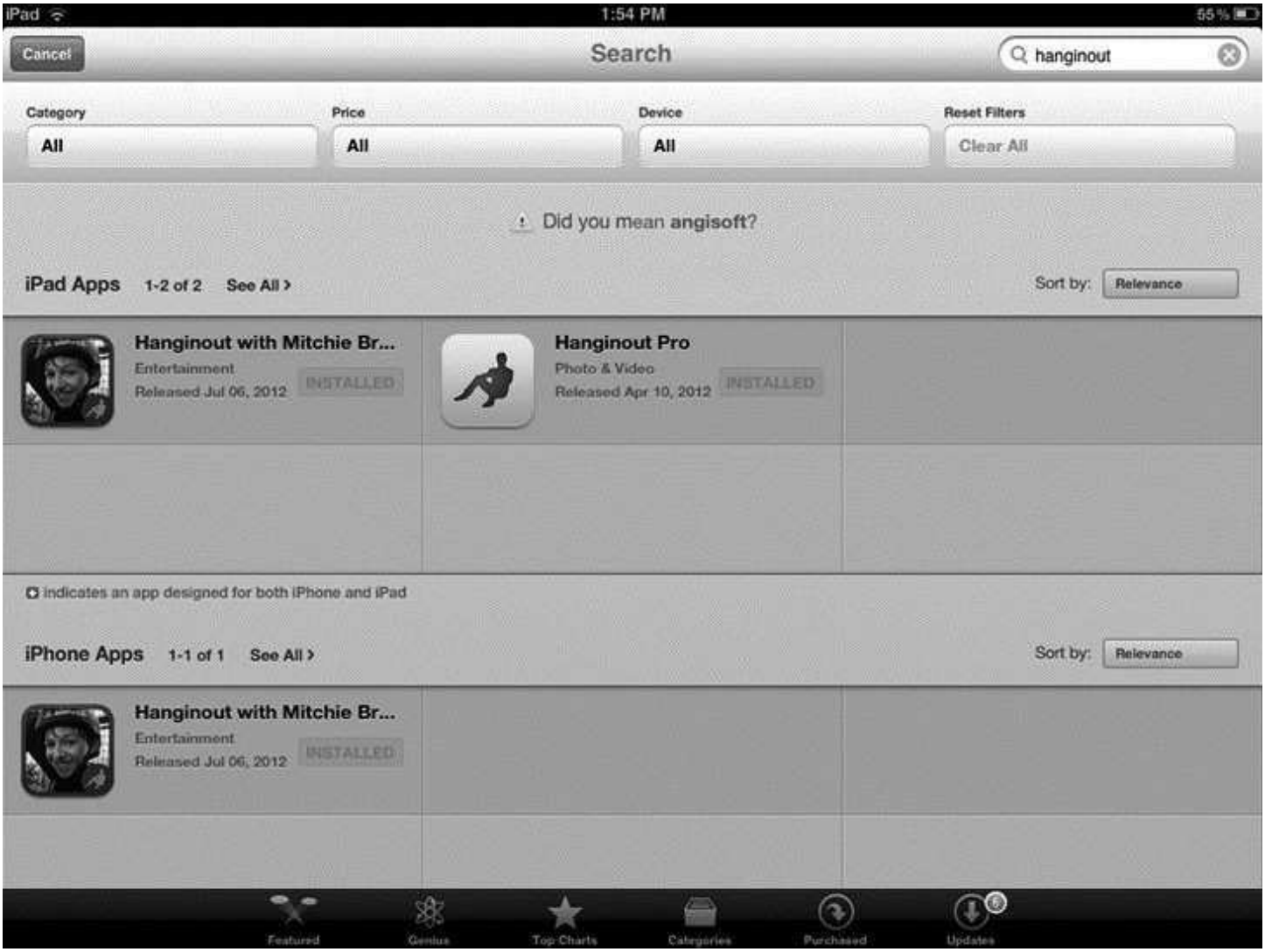
with
diddy


iPad
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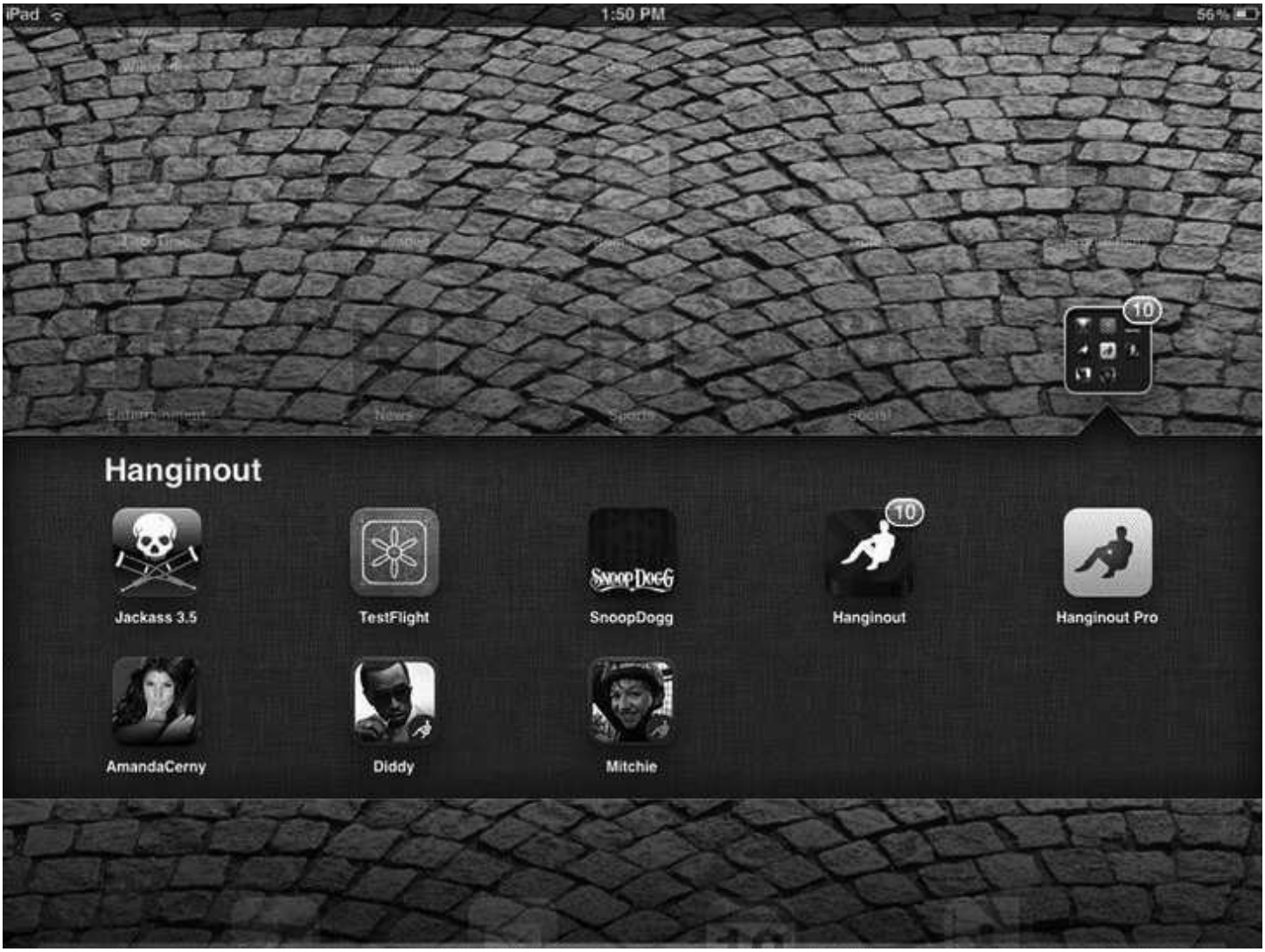
55 %
Cancel
Search
hanginout
Category
All
Price
All
Device
All
Reset Filters
Clear All
Did you mean angisoft?
iPad Apps
1-2 of 2
See All >
Sort by:
Relevance
Hanginout with Mitchie Br...
Entertainment
Released Jul 06, 2012
INSTALLED
Hanginout Pro
Photo & Video
Released Apr 10, 2012
INSTALLED
indicates an app designed for both iPhone and iPad
iPhone Apps
1-1 of 1
See All >
Sort by:
Relevance
Hanginout with Mitchie Br...
Entertainment
Released Jul 06, 2012
INSTALLED
Featured
Genius
Top Charts
Categories
Purchased
Updates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Hanginout
Jackass 3.5
TestFlight
SnoopDogg
10
Hanginout
Hanginout Pro
AmandaCerny
Diddy
Mitchie

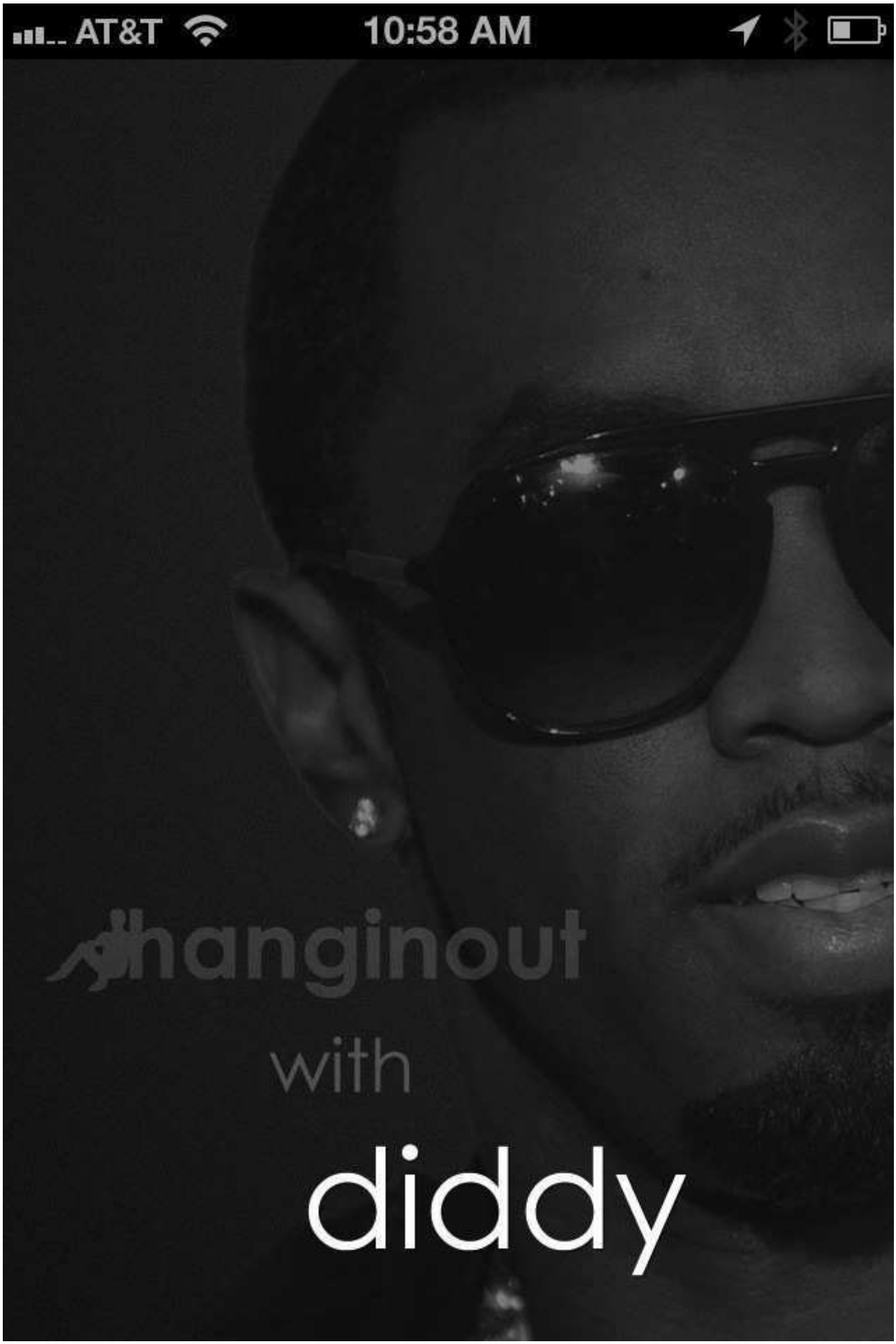
AT&T
10:58 AM
#hanginout
with
diddy

Exhibit 1-F

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 85674801
Filing Date: 07/12/2012

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85674801
MARK INFORMATION	
***MARK**	HANGINOUT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	HANGINOUT
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
***OWNER OF MARK**	Hanginout, Inc.
***STREET**	2712 Jefferson Street
***CITY**	Carlsbad
***STATE** **(Required for U.S. applicants)**	California
***COUNTRY**	United States
***ZIP/POSTAL CODE** **(Required for U.S. applicants only)**	92008
LEGAL ENTITY INFORMATION	
TYPE	corporation
STATE/COUNTRY OF INCORPORATION	Delaware
GOODS AND/OR SERVICES AND BASIS INFORMATION	
INTERNATIONAL CLASS	009
	Computer application software for mobile

*IDENTIFICATION	devices in the field of telecommunications and social networking services
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0003.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0004.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0005.JPG
SPECIMEN DESCRIPTION	Screenshots
INTERNATIONAL CLASS	038
*IDENTIFICATION	Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online community forum for users to share information, photos, audio and video content to engage in social networking
FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0006.JPG
	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0007.JPG

	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml1\ APP0008.JPG
SPECIMEN DESCRIPTION	Screenshots
ATTORNEY INFORMATION	
NAME	Andrew D. Skale
ATTORNEY DOCKET NUMBER	44467-401
FIRM NAME	Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
INTERNAL ADDRESS	Suite 300
STREET	3580 Carmel Mountain Road
CITY	San Diego
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92130
PHONE	858-314-1506
FAX	858-314-1501
EMAIL ADDRESS	adskale@mintz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
OTHER APPOINTED ATTORNEY	Susan Neuberger Weller, Rosemary M. Allen, Heidi F. Aston, Christine M. Baker, Ingrid A. Beattie, Emma Bevan, James P. Cleary, James Conley, Micha Danzig, John M. Delehanty, Joseph DiCioccio, Ivor R. Elrifi, Heidi A. Erlacher, Richard G. Gervase, Jr., Marvin S. Gittes, John Giust, Jeremy Glaser, Geri Haight, Fred C. Hernandez, Brian P. Hopkins, Jennifer Karnakis, Cynthia A. Kozakiewicz, Carl A. Kukkonen III, Muriel M. Liberto, Boris A. Matvenko, A. Jason Mirabito, Matthew Pavao, Brad M. Scheller, Timur Slonim, Peter F. Snell, Christina K. Stock, Pedro Suarez, Michael Van Loy, and all attorneys with the firm of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
CORRESPONDENCE INFORMATION	
NAME	Andrew D. Skale

FIRM NAME	Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
INTERNAL ADDRESS	Suite 300
STREET	3580 Carmel Mountain Road
CITY	San Diego
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92130
PHONE	858-314-1506
FAX	858-314-1501
EMAIL ADDRESS	adskale@mintz.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
NUMBER OF CLASSES	2
FEE PER CLASS	325
***TOTAL FEE DUE**	650
***TOTAL FEE PAID**	650
SIGNATURE INFORMATION	
SIGNATURE	/Justin Malone/
SIGNATORY'S NAME	/Justin Malone/
SIGNATORY'S POSITION	/CEO/
DATE SIGNED	07/11/2012

PTO Form 1478 (Rev 9/2006)
OMB No. 0651-0009 (Exp 12/31/2014)

Trademark/Service Mark Application, Principal Register

Serial Number: 85674801
Filing Date: 07/12/2012

To the Commissioner for Trademarks:

MARK: HANGINOUT (Standard Characters, see mark)
The literal element of the mark consists of HANGINOUT.
The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Hanginout, Inc., a corporation of Delaware, having an address of
2712 Jefferson Street
Carlsbad, California 92008
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 009: Computer application software for mobile devices in the field of telecommunications and social networking services

In International Class 009, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 06/06/2012, and first used in commerce at least as early as 06/06/2012, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots.
Specimen File1
Specimen File2
Specimen File3

International Class 038: Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online community forum for users to share information, photos, audio and video content to engage in social networking

In International Class 038, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 06/06/2012, and first used in commerce at least as early as 06/06/2012, and is now in use in such commerce. The applicant is submitting one(or more)

specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Screenshots.
Specimen File1
Specimen File2
Specimen File3

The applicant's current Attorney Information:
Andrew D. Skale and Susan Neuberger Weller, Rosemary M. Allen, Heidi F. Aston, Christine M. Baker, Ingrid A. Beattie, Emma Bevan, James P. Cleary, James Conley, Micha Danzig, John M. Delehanty, Joseph DiCioccio, Ivor R. Elrifi, Heidi A. Erlacher, Richard G. Gervase, Jr., Marvin S. Gittes, John Giust, Jeremy Glaser, Geri Haight, Fred C. Hernandez, Brian P. Hopkins, Jennifer Karnakis, Cynthia A. Kozakiewicz, Carl A. Kukkonen III, Muriel M. Liberto, Boris A. Matvenko, A. Jason Mirabito, Matthew Pavao, Brad M. Scheller, Timur Slonim, Peter F. Snell, Christina K. Stock, Pedro Suarez, Michael Van Loy, and all attorneys with the firm of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. of Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.

Suite 300
3580 Carmel Mountain Road
San Diego, California 92130
United States
The attorney docket/reference number is 44467-401.
The applicant's current Correspondence Information:
Andrew D. Skale
Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C.
Suite 300
3580 Carmel Mountain Road
San Diego, California 92130
858-314-1506(phone)
858-314-1501(fax)
adskale@mintz.com (authorized)

A fee payment in the amount of $650 has been submitted with the application, representing payment for 2 class(es).

Declaration

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Justin Malone/ Date: 07/11/2012
Signatory's Name: /Justin Malone/
Signatory's Position: /CEO/
RAM Sale Number: 9845
RAM Accounting Date: 07/12/2012

Serial Number: 85674801
Internet Transmission Date: Thu Jul 12 08:25:47 EDT 2012
TEAS Stamp: USPTO/BAS-38.97.105.2-201207120825479583
57-85674801-49069aedee51a5cb983b6d46d483
564f-CC-9845-20120711095851083179

HANGINOUT


AT&T
10:57 AM
Messages
Photos
Newsstand
Camera
Productivity
Maps
280
Weather
73°
Settings
iTunes
iTC Mobile
App Store
18
Hanginout
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Diddy
Fancy
Twitter
79
37
Phone
Mail
Safari
Hanginout


AT&T
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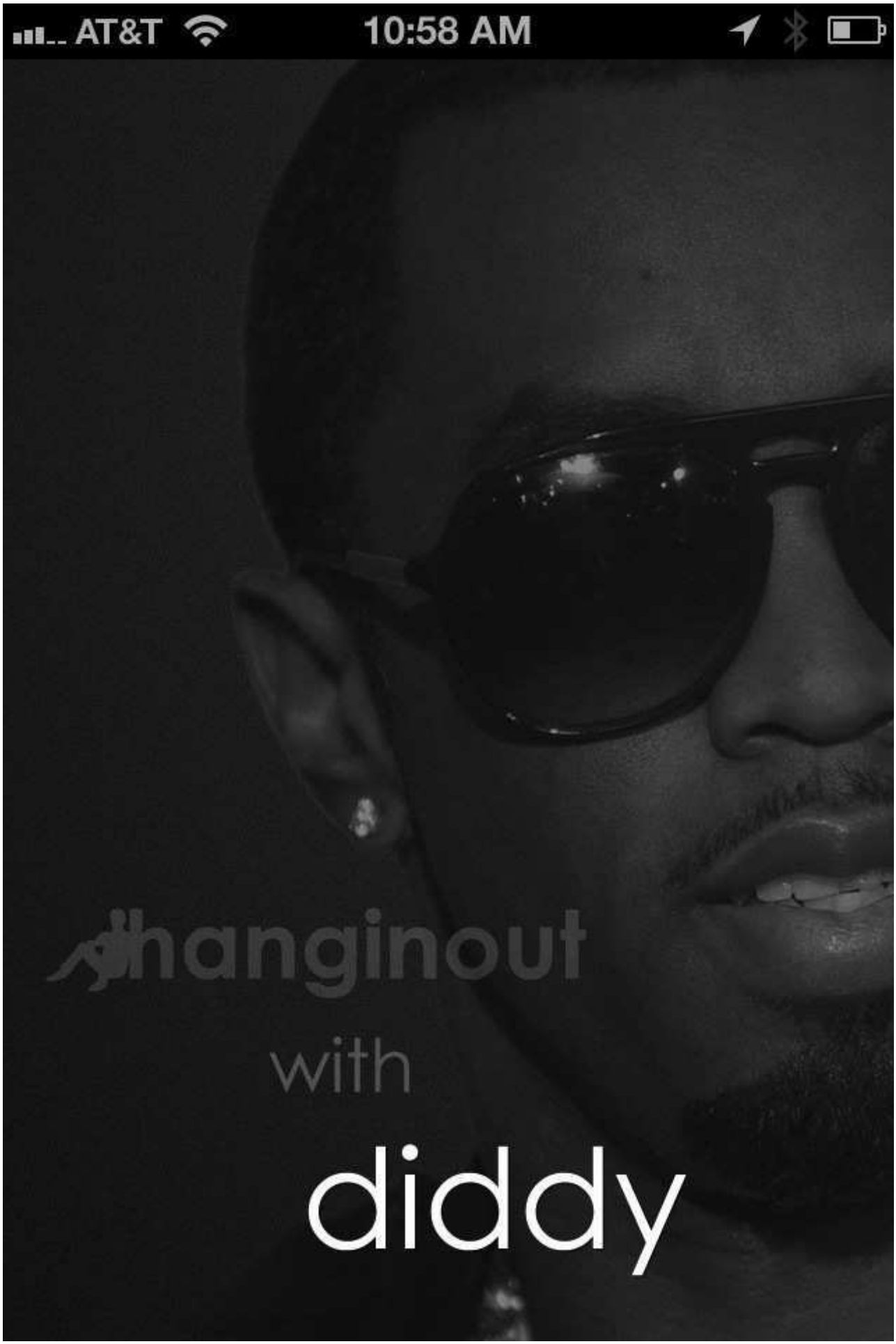
hanginout


AT&T
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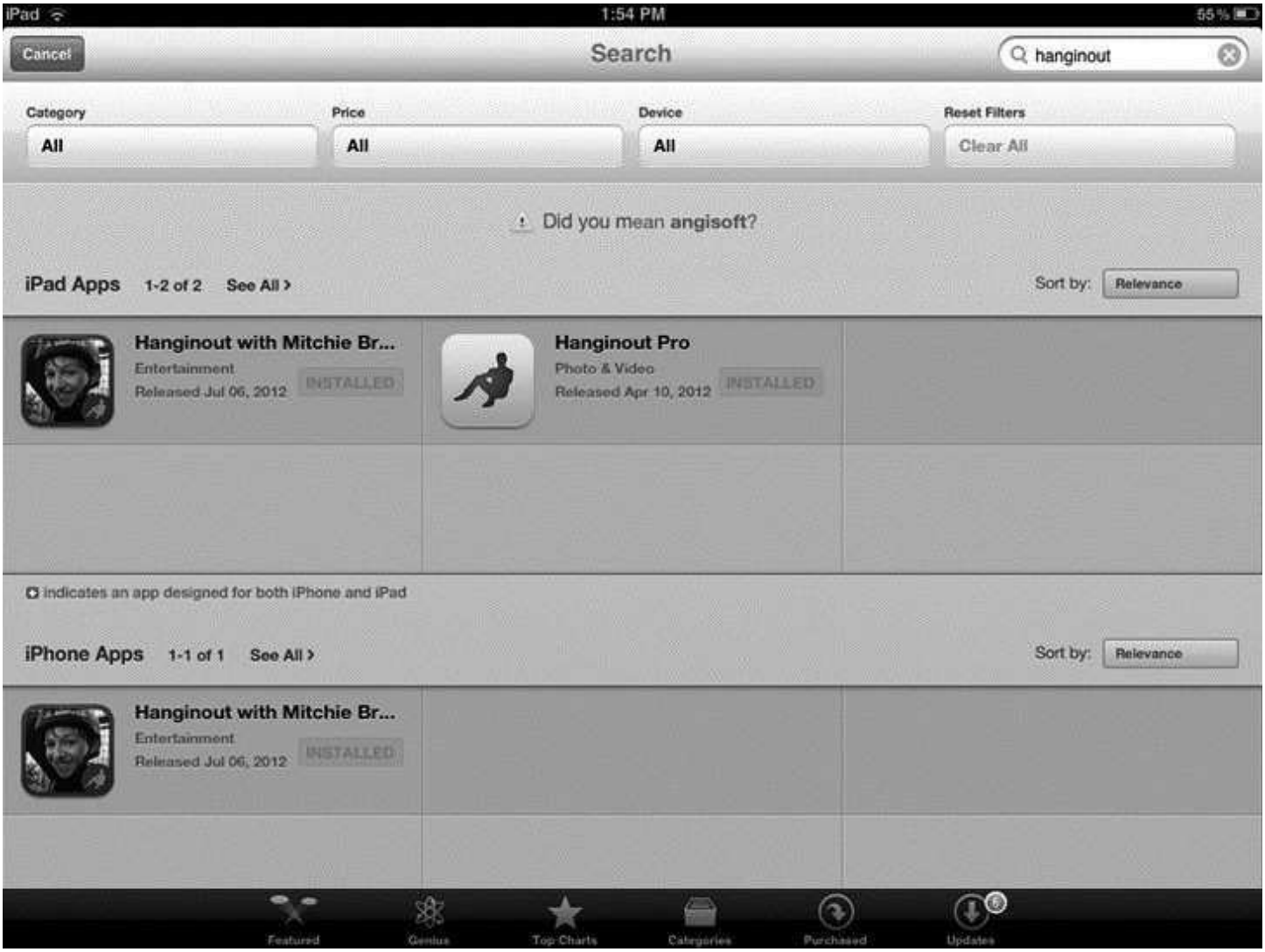
#hanginout
with
diddy


iPad
1:54 PM
55 %
Cancel
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Category
All
Price
All
Device
All
Reset Filters
Clear All
Did you mean angisoft?
iPad Apps
1-2 of 2
See All >
Sort by:
Relevance
Hanginout with Mitchie Br...
Entertainment
Released Jul 06, 2012
INSTALLED
Hanginout Pro
Photo & Video
Released Apr 10, 2012
INSTALLED
indicates an app designed for both iPhone and iPad
iPhone Apps
1-1 of 1
See All >
Sort by:
Relevance
Hanginout with Mitchie Br...
Entertainment
Released Jul 06, 2012
INSTALLED
Featured
Genius
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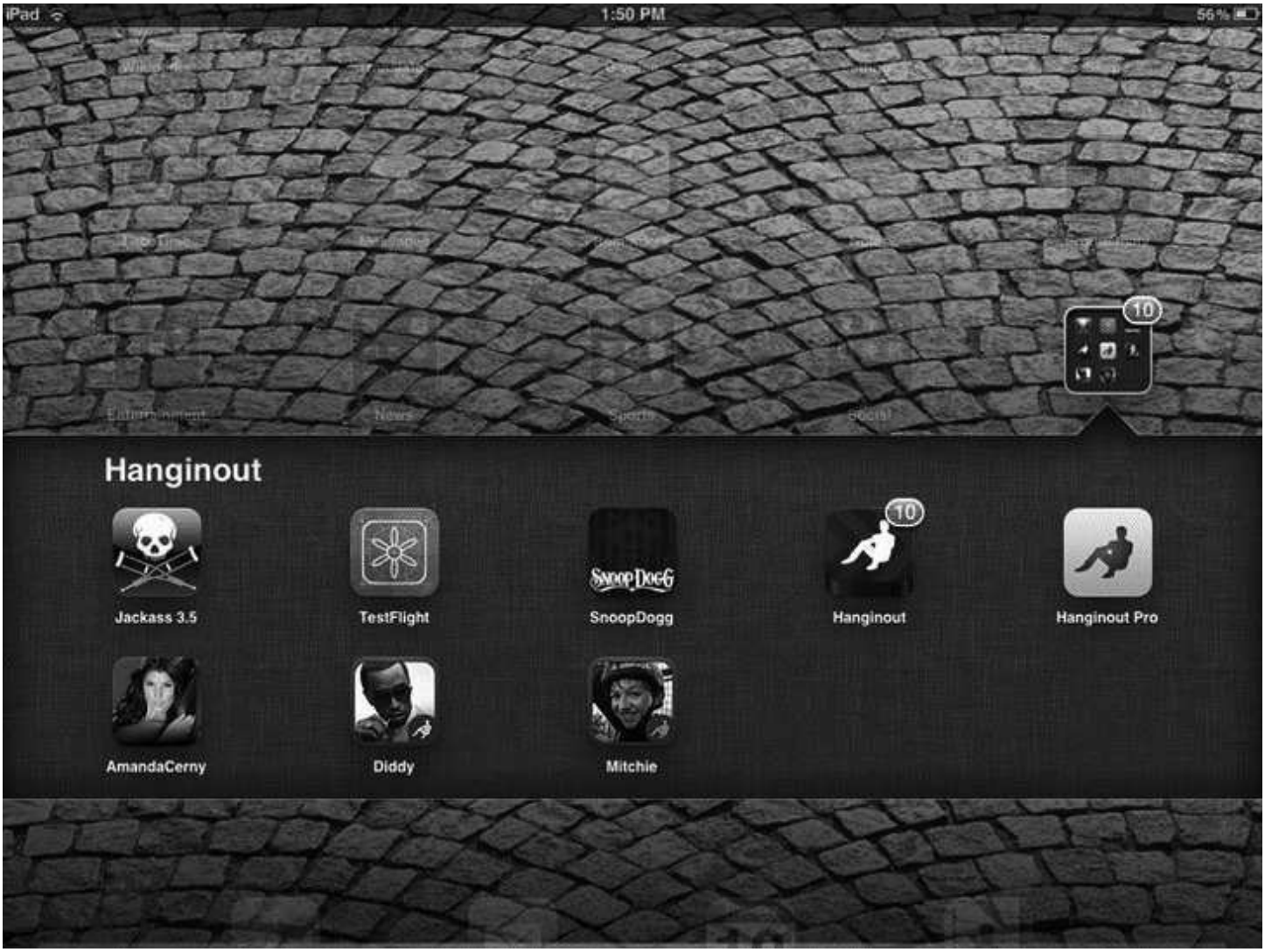
Purchased
Updates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Hanginout
Jackass 3.5
TestFlight
SnoopDogg
10
Hanginout
Hanginout Pro
AmandaCerny
Diddy
Mitchie

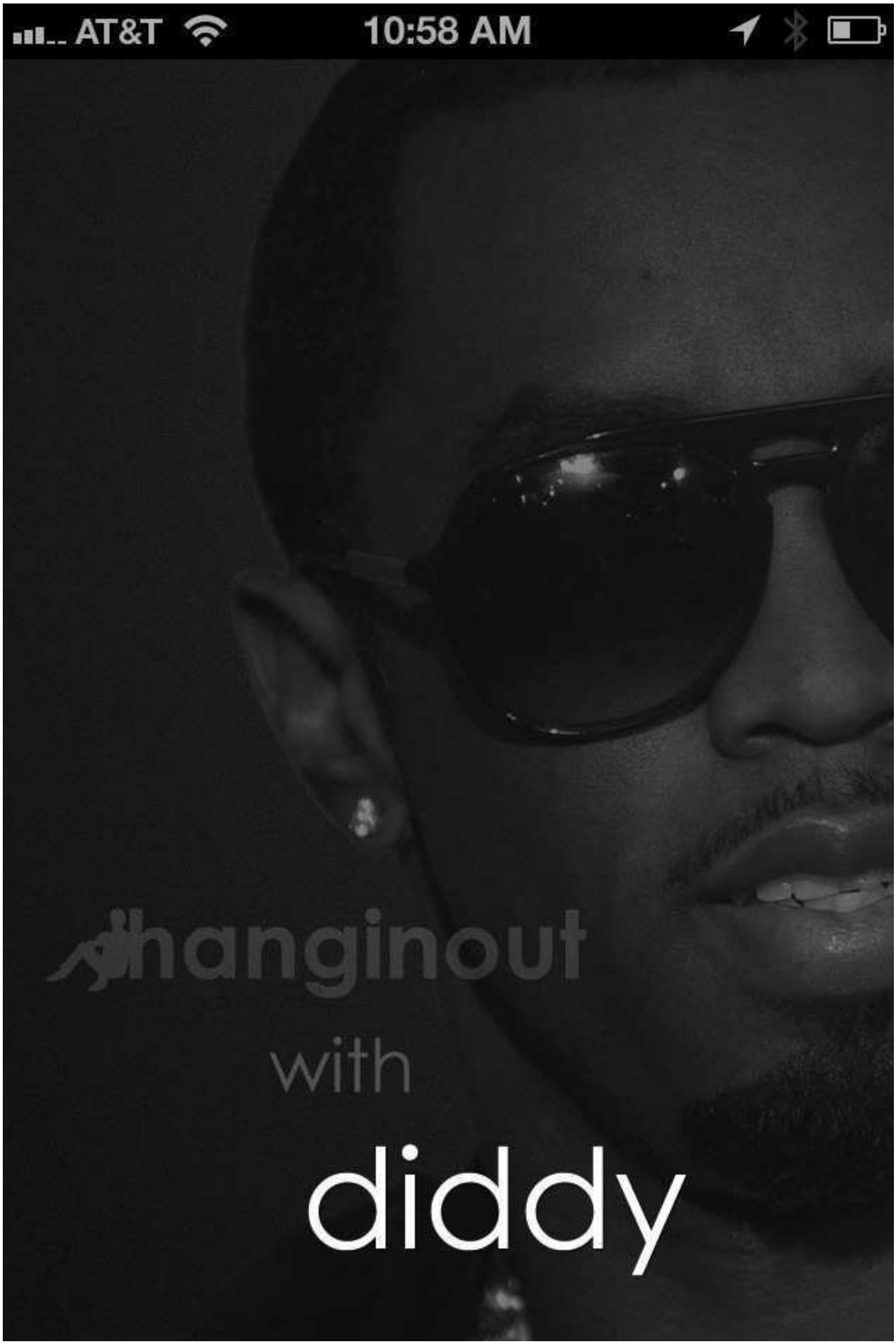
AT&T
10:58 AM
#hanginout
with
diddy

Exhibit 1-G

To:	Hanginout, Inc. (adskale@mintz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85674801 - HANGINOUT - 44467-401
Sent:	5/28/2013 12:59:57 PM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 85674801

MARK: HANGINOUT

85674801

CLICK HERE TO RESPOND TO
http://www.uspto.gov/trademarks/teas/r

CORRESPONDENT ADDRESS:
ANDREW D. SKALE
MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND
3580 CARMEL MOUNTAIN RD STE 300
SAN DIEGO, CA 92130-6768

APPLICANT: Hanginout, Inc.

CORRESPONDENT'S REFERENCE/DOCKET NO :
44467-401
CORRESPONDENT E-MAIL ADDRESS:
adskale@mintz.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 5/28/2013

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on May 2, 2013.

In light of the Trademark Trial and Appeal Board's granting of applicant's Petition to Cancel U.S. Registration No. 3857338, the previously issued Section 2(d) refusal is now rendered moot.

The applicant's amended identification of goods and services is accepted and made of record.

However, the substitute specimens for Class 38 are still unacceptable. The refusal of registration based on the failure to provide a specimen that shows the applied-for mark in use in commerce as a service mark is now made final. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a), 2.64(a); TMEP §§904, 904.07(a).

Specimen Requirement

The specimen does not show the applied-for mark in use in commerce in connection with any of the services specified in International Class 38, and therefore is not acceptable. Specifically, the substitute specimens and original specimens show that the mark is used in connection with a downloadable software application that involves some of the functionalities described in the applicant's Class 38 recitation. The specimens do not, however, show that applicant provides all of the telecommunications services recited in the application.

Just because the applicant is conducting an activity that may involve transmission of data on the Internet does not mean the applicant's service is a Class 38 service. For example, an applicant who merely has a website is not conducting "electronic transmission of messages and data," in Class 38. The companies providing the Internet connections are conducting the actual transmissions; the applicant is merely making the information available. TMEP § 1402.11(a). The applicant's downloadable software application *involves* or features the technology that enables the (1) interaction between and among users of computers, mobile and handheld computers, and wire and wireless communication devices, (2) transmission of audio clips, text, and video clips, and (3) transmission and receipt of messages via email, instant messaging, or website. The applicant makes the information available to the customers who download the software application. It does not provide the Internet connections that conduct the actual transmissions of data.

Furthermore, the substitute specimens and original specimens only show screenshots of the downloadable application, which do not support the services of "providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking."

An application based on Trademark Act Section 1(a) must include a specimen showing the applied-for mark in use in commerce for each international class of goods and/or services identified in the application or amendment to allege use. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a). Therefore, applicant must satisfy one of the following, as appropriate:

> (1) Submit a different specimen (a verified "substitute" specimen) that (a) was in actual use in commerce at least as early as the filing date of the application (or prior to the filing of an amendment to allege use) and (b) shows the mark in actual use in commerce for the services identified in International Class 38.
>
> (2) Amend the filing basis to intent to use under Section 1(b). This option will later necessitate additional fee(s) and filing requirements.

Pending receipt of a proper response, registration is refused because the specimen does not show the applied-for mark in use in commerce as a service mark for the identified Class 38 services. Trademark Act Sections 1 and 45, 15 U.S.C. §§1051, 1127; 37 C.F.R. §§2.34(a)(1)(iv), 2.56(a); TMEP §§904, 904.07(a).

For an overview of *both* response options referenced above and instructions on how to satisfy either option online using the Trademark Electronic Application System (TEAS) form, please go to http://www.uspto.gov/trademarks/law/specimen.jsp.

Response to Final Action

Applicant must respond within six months of the date of issuance of this final Office action or the following class to which the final requirement(s) apply will be **deleted** from the application by Examiner's Amendment: Class 38. 37 C.F.R. §2.65(a); *see* 15 U.S.C. §1062(b).

The application will then proceed for the following class: Class 9.

Applicant may respond by providing one or both of the following:

(1) A response that fully satisfies all outstanding requirements;

(2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of $100 per class.

37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is $100. 37 C.F.R. §2.6(a)(15).

/Yatsye I. Lee/
Trademark Examining Attorney
Law Office 107
Phone: 571-272-3897
yatsye.lee@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.

To:	Hanginout, Inc. (adskale@mintz.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 85674801 - HANGINOUT - 44467-401
Sent:	5/28/2013 12:59:58 PM
Sent As:	ECOM107@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **5/28/2013** FOR U.S. APPLICATION SERIAL NO. 85674801

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **5/28/2013** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

WARNING

Failure to file the required response by the applicable response deadline will result in the

ABANDONMENT of your application. For more information regarding abandonment, see http://www.uspto.gov/trademarks/basics/abandon.jsp**.**

PRIVATE COMPANY SOLICITATIONS REGARDING YOUR APPLICATION: Private companies **not** associated with the USPTO are using information provided in trademark applications to mail or e-mail trademark-related solicitations. These companies often use names that closely resemble the USPTO and their solicitations may look like an official government document. Many solicitations require that you pay "fees."

Please carefully review all correspondence you receive regarding this application to make sure that you are responding to an official document from the USPTO rather than a private company solicitation. All official USPTO correspondence will be mailed only from the "United States Patent and Trademark Office" in Alexandria, VA; or sent by e-mail from the domain "@uspto.gov." For more information on how to handle private company solicitations, see http://www.uspto.gov/trademarks/solicitation_warnings.jsp.

Exhibit 1-H

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85674801
LAW OFFICE ASSIGNED	LAW OFFICE 107
MARK SECTION	
MARK	http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85674801
LITERAL ELEMENT	HANGINOUT
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size or color.
GOODS AND/OR SERVICES SECTION (009)(no change)	
GOODS AND/OR SERVICES SECTION (038)(current)	
INTERNATIONAL CLASS	038
DESCRIPTION	
Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
GOODS AND/OR SERVICES SECTION (038)(proposed)	

INTERNATIONAL CLASS	038
DESCRIPTION	
Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking	
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 06/06/2012
FIRST USE IN COMMERCE DATE	At least as early as 06/06/2012
STATEMENT TYPE	**"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application"***[for an application based on Section 1(a), Use in Commerce] OR* **"The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use"** *[for an application based on Section 1(b) Intent-to-Use]. OR* **"The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use"** [for an illegible specimen].
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT16\IMAGEOUT 16\856\748\85674801\xml8\ RFR0002.JPG
SPECIMEN DESCRIPTION	Website printout
SIGNATURE SECTION	
DECLARATION SIGNATURE	/Justin Malone/
SIGNATORY'S NAME	Justin Malone
SIGNATORY'S POSITION	CEO
DATE SIGNED	11/25/2013
RESPONSE SIGNATURE	/Andrew D. Skale/
SIGNATORY'S NAME	Andrew D. Skale
SIGNATORY'S POSITION	Attorney of record
SIGNATORY'S PHONE NUMBER	858-314-1506

DATE SIGNED	11/25/2013
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO
FILING INFORMATION SECTION	
SUBMIT DATE	Mon Nov 25 12:59:14 EST 2013
TEAS STAMP	USPTO/RFR-38.97.105.2-201 31125125914942838-8567480 1-500bad74d35f9f7e677823e 281801ef74aa33dc23efd4678 98f422a7edfe46d24-N/A-N/A -20131125125551842577

PTO Form 1960 (Rev 9/2007)
OMB No. 0651-0050 (Exp. 07/31/2017)

Request for Reconsideration after Final Action
To the Commissioner for Trademarks:

Application serial no. **85674801** HANGINOUT(Standard Characters, see http://tess2.uspto.gov/ImageAgent/ImageAgentProxy?getImage=85674801) has been amended as follows:
CLASSIFICATION AND LISTING OF GOODS/SERVICES
Applicant proposes to amend the following class of goods/services in the application:
Current: Class 038 for Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking
Original Filing Basis:
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/06/2012 and first used in commerce at least as early as 06/06/2012 , and is now in use in such commerce.

Proposed: Class 038 for Telecommunications services, namely, providing online and telecommunication facilities for real-time and on-demand interaction between and among users of computers, mobile and handheld computers, and wired and wireless communication devices; audio, text and video broadcasting services over the Internet or other communications networks, namely, electronically transmitting audio

clips, text and video clips; electronic messaging services enabling individuals to send and receive messages via email, instant messaging or a website on the Internet in the field of general interest; providing online forums for communication on topics of general interest; providing an online forum for users to share information, photos, audio and video content to engage in social networking
Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 06/06/2012 and first used in commerce at least as early as 06/06/2012 , and is now in use in such commerce.
Applicant hereby submits one(or more) specimen(s) for Class 038 . The specimen(s) submitted consists of Website printout .
"**The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application"***[for an application based on Section 1(a), Use in Commerce] OR* "**The substitute (or new, or originally submitted, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use**" *[for an application based on Section 1(b) Intent-to-Use]. OR* **"The attached specimen is a true copy of the specimen that was originally submitted with the application, amendment to allege use, or statement of use"** [for an illegible specimen]. Specimen File1

SIGNATURE(S)
Declaration Signature
If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Justin Malone/ Date: 11/25/2013
Signatory's Name: Justin Malone
Signatory's Position: CEO

Request for Reconsideration Signature

Signature: /Andrew D. Skale/ Date: 11/25/2013
Signatory's Name: Andrew D. Skale
Signatory's Position: Attorney of record

Signatory's Phone Number: 858-314-1506

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 85674801
Internet Transmission Date: Mon Nov 25 12:59:14 EST 2013
TEAS Stamp: USPTO/RFR-38.97.105.2-20131125125914942 8-85674801-500bad74d35f9f7e677823e28180 1ef74aa33dc23efd467898f422a7edfe46d24-N/ A-N/A-20131125125551842577

hanginout

Interesting People

Interesting people are all around us, and now you can interact with and follow these people on Hanginout. Photos are great, but the best way to get to know them is interacting and listening to them talk about the things they are patiionate about.

Download on the App Store

Just Ask.

In Hanginout the content is driven by users interacting with each other. If you want to know something about someone or have an expert give you advise, just ask.

Record Responses.

Whether you are connecting with family and friends in different timezones or archiving your families legacy for the future, Hanginout makes it easy. Right from your iPhone create and manage a dynamic interactive video profile.

Auto Responeses

Auto Responses are little videos you record that make your profile feel like people are really hanginout with you. Add welcome clips, waiting clips, and a custom video that will play when a user asks you some thing you haven't asnwered yet.

Notifications

Recieve important notifications right on your phone when other users interact with you. Know instantly when your questions to other users have been created and published.

Interviews

Interviews are an easy way to find questions organized by categories. Choose a question, record a response and build an amazing profile.

Inbox

Your inbox makes it easy to find the questions other have asked you in one easy place. Answer their question if you like or delete it.

Search

Search users and responses to find people and video responses.

 Features Support Questions Terms Privacy

hanginout

Interesting People

Interesting people are all around us, and now you can interact with and follow these people on Hanginout. Photos are great, but the best way to get to know them is interacting and listening to them talk about the things they are patiionate about.

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Recieve important notifications right on your phone when other users interact with you. Know instantly when your questions to other users have been created and published.

Interviews

Interviews are an easy way to find questions organized by categories. Choose a question, record a response and build an amazing profile.

Inbox

Your inbox makes it easy to find the questions other have asked you in one easy place. Answer their question if you like or delete it.

Search

Search users and responses to find people and video responses.

 Features Support Questions Terms Privacy

Exhibit 2

Q If you turn to the next page, you see what looks to be a screen shot from an iPhone. Do you see that? 17:32:32

A I see that. 17:32:50

Q What is this page? 17:32:51

MR. NAHAMA: Objection. The document speaks for itself. 17:32:52

THE WITNESS: It's a representation of an iPhone screen. 17:32:58

BY MS. CARUSO: 17:33:01

Q Did you provide -- do you know where this image was obtained from? 17:33:05

A One of the devices of somebody in the company. 17:33:17

Q Do you see on the -- 17:33:25

A I believe it's my iPhone. 17:33:28

Q -- fourth row there is a little app square that says "Mitchie" under it? 17:33:32

A Yes. 17:33:38

Q Do you see that next to that there is an app square that says "Diddy" under it? 17:33:38

MR. NAHAMA: Objection. The document speaks for itself. 17:33:44

THE WITNESS: I see those. 17:33:47

BY MS. CARUSO: 17:33:47

Q Did Hanginout ever offer a Diddy app? 17:33:48

A No. 17:33:54

Q If you'd turn to the next page and the one after that. What do you understand that to be? 17:33:58

A That's a screen grab of a loading screen from the Diddy demo. 17:34:16

Q The Diddy demo was not offered to consumers; is that correct? 17:34:23

A Correct. 17:34:28

MR. NAHAMA: Objection to the extent that it calls for a legal conclusion. 17:34:29

BY MS. CARUSO: 17:34:32

Q The Diddy demo was not sold to anyone; is that correct? 17:34:32

MR. NAHAMA: Objection to the extent that it calls for a legal conclusion. 17:34:35

THE WITNESS: We did not sell the Diddy app. 17:34:39

BY MS. CARUSO: 17:34:46

Q If you turn to the page after the next page, it's kind of a brick walkway background. Do you see that? 17:34:47

A I see it. 17:34:58

Q What do you understand this image to be? 17:34:59

A This is a screen of an iPad with applications. 17:35:06

Q The bottom row has an image that underneath it says "Amanda Cerny." Do you see that? 17:35:16

Exhibit 3

UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

HANGINOUT, INC., a Delaware corporation, Plaintiff, v. GOOGLE, INC., a Delaware corporation, Defendant.	Case No.13cv2811 AJB (NLS) ORDER: (1) DENYING HANGINOUT'S MOTION FOR PRELIMINARY INJUNCTION, (Doc. No. 12); and (2) DENYING GOOGLE'S MOTION TO DISMISS THE FIRST AMENDED COMPLAINT, (Doc. No. 23).

On November 26, 2013, Hanginout, Inc. ("Hanginout") filed this action against Google, Inc. ("Google") alleging trademark infringement, federal unfair competition, and California statutory and common law unfair competition.[1] (Doc. No. 1.) In the First Amended Complaint, Hanginout alleges that it has used the HANGINOUT mark in commerce to market its interactive video-response platform since at least March 2010, and that Google's use of the HANGOUTS mark to market its video-response platform, which is substantially similar if not identical to Hanginout's product, infringes on Hanginout's common law trademark rights. (Doc. No. 14.)

[1] Google filed a motion to dismiss the original complaint on January 10, 2014, (Doc. No. 9), which was deemed moot after Hanginout filed the First Amended Complaint on January 28, 2014, (Doc. No. 14).

Currently before the Court are Hanginout's motion for preliminary injunction filed on January 22, 2014, (Doc. No. 12), and Google's motion to dismiss the First Amended Complaint filed on February 28, 2014, (Doc. No. 23). Hanginout's motion for preliminary injunction seeks to enjoin Google from using the HANGOUTS mark on the Internet in connection with its social media platform, either nationwide or limited to California. The Court heard oral argument on both motions on April 25, 2014. (Doc. No. 41.) For the reasons set forth below, the Court DENIES Hanginout's motion for a preliminary injunction and DENIES Google's motion to dismiss.

BACKGROUND

I. Factual Background

Hanginout is a technology based Delaware corporation that has developed mobile video and social media based communication products since at least 2009.[2] (Doc. No. 14 ¶ 10.) At issue in this litigation is Hanginout's interactive video response platform HANGINOUT, which enables users to create, promote, and sell their own brands by engaging directly with potential customers via pre-recorded video messages and/or video profiles. (*Id.* at ¶¶ 12–14.) The HANGINOUT platform also includes a "Q&A" function, wherein users can exchange questions and personal video responses from anyone in the application at any time. (*Id.* at ¶¶ 14–15.)

A. The HANGINOUT mark

Hanginout alleges it adopted the HANGINOUT word and design marks in connection with its social media based platform as early as November 2008, and that for the first year or so developed business plans and the technological know-how to turn its vision into a reality. (*Id*. at ¶ 11; Doc. No. 12, Malone Decl. ¶¶ 6, 7, Ex. 1.) Thereafter, beginning in early 2010, Hanginout began marketing the HANGINOUT platform through social media and various partnerships with celebrities and professional athletes. (Doc. No. 4 ¶¶ 16-17.) For example, in March 2010, Hanginout's company Facebook

[2] Hanginout incorporated in the state of Delaware in 2011. (Doc. No. 14 at ¶ 1.) Its principal place of business is located at 2712 Jefferson Street, Carlsbad, CA 92008. (*Id*.)

profile containing the HANGINOUT mark was uploaded and Hanginout partnered with professional athlete Shawne Merriman to shoot a HANGINOUT promotional video. (*Id.*)

Approximately a year later, in or around March or April 2011, Hanginout alleges that consumers began registering for HANGINOUT profiles via Hanginout's web-based application and endorsing the product on social-media based platforms such as Twitter and Facebook. (*Id.* at ¶ 18.) Thereafter, Hanginout alleges it continued to market the HANGINOUT application through various social-media outlets. (*Id.* at ¶ 19.) By May 2011, Hanginout alleges that over 200 customers had registered for and used Version 1.0 of the HANGINOUT Q&A web-based platform. (*Id.* at ¶ 20.)

On July 12, 2012, Hanginout filed trademark applications for the HANGINOUT word and design marks with the United States Patent and Trademark Office ("USPTO"). (*Id.* at ¶ 21.) The USPTO assigned Application Serial No. 85674801 to the HANGINOUT word mark and Application Serial No. 85674799 to the HANGINOUT design mark.[3] (*Id.* at ¶ 22.) Both applications have since been published by the USPTO for opposition. (*Id.* at ¶ 24.) As of the date of this order, neither trademark is officially registered with the USPTO. Two months later, on September 12, 2012, Hanginout officially launched a HANGINOUT iOS application for its web-based platform on the iTunes App Store. (Doc. No. 12 at 5:2–3, 25; Doc. No. 14 ¶ 27.) Since this date, Hanginout alleges that the HANGINOUT app has received hundreds of thousands of views from individuals across the world, received celebrity media attention, has been downloaded and used by consumers across the United States, and has been featured by Apple in the iTunes application portal. (Doc. No. 12 ¶ 27.)

B. The HANGOUTS Mark

By 2009, Google alleges it had already developed an internal version of what later became its HANGOUTS product, referring to the prototype as "The Hangout." (Doc.

[3] Hanginout attached both trademark applications to the First Amended Complaint. (Doc. No. 14, Exs. A, B.)

No. 30 at 2:24-25, Lachappelle Decl. ¶ 4.) Thereafter, on June 28, 2011, Google made HANGOUTS accessible to the public, including it as one of several products that made up Google+, a social layer that connects many of Google's products.[4] (Doc. No. 30 at 2:26-28, Leske Decl. ¶ 3, Exs. 1-2.) Among other features, HANGOUTS allows users to engage in live interactions with other users, including instant messaging and real-time video-conferencing. (Doc. No. 34, Caruso Decl. ¶ 3, Ex. 1; Leske Decl. ¶¶ 3, 6.) HANGOUTS had 50,000 unique registered users the very first day it launched and 150,000 unique registered users as of July 8, 2011.[5] (Doc. No. 30 at 3:6, Leske Decl. ¶ 3, Ex. 1.) Since HANGOUTS launch, Google contends that users have initiated more than [redacted]HANGOUT video conferences and the app version of HANGOUTS has been installed on more than [redacted]mobile devices. (*Id*. at 3:6-10, Leske Decl. ¶¶ 5-6.)

On April 26, 2013, Google filed an application with the USPTO to register the HANGOUTS mark, which was assigned Application Serial No. 85916316. (Doc. No. 14 ¶ 29.) Thereafter, in or around May 2013, Google released the HANGOUTS iTunes application for the App store. (Doc. No. 12 at 7:2-3.) On July 30, 2013, the USPTO suspended Google's HANGOUTS trademark application after finding that a "pending application(s) may present a bar to registration of the applicant's mark." (Doc. No. 12, Malone Decl., Ex. 26.)

On September 12, 2013, Google launched Hangouts On Air ("HOA"), which offers users the ability to host interactive conversations with people from around the world. (Doc. No. 29, Ex. 3.) HOA is different from HANGOUTS because HOA is not

[4] At oral argument, counsel for Google provided the Court with a time line of Google's uses of "Hangouts" and "Google+ Hangouts." This document has been marked at Court's Exhibit 1. (Doc. No. 42.)

[5] Google asserts that by June 30, 2011, Google's official blog post announcing HANGOUTS was viewed more than 460,000 times. (Doc. No. 30, Leske Decl. ¶ 3.) Press reports regarding the release of HANGOUTS immediately followed, including articles and announcements by The New York Times, NBC News, CNN, Fox News, Bloomberg Businessweek, Computer World, Rolling Stone, and PC Magazine. (*Id*.)

limited to ten participants and allows the public to view the live feed.[6] (Doc. No. 30, Leske Decl. ¶¶ 8–10.) Google alleges that HANGOUTS can be accessed through Gmail, Google+ websites, or through mobile applications available for Android and iOS devices. (*Id.* at ¶ 28.)

DISCUSSION

I. Hanginout's Motion for Preliminary Injunction

Hanginout moves to preliminary enjoin Google from using the HANGOUTS mark in its messaging and social media platforms, its Q&A platform, and cease advertising and soliciting the HANGOUTS mark in connection with its messaging platform. Because the parties' briefing focused solely on Hanginout's trademark infringement claim under the Lanham Act, the Court does not address Hanginout's federal unfair competition claim or Hanginout's statutory and common law unfair competition claims under California law.

A. Legal Standard

In deciding whether to issue a preliminary injunction, the court must consider: (1) the likelihood of the moving party's success on the merits; (2) the possibility of irreparable injury to the moving party if relief is not granted; (3) the extent to which the balance of hardships tips in favor of one party or the other; and (4) whether the public interest will be advanced by granting preliminary relief. *Toyo Tire Holdings of Ams. Inc. v. Cont'l Tire N. Am., Inc.*, 609 F.3d 975, 982 (9th Cir. 2010) (citing *Winter v. Natural Res. Def. Council, Inc.*, 555 U.S. 7, 22, 20 (2008)). "A preliminary injunction is an extraordinary remedy" that may only be granted "upon a clear showing that the plaintiff is entitled to such relief." *Winter*, 555 U.S. at 22, 24; *Mazurek v. Armstrong*, 520 U.S. 968, 972 (1997) ("And what is at issue here is not even a defendant's motion for summary judgment, but a plaintiff's motion for preliminary injunctive relief, as to which the requirement for substantial proof is much higher."). The mere possibility that a plaintiff

[6] The live feed is then saved on the host Google+ page and YouTube to allow editing and sharing. (Doc. No. 30, Leske Decl. ¶¶ 8–10.)

will suffer irreparable injury is insufficient. *See Am. Trucking Ass'n*, *Inc. v. City of L.A.*, 559 F.3d 1046, 1052 (9th Cir. 2009) (stating that following *Winter* cases suggesting a lower standard "are no longer controlling, or even viable").

B. Analysis

1. Likelihood of Success on the Merits

To state a claim for trademark infringement under the Lanham Act, 15 U.S.C. § 1125(a), a plaintiff must demonstrate that it is: "(1) the owner of a valid, protectable mark, and (2) that the alleged infringer is using a confusingly similar mark." *Herb Reed Enters.*, *LLC v. Fla. Entm't Mgmt*, *Inc.*, 736 F.3d 1239, 1247 (9th Cir. 2013) (citing *Grocery Outlet*, *Inc. v. Albertson's*, *Inc.*, 497 F.3d 949, 951 (9th Cir. 2007)).

i. Ownership of a Valid, Protectable Mark

To establish common law trademark rights in the absence of federal registration, a plaintiff must plead and prove that it is the senior user of the mark with sufficient market penetration to preclude the defendant from using the mark in a specific geographic market.[7] *See Sengoku Works Ltd. v. RMC Int'l*, *Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996) ("To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services."); *Quiksilver*, *Inc. v. Kymsta Corp.*, 466 F.3d 749, 761–62 (9th Cir. 2006) (stating that use equated to sales in a specified area); *Adray v. Adry-Mart*, *Inc.*, 76 F.3d 984, 988 (9th Cir. 1995); *Credit One Corp. v. Credit One Fin.*, *Inc.*, 661 F. Supp. 2d 1134, 1138 (C.D. Cal. 2009) ("A party asserting common law rights must not only establish that it is the senior user, it must also show that it has 'legally sufficient market penetration' in a certain geographic market to

[7] It is undisputed that neither mark—HANGOUTS or HANGINOUT—is registered with the USPTO. Therefore, neither are presumed valid. *See Tie Tech*, *Inc. v. Kinedyne Corp.*, 296 F.3d 778, 783 (9th Cir. 2002) (stating that registration of a mark carries a "presumption of validity").

establish those trademark rights.").[8] Contrary to Plaintiff's contentions, the Court finds these are two independent determinations—seniority of use and market penetration—both of which must be satisfied in the absence of federal registration.[9]

a. Senior User

"It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services." *Brookfield Commc'ns, Inc. v. W. Coast Entm't Corp*., 174 F.3d 1036, 1047 (9th Cir. 1999). Although seniority of use does not require "evidence of actual sales," *Rearden LLC v. Rearden Commerce*, 683 F.3d 1190, 1205 (9th Cir. 2012), the Ninth Circuit has stated that use of the mark must be "sufficiently public" so that the public identifies the mark with the "adopter of the mark," *Johnny Blastoff*, *Inc. v. L.A. Rams Football Co.*, 188 F.3d 427, 433-34 (9th Cir. 1999). In making this determination, a court may rely on the mark's use and promotion in " 'advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications,' as well as in media outlets such as television and radio." *Id.* at 434 (quoting *T.A.B. Sys. v. Pactel Teletrac*, 77 F.3d 1372, 1375 (Fed. Cir. 1996); *see*

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[8] Hanginout contends that a presumption of nationwide ownership should exist based on Hanginout's pending federal trademark applications. The Court does not agree. *See*, *e.g.*, *CG Roxane LLC v. Fiji Water Co. LLC*, 569 F. Supp. 2d 1019, 1032 (N.D. Cal. 2008) ("[S]ince the defendant was using the mark prior to its registration, plaintiff is not entitled to a presumption that the mark is valid."); *Pollution Denim & Co. v. Pollution Clothing Co.*, 547 F. Supp. 2d 1132, 1139 (C.D. Cal. 2007).

[9] At oral argument, Hanginout suggested that market penetration in a specific geographic area is not required to assert common law trademark rights in the absence of federal registration. The Court does not agree. It is nonsensical that mere advertising or use of a mark in commerce could be enough to enjoin a junior user from using a similar mark anywhere in the United States—priority of use is limited to the geographic area in which the product at issue is sold. *See*, *e.g.*, *Adray*, 76 F.3d at 989 ("The extent of market penetration depends upon the volume of sales, the positive and negative growth trends, the number of people who purchased the party's goods in relation to the number of potential customers, and the amount of advertising."); *Glow*, 252 F. Supp. 2d at 983 ("Generally, the senior user of a mark is entitled to assert trademark rights in all areas in which it has legally sufficient market penetration."); *Optimal Pets*, 877 F. Supp. 2d at 958 ("A party asserting common law rights must not only establish that it is the senior user, it must also show that it has 'legally sufficient market penetration' in a certain geographic market to establish those trademark rights.") (internal citation omitted).

also Brookfield Commc'ns, 174 F.3d at 1036 (stating that trademark rights can vest even before any goods are actually sold if "the totality of [one's] prior actions, taken together, [can] establish a right to use the trademark") (internal quotations and citation omitted).

Under the framework set forth above, Hanginout contends it is the senior user of the mark based on the totality of the circumstances. Hanginout asserts that by March 2010, over a year before Google released Hangouts+ as part of the Google+ platform, and over two years before Google rebranded the platform as purely HANGOUTS, Shawne Meriman shot a HANGINOUT promotional video and Hanginout's company Facebook page was uploaded. Thereafter, by May 2011, nearly two months before Google's release of HANGOUTS+, Hanginout asserts that over 200 consumers registered for and used Version 1.0 of the HANGINOUT Q&A web-based platform. (Doc. No. 12, Malone Decl. ¶ 17.) Hanginout further argues that the marketing campaign for the HANGINOUT platform, all of which utilized the HANGINOUT mark, was aggressively and publicly pursued on a continuous basis beginning in May 2011 via LinedkIn, Twitter, and celebrity YouTube videos.

In opposition, Google contends Hanginout cannot possibly be the senior user of the mark based on Hanginout's own representations to the USPTO. Google argues that on July 12, 2012, more than a year after Google released HANGOUTS, Hanginout filed trademark applications with the USPTO asserting that it first began using the mark in commerce on June 6, 2012.[10] (Doc. No. 14 ¶ 22, Exs. A, B.) Therefore, because Hanginout previously represented to the USPTO that it first began using the mark in commerce on June 6, 2012, but now asserts an earlier "first use" date, Google argues Hanginout must prove the earlier first-use date by clear and convincing evidence. *See Wells Fargo & Co. v. Stagecoach Props., Inc.*, 685 F.2d 302, 304 n.1 (9th Cir. 1982).[11]

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[10] Google contends it was only after it raised this priority of use argument in its first motion to dismiss that Hanginout amended its complaint. (Doc. No. 14 ¶¶ 17–20.)

[11] Both parties agree that under *Wells Fargo v. Stagecoach* a party must present "clear and convincing" evidence to establish a date prior in time than that represented to the USPTO. (Doc. No. 30 at 7:19-23; Doc. No. 36 at 3:9-11.)

Representations to the USPTO aside, Google argues Hanginout's actions fail to establish seniority of use in a nationwide market. Google maintains that similar to *Future Domain Corp. v. Trantor Sys. Ltd.*, No. C930812, 1993 WL 270522, at *8 (N.D. Cal. May 3, 1993), wherein the court found the plaintiff's advertisement at a large trade show was insufficient to establish seniority of use, here, the only evidence Hanginout provides to support its alleged aggressive marketing campaign prior to June 28, 2011 (Google's alleged first use date), are exhibits showing two promotional YouTube videos, Hanginout's company Facebook page, an announcement of the HANGINOUT preview launch on LinkedIn, a brief article in a lesser-known tech-blog called Tech Cocktail, and 48 tweets on Hanginout's company Twitter page. (Doc. No. 12 at 3, Malone Decl. ¶¶ 7, 11, 12, 15–16; Doc. No. 30, Caruso Decl. ¶¶ 4–5, Exs. 2–5.) However, Google contends none of these alleged advertising tactics are noteworthy because the article in Tech Cocktail received no likes, tweets, or shares; the endorsement on Facebook by Tech Cocktail received only two likes (one of which was from the then COO/CFO of Hanginout); the announcement of the preview on LinkedIn received only one like; and Hanginout's Twitter feed shows only 48 tweets before June 28, 2011 (18 of which were from Hanginout). As a result, Google contends Hanginout has failed to provide any evidence that a sufficient number of people actually saw or noticed its promotional efforts.[12]

Although the parties ardently dispute whether Google first began using the HANGOUTS mark in commerce as of June 2011, or whether the use did not commence until May 2013, this argument need not be resolved because the Court finds Hanginout first began using the HANGINOUT mark in commerce in or around May 2011—prior to both of Google's alleged first-use dates.[13] Therefore, because more than 200 customers

[12] Google asserts that Hanginout's promotional YouTube videos were poorly viewed. (Doc. No. 30, Caruso Decl. ¶¶4–5, Exs. 2, 5.)

[13] Because Hanginout's trademark applications stated that the marks were first used in commerce "[a]t least as early as 06/06/2012," the clear and convincing standard set forth in *Wells Fargo* does not apply. (Doc. No. 36, Wagner Decl., Exs. 13, 14.)

had registered for Version 1.0 of Hanginout's web-based platform as of May 2011, which was then followed by continuous advertising and marketing of the platform under the HANGOUTS mark, this case is markedly different from *Future Domain* and *Chance v. Pac-Bel*, both of which were cited by Google. *Future Domain v. Trantor*, No. C930812, 1993 WL 270522, at *6–10 (N.D. Cal May 3, 1993) (stating that the launch of a mark at a single trade show was insufficient to show priority of use); *Chance v. Pac-Bel*, 242 F.3d 1151 (9th Cir. 1988) (finding no priority of use based on postcards that did not generate a single use of services) and, because here, Hanginout has presented evidence of its actual use and marketing of the HANGINOUT mark, in commerce, prior to the first use date of Google's HANGOUTS mark.[14]

Accordingly, the Court finds Hanginout is the senior user of the marks based on the totality of the circumstances—number of registered users, marketing via social media, and launch of iTunes app in the Apple store to name a few. *See Allard Enterprises*, *Inc. v. Advanced Programming Res.*, *Inc.*, 146 F.3d 350, 358 (6th Cir. 1998) ("As long as there is a genuine use of the mark in commerce, however, ownership may be established even if the first uses are not extensive and do not result in deep market penetration or widespread recognition."); *Dep't of Parks & Recreation v. Bazaar del Mundo Inc.*, 448 F.3d 1118, 1126 (9th Cir. 2006) ("Although mere advertising by itself may not establish priority of use, advertising combined with other non-sales activity, under our 'totality of the circumstances test,' can constitute prior use in commerce.") (internal citations omitted).

b. Market Penetration in a Specific Geographic Area

Establishing priority of use however is not in and of itself sufficient to bestow common law trademark rights. To warrant immediate injunctive relief,

[14] The HANGINOUT app had been viewed more than a million times (90% repeat visits) from users in every state in the U.S. (30,000 from California), it enjoyed tens of thousand of users (including high-profile celebrities and politicians), and had substantial media attention (including ESPN). (Doc. No. 12, Malone Decl. ¶¶ 3-5, 9, 11-17, 20, 23, 24, 26, 27, 29-33, Exs. 2-7, 9, 11-12, 14, 15, 17-19.) Hanginout also contends that of the nearly 300 YouTube views, it generated over 200 customers, thereby equating to a 65% conversion ratio.

Hanginout must also establish sufficient market penetration in a specified geographic area. *See Credit One Corp*, 661 F. Supp. 2d at 1138 ("A party asserting common law rights must not only establish that it is the senior user, it must also show that it has 'legally sufficient market penetration' in a certain geographic market to establish those trademark rights."); *Optimal Pets*, 877 F. Supp. 2d at 958 ("The first to use a mark in an area is deemed the 'senior' user and has the right to enjoin 'junior' users from using confusingly similar marks in the same industry and market or within the senior user's natural zone of expansion.").

To determine whether Hanginout has market penetration in an identified geographic area, the court considers: (1) the volume of Hanginout's sales with regard to the product at issue; (2) the growth trends of the product both positive and negative; (3) the number of persons actually purchasing/registering for the pertinent product in relation to the total number of potential customers; and (4) the amount of advertising with the regard to the product at issue. *See Adray*, 76 F.3d at 989 (9th Cir. 1995); *Optimal Pets*, 877 F. Supp. 2d at 958. Thereafter, and only if Hanginout can establish market penetration in a specific geographic area, the Court must then assess whether Hanginout may preclude Google from utilizing the mark within Hanginout's "natural zone of expansion." *Optimal Pets*, 877 F. Supp. 2d at 958; 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, § 26:13 (4th ed. 2002) (stating that "in the absence of federal registration, both parties have the right to expand [use of an unregistered mark] into unoccupied territory and establish exclusive rights by being first in that territory. In effect, it is a race between the parties to establish customer recognition in unoccupied territory.").

Here, Hanginout urges the Court to find that its market penetration is either nationwide, or Southern California with a nationwide zone of expansion. In support, Hanginout asserts that: (1) it had a Facebook profile by March 2011; (2) by May 2011,over 200 consumers had registered for and used Version 1.0 of the HANGINOUT web-based platform; (3) from September 15, 2012 through December 23, 2013 the

HANGINOUT smart phone application had 30,000 visits from California[15] consumers, 7,000 visits from New York consumers, 3,500 visits from Florida consumers, 2,700 visits from Michigan consumers, 2,600 visits from Texas consumers, and a ranging number of visits from consumers in the remaining states; (4) nearly 8,000 individuals had registered for the HANGINOUT iTunes application by the filing of the preliminary injunction; and (5) various celebrities and politicians have created HANGINOUT accounts and published content utilizing the HANGINOUT platform. (Doc. No. 12 at 10–11; Malone Decl. ¶¶ 10, 20, 17, 32, Exs. 9, 19.) Therefore, Hanginout contends that because it offered and marketed its computer-based services under the HANGINOUT mark via its website and iTunes application, its customers, and therefore its market penetration, is nationwide.

In response, Google contends Hanginout has failed to submit any evidence of its actual market penetration in a specific area, and use of a mark over the Internet does not automatically implicate a nationwide market. In support, Google relies on *Glow Indus., Inc. v. Lopez*, 252 F. Supp. 2d 962, 984 (C.D. Cal. 2002) (finding no market penetration because the plaintiff had presented no evidence of the "volume or level of sales in any location, nor how [the plaintiff's] market penetration compares with that of competitors"); *Credit One Corp. v. Credit One Fin., Inc*., 661 F. Supp. 2d 1134, 1137 (C.D. Cal. 2009) (stating that the plaintiff failed to show market penetration in areas where an office had closed and there was no basis for which to believe sales had occurred); and *Optimal Pets*, 877 F. Supp. 2d 953, 962 (C.D. Cal. 2012) (finding no market penetration because the plaintiff had no sales in 34 states, in 8 of the 16 states where there were sales

[15] The California data can be further broken down as follows: Los Angeles (4,456 visits), Carlsbad (4,191 visits), and San Diego (3,726 visits). (Doc. No. 12, Malone Decl. ¶ 45, Ex. 28.)

those sales were under $80, and the two states with "big ticket" sales all originated in a single zip code).[16]

The Court finds the cases relied upon by Google instructive, and Hanginout's failure to present any evidence as to the actual location of its registered users dispositive. First, with regard to total sales, or in this case registered users, although Hanginout represented that it had over 200 registered users of its web-based platform as of May 2011, and nearly 8,000 registered users of its iTunes application as of the filing of the preliminary injunction, Hanginout has never identified the state of residence of these alleged registered users.[17] *See Optimal Pets*, 877 F. Supp. 2d at 962 ("Thus, a sale to a customer through the internet will be considered a sale in the geographical area in which the customer is located.").[18] Hanginout's evidence of "site visits" fairs no better.[19] Although this evidence pins down the state (and city within California) of the consumer that viewed Hanginout's mobile profile, the Court is at a loss as to how these statistics

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[16] The *Optimal Pets* court further noted that there was a "downward trend" in sales, no evidence of "actual vis-á-vis potential purchasers," and no evidence of "continued" marketing or advertising from 2004 through 2008. *Id.* at 963–64.

[17] Hanginout conceded this point at oral argument, stating that they are not required to identify the location of their users to attain common law trademark rights. As stated below, the Court does not agree, and finds the location of Hanginout's users key to fashioning an injunction.

[18] Hanginout provided a print-out from Apple to document the total number of individuals who registered for the HANGINOUT iTunes application in 2012 and 2013. (Doc. No. 12, Malone Decl., Ex. 28.) However, this document shows that of the 9,534 individuals who downloaded the application in 2012, only 6,926 resided in the United States; and of the 2,306 individuals who downloaded the application in 2013, only 1,235 resided in the United States. (*Id.*) The document never specifies the specific geographic residence within the United States of each registered user. (*Id.*) Furthermore, Hanginout did not provide any evidence, other than the Malone Declaration, of the 200 users that registered for its web-based platform in May 2011. (*Id.*)

[19] Hanginout attached a Google Analytic Report showing that between September 15, 2015 and December 23, 2012, 61,601 total individuals visited/clicked on HANGINOUT Mobile. (Doc. No. 12, Malone Decl., Ex. 17.) This information further breaks down the number of visits between and among the various states in the United States, showing visits from every state with the highest number of visits from California (29,985), New York (7,056), Florida (3,506), Michigan (2,701), Texas (2,629), Colorado (1,283), and Illinois (1,094). (Doc. No. 12, Malone Decl., Ex. 19.) Although the total number of visits is 71,503, the Court disregards visits from individuals outside the United States.

identify the location of Hanginout's registered users. Therefore, although evidence of site visits shows that consumers are actually looking at Hanginout's website and/or products, and supports Hanginout's seniority of use argument, it is insufficient to show actual sales/registration for Hanginout's product necessary to establish market penetration.

Second, with regard to actual growth trends of the product at issue, although Hanginout never specifically commented on this factor, the Court finds the evidence submitted by Hanginout speaks for itself. For example, the Google Analytic Audience Overview report shows a dramatic decline in the overall number of views of the HANGINOUT application, with the number of visits the highest in or around October 2012, then nearly flat-lining in or around October 2013. (Doc. No. 12, Malone Decl., Ex. 17.) This analysis is then confirmed by sales statistics that were reported to Hanginout by iTunes. (Doc. No. 12, Malone Decl., Ex. 28.) These sales reports indicate that 6,926 individuals downloaded the HANGINOUT application in 2012, and that 1,235 individuals downloaded the HANGINOUT application in 2013. (*Id*.) This represents a 82.17% decline in the number of registered users, or 5,691 fewer registered users from 2012 to 2013. (*Id*.) Therefore, based on these statistics, all of which were produced by Hanginout, there appears to be a negative growth trend for the HANGINOUT product. *See Optimal Pets*, 877 F. Supp. 2d at 963.

Third, with regard to the actual number of consumers actually purchasing/registering for the product in relation to the total number of potential consumers, Hanginout once again did not produce or direct the Court to any evidence indicative of this factor. Instead, the only evidence the Court is left to consider is that 6,926 individuals registered for the HANGINOUT iTunes application in 2012, 1,235 individuals registered for the HANGINOUT iTunes Application in 2013, and that 61,601 individuals viewed HANGINOUT Mobile between September 2012 and December 23, 2013. However, as these numbers do not directly overlap, nor did Hanginout present any

evidence regarding its market share, this weighs against finding Hanginout had sufficient market penetration to warrant immediate injunctive relief.

However, with regard to marketing and advertising, Hanginout fares much better. Hanginout contends that as early as 2009, it began utilizing various means to market and advertise the HANGINOUT web-based platform. For example, Hanginout asserts that by March 2010, it began partnering with celebrities and professional athletes to create HANGINOUT profiles for their interactive social-media platforms. These individuals included Kassim Osgoode (NFL), Shawne Meriman (NFL), Ritchie Brusco (X-Games), DJ Chuckie (DJ), Eric Griggs (Music Producer), Miles McPhereson (Pastor at the Rock Church and former NFL player), Mike Hill (ESPN), Daphne Joy (Actress/Model), Jessica Burciaga (Model), Amanda Cerny (Model), Da Internez (Music Producers), and Belmont Lights (Band). (Doc. No. 12, Malone Decl. ¶ 10, Ex. 2.) Hanginout further contends that these efforts were supplemented by announcements on Twitter, LinkedIn, and the release of YouTube videos detailing key elements of the HANGINOUT platform. (Doc. No. 12, Malone Decl. ¶¶ 11, 13-14.) Thereafter, on October 24, 2011, San Diego mayoral candidate Carl DeMaio utilized HANGINOUT to create a "virtual town hall" for his campaign, and on July 6, 2012, professional skateboarder Ritchie Brusco launched an application utilizing the HANGINOUT platform. (*Id*. at ¶ 22, Ex. 11.) Hanginout further contends that ESPN ran an article about the Brusco application in conjunction with the upcoming X-Games, (*Id.* at ¶ 23, Ex. 12), and that on September 16, 2012, Hanginout officially launched a HANGINOUT application in the iTunes App store and Apple elected to feature the HANGINOUT app as one of its social-media based applications. (*Id*. at ¶ 24.)

Although the Court finds the evidence presented above exemplifies Hanginout's marketing and intent to use the HANGINOUT mark in commerce, none of the evidence is sufficient to support a finding of market penetration in a specific geographic market. Therefore, because marketing and advertising is but one factor to consider in determining market penetration of an unregistered mark, without evidence as to the actual

location of Hanginout's registered users, the Court cannot determine Hanginout's market penetration. *See Charles Jacquin Et Cie*, *Inc. v. Destileria Serralles*, *Inc*., 921 F.2d 467, 472 (3d Cir. 1990) ("The proper geographic scope of an injunction in a trademark infringement case is determined by examining the market penetration of the mark."). Accordingly, although the Court is cognizant of the complexities posed by the use of Internet, the Court does not agree with Hanginout that marketing, advertising, and promoting an unregistered mark over the Internet is sufficient to find nationwide market penetration. The Court also does not agree with Hanginout that it has sufficient market penetration in Southern California by virtue of the location of its office and/or the number of site views originating out of Southern California.

As a result, the Court finds Hanginout had not presented sufficient evidence to permit the Court to determine its market penetration in a specific geographic area, and as a result, the Court need not consider Hanginout's natural zone of expansion. *See*, *e.g.*, *Optimal Pets*, 877 F. Supp. 2d at 962 (quoting Brian L. Berlandi, What State Am I In?: Common Law Trademarks on the Internet, 4 Mich. Telecomm. & Tech. L. Rev. 105, 123–24 (1998) ("[T]he limits of territorial protection for a common law mark become much more difficult to define once that mark is placed on the Internet . . . mostly due to the apparent lack of 'boundaries' on the Internet."); *Echo Drain v. Newsted*, 307 F. Supp. 2d 1116, 1128 (C.D. Cal. 2003) ("Although Echo Drain has a website, Echo Drain offers no evidence that people outside of the Dallas–Fort Worth area have accessed the website, downloaded performances from the website, or even posted messages to the website."); *Pure Imagination*, *Inc. v. Pure Imagination Studios*, *Inc*., No. 03 C 6070, 2004 WL 2967446, at *12 (N.D. Ill. Nov. 15, 2004) ("Studios has failed to offer any specificity as to its activity in any markets in which it alleges priority rights."); *Alliance for the Wild Rockies v. Cottrell*, 632 F.3d 1127, 1131 (9th Cir. 2011) ("A preliminary

injunction is an extraordinary remedy never awarded as of right.") (internal citations omitted).[20]

ii. Likelihood of Confusion

Although the Court has determined that Hanginout has not shown market penetration in a specific geographic area, the Court will nonetheless examine whether Google's use of the HANGOUTS mark will likely confuse the consuming public as to the source of the parties' products. A court considers eight factors to determine if there is a likelihood of confusion:

> (1) strength of the mark, (2) proximity of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) type of goods and the degree of care likely to be exercised by the purchaser, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.

AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348–49 (9th Cir. 1979).

A court need not address all eight factors, nor must the plaintiff establish that each weighs in its favor to establish a likelihood of confusion. *See C & C Org. v. AGDS*, *Inc*., 676 F. Supp. 204, 206 (C.D. Cal. 1987); *Network Automation, Inc. v. Advanced Sys. Concepts*, *Inc*., 638 F.3d 1137, 1145 (9th Cir. 2011) ("The Sleekcraft factors are intended as an adaptable proxy for consumer confusion, not a rote checklist."); *Dreamwerks Prod. Grp.*, *Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998) ("The factors should not be rigidly weighed; we do not count beans."); *Eclipse Assoc. Ltd. v. Data Gen. Corp*., 894 F.2d 1114, 1118 (9th Cir.1990) ("These tests were not meant to be requirements or hoops that a district court need jump through to make the determination."). The Court addresses the *Sleekcraft* factors in the order presented by Hanginout.

a. Proximity or Relatedness of the Goods

"Related goods are those 'products which would be reasonably thought by the buying public to come from the same source if sold under the same mark.' " *Sleekcraft*,

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[20] The Court finds Hanginout's citation to *Taylor v. Thomas*, No. 2:12-CV-02309-JPM, 2013 WL 228033, (W.D. Tenn. Jan. 22, 2013) unavailing. The issue in *Taylor* was not whether the plaintiff had established sufficient use in a particular market, but whether ownership of a mark could be based on an assignment.

599 F.2d at 348, n.10 (quoting *Standard Brands*, *Inc. v. Smidler*, 151 F.2d 34, 37 (2d Cir. 1945)); *see also* 4 J. McCarthy, McCarthy on Trademarks and Unfair Competition, § 24.24 (4th ed. 2002) ("Goods are 'related' if consumers are likely to mistakenly think that the infringer's goods come from the same source as the senior user's goods or are sponsored or approved by the senior user."). "[T]he danger presented is that the public will mistakenly assume there is an association between the producers of the related goods, though no such association exists." *Sleekcraft*, 599 F.2d at 350. Proximity of goods is measured by whether the products are: (1) complementary; (2) sold to the same class of purchasers; and (3) similar in use and function. *Id.*

Hanginout contends the products offered by Hanginout and Google directly overlap because they are both social-media based platforms offering the same services through the iTunes app store. To support this contention, Hanginout compares its pending trademark application, which lists computer application software, telecommunication services, audio, text, and video broadcasting, electronic messaging services, and providing online forums for communication as the marks uses, with information obtained from Google's website, wherein Google describes the HANGOUTS Q&A platform as allowing users to solicit questions from concurrent viewers, select and answer live questions, and timestamp a YouTube recording by marking questions as they are answered.

In opposition, Google contends that although the products contain some similar functions within the broad category of video communications, the purposes and functions of the products are neither identical nor interchangeable. For example, whereas HANGOUTS allows real-time, live video-conferencing, instant messaging, and other communications among multiple parties, HANGINOUT is merely a platform for posting and viewing pre-recorded video messages or video profiles. Furthermore, Google maintains that contrary to Hanginout's contentions, there is no such thing as the HANGOUTS Q&A application, instead HANGOUTS Q&A is a feature of Google's HANGOUTS ON AIR, which the host can turn on or off. Therefore, because the Q&A feature

is only related to HANGOUTS ON AIR, which is not the basis of this litigation, Google argues the Q&A feature of HANGOUTS ON AIR is irrelevant.

Although the Court finds Google and Hanginout offer similar products under the HANGOUTS and HANGINOUT marks, the Court finds the products have distinct differences that change the functionality of the products. Therefore, because Hanginout did not respond to Google's contention that the products are necessarily different based on the fact that HANGOUTS offers real-time capabilities whereas HANGINOUT only offers pre-recorded messaging and video features, this factor does not weigh in favor of finding a likelihood of confusion.

b. Similarity of the Marks

"[T]he more similar the marks in terms of appearance, sound, and meaning, the greater the likelihood of confusion." *Brookfield*, 174 F.3d at 1054. "Where the two marks are entirely dissimilar, there is no likelihood of confusion." *Id*. "Similarity of the marks is tested on three levels: sight, sound, and meaning. Each must be considered as they are encountered in the marketplace." *Sleekcraft*, 599 F.2d at 351 (citations omitted).

Here, Hanginout contends that the marks at issue—HANGINOUT and HANGOUTS—are nearly identical in sight, sound, and meaning, and therefore, this factor weighs in favor of finding a likelihood of confusion. *See*, *e.g. Banff*, *Ltd. v. Federated Dep't Stores, Inc*., 841 F.2d 486, 491 (2d Cir. 1988) (finding a likelihood of confusion between B WEAR and BEE WEAR for women's clothing); *Baker v. Simmons Co.*, 307 F.2d 458, 465 (1st. Cir. 1962) (finding SIMMONS and SIMMONS essentially identical in sound). As would be expected, Google does not agree. Instead, Google maintains the marks are significantly different because unlike *Banff* and *Baker*, the two decisions cited by Hanginout, the marks are not phonetically identical. Google argues that whereas HANGOUTS has two syllables, is plural, and is a noun; HANGINOUT has three syllables, is singular, and describes an activity. These nonsensical arguments aside, Google argues that given the actual appearance of the marks in commerce, in that the

Google name appears next to or close to any reference to HANGOUTS, no consumer is likely to be confused as to the product's origin.

Although the Court finds Google's final contention persuasive, in that marks must be considered as they will be encountered in the marketplace, *Lindy Pen Co.*, *v. Bic Pen Corp*., 725 F.2d 1240, 1245 (9th Cir. 1984), the Court also finds that the marks are relatively similar in sight, sound, and meaning. Thus, although the marks have different design features associated with the words that define them, courts have found that where a trademark includes a combination of words and a design, "the word is normally accorded greater weight[] because it would be used by purchasers to request the goods." *L.C. Licensing*, *Inc. v. Cary Berman*, 86 U.S.P.Q.2d 1883, 2008 WL 835278, at *3 (T.T.A.B. 2008); *see also Herbko Int'l v. Kappa Books*, 308 F.3d 1156, 1165 (Fed. Cir. 2002) ("The words dominate the design feature."). Accordingly, although Hanginout has not presented any evidence of actual consumer confusion (as detailed below), the Court finds this factor weighs slightly in favor of Hanginout.

c. Marketing Channels Used

"Convergent marketing channels increase the likelihood of confusion." *Sleekcraft*, 599 F.2d at 353 (finding that confusion is likely due to the fact that both parties advertised in niche markets, including boat shows, speciality retail outlets, and trade magazines). "However, this factor becomes less important when the marketing channel is less obscure." *Network Automation, Inc. v. Advanced Sys. Concepts*, *Inc.*, 638 F.3d 1137, 1151 (9th Cir. 2011). Where both parties utilize the Internet to market the products at issue, the Ninth Circuit has found this factor carries little weight in the likelihood of confusion calculation. *See Playboy Enters.*, *Inc. v. Netscape Commc'ns Corp*., 354 F.3d 1020, 1028 (9th Cir. 2004) ("Given the broad use of the Internet today, the same could be said for countless companies. Thus, this factor merits little weight.").

Here, although Hanginout urges the Court to find that this factor weighs in favor of finding a likelihood of consumer confusion because there is a limited number of iTunes app store applications, the Court finds *Network Automation* and *Playboy* control-

ling. Therefore, Google and Hanginout's shared use of the Internet and iTunes app store to market their respective products weighs against a likelihood of confusion.

d. Strength of the Plaintiff's Mark

"The stronger a mark—meaning the more likely it is to be remembered and associated in the public mind with the mark's owner—the greater the protection it is accorded by the trademark laws." *Brookfield*, 174 F.3d at 1058. Strength of a given mark is determined by measuring conceptual strength and commercial strength. *Network Automation*, 638 F.3d at 1149. "Conceptual strength involves classification of a mark 'along a spectrum of generally increasing inherent distinctiveness as generic, descriptive, suggestive, arbitrary, or fanciful.' " *Id*. (quoting *Brookfield*, 174 F.3d at 1058). "A mark's conceptual strength depends largely on the obviousness of its connection to the good or service to which it refers." *Fortune Dynamic*, *Inc. v. Victoria's Secret Stores Brand Mgmt.*, *Inc*., 618 F.3d 1025, 1032–33 (9th Cir. 2010). Once a mark has been placed on the conceptual strength spectrum, the court must then assess the marks commercial strength, i.e., whether the mark has actual "marketplace recognition." *Brookfield*, 174 F.3d at 1058 (stating that large advertising expenditures can transform a suggestive mark into a strong mark).[21]

Hanginout contends its marks are suggestive, if not stronger, because a "mental leap" is required to get from the term HANGINOUT to the product's features. *See Network Automation*, 638 F.3d at 1149 ("If a mental leap between the word and the product's attribute is not almost instantaneous, this strongly indicates suggestiveness, not direct descriptiveness."). Hanginout further argues that Google has admitted that the HANGINOUT mark is inherently distinctive because Google identified the mark on its trademark list as "HanginoutTM Messaging Service."[22] However, besides these two points, Hanginout does not address either marks commercial strength. In opposition,

[21] Hanginout confirmed at oral argument that this is not a reverse confusion case, which would necessitate a different analysis.

[22] Hanginout argues that designating a mark with a TM is an admission that the mark is distinctive.

Google asserts that the HANGINOUT mark is weak and the HANGOUTS mark is strong, which can be exemplified by the market penetration and actual use of the respective marks. Google further argues that Hanginout has an erroneous understanding of the meaning of the TM symbol, in that the symbol reflects common law trademark rights not inherent distinctiveness.

The Court finds it telling that Hanginout failed to identify or discuss the commercial strength of the HANGINOUT mark, which is key to determining whether Google's marketing and advertising has resulted in a "saturation in the public awareness of [Hanginout's] mark," thereby reducing Hanginout's marketplace recognition. *A & H Sportswear*, *Inc. v. Victoria's Secret Stores*, *Inc*., 237 F.3d 198, 231 (3d Cir. 2000). However, based on the evidence presented to the Court, it is apparent that Google has spent substantial time and substantial monies developing and promoting HANGOUTS, which has an installed base of millions of users.[23] Google has further represented that the HANGOUTS product has been featured by prominent magazines and websites, and that Google has invested substantial resources in media costs for advertising.[24] In contrast, Hanginout has failed to present any evidence as to the amount of money expended to develop, market, and/or promote HANGINOUT, and the only evidence of Hanginout's growth trends shows a 82% drop in the number of individuals who registered for the HANGINOUT iTunes application from 2012 to 2013.

Therefore, although the parties ardently dispute the marketplace recognition of their respective products, seemingly engaging in a popularity contest based on who utilized their products (Dalai Lama for Google and Shawne Merrriman for Hanginout), the Court finds Google is likely to overwhelm Hanginout's product line if the products are in competition with one another in the market due to Google's marketplace recognition. *See Cohn v. Petsmart*, *Inc.*, 281 F.3d 837, 841 (9th Cir. 2002) ("Petsmart's extensive advertising gives it the ability to overwhelm any public recognition and

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[23] For exact figures see Google's sealed opposition. (Doc. No. 34 at 1:20-25.)

[24] For exact figures see Google's sealed opposition. (Doc. No. 34 at 23-24.)

goodwill that Cohn has developed in the mark."). However, because the parties did not present any evidence as to how crowded the market actually is, and Hanginout cannot claim a right to all variants of the phrase in the given market, this factor does not weigh in favor of finding a likelihood of consumer confusion. *See SunEarth, Inc. v. Sun Earth Solar Power Co., Ltd.*, 846 F. Supp. 2d 1063, 1078 (N.D. Cal. 2012), appeal dismissed (Apr. 18, 2012) (recognizing that where the marks share a word or phrase but are otherwise different, the plaintiff is not permitted to claim a right to all variant of the phrase in a specific market).

e. Evidence of Actual Confusion

"[A] showing of actual confusion among significant numbers of consumers provides strong support for the likelihood of confusion." *Playboy*, 354 F.3d at 1026 (citing *Thane Int'l, Inc. v. Trek Bicycle Corp.*, 305 F.3d 894, 902 (9th Cir. 2002)) ("Evidence of actual confusion constitutes persuasive proof that future confusion is likely . . . If enough people have been actually confused, then a likelihood that people are confused is established."). "Actual confusion is not necessary to a finding of likelihood of confusion under the Lanham Act." *Academy of Motion Picture Arts & Sciences v. Creative House Promotions, Inc.*, 944 F.2d 1446, 1456 (9th Cir. 1991) (citing *Am. Int'l Grp., Inc. v. Am. Int'l Bank*, 926 F.2d 829, 832 (9th Cir. 1991)). Indeed, "[p]roving actual confusion is difficult . . . and the courts have often discounted such evidence because it was unclear or insubstantial." *Sleekcraft*, 599 F.2d at 352.

Here, Hanginout tries to articulate a basis for actual confusion when none in fact exists. Therefore, the Court finds this factor should be accorded no weight.[25] *See Network Automation*, 638 F.3d at 1151 ("Therefore, while this is a relevant factor for determining the likelihood of confusion in keyword advertising cases, its importance is diminished at the preliminary injunction stage of the proceedings."); *Rearden*, 597 F.

[25] Hanginout's only evidence of actual confusion is that consumers have used the phrase "Hanging out" and "Hangout" when referring to the HANGINOUT platform. However, Hanginout does not connect these references to Google's HANGOUTS mark. (Doc. No. 12 at 20:18-23.)

Supp. 2d at 1023, 1023 n.9 (stating that, while courts outside of the Ninth Circuit may consider confusion by others relevant, the Ninth Circuit's "precedents clearly hold that the key inquiry is confusion of prospective purchasers").

f. Degree of Care Likely Exercised by Purchasers

"Low consumer care . . . increases the likelihood of confusion." *Playboy*, 354 F.3d at 1028. "In assessing the likelihood of confusion to the public, the standard used by the courts is the typical buyer exercising ordinary caution . . . . When the buyer has expertise in the field, a higher standard is proper though it will not preclude a finding that confusion is likely. Similarly, when the goods are expensive, the buyer can be expected to exercise greater care in his purchases; again, though, confusion may still be likely." *Sleekcraft*, 599 F.2d at 353 (citations omitted).

Here, Hanginout argues that because the products at issue are inexpensive (or for that matter free), it is likely that consumers are likely to register for the products without doing significant investigation. In opposition, Google contends that Hanginout has presented no evidence of the degree of sophistication of its customers, and that such an inference can not be made purely on the basis that the products are offered free of charge. Google also contends that because consumers will most likely select a product that their friends, family, and/or acquaintances are also using (or will be using), this factor does not automatically weigh in favor of Hanginout. Finally, Google contends that because viruses and spyware can potentially be included in free software, it cannot be assumed that the average consumer takes minimal care in downloading free software.

Although Google's final point is without merit, as Apple pre-screens all applications offered on the iTunes app store (either free or at a cost), the Court finds Google's first two points raise valid arguments. As recently explained by the Ninth Circuit in *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1176 (9th Cir. 2010), when examining consumer confusion in the context of products offered over the Internet, the "relevant marketplace is the online marketplace, and the relevant consumer is a reasonably prudent consumer accustomed to shopping online . . . . Unreasonable, imprudent

and inexperienced web-shoppers are not relevant." *Id.* As a result, although it is true that courts originally presumed a low degree of care exercised by Internet consumers, the Ninth Circuit has cautioned against such a conclusory analysis and instructed lower courts to consider the "nature and the cost of the goods, and whether the products being sold are marketed primarily to expert buyers." *See Network Automation*, 638 F.3d at 1152 (citing *Brookfield*, 174 F.3d at 1060).

Accordingly, taking all of these factors into consideration: (1) the heightened degree of care of Internet consumers; (2) the fact that both products are offered free of charge; and (3) the fact that the applications offered via the iTunes app store indicated the source of the application, i.e., whether the application was offered by Google or Hanginout, the Court finds Hanginout has not presented sufficient evidence to support a finding that this factor weighs in favor of a likelihood of confusion.

g. Intent

"When the alleged infringer knowingly adopts a mark similar to another's, reviewing courts presume that the defendant can accomplish his purpose: that is, that the public will be deceived." *Sleekcraft*, 599 F.2d at 354. However, the Ninth Circuit has cautioned lower courts that this factor must be considered in light of whether the defendant's use of the trademark was to mislead consumers rather than truthfully inform them of their choice of products. *See Network Automation*, 638 F.3d 1153.

Hanginout contends Google intentionally adopted the HANGOUTS mark with full knowledge of the HANGINOUT mark because Google received the suspension notice from the USPTO of their trademark application on July 30, 2013, but nevertheless proceeded to launch the HANGOUTS iTunes application on September 12, 2013. Hanginout further argues that considering the shear size of Google, and the number of researchers, employees, and attorneys that work for Google, it seems highly improbable that Google had no knowledge of the HANGINOUT mark prior to releasing its HANGOUTS iTunes application. In response, Google contends that its actions are not automatically indicative of bad faith because even after the USPTO alerted it of the existence of

Hanginout's pending trademark application in July 2013, it nonetheless believed it had superior common law rights and intended to challenge the mark.

Although the date Google submitted its trademark application for HANGOUTS closely correlates with the date Hanginout successfully had a third-party mark for HANGOUTS suspended due to lack of use, the Court does not find that Google adopted the HANGOUTS mark with the intent to deceive consumers. Thus, to the extent Google believed it had superior common law trademark rights, the Court finds this fact does not weigh in favor of finding a likelihood of confusion. *See SecuraComm Consulting*, *Inc. v. Securacom Inc*., 166 F.3d 182, 188 (3d Cir. 1999)

h. Likelihood of Expansion of the Product Line

"In asmuch as a trademark owner is afforded greater protection against competing goods, a 'strong possibility' that either party may expand his business to compete with the other will weigh in favor of finding that the present use is infringing. When goods are closely related, any expansion is likely to result in direct competition." *Sleekcraft*, 599 F.2d at 354 (citations omitted). However, where two companies "already compete to a significant extent," this factor is unimportant. *Brookfield*, 174 F.3d at 1060; *See Network Automation*, 638 F.3d 1153.

Hanginout contends that Google intends to directly compete with Hanginout in the social-media arena, and therefore, expansion is an established fact. In opposition, Google contends that Hanginout's assertions should be afforded little weight because Hanginout has failed to present any evidence that either Google or Hanginout plans to expand into a different product areas. *See Instant Media, Inc. v. Microsoft Corp*., No. C 07-02639 SBA, 2007 WL 2318948, at * 17 (N.D. Cal. Aug. 13, 2007) ("Nevertheless, in the absence of any concrete evidence that Microsoft plans to use the i'm mark in connection with the sort of product that would compete with the I'M player, this factor weighs slightly in Microsoft's favor.").

The Court agrees with Google that Hanginout has failed to present any evidence that it plans to expand into real-time video conferencing and messaging services, thereby

merging into and offering services/products in competition with Google. As a result, the Court finds this factor neither weighs in favor or against a finding of likelihood of consumer confusion.

Accordingly, after taking all the *Sleekcraft* factors into consideration, the Court finds Hanginout has failed to show that consumers will likely be confused by the two products at issue based on the evidence presently before the Court. This determination was made with special consideration to: (1) the strength of the marks; (2) evidence of actual confusion; (3) the type of goods and degree of care likely to be exercised by the purchaser; and (4) the labeling and appearance of the marks when offered to consumers through the iTunes app store.

2. Irreparable Harm

In addition to the factors outlined above, a plaintiff must establish irreparable harm to be entitled to immediate injunctive relief, i.e., that the plaintiff is unlikely to be made whole by an award of monetary damages or some other legal remedy within the ordinary course of litigation.[26] *See Am. Trucking Associations*, 559 F.3d at 1059. Speculative future harm is insufficient. *See Herb Reed Enters.*, 736 F.3d at 1250 (stating that the record below failed to support a finding of irreparable harm in the absence of evidence that such harm was likely rather than speculative); *see also Mortgage Elec. Registration Sys. v. Brosnan*, No. C 09-3600, 2009 WL 3647125, at *8, (N.D. Cal. Sept. 4, 2009) (citing *Stuhlbarg Intern. Sales Co., Inc. v. John D. Brush and Co., Inc.*, 240 F.3d 832, 841 (9th Cir. 2001)) ("The potential loss of good will or the loss of the ability to control one's reputation may constitute irreparable harm for purposes of preliminary injunctive relief."). Moreover, where there is a delay in time between the defendant's

[26] Although the standard for issuing a preliminary injunction in the trademark context previously presumed irreparable injury if the moving party showed a likelihood of success on the merits, district courts in this circuit have found the presumption no longer applicable. *See, e.g., Jumbo Bright Trading Ltd. v. Gap, Inc.*, No. CV12–8932, 2012 WL 5289784, at *1 (C.D. Cal. Oct. 25, 2012) ("As far as this court is aware, every district court in the Ninth Circuit that has examined the issue after *Flexible Lifeline* . . . has either found or at least suggested that irreparable harm cannot be presumed in trademark cases as well.") (collecting cases).

first alleged infringing use and the plaintiff's filing of the preliminary injunction, courts have found that a "lack of urgency" weighs against finding irreparable harm. *Oakland Tribune*, *Inc. v. Chronicle Publ'g Co.*, 762 F.2d 1374, 1377 (9th Cir. 1985); *see also Playboy Enters.*, *Inc. v. Netscape Commc'ns Corp.*, 55 F. Supp. 2d 1070, 1090 (C.D. Cal. 1999) ("[Plaintiff]'s [five-month] delay in seeking injunctive relief further demonstrates the lack of any irreparable harm.") *aff'd*, 202 F.3d 278 (9th Cir. 1999); *Valeo Intellectual Prop.*, *Inc. v. Data Dep't Corp.*, 368 F. Supp. 2d 1121, 1128 (W.D. Wash. 2005) ("A three-month delay in seeking injunctive relief is inconsistent with [plaintiff]'s insistence that it faces irreparable harm.").

In the present case, Hanginout argues that it will suffer irreparable harm if an injunction does not issue because: (1) Google will continue to exploit Hanginout's goodwill; (2) Hanginout will lose the ability to police and control its brand and pending trademark applications; and (3) actual confusion, not just a likelihood of confusion, is already occurring. In opposition, Google contends any irreparable harm Hanginout alleges has or will continue to occur is displaced by Hanginout's failure to commence this litigation, or file the pending motion for preliminary injunctive relief, soon after it learned of Google's alleged infringing conduct. As a result, because Google first announced the release of HANGOUTS on June 28, 2011, but Hanginout did not file the instant litigation until November 26, 2013 (approximately 29 months later), or the pending motion for preliminary injunction until January 22, 2014 (approximately 31 months later), Hanginout's lack of urgency weighs against irreparable harm. Finally, Google contends that Hanginout has failed to offer any evidence that: (1) it has experienced a decline in customers/goodwill or that such a decline is likely; (2) that actual consumer confusion has occurred; and/or (3) that any immediate threatened injury exists.

Whether the Court considers Google's first-use date as of June 28, 2011 or May 2013 is irrelevant. Hanginout still waited anywhere between 29 months (June 2011) to 7 months (May 2013) before initiating the instant litigation, and even longer before filing the instant motion for preliminary injunctive relief. Some courts have found a delay

shorter than this—7 months—on its own, sufficient to weigh against a finding of irreparable harm. *See*, *e.g.*, *Edge Games*, *Inc. v. Elec. Arts*, *Inc.*, 745 F. Supp. 2d 1101, 1117–18 (N.D. Cal. 2010) ("The undisputed fact that plaintiff did not timely act to prevent the "Mirror's Edge" franchise from inundating the market is *alone* sufficient to deny the instant motion.") (alteration in original); *Playboy Enters.*, 55 F. Supp. 2d at 1090 (C.D. Cal. 1999) (stating the five month delay weighed against a finding of irreparable harm); *Valeo Intellectual Prop.*, 368 F. Supp. 2d at 1128 (stating that three month delay was inconsistent with a finding of irreparable harm). The Court also finds Hanginout's contention, raised at oral argument, that they did not file sooner because they did not believe Google intended to use the mark without merit.

Finally, even if the Court found the delay excusable, which is does not, Hanginout has failed to present any evidence that it has experienced a decline in customers or goodwill that occurred as a result of actual customer confusion. Allegations that the plaintiff has invested resources in developing its brand and that the alleged infringing conduct is denying the plaintiff the benefit of its investment is insufficient. *See Mytee Prods.*, *Inc. v. Shop Vac Corp.*, No. 13CV1610 BTM BGS, 2013 WL 5945060, at *6–7 (S.D. Cal. Nov. 4, 2013) ("Plaintiff has failed to establish that Defendant is causing irreparable harm that cannot be cured by money damages."). Accordingly, the Court finds Hanginout has failed to produce "probative, nonspeculative evidence" that it has "lost, or will likely lose, prospective customers or goodwill due to" Goggle's alleged infringing conduct. *Spiraledge*, *Inc. v. SeaWorld Entm't*, *Inc.*, No. 13 CV296-WQH-BLM, 2013 WL 3467435, at *4 (S.D. Cal. July 9, 2013); *see also ConocoPhillips Co. v. Gonzalez*, No. 5:12-CV-00576-LHK, 2012 WL 538266 (N.D. Cal. Feb. 17, 2012) (stating that if the "Plaintiff could wait eight months since becoming aware of the alleged trademark infringement before filing its ex parte application . . . Plaintiff can wait until Defendant has an opportunity to be heard").

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3. Balance of Equities and the Public Interest

Finally, the Court finds the remaining two factors—balance of equities and public interest—also weigh in favor of denying Hanginouts's request for injunctive relief. In the trademark context, courts often define the public interest as the right of the public not to be deceived or confused. *See*, *e.g.*, *Moroccanoil*, *Inc. v. Moroccan Gold*, *LLC*, 590 F. Supp. 2d 1271, 1282 (C.D. Cal. 2008); *Davidoff & Cie*, *S.A. v. PLD Int'l Corp*., 263 F.3d 1297, 1304 (11th Cir. 2001) (noting the public interest is served by avoiding confusion in the marketplace); *BellSouth Adver. & Publ'g Corp. v. The Real Color Pages*, *Inc*., 792 F. Supp. 775, 785 (M.D. Fla. 1991) ("When a trademark is said to have been infringed, what is actually infringed is the right of the public to be free of confusion and the synonymous right of the trademark owner to control his products' reputation.").

Therefore, in light of the findings set forth above, specifically Hanginout's failure to show market penetration in a specific geographic area and actual consumer confusion, the Court finds the balance of equities and the public interest weigh against granting Hanginout's motion for immediate injunctive relief. As noted by Google, it has expended substantial time and resources to develop and market the HANGOUTS mark, and requiring Google to re-brand the product on the evidence presented now would be unjust and potentially harm third-party developers as well as the public.

Accordingly, for the reasons stated above, Hanginout's motion to preliminarily enjoin Google from using the HANGOUTS mark is DENIED.

II. Motion to Dismiss

Similar to the arguments presented above, Google moves to dismiss the First Amended Complaint on the basis that Hanginout has failed to sufficiently allege seniority of use and market penetration in a specific geographic area.[27] However, because obtaining preliminary injunctive relief and succeeding on a motion to dismiss require different quanta of proof, the Court does not assume Google's motion to dismiss

[27] Google contends Hanginout's state law claims fail for the same reasons its federal trademark infringement claims fail.

will be granted purely because Hanginout's motion for preliminary injunctive relief was denied. *See Walker v. Woodford*, 454 F. Supp. 2d 1007, 1024 (S.D. Cal. 2006), *aff'd in part*, 393 F. App'x 513 (9th Cir. 2010).

A. Legal Standard

A motion to dismiss pursuant to Rule 12(b)(6) tests the legal sufficiency of the claims asserted in the complaint. Fed. R. Civ. P. 12(b)(6); *Navarro v. Block*, 250 F.3d 729, 731 (9th Cir. 2001). When ruling on a motion to dismiss under Rule 12(b)(6), the court must accept all factual allegations pleaded in the complaint as true, and must construe them and draw all reasonable inferences from them in favor of the nonmoving party. *Cahill v. Liberty Mut. Ins. Co.*, 80 F.3d 336, 337–38 (9th Cir. 1996). The court, however, is not bound to accept "legal conclusions" as true. *Ashcroft v. Iqbal*, 556 U.S. 662, 664 (2009).

To avoid a Rule 12(b)(6) dismissal, a complaint need not contain detailed factual allegations; rather, the complaint must plead "enough facts to state a claim to relief that is plausible on its face." *Bell Atl. Corp. v. Twombly*, 550 U.S. 544, 570 (2007). A claim has "facial plausibility when the plaintiff pleads factual content that allows the court to draw the reasonable inference that the defendant is liable for the misconduct alleged." *Iqbal*, 556 U.S. at 678. "The plausibility standard is not akin to a 'probability requirement,' but it asks for more than a sheer possibility that a defendant has acted unlawfully." *Id.* "Where a complaint pleads facts that are 'merely consistent with' a defendant's liability, it 'stops short of the line between possibility and plausibility of entitlement to relief.' " *Id.* (quoting *Twombly*, 550 U.S. at 557). It is not proper for the court to assume that "the [plaintiff] can prove facts that [he or she] has not alleged or that defendants have violated . . . laws in ways that have not been alleged." *Associated Gen. Contractors of Cal., Inc. v. Cal. State Council of Carpenters*, 459 U.S. 519, 526 (1983).

B. Analysis

To state a claim for trademark infringement under the Lanham Act, a plaintiff must allege that it owns a valid, protectable trademark, and that the defendant is using a

mark in commerce that is confusingly similar to the plaintiff's mark. *See* 15 U.S.C. § 1125(a); *Herb Reed Enters.*, 736 F.3d at 1247; *Dep't of Parks & Recreation for State of Cal. v. Bazaar Del Mundo Inc.*, 448 F.3d 1118, 1124 (9th Cir. 2006). Although federal registration is not a prerequisite to an infringement claim, in the absence of federal registration, a plaintiff must plead that it is the senior user of the market and has sufficient market penetration in the area in which protection is requested. *See*, *e.g.*, *Adray*, 76 F.3d at 989 ("The extent of market penetration depends upon the volume of sales, the positive and negative growth trends, the number of people who purchased the party's goods in relation to the number of potential customers, and the amount of advertising"); *Glow*, 252 F. Supp. 2d at 983 ("Generally, the senior user of a mark is entitled to assert trademark rights in all areas in which it has legally sufficient market penetration."); *Optimal Pets*, 877 F. Supp. 2d at 958 ("A party asserting common law rights must not only establish that it is the senior user, it must also show that it has "legally sufficient market penetration" in a certain geographic market to establish those trademark rights"). Google contends Hanginout has failed in both regards.

1. Priority of Use

"It is axiomatic in trademark law that the standard test of ownership is priority of use." *See Sengoku Works Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1219 *as modified*, 97 F.3d 1460 (9th Cir. 1996). "To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services." *Id.* Courts must examine the totality of the circumstances when determining whether a mark has been adequately used in commerce so as to gain the protection of the Lanham Act. *See Chance*, 242 F.3d at 1159.

As discussed above, because Hanginout has alleged that it first used the HANGINOUT mark in commerce as early as March 2010, and had over 200 registered users of the web-based platform as early as May 2011, whereas Google did not begin using the HANGOUTS mark in commerce until June 28, 2011, assuming the Court

agreed with Google, the Court finds Hanginout has stated a plausible claim that it is the senior user of the mark in question. *See*, *e.g.*, *Allard Enterprises*, 146 F.3d at 358 ("As long as there is a genuine use of the mark in commerce, however, ownership may be established even if the first uses are not extensive and do not result in deep market penetration or widespread recognition."); *Dep't of Parks & Recreation*, 448 F.3d at 1126 ("Although mere advertising by itself may not establish priority of use, advertising combined with other non-sales activity, under our 'totality of the circumstances test,' can constitute prior use in commerce.") (internal citations omitted); *Autodesk*, *Inc. v. Dassault Systemes SolidWorks Corp.*, No. C08-04397 WHA, 2008 WL 6742224, at *2 (N.D. Cal. Dec. 18, 2008) (denying motion to dismiss in trademark case where moving party claimed priority because factual allegations in the complaint were inconsistent with the plaintiff's submissions to the USPTO); *Gulfstream Media Grp.*, *Inc. v. PD Strategic Media*, *Inc.*, No. 12-62056-CIV, 2013 WL 1891281 at *5 (S.D. Fla. May 6, 2013) (stating the Court must wait to consider the evidence adduced later in the litigation to determine priority of use and whether that use constituted use in commerce).[28]

2. Market Penetration in a Specific Geographic Area

"Sufficient market penetration is determined by 'examining the trademark user's volume of sales and growth, number of persons buying the trademarked product in relation to the number of potential purchasers, and the amount of advertising' in a given market." *Credit One Corp.*, 661 F. Supp. 2d at 1138 (quoting *Glow*, 661 F. Supp. 2d at 1138); 5 McCarthy on Trademarks and Unfair Competition §26:13 (4th ed.) ("In the absence of federal registration, both parties have the right to expand into unoccupied territory and establish exclusive rights by being first in that territory. In effect, it is a race between the parties to establish customer recognition in unoccupied territory, possibly subject to the concept of a zone of natural expansion.").

[28] The Court also notes that none of the cases cited by Google with respect to this issue concerned a motion to dismiss pursuant to Rule 12(b)(6), in which the Court was required to accept the plaintiff's factual allegations as true.

Google asserts Hanginout has failed to sufficiently allege market penetration "in any single geographic location, let alone nationwide." (Doc. No. 23 at 7.) Google further claims that Hanginout "pleads no specific facts regarding its volume of sales and growth trends, the number of persons buying the trademarked product in relation to the number of potential purchasers, the amount of its advertising prior to June 2011, or where the 200 alleged users were located." (*Id*.) In opposition, Hanginout contends Google completely ignores the pleading standard and what is required to defeat a motion to dismiss. Therefore, Hanginout asserts that Google's efforts are premature, and "[w]hile Google may explore the depths of Hanginout's allegations as litigation and discovery progress," such an inquiry is not appropriate on a motion to dismiss.

The Court agrees. Although Hanginout has failed to present sufficient evidence of its market penetration in a specific geographic area to warrant preliminary injunctive relief at this juncture, on a motion to dismiss, the Court must take the plaintiff's allegations as true, and construe the facts in the light most favorable to the plaintiff. *Cahill*, 80 F.3d at 337–38; *Ashcroft*, 556 U.S. at 678 (stating that while a plaintiff need not "plead every detail or prove every fact," a plaintiff must allege certain facts, which if true, would state a plausible claim for relief). Therefore, because Hanginout has alleged that it "achieved market penetration through the United States and, at a minimum, in California," the Court must take these facts as true and leave for a later date the determination of whether Hanginout will be able to support such facts with the necessary evidence. *See Monster Daddy, LLC v. Monster Cable Prods., Inc*., No. CA 6:10-1170-TMC, 2012 WL 2513466, at *2-3 (D.S.C. June 29, 2012) (denying 12(b)(6) motion in trademark case on grounds that it was not appropriate for the court to make factual determinations at that time) (denying 12(b)(6) motion in trademark infringement case on the basis that it was inappropriate for the court to make factual determinations on a motion dismiss); *CYBERsitter, LLC v. Google Inc*., 905 F. Supp. 2d 1080, 1087 (C.D. Cal. 2012). Accordingly, the Court DENIES Google's motion to the dismiss the First Amended Complaint.

CONCLUSION

As set forth above, the Court DENIES Hanginout's motion for preliminary injunction, (Doc. No. 12), and DENIES Google's motion to dismiss the First Amended Complaint, (Doc. No. 23). Google must file an answer to the operative complaint no later than thirty (30) days from the date of this order.

IT IS SO ORDERED.

DATED: May 12, 2014

Hon. Anthony J. Battaglia
U.S. District Judge

Exhibit 4

AT&T 4G 5:10 PM

Me **Tweet**

iamdiddy
@iamdiddy

Happy Birthday to the CEO of @HanginoutApp my friend @malonekreativ ! #entrepreneur #vision #manoffaith #work

Retweeted by Hanginout App
11/1/12, 4:30 PM

21 RETWEETS **11** FAVORITES

Exhibit 5

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UNITED STATES DISTRICT COURT

SOUTHERN DISTRICT OF CALIFORNIA

HANGINOUT. INC.. a Delaware corporation.

Plaintiff.

vs.

GOOGLE. INC.. a Delaware corporation.

Defendant.

Case No. 3:13-cv-02811-AJB-NLS

DECLARATION OF JUSTIN MALONE IN SUPPORT OF PLAINTIFF HANGINOUT, INC.'S MOTION FOR PRELIMINARY INJUNCTION

Date: March 13, 2014
Time: 2:00 p.m.
Courtroom 3B
The Honorable Anthony Battaglia

I, JUSTIN MALONE, DECLARE AS FOLLOWS:

1. I am the founder and CEO of Hanginout, Inc. ("Hanginout"). I have personal knowledge of the facts set forth in this declaration and could and would competently testify as to the same.

2. As founder and CEO of Hanginout, I am readily familiar with Hanginout's business operations, including the research, marketing, and product-development of Hanginout's social-media based platforms and iTunes applications ("app").

3. Hanginout developed the HANGINOUT interactive video-response platform and apps to give users the ability to easily build and publish engaging video profiles.

4. One of the HANGINOUT application's distinguishing features is a question and answer capability giving users the unique ability to field questions from other users, by recording and publishing video responses, then sharing them from anywhere at any time.

5. The Hanginout Pro application also provides real-time analytic solutions that analyze website demographics, usage, and audience interests.

6. Hanginout adopted the HANGINOUT logo and word mark in November 2008. Attached as **Exhibit 1** is a true and correct copy of a Wayback Machine screen capture retrieved from archive.org on January 15, 2014, depicting Hanginout's November 2008 use of the Hanginout logo. "Archive.org" alleges to provide a method of viewing content on a domain page's webpage as it existed at various points in the past. On information and belief, the website is run by the Internet Archive, a 501(c)(3) non-profit that was founded in 1996 to build an Internet library, with the purpose of offerings permanent access to historical collections that exist in digital format.

7. Hanginout began developing its social-media based platforms with an ultimate goal of providing celebrities, politicians, businesses, and everyday people with a platform to organize their social media connections and connect with others through a highly-interactive video question and answer ("Q&A") format.

8. In early 2009, we began creating a free mobile platform allowing consumers to engage each other through interactive video and empower brands to engage their consumers in a more compelling, interest-driven way.

9. By March 2010, to promote our product, Hanginout began partnering with celebrities and professional athletes to create HANGINOUT profiles for its

interactive social-media platform. Attached as **Exhibit 2** is a true and correct copy of a screen capture of a Hanginout Facebook promotion with NFL athlete Shawne Merriman, from the day of the first video shoot.

10. From March 2010 through the present, the following non-exhaustive list of celebrities and public figures have created Hanginout accounts and published content on the HANGINOUT platform:

- Kassim Osgood (NFL)
- Shawne Merriman (NFL)
- Mitchie Brusco (X-Games)
- DJ Chuckie (DJ)
- Eric Griggs (Music Producer)
- Miles McPhereson (Pastor, The Rock Church, former San Diego Charger)
- Mike Hill (ESPN)
- Daphne Joy (Actress/Model)
- Jessica Burciaga (Model)
- Amanda Cerny (Model)
- Da Internz (Music Producers)
- Belmont Lights (Band)

11. In March and April 2011, consumers began registering HANGINOUT Profiles and endorsing the product on social-media platforms such as Twitter and Facebook. Attached as **Exhibit 3** is a true and correct copy of the Hanginout endorsements on Twitter that announced the release of our beta and demo platforms.

12. From April 1, 2011 to April 20, 2011, we invited hundreds of contacts to register profiles for the HANGINOUT Platform.

13. On May 4, 2011, Hanginout began its broader marketing campaign for

its Q&A video platform. Hanginout launched several social-media advertising initiatives to promote the application. For example, a preview of the HANGINOUT platform was posted on LinkedIn. Attached as **Exhibit 4** is a true and correct copy of the May 4, 2011 LinkedIn announcement regarding the HANGINOUT platform.

14. On May 4, 2011, a YouTube video was uploaded explaining the HANGINOUT platform and an overview of its general capabilities. Attached as **Exhibit 5** is a true and correct copy of the Promotional YouTube video for the HANGINOUT platform on a CD. Exhibit 5 can also be seen at: http://www.youtube.com/watch?v=BWo_x5YviAM&list=FLhZUDGwy0dK7qAClds Huidg&index=3

15. On May 23, 2011, Tech Cocktail endorsed Hanginout's "Interactive Video Q&A Platform" on Facebook. Attached as **Exhibit 6** is a true and correct copy of the Tech Cocktail endorsement on Facebook.

16. On the same day, Tech Cocktail released an online article endorsing the HANGINOUT platform. Attached as **Exhibit 7** is a true and correct copy of the May 23, 2011 Tech Cocktail Article.

17. By the end of May 2011, over 200 customers had registered for and used Version 1.0 of the HANGINOUT Q&A platform. Presently, there are nearly 8,000 registered customers.

18. On June 1, 2011, Hanginout, Inc. was officially formed as a corporation. I assigned the rights and goodwill in the HANGINOUT brand to the company.

19. On June 9, 2011, Hanginout released another YouTube video detailing some key elements of the HANGINOUT platform with celebrities including NFL athlete Shawne Merriman. Attached as **Exhibit 8** is a true and correct copy of the Promotional YouTube video for the HANGINOUT platform on a CD. Exhibit 8 can also be seen at: http://www.youtube.com/watch?v=18sSmlp9lJY

20. On October 24, 2011, San Diego Mayoral candidate Carl DeMaio utilized HANGINOUT to create a "virtual town hall" for his campaign. Attached as **Exhibit 9** is a true and correct copy of Carl DeMaio's website utilizing the HANGINOUT platform on a CD. Exhibit 9 can also be seen at: http://www.thecampaignsolutionsgroup.com/virtual-townhall/

21. On April 10, 2012, Hanginout offered the Hanginout Pro Application to provide additional capabilities to its existing customers. The Hanginout Pro application permitted users to build an interactive profile to receive questions and publish video response instantly. Attached as **Exhibit 10** is a true and correct copy of the AppAnnie overview of the Hanginout Pro Application.

22. On, July 6, 2012, working with Hanginout, popular professional skateboarder Mitchie Brusco launched an application utilizing the HANGINOUT platform to stay in touch with his friends and fans. Attached as **Exhibit 11** is a true and correct copy of the App Details for Mitchie Brusco's HANGINOUT App.

23. ESPN ran an article about the Mitchie Brusco application and HANGINOUT platform on July 19, 2012, in conjunction with the upcoming X-Games. Attached as **Exhibit 12** is a true and correct copy of the ESPN article.

24. On September 16, 2012, Hanginout officially launched the HANGINOUT iOS App in the iTunes Application Store. Apple chose to feature the HANGINOUT App.

25. On September 18, 2012, iSnoops endorsed the HANGINOUT platform. Attached as **Exhibit 13** is a true and correct copy of iSnoops endorsement.

26. On September 28, 2012, AppAnnie ranked the HANGINOUT Application fourth in the United States and first in Sweden in the featured social-media category. Attached as **Exhibit 14** is a true and correct copy of the September 28, 2012 AppAnnie rankings.

27. On November 1, 2012, celebrity and recording artist Sean "Puff Daddy"

Combs wished me happy birthday on Twitter while referencing the HANGINOUT app. Attached as **Exhibit 15** is a true and correct copy of the Twitter message from Sean Combs.

28. As part of Hanginout's efforts to police its Mark, Hanginout learned that the Mark HANGOUT (Reg. No. 3857338) existed. Hanginout filed a petition to cancel the HANGOUT registration. The petition was granted and the HANGOUT registration was canceled on May 6, 2013. Attached as **Exhibit 16** is a true and correct copy of the USPTO Cancelation Notice for the HANGOUT Mark.

29. I consistently monitored Google Analytics Reports ("Google Reports") from October 2012 through December 23, 2013, to monitor traffic through the HANGINOUT iOS Application.

30. Attached as **Exhibit 17** is the Google Analytic Report for Hanginout's Audience Overview between September 15, 2012 and December 23, 2013.

31. Attached as **Exhibit 18** is the Google Analytic Report for Hanginout's International usage between September 15, 2012 and December 23, 2013.

32. Attached as **Exhibit 19** is the Google Analytic Report for Hanginout's United States usage between September 15, 2012 and December 23, 2013.

33. Attached as **Exhibit 20** is the Google Analytic Report for Hanginout's California usage between September 15, 2012 and December 23, 2013.

34. The Google Analytic Reports confirm that the Hanginout Application was viewed over 1,000,000 times since October 2012; viewed by consumers in 112 countries throughout the world; and viewed by consumers throughout the United States with the largest quantity of consumers in California, specifically Los Angeles and San Diego counties.

35. Since the HANGINOUT platform's September 12, 2012 launch through December 23, 2013, the HANGINOUT Application was viewed 1,047,549 times. Additionally, 87.5 percent of visitors have returned to view the app.

36. As of December 23, 2013, the HANGINOUT Application was viewed by at least one consumer in 112 countries. The U.S. ranks highest among all these countries. As of December 23, 2013, the top five states with the most visits are California (29,985 visits), New York (7,056 visits), Florida (3,506 visits), Michigan (2,701 visits) and Texas (2,629 visits).

37. As a result, of the 29,985 visits from California consumers, the three cities with the most visits were Los Angeles (4,456 visits), Carlsbad (4,191 visits) and San Diego (3,726 visits). In total, there were 347 California cities with at least one Application view.

38. On December 17, 2013, the USPTO Publication & Issue Review was completed for the Hanginout applications, with a publication date of January 21, 2014. Attached as **Exhibit 21** is a true and correct copy of the USPTO's Notice of Publications for Hanginout's Serial Nos. 85674801 and 85674799.

39. Attached as Exhibit 22 is a true and correct copy of Google's Official Blog article introducing +Hangouts.

40. Attached as **Exhibit 23** is a true and correct copy of an AppAnnie printout detailing the release and upgrade dates of Google's "Hangouts" Application. AppAnnie collects information on applications (apps that can be downloaded on "smart devices" such as smart phones), and provides statistics for those applications.

41. Attached as **Exhibit 24** is a true and correct copy of the screen capture for the top Google search-engine results for "What is Google Hangouts," retrieved January 17, 2014.

42. On April 26, 2013, Google filed a federal trademark application to register the mark "Hangouts," Application Serial No. 85916316. Attached as **Exhibit 25** is a true and correct copy of Google's Application for "Hangouts."

43. On July 30, 2013, the USPTO suspended Google's Hangouts application because of the HANGINOUT mark. Attached as **Exhibit 26** is a true and

correct copy of the USPTO's Suspension Notice for Google's "Hangouts" application.

44. Attached as **Exhibit 27** is a true and correct copy of the Google announcing its "Hangouts on Air" Q&A Platform.

45. In 2012, the Hanginout App was downloaded on iTunes 8,691 times, the Hanginout Pro 288 times and Hanginout with Mitchie Brusco 522 times. In 2013, downloads continued with the Hanginout App receiving 1,419 downloads, Hanginout Pro 75, and Hanginout with Mitch Brusco 1,174. Attached as **Exhibit 28** is a true and correct screen capture, retrieved January 21, 2014, of iTunes' 2012 and 2013 download statistics for the Hanginout App, Hanginout Pro, and Hanginout with Mitch Brusco App.

46. Attached as **Exhibit 29** is a true and correct copy of Google's trademark list, obtained from google.com.

47. Attached as **Exhibit 30** is a true and correct copy of a video with celebrity Leon Walker utilizing the HANGINOUT platform.

48. Attached as **Exhibit 31** is a true and correct copy of Google's description of its Hangouts platform, also located at www.google.com/+/learnmore/hangouts/.

I declare under penalty of perjury under the laws of the United States of America, that the foregoing is true and correct.

Executed this 22th day of January, 2014, at San Diego, California.

JUSTIN MALONE

25581948v.3

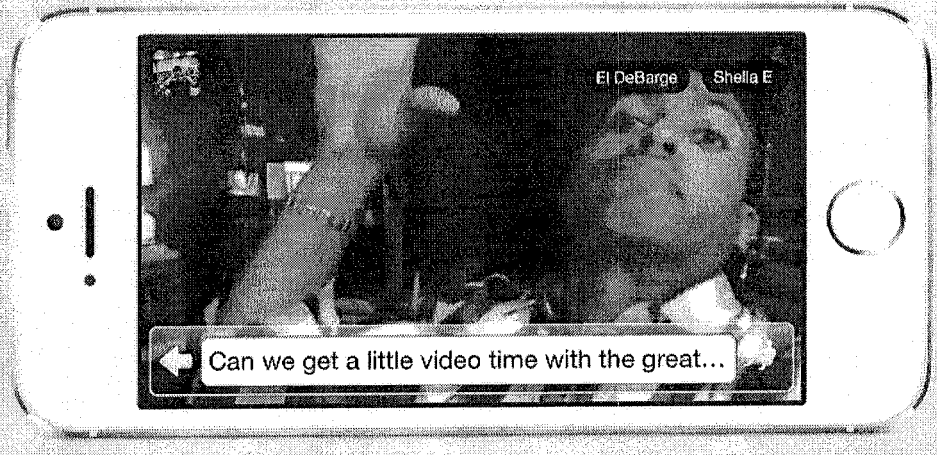
Exhibit 6

hanginout

Interesting People

Interesting people are all around us, and now you can interact with and follow these people on Hanginout. Photos are great, but the best way to get to know them is interacting and listening to them talk about the things they are patiionate about.

Download on the App Store



Just Ask.

In Hanginout the content is driven by users interacting with each other. If you want to know something about someone or have an expert give you advise, just ask.

Record Responses.

Whether you are connecting with family and friends in different timezones or archiving your families legacy for the future, Hanginout makes it easy. Right from your iPhone create and manage a dynamic interactive video profile.

Auto Responses

Auto Responses are little videos you record that make your profile feel like people are really hanginout with you. Add welcome clips, waiting clips, and a custom video that will play when a user asks you some thing you haven't asnwered yet.

Notifications

Recieve important notifications right on your phone when other users interact with you. Know instantly when your questions to other users have been created and published.

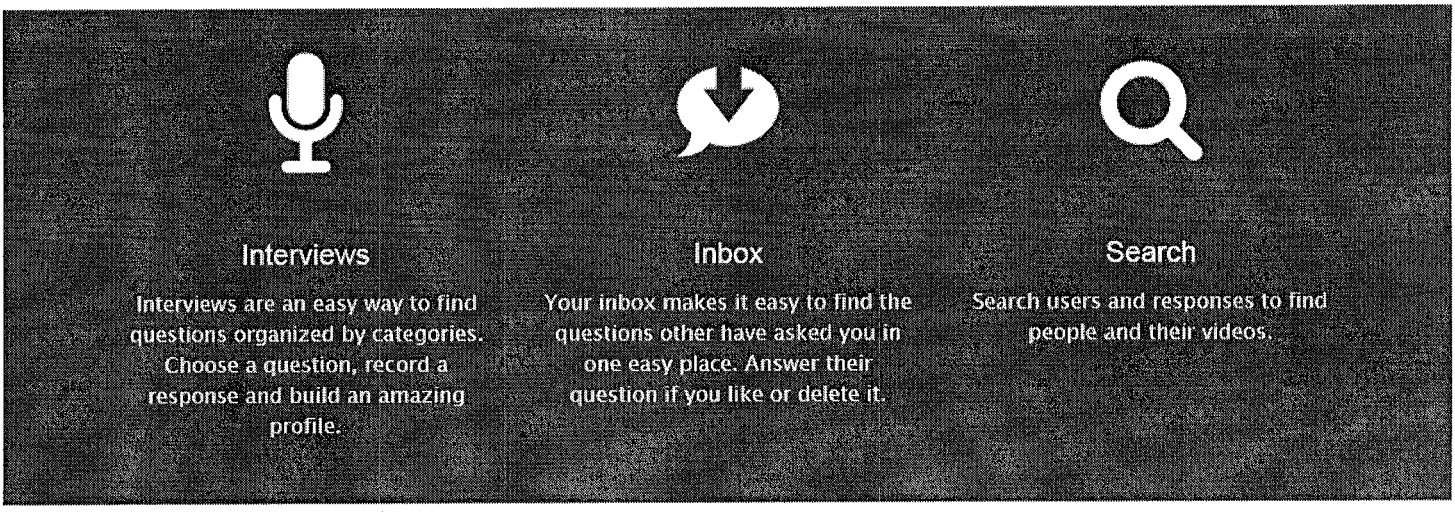
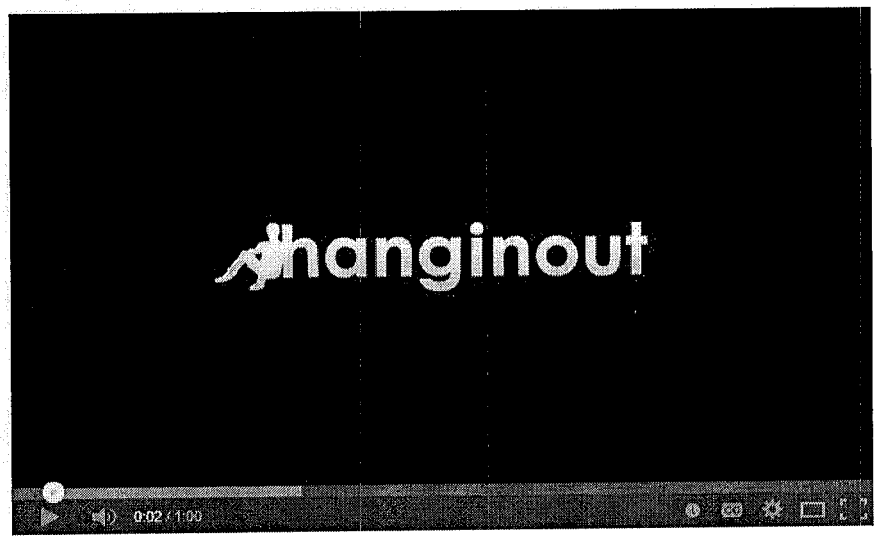


Exhibit 7

YouTube

Upload Sign in



Hanginout Preview

Hanginoutinc · 2 videos

Subscribe 4

346 views

0 0

Like About Share Add to

Uploaded on May 4, 2011

Hanginout is an interactive video Q&A publishing platform. Check out our preview at http://hanginout.com.

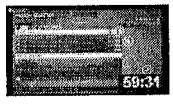
Show more

NO COMMENTS YET

Share your thoughts

Kendall Schmidt from BigTimeRush - Q&A on Cambio
by TinaGotLostLife
23 625 views

FISHROOM BEDTIME!!
by CICHLIDMAN09
743 views



Hangin' out with the Crew: 8-27-2013
by GamatariLifeCosmic

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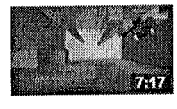

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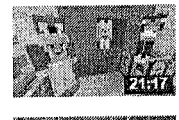

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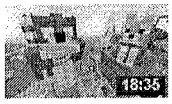

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