

This Opinion is not a
Precedent of the TTAB

Mailed: May 22, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board

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Nokia Corporation

v.

Somasundaram Ramkumar

—
Opposition No. 91238114
—

Helen Hill Minsker and Maurine L. Knutsson of Banner & Witcoff, Ltd.
for Nokia Corporation.

Somasundaram Ramkumar, *pro se*.

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Before Cataldo, Adlin and Pologeorgis,
Administrative Trademark Judges.

Opinion by Adlin, Administrative Trademark Judge:

Applicant Somasundaram Ramkumar seeks registration of JIOKIA, in standard
characters, for

web-based electronic mail services, namely, electronic transmission of email, email forwarding; instant messaging services, namely, electronic message sending, electronic messaging; providing telecommunication connections to the internet or database; providing information in the field of Internet connections; providing information in the field of Internet connections via the Internet; providing an on-line interactive database featuring crowd sourced information on global internet connection speeds; providing user access to on-line games and job information by means of global computer networks;

providing user access to global computer information networks for the transfer and dissemination of information about games and jobs; providing internet chat rooms; electronic data transmission services; communications by mobile phones; television broadcasting; communications by computer terminals and fiber optic networks; providing telecommunications connections to a global computer network; providing user access to global computer networks; e-mail services, namely, electronic transmission of email, email forwarding; fax and email services, namely, broadcast communication services, namely, transmitting e-mails and faxes to designated recipients for others; electronic transmission of messages and images, namely, message and image sending and receipt; electronic mail services, namely, electronic transmission of mail; providing access to computer database on the global computer network for searching and retrieving information, data, web sites available on computer networks; spam message blocking services in International Class 38.¹

In its notice of opposition, Opposer Nokia Corporation alleges prior use and registration of NOKIA and variations thereof for a variety of telecommunications-related products and services, including mobile devices, computer hardware and software and Internet access.² As grounds for opposition, Opposer alleges that use of Applicant's mark would be likely to cause confusion with, and dilute (by blurring), Opposer's mark. In his answer, Applicant denies the salient allegations in the notice of opposition, and attempts to assert "the affirmative defenses found in Federal Rule of Civil Procedure 8(c) that may be applicable." Because he failed to identify or detail any particular affirmative defense, Applicant has failed to plead one, and even if he

¹ Application Serial No. 87461796, filed May 24, 2017 under Section 1(b) of the Trademark Act, based on an alleged bona fide intent to use the mark in commerce.

² Registration Nos.: 2667758, for NOKIA in typed form, issued December 31, 2002 and renewed; 2690201, for NOKIA in typed form in the color blue, issued February 25, 2003 and renewed; and 5202542, for NOKIA in standard characters, issued May 16, 2017.

had, he failed to participate in the trial or file a brief on the case, and has therefore waived any affirmative defenses. *Miller v. Miller*, 105 USPQ2d 1615, 1616 n.3 (TTAB 2013); *Baroness Small Estates Inc. v. Am. Wine Trade Inc.*, 104 USPQ2d 1224, 1225 n.2 (TTAB 2012).

I. The Record

The record consists of the pleadings and, by operation of Trademark Rule 2.122(b), the file of Applicant's involved application. In addition, Opposer introduced:

Testimony Declaration of Jeremie Vaquer, its Senior Legal Counsel, Trademarks, Domain Names & Designs, and the exhibits attached thereto ("Vaquer Dec."). 19 TTABVUE.³

Notice of Reliance ("Opp. NOR") on its pleaded and additional unpleaded NOKIA trademark registrations, and the file histories therefor, as well as several uninvolved applications filed by Applicant, and the file histories therefor. 26 TTABVUE.

Applicant did not submit any testimony or other evidence, nor did he file a brief.

II. The Parties

Opposer is one of the world's leading providers of telecommunications products and services. Applicant is an individual from India who has filed a number of applications to register telecommunications and Internet-related marks in the United States.

³ Citations to the record reference TTABVUE, the Board's online docketing system. The number preceding "TTABVUE" corresponds to the docket entry number(s), and any number(s) following "TTABVUE" refer to the page number(s) of the docket entry where the cited materials appear.

A. Opposer

Opposer is a Finnish company which started in 1865 “as a paper mill operation.”
19 TTABVUE 14 (Vaquer Dec. ¶ 20). Opposer started manufacturing telecommunications equipment in the 1880s. *Id.* Following a series of mergers, Opposer’s telecommunications business grew substantially beginning in the 1960s, and in the 1970s and 1980s Opposer expanded into personal computers and other consumer electronics. “By 1992, Nokia had made the first mobile phone commercially available”:



Id. at 15 (Vaquer Dec. ¶¶ 21-22).

“Sales of Nokia’s mobile phones skyrocketed, and by 1998, Nokia was the largest mobile phone manufacturer in the world, overtaking both Motorola and Ericsson,” with 30% market share and worldwide sales revenue exceeding \$15 billion. *Id.* at 16 (Vaquer Dec. ¶ 23). In 2003, Opposer offered the first camera phone for sale in North America:



Id. (Vaquer Dec. ¶ 24). Opposer began offering smartphones (as opposed to the “feature phones” depicted above) in 2005:



Id. at 17 (Vaquer Dec. ¶ 25).

In 2011, Opposer and Microsoft entered into a strategic partnership which resulted in Opposer adopting: (1) Windows Phone as its phones’ primary operating system; and (2) the mark LUMIA, which Opposer uses with its house mark NOKIA. *Id.* at 20 (Vaquer Dec. ¶ 26). In 2014 Microsoft acquired Opposer’s mobile and devices division, before selling it to HMD Global (“HMD”) in 2016; HMD now offers a variety of NOKIA-branded phones as Opposer’s trademark licensee, including both feature phones and smartphones with the Android operating system. *Id.* at 20-22 (Vaquer Dec. ¶¶ 26, 30).

In recent years Opposer has developed a 5G (the fifth, most robust generation of wireless technology) platform, helped by its acquisition of Alcatel-Lucent, parent company of Bell Labs (now Nokia Bell Labs). Opposer has 5G-related contracts with AT&T, Verizon and T-Mobile. *Id.* at 9, 13, 21 (Vaquer Dec. ¶¶ 10, 18, 29).

Opposer's worldwide success extends to the United States. Indeed, Opposer's net sales in the United States easily exceeded \$1 billion every year from 2001-2012, with sales well in excess of \$2 billion in every one of those years except 2011, and sales in excess of \$4 billion from 2001-2004. *Id.* at 25-26. (Vaquer Dec. ¶ 31). From 2013-2018, there were over 3.4 million United States visitors to Opposer's website "nokia.com". Opposer has over 13 million Facebook followers, 703,000 Instagram followers, 389,000 YouTube subscribers, 915,000 LinkedIn followers and over 2.18 million Twitter followers. *Id.* at 27 (Vaquer Dec. ¶ 33); 22 TTABVUE 401, 404, 408, 412 (Vaquer Dec. Exs. 54-57); 23 TTABVUE 4 (Vaquer Dec. Ex. 58). Opposer's phones have appeared in movies, including Lethal Weapon, The Matrix, The Dark Knight and Star Trek. 19 TTABVUE 28 (Vaquer Dec. ¶ 35); 23 TTABVUE 23-54, 112-119 (Vaquer Dec. Exs. 60-61). From 2007-2015, the NOKIA Theater L.A. Live in Los Angeles hosted entertainment events, and from 2005-2010 the NOKIA Theater Times Square in New York did the same. 19 TTABVUE 28-29 (Vaquer Dec. ¶ 38); 23 TTABVUE 121-127 (Vaquer Dec. Exs. 62-63). HMD's NOKIA-branded smartphones earned positive reviews in 2019 from, among others, Forbes and Reuters. 19 TTABVUE 29-30 (Vaquer Dec. ¶ 39); 23 TTABVUE 129-161 (Vaquer Dec. Exs. 64-

66). Of the 20 bestselling mobile phones of all time, 12 are NOKIA phones, including the top six. 19 TTABVUE 32 (Vaquer Dec. ¶ 44).

B. Applicant

Applicant failed to introduce any evidence whatsoever. However, Opposer introduced several trademark applications Applicant filed in addition to the involved application. These include applications to register marks associated with Opposer (HMD, HMDGLOBAL and LUMIA), as well as marks associated with other major providers of telecommunications products and services (AMAZON, ANDROID and ANDROIDONE). *Id.* at 38-41 (Vaquer Dec. ¶¶ 61-64); 26 TTABVUE 2069-2616.

III. Standing

Because status and title copies of Opposer's pleaded registrations are of record, 1 TTABVUE 18-54, Opposer has established its standing. *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000).

IV. Priority

Because Applicant has not counterclaimed to cancel any of Opposer's pleaded registrations, priority is not at issue with respect to the marks and goods and services identified therein. *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Furthermore, Opposer has established prior common law use of its mark for a number of additional goods and services. 19 TTABVUE 8-34, (Vaquer Dec. ¶¶ 8-15, 20-38, 40-47).

V. Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the probative evidence of record bearing on the likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973) (setting forth factors to be considered); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and services. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) (“The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.”). The fame of the prior mark may also be critical. *Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1305 (Fed. Cir. 2002). Opposer bears the burden of establishing that there is a likelihood of confusion by a preponderance of the evidence. *Cunningham*, 55 USPQ2d at 1848. We consider the likelihood of confusion factors about which there is evidence, and treat the remaining factors as neutral. *See In re Guild Mortg. Co.*, 912 F.3d 1376, 129 USPQ2d 1160, 1162-63 (Fed. Cir. 2019).

We focus here on Opposer’s pleaded Registration No. 2690201 (the “201 Registration”) for the mark NOKIA in typed format and the color blue, which is registered for, *inter alia*, “telecommunication and wireless communication services, namely, electronic mail.” If we find confusion likely between this mark and Applicant’s involved mark, we need not consider the likelihood of confusion between Applicant’s mark and Opposer’s other pleaded marks. On the other hand, if we find

no likelihood of confusion between Applicant's mark and the mark in Opposer's pleaded '201 Registration, we would not find confusion likely between Applicant's mark and Opposer's other pleaded marks. *In re Max Capital Grp.*, 93 USPQ2d 1243, 1245 (TTAB 2010).

A. The Strength/Fame of Opposer's Mark

Before addressing the marks and services, we consider the strength of Opposer's mark, to ascertain the scope of protection to which it is entitled.

There is no evidence, and Applicant does not argue, that Opposer's mark is conceptually weak. There are no dictionary definitions of the term of record, and we perceive nothing about the term NOKIA which describes or suggests telecommunications or any of the products or services for which NOKIA is registered or for which Opposer has established prior use. The mark is therefore arbitrary and conceptually strong for Opposer's services.

As for commercial strength, Opposer argues, and Applicant does not dispute, that NOKIA is "famous." Where fame exists, it "plays a 'dominant role in the process of balancing the *DuPont* factors,' ... and '[f]amous marks thus enjoy a wide latitude of legal protection.'" *Bose*, 63 USPQ2d at 1305 (quoting *Recot, Inc. v. Benton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000)). A strong mark "casts a long shadow which competitors must avoid." *Kenner Parker Toys, Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453, 1456 (Fed. Cir. 1992).

Here, we must determine where to place Opposer's mark on the "spectrum" of marks, which ranges from "very strong to very weak." *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1694

(Fed. Cir. 2005) (quoting *In re Coors Brewing Co.*, 343 F.3d 1340, 68 USPQ2d 1059, 1063 (Fed. Cir. 2003)). See also, *Joseph Phelps Vineyards, LLC v. Fairmont Holdings, LLC*, 857 F.3d 1323, 122 USPQ2d 1733, 1734-35 (Fed. Cir. 2017). The record in this case fully supports Opposer's claim that its mark is not only very strong, but famous.

While Opposer has not introduced any consumer surveys showing fame, they are not necessary; indeed, they "rarely appear." *Bose*, 63 USPQ2d at 1305. Rather, "fame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Id.* Other relevant factors include "length of use of the mark, market share, brand awareness, licensing activities, and variety of goods bearing the mark." *Coach Services Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1720 (Fed. Cir. 2012).

Each of these measures shows that Opposer's NOKIA mark is famous. Indeed, besides being in use for well over a century, the NOKIA mark has enjoyed considerable commercial success and is widely recognized by the public.

For example, Opposer introduced the first commercially available mobile phone. It was for at least a period of time the world's largest mobile phone manufacturer, with 30% market share. Opposer's global fame, and the worldwide fame of its NOKIA mark, extends to the United States.

In fact, for more than the first decade of this century, Opposer's United States sales were well in excess of \$1 billion annually, averaging almost \$3.5 billion per year during that period. Opposer's website has drawn millions of United States visitors.

Opposer's followers on social media number in the millions and hundreds of thousands, depending on the platform. Opposer's phones have appeared in well-known movies such as *The Matrix* and *Lethal Weapon*. The NOKIA mark was used for years in connection with New York and Los Angeles theaters. Currently, Opposer's licensee offers NOKIA-branded phones which have been the subject of positive reviews in national publications. Most of the top selling mobile phones of all time are NOKIA phones. In short, NOKIA is a famous mark in the United States. This factor weighs heavily in favor of finding a likelihood of confusion.

B. Similarity of the Services, Channels of Trade and Classes of Consumers

Applicant seeks registration of its mark for, *inter alia*, "electronic mail services, namely, electronic transmission of mail," which is identical to the "telecommunication and wireless communication services, namely, electronic mail" identified in the '201 Registration.⁴ Because the services are identical, we must presume that the channels of trade and classes of purchasers are as well. *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012) (even though there was no evidence regarding channels of trade and classes of consumers, the Board was entitled to rely on this legal presumption in determining likelihood of confusion); *American Lebanese Syrian Associated Charities Inc. v. Child Health Research Institute*, 101 USPQ2d 1022, 1028 (TTAB 2011).

⁴ See also 24 TTABVUE 126, 143, 148 (showing prior common law use of NOKIA for e-mail services).

The legal identity of the services and their overlapping channels of trade and classes of purchasers not only weigh heavily in favor of finding a likelihood of confusion, but also reduce the degree of similarity between the marks necessary to find a likelihood of confusion. *In re Viterra*, 101 USPQ2d at 1908; *In re Mighty Leaf Tea*, 94 USPQ2d at 1260; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1248 (TTAB 2010).

C. Similarity of the Marks

The marks are more similar than dissimilar “in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). Indeed, they both end identically, with the same four letters O-K-I-A. This similarity is more important than the difference between the marks, which is that Opposer’s begins with an “N” while Applicant’s begins with a “JI.”

Specifically, because the marks end in the same four letters, they will most likely rhyme when spoken and in any event will sound quite similar. It is even possible that one of these marks might be taken for the other when encountered aurally if a listener does not hear the first part of one of the marks well or in its entirety.

Having the same last four letters also makes the marks look similar. While we do not agree with Opposer’s contention that the “JI” in Applicant’s mark is “a combination of letters that is visually close to the letter ‘N’” in Opposer’s mark, 27 TTABVue 25, the point is not that these few letters are identical or even similar, but simply that the marks in their entirety appear similar enough that confusion as to

the source of the goods and services offered under the marks is likely to result. *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3 (CCPA 1977); *Spoons Rests. Inc. v. Morrison Inc.*, 23 USPQ2d 1735, 1741 (TTAB 1991). In fact, “[t]he proper test is not a side-by-side comparison of the marks, but instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs.*, 101 USPQ2d at 1721 (quoting *Leading Jewelers Guild, Inc. v. LJOW Holdings, LLC*, 82 USPQ2d 1901, 1905 (TTAB 2007)).⁵

As for meaning and commercial impression, there is no evidence that either mark means anything. Opposer’s appears to be arbitrary, and given the only evidence of record concerning Applicant, discussed in more detail below, it appears that Applicant’s mark may be based on or intended to evoke Opposer’s mark.⁶ In any event, Applicant’s mark is apparently also arbitrary, and arbitrary marks analogous to those at issue here have often been found confusingly similar. *See e.g., Inter Ikea Sys. B.V. v. Akea, LLC*, 110 USPQ2d 1734, 1741 (TTAB 2014) (finding IKEA and AKEA confusingly similar, stating “[w]here, as here, both marks are coined terms

⁵ While the mark in the ‘201 Registration is limited to the color blue, this is not a legal difference between the marks because Applicant seeks registration of his mark in standard characters. Indeed, Applicant could display his standard character mark in any color (or lettering style or font). *In re i.am.symbolic, LLC*, 866 F.3d 1315, 123 USPQ2d 1744, 1748 (Fed. Cir. 2017) (“Symbolic does not, and cannot, dispute that the mark, I AM in standard character form, and the registrants’ marks, I AM in standard character, typed, or stylized form, are pronounced the same way and, at a minimum, legally identical.”); *In re Viterra Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 USPQ2d 1253, 1258-59 (Fed. Cir. 2011).

⁶ To the extent Applicant’s mark evokes Opposer’s, the marks would likely convey similar meanings.

that look alike and sound alike and there are no known differences in the meaning to distinguish them, the marks engender a similar commercial impression”) (citing cases); *Atlas Supply Co. v. The Dayton Rubber Co.*, 125 USPQ 529, 530 (TTAB 1960) (“The marks ‘PLYCRON’ and ‘NYCRON’ are similar in composition, they bear a marked resemblance in sound, and they are both coined terms having no apparent meaning other than as trademarks. In view thereof, it is believed that purchasers of tires might reasonably attribute a common origin to ‘PLYCRON’ tires and ‘NYCRON’ cord for making tires”).

This factor also weighs in favor of finding a likelihood of confusion.

D. Applicant’s Intent in Adopting His Mark

Opposer argues that Applicant’s attempts to register marks associated with Opposer (HMD, HMDGLOBAL, LUMIA) and other well-known companies (AMAZON, ANDROID, ANDROIDONE) “strongly suggest” bad faith. 27 TTABVue 30. Given that all of the other likelihood of confusion factors weigh in Opposer’s favor, we need not find bad faith here in order to sustain the opposition.

Nonetheless, Applicant’s failure to even attempt to explain, much less excuse, his attempted registration of other marks owned by or associated with, *inter alia*, Opposer makes it hard to draw any other conclusion. Suffice it to say that a defendant’s unexplained attempts to appropriate multiple marks owned by a plaintiff will generally not assist him in seeking to register or maintain registration of any of them. However, rather than belaboring a point which is now superfluous to this decision, and for purposes of this decision only, we will go no further than necessary and simply consider this factor neutral. *Cf. L’Oreal S.A. and L’Oreal USA, Inc. v.*

Marcon, 102 USPQ2d 1434, 1442 (“Applicant’s demonstrated pattern of filing applications to register various well-known marks convinces us that applicant’s adoption of the L’OREAL PARIS mark was in bad faith, with the intention to trade off of opposer’s famous L’OREAL and L’OREAL PARIS marks.”).

VI. Conclusion

Opposer’s mark is famous and conceptually strong, the services, channels of trade and classes of consumers are identical, and the marks are more similar than dissimilar. Confusion is likely.

Decision: The opposition is sustained on Opposer’s Section 2(d) claim, and we therefore need not reach Opposer’s dilution claim. *Multisorb Tech., Inc. v. Pactiv Corp.*, 109 USPQ2d 1170, 1171 (TTAB 2013). Registration of Applicant’s mark is refused.