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TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

September 28, 2021

Opposition No. 91264424

Sitecore Corporation A/S

v.

Sitecare, LLC

Before Bergsman, Goodman, and English,
Administrative Trademark Judges.

By the Board:

This proceeding now comes before the Board for consideration of (1) Opposer's motion (filed May 11, 2021) for summary judgment or, in the alternative, for sanctions, and (2) Applicant's cross-motion (filed June 21, 2021) to reopen its time to comply with the Board's February 17, 2021 order, to reopen its time to respond to discovery requests, and to extend discovery.

I. Background

Applicant seeks to register the standard character mark SITECARE for "Pay per click (PPC) advertising management services; Search engine optimization for sales promotion" in International Class 35 and "Design, creation, hosting, maintenance of

websites for others; Website design and development for others; Website design consultancy” in International Class 42.¹

On August 26, 2020, Opposer filed a notice of opposition asserting likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), and an allegation of dilution. In support of its entitlement to a statutory cause of action and claim, Opposer pleads prior use of the mark SITECORE and a “family” of SITECORE marks, as well as ownership of eight registrations, including, for example, the following:



- Registration No. 2954856 for the mark **sitecore** for “Computer software for managing online content, computer software for editing and managing the information contained on the Internet, intranet and extranet sites, and computer software for development of Internet applications” in International Class 9;²
- Registration No. 4696859 for the standard character mark SITECORE for “Design and development of computer software for content management, commerce, multi-channel marketing and experience management; Technical support, namely, monitoring technological functions of computer network systems to report on social media, brand awareness, customer loyalty and related web monitoring activities; Technical support services, namely, 24/7 monitoring of network systems, servers and web and database applications and notification of related events and alerts; Providing a web site featuring temporary use of non-downloadable software allowing web site users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery via email, SMS, MMS and content management for web, mobile, print, and social experiences; Cloud computing featuring software for use in enabling

¹ Application Serial No. 88865956, filed April 9, 2020, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

² Issued May 24, 2005, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Renewed. The description of the mark is as follows: “The mark consists of the wording SITECORE and a circle, within which are three swatches of graduated size.”

web site users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery via email, SMS, MMS and content management for web, mobile, print, and social experiences; Computer software consultation regarding the end business objectives behind such software” in International Class 42;³ and

- Registration No. 6069858 for the standard character mark SITECORE EXPERIENCE MANAGER for “Design and development of computer software for content management, commerce, multi-channel marketing and experience management; Technical support, namely, monitoring technological functions of computer network systems to report on social media, brand awareness, customer loyalty and related web monitoring activities; Technical support services, namely, 24/7 monitoring of network systems, servers and web and database applications and notification of related events and alerts; Providing a web site featuring temporary use of non-downloadable software allowing web site users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery via email, SMS, MMS and content management for web, mobile, print, and social experiences; Cloud computing featuring software for use in enabling web site users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery via email, SMS, MMS and content management for web, mobile, print, and social experiences; Computer software consultation regarding the end business objectives behind such software; Design of computer machine and computer software for commercial analysis and reporting; Data automation and collection service using proprietary software to evaluate, analyze and collect service data” in International Class 41.⁴

In its October 5, 2020 answer, Applicant denied the salient allegations in the notice of opposition.

³ Issued March 3, 2015, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

⁴ Issued June 2, 2020, pursuant to Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). “MANAGER” is disclaimed.

On February 17, 2021, the Board granted Opposer's motion to compel Applicant's service of its initial disclosures as conceded and ordered Applicant to serve its initial disclosures within twenty days of the Board's order.⁵

On May 11, 2021, Opposer filed a motion for summary judgment on its pleaded claim of likelihood of confusion or, in the alternative, for sanctions for Applicant's failure to comply with the Board's February 17, 2021 order.

On June 21, 2021, Applicant filed a combined response to Opposer's motion for summary judgment and sanctions and a cross-motion to: (1) reopen its time to comply with the Board's February 17, 2021 order, (2) reopen its time to respond to Opposer's discovery requests, including requests for admission, and (3) extend discovery and all remaining dates.

II. Review of Pleadings

As an initial matter, in determining Opposer's motion for summary judgment, we have reviewed the pleadings in this proceeding. Opposer has sufficiently pleaded its entitlement to a statutory cause of action and its claim of likelihood of confusion based on its individual marks; however, Opposer has not sufficiently pleaded a claim of likelihood of confusion based on a family of marks.

To plead ownership of a family of marks, a plaintiff must allege: "(1) prior use of marks sharing a recognizable common characteristic; (2) that the common characteristic is distinctive (i.e., not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's

⁵ 7 TTABVUE.

mark); and (3) that prior to the defendant's first use (or constructive first use) of its involved mark, plaintiff's marks have been used and advertised in promotional material or in everyday sales activities in such a manner as to create common exposure and thereafter recognition among the purchasing public such that the common characteristic is itself indicative of a common origin of the goods or services."

Wise F&I, LLC v. Allstate Ins. Co., 120 USPQ2d 1103, 1109 (TTAB 2016).

Although not identified as a claim on the ESTTA cover sheet, the notice of opposition also contains an allegation that "Applicant's use of the SITECARE mark will dilute the goodwill and recognition developed by [Opposer]." ⁶ This allegation, standing alone, does not constitute a claim of dilution under Section 43(c) of the Trademark Act. *See Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1174-75 (TTAB 2001) (dilution claim requires an allegation that the plaintiff's mark or marks were famous prior to the Applicant's first use or constructive first use of its mark). Inasmuch as there are no allegations supporting a dilution claim beyond the conclusory statement that Applicant's mark will dilute Opposer's marks, Opposer has not pleaded a claim of dilution.

In Applicant's answer, Applicant asserts three affirmative defenses. As its first "affirmative defense," Applicant pleads that there is no likelihood of confusion. This statement is not an affirmative defense, but is rather nothing more than a reiteration of Applicant's denial of Opposer's likelihood of confusion claim. The first affirmative defense is therefore stricken. *See Order of Sons of Italy in Am. v. Profumi Fratelli*, 36

⁶ 1 TTABVUE 10, Notice of opposition ¶ 10.

USPQ2d 1221, 1223 (TTAB 1995) (striking defenses that consist of nothing more than reiteration of denial of claims).

As its second affirmative defense, Applicant pleads that Opposer's claims are barred by the doctrines of laches, estoppel, and/or acquiescence based on Applicant's predecessor-in-interest's use of the mark WP SITECARE. Generally, the equitable doctrines of laches, estoppel and acquiescence are unavailable in an opposition proceeding, because these defenses start to run from the time the mark is published for opposition, not from the time of knowledge of use. *See Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) ("In an opposition or cancellation proceeding, the objection is to the rights which flow from registration of the mark."); *Panda Travel, Inc. v. Resort Option Enters., Inc.*, 94 USPQ2d 1789 (TTAB 2009) (laches begins to run from publication date and when an opposition is timely filed, there can be no laches defense based on opposer's knowledge of prior use). Here, Applicant's involved application was published for opposition on August 4, 2020. Opposer filed the opposition only three weeks later on August 26, 2020. Additionally, "acquiescence and estoppel require some affirmative act by opposer which led applicant to reasonably believe that opposer would not oppose applicant's registration of its mark." *DAK Indus. Inc. v. Daiichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993). Accordingly, the second affirmative defense is stricken.⁷

⁷ "[U]nder certain circumstances, a laches defense in an opposition may be based upon an opposer's failure to object to an applicant's earlier registration of substantially the same mark for substantially the same goods." *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at *8 (TTAB 2020) (citing *Aquion Partners L.P. v. Envirogard Prod. Ltd.*, 43

Finally, as its third affirmative defense, Applicant pleads that Opposer's dilution claim must fail because its marks are not famous within the meaning of 15 U.S.C § 1125. As stated above, Opposer has not pleaded a claim of dilution. Accordingly, Applicant's third affirmative defense is inapplicable and is stricken.

III. Opposer's Motion for Summary Judgment or Sanctions and Applicant's Cross-Motion to Reopen and Extend

Opposer seeks summary judgment on its claim of likelihood of confusion. Opposer relies, in part, on Applicant's deemed admissions to its First Set of Requests for Admission.⁸ In the alternative, Opposer seeks sanctions against Applicant for its failure to serve initial disclosures by March 9, 2021 in compliance with the Board's February 17, 2021 order granting Opposer's motion to compel.⁹

In response, Applicant cross-moves to reopen its time to comply with the Board's February 17, 2021 order by serving its initial disclosures, to reopen its time to respond to all of Opposer's written discovery requests, including Opposer's requests for admission, and to extend discovery.¹⁰

USPQ2d 1371, 1373 (TTAB 1997)). In its response to the summary judgment motion, Applicant asserts that its predecessor-in-interest obtained a registration for the mark WP SITE CARE. 14 TTABVUE 3, 18-61. Applicant's assertions in its brief do not form part of the pleading, however. Additionally, to the extent Applicant intended to plead a prior registration defense, Applicant must allege that the prior registration is for substantially the same mark for substantially the same goods or services.

⁸ 8 TTABVUE 7-8.

⁹ *Id.* at 9.

¹⁰ 14 TTABVUE. When a party files an unconsented motion to extend the discovery period or pretrial disclosures and testimony periods, it is preferable that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. *See* TBMP § 509.02.

Opposer did not file a response to Applicant's cross-motion to reopen and extend. Accordingly, Applicant's cross-motion to reopen and extend is **granted** as conceded.¹¹ See Trademark Rule 2.127(a). Applicant is allowed until **thirty days** from the date of this order to serve its initial disclosures and responses to Opposer's discovery requests. In view thereof, Opposer's alternative motion for sanctions based on Applicant's failure to comply with the Board's February 17, 2021 order is **denied as moot**.

A. Opposer's Motion for Summary Judgment

We turn next to Opposer's motion for summary judgment on its likelihood of confusion claim. Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to material facts, thus allowing resolution as a matter of law. See Fed. R. Civ. P. 56(a). A party moving for summary judgment has the burden of demonstrating the absence of any genuine dispute as to a material fact, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). See also *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions, Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793, 1796 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See *Opryland USA Inc v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

¹¹ In view thereof, we need not and do not consider Applicant's alternative motion to amend and withdraw its deemed admissions.

The evidence of record on summary judgment must be viewed in the light most favorable to the nonmoving party, and all justifiable inferences must be drawn from the undisputed facts in favor of the nonmoving party. *See Lloyd's Food Prods. Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); *Opryland USA*, 23 USPQ2d at 1472; *Bad Boys Bail Bonds, Inc. v. Yowell*, 115 USPQ2d 1925, 1929 (TTAB 2015).

To prevail on its claim of likelihood of confusion, Opposer must establish that there is no genuine dispute of material fact that it has entitlement to a statutory cause of action, that it has priority of use, and that contemporaneous use of the parties' marks on their respective goods and services would be likely to cause confusion, mistake, or to deceive consumers. *See* 15 U.S.C. § 1052(d); *Hornblower & Weeks*, 60 USPQ2d 1733, 1735 (TTAB 2001).

For purposes of the summary judgment motion only, we find that there is no genuine dispute of material fact with respect to Opposer's entitlement to a statutory cause of action by virtue of Opposer's submission of copies of information from the USPTO's Trademark Status & Document Retrieval (TSDR) electronic database records showing the current status and title of its pleaded registrations.¹² *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189

¹² Opposer is required to maintain its entitlement to a statutory cause of action throughout this proceeding and affirmatively prove its entitlement at trial. *See Lipton Ind., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 USPQ2d 1844, 1848 (TTAB 2017).

(CCPA 1982); *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399, 1407-08 (TTAB 2010).

Opposer has also established its priority by submitting copies of its pleaded registrations showing that the registrations are valid and subsisting and owned by Opposer. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *see also* TBMP § 309.03(c)(2) and authorities cited therein. Accordingly, for purposes of this motion only, there is no genuine dispute of material fact as to Opposer's priority.

In determining the issue of likelihood of confusion and whether there is any genuine dispute of material fact, we consider all of the *du Pont* factors that are relevant under the circumstances and for which there is evidence of record. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973). Two key factors in determining likelihood of confusion are the degree of similarity of the parties' respective marks and the degree of similarity in their respective 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 the differences in the marks.").

In its motion for summary judgment, Opposer relies, in part, on Applicant's deemed admissions to establish its likelihood of confusion claim. Inasmuch as we have granted Applicant's motion to reopen its time to serve responses to the requests for admission, we have given the requests for admission no consideration. Opposer

also contends that the parties' respective marks are similar and that Applicant's identified services are competitive with those of Opposer.¹³

In response, Applicant argues SITE-formative marks are commonly used in connection with web design related services and that Opposer's pleaded marks are therefore weak.¹⁴

Upon careful consideration of the parties' arguments and evidence, and drawing all reasonable inferences in favor of Applicant as the nonmoving party, we find that Opposer has failed to meet its burden of establishing that there is no genuine dispute of material fact with respect to its claim of likelihood of confusion. At a minimum, a genuine dispute of material fact remains as to whether the parties' respective marks convey a similar meaning or commercial impression, the relatedness of the parties' respective services, and the strength of Opposer's pleaded marks.¹⁵

In view of the foregoing, Opposer's motion for summary judgment is **denied**.

¹³ 8 TTABVUE 8, 13. In support of its argument that the services are "competitive," Opposer references a website purportedly owned by Applicant; however, Opposer did not attach a copy of the website.

¹⁴ 14 TTABVUE 13-14 and 80-135 (attaching TSDR records for third-party registrations).

¹⁵ The fact that we have identified certain genuine disputes of material fact as a sufficient basis for denying Opposer's summary judgment motion should not be construed as a finding that such disputes are necessarily the only disputes that remain for trial. Additionally, the parties should note that the evidence submitted in connection with a motion for summary judgment or opposition thereto is of record only for consideration of that motion. Any such evidence to be considered at final hearing must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983). The parties may, however, stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. See, e.g., *Micro Motion Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 n.2 (TTAB 1998).

IV. Schedule

Proceedings are resumed. Opposer is allowed until **twenty days** from the date of this order to file and serve an amended notice of opposition that properly pleads a claim of likelihood of confusion based on a family of marks, if justified and appropriate, failing which, the claim of likelihood of confusion based on a family of marks will be dismissed with prejudice and given no further consideration.

Applicant is allowed until **twenty days** from the date of service of the amended notice of opposition to file and serve an answer to the amended notice of opposition, if any.

In addition, as noted, Applicant is allowed until **thirty days** from the date of this order to serve its initial disclosures and responses to Opposer's discovery requests.

Remaining dates are reset as follows:

Expert Disclosures Due	11/7/2021
Discovery Closes	12/7/2021
Plaintiff's Pretrial Disclosures Due	1/21/2022
Plaintiff's 30-day Trial Period Ends	3/7/2022
Defendant's Pretrial Disclosures Due	3/22/2022
Defendant's 30-day Trial Period Ends	5/6/2022
Plaintiff's Rebuttal Disclosures Due	5/21/2022
Plaintiff's 15-day Rebuttal Period Ends	6/20/2022
Plaintiff's Opening Brief Due	8/19/2022
Defendant's Brief Due	9/18/2022
Plaintiff's Reply Brief Due	10/3/2022
Request for Oral Hearing (optional) Due	10/13/2022

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in

Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).

TIPS FOR FILING EVIDENCE, TESTIMONY, OR LARGE DOCUMENTS

The Board requires each submission to meet the following criteria before it will be considered: 1) pages must be legible and easily read on a computer screen; 2) page orientation should be determined by its ease of viewing relevant text or evidence, for example, there should be no sideways or upside-down pages; 3) pages must appear in their proper order; 4) depositions and exhibits must be clearly labeled and numbered – use separator pages between exhibits and clearly label each exhibit using sequential letters or numbers; and 5) the entire submission should be text-searchable. Additionally, submissions must be compliant with Trademark Rules 2.119 and 2.126. Submissions failing to meet all of the criteria above may require re-filing. **Note:** Parties are strongly encouraged to check the entire document before filing.¹⁶ The Board will not extend or reset proceeding schedule dates or other deadlines to allow time to re-file documents. For more tips and helpful filing information, please visit the [ESTTA help](#) webpage.

¹⁶ To facilitate accuracy, ESTTA provides previews of each page before submitting.