

THIS OPINION IS  
NOT A PRECEDENT  
OF THE T.T.A.B.

Mailed:  
March 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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ABBY Software Ltd.

v.

Ectaco Inc.

—  
Cancellation No. 92049973

Roy Ching of Merit Law Group PC for ABBY Software Ltd.

Anna Vishev of Ostrolenk Faber LLP for Ectaco Inc.

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Before Seeherman, Bucher and Zervas, Administrative  
Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

ABBY Software Ltd. ("petitioner") filed a petition to  
cancel trademark Registration No. 3015325 for the mark  
LINGVOSOFT (in typed form) on the Principal Register for the  
following International Class 9 goods:

translation software, language learning software,  
electronic voice interpreter, [and] electronic  
handheld dictionaries.

**Cancellation No. 92049973**

Ectaco Inc. ("respondent") is the owner of record of this registration, which issued on November 15, 2005 as a result of an application filed on July 30, 2004. The registration claims first use and first use in commerce on May 10, 2004.

As grounds for cancellation, petitioner pleads priority, likelihood of confusion and fraud. Specifically, petitioner claims that it produces, sells and distributes dictionaries and translation software, language learning software, electronic voice interpreters, and electronic handheld dictionaries; that it used LINGVO as a trademark in the United States as early as February 10, 1995; that petitioner has priority; and that registrant's mark is likely to be confused with petitioner's mark. In addition, petitioner alleged fraud in connection with the filing of respondent's application which matured into the present registration because respondent knew of petitioner's mark prior to filing its application and failed to disclose petitioner's mark in its application; and because respondent was not using its mark on all of the goods identified in its application despite its representation to the Office to the contrary.

Respondent has filed an amended answer which denies the salient allegations of the petition to cancel, and asserts that LINGVO translates to "language" in Esperanto, "is a generic name for Petitioner's goods ... in ... Esperanto," and

is merely descriptive of petitioner's goods and lacks secondary meaning. Respondent also pleaded affirmative defenses of laches and estoppel.<sup>1</sup>

*The Record*

The record consists of the pleadings and the file of the involved registration. Also, pursuant to the stipulation filed on June 4, 2009 allowing each party to submit the testimony of witnesses in affidavit (or declaration) form, and allowing for objections to admissibility and countering testimony by deposition, the parties filed the following declarations:

Petitioner's witnesses' declarations:

- Vladimir Kovalev, former U.S. distributor for petitioner
- Ding-Yuan Tang, CEO of ABBYY USA Software House Inc., petitioner's U.S. subsidiary
- Marinos Dimosthenous, petitioner's managing director
- Muchnik Stanislava, translator

Respondent's witness' declaration:

- David Lubinitsky, respondent's CEO

Petitioner's rebuttal witness' declaration:

- Vladimir Selegey, petitioner's Director of Linguistic Research and Head of Applied Linguistic Department

The parties did not file exhibits to each declaration with the declaration but filed them with "Petitioner's Exhibits and Notice

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<sup>1</sup> Because respondent did not discuss its affirmative defense of acquiescence in its brief, it is considered waived.

of Reliance" and "Respondent's Exhibits and Notice of Reliance." (Each filing included more than the declarant's exhibits.) They did not designate which submission a declarant was relying on as an exhibit to his declaration and which submission was being introduced pursuant to a notice of reliance. In view of the number of declarations and the large number of exhibits that each party introduced, and because neither party has objected to any of the exhibits, we have considered all of the exhibits regardless of whether they were properly the subject of a notice of reliance.

*Preliminary Matter*

On April 27, 2010, approximately a week after respondent filed Mr. Lubinitsky's declaration, petitioner filed objections to various statements in the declaration, and on April 29, 2010, the Board stated in an order that it would rule on those objections in the final decision. Petitioner's objections - which largely go to the probative value of the statements rather than their admissibility - are all overruled and we have considered the statements which petitioner maintains are objectionable. Petitioner's objections, however, have been considered in determining the weight to accord to those statements to which petitioner has objected.

*Standing*

Petitioner is the owner of the LINGVO mark and is the parent company of a United States company (ABBYY USA Software House Inc.) that distributes and sells LINGVO software products for language instruction in the United States. Dimosthenous ¶¶ 18 - 22. See also respondent's exh. 36, petitioner's response to interrogatory no. 5. This is sufficient to demonstrate that petitioner has a real interest in this proceeding, and therefore has standing. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982),

*Priority*

To establish its priority under Section 2(d), petitioner must prove that, vis-à-vis respondent, it owns "a mark or trade name previously used in the United States ... and not abandoned ...." See Trademark Act Section 7(c), 15 U.S.C. §1057(c); and *Larami Corp. v. Talk to Me Programs, Inc.*, 36 USPQ2d 1840 (TTAB 1995). In view of the statements in respondent's answer that petitioner's asserted mark LINGVO is merely descriptive, petitioner was put on notice that it must demonstrate that its trademark is inherently distinctive or had acquired distinctiveness before the date on which respondent can establish its rights. *Threshold, TV, Inc. v. Metronome Enterprises, Inc.* 96 USPQ2d 1031 (TTAB 2010).

Is petitioner's mark distinctive?

Respondent's asserts in its answer and its brief that the Esperanto word LINGVO translates to the English word "language." Websters-online-dictionary.org defines "lingvo" as an Esperanto term (not an English term) for "language, tongue." Respondent's exh. 5. Dicts.info defines "lingvo" as the Esperanto term for "language; linguistic communication." Respondent's exh. 5. Further, wikitionary.org defines "lingvo" as "language." Respondent's exh. 6. Respondent's witness, Mr. Lubinitsky, states in ¶ 46 of his declaration that the English translation from Esperanto of "lingvo" is "language" or "linguistic communication." From this evidence, we find that "lingvo" is an Esperanto term for "language" and "tongue."

Pursuant to the doctrine of foreign equivalents, words from modern languages are generally translated into English to determine descriptiveness or genericness. *In re N. Paper Mills*, 64 F.2d 998, 17 USPQ 492 (CCPA 1933). See *In re Tokutake Indus. Co.*, 87 USPQ2d 1697 (TTAB 2008) (AYUMI and its Japanese-character equivalent held merely descriptive for footwear where the evidence, including applicant's own admissions, indicated that the primary meaning of applicant's mark is "walking"); *In re Oriental Daily News, Inc.*, 230 USPQ 637 (TTAB 1986) (Chinese characters that mean

ORIENTAL DAILY NEWS held merely descriptive of newspapers); *In re Geo. A. Hormel & Co.*, 227 USPQ 813 (TTAB 1985) (SAPORITO, an Italian word meaning "tasty," held merely descriptive because it describes a desirable characteristic of applicant's dry sausage). However, foreign words from obscure languages may be so unfamiliar to the American buying public that they should not be translated into English for considering descriptiveness and genericness issues. See *Enrique Bernat F. S.A. v. Guadalajara Inc.*, 210 F.3d 439, 54 USPQ2d 1497 (5th Cir. 2000), *reh'g denied*, 218 F.3d 745 (2000).

The Federal Circuit recently explained when to apply the doctrine of foreign equivalents:

One aspect of the doctrine of foreign equivalents generally requires considering the meaning of a mark in a non-English language to the speakers of that language. As we stated in *Palm Bay*, "[u]nder the doctrine of foreign equivalents, foreign words from common languages are translated into English ... ." *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée en 1772*, 396 F.3d 1369, 1377 [73 USPQ2d 1689] (Fed. Cir. 2005); *In re N. Paper Mills*, 64 F.2d 998, 998-99 [17 USPQ 492] (CCPA 1933). The doctrine has been summarized in a leading trademark treatise in the context of determining whether a mark is descriptive (or geographically descriptive) under subsections (e)(1) and (e)(2) of the statutory section governing registration:

Under the "doctrine of foreign equivalents," foreign words are translated into English ... . However, the "doctrine of foreign equivalents" is not an absolute rule, for it does not mean that words from dead or obscure

languages are to be literally translated into English for descriptive purposes.

*In re Spirits International N.V.*, 90 USPQ2d 1489, 1491 (Fed. Cir. 2009). Thus, we must determine whether in the United States, Esperanto is a common, and not an obscure, language, to ultimately test the mere descriptiveness or genericness of "lingvo."

Respondent's evidence fails to persuade us that there are sufficient Esperanto speakers in the United States who would stop and translate the mark into English. Much of respondent's evidence is in a foreign language, and respondent has not provided any translation of this evidence or even indicated whether the language is Esperanto. Mr. Lubinitsky's statements in ¶ 48 of his declaration<sup>2</sup> regarding the number of people who "use" Esperanto and his statement that there are "multiple international organizations, associations, congresses and clubs dedicated to studying and propagation of Esperanto" are not persuasive because Mr. Lubinitsky relies on various sources for his testimony without identifying them; his testimony is clearly hearsay as he has no independent knowledge; and he does not

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<sup>2</sup> Mr. Lubinitsky states at ¶ 48:

According to various sources ... 2 - 20 million people use Esperanto. There are multiple international organizations, associations, congresses and clubs dedicated to studying and [the] propagation of Esperanto. Esperanto is the most widely used international language and is especially popular in the modern Internet-dependent environment.



indicate how many persons who speak Esperanto are in the United States. The Google search summaries for "Lingvo Esperanto" and "Lingvo Internacia," some of which are entirely or in part in a foreign language, and the statements in the search summaries that the Google search engine located 5,450,000 hits and 274,000 hits, respectively, also have little probative value regarding whether Esperanto is a commonly understood language in the United States.<sup>3</sup> Respondent also maintains that there are 121,946 articles in Esperanto on Wikipedia, relying on a foreign language document taken from eo.wikipedia.org for which there is no translation. Respondent's exh. 13 (document no. LS003329). Because this document is not in English, and respondent has not supplied a translation, we do not consider it or respondent's representation as to its contents.

Respondent's position that the doctrine of foreign equivalents should be applied is undercut by several statements made in its brief. At p. 17, respondent acknowledges that no country has officially adopted Esperanto as a national language, and that it has only one thousand native speakers. It also acknowledges that it does not know how many persons speak the language, including in

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<sup>3</sup> Google search summaries have little probative value because they do not show the context in which a term is used. *In re*

the United States, through its statement that the number of people who are fluent in Esperanto ranges from ten thousand "to as high as two million (or even 20 million ...)," and that the users are spread in about 115 countries.

In sum, respondent has not established how widespread Esperanto is in the United States. Respondent has simply not submitted sufficient evidence to establish that Esperanto is a common language in the United States, or at best, has only established that Esperanto is an obscure language in the United States. We therefore do not apply the doctrine of foreign equivalents to petitioner's mark. And, because "lingvo" does not have an English language meaning, we consider the term to be an arbitrary term as applied to petitioner's goods.<sup>4</sup> We make this finding despite Mr. Lubinitsky's apparent argument at ¶¶ 53 and 56 that "lingvo" is similar to the prefixes "ling" (as in "linguistics") and "lang" (as in "language") in English, which we do not find persuasive. See also respondent's exh. 22.

#### First Use

Petitioner has not claimed ownership of a federal registration. It therefore must show that it developed

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*Bayer Aktiengesellschaft*, 488 F.3d 960, 82 USPQ2d 1828 (Fed. Cir. 2007).

<sup>4</sup> Petitioner's claim of acquired distinctiveness made through the testimony of Mr. Dimosthenous at ¶ 35 of his declaration is unnecessary and is not given any further consideration.

common law rights prior to respondent's priority date. Respondent maintains that it began using LINGVOSOFT in 2004. Thus, to establish that it has priority, petitioner must demonstrate that it used its mark prior to 2004.<sup>5</sup>

Petitioner's witnesses, Mr. Tang and Mr. Dimosthenous, both state in their declarations that:

Lingvo is a software product providing translations, definitions and spelling of words, among other features. Over the years, its features have expanded to include a mobile version, grammatical information, pronunciations, examples for word use, definitions, synonyms and antonyms, word searches, etc. It enables its users to study and learn foreign languages, including Russian, European languages, such as French, German or Italian, and Chinese.

Tang ¶ 12; Dimosthenous ¶ 15. They refer to these products collectively as "Lingvo software products." Mr. Tang, president of ABBYY USA Software House Inc., states at ¶¶ 21 and 22 of his declaration that ABBYY USA Software House Inc. and Micro 3 Corporation, two of petitioner's United States distributors, first sold Lingo software products in the United States in July 2000 and in February 2001, respectively. Mr. Dimosthenous states at ¶ 7 of his declaration that first use of LINGVO in the United States was in 1994.

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<sup>5</sup> Respondent asserts that it used LINGVO since at least September 1999 when it opened its first "lingvobit" store in New York and when it created [www.lingvobit.com](http://www.lingvobit.com). Brief at 15. Because the registered mark which petitioner seeks to cancel is LINGVOSOFT and not LINGVOBIT, respondent's use of "lingvobit" is irrelevant.

Petitioner introduced invoices and sales analysis reports maintained in the ordinary course of business by Micro 3 Corporation and ABBYY USA Software House Inc. for various LINGVO products showing sales from 2000 through 2007, including "Lingvo 7.0," "Lingvo 8.0" and "Lingvo 9.0." Petitioner's Exh. 8, P000310 - P00312, P00354 - P00370, and P00374 - P00376. Lingvo 7.0 is identified as "Eng/Russian Dictionary" on Micro 3 Corporation's sales analysis report, listing sales from 2001 to 2003. See also September 19, 2001 invoice identifying LINGVO 7.0 as "Eng/Russian Dictionary." Petitioner's Ex. 8 - P00316 - P000319. Lingvo 8.0 is identified as "Multi-Language" and "for Pocket" on other Micro 3 Corporation reports, with 2003 and 2004 dates. Petitioner's Ex. 8 P00317 and P000320 - P000322. Lingvo 9.0 is identified as "Multilingual Dictionary" in another Micro 3 Corporation sales analysis report indicating sales for 2004 - 2005, and in a 2004 Micro 3 Corporation invoice. Exh. 8, P00325. Further, petitioner maintains that "its products are software, the features of which include language translation and learning." Petitioner's response to interrogatory no. 22, respondent's exh. 36.

In addition, respondent conceded petitioner's priority, maintaining that the earliest date of use that petitioner can establish is in 2000. Brief at 14 - 15 ("Thus, the

Petitioner's earliest priority date with respect to the term 'Lingvo' is November 2000 (or, at the very earliest, August 2000)").

In view of the foregoing and the evidence of record, we find that petitioner has established its priority based on its use of LINGVO for translation software, language learning software and translation dictionaries for computers in the year 2000.<sup>6</sup>

*Likelihood of Confusion*

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he 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." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

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<sup>6</sup> Because the year 2000 is well before respondent's first use date, we need not address Mr. Dimosthenous' statements that the mark was used as early as 1994, and hence respondent's contentions that respondent has only made insignificant use of the mark in the years following 1994.

The Goods

To review, respondent's registration recites the following goods:

translation software, language learning software, electronic voice interpreter, [and] electronic handheld dictionaries.

As discussed above, petitioner has established its priority for translation software, language learning software and translation dictionaries for computers. Respondent states in its brief that "despite the fact that some of Registrant's products indeed overlap with Petitioner's products sold under the trade name 'Lingvo,' some of the products are clearly different," referring to hand-held dictionaries and pocket translators.

It is not necessary for petitioner to prevail that it establish likelihood of confusion with respect to all of the goods identified in respondent's registration. See *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (likelihood of confusion must be found if there is likely to be confusion with respect to any item that comes within the identification of goods in a single-class application). At a minimum, certain of petitioner's and respondent's goods, i.e., translation software and language learning software, are identical.

The *du Pont* factor regarding the similarity of the goods weighs in petitioner's favor.

Purchasers and Trade Channels

Petitioner's "Lingvo products have been sold in scores of retail outlets, including computer or electronic stores and bookstores, as well as directly to consumers via the Internet, and direct orders submitted to Lingvo product distributors." Petitioner's response to respondent's interrogatory no. 7, respondent's exh. 36. Given the absence of any restrictions or limitations as to trade channels or classes of purchasers in respondent's identification of goods, we presume that respondent's goods are or will be marketed in all normal trade channels for, and to all normal classes of purchasers of, such goods, regardless of what might be their actual trade channels and classes of purchasers. See *Packard Press Inc. v. Hewlett-Packard Co.*, 227 F.2d 1352, 56 USPQ2d 1351 (Fed. Cir. 2000); and *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990). The trade channels and classes of purchasers for respondent's goods include the same trade channels and consumers identified by petitioner.

The Marks

We next consider the similarity of the marks as to appearance, sound, connotation and commercial impression. *Palm Bay*, 73 USPQ2d at 1691. The test, under this *du Pont* factor, is not whether the marks can be distinguished when

subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). While we must consider the marks in their entireties, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). We keep in mind that when marks would appear on identical goods, as they do here, the degree of similarity necessary to support a conclusion of likely confusion declines. *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992).

As both parties recognize in their briefs, respondent's LINGVOSOFT mark is a combination of the terms LINGVO and SOFT. SOFT would be readily recognizable to purchasers of respondent's goods, i.e., software, as a shorthand form for "software." As such, it is at best a highly suggestive



term.<sup>7</sup> Although we do not disregard SOFT in registrant's mark in our comparison of the respective marks as a whole, SOFT is entitled to less weight than LINGVO because highly suggestive words are accorded less weight in the likelihood of confusion analysis. See *In re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004). Consumers will treat the LINGVO portion of registrant's mark as having greater source-indicating significance.

With regard to the sound and appearance of the marks, we find them to be similar. Petitioner's mark is LINGVO, and LINGVO is the beginning and dominant part of respondent's mark. Also, respondent's mark - as a standard character mark - can be displayed with SOFT in a smaller size than LINGVO, which would emphasize the term LINGVO and render respondent's mark closer to petitioner's mark in appearance. See *Phillips Petroleum Co. v. C.J. Webb Inc.*, 442 F.2d 1376, 170 USPQ 35 (CCPA 1971). In terms of pronunciation, because SOFT in respondent's mark is highly suggestive and will be perceived as referring to respondent's software, the slight difference in

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<sup>7</sup> "Soft" is also identified as an abbreviation for "software" in *Acronyms, Initialisms & Abbreviations Dictionary* (33rd ed. 2004) and in *Abbreviations Dictionary* (10th ed. 2001). We take judicial notice of the abbreviation of "software" as "soft" from these references. See *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (Board may take judicial notice of dictionary definitions). See also, TBMP § 704.12 (2d ed. rev. 2004).

pronunciation due to this additional element is not sufficient to distinguish the marks.

The meanings of the marks are also similar. The dominant component of respondent's mark is identical to petitioner's mark, and SOFT does not impart any additional meaning to the mark beyond suggesting what respondent's goods are (software).

We also find the commercial impression of the marks to be similar. LINGVO has no meaning in English, and the addition of SOFT, which consumers would consider as referencing registrant's goods, does not distinguish the commercial impression of respondent's mark from that of petitioner's mark.

In view of the foregoing, we find the *du Pont* factor regarding the similarity of the marks weighs in petitioner's favor.

#### Third-Party Trademark Uses

Respondent maintains that its evidence demonstrates that there are "numerous trade names for translation products and services" and that "Lingvo" has been "used by multiple third parties in titles of books on Esperanto and linguistics, in titles of electronic software and in titles of various electronic and paper dictionaries." Brief at 32. Much of respondent's evidence in support of its argument has no probative value. Respondent has not translated the

foreign language webpages it submitted; and the web addresses containing the term "lingvo," submitted as an exhibit to Mr. Lubinitsky's declaration, do not exhibit trademark use. Additionally, the listings of titles containing "lingvo" set forth in esperanto-usa.org and the Internet printouts from the New York Public Library card catalog do not help respondent because titles are not trademarks.<sup>8</sup> See *In re Cooper*, 254 F.2d 611, 117 USPQ 396 (CCPA 1958) ("the title of books are mere names, and hence not trademarks.")

The *du Pont* factor regarding third-party marks is neutral.

Fame/Strength of the Prior Mark

Petitioner argues that its mark is both famous and well known in the United States, relying largely on its witnesses' testimony. Brief at 9 and 10. Messrs. Dimosthenous and Kovalev both state that "[s]ince 1990's, the ABBYY companies have spent several thousands of dollars to market Lingvo, annually, ... and the Lingvo software products have generated well over a million dollars in revenue annually." Dimosthenous ¶ 45, Kovalev ¶ 31. (No additional information on these figures is provided.) Regarding marketing, the combined testimony of Messrs. Dimosthenous, Kovalev and Tang is that petitioner's

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<sup>8</sup> See respondent's exh. 16.

marketing efforts in the United States have included word-of-mouth, phone calls, participation in trade shows and conventions, networking activities, having a website, email marketing campaigns and catalog mailings to potential customers. Petitioner also maintains at p. 9 in its brief that "U.S. based companies have consistently and repeatedly recognized Lingvo as being the best software of its kind in categories, such as electronic dictionaries and linguistic software." Petitioner relies on the documents contained within its exh. 4, which comprise various certificates from *P.C. Magazine*, *PC World Magazine* and *Softtool*, and various entities. The certificates are in a foreign language, likely Russian, and have been translated into English. The translation of one certificate (P00400) is typical. It states, "PC World Magazine Editorial Office on behalf of Open System Publishers [b]ased of [sic] readership survey results declares The Greater English-Russian, Russian-English Dictionary ABBYY Lingvo v. 7 by ABBYY 'Best Product 2001' in the Electronic Dictionaries Category." The certificate is signed by *PC World Magazine* Editor-in-Chief Alexey Orlov and Open Systems Publishers ZAO Chief Executive Galina Gerasina.

The advertising figures of "several thousands of dollars" and revenue figures of "well over a million dollars" are of limited probative value because there is no

indication as to whether these figures are for the United States only or include figures for other countries, and statements such as "several thousands of dollars" and "well over a million dollars" are far too indefinite to establish strength or fame of a mark. Also, the certificates that petitioner relies on from *P.C. Magazine*, *PC World Magazine*, *Softtool* and other entities have limited probative value; the fact that the certificates are in Russian suggest that they were awarded in Russia and not in the United States, and hence do not evidence acclaim in the United States. One certificate states that the source of the certificates is the "editorial office" of the Russian edition of *P.C. Magazine*. Petitioner's ex. 4, P00437. The *Softtool* and the *PC World Magazine* certificates state "Moscow" next to the year of the award. Petitioner's ex. 4, P0438, 441 - 446. Further, there is no indication that the certificates are based on surveys of readers in the United States, or whether or how many U.S. consumers would be aware of these certificates. Thus, petitioner's evidence falls far short of establishing that its LINGVO mark is famous.

This *du Pont* factor is therefore neutral.

No Actual Confusion

Respondent emphasizes that the record contains no instances of actual confusion despite the fact that both parties have concurrently sold translation software for at

least six years over the Internet. Brief at 33. However, it is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.* 902 F.2d 1546, 223 USPQ 1025 (Fed. Cir. 1990). Thus, while evidence of actual confusion strongly supports a finding of likelihood of confusion, the absence thereof does not require a finding of no likelihood of confusion. See *Herbko International Inc. v. Kappa Books Inc.*, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002) ("[a] showing of actual confusion is not necessary to establish a likelihood of confusion.").

Accordingly, this *du Pont* factor must be considered to be neutral or to only slightly favor respondent.

Bad Faith Adoption

Petitioner has not asserted any facts which persuade us that respondent acted in bad faith in adopting its LINGVOSOFT mark. It does not necessarily follow that respondent adopted its mark in bad faith simply because petitioner adopted its mark fourteen years prior to respondent's adoption of its mark, and petitioner enjoyed some commercial success around the world with goods on which the mark is used. Further, petitioner's conclusory statements at pp. 20 - 21 of its brief about respondent's conduct, with no evidentiary support, fail to persuade us otherwise. See TBMP §704.06(b) (2d ed. rev. 2004), which

states, "[f]actual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial."

The *du Pont* factor regarding bad faith adoption is neutral in our likelihood of confusion analysis.

Conclusion

In balancing the above factors, we find that petitioner has established that there is a likelihood of confusion between its LINGVO mark and respondent's LINGVOSOFT mark.

*Laches*

A laches defense, if successful, will serve as a bar against a petition for cancellation grounded on likelihood of confusion unless confusion is inevitable. See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125 (TTAB 1990) (equitable defense such as laches would not preclude a judgment for plaintiff if it is determined that confusion is inevitable); and *Feed Flavors Inc. v. Kemin Industries, Inc.*, 214 USPQ 360 (TTAB 1982). In order to prevail on its affirmative defense of laches, respondent is required "to establish that there was undue or unreasonable delay [by petitioner] in asserting its rights, and prejudice to [respondent] resulting from the delay." *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1462-1463 (Fed. Cir. 2001).

In the absence of actual notice before the close of the opposition period, the date of registration is the operative date for calculating laches. *Teledyne Technologies, Inc. v. Western Skyways, Inc.*, 78 USPQ2d 1203 (TTAB 2006), *aff'd unpublished opinion*, Appeal Nos. 2006-1366 and 1367 (Fed. Cir. Dec. 6, 2006). Here, there is no evidence as to when petitioner learned of respondent's actual use of its mark in the United States. We therefore find that petitioner was put on constructive notice of respondent's trademark as of November 15, 2005, the registration date. Because the petition for cancellation was filed on September 28, 2008, the length of delay prior to the filing of the petition to cancel was three years. This delay is sufficiently long in duration to allow for a finding of laches. *Id.* (delay of three years, eight months held to constitute a laches defense to a cancellation founded on likelihood of confusion).

With respect to its claim of prejudice, respondent rests its claim primarily on the following:

In promoting and developing its business, Registrant actively developed its website *lingvosoft.com* and spent large sums in reliance upon its apparent immunity. Specifically, Registrant's advertising expenses for LINGVOSOFT gradually increased from \$243,987 in 2005 to \$783,628 in 2008, totaling \$1,756,134 for this time period.



Brief at 39.<sup>9</sup>

Respondent's claim of prejudice is not persuasive. It indicates that it has actively developed its website but has not indicated how much money it has spent on development of its website. Also, respondent relies on its advertising expenses, but has only provided copies of credit card bills showing charges for Google Adwords advertising, which do not identify the Adwords.<sup>10</sup> Respondent therefore has not proved that it has been prejudiced by petitioner's delay in commencing this proceeding.

Because respondent has not persuaded us that it is prejudiced, we find that respondent has not sustained its burden of persuasion regarding its laches affirmative defense. *Cf. The Christian Broadcasting Network, v. ABS-CBN International*, 84 USPQ2d 1560 (TTAB 2007) (finding laches because both the number of respondent's satellite subscribers and the number of all subscribers grew, respondent changed its business model and respondent's

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<sup>9</sup> These figures are apparently for the United States; Mr. Lubinitsky cites the same figures as support for his statement that respondent "has had extensive sales and distribution of the linguistic products set forth in Registration No. 3,015,325 under the mark LINGVOSOFT in the United States." Lubinitsky ¶ 26.

<sup>10</sup> Also, respondent states that "it is a grave dislocation of the business to stop its use." But we may not stop respondent's use; this proceeding only involves the continued registration of respondent's mark and does not extend to issues regarding use of the mark. See *Person's Co., Ltd. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1481 (CAFC 1990) ("The Board's function is to determine whether there is a right to secure or to maintain a registration."). Our authority does not extend to ordering a respondent to cease using its mark.

satellite distribution network grew from 300-400 dealers to 70,000 dealers).

*Unclean Hands*

Most of respondent's allegations in support of its unclean hands defense pertain to representations petitioner made in this Board proceeding or in applications for registration of LINGVO in Russia and in the United States. Such representations do not form the basis for an unclean hands defense; respondent has had an opportunity to submit its views in opposition to representations petitioner makes in this proceeding, and petitioner's applications are not involved in this proceeding. Also, respondent's representation at p. 40 of its brief that "Petitioner has marked its translation software products with the precautionary symbol ® to mislead the consumers and competitors," without citing to any factual support in the large record before us, does not establish an unclean hands affirmative defense.

*Petitioner's Other Grounds*

Because we have found for petitioner on its likelihood of confusion claim, we need not consider the other grounds for opposition argued by petitioner.

**DECISION:** The petition for cancellation on the ground of priority and likelihood of confusion is granted. Registration No. 3015325 shall be cancelled in due course.