

This Opinion is not a
Precedent of the TTAB

Mailed: July 2, 2021

UNITED STATES PATENT AND TRADEMARK OFFICE

TRADEMARK TRIAL AND APPEAL BOARD

*Equinix, Inc. substituted for
Packet Host, Inc.*

v.

OnePacket LLC

Cancellation No. 92069714

Paul E. Godinez of Bailey Duquette P.C. for Petitioner, Packet Host, Inc.

Leon Croese of OnePacket LLC for Respondent, OnePacket LLC.

Before Lykos, Kuczma and Dunn,
Administrative Trademark Judges.

Opinion by Kuczma, Administrative Trademark Judge:

Packet Host, Inc., the predecessor-in-interest of Equinix, Inc., (“Petitioner”),¹ filed a Petition for Cancellation of OnePacket LLC’s (“Respondent”), Trademark Registration No. 4738253 for the mark ONEPACKET (in standard characters) for:

¹ On September 4, 2020, Serial No. 87680188, including all common law rights to the mark and the goodwill of the business with which the mark is used, was assigned by Packet Host, Inc. to Equinix, Inc., a Delaware corporation, having a principal address in Redwood City,

Communications services, namely, providing network access points through which information on the global computer information network passes from one global computer information network service provider to another; Telecommunications services, namely, data transmission services via a fiber optic network; Providing multiple user access to a global computer information network, in International Class 38, and

Computer services, namely, hosting the software, websites and other computer applications of others on a virtual private server; Internet-based application service provider, namely, hosting, managing, developing, analyzing, and maintaining the code, applications, and software for web sites of others; Computer services in the nature of developing, leasing, maintaining, configuring, updating, monitoring, optimizing, repairing and troubleshooting of computer software; Providing data backup services; computer services, namely, providing a website featuring technology that provides restoration services; network security management in the nature of firewall services and virus protection for hosted websites, in International Class 42.²

Petitioner is the owner of Application Serial No. 87680188 for the stylized mark

packet for:

CA. A copy of the assignment was filed with the Assignment Branch on September 9, 2020 and recorded at Reel/Frames: 7046/0938-0940.

The term “Petitioner” is used herein to refer to Equinix, Inc. as well as its predecessor-in-interest, Packet Host, Inc. When a mark that is the subject of a Federal registration has been assigned, together with the application or registration, any action with respect to the application or registration that may or must be taken by the registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded with the USPTO or that proof of the assignment has been submitted in the Board proceeding record. Accordingly, the Board sua sponte substitutes the current owner of the pleaded mark as plaintiff. TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) § 512.01 (2021).

² Registration No. 4738253 issued on May 19, 2015. It was filed as Application Serial No. 86383599, on September 3, 2014, based on Respondent’s use of the mark in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), alleging February 13, 2008, as the dates of first use and first use in commerce for the services in International Classes 38 and 42.

Computer services, namely, cloud hosting provider services; On-demand infrastructure as a service featuring computer software platforms for creating, managing, and deploying different types of cloud computing environments and services; Installation, configuration, and operation of computer software platforms for creating, managing, and deploying cloud computing environments and services; Design, deployment, support, management, and maintenance of cloud computing infrastructure software for others; Technical support services, namely, administration, management and troubleshooting in the nature of service desk/help desk services, providing dedicated service desk/help desk personnel, troubleshooting of computer software and network problems, and diagnosing of computer hardware problems in the field of cloud computing, and cloud hosting; Application service provider featuring application programming interface (API) software for receiving, validating and providing event notifications to users in the field of cloud computing and cloud hosting, server hosting, in International Class 42,³

which was refused registration on the ground of likelihood of confusion with Respondent's registered mark. In its Petition for Cancellation, Petitioner alleges that Respondent abandoned its mark and is not entitled to continued registration of its mark under Section 14 of the Trademark Act, 15 U.S.C. § 1064.

Respondent denies the salient allegations in its Answer to the Petition for Cancellation.⁴

³ Application Serial No. 87680188 filed on November 10, 2017 based on Petitioner's claim of first use anywhere and first use in commerce since at least as early as December 2, 2014, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). "The mark consists of the word packet written in a stylized font; the background is transparent."

⁴ 5 TTABVUE.

I. The Record

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file history of Respondent's Registration No. 4738253 which is the subject of this proceeding.

The record also includes the following evidence submitted by Petitioner:

1. Notice of Reliance on Trademark Registrations (9 TTABVUE 2-181):

- Exhibit 1: Trademark Status and Document Retrieval (TSDR) report for Petitioner's Application Serial No. 87680188 (9 TTABVUE 5-177) including: December 6, 2017 Office Action (9 TTABVUE 54), March 21, 2018 Response to Office Action including Declaration of Paul E. Godinez with Exhibits A-G (9 TTABVUE 55-103), April 16, 2018 Final Office Action (9 TTABVUE 104-177);
- Exhibit 2: TSDR report for Registration No. 4738253 (9 TTABVUE 178-181).

2. Notice of Reliance on Printed Publications (9 TTABVUE 182-278):

- Exhibit 1: copies of web pages from the website for Notary-NY.com, <http://www.notary-ny.com/> (9 TTABVUE 182, 186-194);
- Exhibit 2: copies of webpages showing results of search engine searches for Onepacket on Google, Bing and Yahoo search engines (9 TTABVUE 182-183, 195-198)
- Exhibit 3: copies of webpages from Respondent Onepacket's website (www.onepacket.com) (9 TTABVUE 183, 199-203);
- Exhibit 4: copies of company filings submitted to United Kingdom's company registrar, www.companieshouse.gov.uk, for Onepacket Ltd., British affiliate listed on the Onepacket website (9 TTABVUE 183, 204-243);
- Exhibit 5: copies of webpages from <https://myip.ms> and <https://www.bizdb.co.uk> showing online research of the Panamanian affiliate listed on the Onepacket website, Onepacket Infrastructure Management Ltd. (9 TTABVUE 183, 244-264);

- Exhibit 6: copies of webpages from <https://www.packet.com> containing articles and online materials showing association of Packet Host with name “Packet” (9 TTABVUE 183, 265-278).
3. Declaration of Jacob Smith, Chief Marketing Officer and co-founder of Packet Host, Inc. (9 TTABVUE 279-282).
 4. Declaration of Paul E. Godinez, trademark counsel for Petitioner (9 TTABVUE 283-):
 - Exhibit 1: copy of photograph Declarant took of door entrance to Suite 912, 280 Madison Avenue, New York, NY 10016 (9 TTABVUE 283-284, 289-290);
 - Exhibit 2: copy of Petitioner’s First Request for the Production of Documents (9 TTABVUE 284-285, 291-300);
 - Exhibit 3: copy of Petitioner’s First Set of Interrogatories to Respondent (9 TTABVUE 285, 301-309);
 - Exhibit 4: copy of April 8, 2019 email from Leon Croese (identified on documents filed with the Board as “Manager, OnePackett LLC,”) ⁵, to Petitioner’s counsel claiming emailed discovery requests went into his Spam folder and “[i]f you still need them, I will do my best to get you the requested info and documents as soon as possible.” (9 TTABVUE 285, 310-312);
 - Exhibit 5: copy of Petitioner’s counsel’s April 9, 2019 email response to Mr. Croese’s April 8th email, requesting responses to Petitioner’s discovery requests (9 TTABVUE 285, 313-314);
 - Exhibit 6: copy of April 11, 2019 email from Leon Croese responding to April 9, 2019 email from Petitioner’s counsel (9 TTABVUE 286, 315-317);
 - Exhibit 7: copy of April 15, 2019 email to Leon Croese from Petitioner’s counsel requesting update on when Respondent would be responding to Interrogatories and Document Requests (9 TTABVUE 286, 318-319);

⁵ See Post-Registration Amendments in Resolution of Cancellation Proceeding at 6 TTABVUE 3 and 8 TTABVUE 3.

- Exhibit 8: copy of April 22, 2019 email to Leon Croese from Petitioner's counsel requesting responses to outstanding discovery requests and addressing Respondent's offer to amend its trademark Registration to show co-existence of its registered ONEPACKET mark with Petitioner's pending application for its PACKET mark (9 TTABVUE 286, 320-321);
- Exhibit 9: copy of April 30, 2019 email from Leon Croese to Petitioner's counsel regarding Respondent's use of ONEPACKET mark for its services (9 TTABVUE 286, 322-323).

Respondent did not submit any evidence or testimony. Only Petitioner submitted a trial brief.⁶ Nonetheless, Petitioner, as plaintiff in this case, bears the burden of providing its claim by a preponderance of the evidence.

II. Entitlement to a Statutory Cause of Action

Petitioner's entitlement to a statutory cause of action, formerly referred to as "standing," is a threshold issue that must be proven by the plaintiff in every *inter partes* case. To determine whether a party has established entitlement to a statutory cause of action, we consider whether it has demonstrated a real interest in the proceeding and a reasonable belief of damage. *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020) (discussing the application of the zone-of-interests and proximate causation test under *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 572 US 118 (2014)); *see also Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837 (Fed. Cir.

⁶ The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant. 37 C.F.R. § 2.128(a)(1). *See also Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1531 n.13 (TTAB 2018) (as defendant in cancellation, respondent not required to submit evidence or a brief, so failure to do so not treated as concession of case). TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") § 801.02(b) (2021).

2020) (discussing entitlement to bring a cause of action), *reh'g en banc denied* (Dec. 4, 2020); *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014). Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Sections 13 and 14 of the Trademark Act, 15 U.S.C. §§ 1063 and 1064, remain applicable as the tests “share a similar purpose and application.” *Corcamore*, 2020 USPQ2d 11277, at *7.

Entitlement to a statutory cause of action may be established through evidence that a petitioner’s trademark application has been refused due to a likelihood of confusion with the mark in the subject registration. *See, e.g., Yazhong Investing v. Multi-Media Tech.*, 126 USPQ2d at 1532 (standing shown where petitioner filed five intent-to-use trademark applications with the USPTO that were subject to refusals to register based on likelihood of confusion with respondent’s registrations); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1043 (TTAB 2012) (standing shown by evidence that petitioner’s application was refused registration in view of respondent’s registration); *Toufigh v. Persona Parfum, Inc.*, 95 USPQ2d 1872, 1874 (TTAB 2010) (petitioner showed a reasonable belief that respondent’s registration would hinder petitioner in registering his mark).

Petitioner has introduced a copy of the application file for its Application Serial No. 87680188 showing its application was refused registration due to Respondent’s Registration which is the subject of this cancellation proceeding.⁷ Thus, Petitioner

⁷ *See* file history for Petitioner’s Application Serial No. 87680188, Petitioner’s Notice of Reliance on Trademark Registrations, Exhibit 1 (9 TTABVUE 6-177).

has shown a reasonable belief of damage and a real interest in this proceeding; therefore, it is not a mere intermeddler, and has established an entitlement to a statutory cause of action.

III. Background

Petitioner is a “venture-backed bare metal cloud computing company based in New York City” seeking registration of the stylized word mark PACKET based on its commercial use of the mark. Since December 2014, Petitioner has used the mark PACKET continuously in U.S. commerce specializing “in automating cloud-based computer infrastructure and communications services, providing network services and private hosting deployment solutions for over a thousand clients.”⁸

Petitioner filed application Serial No. 87680188 to register its stylized mark PACKET for services including “computer services, namely cloud hosting provider services” in International Class 42.⁹ Registration was finally refused under § 2(d) of the Trademark Act based on Respondent’s Registration No. 4738253 for the mark ONEPACKET registered for communications services including: providing computer network access points, data transmission services and providing multiple user access to a global computer information network, in Class 38; and computer services including: hosting the software, websites and other computer applications of others on a virtual private server; and hosting, managing, developing, analyzing, and

⁸ Declaration of Jacob Smith ¶¶ 3-4 (9 TTABVUE 279-280); Petitioner’s Notice of Reliance on Printed Publications ¶ 6, Exhibit 6 (9 TTABVUE 183, 265-278).

⁹ Smith Declaration ¶ 5 (9 TTABVUE 280) and Declaration of Paul E. Godinez ¶ 3 (9 TTABVUE 283) citing to Notice of Reliance on Trademark Registrations, Exhibit 1 (9 TTABVUE 2, 6-9).

maintaining the code, applications, and software for web sites of others, in Class 42 (complete identification of services set forth above).

Petitioner filed a petition to cancel Registration No. 4738253 alleging Respondent's abandonment of the ONEPACKET mark.¹⁰ In its Answer, Respondent denied abandonment of its ONEPACKET mark.¹¹ While Petitioner agreed to an extension of time for Respondent to respond to Petitioner's interrogatories and document requests, and followed up with Respondent requesting its responses several times, Respondent failed to provide any responses.¹²

Petitioner contends that Respondent admits it does not intend to resume use of the ONEPACKET mark for the services described in its Registration referring to an email dated April 30, 2019 it received from Respondent's CEO, Leon Croese:

As we discussed I send you a more detailed description of our services;

From the start the OnePacket brand was used for hosting activities, mainly managed dedicated hosting. This included associated services like security and backup services. Customers are mainly businesses worldwide.

Over time we transitioned the OnePacket brand more into a communications company providing network connectivity and network security services. Almost all of the managed hosting activity and customers have been moved to other brands we carry.

¹⁰ 1 TTABVUE.

¹¹ 5 TTABVUE.

¹² See Godinez Declaration ¶¶ 16-18, Exhibits 4-8 (9 TTABVUE 285-286, 311-312, 314, 316, 319, 321). To date, Respondent has not served responses to Petitioner's discovery requests (9 TTABVUE 286).

Hence I have no issue modifying our trademark class description in order for us to co-exist.¹³

After the discovery period closed and before Petitioner's trial period opened, Respondent filed a Post-Registration Amendment in Resolution of Cancellation Proceeding, with Petitioner's consent.¹⁴ Consistent with Respondent's earlier email, Respondent requested that its identification of services "be amended to delete the description of goods and services for Class 42 in its entirety and be replaced with a new description of goods and services" (set forth in Attachment A thereto, at 8 TTABVUE 4):

REVISED DESCRIPTION FOR CLASS 42:

~~IC 042: Computer services, namely, hosting the software, websites and other computer applications of others on a virtual private server; Internet-based application service provider, namely, hosting, managing, developing, analyzing, and maintaining the code, applications, and software for web sites of others; Computer services in the nature of developing, leasing, maintaining, configuring, updating, monitoring, optimizing, repairing and troubleshooting of computer software; Providing data backup services; computer services, namely, providing a website featuring technology that provides restoration services; network security management in the nature of firewall services and virus protection for hosted websites~~ Provision of access to telecommunications and communications networks; transmission of information, web pages, computer programs and other data via telecommunications network; data transmission services between networked computer systems via telecommunications means; provision of Ethernet based services; telecommunication services, namely, the transfer of packet-based data; telecommunications routing and junction services; provision of access to closed group networks; wide area network services, namely, electronic transmission of data over long distances between computers and computer users; provision of network security management, namely, firewall services for servers and networks; provision of information, advice and consultancy relating to all the aforementioned services.

¹³ Godinez Declaration ¶ 21, Exhibit 9 (9 TTABVUE 286, 323).

¹⁴ Filed on August 9, 2019, *see* 8 TTABVUE (. . . If the Board accepts Registrant/Respondent's requested amendment, then consistent with the parties' agreement, Petitioner will withdraw its Notice of Cancellation.).

Before the Board acted on Respondent's Post-Registration Amendment and prior to the opening of its testimony period, Petitioner filed Notices of Reliance on Trademark Registrations (including its pending trademark application) and Printed Publications, the Declarations of Jacob Smith, its Chief Marketing Officer and co-founder of Petitioner, and Paul E. Godinez, Petitioner's trademark counsel, as well as its Trial Brief.

Although Petitioner's Notices of Reliance and Testimony Declarations were prematurely filed in view of the suspension of the proceeding noted in the Board's July 18, 2019 order (7 TTABVUE 2), Respondent did not object to them on grounds of untimeliness. Moreover, any such objections thereto would be waived as their premature submission could have been corrected if objected to on a timely basis. *Cf. Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555, 1556 n.2 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, but applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected on seasonable objection). Similarly, a notice of reliance filed prior to a party's scheduled trial period may also be considered under some circumstances. *See Plus Products v. Natural Organics, Inc.*, 204 USPQ 773, 775 n.5 (TTAB 1979) (untimely notice of reliance filed prior to testimony period considered where no objection was raised and error was not prejudicial). Inasmuch

as Respondent raised no evidentiary objections, the Board deemed Petitioner's evidence and Trial Brief to be timely filed.¹⁵

The Board later found Respondent's proposed amendment "unacceptable in its entirety as it identifies services that are not within the scope of the present identification." Accordingly, the Board denied Respondent's motion to amend without prejudice. In the interest of streamlining the proceeding and in light of Respondent's failure to object, the Board accepted Petitioner's brief and evidence, and reset the trial dates to commence with Respondent's pretrial disclosures.¹⁶ However, Respondent submitted no evidence during its assigned testimony period and did not file a trial brief.

The sole issue in this proceeding is whether Respondent abandoned its registered ONEPACKET mark by failing to use, or ceasing use of, the mark in the United States in connection with the services listed in its Registration without an intent to resume use.

IV. Abandonment

Under § 45 of the Trademark Act, 15 U.S.C. § 1127, a mark is considered "abandoned" if the following occurs:

¹⁵ Although the Board's July 18, 2019 order suspended the proceeding (7 TTABVUE 2), Petitioner filed its Notices of Reliance on Trademark Registrations (9 TTABVUE 2-181) and Printed Publications (9 TTABVUE 182-278), Smith Declaration (9 TTABVUE 279-282) and Godinez Declaration (9 TTABVUE 283-323), and its Trial Brief (10 TTABVUE) during the suspension. In the interest of streamlining the proceeding and in light of Petitioner's submission of evidence and filing of a trial brief, the Board subsequently reset the schedule to commence with Respondent's pretrial disclosures (11 TTABVUE).

¹⁶ See Board's September 22, 2020 order (11 TTABVUE 2-3).

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

15 U.S.C. § 1127.

Because registrations are presumed valid under 15 U.S.C. § 1057, Petitioner, the party seeking cancellation based on abandonment, bears the burden of proving a prima facie case by a preponderance of the evidence. *Quality Candy Shoppes/Buddy Squirrel of Wisconsin Inc. v. Grande Foods*, 90 USPQ2d 1389, 1393 (TTAB 2007) citing *On-Line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000); *Cerveceria Centroamericana S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989); *Exec. Coach Builders, Inc. v. SPV Coach Co.*, 123 USPQ2d 1175, 1180-81 (TTAB 2016). A petitioner's introduction of evidence of nonuse of a mark for three consecutive years constitutes a prima facie showing of abandonment and triggers a rebuttable presumption that the registrant abandoned the mark without intent to resume use. *Rivard v. Linville*, 133 F.3d 1446, 45 USPQ2d 1374, 1376 (Fed. Cir. 1998); 15 U.S.C. § 1127. If Petitioner presents a prima facie case of abandonment, the burden of production, i.e., going forward, then shifts to Respondent, the party contesting the abandonment, to produce evidence that it has either used the mark during the statutory period, or intended to resume use. *Cerveceria Centroamericana v. Cerveceria India*, 13 USPQ2d at 1312.

In support of its prima facie case of abandonment, Petitioner introduces the following evidence supporting Respondent's non-use of the ONEPACKET mark.

Petitioner's counsel of record testifies that he visited the address of Respondent listed on its Registration at 280 Madison Avenue, Suite 912, New York, NY 10016. The business located at that address was identified on the door as "www.Notary-NY.com." No one at Notary-NY.com could identify Respondent and the building staff at 280 Madison Avenue identified Notary-NY.com as the only tenant located in Suite 912.¹⁷ Notary-NY's website, www.notary-ny.com, shows that it promotes itself as a mobile notary service operating in New York City, Long Island and Lower Hudson Valley, and that "Notary New York, [is] an assumed name of New York Executive Office Inc."¹⁸ This evidence supports that Respondent is not located or doing business at the address listed on its certificate of registration, which is the address of record for Respondent, and that there is no connection between Respondent and Notary-NY.

Petitioner also submits a copy of Respondent's website dated September 11, 2019, identifying Respondent's U.S. address at 280 Madison Avenue, Suite 912, New York, NY 10016. The website displays a 2014 copyright notice, indicating no updates have been made to the site in at least five years. Additionally, as noted by Petitioner, Respondent's website does not list the names of any executives, employees or customers, nor does it list any other indication of use of the ONEPACKET mark in the sale of communications and computer services in the United States.¹⁹

¹⁷ Godinez Declaration ¶¶ 8-9, Exhibit 1 (9 TTABVUE 284-286, 289-290).

¹⁸ Petitioner's Notice of Reliance on Printed Publications ¶ 1, Exhibit 1 (9 TTABVUE 182, 186-194).

¹⁹ Petitioner's Notice of Reliance on Printed Publications ¶ 3, Exhibit 3 (9 TTABVUE 183, 200-203) consisting of pages from www.onepacket.com, i.e., Respondent's website (last accessed September 11, 2019). The top left-hand corner of its webpages show use of the copyright symbol in connection with OnePacket, i.e., "OnePacket©." In comparing the

Petitioner also submits copies of internet searches performed using the Google, Bing and Yahoo search engines. Petitioner offers these searches to show that other than OnePacket's (i.e., Respondent's) website, there are no online advertisements or marketing materials regarding Respondent's services or goods available for purchase from an online store or other public marketplace, nor are there any third-party reviews, news items or other media coverage regarding Respondent or any of its services or goods offered under the ONEPACKET mark.²⁰

Online search summaries are not usually received into evidence as they have limited probative value because they are often in the nature of listings of documents (i.e., the websites to which the summary links) rather than providing the context of the documents themselves. *See Calypso Tech., Inc. v. Calypso Capital Mgmt., LP*, 100 USPQ2d 1213, 1219 (TTAB 2011); *Safer Inc. v. OMS Investments Inc.*, 94 USPQ2d 1031 (TTAB 2010); § 704.08(b) of the TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE ("TBMP") (2021). Here, the evidence Petitioner introduces provides at least some context to mitigate the concerns expressed in *Calypso Tech.* and the TBMP regarding the limits of search summaries as it allows us to extract some content from the search summaries, providing sufficient context to give the results at least some probative value. *Cf. Mitchell Miller, A.P.C. v. Miller*, 105 USPQ2d 1615, 1617-18 (TTAB 2013) (search summaries with "sufficient surrounding text to determine that

September 2019 pages of Respondent's website with the pages submitted as a specimen of use on September 3, 2014, we note that they are identical, except that the September 2019 Services page deletes the last paragraph entitled Managed Hosting.

²⁰ Petitioner's Notice of Reliance on Printed Publications ¶ 2, Exhibit 2 (9 TTABVUE 182-183, 195-198).

MILLER is the surname of a particular individual, and that MILLER LAW GROUP is used in connection with that individual’s legal practice” were probative of the issue of whether MILLER was primarily merely a surname within the meaning of § 2(e)(4) of the Trademark Act and admissible over objection). Thus, we consider it for whatever probative value it may have.

Additionally, despite extensions of time graciously allowed by Petitioner for Respondent to answer Petitioner’s First Request for the Production of Documents and First Set of Interrogatories,²¹ no responses to Petitioner’s discovery requests were ever provided.²² The appropriate course of action, particularly in view of Respondent’s failure to respond to Petitioner’s Interrogatories,²³ was for Petitioner to file a motion

²¹ See Godinez Declaration ¶¶ 12-20 (9 TTABVUE 285-286). After the time for Respondent to respond to Petitioner’s Request for the Production of Documents and the Interrogatories elapsed, Mr. Croese sent an email to Petitioner’s counsel on April 8, 2019 explaining that the email from Petitioner’s counsel went into his Spam folder and stating “[i]f you still need them, I will do my best to get you the requested info and documents as soon as possible.” Godinez Declaration ¶ 16, Exhibit 4 (9 TTABVUE 285, 311-312)). Despite email follow-up by Petitioner (Godinez Declaration ¶ 17, Exhibit 5 (9 TTABVUE 285, 314)), Respondent failed to produce responses to Petitioner’s interrogatories and document requests, even after Respondent’s CEO again promised on April 11, 2019 that “[w]e are working on your request.” Godinez Declaration ¶ 18, Exhibit 6 (9 TTABVUE 286, 316). Having received nothing, Petitioner’s counsel sent emails to Mr. Croese on April 15 and 22, 2019, again requesting an update on when Respondent would produce the requested documents and provide answers to the Interrogatories. Godinez Declaration ¶¶ 19 & 20, Exhibits 7 & 8 (9 TTABVUE 286, 319, 321).

²² Godinez Declaration ¶ 22 (9 TTABVUE 286).

²³ The following unanswered Interrogatories of Petitioner requested particularly relevant information regarding Respondent’s use and promotion of its mark (see 9 TTABVUE 302, 306-307):

INTERROGATORY NO. 4: For each good or service that Respondent has offered, sold, or provided under or in connection with the Challenged Mark, state the date ranges of actual use of the Challenged Mark in connection with the good or service, including the specific date of first use or intended first use of the mark for each good or service.

INTERROGATORY NO. 6: Describe the nature of any advertisements, promotional materials, and marketing materials (for example, newspaper advertisements, magazine advertisements, internet websites, television commercials, brochures), including by

with the Board to compel answers. *See* 37 C.F.R. § 2.120(f). However, inasmuch as Petitioner failed to file a motion to compel, “it may not thereafter be heard to complain about the sufficiency thereof.” *See* TBMP § 523.04.

Reviewing the evidence, Petitioner has not presented a prima facie case of abandonment. Petitioner has shown that Respondent’s website bears the same copyright notice of 2014 as it did on the filing date of its application and on September 11, 2019; that Respondent does not have offices at the address identified on both its

identifying the specific media (for example, *The New York Times*, *Time* magazine, Google.com, CBS Network television) in which Respondent is using, has used, or plans to use the Challenged Mark.

INTERROGATORY NO. 8: Identify all website(s) displaying the Challenged Mark that are owned, operated, or controlled by Respondent, and all persons who participated in or were or are responsible for the creation and development of each website.

INTERROGATORY NO. 9: Describe all channels of trade in the United States through which Respondent has offered for sale, sold, or intends to offer for sale or sell goods or services under or in connection with the Challenged Mark.

INTERROGATORY NO. 10: Describe all classes and/or types of customers (for example, age, gender, socioeconomic group) that comprise the intended market for goods or services offered for sale, sold, or intended to be offered for sale or sold under or in connection with the Challenged Mark.

INTERROGATORY NO. 11: Identify the geographic regions in the United States in which Respondent has caused to be advertised, promoted, marketed, displayed, distributed, offered for sale, or sold, or plans or intends to advertise, promote, market, display, distribute, offer for sale, or sell, either directly or through others, any goods or services under or in connection with the Challenged Mark.

INTERROGATORY NO. 12: Identify and describe all expenditures incurred by you in connection with the development, production, distribution, promotion, advertisement, and sale of any goods or services under the Challenged Mark, including by identifying the nature and amount of each expenditure.

INTERROGATORY NO. 15: Describe all facts and circumstances that support Respondent’s allegation in paragraph 15 of its answer that “ONEPACKET explicitly denies that it did abandon or discontinue [use of] the ONEPACKET mark.”

INTERROGATORY NO. 16: State Respondent’s total annual sales of each good and service under or in connection with the Challenged Mark for each year since Respondent first used the Challenged Mark.

INTERROGATORY NO. 17: State Respondent’s total annual advertising expenditures for each year since Respondent first used the Challenged Mark.

certificate of registration and the USPTO's TDSR system; and that there is no advertising or promotional materials, or press coverage, available on the Google, Bing and Yahoo internet search engines (on September 11, 2019) regarding Respondent's services. Although this evidence is relevant, it does not establish Respondent's lack of use of its mark for a three-year period. While use in commerce of a service mark requires rendering the services, it does not require updates to a website, location at a specific address, or advertising in any specific venue. Abandonment is a question of fact; thus, any inference of abandonment must be based on proven fact. *Quality Candy Shoppes v. Grande Foods*, 90 USPQ2d at 1393. The record consists only of circumstantial evidence of abandonment. Petitioner could have taken the oral testimony deposition of Respondent to ascertain whether Respondent had indeed discontinued use of its registered mark and if so, whether it had any intent to resume use, but elected not to do so. Therefore, Petitioner has failed to make a prima facie showing that there is no use of Respondent's registered mark for the services identified in its Registration over a three-year period.

V. Conclusion

Petitioner has not shown a prima facie case of abandonment and has failed to demonstrate by a preponderance of the evidence that cancellation of Respondent's Registration No. 4738253 is warranted.

Decision: The Petition to Cancel Registration No. 4738253 for the mark ONEPACKET is dismissed.