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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

NetSpeak Corporation
v.
Columbia Telecommunications Group, Inc.

Opposition No. 91110328
to application Serial No. 75215850
filed on December 19, 1996

Jeffrey S. Ginsberg and Daniel H. Solomon of Kenyon & Kenyon
for NetSpeak Corporation.

William J. Thomashower of Kaplan, Thomashower & Landau LLP
for Columbia Telecommunications Group, Inc.

Before Seeherman, Walters and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Columbia Telecommunications Group, Inc. (a New York
corporation) has applied to register on the Principal
Register the mark WEBNETPHONE for goods amended to read as
"telephones and telephone accessories, namely, sound cards,
integrated circuits, and modems for data and voice

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communication via interconnected computer networks" in International Class 9.¹

NetSpeak Corporation (a Florida corporation) has opposed the application asserting as grounds therefor that it is the owner of Registration No. 2001102 for the mark WEBPHONE for "computer software and computer hardware that enable real-time audio communication over computer networks";² that opposer has priority because of the July 20, 1995 filing date of the application that matured into opposer's Registration No. 2001102; that opposer owns four pending applications, all for the mark WEBPHONE, all filed on November 20, 1997 based on claimed dates of first use (and all under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f)) -- (i) application Serial No. 75393535 for "computer software and computer hardware that enable multimedia data communications and conferencing over computer networks and telecommunications networks" (International Class 9), (ii) application Serial No. 75393831 for "computer software and computer hardware that enable real-time audio communication over computer networks" (International Class 9), (iii) application Serial No.

¹ Application Serial No. 75215850, filed December 19, 1996, is based on applicant's assertion of a bona fide intention to use the mark in commerce on the identified goods.

² Reg. No. 2001102 issued on the Principal Register on September 17, 1996; Section 8 affidavit accepted. The application was originally filed by The Internet Telephone Company (a Florida corporation), which assigned it to NetSpeak Corporation. See Reel 1494, Frame 0889.

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75393536 for a variety of goods in International Class 9 and a variety of services in International Class 42, and (iv) application Serial No. 75393753 for "information, directory and call processing services over computer networks and telecommunications networks" (International Class 38); that from a time prior to applicant's filing date (December 19, 1996), opposer has continuously used the mark WEBPHONE on or in connection with its goods and services; that "Opposer's mark WEBPHONE is symbolic of extensive good will and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising, promotion and sales of the goods and services in connection with the mark WEBPHONE" (paragraph 7); and that applicant's mark, when used on or in connection with its goods, so resembles opposer's previously used and registered mark, as to be likely to cause confusion, mistake, or deception.

Applicant/counterclaim petitioner (hereinafter applicant) filed an answer with a counterclaim to cancel opposer's pleaded Registration No. 2001102. In its answer applicant denies the salient allegations of the notice of opposition. In its counterclaim, applicant alleges that opposer/counterclaim respondent's (hereinafter opposer)

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asserted mark, WEBPHONE, "is generic, functional or merely descriptive ... and ... has no secondary meaning."³

In its answer to the counterclaim, opposer denies the salient allegations of applicant's counterclaim.

Pending Motions Decided / Pleadings

Briefs on the opposition and counterclaim were filed, and both parties included motions in their trial briefs.⁴

The Board notes that this case (first instituted in May 1998) is unusual in that there are several motions which are pending at this final stage of the proceeding. We shall now determine the pending motions.

The motions now pending before the Board are the following:

³ The counterclaim to cancel was filed prior to the subject registration being five years old. Therefore, all grounds for cancellation, including mere descriptiveness, were available to applicant. See Section 14(1) of the Trademark Act, 15 U.S.C. §1064(1).

Applicant submitted neither evidence nor argument in support of its pleaded counterclaim ground of "functional." Thus, this ground will not be further considered by the Board.

⁴ Opposer's March 13, 2003 consented motion to extend its testimony period as rebuttal in the opposition and as defendant in the counterclaim for a few days to March 26, 2003 is granted.

Opposer's amended consented motion (filed August 25, 2003, via certificate of mailing) to extend its time to file a reply brief to applicant's motion to dismiss under Trademark Rule 2.132, as well as applicant's consented motion (filed September 8, 2003, via certificate of mailing) to extend its time to file a reply brief on the counterclaim and a reply brief in support of its motion to dismiss under Trademark Rule 2.132 are each granted.

Opposer's original consented motion (filed August 18, 2003, via certificate of mailing) to extend time is considered moot as it was superseded by the amended motion.

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- (1) applicant's motion to dismiss under Trademark Rule 2.132;
- (2) applicant's motion to strike the affidavit testimony of Martin Rothberg, opposer's CEO;
- (3) opposer's motion to reopen its testimony period to allow newly discovered evidence; and
- (4) opposer's motion to amend its notice of opposition.

We consider first applicant's motion to dismiss under Trademark Rule 2.132. Opposer did not submit any testimony or other evidence during its testimony period. Applicant did not specify whether it seeks judgment under Trademark Rule 2.132(a) or (b), but that is immaterial as applicant stated the following in the introductory remarks to its cross-examination deposition of opposer's CEO, Martin Rothberg:

This is in effect the cross-examination testimony or deposition of [opposer] because we have agreed that [opposer's] direct evidence which was submitted as part of its rebuttal time, [opposer] did not submit evidence during the testimony period, but is submitting in rebuttal an affidavit of Martin Rothberg which we have with us.

We find this statement to indicate applicant's consent to continue trial of this case on the merits despite opposer's failure to submit evidence during its main testimony period. Moreover, applicant did not move to dismiss under Trademark Rule 2.132 prior to the opening of

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its own testimony period as required by Trademark Rule 2.132(c). The parties continued with trial after the close of opposer's testimony period, so there would be no saving or judicial economy for the parties or the Board in dismissing the case under Trademark Rule 2.132 at this stage and in these circumstances rather than deciding it on the merits. Applicant's motion to dismiss under Trademark Rule 2.132 is denied.

Turning next to applicant's motion to strike the affidavit testimony of Martin Rothberg (submitted by opposer on March 13, 2003, via certificate of mailing), it is clear that the affidavit does not include and is not accompanied by the written agreement of the adverse party as required by Trademark Rule 2.123(b). However, both parties have treated the affidavit as if it were of record, noting in particular, applicant's deposition of Mr. Rothberg, which is characterized as cross-examination. Thus, the Board considers Mr. Rothberg's affidavit to have been stipulated into the record. Applicant's arguments in support of its motion to strike relate to the weight to be accorded this evidence, not its admissibility. Applicant's motion to strike the affidavit of Martin Rothberg is denied.

Next, we turn to opposer's motion to reopen its testimony period for newly discovered evidence. The evidence opposer seeks to introduce as newly discovered

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consists of two exhibits to the declaration of Daniel Solomon, which was submitted with opposer's reply brief as plaintiff in the opposition and its trial brief as defendant in the counterclaim. Specifically, these are (1) Exhibit C -- a (heavily) redacted copy of a document titled "Trademark License Agreement," dated May 15, 2003, between opposer and Sprewell-Consultadorio e Projectos, LDA (located in Portugal)(Sprewell); and (ii) Exhibit B -- a printout of one page from a www.webphone.com web site, showing a copyright in the name of Sprewell thereon.

This evidence essentially relates to applicant's claim that opposer abandoned the mark WEBPHONE. Although the ground of abandonment was not pleaded, we find that it was tried by consent of the parties. Thus, we treat the pleadings to be amended to assert this ground. Applicant's ground of abandonment is added as a pleaded ground in the counterclaim pursuant to Fed. R. Civ. P. 15(b). However, as explained later in this opinion, we are denying applicant's abandonment counterclaim. Accordingly, no purpose would be served in reopening opposer's testimony period for the admission of additional evidence to prove opposer has not abandoned its mark. Therefore, opposer's motion to reopen is denied as moot.

Opposer's motion to amend its notice of opposition was offered in the alternative to applicant's motion to dismiss

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under Trademark Rule 2.132. Inasmuch as we have denied applicant's motion to dismiss, we do not have to reach opposer's motion to file an amended notice of opposition. However, to ensure the scope of the pleadings is clear, we will determine opposer's alternative motion to amend its pleading. Opposer seeks to amend the pleadings to include a claim of likelihood of confusion with respect to its Registration No. 2094102.⁵ This registration was not pleaded in the original notice of opposition, and opposer has not provided any reason why leave should be granted to amend the pleadings at this stage of the proceeding. See *Long John Silver's, Inc. v. Lou Scharf, Inc.*, 213 USPQ 263 (TTAB 1982). Moreover, it is clear that the issue of likelihood of confusion with respect to the additional registration was not tried. Accordingly, opposer's motion to amend the pleadings under either Fed. R. Civ. P. 15(a) or (b) is denied.⁶

⁵ Registration No. 2094102 issued on the Principal Register on September 9, 1997, for the mark WEB PHONE ("phone" disclaimed) for "providing telephone directory information over a global computer information network." A Section 8 affidavit has been filed.

⁶ We note that opposer's originally pleaded Registration No. 2001102 and opposer's second Registration No. 2094102 are the subject of separate petitions to cancel filed by a third-party, Samsung Telecommunications America, Inc. (Cancellation No. 92028616 involves Registration No. 2100102 and Cancellation No. 92028617 involves Registration No. 2094102. These cancellation petitions are currently consolidated and pending at the Board.)

The Record

The record consists of the pleadings; the file of the opposed application; the file of the registration which is the subject of applicant's counterclaim; and the affidavit testimony of Martin Rothberg, and applicant's cross-examination of this witness. Applicant has submitted, under a notice of reliance, (i) printouts from the USPTO's Trademark Electronic Search System (TESS) of four applications as well as copies of four Board decisions thereon, all marked "not citable as precedent,"⁷ (ii) printouts of additional records from the USPTO's Trademark Electronic Search System (TESS) for 11 applications for marks which include the words "web" and "phone," (iii) a printout of a listing from the USPTO's Trademark Electronic Search System (TESS) showing the first 100 "hits" in a listing format of the 1067 records for applications and registrations in which the term "web" has been disclaimed, and (iv) printouts of stories retrieved from the Westlaw database. Applicant also submitted printouts of pages from opposer's web site and Adir Technologies, Inc.'s web site. Printouts of Internet pages do not constitute printed

⁷ While the copies of non-precedential Board decisions are admissible under Trademark Rule 2.122(e), nonetheless, these decisions, each marked "not citable as precedent," are of no precedential value and, thus, have not been considered. See

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publications within the meaning of Trademark Rule 2.122(e), and thus may not be made of record by way of notice of reliance. See TBMP §704.08 (2d ed. June 2003). However, because both parties have treated this material as if it were of record, we consider it to have been stipulated into the record.

Opposer has submitted, under a notice of reliance, (i) printouts of stories retrieved from the Westlaw database and the Nexis database, (ii) printouts of several third-party registrations from the USPTO's Trademark Electronic Search System (TESS) wherein the term "web" is not disclaimed, and (iii) copies of four Board decisions, all marked "not citable as precedent"⁸; and opposer's affidavit testimony of Martin Rothberg, CEO of both Adir Technologies, Inc. and opposer. Finally, applicant submitted the cross-examination testimony of Martin Rothberg;⁹ and applicant's notice of reliance on the assignment abstract for opposer's pleaded Registration No. 2001102, showing opposer, NetSpeak Corporation, as the owner thereof.

We note two final matters regarding the record as argued in the parties' briefs, the first being the parties'

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270, footnote 9 (TTAB 1992).

⁸ These decisions have not been considered as explained in footnote 6, *infra*.

⁹ The cross-examination deposition transcript was originally taken as "confidential," but when submitted by applicant, the cover letter explained that opposer withdrew its preliminary confidential designation.

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various requests for judicial notice and the second being applicant's request that the Board draw adverse inferences from opposer's witness's refusal to answer various questions.

Applicant requests that the Board take judicial notice of dictionary definitions of "web" as the "world wide web" and "phone" as "a shorthand reference of telephone."

(Applicant's opening brief, p. 10). Although applicant did not provide copies of any dictionary definitions, we hereby grant applicant's request for judicial notice, and we specifically take judicial notice of The American Heritage Dictionary of the English Language (Fourth Edition 2000) definitions of "phone" as "n. A telephone," and "web" as "n. ... 6. often Web, The World Wide Web."

In its brief as defendant in the counterclaim and reply brief as plaintiff in the opposition, opposer requests that the Board take judicial notice of third-party applications and registrations which are the results of opposer's search of the Internet website www.saegis.com, as "these searches [contain] information from the U.S. Patent and Trademark Office's federal trademark database."

The cases are legion that the Board does not take judicial notice of third-party applications or registrations, or of search reports taken from private company's databases. See *In re Carolina Apparel*, 48 USPQ2d

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1542, footnote 2 (TTAB 1998); and *In re Smith & Mehaffey*, 31 USPQ2d 1531, footnote 3 (TTAB 1994). See also, TBMP §704.03(b)(1)(B) (2d ed. June 2003), and cases cited therein. Opposer's request for judicial notice of the search report results is denied.

On page 15 of that same brief, opposer referred to the USPTO's acceptance of opposer's Section 8 affidavit filed in connection with its Registration No. 2001102. Opposer asserts that the affidavit, and the specimen submitted with the affidavit, is evidence that the mark is being used in commerce for the goods identified in the registration; and opposer then simply makes reference to its previous request for judicial notice. To the extent opposer seeks judicial notice that it is using its mark in commerce, that is not a matter appropriate for judicial notice. See Fed. R. Evid. 201(b); and TBMP §704.12 (2d ed. June 2003). Opposer's request for such judicial notice is denied.

In applicant's opening brief, it specifically requests that the Board draw adverse inferences from the refusal (on instruction of counsel) of Martin Rothberg, opposer's CEO, to answer questions on asserted generic uses of the term "WEBPHONE." See pp. 70-77 of the deposition. Having carefully reviewed this testimony and the reasons for the refusal to answer, we conclude that the questions propounded by applicant on cross-examination did exceed the scope of

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Mr. Rothberg's affidavit testimony. Thus, we will not draw adverse inferences against opposer. However, the testimony and exhibits remain of record for whatever probative value they have. We disagree, though, with applicant's argument that because Exhibit Nos. 5 and 6 are of record as part of Exhibit E to applicant's notice of reliance, they are proper subject matter for cross-examination. We also disagree with applicant's argument that opposer's attorney's instruction to the witness not to answer certain questions is grounds to strike the Rothberg affidavit.¹⁰

As explained above, both parties filed briefs on the case.¹¹ Neither party requested an oral hearing.

The Parties

Opposer NetSpeak Corporation was acquired for approximately \$48 million by and became a wholly-owned subsidiary of Adir Technologies, Inc. in the summer of 2001. (Dep., pp. 9, 13 and 48). As stated by Mr. Rothberg in his

¹⁰ Opposer's attorney, Mr. Solomon, submitted a declaration with opposer's brief as defendant in the counterclaim and its reply as plaintiff in the opposition. This is an untimely submission, and has not been considered by the Board. Moreover, Exhibits B and C are not part of the record in view of our denial of opposer's motion to reopen testimony for newly discovered evidence. Even if considered, these materials are of limited probative value and would not alter our decision herein.

¹¹ Neither party's brief included a description of the record or a statement of the issues. Such information is generally helpful to the Board. Both parties' attorneys are strongly urged to supply such information in future briefs in inter partes Board cases. See Trademark Rule 2.128(b); and TBMP §801.03 (2d ed. June 2003).

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affidavit, NetSpeak Corporation first used the mark WEBPHONE for Internet telephony¹² services on September 25, 1995; that "[F]ollowing the acquisition, the WebPhone service was placed on hold while the businesses were being integrated..."; and that while the service was on hold, opposer never intended to abandon use of the mark WEBPHONE and in fact, it plans to license the mark to Adir's parent company, Net2Phone, Inc. (Aff. Paragraphs 3, 5 and 7.)

Mr. Rothberg later testified (during the cross-examination deposition) regarding the products offered by NetSpeak Corporation under the mark WEBPHONE as follows (dep., pp. 18-20):

Q. Did they show you any products using their Webphone name?

A. They showed us their Webphone products.

Q. What did that consist of at that time? This is prior to the acquisition sometime.

A. They have a PC to phone offering. Excuse me. PC to PC offering, PC to phone offering as well as Internet call waiting product which they utilized their Webphone client for that offering.

Q. Now, were there plans made to terminate those products in connection with the acquisition?

A. No.

...

¹² The Board takes judicial notice of the Computer Desktop Encyclopedia (Ninth Edition 2001) definition of Internet telephony as "Using the Internet for a voice call." See TBMP §704.12(a) (2d ed. June 2003).

- A. NetSpeak had a service component that they were marketing to consumers. That was put on hold after the acquisition, but the product, the Webphone product that they offered to service providers was utilized before the acquisition, during the acquisition and to this day [is] being utilized.

Mr. Rothberg explained that Adir Technologies, Inc. provides its product to the service providers to enable them to offer PC to PC, PC to phone and Internet call waiting solutions to their customers. (Dep., p. 22.) Mr. Rothberg testified that his companies get customers through "resellers"; that documentation is sent out to customers who inquire about the WEBPHONE product. It is clear from his testimony that he had not seen the packaging, the CDs or advertising carrying the mark; and that he was not familiar with the service offered by NetSpeak Corporation prior to its acquisition by Adir Technologies, Inc. (Dep., pp. 28-30.) Prior to the acquisition of NetSpeak Corporation by Adir, he was aware of opposer through trade shows, and he had seen the software box that had a WEBPHONE product in it, but he never had used the product. (Dep., p. 35.)

Mr. Rothberg was unaware of who put the notice up on opposer's web site that "... the NetSpeak Webphone service has been discontinued. ..." (Applicant's Exhibit No. 2 -- www.webphone.com), or when it was put up. (Dep., pp. 43-44.) But to his knowledge the WEBPHONE service that was

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placed on hold has not been restored, and he was not aware of any business plans to do so. (Dep., pp. 55-56.)

Mr. Rothberg was aware that Adir Technologies, Inc. has participated in discussions regarding the licensing of the WEBPHONE mark for Internet telephony services, but he was not aware of whether or not an actual licensing contract had been drawn up yet. (Dep., pp. 58-60.)

What limited information we have about applicant comes from its application. Applicant is a corporation of New York originally located in Port Washington, New York, now in Farmingdale, New York; and that it asserts a bona fide intention to use the mark WEBNETPHONE in commerce on the identified goods.

Burden of Proof

In Board proceedings regarding the registrability of marks, our primary reviewing Court has held that the plaintiff must establish its pleaded case (e.g., likelihood of confusion, genericness, descriptiveness), as well as its standing, and must generally do so by a preponderance of the evidence. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993); *Magic Wand Inc. v. RDB Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1554 (Fed. Cir. 1991); and *Cerveceria*

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Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307, 1309 (Fed. Cir. 1989).

Thus, opposer bears the burden of proving by a preponderance of the evidence its standing, and its claim of priority and likelihood of confusion, and applicant (as plaintiff in the counterclaim) bears the same burden of proof as to its claims of abandonment, genericness and mere descriptiveness.¹³

We now turn to the merits of the claims of the parties, starting with applicant's counterclaim.

Counterclaim

Abandonment

The Trademark Act provides for the cancellation of registrations if use of the registered mark has been abandoned. See Section 14 of the Trademark Act, 15 U.S.C. §1064. The Trademark Act defines abandonment as discontinued use with intent not to resume use. See Section 45 of the Trademark Act, 15 U.S.C. §1127. Because registrations are presumed valid under the law, the party seeking cancellation must rebut this presumption by a preponderance of the evidence. See On-Line Careline Inc. v.

¹³ Applicant's standing to maintain the counterclaim is inherent in its position as defendant in the opposition proceeding in which opposer asserted the registration against applicant. See Ceccato v. Manifattura Lane, 32 USPQ2d 1192, footnote 7 (TTAB

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America Online Inc., 229 F.3d 1080, 56 USPQ2d 1471, 1476 (Fed. Cir. 2000).

The evidence relating to opposer's asserted abandonment of its mark WEBPHONE consists of Exhibit A to applicant's notice of reliance, consisting of printouts of four web pages from three web sites; the affidavit of Martin Rothberg, CEO of opposer and CEO of Adir Technologies, Inc.; and applicant's cross-examination deposition of Mr. Rothberg, with exhibits (including two of the four pages from web site printouts--Exhibit Nos. 2 and 3).

What evidence there is about non-use refers to non-use of the mark WEBPHONE for a service. The web site page so heavily relied on by applicant reads as follows:

NetSpeak, Inc. no longer exists as a public corporation. As a result, the NetSpeak Webphone service has been discontinued. We apologize for any confusion or inconvenience. Thank you for your patronage. www.webphone.com (Applicant's Exhibit No. 2.)

However, the registration sought to be cancelled is for goods, not services. There is no specific evidence relating to opposer ceasing use of the mark on goods, and particularly to the goods identified in the registration which is sought to be cancelled. To the contrary, in Mr. Rothberg's affidavit he avers only that the WEBPHONE *service* was temporarily placed on hold. (Paragraphs 5-7.) And, in

1994); and Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14

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his cross-examination testimony, he testified that opposer's "service component" was put on hold after the acquisition; that there were no plans to terminate the products in connection with the acquisition of opposer by Adir; that the WEBPHONE product was utilized before, during and after the acquisition; and that opposer uses the mark WEBPHONE in its literature when it is selling the product to service providers. (Dep., pp. 18-21).

Applicant has not proven either that opposer ceased use of the mark WEBPHONE for "computer software and computer hardware that enable real-time audio communication over computer networks," or that, if there had been nonuse, opposer had no intent to resume use of the mark. Therefore, applicant has not established abandonment.

Genericness

Section 14(3) of the Trademark Act, 15 USC §1064(3), permits cancellation of a registration if the "registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered..."

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation to refer to the genus or category of goods or services in question. See *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d

USPQ2d 1879 (TTAB 1990).

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987, 228 USPQ 528 (Fed. Cir. 1986). In making our determination, we follow the two-step inquiry set forth in that case and reaffirmed in *In re American Fertility Society*, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), namely:

- (1) What is the genus or category of goods at issue?, and
- (2) Is the designation sought to be registered understood by the relevant public primarily to refer to that genus or category of goods?

"The correct legal test for genericness, as set forth in *Marvin Ginn*, requires evidence of 'the genus of goods or services at issue' and the understanding by the general public that the mark refers primarily to 'that genus of goods or services.'" *American Fertility Society*, 51 USPQ2d at 1836. That is, do the members of the relevant public understand or use the term sought to be registered to refer to the genus of the goods and/or services in question?

The genus or category of goods involved in this case is "computer software and computer hardware that enable real-time audio communication over computer networks"--the goods identified in opposer's registration.

In support of applicant's contention that opposer's registered mark is generic, applicant points to (i) the common dictionary meanings of the two individually assertedly generic terms, each having a commonly understood meaning; (ii) precedent, both citable -- e.g., *In re Web*

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Communications, 49 USPQ2d 1478) (TTAB 1998) and not citable; (iii) evidence from the USPTO's Trademark Electronic Search System (TESS) of several applications and registrations in which the term "web" is part of the marks and was disclaimed; and (iv) copies of printed publications wherein the term "webphone" is used.

Opposer argues that its mark is a coined term consisting of two common words; that its goods are not telephones used to access the World Wide Web, but rather are computer hardware and software that enable people to use the Internet for making a voice call; that applicant's "dictionary" approach is not sufficient to prove genericness in this case; that opposer has made of record information from the USPTO's Trademark Electronic Search System (TESS) showing that there are many registrations for marks which include the word "web," in which the term has not been disclaimed (opposer's Exhibit C to its notice of reliance); that there are several instances in which WEBPHONE appears as opposer's trademark in printed publications (opposer's Exhibit A to its notice of reliance); and that applicant's references to uses of the term WEBPHONE in printed publications are generally inapposite because several of the publications are foreign and thus do not reflect the significance of the mark to consumers in the United States, while others refer to telephones that can access or browse

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the World Wide Web, which are not the same as opposer's goods.

In considering the understanding of the relevant public, we must first determine who comprises the public for the identified goods. See *Magic Wand Inc. v. RDB Inc.*, supra; and *Stocker v. General Conference Corp. of Seventh-day Adventists*, 39 USPQ2d 1385, at 1394 (TTAB 1996). In this case, we find the relevant public is general consumers in the United States.

As previously stated, it is applicant's burden (as plaintiff in the counterclaim) to establish, by a preponderance of evidence, that the registered mark is generic. Aside from the dictionary definitions, applicant's evidence essentially consists of copies of 11 stories retrieved from Westlaw's "ALLNEWS" database. Of these 11 stories, 2 are from foreign publications. Opposer is correct that some of the remaining 9 stories do not relate to opposer's goods, but rather they relate to uses of "Web phone" or "Webphone" for a telephone that can access or browse the World Wide Web.

Only a few of the excerpts from publications distributed in the United States utilize the term "Web phone" or "Webphone" for computer hardware or software that is for audio communication over computer networks. See

e.g., Rothberg, dep., applicant's Exhibits Nos. 5 ("Forbes," July 9, 2001) and 6 ("BusinessWeek," July 9, 2001).¹⁴

There is a high standard to find a term generic. See *Marvin Ginn v. International Association*, supra; and *Magic Wand v. RDB*, supra. In the case now before us, applicant asks that we cancel opposer's registration for the mark WEBPHONE based on dictionary definitions of the separate words, a few articles from printed publications, and records of the USPTO showing disclaimers of the term "web." Applicant's evidence is weak or ambiguous. For example, evidence showing the descriptiveness of "web" is not sufficient to show that "web phone" is generic. Nor do we agree with applicant that the circumstances of this inter partes case involving opposer's use of WEBPHONE fit squarely within the circumstances of the case of *In re Gould Paper*, 834 F.2d 1017, 5 USPQ2d 1110 (Fed. Cir. 1987) (involving the mark SCREENWIPE), which was subsequently discussed and limited by the Court in *American Fertility*, supra. While opposer's goods enable people to use their computers as they would use a telephone, clearly the computer hardware and computer software are not really a "telephone."

¹⁴ As mentioned previously, the witness was instructed to not answer questions regarding these exhibits, but as decided previously herein, we do not draw an adverse inference against opposer based thereon. The articles (Exhibit Nos. 5 and 6) were also part of applicant's Exhibit E to its notice of reliance. They are in the record for whatever probative value they have, and even if negative inferences were drawn against opposer, it would not alter our decision herein.

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Although there are a few excerpted articles in which "webphone" is used in a generic manner, there are also printed publications showing use of WEBPHONE as opposer's trademark.

In view of the limited and conflicting evidence of generic use, and the lack of direct evidence of consumer understanding of this mark as a generic term for opposer's goods, we find that applicant has not established, by a preponderance of the evidence, that the mark WEBPHONE is generic for "computer software and computer hardware that enable real-time audio communication over computer networks."

Mere Descriptiveness

Once again, applicant (as plaintiff in the counterclaim) bears the burden of proving, by a preponderance of the evidence, its asserted ground of mere descriptiveness.

The test for determining whether a mark is merely descriptive is whether the mark immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). Moreover, in order to be merely descriptive, the mark must

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immediately convey information about the goods or services with a "degree of particularity." In re TMS Corporation of the Americas, 200 USPQ 57, 59 (TTAB 1978); and In re Entenmann's Inc., 15 USPQ2d 1750, 1751 (TTAB 1990), aff'd, unpub'd, Fed. Cir. February 13, 1991. Whereas a mark is suggestive if imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See In re Quik-Print Copy Shop, Inc., 616 F.2d 523, 205 USPQ2d 505 (CCPA 1980).

Of course, whether a mark is merely descriptive is determined not in the abstract, but in relation to the goods or services for which the mark is registered, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term or phrase would have to the average purchaser of the goods or services because of the manner of its use. See In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); and In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

While the test for mere descriptiveness is different from that for genericness, we find, on this sparse record, that applicant has not established the mark WEBPHONE is merely descriptive of opposer's identified goods. Opposer's goods are not telephones or "phones" per se; rather, opposer's goods enable the purchasers and users thereof to engage in audio communication over the Internet.

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Based on the record before us and the limited evidence that has been submitted, we find that applicant has not established, by a preponderance of evidence, that the mark WEBPHONE is merely descriptive of opposer's identified goods.

Applicant's counterclaim petition to cancel opposer's Registration No. 2001102 is denied.¹⁵

Opposition

Standing and Priority

Applicant makes much of opposer's failure to submit a proper status and title copy of its pleaded Registration No. 2001102, or otherwise properly make the registration of record under Trademark Rule 2.122(d). However, opposer's registration is of record by virtue of the counterclaim brought by applicant. See Trademark Rule 2.122(b).¹⁶ Because opposer's pleaded Registration No. 2001102 is of

¹⁵ Of course, on a different record, we might reach a different result. (We note that opposer's involved registration remains the subject of Cancellation No. 28616, consolidated with Cancellation No. 28617.)

¹⁶ If a registration owned by a party has been properly made of record in an inter partes case (as is the case here), and there are changes in the status of the registration between the time it was made of record (when applicant filed its counterclaim) and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the United States Patent and Trademark Office. See TBMP §704.03(b)(1)(A) (2d ed. June 2003), and the cases cited therein. The Board hereby takes judicial notice of the current status of opposer's Registration No. 2001102, specifically, opposer's Section 8 affidavit has been accepted by the USPTO.

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record, we find that opposer has established its standing. In addition, in view of opposer's ownership of a valid and subsisting registration for its WEBPHONE mark, the issue of priority does not arise in this opposition proceeding. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 181 USPQ 272, at footnote 6 (CCPA 1972); and *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995).

Likelihood of Confusion

We turn now to a consideration of the issue of likelihood of confusion. Our determination of likelihood of confusion 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. See *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 any likelihood of confusion analysis, two key considerations are the similarities of the marks and the similarities of the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated

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by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [and services] and differences in the marks."). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997). In fact, in this case, as explained previously herein, opposer submitted no evidence on the issue of likelihood of confusion. Therefore, we are essentially left with the marks and the goods as set forth in applicant's application and opposer's registration.

Turning first to a consideration of the parties' respective goods, in Board proceedings the issue of likelihood of confusion must be determined in light of the goods as identified in the involved application and registration and, in the absence of any specific limitations therein, on the presumption that all normal and usual channels of trade and methods of distribution are or may be utilized for such goods. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, N. A. v. Wells Fargo Bank*, 811 F.2d 490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983).

The goods involved herein are opposer's "computer software and computer hardware that enable real-time audio communication over computer networks" and applicant's

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"telephones and telephone accessories, namely, sound cards, integrated circuits, and modems for data and voice communication via interconnected computer networks." As identified, opposer's goods are computer hardware and software which allow audio communication over computer networks, while applicant's goods are telephones and telephone accessories allowing data and audio communication over computer networks. These identifications of goods are not the same on their face -- computer hardware and software vis-a-vis telephones and telephone accessories. While both have an audio component, there is no evidence that these goods are made or sold by the same entities. Opposer's statement in its brief (p. 4) that "it is likely that the products of the two companies will be in direct competition" is completely unsupported in the record.

Opposer has failed to establish that the parties' respective goods are related within the meaning of the Trademark Act. That is, opposer has not proven that the relevant consumers are likely to believe that goods of this type would emanate from the same source. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); and *Recot Inc. v. M.C. Becton*, 214 F.3d 1332, 54 USPQ2d 1894 (Fed. Cir. 2000).

While there are no limitations in either party's identification of goods as to channels of trade and/or

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conditions of sale, nonetheless there is likewise no evidence regarding these du Pont factors. Thus, we cannot find that these respective goods are likely to be sold through the same channels of trade.

Turning next to a consideration of the similarities or dissimilarities of the marks, we first address opposer's assertion in its opening brief (p. 1) that "Opposer has developed protectable rights in a family of WEBPHONE marks (both as one and two words)... ." It is an understatement to say that opposer has not proven (or even pleaded) a family of WEBPHONE marks. Opposer's claim of a family of WEBPHONE marks will not be further addressed herein.

In this case, we must determine the similarities and dissimilarities of the marks WEBPHONE and WEBNETPHONE. Earlier in this decision, we took judicial notice of the dictionary definition of "web" as "World Wide Web" and "phone" as "telephone." We also take judicial notice from the same dictionary (The American Heritage Dictionary of the English Language (Fourth Edition 2000)), of the definition of the term "Net" as "n. The Internet." Clearly the two elements comprising opposer's mark are weak, highly suggestive or descriptive words, and when these elements are combined as WEBPHONE, we find that opposer's mark is highly suggestive and is not entitled to a broad scope of

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protection.¹⁷ See *General Mills Inc. v. Health Valley Foods*, supra; *Local Trademarks Inc. v. The Handy Boys Inc.*, 16 USPQ2d 1156 (TTAB 1990); *Wooster Brush Co. v. Prager Brush Co.*, 231 USPQ 316 (TTAB 1986); *Color Key Corp. v. Color Associates, Inc.*, 219 USPQ 936 (TTAB 1983); and *Industrial Adhesive Co. v. Borden, Inc.*, 218 USPQ 945 (TTAB 1983).

In the context of opposer's goods (computer software and computer hardware used for audio communication over computer networks), the term "phone" has a different nuance or connotation with regard to computer hardware and computer software than it does for telephones. While in the context of applicant's goods (telephones and telephone accessories including modems for data and voice communication via computer networks), the term "phone" is generic.

Further, applicant's mark, which combines the similar terms "web" and "net," creates a repetitive, incongruous impression. Thus, the overall connotations of the parties' respective marks, WEBPHONE and WEBNETPHONE, in the context of the parties' respective goods, are somewhat different. In addition, because of this incongruity in applicant's mark, the presence of the word "NET" is likely to make an impression on consumers, thus emphasizing the differences in appearance and sound in the marks.

¹⁷ As indicated previously, we cannot find on this record that

As the Court of Customs and Patent Appeals (the predecessor Court to our primary reviewing Court) stated in *Sure-Fit Products Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 117 USPQ 295 (CCPA 1958): "Where a party chooses a weak mark, his competitors may come closer to his mark than would be the case with a strong mark without violating his rights. The essence of what we have said is that in the former case there is not the possibility of confusion that exists in the latter case." See also, *In re National Data Corporation*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); and 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition, §11:73 (4th ed. 2001).

In view of the differences in the marks and the goods, and the weakness of opposer's mark, we find that confusion from applicant's use of its mark is unlikely.¹⁸

Decision: The counterclaim petition to cancel opposer's Registration No. 2001102 is denied, and the opposition is dismissed.

opposer's mark is merely descriptive.

¹⁸ Applicant argued, inter alia, that "there are a large number of other similar marks in use for similar goods," referring to evidence of applications and registrations from USPTO's Trademark Electronic Search System (TESS). (Applicant's opening brief, pp. 6-7.) Suffice it to say that we find there is no evidence of use of similar marks in this record.