

**THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB**

Mailed:  
April 8, 2008

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

Panic, Inc.  
v.  
Panicware, Inc.

—————  
Opposition No. 91160780  
to application Serial No. 78185656  
filed on November 15, 2002; and,  
to application Serial No. 78187217  
filed on November 20, 2002

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Gary H. Lau, Esq. for Panic, Inc.

Panicware, Inc., *pro se*.

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Before Drost, Taylor and Bergsman, Administrative Trademark  
Judges.

Opinion by Bergsman, Administrative Trademark Judge:

Panicware, Inc. filed two use based applications for the mark PANICWARE, in standard character format, for the following goods and services, as ultimately amended:

Computer software services for enhanced computer privacy control, namely technical support services relating to monitoring software; dissemination of information over a global computer communications network in the fields of elimination of user input records and detection of monitoring software; providing temporary use of on-line, non-downloadable software for scanning and elimination of user input on remote

computers over a network; notification and delivery of software updates, in Class 42 (Serial No. 78185656); and,

Computer software for enhancement of a user's Web browsing experience, namely privacy control software; content filtering software; software for identifying the use of monitoring utilities; downloadable software for updating other software for use in content filtering and privacy control; and computer networking software, in Class 9 (Serial No. 78187217).

Panic, Inc. opposed the registration of both of applicant's marks on the following grounds:

1. Applicant's mark falsely suggests a connection with opposer under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a);
2. Applicant's mark is likely to cause confusion with opposer's mark, PANIC for "downloadable software for use in decoding, encoding and managing digital audio; downloadable computer software for transmitting, receiving and managing data using the file transfer protocol, both for general use" under Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d);<sup>1</sup> and,

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<sup>1</sup> Registration No. 2397125, issued October 24, 2000; canceled under Section 8 of the Trademark Act of 1946, 15 U.S.C. §1058, on July 28, 2007.

3. Applicant's mark is likely to dilute the distinctive quality of opposer's mark under Section 43(c) of the Trademark Act of 1946, 15 U.S.C. §1125(c).

Only opposer introduced evidence and filed a brief. However, in its brief, opposer only discussed the issue of likelihood of confusion under Section 2(d) of the Trademark Act. Opposer limited its evidence and argument in its brief to the issue of likelihood of confusion. Accordingly with respect to the issues of whether applicant's mark falsely suggests a connection with opposer and dilution, we give those claims no further consideration. *See Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1653, n. 3 (TTAB 2002); *Viacom International Inc. v. Komm*, 46 USPQ2d 1233, 1235 n.3 (TTAB 1998).

#### Evidentiary Issues

- A. Exhibits attached to opposer's brief.

Opposer attached seven exhibits to its brief. "Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony." TBMP §704.05(b) (2<sup>nd</sup> ed. rev. 2004) and the cases cited therein. Accordingly, we have given the exhibits attached to opposer's brief no consideration.

B. Exhibits attached to opposer's notice of reliance.

The only evidence in the record is opposer's notice of reliance. We have attempted, to the best of our ability, to identify below the documents proffered through opposer's notice of reliance. However, opposer did not identify the documents or the relevance of those documents as required by Trademark Rule 2.122(e), 37 CFR 2.122(e).

1. A copy of a service mark application for PANIC;<sup>2</sup>
2. An exchange of emails between the parties regarding the status of the proceeding;
3. Copies of an August 29, 2003, March 7, 2003, and February 11, 2003 "cease and desist" letters from opposer to applicant;
4. A copy of opposer's pleaded registration;
5. Press releases and articles posted on websites;
6. An article entitled "*Hot Stuff*" in the May 2005 issue of *MacWorld*;
7. An unidentified document entitled *Panic Inc. MacWorld Expo SF 2005*;
8. Excerpts from the January 26, 2001 and April 1, 2005 issues of the U.K. version of *MacUser* magazine;
9. Copies of emails from opposer's customers and potential customers;

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<sup>2</sup> There is no evidence that the application was ever filed.

10. An excerpt from applicant's website;
11. Copies of applicant's applications from the Trademark Office electronic database; and,
12. An excerpt from opposer's website.

Trademark Rule 2.122(e), 37 CFR §2.122(e), provides that a party may introduce into evidence through a notice of reliance "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant." Also, public records may be introduced through a notice of reliance. In view thereof, we may only consider the copies of the official records from the U.S. Patent and Trademark Office and the excerpts from magazines in general circulation. We cannot consider the email correspondence and the regular correspondence between the parties, nor may we consider the excerpts from Internet websites because, *inter alia*, they are not proper subjects for introduction into evidence through a notice of reliance. We hasten to add, however, that even if we considered all of the evidence introduced by opposer, it would not change our decision.

#### Standing and Priority

A party has standing to bring an opposition if it has a personal stake in the outcome of the case. It is a threshold question directed solely to establishing the

interest of the party. Standing is a part of opposer's case, and it must be affirmatively proved. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Compuclean Marketing v. Berkshire Products Inc.*, 1 USPQ2d 1323, 1324 (TTAB 1986) (standing is an essential element in any opposition). In this case, opposer has failed to present any evidence establishing opposer's use or registration of its pleaded mark.

Opposer's pleaded registration is not sufficient to prove opposer's standing because it has been canceled, and therefore it has no evidentiary value. *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1487 n.9 (TTAB 2007); *Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc.*, 204 USPQ 144, 147 (TTAB 1979); *General Precision, Inc. v. Thein*, 13 USPQ2d 478, 479 n.1 (TTAB 1962). Moreover, there is no evidence in the notice of reliance that opposer uses "Panic" as a trademark.<sup>3</sup>

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<sup>3</sup> With respect to opposer's service mark application, it is only evidence of the filing of the application. Even if opposer had filed the application, the dates of use and specimens are not evidence of use on behalf of the opposer. *Lasek & Miller Associates v. Rubin*, 201 USPQ 831, 833 n.3 (TTAB 1978); *St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co.*, 196 UPSQ 778, 780 n.4 ((TTAB 1977); TBMP §704.03(b)(2) (2<sup>nd</sup> ed. rev. 2004).

Even though opposer did not allege that it had used "Panic" as a trade name, we searched opposer's notice of reliance in vain to find any trade name use of "Panic."<sup>4</sup> The closest use we could find was an excerpt from a *Macworld* magazine, December 2004. In the *Help Desk* column, with a subtitle *Mac 911*, regarding changing icons, there is an obtuse reference: "Or you can take the easy route: Purchase Panic's \$13 CandyBar utility."<sup>5</sup>

A trade name means "any name used by a person to identify his or her business or vocation." (Emphasis added). Section 45 of the Trademark Act of 1946, 15 U.S.C. §1127. See also *W. End Brewing Co. of Utica, N.Y. v. S. Australian Brewing Co.*, 2 USPQ2d 1306, 1307 (TTAB 1987), quoting *Weldon Farm Products, Inc. v. Packaging Enterprises, Inc.*, 197 USPQ 584, 589 (TTAB 1977) ("all that is required is that the designation in question be a name or title which has been lawfully adopted and previously used in the United States by an entity engaged in trade or commerce and capable of suing or being sued, and not abandoned").

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<sup>4</sup> An opposition can be granted based on opposer's prior use of a trade name. Section 2(d) of the Trademark Act of 1946, 15 U.S.C. §1052(d). See also *W. Florida Seafood, Inc. v Jet Restaurants, Inc.*, 31 F.3d 1122, 31 USPQ2d 1660, 1665 (Fed. Cir. 1994).

<sup>5</sup> Opposer proffered a May 2005 issue of *Macworld* that featured a column introducing opposer's TRANSMIT file transfer protocol, but the only reference to opposer was a domain name (www.panic.com). Also, opposer proffered two U.K. issues of *MacUser*. We have not given these magazines any consideration because there is no evidence that they have been circulated in the United States. Moreover, the use of "Panic" in *MacUser* is similar to the use

The reference in *Macworld* is not use by opposer. It is a reference by the author of the article. Use of a term by third parties to refer to an entity or its goods and services may inure to the benefit of that entity when such use is sufficiently open and public that it creates an association in an appropriate segment of the public. *NCTA v. American Cinema Editors*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) ("The evidence is profuse that Editors has publicly been known as ACE since prior to 1979"); *American Stock Exchange, Inc. v. American Express Co.*, 207 USPQ 356, 361, 364 (TTAB 1980) ("the record is sufficient to show that the term 'Am Ex Co' was used . . . by the public and by applicant itself to refer to applicant and its services" because "'AMEXCO' or variations thereof have frequently been used to refer to applicant"); *Norac Co. Inc. v. Occidental Petroleum Corp.*, 197 USPQ 306, 315 (TAB 1977) ("the record shows overwhelming evidence of use and public recognition of the term 'OXY' in association with and to identify respondent"); *Volkswagenwerk A.G. v. Thermo-Chem Corp.*, 185 USPQ 561, 562 (TTAB 1975) ("The record shows that the public in general, opposer, its dealers and writers have used the word 'BUG' to identify the automotive vehicles sold by opposer," in addition to a survey establishing that there is an association of 'BUG' with Volkswagen); *Pieper v.*

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described below in the *MacWorld* magazine because it is not use by

*Playboy Enterprises, Inc.*, 179 USPQ 318 (TTAB 1973) ("the term 'BUNNY CLUB' was being used in newspaper articles synonymously with 'PLAYBOY CLUB' and such use was not de minimus but, as the record shows, quite extensive"). One reference, buried in an article in one issue of a magazine of unknown circulation is not sufficient to demonstrate that there is a public association of the name "Panic" with opposer.

Moreover, even if we found that the one reference was sufficient to prove a public association of the name "Panic" with opposer, that reference appeared in the December 2004 issue of *Macworld*, a date two years after the filing date of the applications at issue (*i.e.*, November 15, 2002 and November 20, 2002).

In this proceeding, opposer's case was essentially unopposed. As indicated above, applicant did not introduce and testimony or evidence, and it did not file a brief. Despite applicant's lack of participation, we have been presented with a record that is too sparse to establish opposer's standing and priority of use. Accordingly, because the record falls below the threshold levels of proof on the issues of standing and priority of use, we are required to find for applicant.

Decision: The opposition is dismissed with prejudice.

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opposer.