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UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Mailed: April 20, 2007

Opposition No. 91171124

Google Inc.

v.

Pivot Design, Inc.

**Before Quinn, Hairston and Kuhlke,  
Administrative Trademark Judges.**

By the Board:

Opposer, Google, Inc., has filed an opposition against registration of the mark BLOGLE (stylized) for "computer software for searching, compiling, indexing and organizing information"<sup>1</sup> alleging that the mark so resembles opposer's previously-used and registered mark GOOGLE,<sup>2</sup> which opposer

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<sup>1</sup> Ser. No. 78664488, filed July 6, 2005.

<sup>2</sup> In the notice of opposition, opposer alleged ownership of three registrations and four pending applications for the mark GOOGLE. One of the applications has now matured to registration. The registrations are: Reg. No. 2806075 for the mark GOOGLE for, *inter alia*, "providing multiple user access to proprietary collections of information by means of global computer information networks," registered January 20, 2004; Reg. No. 2884502 for the mark GOOGLE for "computer hardware; computer software for creating indexes of information, indexes of web sites and indexes of other information resources;" registered September 14, 2004; Reg. No. 2954071 for the mark GOOGLE for goods in international classes 9, 11, 12, 16, 18, 21, 25, 28, and 35, registered May 24, 2005; and Reg. No. 3140793 (identified as Ser. No. 76317811 in the notice of opposition) for the mark GOOGLE for, *inter alia*, "computer software for searching, compiling, indexing and organizing information on computer networks;" registered September 12, 2006. The applications are Ser. Nos. 78433507, 78828042, and 78828053.

uses in connection with a search engine provided to consumers for searching the Internet, as to cause confusion, mistake, or deception. Applicant filed an answer to the notice of opposition, denying the salient allegations of the complaint.

This case now comes before the Board for consideration of opposer's motion (filed November 22, 2006) for partial summary judgment on its pleaded claim of likelihood of confusion, and for consideration of applicant's motion (filed October 5, 2006) to amend the filing basis of its application from Trademark Act Section 1(a) to Section 1(b). Office records indicate no response was filed to applicant's motion to amend. The motion for summary judgment has been fully briefed.

A motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c); TBMP § 528.01 (2d ed. rev. 2004). To prevail on its motion, opposer must establish that there is no genuine issue of material fact in dispute, thus leaving its claim of likelihood of confusion to be resolved as a matter of law. See *Celotex Corp. v. Catrett*, 477 U.S. 317 (1986); *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Opposer has submitted certified copies showing current status and title of its registrations and applications for the mark GOOGLE. This proof, in addition to establishing that there are no genuine issues of material fact regarding opposer's standing, removes the issue of priority from this case. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Accordingly, the focus of our determination is whether there are any genuine issues of material fact in dispute as to opposer's claim of likelihood of confusion. Our determination is based on an analysis of the probative facts in evidence that are relevant to the likelihood of confusion factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

We turn first to the factor of fame, because this factor "plays a 'dominant role' in the process of balancing the du Pont factors." *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000); see also *Kenner Parker Toys Inc. v. Rose Art Industries, Inc.*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). In order to measure the fame of a mark, we look to "the volume of sales and advertising expenditures for the goods and services sold under the mark, and by the length of time those indicia of commercial awareness have been evident." *Blue Man Productions, Inc. v. Tarmann*, 75 USPQ2d 1811, 1817 (TTAB 2005).

Opposer has submitted the declaration of its senior in-house trademark attorney, Rose Hagan, in support of its assertion that its mark is famous. Ms. Hagan states that opposer has used its mark continuously since 1997 in connection with the offering of "search engine software" and that opposer has provided "blog searching" since 2000. Ms. Hagan further states that over 300 million "visitors with I.P. addresses in the United States" per day visited the Google website in 2006; that "considering only United States revenue" the company's revenues have risen from over 400 million dollars in 2002 to 7.3 billion dollars in 2006; and that "recognition of opposer's mark (and the associated growth in opposer's revenues) has occurred without extensive advertising."

These sales and usage figures evidence wide consumer exposure of opposer's mark. Also significant are two surveys submitted under the declarations of Ms. Hagan and Matthew Schneller (one of opposer's attorneys). The "Reader's Choice" survey conducted by Interbrand Consultancy indicates that "Google" and "Google.com" were among the top 5 leading brands worldwide from 2001-2005. A "Data Memo" from Pew Internet American Life Project, entitled "Search Engine Use November 2005," indicates that "Google was the most heavily used search engine [in the United States] in October 2005."

Opposer has also submitted two online dictionary definitions of "Google," which have been authenticated by Mr. Schneller. *The Merriam Webster Collegiate* (2006) online dictionary defines "google" as a "trademark for a search engine." *The Oxford English Dictionary Online* defines "google" as a "proprietary name for an Internet search engine" in an entry dated June 2006; but the entry is marked as only a "draft." We additionally take judicial notice of the definition of the term "google" that appears in *The American Heritage Dictionary of the English Language*, 4<sup>th</sup> ed. 2006):<sup>3</sup>

Google - A trademark used for an Internet search engine. This trademark often occurs in print as a verb, sometimes in lowercase: "A high school English teacher ... recently Googled a phrase in one student's paper and found it had been taken from a sample essay of an online editing service"

"When a trademark attains dictionary recognition as a part of the language, we take it to be reasonably famous." *B.V.D. Licensing v. Body Action Design*, 846 F.2d 727, 6 USPQ2d 1719, 1720 (Fed. Cir. 1988); see also *The B.V.D. Licensing Corporation v. Florencio Rodriguez*, \_\_\_ USPQ2d \_\_\_, (TTAB 2007). Applicant has presented no evidence or argument to rebut opposer's evidence of fame. Based on this

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<sup>3</sup> Retrieved April 13, 2007, from Dictionary.com website: <http://dictionary.reference.com/browse/google>. The Board may take judicial notice of online dictionary definitions where the dictionary exists in printed format. See *In re CyberFinancial.Net Inc.*, 65 USPQ2d 1789, 1791 n.3 (TTAB 2002); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

record, we find that the mark GOOGLE is famous for search engine software and related services, and opposer has established that no genuine issue of material fact remains as to this issue.

Two additional considerations in determining whether there is a likelihood of confusion are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). The Lanham Act's tolerance for similarity between competing marks varies inversely with the fame of the prior mark. "As a mark's fame increases, the Act's tolerance for similarities in competing marks falls." *Kenner Parker Toys*, 963 F.2d at 353. Moreover, "when marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

Here, opposer's goods encompass applicant's goods and opposer's services are closely related to applicant's goods. Applicant seeks to register its mark for "computer software for searching, compiling, indexing and organizing information." Opposer's registrations cover, *inter alia*, "computer software for creating indexes of information, indexes of web sites and indexes of other information

resources" and "providing multiple user access to proprietary collections of information by means of global computer information networks." There are no genuine issues of material fact that the goods are legally identical for purposes of our likelihood of confusion analysis and that opposer's services are closely related to applicant's goods. Further, applicant does not dispute the relatedness of the goods and/or services.

The crux of applicant's argument is that genuine issues of material fact preclude summary judgment because the marks are different. The similarity or dissimilarity of the marks is assessed by comparing the marks "in their entireties as to appearance, sound, connotation and commercial impression." See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 476 F.2d at 1361). In appearance, both marks contain six letters, the last four of which are identical, giving the marks a similar appearance despite the difference in the beginning letters of each. As for their pronunciations, each mark is made up of two syllables having a similar cadence. Importantly, the connotation of applicant's mark includes the word "blog." A "blog" is defined as an abbreviation for "weblog," which is further defined as "a website that displays in chronological order the postings by one or more individuals and usually

has links to comments on specific postings." *The American Heritage Dictionary of the English Language* (4<sup>th</sup> ed. 2006).<sup>4</sup>

Applicant admits that the word "blog" is descriptive of an online diary (response to request for admissions No. 9), and that it intends to use its mark for an Internet search engine (response to request for admissions No. 2). Thus, the impression of applicant's mark is that of a "search engine for blogs." Ms. Hagan states that opposer engages in "blog searching." When considered in the context of the connotation of applicant's mark and the fact that the marks are used, or intended to be used, on legally-identical goods, there are no genuine issues of material fact that the marks have a similar overall commercial impression.

The manner of use of applicant's mark adds to the overall similarity of the commercial impression of the marks. While applicant now seeks to amend its application to claim Section 1(b) as a basis, when it initially filed its application, applicant claimed that it had used the mark on a "website home page" and submitted a specimen of use. "In trying to visualize what other forms the mark might appear in, we are aided by the specimens submitted with [applicant's] application as illustrating 'the mark as actually used.'" *Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376,

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<sup>4</sup> Retrieved April 13, 2007, from Dictionary.com website: <http://dictionary.reference.com/browse/blog> and <http://dictionary.reference.com/browse/weblog>.

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1378, 170 USPQ 35, 36 (CCPA 1971) (applicant applied to register mark in typed format). We may look to how competing marks are displayed when considering whether they project confusingly similar commercial impressions. See *Uncle Ben's Inc. v. Stubenberg International Inc.*, 47 USPQ2d 1310, 1312 (TTAB 1998) (fact that applicant had "chosen to display its mark in the color blue" although it applied for registration in typed format served to enhance confusion); cf. *Kenner Parker Toys*, 963 F.2d at 355 ("The trade dress of the marks enhances their inherently similar commercial impression").

Applicant's mark as it appears in the specimen submitted in support of applicant's application shows the first four letters of its mark ("BLOG") in orange and the last two letters ("LE") in blue. Opposer's mark as it appears in the specimen of use submitted for opposer's application serial no. 78433507 shows the mark in the colors red, blue, green and yellow.

The marks are reproduced below.



Opposer's registration no. 3140793 has been lined for these same colors and includes a description of the mark as consisting of "the first letter "G" is blue; the second letter "O" is red; the third letter "O" is yellow; the fourth letter "G" is blue; the fifth letter "L" is green;

and the sixth letter "E" is red. The mark is reproduced below.

The word "Google" is rendered in a classic, outlined, sans-serif font. Each letter is composed of two parallel lines, creating a hollow, wireframe effect. The letters are evenly spaced and centered on the page.

The use of colored letters in the parties' marks as well as the similarities in their stylizations enhances the inherently-similar commercial impressions made by the marks. Thus, due to their similar sight, sound and connotations, as well as overall commercial impressions, we find no genuine issues of material fact that the marks are confusingly similar.

In sum, given the fame of opposer's mark, the similarity of the marks, the legally-identical nature of the goods involved and the close relationship between opposer's services and applicant's goods, we find that opposer has borne its burden to show the absence of genuine issues of material fact as to whether there is a likelihood of confusion as a matter of law.

Accordingly, opposer's motion for summary judgment is hereby granted, the opposition is sustained and registration to applicant is refused.<sup>5</sup>

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<sup>5</sup> In view thereof, applicant's motion to amend its application is denied as moot. Further, we need not reach opposer's alternate claim of dilution pleaded in the notice of opposition.