Paper No. 14
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 7/31/00

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

SOHO Internetwork, Inc.
v.
Advanced Intelligent Networks Corporation

Opposition No. 110,081
to Application No. 75/134,814
filed on July 16, 1996

Adam M. Cohen of Kane Kessler for opposer.

Sabrina C. Stavish of Sheridan, Ross & McIntosh for applicant.

Before Simms, Hohein and Walters, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

SOHO Internetwork, Inc. has filed an opposition to the application of Advanced Intelligent Networks Corporation to register the mark SOHONET for “computer software for solving multimedia communications problems relating to directing electronic mail, facsimiles, voice mail and

telephone calls, and determining communication protocols" in International Class 9.[1]

As grounds for opposition, opposer asserts that applicant's mark is merely descriptive of the identified goods, under Section 2(e)(1) of the Trademark Act, and has not acquired distinctiveness, under Section 2(f) of the Trademark Act; or, alternatively, that applicant's mark, when applied to applicant's goods so resembles opposer's mark SOHONET, previously used for hosting and designing sites on the World Wide Web, designing and licensing computer software for Internet applications, and goods and services related to electronic mail and dial-up Internet connectivity, as to be likely to cause confusion, under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of opposer's claims.

The Record

The record consists of the pleadings; the file of the involved application; and the testimony deposition by opposer of John Bogosian, opposer's chief operating

[1] Application Serial No. 75/134,814, filed July 16, 1996, based upon an allegation of a bona fide intention to use the mark in commerce in connection with the identified goods.

officer, with accompanying exhibits,[2] including applicant's answers to opposer's interrogatories. Applicant filed no testimony or other evidence. Only opposer filed a brief on the case and a hearing was not requested.

The Parties

Opposer sells a number of Internet-related goods and services. Mr. Bogosian, opposer's chief operating officer, testified that opposer's business includes Web hosting and design. He described Web hosting as "taking clients' data, hosting it on our file servers and connecting that data to Internet users over a network." He described Web design as database development and/or graphic design using Hyper Text Mark-up Language (HTML) formatting. Mr. Bogosian stated that opposer has also provided dial-up Internet access

---

[2] Opposer's attorney stated during Mr. Bogosian's deposition that Exhibit No. 18 is confidential and is submitted under seal. In this regard, we note the relevant provisions of Trademark Rule 2.125(e), 37 CFR §2.125(e):

> Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept confidential under the provisions of §2.27(e).

However, opposer has not requested a protective order with respect to this exhibit, nor have the parties filed a stipulated protective order. Therefore, within thirty days of the date of this decision, opposer is directed to prepare a protective order, preferably upon terms mutually agreeable to opposer and applicant, for the Board's consideration, including an explanation of why the exhibit submitted under seal is deemed to be confidential in nature. We will keep opposer's exhibit under seal until we decide opposer's motion upon resubmission. If no resubmission is made within the specified period, we will place opposer's Exhibit No. 18 in the opposition file.

service, e-mail services with dial-up access, and software development services. In addition to custom software development, opposer has a family of software products under the mark RunTime, including a Web content management system and a content filtering engine, which allows information to be cached.

Opposer began using the trademark SOHONET in connection with the above-described goods and services when it began its business in April, 1995, and has continued to use it in connection with its goods and services to the present. Opposer displays its SOHONET mark on its Web site, on advertising brochures, on letterhead stationery, and has registered Sohonet.com as an Internet domain name.

Applicant, in its answer, admitted "that [applicant][3] is in the business of selling computer software and providing services relating to the integration of electronic mail, facsimile, telephone and other modes of communication and operating Web sites." In answers to opposer's interrogatories, without specifying the nature of the use or the particular goods and/or services involved, applicant stated that it first used its mark in August, 1996, and first used its mark in commerce in October, 1996.

[3] Applicant's answer contains what is clearly a typographical error referring to "opposer's" business, whereas the referenced paragraph in the notice of opposition identifies "applicant's" business.

We note that the application herein is based on a bona fide intention to use the mark in commerce on a specifically identified software product and no amendment alleging use has been filed.

Analysis

The opposition herein is based on the alternate claims of mere descriptiveness, or priority and likelihood of confusion. However, while opposer pled mere descriptiveness and argued the issue in its brief, opposer has not established, on the record before us, that SOHONET is merely descriptive in connection with applicant's identified goods.

We consider, next, the issues of priority and likelihood of confusion. Opposer has established that it is the owner of the mark SOHONET for the goods and services described herein and that the mark has been in continuous use in interstate commerce in connection with these goods and services since April 1995. Because this date is prior to the filing date of applicant's intent-to-use application and applicant has not otherwise established use of its mark in commerce in connection with the identified goods, we find that opposer has established its priority in this case. *See Zirco Corp. v. American Telephone and Telegraph Co.,* 21 USPQ2d 1542 (TTAB 1991).

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. du Pont de Nemours & Co.,* 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Key considerations in this case are the identity of the marks and the similarities between the goods and services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Considering, first, the marks, there is no question that the parties' marks are identical.

With respect to the goods and services of the parties, we find that applicant's goods and opposer's goods and services are closely related. Both parties' facilitate access to e-mail. Additionally, applicant, in its answer, admitted that its products facilitate communication via the Internet. Similarly, opposer's goods and services pertain to communication via the Internet. Further, in the relatively short period of time that the parties have been coexisting, opposer has established, and applicant does not dispute, that actual confusion in the nature of misdirected e-mail communications has occurred.

In view of the identity of the parties' marks, SOHONET, and the close relationship between applicant's

goods and opposer's goods and services, we conclude that the contemporaneous use of the parties' marks on or in connection with their respective goods and services is likely to cause confusion as to the source or sponsorship of such goods and services.

Decision: The opposition is sustained under Section 2(d) of the Trademark Act, on the ground of likelihood of confusion; and dismissed under Section 2(e)(1) of the Trademark Act, on the ground of mere descriptiveness.

R. L. Simms

G. D. Hohein

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board