

This Opinion is Not a
Precedent of the TTAB

Mailed: December 30, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Rubicon Communications, LLC

v.

Nexgate, Inc. fka Social iQ Networks Inc. and Proofpoint, Inc.

Opposition No. 91218371

Dwayne K. Goetzel of Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C.,
for Rubicon Communications, LLC.

Michael S. Lemley of Nexgate, Inc. and Proofpoint, Inc.,
for Nexgate, Inc. fka Social iQ Networks Inc.

Before Lykos, Kuczma, and Hightower,
Administrative Trademark Judges.

Opinion by Hightower, Administrative Trademark Judge:

Nexgate, Inc., formerly known as Social iQ Networks Inc., and Proofpoint, Inc.

(“Applicants”) seek to register the mark NEXGATE (in standard characters) on the

Principal Register for the following services in International Class 42:¹

¹ Application Serial No. 86155724, filed January 1, 2014, based on Applicant Nexgate, Inc.’s claim of first use anywhere on April 10, 2013 and use in commerce since April 30, 2013 under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Assignment of the application to Applicant’s successor Proofpoint, Inc. was recorded with the U.S. Patent and Trademark Office (PTO) Assignment Recordation Branch on June 2, 2015, at Reel/Frame 5540/0262, after commencement of this proceeding. As such, Proofpoint, Inc. is joined as a party

Providing a secured-access, members only website featuring technology that gives members the ability to find, audit, monitor and secure the user access and content shared on social media network accounts, pages or sites.

Rubicon Communications, LLC (“Opposer”) opposes registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), asserting priority and a likelihood of confusion with its mark NETGATE, registered (in standard characters) on the Principal Register for the following goods in International Class 9:

- “Telecommunications products, namely, encryption devices to enable a virtual private telecommunications network,”² and
- “Computer hardware, namely, computer chips and modules for wireless communications, data communications, and voice communications; computer software for controlling, operating, and interfacing with wireless communications systems; computer hardware and software enabling wireless access to a computer-based information network; computer network security software for protecting networks from unauthorized access.”³

Opposer filed its brief on September 22, 2016. Applicants filed an answer denying the allegations in the Notice of Opposition, but submitted neither evidence nor a brief. Nonetheless, Opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1848 (Fed. Cir. 2000).

We sustain the opposition pursuant to Trademark Act Section 2(d).

defendant. See *Interstate Brands Corp. v. McKee Foods Corp.*, 53 USPQ2d 1910, 1911 n.1 (TTAB 2000) (adding assignee as a party at final decision); see also TBMP § 512.01 (2016).

² Registration No. 3146119, issued September 19, 2006 from an application filed May 14, 2001; renewed. The mark is a typed drawing, as standard character drawings were known before November 2, 2003. A typed mark is the legal equivalent of a standard character mark. Trademark Manual of Examining Procedure (TMEP) § 807.03(i) (October 2016).

³ Registration No. 3161285, issued October 24, 2006 from an application filed March 10, 2004; renewed.

I. Record

The record in this case consists of the pleadings and, without any action by the parties, the file of the involved application. Trademark Rule 2.122(b)(1), 37 C.F.R. § 2.122(b)(1).

In addition, Opposer made of record by Notice of Reliance the following evidence:

- Copies of Opposer's two pleaded registrations and pending application to register the mark NETGATE (in standard characters), printed from the PTO's Trademark Electronic Search System (TESS) database;⁴
- Opposer's requests for admission to Applicants, along with a statement that Applicants failed to respond to the requests, such that the requests are deemed admitted under FED. R. CIV. P. 36(a)(3);⁵ and
- Internet printouts from or concerning Opposer's and Applicants' websites and social media presence.⁶

II. Opposer's Standing and Priority

Standing is a threshold issue that must be proven by the plaintiff in every *inter partes* case. See *Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014), *cert. denied*, 135 S. Ct. 1401 (2015); *John*

⁴ Notice of Reliance, Exhibit 1, 9 TTABVUE 6-14. Application Serial No. 86375940 recites the following services in International Class 42: "Support services, namely, troubleshooting of computer software problems; providing software updates and bug fixes; consulting services regarding VPN and firewall configuration, and best practices for the use and installation of software; maintenance of computer software; computer software development; computer software consulting; consulting services in the field of design, selection, implementation and use of computer hardware and software systems for others; technological consultation in the technology field of computer hardware systems; consulting in the field of configuration management for computer hardware and software." The application was filed August 25, 2014, based on Opposer's claim of first use anywhere on November 10, 1992 and use in commerce since April 15, 1993, under Section 1(a) of the Trademark Act.

⁵ Notice of Reliance, Exhibit 3, 9 TTABVUE 2, 23-37. Opposer also submitted copies of its interrogatories and requests for production to Applicants, but they are not properly of record and have been given no consideration in this decision. See Trademark Rule 2.120(j)(3)(i).

⁶ Notice of Reliance, Exhibit 4, 9 TTABVUE 65-184.

W. Carson Found. v. Toilets.com Inc., 94 USPQ2d 1942, 1945 (TTAB 2010). Opposer's standing to oppose registration of Applicants' mark is established by its pleaded registrations, which the record shows to be valid and subsisting, and owned by Opposer. *See, e.g., Cunningham*, 55 USPQ2d at 1844; *Otter Prods. LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012). In addition, because Opposer's pleaded registrations are of record and Applicants did not counterclaim to cancel them, priority is not an issue with respect to the goods covered by Opposer's pleaded registrations. *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (citing *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974)).

III. Likelihood of Confusion

Our determination under Trademark Act Section 2(d) is based on an analysis of all probative facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); *see also In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, key considerations are the similarities between the marks and the similarities between the goods or services, the first two *du Pont* factors. *See Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

We address in turn the *du Pont* factors on which our decision rests.

A. Similarity of the Marks

We begin with consideration of the first *du Pont* factor, the similarity of the parties' marks. In a likelihood of confusion analysis, we compare the marks in their entirety for similarities and dissimilarities in appearance, sound, connotation and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). "The proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that persons who encounter the marks would be likely to assume a connection between the parties." *Coach Servs. Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

Applicants' mark is NEXGATE. Opposer's mark is NETGATE. The marks differ by only one letter, with Applicants' mark incorporating an "X" instead of a "T" before the suffix GATE. By way of their deemed admissions, Applicants admitted certain similarities between the marks, including that their mark "sounds similar" and "is visually similar" to Opposer's mark.⁷ There is a slight difference in connotation between the marks, with Opposer's mark suggesting a gate to the Internet and Applicants' mark perhaps implying that it offers the "next" gate. Nonetheless, we find these two nearly identical marks to be similar in appearance, sound, and overall commercial impression. The first *du Pont* factor weighs in favor of a finding that confusion is likely.

⁷ Requests for Admission 25 and 26, 9 TTABVUE 33.

B. Similarity of the Goods and Services

The second *du Pont* factor assesses the similarity or dissimilarity of the parties' goods and services. In comparing the goods and services, the issue to be determined "is not whether the goods [and services] of plaintiff and defendant are likely to be confused but rather whether there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). The parties' goods and services need not be similar or even competitive to support a finding of likelihood of confusion. It is sufficient that the respective goods and services are related in some manner, or that the conditions surrounding their marketing are such that they would be encountered by the same consumers under circumstances that could, in light of the similarity of the marks, give rise to the mistaken belief that they originate from or are associated with the same source. *See In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785 (TTAB 1993).

As noted *supra*, Applicants' services are "Providing a secured-access, members only website featuring technology that gives members the ability to find, audit, monitor and secure the user access and content shared on social media network accounts, pages or sites." Goods identified in Opposer's pleaded Registration No. 3161285 include "computer network security software for protecting networks from unauthorized access."

It is apparent from the identifications that Opposer's goods and Applicants' services offer means of securing access to computer networks on the one hand and social media network accounts, pages, or sites on the other. Through their deemed

admissions, moreover, Applicants admitted that both parties' marks are or will be used in connection with "security issues relating to computer use" and "security for information technology," and that Opposer's mark "can be used in connection with security for issues relating to social media."⁸

Therefore, we find that Applicants' services are inherently related to the "computer network security software for protecting networks from unauthorized access" identified in Opposer's Registration No. 3161285. The second *du Pont* factor also weighs in favor of a likelihood of confusion.

IV. Conclusion

We have found that the critical first and second *du Pont* factors weigh in favor of a likelihood of confusion, while no factors weigh against such a finding. Considering the record evidence as a whole, we find that Opposer has carried its burden to establish by a preponderance of the evidence that Applicants' mark NEXGATE is likely to cause consumer confusion with Opposer's mark NETGATE when used in association with the parties' respective goods and services.

Decision: The opposition to registration of Applicants' mark is sustained pursuant to Section 2(d) as to Opposer's Registration No. 3161285.

⁸ Requests for Admission 28-33, 9 TTABVUE 33-34.