

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

RIPL CORP., a Washington corporation,
Plaintiff,

No. 2:12-cv-02050-RSM
ORDER ON MOTIONS

v.

GOOGLE INC., a Delaware corporation,
Defendant.

GOOGLE INC., a Delaware corporation,
Counterclaimant,

v.

RIPL CORP., a Washington corporation,
Counterdefendant.

I. INTRODUCTION

Before the Court are several discovery-related motions and cross motions for summary judgment in this trademark infringement action between Plaintiff RIPL Corp. (“RIPL”) and Defendant Google Inc. (“Google”). The Court heard argument on the cross motions for summary

1 judgment on March 24, 2014. For the reasons that follow, Google’s Motion for Summary
2
3 Judgment (Dkt. ## 99, 100) is granted in its entirety; RIPL’s Motion for Partial Summary
4
5 Judgment (Dkt. # 94) is denied; RIPL’s Motion to Dismiss (Dkt. # 55) is stricken as moot;
6
7 Google’s two Motions to Compel (Dkt. ## 27, 63) and its Motion for a Protective Order (Dkt. #
8
9 44) are stricken as moot; RIPL’s Sealed Motion to Waive Attorney/Client Privilege (Dkt. # 60) is
10
11 stricken as moot; and the remaining Motions to Seal (Dkt. ## 57, 97, 104) are granted.
12
13

14 **II. BACKGROUND**

15
16
17 This is a reverse confusion trademark infringement case between RIPL, the senior user of
18
19 “RIPL” and Google, the junior user of “RIPPLES.” RIPL was founded in 2005 as Kahuna
20
21 Technologies, Inc. (“Kahuna”) to develop and operate proprietary software. When Kahuna
22
23 obtained the domain name “ripl.com” in 2006, it changed its name to RIPL. It later filed an
24
25 application for RIPL as a service mark for use in connection with Internet-related services. RIPL
26
27 owns a U.S. Service Mark on “RIPL,” Registration Number 3,490,487, which issued on August
28
29 19, 2008.
30
31

32
33 The first identified use of the RIPL mark in connection with consumer services occurred
34
35 on March 27, 2007, when RIPL made a “web application for the automated sharing of content
36
37 between users based on the interests they share” available to a limited number of University of
38
39 Washington students, faculty, and staff with a University of Washington e-mail address. Dkt. #
40
41 103, Alger Decl., Ex. A (RIPL Dep. 84:1-21); Dkt. # 102, Alger Decl., Ex. E at 5-7. The March
42
43 27, 2007 release was referred to as the “beta launch.” RIPL received mixed reviews about the
44
45 launch and the user accounts were thought to be “wiped” from the system. *See* Dkt. # 103, Alger
46
47 Decl., Ex. B (Messing Dep. 62:6-10). RIPL then turned its attention to creating its Application
48
49
50
51

1 Programming Interface (“API”), which it released in 2009 or 2010. *See id.* at 146:2-150:6. The
2
3 API was based on the original automated content sharing software but was designed for
4
5 corporate customers to run the content sharing software on their own websites. *Id.* RIPL was
6
7 unsuccessful in licensing the API to any third-party business. *Id.* at 52:3-5. The API was
8
9 marketed, but never sold, to several media companies.¹
10

11
12 RIPL’s CEO, Bill Messing, has been the sole employee of RIPL since October 2008. Dkt.
13
14 # 103, Alger Decl., Ex. A (RIPL Dep. 21:25-22:11). RIPL has not filed any tax returns since
15
16 2007, and has never had any revenue. Dkt. # 103, Alger Decl., Ex. A and B (Messing Dep.
17
18 138:3-13; RIPL Dep. 200:5-10, 237:16-21). Mr. Messing maintains at least one website for the
19
20 company and states that he will respond to inquiries made to him via e-mail and telephone. Dkt.
21
22 # 103, Alger Decl., Ex. B (Messing Dep. 67:10-17).
23
24

25
26 Google+, Google’s free social networking site, introduced a new service called
27
28 Google+Ripples in October 2011. Dkt. # 101, Borovoy Decl. ¶ 3. When activated, Ripples
29
30 displays a graphic visualization of how content is shared and distributed among Google+ users.
31
32 *Id.* The feature is only available within the Google+ environment when a user clicks “View
33
34 Ripples” from a drop down menu. *See id.*
35
36

37
38 Around February 2012, RIPL began negotiations with a company called Ripple
39
40 Commerce to license the “phonetic expression of the RIPL trademark.” Dkt. # 103, Alger Decl.,
41
42 Ex. R. Ultimately, the deal was unsuccessful. *See* Dkt. # 102, Alger Decl., Ex. D (Sloan Dep. 35:
43

44
45 ¹ Including: Myspace, Myspace Music, Real Networks, Rhapsody, Universal Music, Vevo,
46
47 Google, Inc., Google TV, Picasa, Liberty Media, QVC, AOL, Huawei, Yahoo, ROVI Corp.,
48
49 Hewlett-Packard (PC, Palm), Paramount Television, Synergy Sports, Adobe, Apple, Facebook,
50
51 Sony, Sony Electronics, Sony Music, Amazon, Microsoft, MSN, Xbox, IPTV, Phone, Music,
Drive, Windows, Windows Live, Spaces, Mesh, T-Mobile, aQuantive, HTC, Cisco, Amdocs,
Akamai, Sub Pop, Overdrive, Classmates, Comcast, The Platform, NBC, Brightcove, Warner
Music, Warner Media, Overdrive, Inc. Dkt. # 111-2, p. 9, Billick Decl., Ex. C.

1 2-9). At some point during negotiations with Ripple Commerce, RIPL decided that Google's
2 pending trademark registration for Ripples infringed its trademark rights. RIPL sent Google a
3 cease-and-desist letter and filed an opposition to Google's registration before the Trademark
4 Trial and Appeal Board. RIPL also filed this district court action alleging that Google+Ripples
5 infringes its registered trademark, and infringes its common law trademark rights. In addition,
6 RIPL asserts claims for false designation of origin, unfair competition, and violation of
7 Washington's Consumer Protection Act.
8
9

10 11 12 13 14 15 16 17 **III. DISCUSSION**

18 19 **A. Cross Motions for Summary Judgment**

20 Google has asserted two counterclaims in this action. It seeks to establish that RIPL
21 abandoned use of the RIPL service mark in commerce, and that the RIPL service mark
22 registration should be cancelled. RIPL has moved for summary judgment on the abandonment
23 counterclaim. Google has cross moved for summary judgment on the abandonment counterclaim
24 and has moved for summary judgment on trademark infringement and damages. Google
25 contends that there is no likelihood of confusion between the marks to warrant a determination
26 that Google+Ripples infringes RIPL's service mark. Google also notes that likelihood of
27 confusion is a required element of each of Plaintiff's additional claims. Thus, if the Court finds
28 no likelihood of confusion, each of RIPL's claims may be dismissed on summary judgment. The
29 Court turns first to the issue of abandonment and then to trademark infringement. As resolution
30 of abandonment and trademark infringement are dispositive of RIPL's claims, the Court does not
31 address Google's motion with respect to damages. Further, because the Court finds no
32 infringement as a matter of law, the pending discovery-related motions are now moot.
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51

1 1. Legal Standard

2
3 Summary judgment is proper where “the movant shows that there is no genuine dispute
4
5 as to any material fact and the movant is entitled to judgment as a matter of law.” Fed. R. Civ. P.
6
7 56(a); *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247 (1986). In ruling on summary
8
9 judgment, a court does “not weigh the evidence or determine the truth of the matter but only
10
11 determine[s] whether there is a genuine issue for trial.” *Crane v. Conoco, Inc.*, 41 F.3d 547, 549
12
13 (9th Cir. 1994) (citing *FDIC v. O’Melveny & Myers*, 969 F.2d 744, 747 (9th Cir. 1992), *rev’d on*
14
15 *other grounds*, 512 U.S. 79 (1994)). Material facts are those which might affect the outcome of
16
17 the suit under governing law. *Anderson*, 477 U.S. at 248.
18
19

20
21 The court must draw all reasonable inferences in favor of the non-moving party. *See*
22
23 *O’Melveny & Myers*, 969 F.2d at 747. However, the nonmoving party must “make a sufficient
24
25 showing on an essential element of her case with respect to which she has the burden of proof” to
26
27 survive summary judgment. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). “If a party fails
28
29 to properly support an assertion of fact or fails to properly address another party’s assertion of
30
31 fact as required by Rule 56(c), the court may . . . consider the fact undisputed for purposes of the
32
33 motion” or the court may “grant summary judgment if the motion and supporting materials . . .
34
35 show that the movant is entitled to it.” Fed. R. Civ. P. 56(e)(2)-(3). Whether to consider the fact
36
37 undisputed for the purposes of the motion is at the court’s discretion and the court “may choose
38
39 not to consider the fact as undisputed, particularly if the court knows of record materials that
40
41 should be grounds for genuine dispute.” Fed. R. Civ. P. 56, advisory committee note of 2010. On
42
43 the other hand, “[t]he mere existence of a scintilla of evidence in support of the plaintiff’s
44
45
46
47
48
49
50
51

1 position will be insufficient; there must be evidence on which the jury could reasonably find for
2
3 the plaintiff.” *Anderson*, 477 U.S. at 252.
4

5 6 2. Abandonment 7

8
9 Under the Lanham Act, a service mark may be any “word, name, symbol, device or any
10 combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use
11 in commerce and applies to register ... to identify and distinguish the services of one person,
12 including a unique service, from the services of others and to indicate the source of the services,
13 even if that source is unknown.” 15 U.S.C. § 1127. The statute defines service marks and
14 trademarks similarly; the marks differ only in the sense that trademarks identify goods while
15 service marks identify services. *Chance v. Pac-Tel Teletrac Inc.*, 242 F.3d 1151, 1156 (9th Cir.
16 2001); *see* 15 U.S.C. § 1127.
17
18
19
20
21
22
23
24
25
26

27 To maintain trademark rights, a mark must be used in commerce. 15 U.S.C. § 1127. For
28 service marks, two elements must be satisfied to meet the “use in commerce” requirement.
29
30 *Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1204 (9th Cir. 2012). Use in
31 commerce may be demonstrated when (1) when the service mark is used or displayed in the sale
32 or advertising of services and (2) when the services are rendered in commerce. *Id.* (citing 15
33 U.S.C. § 1127). Because the test is conjunctive, it is not enough for a mark owner to simply
34 advertise its services: the test requires an “element of actual use” and an “element of display.”
35
36
37
38
39
40
41
42 *Chance*, 242 F.3d at 1159.
43
44

45 A trademark owner abandons its rights “[w]hen use has been discontinued with intent not
46 to resume such use.” 15 U.S.C. § 1157. “Nonuse for 3 consecutive years shall be prima facie
47 evidence of abandonment.” *Id.* “[U]se of a trademark defeats an allegation of abandonment
48
49
50
51

1 when: the use includes placement on goods sold or transported in commerce; is bona fide; is
2
3 made in the ordinary course of trade; and is not made merely to reserve a right in the mark.”

4
5 *Electro Source, LLC v. Brandess-Kalt-Aetna Grp., Inc.*, 458 F.3d 931, 936 (9th Cir. 2006)

6
7
8 (quotation marks omitted).

9
10 The statute implies a strict standard. *Id.* at 937; 15 U.S.C. § 1157. To prevail on a claim
11
12 for abandonment, the moving party must demonstrate complete discontinuance of use. *See id.* at
13
14 937. To determine whether a mark has been abandoned, the Ninth Circuit applies a totality-of-
15
16 the-circumstances approach and considers the following factors:

17
18
19 the genuineness and commercial character of the activity, the
20 determination of whether the mark was sufficiently public to identify or
21 distinguish the marked service [or product] in an appropriate segment of
22 the public mind as those of the holder of the mark, the scope of the
23 [trademark] activity relative to what would be a commercially reasonable
24 attempt to market the service [or product], the degree of ongoing activity
25 of the holder to conduct the business using the mark, the amount of
26 business transacted, and other similar factors which might distinguish
27 whether a service [or product] has actually been “rendered in commerce.”

28
29
30
31 *Electro Source*, 458 F.3d at 940 (9th Cir. 2006).

32
33 Once discontinuance of use has been established, the question of whether a trademark
34
35 holder intends to resume use in commerce depends on more than a “purely subjective intention
36
37 in the abandoner’s mind to re-engage in a former enterprise at some indefinite future time.”

38
39 *Specht v. Google, Inc.*, 758 F. Supp. 2d 570, 595 (N.D. Ill. 2010). “The registrant must put forth
40
41 evidence with respect to what activities it engaged in during the nonuse period or what outside
42
43 events occurred from which an intent to resume use . . . could reasonably be inferred.” *Imperial*
44
45 *Tobacco Ltd., Assignee of Imperial Grp. PLC v. Phillip Morris, Inc.*, 899 F.2d 1575, 1581 (Fed.
46
47
48
49
50
51

1 Cir. 1990). Such evidence should include specific plans to use the mark in commerce. *See*
2
3 *Specht*, 758 F. Supp. 2d at 595.
4

5 As discussed above, RIPL contends that it offers two services in conjunction with the
6 RIPL service mark: a “consumer service” and a “business-facing Application Programming
7 Interface (“API”).” Dkt. # 95, Messing Decl., ¶ 6. Google argues that both uses of the RIPL
8 service mark were abandoned.
9

10
11
12
13
14 **a. The Consumer Service**

15 RIPL’s consumer service comprised downloadable software that was first made
16 available, on a restricted basis in 2007, on the ripl.com website. Dkt. # 103, Alger Decl., Ex. A
17 (RIPL Dep., 78:1-15). Once downloaded, the software was designed to show the user media
18 content that was being consumed by other people in her network, and to monitor her media
19 consumption for the purpose of distributing that content to others. *See id.* at 78:15-22. The only
20 evidence in the record that this consumer service was promoted by RIPL and used by any
21 individuals was during the March 27, 2007 beta launch that was limited to university students,
22 faculty, and staff that had a university e-mail address. Dkt. # 103, Alger Decl., Ex. A (RIPL Dep.
23 84:1-21). RIPL contends that it has not abandoned the RIPL service mark in connection with its
24 consumer service because the “product for individuals has been made available for purchase on
25 the ripl.com website since it went live on March 27, 2007.” Dkt. # 110, p. 3. Google, however,
26 contends that the RIPL mark was either never used in commerce, or at best, abandoned in 2008
27 because there have been no active users of the consumer service since that time, and RIPL has no
28 plans to develop this or any other consumer-facing service in the future. *See* Dkt. ## 99, 100, p.
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51

1 Considering the totality of the circumstances, a reasonable jury could not conclude, on
2
3 this record, that RIPL used its service mark in connection with the consumer service after the
4
5 2007 beta launch. First, although RIPL argues in its briefing that the consumer service is
6
7 available for purchase on the ripl.com website, it has failed to file on the record evidence that it
8
9 cites to support its assertion. *See* Dkt. # 110, p. 3 (citing Billick Decl., Ex. B, which was never
10
11 filed in this case). Second, RIPL has submitted no evidence to show any sales of the consumer
12
13 service, nor has it submitted evidence to show that any individual user downloaded the software.
14
15 Third, RIPL has submitted no evidence to show that it has engaged in any marketing or
16
17 promotional activity whatsoever to advertise this consumer service after the beta launch. The
18
19 only evidence provided or cited by RIPL to support its contention that the consumer service is
20
21 used in commerce are two statements made by Mr. Messing: that (1) “[t]he RIPL service is and
22
23 has always been available at the ‘ripl.com’ domain,” and (2) that the last “release” of the
24
25 consumer product was in 2009. Dkt. # 95, Messing Decl., ¶¶ 7, 6, respectively.
26
27
28
29

30
31 In contrast, Google cites to the deposition testimony of Mr. Messing to show that no
32
33 consumer ever purchased the consumer service, no purchaser was known to have used the
34
35 consumer service after the beta launch, and to show that Mr. Messing does not monitor the
36
37 website to see whether anyone has visited it. Dkt. # 103, Alger Decl., Ex. B (Messing Dep. 30:2-
38
39 14, 59:5-12, 62:6-64:21); Alger Decl., Ex. G at 8. Construing the evidence in the light most
40
41 favorable to RIPL, the record suggests only that a 2009 version of the consumer service was
42
43 made available on RIPL’s website, but RIPL has supplied no evidence to show that any
44
45 consumer purchased or used the service, or whether anyone even visited the site. Applying the
46
47 relevant factors, there is no evidence of commercial activity, no evidence that the website,
48
49
50
51

1 service, or mark was sufficiently public to create an association between the mark and its owner,
2
3 and no evidence of marketing activity beyond maintaining the website past 2007. Moreover,
4
5 RIPL has failed to provide evidence to show that a customer could purchase the consumer
6
7 service from its website. *See Specht*, 758 F. Supp. 2d at 593 (concluding that mere maintenance
8
9 of a website was not a bona fide use in commerce); *see also In re Genitope Corp.*, 78 U.S.P.Q.2d
10
11 1819 (T.T.A.B. 2006) (website indicating how a customer could obtain more information about a
12
13 product, but not containing information on how to purchase a product, constituted mere
14
15 advertising and was not acceptable to show trademark use). On balance, RIPL has not provided
16
17 evidence that it rendered its consumer service in commerce after the 2007 beta launch.²
18
19 Accordingly, the Court finds that RIPL has not used the service mark in connection with the
20
21 consumer service for more than three years such that abandonment may be presumed.
22
23
24

25
26 To meet the second prong of the abandonment inquiry, Google must show that RIPL did
27
28 not have an intent to resume use of the mark in commerce. Although RIPL argues that Google
29
30 must prove that it had “no intent to abandon” the mark, it has misstated the standard.
31
32 “Abandonment under § 1127 requires an intent not to resume trademark use, as opposed to a
33
34 prospective intent to abandon the mark in the future.” *Electro Source*, 458 F.3d at 937. The Ninth
35
36 Circuit has recognized that “[n]othing in the statute entitles a registrant who has formerly used a
37
38 mark to overcome a presumption of abandonment arising from subsequent non-use by simply
39
40 averring a subjective affirmative ‘intent not to abandon.’” *Id.* (quoting *Imperial Tobacco Ltd.*,
41
42 899 F.2d at 1581.
43
44
45
46
47
48
49

50 ² The Court assumes, but does not decide, that the consumer service was used in commerce in the first
51 instance.

1 Here, RIPL has not offered evidence of a plan to resume use of the mark in conjunction
2
3 with its consumer-facing service. As RIPL's 30(b)(6) deponent, Mr. Messing testified that RIPL
4
5 expected to leave the consumer service "in the state it's in" while RIPL developed the business-
6
7 facing API. Dkt. # 103, Alger Decl., Ex. A (RIPL Dep. 213:16-22). He further testified that at
8
9 some unknown later date, RIPL "may go back to the consumer service." *Id.* at 213: 23-24 -
10
11 214:1-4. Such evidence does not constitute an intent to resume use.
12
13

14 RIPL has presented no evidence to demonstrate that RIPL has actively promoted or sold
15
16 to the consumer-facing market beyond the 2007 beta launch. RIPL has also failed to provide
17
18 evidence that it has specific plans to reenter the consumer market. Thus, RIPL abandoned use of
19
20 the mark in connection with its consumer-facing service.
21
22

23 **b. RIPL's Business-facing API**

24 Although this is a closer question, RIPL has failed to provide evidence from which the
25
26 Court could infer that RIPL has used the RIPL mark for anything beyond mere advertising since
27
28 2010, nor has RIPL offered evidence of concrete plans to establish a future bona fide commercial
29
30 use of its API.
31
32

33 RIPL relied exclusively on the declaration of RIPL CEO Bill Messing to establish use in
34
35 commerce in its cross motion for summary judgment. He states:
36
37

38 RIPL had just embarked on a promotional push with the launch of the
39
40 marketing site in 2012 when it became aware of Google's attempted
41
42 registration of the "Ripples" mark. It makes no sense to seek investment
43
44 dollars while under attack by Google, so RIPL Corp. has been operating
45
46 on a shoestring budget until this cloud is lifted. That means making sure
47
48 the web site is available, making sure that visitors have the ability to
49
50 contact the company by email and phone, and pursuing leads
51
opportunistically. RIPL Corp. commonly receives inquiries about the
RIPL API and web site, and I pursue those leads whenever feasible.

1 Dkt. # 95, Messing Decl., ¶ 9.
2

3 In response to Google's cross motion for summary judgment, RIPL relied exclusively on
4 its attorney's declaration and the attached exhibits for evidence of use of the mark in commerce
5 with respect to the API. The relevant exhibits contain the following: (1) RIPL's response to
6 Google's Interrogatory No. 6, in which RIPL states that it "dedicated most of 2011 to
7 developing customers for the API" and that it changed its website in 2012 (Dkt. # 111-2, p. 12,
8 Billick Decl., Ex. C); (2) RIPL's response to Google's Interrogatory No. 12, in which RIPL
9 states that "2010 included numerous pitch meetings with prospective business partners," that in
10 2011 its "resources did not allow it to hire personnel or promote extensively," and that in 2012 it
11 created a new website for the API and followed "up on its marketing efforts with numerous
12 prospects at the annual Consumer Electronics show in Las Vegas" (Dkt. # 111-4, pp. 8, Billick
13 Decl., Ex. E); and (3) e-mails from 2010 that describe a summary of business communications
14 made between RIPL and several businesses (Dkt. # 111-5, pp. 2-4, Billick Decl., Ex. F).
15
16 Importantly, there are no e-mails or other evidence to show that RIPL conducted business
17 meetings to promote the sale of the API after 2010. For use of the mark past 2010, the record
18 suggests only that RIPL changed the website for the API and that it attended a trade show in
19 2012.
20
21

22 As discussed above, maintenance of a website alone is insufficient to demonstrate use in
23 commerce because RIPL has failed to demonstrate that its website provides customers with
24 information on how to purchase its products. In addition, RIPL has failed to demonstrate that its
25 attendance at a trade show in 2012 constituted use in commerce sufficient to overcome a
26 presumption of non-use of the mark past 2010. RIPL has not detailed what sales efforts it has
27
28
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51

1 made or whether its attendance at the trade show amounted to something more than “unsolicited
2
3 proposal(s) . . . that lead nowhere.” *Natural Answers, Inc. v. SmithKline Beecham Corp.*, 529
4
5 F.3d 1325, 1330 (11th Cir. 2008) (holding that evidence of a failed putative negotiation after
6
7 abandonment was insufficient to demonstrate an intent to resume use). Although “non-sales
8
9 activities such as solicitation of potential customers may be taken into account as part of the
10
11 totality of the circumstances inquiry[,]” RIPL’s vague allusions to a 2012 “promotional push” do
12
13 not countenance a finding that RIPL’s API was rendered in commerce. *Rearden LLC v. Rearden*
14
15 *Commerce, Inc.*, 683 F.3d 1190, 1205 (9th Cir. 2012) (internal quotations and citations omitted).
16
17

18
19 In contrast, Google has cited to numerous instances in the record that support a finding of
20
21 abandonment. First, RIPL has never sold or licensed any product or service under the RIPL mark
22
23 in the business market. Nor does it currently have any customers. Dkt. # 103, Alger Decl., Ex. B
24
25 (Messing Dep. 52:3-5, 81:2-4). Second, RIPL’s CEO Bill Messing testified that “[w]e’re not
26
27 actively promoting right now.” Dkt. # 103, Alger Decl., Ex. A (RIPL Dep. 96:23, 284:25-285:1).
28
29 He also stated that with respect to the website: “I’m not acting on visits to the site, no If
30
31 they contact me, I will follow up on it.” Dkt. # 103, Alger Decl., Ex. B (Messing Dep. 69:5-16,
32
33 71:6-14). Third, RIPL has provided no evidence of its business reputation. Mr. Messing testified
34
35 that RIPL’s brand equity and reputation are “unknowable” and he failed to identify a single
36
37 person who could testify about its business reputation. Dkt. #103, Alger Decl., Ex. A (RIPL Dep.
38
39 204:14-206:20; 232:14-233:11).
40
41
42
43

44
45 To survive summary judgment, RIPL must provide actual evidence of use in commerce
46
47 and intent to resume use, which it has failed to do. RIPL could have provided screen shots of the
48
49 website and explained how the website works, or provided testimony from potential clients about
50
51

1 RIPL's ongoing solicitation efforts or its reputation in the industry. But RIPL has offered nothing
2
3 concrete to rebut Google's arguments and relies only on RIPL's maintenance of the RIPL
4
5 website and allusions to limited promotional activity to demonstrate use of the mark in
6
7 commerce. Further, RIPL has provided no evidence of a plan to resume use of its mark in
8
9 connection with the API. Accordingly, summary judgment is GRANTED in Google's favor.
10
11

12 3. Trademark Infringement – Likelihood of Confusion

13
14
15 To prevail on a trademark infringement claim in a reverse confusion case, the plaintiff
16
17 must demonstrate (1) that it is the senior user; (2) of a valid trademark; (3) and that the
18
19 defendant—or junior user—is using its mark in a way that is likely to confuse the plaintiff's
20
21 customers into believing that they are dealing with the defendant. *Brookfield Comm., Inc. v. West*
22
23 *Coast Ent. Corp.*, 174 F.3d 1047, 1053 (9th Cir. 1999). “The core element of trademark
24
25 infringement is the likelihood of confusion, *i.e.*, whether the similarity of the marks is likely to
26
27 confuse customers about the source of the products.” *Brookfield*, 174 F.3d at 1053. In *AMF, Inc.*
28
29 *v. Sleekcraft Boats*, the Ninth Circuit Court of Appeals delineated an eight factor test to
30
31 determine whether there exists a “likelihood of confusion” between the marks at issue. 599 F.2d
32
33 341, 348-49 (9th Cir. 1979), *abrogated in part on other grounds as recognized by in Mattel, Inc.*
34
35 *v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003). The *Sleekcraft* factors are (1) strength
36
37 of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual
38
39 confusion; (5) marketing channels used; (6) type of goods and degree of care likely to be
40
41 exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of
42
43 expansion of product lines. *Id.* Because the likelihood of confusion analysis is a factual inquiry,
44
45 the issue before the court is “whether a reasonable jury could conclude that a consumer might
46
47
48
49
50
51

1 reasonably believe that” RIPL’s service is actually Google’s service. *One Industries, LLC v. Jim*
2
3 *O’Neal Distributing, Inc.*, 578 F.3d 1154, 1162 (9th Cir. 2009).

4
5 “The Sleekcraft factors are intended to function as a proxy or substitute for consumer
6
7 confusion, not a rote checklist.” *Rearden*, 683 F.3d at 1209. Further, not all *Sleekcraft* factors
8
9 may be relevant in a particular case. *Id.* (“[a] determination may rest on only those factors that
10
11 are most pertinent to the particular case”). Because the likelihood of confusion inquiry is
12
13 inherently factual and open-ended, summary judgment is often disfavored. *Id.* at 1210. However,
14
15 the Ninth Circuit has affirmed summary judgment rulings “[i]n cases where the evidence is clear
16
17 and tilts heavily in favor of a likelihood of confusion[.]” *Id.* (quoting *Au-Tomotive Gold, Inc. v.*
18
19 *Volkswagen of Am., Inc.*, 457 F.3d 1062, 1075 (9th Cir. 2006)).
20
21
22

23 24 **a. Strength of the Marks**

25
26 The conceptual, or inherent, strength of a trademark is evaluated on a spectrum that
27
28 assigns more strength to marks that are fanciful or arbitrary, and less strength to those that are
29
30 merely generic or descriptive of the goods they represent. *See, e.g., Survivor Media, Inc. v.*
31
32 *Survivor Productions*, 406 F.3d 625, 631-32 (9th Cir. 2005). In the middle are those that are
33
34 suggestive. *See id.* at 632. Suggestive marks require an inferential or imaginative step to connect
35
36 the trademark to the good or service offered. *Id.* The strength of both the senior and junior mark
37
38 is relevant in a reverse confusion trademark action. *Id.*
39
40
41

42 The RIPL and Ripples services are broadly related to content sharing over social media.
43
44 Neither mark is descriptive of the service provided; each requires an inferential step to associate
45
46 the propagation of “concentric, circular waves” with the propagation of media content over
47
48
49
50
51

1 social media. Thus, both marks are suggestive, which means that, conceptually, they are assigned
2 moderate strength along the strength spectrum.
3

4
5 “Identifying whether a mark is generic, descriptive, suggestive, arbitrary or fanciful,
6 however, is only the first step of the inquiry. The second step is to determine the strength of the
7 mark in the marketplace.” *One Industries*, 578 F.3d at 1164 (quotations and citations omitted).
8
9 Importantly, “[w]hen similar marks permeate the marketplace, the strength of the mark
10 decreases.” *Id.* Both marks are weakened by the presence of several ripple-like marks operating
11 within the social media sphere. *See M2 Software, Inc. v. Madacy Entertainment*, 421 F.3d 1073,
12 1088 (9th Cir. 2005) (“Use of similar marks by third-party companies in the relevant industry
13 weakens the mark at issue.”). For example, Google’s trademark search revealed “RIPPLR” for
14 use with social media strategy and marketing, “Ripple Group” associated with business analysis
15 in the digital media content and technology industry, “ripplusa” associated with social media
16 services, “Ripple Tag” associated with social networking, “webripples” associated with social
17 media, and “MEDIA RIPPLE” associated with software for managing and sharing digital media
18 content. *See* Dkt. # 116, Alger Decl., Ex. A. Because RIPL and Ripples operate in a relatively
19 crowded field of ripple-associated trademarks, their market strength is weakened. Moreover,
20 RIPL has presented no evidence to demonstrate commercial strength because it has failed to
21 provide any evidence of actual marketplace recognition. RIPL could have submitted evidence
22 such as advertising expenditures to demonstrate heightened commercial strength of its mark, but
23 it has failed to do so. *See Network Automation, Inc. v. Advanced Systems Concepts, Inc.*, 638
24 F.3d 1137, 1149 (9th Cir. 2011) (“advertising expenditures can transform a suggestive mark into
25 a strong mark”) (quotation and citation omitted). In sum, both marks are weakened by a lack of
26
27
28
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51

1 commercial strength. Because RIPL has failed to raise a genuine issue of material fact, this factor
2
3 favors Google.
4

5
6 **b. Proximity of the Goods, and Type of Goods and Degree of Care of**
7 **Purchaser Factors**
8

9 “The standard for deciding whether the parties’ goods or services are ‘related’ is whether
10 customers are ‘likely to associate’ the two product lines.” *Survivor Media*, 406 F.3d at 633
11 (quoting *Dreamwerks Production Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1131 (9th Cir.
12 1998)). Goods and services may be related when they are “sold to the same class of consumers.”
13 *Nautilus Grp., Inc. v. Savvier, Inc.*, 427 F. Supp. 2d 990, 996 (W.D. Wash, 2006). But “[w]hen
14 fundamental functionality is distinct, the case supports a finding of ‘no confusion.’” *Real*
15 *Networks, Inc. v. QSA ToolWorks, LLC*, Case No. C07-1959 MJP, 2009 WL 2512407, at *4-5
16 (W.D. Wash. Aug. 14, 2009).
17
18
19
20
21
22
23
24
25
26

27 Google+Ripples is a feature that is available to every Google+ account holder. On the
28 Google+ site, there is a dropdown menu that allows a Google+ user to “View Ripples.” Dkt. #
29 101, Borovoy Decl., ¶ 3. When activated, the feature allows the user to see a display of how
30 public postings have been shared and reshared among other Google+ users. *Id.* As noted before,
31 a user does not purchase a Google+ account, nor can the user purchase the Ripples feature. Both
32 are free. *Id.* at ¶ 7.
33
34
35
36
37
38
39
40

41 RIPL’s products are functionally different. The consumer facing product comprises
42 software that may be downloaded. The software collects information about the user’s media
43 content and is designed to “push” that content to other users within the network so that they
44 would automatically receive media content without having to search for it. The business facing
45
46
47
48
49
50
51

1 product is an expensive piece of software that RIPL has marketed to large media companies so
2
3 that they could enable their own websites with the “push” technology.
4

5
6 Although RIPL contends that the goods are related “because the RIPL product both
7
8 collects and displays data from social media, and . . . Google’s Ripples displays data from the
9
10 Google+ social media site,” that argument ignores the functional differences between how the
11
12 products work and their intended consumer. Mr. Messing testified that RIPL’s main function is
13
14 “to automate the distribution of content from one user to another based on the interests they
15
16 share.” Dkt. # 103, Alger Decl., Ex. B (Messing Decl. 153:2-9). He then acknowledged that
17
18 “[n]obody else can make that statement.” *Id.* at 153:9-10. In contrast, “Google+Ripples does not
19
20 push or cause the automated republication of content nor does it track consumption of content
21
22 (*i.e.*, whether users have read or listened to a piece of media).” Dkt. # 101, Borovoy Decl., ¶ 6.
23
24 RIPL has failed to support its argument with evidence that demonstrates similarity of RIPL and
25
26 Google’s services. Further, Mr. Messing’s testimony directly contradicts RIPL’s argument that
27
28 the services are functionally the same.
29
30
31

32
33 Similarly, RIPL has failed to demonstrate that the intended consumers of RIPL and
34
35 Ripples would exercise the same degree of care in purchasing the RIPL and Ripples services.
36
37 The degree of care exercised by consumers is measured under the reasonably prudent consumer
38
39 standard. *See, e.g., Brookfield*, 174 F.3d at 1060. This standard requires courts to consider the
40
41 price of the products at issue and the level of sophistication expected of a consumer purchaser.
42
43
44 *Id.*

45
46 Here, both the price of products and the sophistication of the intended consumers are
47
48 different. For RIPL’s consumer-facing technology, it maintains a passive website and does not
49
50
51

1 monitor web traffic. The only time the software was actually known to be used was during the
2
3 2007 beta launch. RIPL has proffered no evidence to show that it actively markets its consumer
4
5 facing product to any individuals. For the API, RIPL has stated that it marketed the API to large
6
7 corporations. *See* Dkt. # 103, Alger Decl., Ex. B (Messing Dep. 67:22-24) (stating that RIPL is
8
9 seeking “one strategic customer for the API”). RIPL’s intended customers appear to be large
10
11 companies that would have savvy purchasing arms. RIPL has provided no evidence to
12
13 demonstrate that users of Google’s free service exercise the same degree of care as a potential
14
15 customer of RIPL’s API. Although Plaintiff argues that Google also markets its Ripples feature
16
17 to large companies, the argument misses the point. A large company would exercise a different
18
19 level of sophistication when considering purchasing RIPL’s API versus utilizing a free Google
20
21 feature. Thus, these factors collectively favor Google.
22
23
24
25

26 **c. Similarity of the Marks**

27
28 To determine whether the marks are similar, the court must compare their sight, sound,
29
30 and meaning. *Entrepreneur Media, Inc. v. Smith*, 279 F.3d 1135, 1146 (9th Cir. 2002). The Ninth
31
32 Circuit has developed the following axioms to guide the similarity analysis: (1) “the marks must
33
34 be considered in their entirety and as they appear in the marketplace,” (2) “similarity is adjudged
35
36 in terms of appearance, sound, and meaning,” and (3) “similarities are weighed more heavily
37
38 than differences.” *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1206 (9th Cir. 2000)
39
40 (citations omitted). Although sound and meaning in this case are similar, the Court finds that
41
42 when the marks are considered in their entirety, they differ dramatically by sight and by how
43
44 they are presented in the marketplace.
45
46
47
48
49
50
51

1 The marks are visually distinct when considered in their entirety. First, RIPL is a short-
 2 form derivative of ripple. RIPL's CEO chose the derivative because he wanted a mark that was
 3 "edgy" like Motorola's adoption of RAZR. Dkt. # 103, Alger Decl., Ex. A (RIPL Dep. 54:22-
 4 55:10, 57:9-20). The CEO saw value in not adopting the full spelling of ripple. *See id.* Ripples,
 5 on the other hand is the full, seven character plural form of the common word, ripple. Second,
 6 Google's mark, as used in the market place, is usually attached to Google+ as depicted below.
 7 Dkt. # 101, Borovoy Decl., ¶ 5. Ripples appears in plain, lowercase blue font, and is often
 8 presented in association with the Google+ house mark. *Id.*

9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28
29
30
31
32
33
34
35
36
37
38
39
40
41
42
43
44
45
46
47
48
49
50
51



Third, RIPL's mark has three forms, two of which use decorative, thicker font and have
 concentric rings around or near the mark. The less-stylized font version has a tag line that reads
 "social discovery for digital media." Dkt. # 103, Alger Decl., Ex. DD; *id.*, Ex. A (RIPL Dep.
 59:17-69:22).



Although both marks use blue font and lowercase letters, the marks are differentiated by RIPL's
 use of decorative font, concentric circles, and a tagline, as opposed to Google's use of unadorned
 font. RIPL wholly failed to address the visual distinctions raised by Google and states only that
 "inspecting logos side-by-side should be done with great caution." Dkt. # 110, p. 14. Notably,
 RIPL fails to support that statement with any citation. Courts have often found marks to be

1 dissimilar by comparing the same visual distinctions made here. *See, e.g., Nautilus*, 427 F. Supp.
2
3 2d at 996 (finding marks dissimilar where different fonts used); *see also Survivor Media*, 406
4
5 F.3d at 633 (finding no material issue of fact where one mark usually displayed with a slogan or
6
7 stylized graphics). As the case law makes clear, “marks are to be considered in their entirety and
8
9 as they appear in the marketplace.” *GoTo.com*, 202 F.3d at 1206. Because RIPL has failed to
10
11 explain or demonstrate how the marks, when considered in their entirety, are similar, it has not
12
13 raised a genuine material issue of fact.
14
15

16
17 **d. Evidence of Actual Confusion**
18

19 RIPL has supplied no evidence of actual confusion. This factor also favors Google.
20

21
22 **e. Marketing Channels**
23

24 Convergent marketing channels increase the likelihood that a consumer would be
25
26 confused as to the origin of the goods. *Sleekcraft*, 599 F.2d at 353. Plaintiff contends that RIPL
27
28 and Ripples share the same marketing channel because the products are marketed over the
29
30 internet.
31
32

33 Mere use of the internet, however, is insufficient to show that the parties operate within
34
35 the same marketing channel. *See Network Automation*, 638 F.3d at 1151. (“Today, it would be
36
37 the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous
38
39 marketing channel does not shed much light on the likelihood of consumer confusion.”);
40
41 *RealNetworks*, 2009 WL 2512407 at *5 (W.D. Wash. Aug. 14, 2009). The RIPL API is
42
43 marketed to sophisticated purchasers acting on behalf of companies. The Ripples mark is
44
45 marketed to existing and future Google+ account holders, some of whom may be the same large
46
47 companies, but none would reasonably confuse Google’s free service with RIPL’s software
48
49
50
51

1 platform.³ Aside from citing generic use of the internet, RIPL has failed to submit any evidence
2
3 that shows that the RIPL and Ripples marks share similar marketing channels. This factor favors
4
5 Google.
6

7
8 **f. Google's Intent in Selecting the Mark**
9

10 A plaintiff need not demonstrate that the alleged infringer intended to deceive consumers
11
12 to prevail on a claim for trademark infringement. *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967
13 F.2d 1280, 1293 (9th Cir. 1992). But if the plaintiff provides evidence that the alleged infringer
14
15 knowingly adopted a similar mark, the court must presume that the defendant intended to
16
17 deceive the public. *Sleekcraft*, 599 F.2d at 354.
18
19
20

21 Plaintiff has presented no evidence to show that Google knew about the RIPL mark prior
22
23 to adopting Ripples. Google supplied the results of its internal trademark search, which show that
24
25 the search did not reveal the RIPL trademark. *See* Dkt. # 116, Alger Decl., Ex. A. In addition,
26
27 Google's 30(b)(6) designee, Rick Borovoy, stated that Google's trademark search did not
28
29 identify RIPL or its mark and that no individual on the team involved in selecting Ripples had
30
31 any knowledge of RIPL or its mark. Dkt. # 101, Borovoy Decl., ¶ 4. RIPL contends that Google
32
33 must have found the RIPL mark during its trademark search and is therefore "hiding" relevant
34
35 information from RIPL. This theory stems from counsel's review of Google's privileged e-mail
36
37 communications that were at issue earlier in the case. Although the Court has not determined that
38
39 the e-mails are admissible, it previously reviewed the e-mails that were filed under seal and notes
40
41 that they do not support RIPL's theory that Google knew about RIPL or its mark when it adopted
42
43
44
45
46
47
48

49 ³ RIPL also contends that it markets to casual users by maintaining a website where the software may be
50 downloaded. It has provided no evidence that any particular casual user has visited the site or downloaded that
51 software.

1 Ripples. Plaintiff’s argument is pure speculation and unsupported by the evidence. Thus, the
2
3 factor favors Google.
4

5
6 **g. Likelihood of Product Line Expansion**

7
8 “Inasmuch as a trademark owner is afforded greater protection against competing goods,
9
10 a ‘strong possibility’ that either party may expand his business to compete with the other will
11
12 weigh in favor of finding that the present use is infringing.” *Sleekcraft*, 599 F.2d at 354
13
14 (quotations and citation omitted). RIPL has provided no evidence that demonstrates that it is
15
16 likely to expand its business to compete with Google+ users. Although RIPL contends that
17
18 RIPL’s services are “available to . . . casual individual users of Google+” (Dkt. # 110, p. 20), it
19
20 has failed to show that it has any “casual individual users” and has further failed to show that it is
21
22 likely to market a service to those users in the future. As noted by the *Groupion* court, “what is
23
24 relevant is the substance of the two companies’ respective products and services, not the
25
26 characterizations or labels offered by the parties regarding the products and services.” *Groupion*,
27
28 *LLC v. Groupon, Inc.*, 859 F. Supp. 2d 1067, 1080 (N.D. Cal. 2012). As discussed above, RIPL
29
30 has failed to provide evidence that demonstrates that Google+Ripples is functionally similar to
31
32 RIPL’s services or that each is intended to reach the same consumer. This factor also favors
33
34 Google.
35
36
37
38
39

40 **h. Summary of Sleekcraft Analysis**

41
42 Having considered the evidence in the light most favorable to RIPL, the Court finds that
43
44 RIPL has failed to raise a material issue of fact as to any *Sleekcraft* factor such that the marks are
45
46 not confusingly similar as a matter of law. Because likelihood of confusion is a required element
47
48 for each of RIPL’s alleged causes of action, RIPL’s complaint is DISMISSED in its entirety.
49
50
51

IV. CONCLUSION

Having considered the motions, the response and replies thereto, the attached declarations and exhibits, oral argument, and the remainder of the record, the Court hereby finds and

ORDERS:

- (1) Google’s Motion for Summary Judgment (Dkt. ## 99, 100) is GRANTED;
- (2) RIPL’s Motion for Partial Summary Judgment (Dkt. # 94) is DENIED;
- (3) The pending Motions to Seal (Dkt. ## 57, 97, 104) are GRANTED;
- (4) Google’s Motion for Protective Order (Dkt. # 44) is STRICKEN AS MOOT;
- (5) Google’s First and Second Motions to Compel (Dkt. ## 27, 63) are STRICKEN AS MOOT;
- (6) RIPL’s Motion to Dismiss (Dkt. # 55) is STRICKEN AS MOOT;
- (7) RIPL’s Sealed Motion to Waive Attorney/Client Privilege (Dkt. # 60) is STRICKEN AS MOOT.

DATED this 3rd day of April 2014.



RICARDO S. MARTINEZ
UNITED STATES DISTRICT JUDGE