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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92080108
Party	Plaintiff Sonic.net, LLC
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THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

SONIC.NET, LLC,)
) Cancellation No. 92080108
) Mark: SONICTEL
 Petitioner,) Registration No. 5,245,621
)
 v.) **THIS PLEADING CONTAINS CONTENT**
) **DESIGNATED AS CONFIDENTIAL**
 SONICTEL, INC.,) **ATTORNEYS EYES ONLY – SENSITIVE**
) **BUSINESS INFORMATION AND**
 Registrant.) **COMPETITIVE BUSINESS INFORMATION**
)
 _____)

**PETITIONER’S OPPOSITION TO MOTION FOR SUMMARY JUDGMENT
(REDACTED VERSION)**

I. INTRODUCTION

In this proceeding, SONIC.NET, LLC (“Petitioner”) seeks cancellation of SONICTEL, INC.’s (“Respondent”) registration of the SONICTEL trademark (the “SONICTEL Mark”) on the grounds that: (1) Petitioner’s trademarks SONIC.NET, SONIC, and the SONIC. design mark (collectively, the “SONIC Marks”) have priority of registration and priority of use over the SONICTEL Mark; and (2) Respondent’s use of the SONICTEL Mark creates a high likelihood of confusion with respect to the source of the telecommunication services provided by Respondent.

In its Motion for Summary Judgment (“MSJ”), which was filed before any discovery had been taken or allowed in this case, Respondent argues that the “undisputed material facts” show that Petitioner’s claims are barred by the doctrine of laches, and that there is no likelihood of confusion between the SONICTEL Mark and the SONIC Marks. As set forth below, Respondent has failed to meet its burden of proving that there are no genuine issues of material

fact in dispute with respect to either Respondent's laches defense or the purported lack of any likelihood of confusion between the SONICTEL Mark and the SONIC Marks.

II. THE PARTIES

A. **Petitioner**

Petitioner is an Internet Service Provider ("ISP") based in Santa Rosa, California (about 40 miles north of San Francisco). Petitioner offers a broad range of telecommunications and internet services to residential and business customers throughout the State of California, including ISP services, traditional telephone services and cloud-based communications services and equipment, including Voice over Internet Protocol (VOIP) services. [Declaration of Dane Jasper ("Jasper Decl."), ¶ 3.] Petitioner currently services more than 100,000 customers in approximately 125 California communities including the San Francisco Bay Area, Sacramento, and Los Angeles. Petitioner is the largest independent Internet Service Provider (ISP) in Northern California. Petitioner also provides services such as email, domain name registration, and website hosting to customers located elsewhere in the United States, outside of California. [Jasper Decl., ¶ 4.]

Petitioner's internet services have been recognized by nationally recognized technology publications and organizations. For example, PCMag.com selected Petitioner as the 2019 Fastest Internet Service Provider in the United States. The article stated "Sonic's PCMag Speed Index is the highest we have ever seen in Fastest ISPs history for an individual ISP." Electronic Frontier Foundation, a nationally renowned organization defending digital privacy, free speech and innovation, has repeatedly recognized Petitioner for policies that protect the rights of its customers. [Jasper Decl., ¶ 5.]

As reflected in the TDSR printouts attached to the Petition, Petitioner owns three registrations of the SONIC Marks. Petitioner applied for and obtained federal registrations for the SONIC Marks as follows:

- SONIC.NET is registered for use as an ISP to provide telephone services, and in connection with “hosting websites on the internet; hosting of internet servers for others; technical support services, namely, technical administration of servers for others and troubleshooting in the nature of diagnosing server problems.” The application to register SONIC.NET was filed on April 25, 2012 and the registration issued on January 29, 2013. The registration asserts a date of first use of August 2000.
- SONIC is registered for use as an ISP to provide e-mail services, and telephone communication services, and in connection with “hosting internet sites for others; hosting digital content on the internet, domain name registration services.” The application to register SONIC was filed on November 12, 2013 and the registration issued on March 24, 2015. The registration asserts a date of first use of November 20, 2014.
- The SONIC. design mark is registered for use as an ISP to provide e-mail services, and telephone communication services, and in connection with “hosting internet sites for others; hosting digital content on the internet, domain name registration services.” The application to register the SONIC design mark was filed on January 8, 2015 and the registration issued on September 1, 2015. The registration asserts a date of first use of November 20, 2014. [Jasper Decl., ¶ 6.]

For decades the SONIC marks have been, and they continue to be, used in the marketing and promotion of Petitioner’s services. They are prominently displayed on Petitioner's website,

signage, newsletters, mailers, and other marketing materials. Petitioner has expended substantial time, money, and resources marketing, advertising, and promoting the services offered under the SONIC Marks, including its telecommunications and VOIP services. Through its widespread marketing efforts and media recognition, Sonic has developed significant goodwill in the SONIC Marks. [Jasper Decl., ¶ 7.]

As a result of its widespread, continuous, and exclusive use of the SONIC Marks to identify its services, and Sonic as their source, Sonic owns valid and subsisting federal statutory and common law rights to the SONIC Marks.

B. Respondent

Respondent, a New York corporation that provides VOIP services and related telecommunications services and equipment, owns a federal registration for SONICTEL. Respondent applied to register SONICTEL on December 20, 2016, and the registration issued on July 18, 2017. The registration asserts January 10, 2015 as the date of first use and first use in commerce. [See TDSR printout for SONICTEL attached to the Petition.]

As indicated by the use and registration information for the SONICTEL Mark and the SONIC Marks, Petitioner's first use of SONIC precedes by many years Respondent's first use of SONICTEL, and all of the SONIC Marks were already registered on the U.S. Principal Register when Respondent applied to register SONICTEL.

III. STATEMENT OF THE CASE

In the Spring of 2022, Respondent signaled its intention to begin doing business in California. On March 30, 2022, Respondent registered to transact business in California by filing a Statement and Designation by Foreign Corporation with the California Secretary of State, and on April 29, 2022, Respondent applied for a license with the California Public Utilities

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