

POPSOCKETS VS. POP!:

Recognition of the vested rights Of the trademark.

PopSockets LLC is a company engaged in the production of consumer electronic accessories from Boulder Colorado (United States) that produces removable grips for portable electronic devices. It was founded in 2012 by David Barnett who created the holder by attaching two buttons to his cell phone.

An accessory that functions as a holder and stand that expands or shrinks thanks to an accordion-like mechanism.

In addition to its innovative product, which is protected, the company is also the holder of its trademark POPSOCKETS (word) , which is part of its trade name, and the following trademarks: POPCLIP, POPHIRS, and among them POP, which are protected not only in Paraguay but in other jurisdictions at an international level as well.

Backgrounds

Trademark Application:

On March 8, 2019, Mr. D.M.M, domiciled in Paraguay, applied before the National Directorate of Intellectual Property (DINAPI) for the trademark POP! (word) under Records No. 1917889 and No. 1917890, to protect products and services in Int. Classes 9 and 35 respectively.

Opposition POP! VS POPSOCKETS

On May 27, 2019, POPSOCKETS LLC. filed opposition to the trademark POP! (word) in classes 9 and 35 on

Client	POPSOCKETS LLC.
Trademarks	POP, POPSOCKETS
Decision-making authority	National Directorate of Industrial Property (Dinapi)



the following grounds:

- ▶ Its vested local rights to its trademarks POP, POPSOCKETS, POPHIRST, POPCLIP granted to protect products in class 9.
- ▶ The notoriety of its trademark, the recognition of the trademark POPSOCKETS and related trademarks for several years at a local and global level .
- ▶ The close word similarity between the trademarks.
- ▶ The risk of direct and indirect confusion that may arise considering the similarity between the classes.
- ▶ Protection of its trade name.
- ▶ Protection of the trade name of Popsockets LLC.

Resolution of the National Directorate of Industrial Property: recognizes the likelihood of confusion and risk of association between trademarks

On May 11, 2022, the Directorate of Litigious Trademark Matters in its Resolutions No. 286 and 291/2022, upholds the opposition and orders the rejection of the trademark POP! in the two classes where it was applied for, based on the following points:

- ▶ *“That after submitting the conflicting trademarks to a joint analysis, we found that there is an absolute identity between them at the visual, graphic, spelling and phonetic levels, which makes them confusingly similar.”*
- ▶ *“That among the trademarks, the applied for POP! and Popsockets, we may note that the registered trademarks are being imitated. Due to this fact, there is a risk of association and confusion with respect to the origin of the products, since the same applicant intends to protect quite similar products, an aspect that is even worsened if we bear in mind that the conflicting trademarks are highly likely to be confused”.*
- ▶ *“That since there is a clear and evident conceptual connection between the conflicting trademarks, consumers are likely to be confused as to the product itself and as to the true origin thereof, since the trademark claimed by the applicant is a reproduction, and the products protected by the opposing trademark are also closely related”.*



Conclusions

- ▶ There is a constant attempt of taking ownership of distinctive and notorious trademarks by third parties, thus trademark monitoring is key.
- ▶ This successful result for Popsockets LLC. is significant since, by ordering the rejection, DINAPI rightly establishes a unified stance regarding this type of applications that attempt to register quite similar trademarks seeking to imitate and appropriate of the recognition and positioning of notorious trademarks, associated by the consumer with a specific business origin.
- ▶ Therefore, the present case serves as an example for registrants who, by protecting their registered trademarks and using the available tools, may prevent third parties from registering and using similar trademarks to the extent of confusing the consumer and avoiding the dilution of their trademarks.

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