

THIS OPINION IS NOT A  
PRECEDENT OF THE TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Mailed: September 19, 2008

Opposition No. 91179090

Elgo, Inc.

v.

Simplywell, LLC

**Before Hairston, Rogers and Bergsman,  
Administrative Trademark Judges.**

**By the Board:**

Applicant seeks to register the mark SIMPLYQUIT in standard character form for "counseling in the field of smoking cessation" in International Class 44.<sup>1</sup> Opposer has pleaded ownership of the mark ***SimplyQuit*** for "smoker's articles, namely, cigarettes containing tobacco substitutes not for medical purposes" in International Class 34.<sup>2</sup>

As its two grounds for the opposition, opposer alleges priority of use and likelihood of confusion, and dilution.

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<sup>1</sup> Application Serial No. 77090694, filed January 25, 2007, pursuant to Trademark Act § 1(b). An amendment to allege use was filed March 15, 2007, claiming dates of first use anywhere and first use in commerce of September 2006.

<sup>2</sup> Opposer has pled common law rights in the mark for products useful for smoking cessation. Opposer also has an application, Serial No. 78085086, filed September 22, 2001, pursuant to Trademark Act § 1(a), claiming a date of first use anywhere of September 15, 2001, and first use in commerce of September 21, 2001. The identification of goods is that which is set out above.

In its answer, applicant denies the salient allegations of the notice of opposition.

This case now comes up on 1) opposer's fully-briefed motion, filed May 7, 2008, for summary judgment in its favor on its claim of priority and likelihood of confusion; and 2) a motion by the examining attorney for remand of applicant's application to the examining attorney, filed September 15, 2008.<sup>3</sup>

Motion for Summary Judgment

In support of its motion for summary judgment, opposer argues that it clearly has priority of use; the marks are identical; opposer's goods are closely related to applicant's services, particularly because opposer includes a booklet on the subject of smoking cessation in the packaging with its substitute cigarettes; and the goods and services are likely to be encountered by consumers in the same channels of trade. In support of its arguments, opposer offers, inter alia, Exhibit 8 containing archived web pages showing its goods offered on its website for each year from 2001 through 2007, and supported by the declaration of its counsel.

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<sup>3</sup> Opposer's pending application, referenced *supra*, had been abandoned but was revived. The examining attorney seeks restoration of jurisdiction over applicant's application to suspend it while opposer's earlier-filed application is allowed to proceed through examination and publication for opposition.

In response to the motion, applicant argues that its services and opposer's goods are dissimilar and they travel in different channels of trade. Applicant also asserts that opposer is not the owner of the pleaded mark, as the application for the mark was filed in the name of an individual, Ely Gold, while opposer is a corporation, Elgo, Inc. Further, applicant asks the Board to strike opposer's Exhibit 8, because it was not properly authenticated. Specifically, applicant argues that the evidence in Exhibit 8 is not self-authenticating, that counsel as the declarant lacked the requisite personal knowledge to authenticate opposer's web pages, and there is no evidence or testimony by a principal or employee of opposer attesting to the authenticity of the web pages found in Exhibit 8.

Opposer then submitted the declaration of its chief operating officer, founder, shareholder and webmaster, Ely Gold, labeled as "Exhibit 12" to its reply brief. Mr. Gold declares that he is "the owner of Trademark Application Serial No. 78085086 for the mark 'SimplyQuit,' which is used by Elgo, Inc.," that he has reviewed the documents in Exhibit 8, and that the "content of these pages is a true and accurate representation" of opposer's website from 2001 through 2007. Opposer asserts that the web pages submitted in Exhibit 8 are self-authenticating and evidence the existence of opposer's website, and argues the newly

introduced declaration provides all necessary support for the documents in its Exhibit 8.

Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. See Fed. R. Civ. P. 56(c). A genuine dispute with respect to a material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the non-moving party. See *Opryland USA Inc. v. Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Thus, all doubts as to whether any particular factual issues are genuinely in dispute must be resolved in the light most favorable to the non-moving party. See *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

A plaintiff moving for summary judgment in its favor on a priority and likelihood of confusion claim must establish that there is no genuine dispute that (1) it has standing to maintain the proceeding; (2) it is the prior user of its pleaded mark or marks or the owner of a valid and subsisting federally registered mark; and (3) contemporaneous use of the parties' respective marks on their respective goods or services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733 (TTAB 2001); see

also, *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Standing is a threshold issue that must be proven by a plaintiff in every inter partes case. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). The purpose of the standing requirement, which is directed solely to the interest of the plaintiff, is to prevent litigation when there is no real controversy between the parties. *Lipton Industries*, 213 USPQ at 189.

To establish standing, it must be shown that the plaintiff has a "real interest" in the outcome of a proceeding; that is, plaintiff must have a direct and personal stake in the outcome of the opposition. *Ritchie*, 50 USPQ2d at 1023. Facts regarding its legitimate personal interest are a part of the plaintiff's case and must be proved. *Lipton Industries*, 213 USPQ at 189. On a motion for summary judgment, it must be shown that there is no genuine issue as to this material fact.

After reviewing the arguments and evidence presented, we find there is a genuine issue regarding opposer's standing to bring this opposition. In the notice of opposition, opposer states, "[o]pposer, through its principal, Ely Gold, applied for a trademark on September

22, 2001 (application no. 78/085086)..." (Notice of opposition at ¶4). In its motion for summary judgment, opposer states, "[o]pposer is the owner of U.S. Trademark Application No. 78/085086 for the trademark SIMPLYQUIT, filed under Section 1(a) on September 22, 2001, for "smoker's articles, namely, simulated cigarette [sic]." (Opposer's motion for summary judgment at 7). And, in his declaration Mr. Gold declares, "I am the owner of Trademark Application Serial No. 78/085086 for the mark 'SimplyQuit,' which is used by Elgo, Inc. for the sale of simulated cigarettes and the 'Step-by-Step Stop Smoking Guide.'" (Exhibit 12 at ¶3). These conflicting statements raise an issue about whether opposer is the real party with interest in these proceedings, and thus whether it has standing.<sup>4</sup>

As to applicant's motion to strike Exhibit 8, we note that authentication of evidence is not as critical for summary judgment purposes where the question is whether genuine issues remain for trial. Under Fed. R. Civ. P. 56(e), the Board may permit the parties to supplement their summary judgment affidavits or to submit additional affidavits. *Shalom Children's Wear Inc. v. In-Wear A/S*, 26

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<sup>4</sup> The fact that we have identified and discussed only the genuine issue regarding opposer's standing as the basis for denying the motion for summary judgment should not be construed to indicate that this is the only issue that remains for trial. At trial, opposer will bear the burden of proving every element of each of its claims.

USPQ2d 1516, 1517 (TTAB 1993). While we could exercise our discretion under the rule in favor of considering the additional evidence offered with opposer's reply brief, which might render moot applicant's objection to Exhibit 8, we would still find a genuine issue as to standing. Therefore, we need not resolve the objection to this exhibit and the effect of applicant's proffer of additional support for the exhibit with its reply brief.

Accordingly, opposer's motion for summary judgment is denied.<sup>5</sup>

Motion for Remand

In the motion for remand of applicant's application, the examining attorney explains that the application was inadvertently approved in error because opposer's application was improperly abandoned due to Office error. Opposer's application has since been revived. The examining attorney seeks restoration of jurisdiction so that applicant's application may be withdrawn from publication and a suspension letter issued.

In light of the time and expense already incurred by the parties in the prosecution of this case, the Board finds

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<sup>5</sup> The parties should note that evidence submitted in support of or in opposition to a motion for summary judgment is of record only for purposes of the motion. Any such evidence to be considered at final hearing must be properly introduced during the appropriate trial period. See, e.g., *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993).

that it would be more efficient to continue with the proceeding. In addition, we note that the opposition is in part based on opposer's claim of common law rights and that issue is properly considered in the opposition proceeding.

Accordingly, the examining attorney's motion for remand of applicant's application Serial No. 77090694 is denied. Appropriate dates are reset below.

|  |                         |
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| DISCOVERY PERIOD TO CLOSE:   | <b>January 30, 2009</b> |
| 30-day testimony period for party in position of plaintiff to close: | <b>April 30, 2009</b>   |
| 30-day testimony period for party in position of defendant to close: | <b>June 29, 2009</b>    |
| 15-day rebuttal testimony period for plaintiff to close:             | <b>August 13, 2009</b>  |

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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