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

Proceeding	91179090
Party	Plaintiff Elgo, Inc.
Correspondence Address	Joseph A. Mandour Mandour & Associates, APC 16870 West Bernardo Drive, Suite 400 San Diego, CA 92127 UNITED STATES jmandour@mandourlaw.com, blila@mandourlaw.com
Submission	Brief on Merits for Plaintiff
Filer's Name	Ben T. Lila
Filer's e-mail	blila@mandourlaw.com,jmandour@mandourlaw.com,kbruce@mandourlaw.com
Signature	/Ben T. Lila/
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I. SUMMARY OF THE ARGUMENT

Opposer Elgo, Inc. (“Elgo”) is the prior user, prior applicant, and registrant of the trademark SIMPLYQUIT, which it has used continuously in commerce in conjunction with goods and services relating to smoking cessation. Applicant SimplyWell, LLC (“SimplyWell”) seeks to register the identical trademark SIMPLYQUIT for its goods and services also relating to smoking cessation in Trademark Application Serial No. 77/090,694.

Elgo’s U.S. Trademark Registration No. 3,557,525 for SIMPLYQUIT is entitled to a presumption of validity under 15 U.S.C. § 1057. Accordingly, SimplyWell’s Application should be refused registration because it is likely to cause confusion with Elgo’s registration in violation of Section 2(d) of the Lanham Act.

II. DESCRIPTION OF THE RECORD

A. Evidence Submitted By Opposer

Opposer has submitted the following Notices of Reliance, which were made of record pursuant to Trademark Rule 2.122(e):

1. Opposer’s First Notice of Reliance dated April 30, 2009 (“Opposer’s First NOR”) containing the file history for Opposer’s U.S. Trademark Registration No. 3,557,525.
2. Opposer’s Second Notice of Reliance dated April 30, 2009 (“Opposer’s Second NOR”) containing the file history of Applicant’s U.S. Trademark Application Serial No. 77/090,694.
3. Opposer’s Third Notice of Reliance dated April 30, 2009 (“Opposer’s Third NOR”) containing various written discovery in the proceeding.
4. Opposer’s Fourth Notice of Reliance dated April 30, 2009 (“Opposer’s Fourth NOR”) containing materials related to Opposer’s use of the SIMPLYQUIT Trademark.

5. Opposer's Fifth Notice of Reliance dated April 30, 2009 ("Opposer's Fifth NOR") containing Applicant's Brief in Opposition to Opposer's Motion for Summary Judgment and Applicant's Brief in Support of Its Motion to Strike.
6. Opposer's Sixth Notice of Reliance dated April 30, 2009 ("Opposer's Sixth NOR") containing advertising material entitled "According to Medical Studies."
7. Opposer's Seventh Notice of Reliance dated April 30, 2009 ("Opposer's Seventh NOR") containing an assignment for the Trademark Application No. 78/085,086.
8. Opposer's Eighth Notice of Reliance dated April 30, 2009 ("Opposer's Eighth NOR") containing an attached printout of the WHOIS database showing the owner of the domain name SimplyQuit.com.

B. Evidence Submitted By Applicant

Applicant has submitted the following Notices of Reliance, which were made of record pursuant to Trademark Rule 2.122(e):

1. Applicant's First Notice of Reliance dated July 30, 2009 ("Applicant's NOR") containing various written discovery in the proceeding.

Applicant has made the following testimony depositions of record pursuant to Trademark Rule 2.123, with exhibits thereto:

1. Michael Demman, Chief Executive Officer of SimplyWell LLC, taken on June 5, 2009, including Exhibits 1-10.

III. STATEMENT OF THE ISSUES

1. Whether Applicant should be barred from registering the SIMPLYQUIT trademark that is (1) identical to Opposer's registered trademark; (2) used with similar goods and services as Opposer; and (3) provided in the same channels of trade as Opposer.
2. Whether Opposer as assignee of record of all rights to the SIMPLYQUIT trademark has standing to oppose Applicant's trademark application.

IV. STATEMENT OF FACTS

The essential facts in this matter are largely undisputed. Opposer Elgo is the prior user, prior applicant, and registrant of the trademark SIMPLYQUIT. Opposer has used the SIMPLYQUIT trademark continuously in interstate commerce in conjunction with goods and services relating to smoking cessation. Elgo is the prior applicant in U.S. Trademark Application No. 78/085,086 for the trademark SIMPLYQUIT for its goods related to smoking cessation, which was filed on September 22, 2001 (Opposer's First NOR, Exhibit A).

Applicant SimplyWell seeks to register the identical trademark SIMPLYQUIT for its services also relating to smoking cessation in Trademark Application Serial No. 77/090,694 (Opposer's Second NOR). SimplyWell filed its application as an intent to use application on January 25, 2007. Applicant filed an Amendment to Allege Use in Commerce on February 7, 2007 alleging a date of first use in commerce of September 2006. Due to an admitted clerical error by the USPTO, SimplyWell's application was approved inadvertently without consideration of Elgo's application. Upon realizing that SimplyWell's application was approved in error, the Examining Attorney identified that Elgo's application barred SimplyWell's application. On January 6, 2009, Elgo's application matured to registration, entitling it to a presumption of validity and constructive use since its application date under 15 U.S.C. § 1057.

V. ARGUMENT

A. SimplyWell's Application Serial No. 77/090,694 is Statutorily Barred from Registration

The Lanham Act Section 2(d) bars registration of an applied-for mark that so resembles a registered trademark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. 15 U.S.C. § 1052(d); TMEP § 1207.01. The determination of whether a likelihood of confusion exists is made by evaluation and balancing of the pertinent *du Pont* factors: (1) The similarity or dissimilarity of the marks in their entireties as to the appearance, sound, connotation and commercial impression; (2) the similarity or dissimilarity and the nature of the goods or services as described in an application or registration in connection with which a prior mark is in use; (3) the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and the buyers to whom sales are made; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without evidence of actual confusion; (9) the variety of goods on which a mark is or is not used; (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which applicant has a right to exclude others from use of its mark on its goods; (12) the extent of potential confusion; *i.e.*, whether *de minimus* or substantial; and (13) any other facts probative of the effect of use. *In re E.I. du Pont de Nemours*, 476 F.2d 1357, 177 (CCPA 1973).

In the present case, the following factors are the most relevant: (1) similarity of the marks, (2) similarity of the goods and/or services, (3) similarity of trade channels of the goods

and/or services, (4) the conditions under which and the buyers to whom sales are made, and (13) other facts probative of the effect of use.

1. Applicant's Trademark is Identical to Opposer's Registered Trademark.

Applicant's SIMPLYQUIT trademark is identical to Opposer's SIMPLYQUIT trademark in appearance, sound, connotation and commercial impression. Both trademarks have identical contents, spelling, and spacing. Both trademarks refer to the concepts of easy smoking cessation. Thus, there is no genuine issue of contention that the trademarks are identical.

2. Applicant's Trademark is for Similar Goods and Services as Opposer's Registered Trademark.

In the case of identical trademarks, the Trademark Trial and Appeal Board has found that the relationship between the goods or services need not be as close to support a finding of likelihood of confusion as would be required in a case where there are differences between the trademarks. *Amcor, Inc. v. Amcor Industries, Inc.*, 210 USPQ 70, 78 (TTAB 1981).

In the present case, both trademarks relate to assistance with smoking cessation. Both Applicant and Opposer offer products and services related to smoking cessation. The fact that Applicant is seeking registration for services and Opposer's registration is for goods does not avoid a likelihood of confusion. It is well recognized that confusion is likely to occur from the use of the same or similar trademarks for goods on one hand, and for related services on the other. *See, e.g., Steelcase Inc. v. Steelcare Inc.*, 219 USPQ 433 (TTAB 1983) (STEELCARE INC. for refinishing of furniture services held likely to be confused with STEELCASE for office furniture and accessories); *In re Phillips-Van Heusen Corp.*, 228 USPQ 949 (TTAB 1986) (21 CLUB for apparel held likely to be confused with THE "21" CLUB (stylized) for restaurant services); *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 463 (Fed. Cir. 1988) (BIGG'S (stylized) for retail store services held likely to be confused with BIGGS (+design) for furniture).

There is clearly a likelihood of confusion between a trademark for counseling services in the field of smoking cessation and a trademark using the identical trademark for a product to aid in smoking cessation. Both are targeted at smokers who are trying to quit, as well as health care providers for the benefit of their patients. Potential consumers would reasonably expect that a smoking cessation service provider such as Applicant might offer products related to smoking cessation, and that a seller of smoking cessation products like Opposer might offer smoking cessation related services. Because Applicant's and Opposer's goods and services relate to smoking cessation, consumers are likely to be confused as to the source of the goods or services.

3. Applicant's Trademark is used in the Same Channels as Opposer's Registered Trademark.

The determination of likelihood of confusion is made on the basis of the goods or services recited in the application. *See e.g., Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d 1001 (Fed. Cir. 2002); *In re Uncle Sam Chemical Co., Inc.*, 229 USPQ 233 (TTAB 1986). For there to be any likelihood of confusion, some "relevant person" must be likely to encounter both trademarks and subsequently be confused as to the source of the goods or services. *In re Digirad*, 45 USPQ2d 1841, 1844 (TTAB 1998).

During the pendency of the Opposition proceeding, Applicant hastily amended its goods and services recitation to add the term "offered through employer sponsored wellness plans." Applicant's amendment, however, does not change the issue that both Applicant's and Opposer's products target individual smokers. Opposer offers its *Step-by-Step Stop Smoking Guide* for self-help counseling, which is essentially the same service offered by Applicant's brochures. Opposer and Applicant, in fact, use many of the same marketing materials for their respective products and services. For example, Opposer is informed and believes that Applicant intentionally used materials from Opposer's website regarding the benefits of smoking cessation.

(See Opposer's Third NOR, Exhibit F, SW00001 and SW00012) It is ultimately individual smokers that receive Applicant's brochures containing the SIMPLYQUIT trademark. These individual smokers may not be direct purchasers of SimplyWell's services, but they are purchasers nonetheless, and they are also the purchasers of Elgo's products and services. Because individual smokers are "relevant persons" likely to encounter both trademarks, there is clearly a likelihood of consumer confusion.

4. The Examining Attorney Has Already Identified That Application Serial No. 77/090,694 Is Likely To Be Confused With Opposer's Registration.

The Examining Attorney for the Applicant's application has properly identified that the application "was inadvertently approved in error," because Opposer's application "prevents registration of the instant application." (See Examining Attorney's Motion for Remand dated September 15, 2008, Docket Doc. 10). As set forth above, Applicant's application is likely to be confused with Opposer's registration. The Examining Attorney's Motion correctly confirms Opposer's contention. Because Opposer's application has matured into a registration, Applicant's application must be barred from registration as a matter of law under 15 U.S.C. § 1052(d).

Additionally, the procedural posture of the present case provides a novel issue as to the burden of proof in the current proceeding. Ordinarily an opposer carries the burden of proof by a preponderance of the evidence, to show that an applicant is not entitled to registration. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 15272, 158081 (Fed. Cir. 1988). The Examining Attorney of the instant application, however, has confirmed that Applicant's application was "inadvertently approved in error." Due to an error in examination, Applicant's application was not properly rejected. Had Applicant's application been properly examined, it is *Applicant* that

would have and should have been required to carry the burden of proof that consumers are *not* likely to be confused. It is therefore inequitable for Opposer to carry the burden of proof in the present case.

B. Opposer has Standing to Oppose Application Serial No. 77/090,694.

Under 15 U.S.C. § 1060, the owner of a registered trademark may assign all rights and interests in the trademark. In its prior ruling on September 19, 2008, the Board identified that an issue of material fact existed as to standing in its prior ruling on September 19, 2008. Since then, on April 23, 2009, Opposer has filed assignment that leaves no doubt that it is the owner of Trademark Registration No. 3,557,525 for SIMPLYQUIT. Recordation of an assignment constitutes *prima facie* evidence of execution of an assignment. 15 U.S.C. § 1060(a)(3). Applicant has provided no evidence in the record rebutting that Opposer is the valid assignee and holder of rights.

As assignee, Opposer holds all rights and interests in the SIMPLYQUIT trademark including the trademark registration. Because Applicant is seeking registration of a trademark identical to Opposer's registration, there is no reasonable issue of contention that Opposer has a real interest in the proceeding and thus has standing.

VI. CONCLUSION

Accordingly and for the foregoing reasons, Opposer Elgo, Inc. respectfully requests that the Board deny registration of Application Serial No. 77/090,694.

Date: January 11, 2010

By: _____ s/ Ben T. Lila
Ben T. Lila
blila@mandourlaw.com
Mandour & Associates, APC
Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing “OPPOSER’S BRIEF ON THE MERITS” has been served via first-class mail, postage pre-paid, upon the attorneys for Applicant at the following address:

Christopher M. Bikus
Husch Blackwell Sanders, LLP
1601 Dodge Street, Suite 2100
Omaha, NE 68102-1637

Dated: January 11, 2010

s/ Ben T. Lila
Ben Lila