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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.
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Submission	Motion for Summary Judgment
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Date	06/27/2008
Attachments	Exhibit12.pdf (3 pages)(49128 bytes) OpposersReplyBriefinSupportofMotionforSJ.pdf (10 pages)(76851 bytes)

Exhibit 12

to

Motion for Summary Judgment

Trademark Opposition No. 91179090

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

In the Matter of Application Serial No. 77/090,694
Published in the *Official Gazette* on August 7, 2007

ELGO, INC.,

OPPOSITION NO.: 91179090

OPPOSER

vs.

SIMPLYWELL, LLC,

APPLICANT

DECLARATION BY ELY GOLD

1. My name is Ely Gold. I am over the age of 21 and competent to make this declaration based upon my personal knowledge.

2. I am the Chief Operating Officer of Elgo, Inc. and a founder and shareholder of Elgo, Inc.

3. 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.”

4. I am the inventor and owner of U.S. Patent No. 6,606,998, entitled “Simple Simulated Cigarette,” which describes the product sold by Elgo, Inc.

5. I am the webmaster for the website <http://www.simplyquit.com>. I designed the website with Sam Gold and built the web site in 2001. I published the website online at least as early as August 2001, and have maintained and updated the website continually since that time.

6. I have reviewed the pages printed out from the Wayback Machine in Exhibit 8 of the Motion for Summary Judgment. The content of these pages is a true and accurate

representation of the <http://www.simplyquit.com> website throughout the time period from 2001 through 2007, and accurately reflects the history of the development of the web site.

7. The domain name [simplyquit.com](http://www.simplyquit.com), the web site <http://www.simplyquit.com>, and the mark SIMPLYQUIT have been in continuous use since 2001. I added sample TV commercials to the web site in 2002 and a sample radio commercial in 2003. I added pages in Spanish in 2002 and in Russian in 2003.

8. In addition to the simulated cigarette product, Elgo, Inc. has offered the “Step-by-Step Stop Smoking Program” and later the “Step-by-Step Stop Smoking Guide” under the SIMPLYQUIT mark and bundled the simulated cigarette with the Program or Guide in a “SIMPLYQUIT Step 1 Kit.” These products have been offered continuously since 2001.

9. Elgo, Inc. has used the mark SIMPLYQUIT in commerce continuously from September 21, 2001 to the present, with sales throughout the U.S. and internationally.

10. Elgo, Inc.’s use of the mark SIMPLYQUIT has resulted in substantial consumer awareness of the mark as a result of seven years of continuous and substantial use.

11. Elgo, Inc. has used the mark SIMPLYQUIT both as a single word “SimplyQuit” and as two words “Simply Quit” in both serifed and non-serifed fonts throughout the period from 2001 to the present.

* * *

I declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

/Ely Gold/
Ely Gold

06/22/08
Date

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

In the Matter of Application Serial No. 77/090,694
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ELGO, INC.,

OPPOSITION NO.: 91179090

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SIMPLYWELL, LLC,

APPLICANT

**OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT AND
REPLY BRIEF TO APPLICANT'S MOTION TO STRIKE**

Pursuant to 37 C.F.R. § 2.127(a) and consistent with TBMP § 502.02(b), Opposer, Elgo, Inc., respectfully submits for the Board's consideration in its discretion this reply brief in support of Elgo, Inc.'s Motion for Summary Judgment.

Nothing in Applicant's submission establishes a genuine issue of material fact or otherwise overcomes the bases for summary judgment set forth in Elgo, Inc.'s initial brief. Elgo, Inc. stands on its initial briefing as to the matters addressed therein, but submits for the Board's consideration the following amendments to Opposer's Statement of Uncontroverted Material Facts, the Declaration of Ely Gold, and the following points in reply to Applicant's Brief in Opposition to the Motion for Summary Judgment and in reply to Applicant's Brief in Support of Its Motion to Strike.

I. Opposer's Amended Statement of Uncontroverted Facts.

Applicant's Service Mark

5. The Specimen in support of Use in Commerce submitted for Application No. 77/090,694 is described as a brochure displaying the mark. The brochure purports to describe Applicants eight-step

smoking cessation program for smokers, and contains content directed at individual smokers (e.g., “Initial contact when you are assigned your personal quit coach,” “Here is how your health can improve after your last cigarette.” (Exhibit 1, Applicant’s Application file)

* * *

Opposer’s Prior Use of the mark SIMPLYQUIT

14. Opposer’s simplyquit.com website was established in August 2001 and has been actively managed by Ely Gold, Elgo, Inc.’s Chief Operating Officer, principal and webmaster, since that time. Records available at the Wayback Machine show 123 snapshots taken between October 16, 2001 and August 29, 2007, with updates noted on 16 dates: October 16, 2001, October 31, 2001, December 4, 2001, June 6, 2002, June 8, 2002, August 6, 2002, September 23, 2002, November 23, 2002, December 1, 2002, February 9, 2003, July 18, 2003, August 4, 2003, February 3, 2006, July 1, 2006, May 29, 2007 and July 2, 2007, indicating active management of the website throughout the time period. The content shown in these records is a true and accurate representation of the <http://www.simplyquit.com> website throughout the time period from 2001 through 2007, and accurately reflects the history of the development of the website. (Exhibit 7, Affidavit of Cynthia Moore; Exhibit 8, printouts from the Wayback Machine; Exhibit 12, Declaration of Ely Gold)

* * *

Opposer’s Trademark Application

26. Ely Gold is the Chief Operating Officer for Opposer Elgo, Inc., as well as a principal and webmaster, and is also the owner of U.S. Trademark Application No. 78/085,086 for the trademark SIMPLYQUIT, filed under Section 1(a) on September 22, 2001, for “smoker’s articles, namely simulated cigarette.” Opposer uses the trademark SIMPLYQUIT for the sale of simulated cigarettes and their “Step-by-Step Stop Smoking Guide.” (Exhibit 9, Opposer’s Application File; Exhibit 12, Declaration of Ely Gold)

Opposer requests that the Board consider Exhibit 12, Declaration of Ely Gold, and note that it

provides additional support for Facts Nos. 14–18.

A. Response to Applicant’s Opposition to Opposer’s Statement of Facts

Applicant has expressed disagreement as to the originally submitted versions of the above statements of facts and alleged that there is a genuine issue of material facts in statements 5, 14–18, 21, and 26. No reasons were given for disputing Fact No. 18, and Opposer submits that there is no genuine issue of material fact related thereto.

Fact number 5 has been amended to state simply that the brochure “contains content directed at individual smokers” as is self-evident from the text displayed therein. The brochure does **not** address its comments at marketing executives or corporate managers, for example, using language such as “Are your employee health care costs soaring due to continued employee smoking habits?” Opposer respectfully submits that it is self-evident that Applicant’s brochure is directed to individual smokers, and not to “corporate managers,” and there is no genuine issue of material fact related to this issue warranting a trial. Applicant’s claim that the brochure is directed at “individual employees of companies that are subscribers to SimplyWell’s Integrated Health Solutions program” is not supported by any information in Applicant’s trademark application file, and does not, in any case, contradict the fact that the brochure is directed at individual smokers. The individuals targeted by SimplyWell’s sample brochure are, at best, a subset of the larger general population of individual smokers. Applicant’s statement that its services are not offered to the general public but through member employee subscribers is also unsupported by Applicant’s trademark application file, and in fact, there is nothing in Applicant’s application file that limits their customer base, modes of advertising or channels of trade in any manner. If allowed to be registered, Applicant would be free to market their counseling services to the public at large if they desired. In any case, their alleged limitations are irrelevant to the identity of the group of people who would be expected to view Applicant’s sample brochure, be exposed thereby to the use of the mark SIMPLYQUIT and be confused.

Fact 26 has been amended to correctly state the ownership of U.S. Trademark Application No.

78/085,086 for the mark SIMPLYQUIT and the relationship between the owner and the Opposer. The amended fact is supported by Opposer's trademark application file and the declaration of Ely Gold. There is no genuine issue of material fact with regard to the amended statement of ownership, and the ownership, in any case, has no bearing on Elgo, Inc.'s standing to oppose.

B. Response to Applicant's Supplemental Statement of Facts

Opposer does not disagree with any of Applicant's Supplemental Statement of Facts, other than to point out that they are irrelevant to the present Opposition.

II. Opposer's Response to Applicant's Arguments

B. Applicant's Assertions that Applicant's services and Opposer's goods are dissimilar

Applicant attempts to characterize its "personalized" smoking cessation counseling services as dissimilar from Opposer's simulated cigarettes, and attempts to obfuscate the issues by arguing that Applicant offers its "highly personalized counseling services solely to participants enrolled in one of Applicant's comprehensive integrated health solutions" while "[i]n contrast, Opposer sells simulated plastic cigarettes to the public via the Internet." Applicant further argues that it is well settled that "where goods and services are not related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source, then, even if the marks are identical, confusion is not likely."

Opposer points out that these points are not relevant to a consideration of whether the goods and services are related, and do not raise in any genuine issues of material fact related thereto. The alleged restricted marketing has no bearing on whether the goods and services are dissimilar, and in any case is irrelevant because Applicant has not limited the scope of its use of the mark in its trademark application file. **An Applicant may not restrict the scope of its customer base or channel of trade in contradiction to that identified in the Application by extrinsic argument or evidence as to their preferred customers or channels of trade.** See, e.g., *In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986). Here, Applicant's assertions that Applicant does not market directly to consumers **are**

not relevant, because the determination of likelihood of confusion must be made on the basis of the goods or services recited in the application.

Applicant's reliance on the fact that the respective goods and services can be found in different international classes is also irrelevant, as previously argued. Further, Applicant's reliance on well settled law is misplaced: the evidence supports Opposer's contention that Opposer's goods and Applicant's services are related or marketed in such a way that they would be encountered by the same persons in situations that would create the incorrect assumption that they originate from the same source. Opposer's goods and Applicant's services would indeed be encountered by overlapping sets of people seeking assistance with smoking cessation, and confusion is therefore, in fact, likely under this well settled doctrine (Facts Nos. 1, 5, 7, 8, 9, 10, 11, 12, 13, 15, 16, 17, 18).

Applicant attempts to distinguish the cases cited in support of Opposer's likelihood of confusion argument. Applicant states "For example, *In re H.J. Seiler Co.* 289 F.2d 674, 129 USPQ 347 (C.C.P.A. 1961) involved catering services and meat, clearly complementary goods and services. Similarly, *In re Hyper Shoppes Inc.* 837 F.2d 463, 6 USPQ2d 1025 (Fed. Cir. 1988) involved a general merchandise store and furniture. It is easy to conceive of a general merchandise store selling furniture."

First of all, Opposer notes that it is easy to conceive of a provider of smoking cessation counseling services recommending or selling smoking cessation aids such as Opposer's simulated cigarettes, or of a supplier of smoking cessation aids offering counseling services or programs for smoking cessation. Second, in contrast to Applicant's characterization of these cases as distinguishable, Opposer notes that these cases stand for the proposition that the use of similar marks on goods and in connection with services using those goods is likely to cause confusion. *In re H.J. Seiler Co.* states that "a customer who attends a banquet which he knows is catered by the appellant would, when he encounters a food product in the grocery store under an almost identical mark, naturally assume that it came from the catering firm". *Id.*

In the instant case, employees of Applicant's corporate subscribers will likely be exposed during

Applicant's counseling services to a wide variety of methods deemed useful for smoking cessation, including simulated cigarette products, whether directly via Applicant's counselors or indirectly via suggestions from personal physician and friends, or questions, requests and suggestions from other participating employees. Further, persons who are trying to quit smoking are likely to watch television programs such as that shown on ABC's "The View" where Whoopi Goldberg hosted a discussion with a physician on smoking cessation methods and aids, and in which Opposer's SIMPLYQUIT simulated cigarettes were discussed. (Exhibit 6) Similarly, persons who are trying to quit smoking may search the internet for assistance and encounter Opposer's SIMPLYQUIT product and Guide. Such persons learning about SIMPLYQUIT simulated cigarettes (including those already using them) will likely be confused as to the source or origin of the SIMPLYQUIT counseling services, and be deceived as to the origin of the simulated cigarettes. As Applicant has no restrictions on its use of the mark for counseling services, such overlapping customers are likely.

Further, the Board in *In re H.J. Seiler Co.* states "*It is, of course, possible that purchasers of the smoked meats would not be likely to call upon the smoked meat manufacturer for catering service.*

However, if customers of the catering service believe that the smoked meat in the grocery store comes from the caterer, it is not necessary that they also believe that the smoked meat manufacturer is the caterer. Either supposition creates confusion as to source or origin." *Id.* (Emphasis in original.)

Similarly, if customers of Applicant's counseling service believe that the SIMPLYQUIT simulated cigarettes come from the Applicant, it is not necessary that they also believe that the simulated cigarette provider is also the provider of the counseling service. Either supposition creates confusion as to source or origin. In the case at hand, a person who is familiar with the use of the mark SIMPLYQUIT in connection with Applicant's counseling services who encounters SIMPLYQUIT on simulated cigarettes as smoking cessation aids is likely to assume, mistakenly, that a single source is responsible for both the goods and the services. This is precisely the kind of confusion that the Lanham Act was designed to help preclude.

Opposer submits that there is no genuine issue of material fact regarding whether Applicant's mark is dissimilar from Opposer's mark, and that the marks are clearly sufficiently related to cause confusion or mistake as to origin.

C. Applicant's Assertions as to Different Channels of Trade

Applicant asserts that Applicant's target customers are a "starkly different group of consumers" from that targeted by Opposer, implying that the likelihood of confusion is lower. Opposer asserts that these are **not** starkly different consumers at all, and that Applicant is mischaracterizing Opposer's consumer base as much narrower than that stated (and not opposed) in Fact No. 13: "individuals seeking assistance with efforts to quit smoking, as well as health care personnel, including physicians, pharmacists, nurses and smoking cessation counselors." Therefore, Applicant erroneously implies that Opposer's channels of trade are much more limited than is actually supported by the factual evidence (Facts Nos. 8, 10, 12, 13, 15; note especially, the extensive list of advertising channels in Fact No. 10).

Opposer asserts that Applicant's narrow identification of its own channels of trade is also misstated and not supported by the Application file. Its "counseling in the field of smoking cessation" is not restricted in any way, and therefore must be presumed to be advertised and offered through any reasonable channel of trade including direct sales to individual smokers. Further, even were it permissible to consider Applicant's sales and marketing as limited to programs sold to "a corporate benefits administrator analyzing applicant's sophisticated health solutions," the programs are then presented to individual smokers using brochures that include the SIMPLYQUIT mark. These individual smokers may not be direct purchasers of SimplyWell's services, but they certainly could be purchasers of Opposer Elgo, Inc.'s products, and there is clear likelihood of confusion for these individuals as to the relationship between the seller of the corporate programs and the seller of the products.

For there to be any likelihood of confusion, some "relevant person" must be likely to encounter both marks and subsequently be confused as to the source of the goods or services. The inquiry is as to whether there is a particular person who would encounter both marks and become confused. *In re*

Digirad, 45 USPQ2d 1841, 1844 (TTAB 1998), *Electronic Design and Sales, Inc. v. Electronic Data Systems Corp.*, 21USPQ2d 1388 (Fed. Cir. 1992). In the instant case, Applicant's corporate customers might reasonably be expected to recommend or purchase smoking cessation products for use in support of their smoking cessation programs, or the benefits administrators might themselves be smokers seeking to quit. Contrary to Applicant's assertion, there is clear overlap between the purchasers of Applicant's services and those of Opposer's products, and there is no genuine issue of material fact warranting trial.

D. Applicant's Assertions that there have been no instance of actual confusion

Applicant asserts that there have been no incidents of actual confusion. Applicant further states that the marks have coexisted in the marketplace since September 2006, and concedes that the geographic extent of the use of the parties' marks overlap, but further states that "there have been instances of actual confusion in this case [*sic*]."

However, it is well settled that the relevant test is *likelihood of confusion*, not actual confusion, and that it is unnecessary to show actual confusion to establish likelihood of confusion. *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 1549, 14 USPQ2d 1840, 1842-43 (Fed. Cir. 1990), and cases cited therein. In addition, Opposer asserts that the time period since September 2006 is very short for obtaining evidence of actual confusion, and that this lack of evidence is therefore not probative. Further, absence of actual confusion is irrelevant because Applicant has failed to present evidence of use of its mark sufficient to generate confusion. See Applicant's Answers to Interrogatory Nos. 11 -14, which show limited use of Applicant's mark to date. (Exhibit 10) Therefore the lack of any actual confusion is not a genuine issue of material fact relevant to this opposition.

E. Applicant's assertion that Exhibit 8 and associated facts should be struck

Applicant argues that the information from the Wayback machine introduced as Exhibit 8 is not self-authenticating and is not supported by a declaration by a person with the requisite personal knowledge to establish that the documents are what the declarant proclaimed them to be. Opposer asserts that the pages are admissible as self-authenticating with respect to their use as evidence of the existence

of the website <http://www.simplyquit.com> through the alleged period of time and evidence of periodic updates, with no specific claim as to the significance of any particular website content or the dates on which particular content was posted.

Nevertheless, the newly introduced Declaration of Ely Gold (Exhibit 12) provides all necessary additional support from a person who, as the webmaster for the website, clearly has personal knowledge of all stated facts supported by Exhibit 8 and is competent to authenticate the evidence. Further, the Declaration supports the assertion that the webpage information correctly reflects the historical development of the website and the content of the website on particular dates as summarized in Fact No. 14-17. Thus, any possible defect with regard to the admissibility of the web pages shown in Exhibit 8 and Facts 14–18 which partially rely thereon has been corrected, and the evidence and Facts should be admitted and considered by the Board.

III. CONCLUSION

Opposer has established prior and continuous use of the same mark as a matter of uncontroverted fact. Opposer has also shown that there is substantial likelihood of confusion between Applicant's use of the mark and Opposer's use of the same mark. There is no genuine issue of material fact regarding the likelihood of confusion.

Opposer therefore prays that the Motion for Summary Judgment be granted and that Applicant's mark be denied registration.

Respectfully submitted,

ELGO, INC., Opposer

Dated this 27th day of June 2008

By: /Cynthia R. Moore/
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CERTIFICATE OF ESTTA FILING

The undersigned hereby certify that a copy of the foregoing papers and all exhibits thereto was filed electronically with the Trademark Trial and Appeal Board via the ESTTA on the 27th day of June 2008.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing papers and all exhibits thereto was served on Christopher Bikus, the attorney for Applicant SimplyWell, LLC, by first class mail postage prepaid this 27th day of June 2008, addressed as follows:

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/Cynthia R. Moore/
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Attorney for Opposer