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

Proceeding	91191371
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CLEARCHOICE HOLDINGS, LLC

Opposer,

v.

DALE D. GOLDSCHLAG, D.D.S., P.C.

Applicant.

Opposition No. 91191371

Serial No. 77/685,491

For the mark: RIGHTCHOICE

Motion to Strike Notices of Reliance and Motion for Judgment for Failure to Prove Case

Pursuant to TBMP § 532, Applicant Dale D. Goldschlag, D.D.S., P.C. (“Applicant”) hereby moves to strike the Third Notice of Reliance, the Second Notice of Reliance, and portions of the First Notice of Reliance, submitted by Opposer ClearChoice Holdings, LLC (“Opposer”). Applicant also moves for judgment (or, dismissal with prejudice) against Opposer, pursuant to 37 C.F.R. § 2.132(b) and TBMP § 534.03, because Opposer has shown no right to relief. Opposer has failed to prove its case during its trial period by (1) not presenting any testimony; and (2) not properly submitting any admissible evidence (other than copies of certain USPTO records). Thus, the Board should strike Opposer’s improper evidence and enter judgment against Opposer.

1. Procedural background

On August 6, 2009, Opposer filed its opposition against Applicant’s application to register the mark RIGHTCHOICE. After granting numerous extensions of various deadlines in this proceeding, on March 21, 2013, the Board denied a motion for summary judgment filed by Opposer and reset discovery and trial dates in this proceeding. The Board noted, however, that “[n]o further requests to extend discovery will be granted absent a showing of extraordinary circumstances.”

Thereafter, Opposer basically did nothing. Opposer failed to conduct any discovery during the discovery period, which closed on June 20, 2013. Opposer's deadline for serving pretrial disclosures was August 4, 2013. However, Opposer did not serve any pretrial disclosures on Applicant or its counsel. Even if Opposer intended not to present witnesses during its case in chief, Opposer had an obligation to disclose that intention in its pretrial disclosures. *See* 37 C.F.R. §2.121(e) ("If a party does not plan to take testimony from any witnesses, it must so state in its pretrial disclosure."). Opposer also failed to serve its pretrial disclosures and did not offer any indication that it intended to prosecute its case.

During Opposer's 30-day trial period, Opposer failed to notice any testimony depositions and did not attempt to present a single witness through deposition transcript. Based on Opposer's failure to prosecute this case, Applicant assumed that Opposer had given up its efforts to oppose Applicant's application. However, on the day before Opposer's trial period closed, Opposer submitted to the Board and served on Applicant three defective notices of reliance. Through these notices of reliance, Opposer attempted to submit scant portions of evidence that Opposer relied on in a different case—evidence which had never been produced to Applicant's counsel in this proceeding.

Opposer's three notices of reliance included the following documents:

(1) Opposer's First Notice of Reliance—copies of registrations for Opposer's marks that incorporate CLEARCHOICE (including some registrations that Opposer did not plead); copies of USPTO records from Applicant's application to register RIGHTCHOICE (Ser. No. 77685491); and the file history of a third-party application to register REAL CHOICE (Ser. No. 77652784).

(2) Opposer's Second Notice of Reliance—a *Merriam-Webster* online dictionary definition of the word RIGHT; a *Merriam-Webster* online thesaurus entry for the word CLEAR; and another thesaurus entry from *The Synonym Finder* for the word CLEAR.

(3) Opposer’s Third Notice of Reliance—a copy of a report from an expert for whom Opposer presented no testimony; and a copy of the Board’s decision in *Clear Choice Holdings LLC v. Implant Direct Int’l* (Opp. No. 91190485) (TTAB Aug. 26, 2013) (non-precedential).

For the reasons outlined below, Opposer has failed to properly introduce any evidence other than some USPTO records, and therefore judgment should be entered against Opposer for failure to present even a *prima facie* case on its claims of likelihood of confusion and dilution.

2. The Board should strike evidence submitted by Opposer through its notices of reliance.

A notice of reliance may be stricken, “in whole or in part, on the ground that the notice of reliance does not comply with the procedural requirements of the particular rule under which it was submitted.” TBMP § 532. Any “[e]vidence not obtained and filed in compliance with [the rules] will not be considered” by the Board. 37 C.F.R. § 2.123(1); *see also* TBMP § 706.

Here, Opposer’s submission of evidence through its notices of reliance is procedurally and substantively defective and should not be considered by the Board. Even if certain aspects of Opposer’s notices of reliance had not been defective, “opposer would still fail to meet its burden of proof in this proceeding” and dismissal is still proper. *El Dorado Park Self Storage v. Marc Yelenich*, Opp. No. 91159837 (Jan. 18, 2008 TTAB) (non-precedential) (concluding that, even if evidence had been properly submitted, the opposition should be dismissed with prejudice).

a. Opposer’s expert report was improperly submitted and should be struck.

The rules do not allow a party to submit an expert report through a notice of reliance, and instead require expert testimony to be presented through the procedures outlined in TBMP § 703. Ironically, Opposer was apprised of this rule in the Board decision that Opposer improperly attempts to rely on in this proceeding. *See Clear Choice Holdings LLC v. Implant Direct Int’l* (Opp. No. 91190485) (TTAB Aug. 26, 2013) (non-precedential) (“expert reports are not admissible by notice of reliance”) (citing Trademark Rule 2.122(e); TBMP § 704.08(a)).

Despite being directly warned that expert reports are not admissible by notice of reliance, Opposer decided to ignore that warning and the rules in the hopes that Applicant would not notice and/or would not object. During its trial period, Opposer presented no expert testimony—whether through a testimony deposition or through a properly submitted transcript. Opposer is not allowed to do so now simply by submitting an expert report in a notice of reliance. Accordingly, the Board should strike Opposer’s expert report contained in Opposer’s Third Notice of Reliance.

Even if the expert report submitted by Opposer was not procedurally defective (it is), it has no probative value in this case or in any other case. In the same case that Opposer attempts to rely on to support its claims in this proceeding, the Board already considered and rejected the very expert survey and report submitted by Opposer. The Board found that “the survey [conducted by the expert] suffers from numerous flaws,” including, among other things, that it (a) “did not follow an established format to measure likelihood of confusion,” (b) “used a small number of respondents to test each mark,” and (c) used a survey universe already familiar with Opposer. *See Clear Choice Holdings LLC v. Implant Direct Int’l* at pp. 16-21 (Opp. No. 91190485) (TTAB Aug. 26, 2013) (non-precedential). Ultimately, the Board ruled that it could “not conclude that opposer’s survey actually measured an appreciable likelihood of confusion” and gave it “no weight.” *Id.* at 21. Thus, the expert report was not only improperly submitted but does not support Opposer’s claims.

b. The Board’s decision in a different case is not evidence and should be struck.

There is also no provision under the rules allowing a party to submit a non-precedential Board decision in a different case as evidence through a Notice of Reliance. Nonetheless, Opposer did just that in its Third Notice of Reliance by submitting a copy of the Board’s decision in *Clear Choice Holdings LLC v. Implant Direct Int’l* (Opp. No. 91190485) (TTAB Aug. 26, 2013) (non-precedential). Simply put, case law is not evidence. There is nothing under the rules that would allow the Board to consider a decision in a different case as evidence.

Nor can Opposer cover up its failure to present testimony or evidence in this proceeding by attempting to co-opt the entire record in an unrelated case before the Board. As the Federal Circuit and the Board have repeatedly held, each case must be decided on its own set of facts and based on the record before the Board. *See, e.g., In re Boulevard Entm't Inc.*, 334 F.3d 1336, 67 U.S.P.Q.2d 1475, 1480 (Fed. Cir. 2003) (“[T]he PTO must decide each application on its own merits, and decisions regarding other registrations do not bind either the agency or this court.”) (citing *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001)). Thus, the Board should strike Opposer’s Third Notice of Reliance in its entirety.

c. Opposer’s dictionary and thesaurus entries also should be struck.

The Board also should strike Opposer’s Second Notice of Reliance because it too is procedurally defective. For any published materials submitted with a notice of reliance, the propounding party must “indicate in the notice of reliance generally the relevance of the material being offered.” 37 C.F.R. § 2.122(e). Under the rules, it is insufficient that a party merely broadly state that the materials are relevant to that party’s claims or to the ultimate issue to be decided (e.g. likelihood of confusion). “If the claim is likelihood of confusion, the propounding party should associate the materials with a relevant likelihood of confusion factor.” TBMP § 704.08.

The Board stressed the importance of this requirement in *Safer, Inc. v. OMS Investments, Inc.*, Opposition No. 91176445, 94 USPQ2d 1031 (TTAB 2010):

We emphasize that under Rule 2.122(e) the propounding party of internet documents as well as traditional publications must “indicate generally the relevance of the material being offered.” For example, it is not sufficient for the propounding party to broadly state that the materials are being submitted to support the claim that there is (or is not) a likelihood of confusion, or that the mark is (or is not) merely descriptive. **Likelihood of confusion or descriptiveness is often the only issue in a case and to simply state this fact is the equivalent of saying that the documents are relevant to the case.** Ordinarily, to meet the requirement to “indicate generally the relevance of the material being offered,” the propounding party should associate the materials with a relevant likelihood of confusion factor (e.g., the strength of the mark, the meaning or commercial impression engendered by the mark, etc.) or a specific fact relevant to determining a particular issue, such as whether a

mark is merely descriptive. This will ensure that any adverse party has been fairly apprised of the evidence it must rebut and the issue for which it was introduced.

Id. (emphasis added).

In none of Opposer's notices of reliance does Opposer indicate the relevance of the documents being offered into evidence, except to state the following: "Opposer intends to rely on these documents to prove there is a likelihood of confusion between the mark RIGHTCHOICE in the opposed application and Opposer's CLEARCHOICE marks." Opposer has never attempted to identify the likelihood of confusion factor to which any of its proffered evidence applies or otherwise how such evidence is relevant to any fact that might establish Opposer's claims.

Opposer's Second Notice of Reliance, which contains dictionary and thesaurus entries, contains the same statement and suffers from the same fatal flaw. Nowhere does Opposer identify the likelihood of confusion factor or any other fact to which Opposer might try to apply this evidence (e.g. the strength of the marks, the similarity of the marks, the commercial impression conveyed by the marks). Thus, Applicant has been left with no idea about how Opposer intends to reference this evidence in its Brief on Case, and Applicant is handcuffed in its ability to present rebuttal evidence.

While Applicant can only guess at how Opposer might use these dictionary and thesaurus entries in presenting its case, ironically, a cursory review of these entries shows that they weigh heavily against a likelihood of confusion. These entries show that the terms RIGHT and CLEAR have completely different definitions and are not synonyms of each other. Thus, even if Opposer had identified the particular relevance of this evidence, it does nothing to support Opposer's claim of likelihood of confusion. Nor could this evidence be used to support Opposer's claim of dilution, which Opposer mentions nothing about in any of its notices of reliance.

Thus, the Board should also strike Opposer's Second Notice of Reliance in its entirety.

d. Opposer's unpleaded registrations also should be struck.

“In cases brought under Trademark Act § 2(d), 15 U.S.C. § 1052(d) the plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations.” TBMP § 309.03; *see also Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q.2d 1629, 1634 (TTAB 2007) (unpleaded registration given no consideration).

In Plaintiff's First Notice of Reliance, Opposer attempts to rely on at least two registrations that Plaintiff did not plead in its notice of opposition. Specifically, Opposer submitted copies of its registrations for THE CLEARCHOICE EXPERIENCE (Reg. No. 4,250,368) and for CLEARCHOICE IS THE PERFECT CHOICE (Reg. No. 4,152,444). Because Opposer did not plead these two registrations, Opposer may not rely on them at trial. Accordingly, these two registrations should be struck from Opposer's First Notice of Reliance.

Notably, one of the registrations that Opposer did plead as a basis for having standing to pursue this opposition was a registration for the standard character mark CLEARCHOICE (Reg. No. 3181966). That registration was cancelled as of July 12, 2013. Therefore, that cancelled registration has no relevance to this proceeding and also should not be considered by the Board.

Stripped of the improper and procedurally defective “evidence” submitted by Opposer (which the Board should strike), Opposer is left with nothing more than copies of USPTO records. These include a handful of Opposer's registrations and the file history of Applicant's Application, the latter of which is automatically of record. As outlined below, such remaining evidence is insufficient, as a matter of law, to prove Opposer's claims.

3. The Board should enter judgment against Opposer for failure to present its case.

Pursuant to 37 C.F.R. § 2.132(b), “[i]f no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is

denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief.” The Board’s rules refer to such a motion as a “Motion for Judgment Under Trademark Rule 2.132(b).” *See* TBMP § 534.03. The purpose of such a motion “is to save the defendant the expense and delay of continuing with the trial in those cases where the plaintiff, during its testimony period, has offered no evidence other than copies of USPTO records, and those records do not make out a prima facie case.” *Id.*

Here, beyond Opposer’s improperly submitted and procedurally defective documents in its Notices of Reliance, Opposer has offered no evidence other than a handful of USPTO records. Such documents are insufficient to establish that Applicant’s RIGHTCHOICE mark is likely to cause confusion with or dilutes any of Opposer’s marks incorporating CLEARCHOICE.

Applicant’s RIGHTCHOICE mark looks and sounds very different from Opposer’s CLEARCHOICE mark and conveys a different overall meaning and commercial impression. The words RIGHT and CLEAR, the dominant part of the parties’ respective marks, are completely different from each other and share no common meaning or root. Opposer has presented no evidence to suggest that its mark is strong or entitled to a broad scope of protection as opposed to a weak mark that is entitled to only a very narrow scope of protection.

Opposer also has presented no evidence that the parties’ respective customers, who are sophisticated and discriminating in deciding which of these expensive services to purchase, would be confused. There is no evidence of actual confusion and no proper survey or expert testimony that was presented during Opposer’s case in chief. Opposer has presented no evidence of the fame of its mark. Nor has Opposer made any attempt to present evidence of why Applicant’s RIGHTCHOICE mark should not be able to coexist with the myriad of CHOICE-based marks in the dental industry or, more specifically, in the area of dental implants.

Opposer also presents no evidence that could possibly support Opposer's claim of dilution against Applicant. Opposer has presented no evidence to suggest that Opposer's mark is famous or is entitled to protection under the dilution statute. Nor has Opposer presented any evidence that Applicant's use or registration of RIGHTCHOICE would blur or tarnish Opposer or its marks.

There is no reason to continue a trial that Opposer has failed to prosecute. To require Applicant to incur the substantial cost of presenting testimony and evidence, preparing and filing briefing, and participating in oral argument—even though Opposer has failed to present even a *prima facie* case in chief—is the very unfair result that the rules were designed to prevent.

In sum, Opposer has submitted improper and procedurally defective evidence with its notices of reliance, and Opposer has shown no right to relief based on the record properly before the Board. Accordingly, the Board should strike Opposer's improper and procedurally defective evidence and should enter judgment against Opposer (or, alternatively, dismiss Opposer's claims with prejudice).

Respectfully submitted this 17th day of October, 2013.

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I hereby certify that this Motion to Strike Opposer's Notices of Reliance and Motion for Judgment for Failure to Prove Case is being sent via Express Mail addressed to:

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Date