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

Proceeding	91191371
Party	Plaintiff ClearChoice Holdings, LLC
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Attachments	opposer's respose to applicant's motion to strike notices of reliance and motion for judgment for failure to prove case.pdf(423249 bytes)

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

CLEARCHOICE HOLDINGS, LLC)	
)	Opposition No. 91191371
Opposer)	
)	Mark: RIGHTCHOICE
v.)	
)	Serial No.: 77/685,491
DALE D. GOLDSCHLAG, D.D.S., P.C.)	
)	
Applicant)	

OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO STRIKE NOTICES OF RELIANCE AND MOTION FOR JUDGMENT FOR FAILURE TO PROVE CASE

ClearChoice Holdings, LLC ("Opposer") respectfully submits its response to Dale D. Goldschlag, D.D.S., P.C.'s ("Applicant") Motion to Strike Opposer's Notices of Reliance and Motion for Failure to Prove Case, filed with the Trademark Trial and Appeal Board ("Board") on October 17, 2013.

Applicant's motion is unfounded in many respects and contains false allegations and misinterpretations of the legal standards for evidentiary submissions in Board proceedings. Applicant alleges Opposer did not serve any pretrial disclosures on Applicant by the stipulated August 4, 2013 deadline. This is incorrect as Opposer's pretrial disclosures were properly served on Applicant's counsel at the time, Adam D. Kaufman, on July 30, 2013.¹

Concurrently herewith, Opposer withdraws the February 2011 Survey of RL Associates, which was submitted as Exhibit A to Opposer's Third Notice of Reliance. Opposer does not

¹ A true copy of Opposer's Pre-trial Disclosures, as served on then counsel for Applicant on July 30, 2013, is attached as Appendix A.

intend to rely on the Survey in support of its case in chief, thus rendering moot the issue of whether this evidence was properly introduced.

Applicant's remaining attacks on Opposer's evidentiary submissions are unfounded, as discussed more fully below.

I. The Board's Decision in *Clear Choice Holdings LLC v. Implant Direct Int'l*

On page 4 of its motion, Applicant states "there is no provision under the rules allowing a party to submit a non-precedential Board decision in a different case as evidence through a Notice of Reliance." Applicant contends the copy of the Board's decision in *Clear Choice Holdings LLC v. Implant Direct Int'l*, which was submitted as Exhibit B to Opposer's Third Notice of Reliance, should be struck. However, the *Clear Choice Holdings LLC* decision was properly submitted by Opposer via Notice of Reliance pursuant to Trademark Rule 2.122(e), which allows for submission of official records of the Patent and Trademark Office via notice of reliance during the prescribed testimony period. Accordingly, the Board's decision should remain in evidence as Exhibit B to Opposer's Third Notice of Reliance and should not be struck from the record.

II. Opposer's Dictionary and Thesaurus Entries

Applicant contends Opposer's Second Notice of Reliance also should be struck because it is procedurally defective. Specifically, Applicant asserts the Second Notice of Reliance is defective because Opposer did not identify the specific likelihood of confusion factor for which the evidence is being proffered, leaving Applicant with "no idea about how Opposer intends to reference this evidence in its Brief on Case..." Applicant cites to *Safer, Inc. v. OMS Investments*,

Inc., 94 USPQ2d 1031 (TTAB 2010), in which the Board stated “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...Ordinarily, the propounding party should associate the materials with a relevant likelihood of confusion factor (e.g. strength of the mark, meaning or commercial impression engendered by the mark, etc.)...” Importantly, the Board also makes it clear in *Safer, Inc.* that “the failure to indicate generally the relevance of the material being offered is an evidentiary defect that can be cured by the propounding party as soon as it is raised by any adverse party, without reopening the testimony period of the propounding party.” *Id.*

For the sake of clarity, Opposer hereby informs Applicant it intends to rely on the webpage printouts from the Merriam-Webster online dictionary and pages from the publication The Synonym Finder to prove the words “right” and “clear” are synonymous, have essentially the same meaning and connotation and therefore result in RIGHTCHOICE and CLEARCHOICE creating the same commercial impression such that there is a likelihood of consumer confusion. Now that Opposer has cured the alleged ambiguity of the reason for its reliance on the evidence submitted in its Second Notice of Reliance, there is no basis for it to be struck and it should remain part of the evidentiary record.

III. **Opposer’s Unpleaded and Cancelled Registrations**

Applicant also requests the Board strike the following: (1) Opposer’s unpleaded registrations, namely, U.S. Registration Nos. 4,250,368 and 4,152,444; and (2) cancelled Registration No. 3,181,966, which comprise part of Opposer’s First Notice of Reliance. There is no legal basis to strike these registrations, as Trademark Rule 2.122(d)(2) expressly states that

such registrations are properly introduced into evidence via notice of reliance (“a registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance...the notice of reliance shall be filed during the testimony period of the party that files the notice.”). Accordingly, these registrations should remain part of the official record.

IV. Applicant’s Request the Board Enter Judgment Against Opposer for Failure to Present Its Case

Applicant’s request that the Board enter judgment against Opposer pursuant to 37 C.F.R. § 2.132(b) has no merit, as Opposer has cured the deficiency in its Second Notice of Reliance. Opposer will fully argue the merits of its case in its trial brief, and is not required to set forth all elements or legal positions during its testimony period. Therefore, judgment against Opposer should not be entered and the opposition proceedings should continue in accordance with the Board’s trial schedule.

Wherefore, Opposer contends that with the exception of the February 2011 Survey of RL Associates which Opposer expressly withdraws, all evidence has been properly proffered via Opposer’s Notices of Reliance and should remain part of the record. Moreover, Applicant’s request that the Board enter judgment against Opposer for failure to present its case should be denied. Such action is respectfully requested.

Respectfully submitted,

ClearChoice Holdings, LLC

By: Eric T. Fingerhut

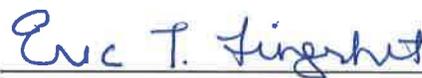
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Attorney for Opposer

Date: November 1, 2013

CERTIFICATE OF SERVICE

I hereby certify that on this 1st of November 2013, a true copy of Opposer's Response to Applicant's Motion to Strike Notices of Reliance and Motion for Judgment for Failure to Prove Case was served on the following counsel of record for Applicant via first class mail, postage prepaid:

Glenn Spencer Bacal
Bacal Law Group, P.C.
6991 E. Camelback Rd., Ste. D-102
Scottsdale, Arizona 85251



Eric T. Fingerhut
Attorney for Opposer

APPENDIX A

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

CLEAR CHOICE HOLDINGS, LLC,

Opposer,

v.

DALE D. GOLDSCHLAG, DDS

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Opposition No. 91191371

OPPOSERS' PRETRIAL DISCLOSURES

Pursuant to Trademark Trial and Appeal Board Practice and Procedure Rule 702.01 and Rule 26(a)(3) of the Federal Rules of Civil Procedure, Clear Choice Holdings, LLC (“Opposer”) makes the following Pretrial Disclosures to Dale D. Goldschlag, DDS (“Applicant”).

These Pretrial Disclosures represent Opposer’s good faith effort to identify each witness from which they may take testimony and other information and documents they currently and reasonably believe may be used as exhibits during said testimony to support their claims or the denial of Applicant’s defenses as required by Fed. R. Civ. P. 26(a)(3).

A. 26(a)(3)(A)(i): Testimony Witnesses

Opposer identifies the following individual(s) who Opposer believe will testify to knowledge of facts Opposer will use to support their claims and the denial of Applicant’s affirmative defenses:

1. Steve Boyd, Dan Christopher, Larry Deutsch, Bob Turner, Sean Baenen and Chandra Downey. Messrs. Boyd, Christopher, Deutsch and Turner may be contacted through the undersigned counsel for Opposer. Mr. Boyd is the former CEO of Clear Choice Holdings, LLC. Mr. Christopher is the former General Counsel for Clear Choice Holdings, LLC. Mr. Deutsch is the former Vice President – Marketing of Clear Choice Holdings, LLC. Mr. Turner is in –house counsel for Clear Choice Holdings, LLC. Mr. Baenen is Chief Marketing Officer of Clear Choice Holdings, LLC. Ms. Downey is the Compliance Officer of Clear Choice Holdings, LLC.

Messrs. Boyd, Christopher, Deutsch, Turner Baenen and Downey are knowledgeable with respect to, and will like testify on the following subjects: (a) Opposer’s adoption, history, use, advertising, and promotion of the marks CLEAR CHOICE, CLEAR CHOICE DENTAL IMPLANTS, and CLEAR CHOICE DENTAL IMPLANT CENTER for dental implant services; (b) the public recognition of Opposer’s marks; (c) Opposer’s registration of its marks and the

applications to register the marks and steps taken by Opposer to protect their marks; (d) the background and history of Opposer's companies and Opposer's marks; (e) the channels of trade for the services provided by Opposer in association with the marks; (f) the purchasers and prospective purchasers of Opposer's services; and (g) the wide-spread publicity Opposer's dental implant services have garnered in local and national media outlets and publications.

2. Dr. Michael Rappaport. Dr. Rappaport is a principal of RL Associates who has been retained by Clear Choice Holdings, LLC to provide expert opinion testimony related to the likelihood of confusion between Opposer's marks and Applicant's mark. RL Associates has a business address of 601 Ewing Street, #A11, Princeton, NJ 05540-2754. Mr. Rappaport has knowledge related to the likelihood of confusion between Opposer's marks and Applicant's mark.

3. Dr. Dale D. Goldschlag. Dr. Goldschlag is the owner of Applicant. He may be contacted through Applicant's counsel. He has knowledge of Applicant's use and adoption of its mark.

B. 26(a)(3)(A)(iii): Documents

Opposer identifies the following categories of documents and things which may be introduced as exhibits during the testimony of the witnesses to support their claims and support the denial of the affirmative defense asserted by Applicant:

(1) Documents regarding the nature and manner of Opposer's prior and current use of its marks in commerce;

(2) Representative samples of advertising and promotional materials, brochures, and national and local publications, television shows and other media showing Opposer's prior and current use of its marks in connection with dental implant services;

(3) Documents pertaining to sales and advertising expenditures for services offered and sold in commerce in connection with Opposer's marks;

(4) Corporate records of Opposer showing the continuous use of the marks in commerce in connection with dental implant services;

(5) Documents regarding Opposer's protection of the marks in the U.S.; and

(6) Documents regarding Opposers' U.S. Registration Nos. 3,181,966; 3,225,921; 3,553,219; and 3,655,580; and documents regarding Applicant's Application Serial No.: 77652784.

(7) Documents regarding Applicant's use of its mark.

(8) The Expert Opinion of Dr. Michael Rappaport.

(9) Any depositions taken in this matter and any discovery response submitted in this matter.

By: /s/ Eric T. Fingerhut

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CERTIFICATE OF SERVICE

I hereby certify that a copy of Opposer's Pretrial Disclosures was served via email and Certified Mail, Return Receipt Requested to the party listed below at the address indicated on this the 30th day of July, 2013.

Adam B. Kaufman
Adam B. Kaufman & Associates, PLLC
585 Stewart Ave., Suite 302
Garden City, NY 11530

/s/ Eric T. Fingerhut
Eric T. Fingerhut