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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

**Reply in Support of Motion to Strike Notices of Reliance
and Motion for Judgment for Failure to Prove Case**

In Opposer's Response to Applicant's Motion to Strike and Motion for Judgment ("Response") [Dkt. 46], Opposer failed to provide any legitimate basis for why judgment should not be entered against Opposer. Instead, Opposer's Response attempted to minimize Opposer's own violations of the rules and efforts to submit evidence through improper means. Apparently, based on the Response and Opposer's actions, Opposer believes it is not bound by various rules governing evidentiary submissions to the Board, a belief we trust the Board will correct.

We respectfully remind the Board that prior to Opposer's Supplement to Opposer's Response ("Supplement"), Opposer had opened its Response by accusing Applicant of making "false allegations" in informing the Board that Opposer had never properly or timely served pretrial disclosures. [Dkt. 46, p. 1] Opposer's Response indignantly stated Applicant was incorrect because Opposer had "properly served" Opposer's pretrial disclosures. [Dkt. 46, p. 1] To cement the point, Opposer then attached these disclosures to the Response with its certificate of mailing, to prove proper service. [Dkt. 46, Appx. A]

When counsel for Applicant contacted counsel for Opposer and objected to this blatant misrepresentation to the Board, counsel for Opposer filed the Supplement, which in some ways

compounded the misconduct. [Dkt. 47] While admitting at the very end of the Supplement that Opposer in fact “did not serve its Pretrial Disclosures as intended” [Dkt. 47, p. 2], Opposer began the Supplement by apologizing to the Board **not** for making a false statement to a tribunal, but for what Opposer characterized as “wasting” the Board’s time in correcting that false statement. [Dkt. 47, p. 1] We trust that the Board does not regard the need to correct a false statement to the Board, especially one used as the basis for what was a false accusation against another party, as a “waste of time.”

The Opposer’s false statement here was part of Opposer’s effort right from the start of its Response to try to undermine and contradict Applicant’s Motion. [Dkt. 46, p. 1] Such a false statement is far more serious misconduct than other false statements that the Board has found to merit the sanction of dismissal. *See, e.g., Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210, 1211 (TTAB 2001) (where opposer’s statements in a mere extension request that the parties were engaged in settlement negotiations were found to be false and filed in bad faith, opposer was sanctioned with dismissal).

Opposer’s misrepresentation goes not to a mere extension request but to whether or not Opposer ever informed Applicant that Opposer intended to continue prosecuting this case by serving its pretrial disclosures. Having not done so, Opposer surprised Applicant by filing notices of reliance right at the end of Opposer’s trial period, and then Opposer tried to cover up that failure with a misrepresentation to the Board. Thus, Opposer’s actions provide a further and independent basis for the Board to dismiss this Opposition, this time in the exercise of the Board’s inherent authority to sanction Opposer.

Significantly, and this is another reason why a reply brief was necessary and proper here, Opposer’s conduct can be demonstrated to be part of a pattern of Opposer to ignore the Board’s rules and rulings, *unless and until caught*. That pattern is repeated and evidenced in Opposer’s Response in several different ways.

As noted in Applicant’s Motion, Opposer ignored the Board’s clear warning to Opposer, in another case a mere month earlier, stating that the rules do not allow a party to submit an expert report through a notice of reliance. When caught in this case violating the very same rule, Opposer in its Response quickly withdrew the expert report, without any comment or explanation other than claiming that withdrawal made it moot whether or not it had been properly introduced. [Dkt. 46, p.1-2] Is this the way the rules were intended by the Board to operate? We understand why Opposer would have liked to moot any discussion of its conduct here.

Similarly, Opposer ignored the rule requiring Opposer to identify the relevant likelihood of confusion factor to which the proffered Opposer’s dictionary and thesaurus entries applied.¹ When caught violating that rule, Opposer once again attempted in the Response to correct any error *after the fact* by coming up with a thin reason why Opposer submitted such “evidence.” [Dkt. 46, p. 3] Even if a party who had not engaged in a pattern of such conduct might otherwise be allowed to correct that kind of error in this manner, a cursory review of the cited dictionary and thesaurus entries shows that they do not even support Opposer’s contention that the words “right” and “clear” are synonymous. Indeed, neither word is found anywhere in the dictionary/thesaurus entry for the other. Hence, even the correction of Opposer’s error fails. Merely submitting dictionary definitions—something that the Board could have taken judicial notice of anyway—is insufficient to establish a *prima facie* case of likely confusion, let alone dilution. Neither Opposer’s Response nor its Supplement even attempts to explain how Opposer has established a *prima facie* case.

Opposer also ignores in its Response the fact that that there is no rule that would allow Opposer to submit a prior decision as “evidence” in a subsequent case. Rather than recognizing that error and voluntarily withdrawing that part of its Notice of Reliance, Opposer instead stubbornly

¹ TBMP § 704.08 (“If the claim is likelihood of confusion, the propounding party should associate the materials with a relevant likelihood of confusion factor.”). Of course, Opposer did this for none of its proffered “evidence” and to date has still only attempted to do so for the dictionary and thesaurus entries.

argues, without any support, that a non-precedential Board opinion in an earlier case involving Opposer “should remain in evidence . . . and should not be struck from the record.” [Dkt. 46, p. 2] Once again, despite Opposer’s attempt to magically transform that prior non-precedential decision into evidence, neither that decision nor any of the evidence considered in rendering that decision is evidence in this case under the rules, unless of course the rules don’t apply to or bind Opposer.

Opposer further violated and continues to ignore in its Response the rule that Opposer cannot rely on unpleaded registrations at trial. Opposer has never sought to amend its notice of opposition to plead additional registrations. Instead, Opposer proclaims (without support) that it is entitled to rely on unpleaded registrations simply by submitting them in a notice of reliance. [Dkt. 46, p. 3-4] The rules and clear precedent from the Board do not appear to allow Opposer to do so.²

Opposer also now remarkably claims in its Response that it should also be allowed to rely on its now *cancelled* registration for the standard character mark CLEARCHOICE (Reg. No. 3181966). [Dkt. 47, p. 3] This cancelled registration was not even included in Opposer’s First Notice of Reliance, even though Opposer now claims that it was. [Dkt. 47, p. 3]. Opposer argues that it should “remain part of the official record.” [Dkt, 47, p 3]. In any event, a cancelled registration has no probative value, and Opposer should not be allowed to include it, especially not at this late stage. *See Black & Decker Corp. v. Emerson Electric Co.*, 84 U.S.P.Q.2d 1482, 1490 (TTAB 2007) (cancelled registration has no probative value). Therefore, the Board should reject Opposer’s improper attempts to include unpleaded and cancelled registrations in the record.

The reality is that Opposer failed to prosecute this case and attempted to cure that failure with a last minute submission of flawed notices of reliance that did not contain any properly

² See TBMP § 309.03 (“[T]he plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations.”); *see also Wet Seal Inc. v. FD Management Inc.*, 82 U.S.P.Q.2d 1629, 1634 (TTAB 2007) (unpleaded registration given no consideration); *Safer Inc. v. OMS Investments, Inc.*, 94 USPQ2d 1031 (TTAB 2010) (If the opposer sought to rely on an unpleaded registration to prove a claim of likelihood of confusion, opposer “should have pled the mark and registration in its original notice of opposition or, at a minimum, sought leave to amend its notice of opposition”).

submitted evidence to prove Opposer's claims. Instead, Opposer's notices of reliance contain things that Opposer knew should not have even been included in a notice of reliance. When caught in misconduct, Opposer submitted a Response that merely abandoned certain attempts to mislead the Board and/or to circumvent the rules, while trying to hang on to others. When the Response itself evidenced further misconduct, Opposer then submitted the Supplement and apologized not for engaging in the misconduct but for having to come back to the Board and "wasting its time" in order to correct the record after being caught in a lie. [Dkt. 47, p 1]

Opposer's Response and Supplement do nothing to refute the clear showing in Applicant's Motion for Judgment that Opposer has failed to establish a *prima facie* case of likelihood confusion or dilution. Rather, Opposer's Response and Supplement provide additional and strong bases for entry of judgment against Opposer.

Opposer apparently believes it should not be bound by the same rules as its opponents, and that it has the right to violate rules willfully, in some instances repeatedly, unless and until someone objects. Applicant does not share such beliefs. The Board's rules and rulings are entitled to respect by all parties. Accordingly, the Board should enter judgment against Opposer.

Respectfully submitted this 18th day of November, 2013.

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I hereby certify that this Reply in Support of 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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Signature

November 18, 2013
Date