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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

TRIAL BRIEF OF OPPOSER

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TRIAL BRIEF OF OPPOSER

Opposer, ClearChoice Holdings, LLC (“ClearChoice”), by and through its undersigned counsel, hereby submits its Trial Brief in the above captioned proceeding.

I. STATEMENT OF THE CASE

A. Brief Nature of the Case

This is an opposition against application serial no. 77685491, for the mark RightChoice (standard character), for “dental implant services” in International Class 44, filed by Dale D. Goldschlag, D.D.S., P.C. (“Goldschlag”). The application is based on a claim of use, claiming a date of first use and first use in commerce of March 6, 2009, which also was the filing date of the opposed application.

ClearChoice commenced this opposition proceeding by timely filing a Notice of Opposition, alleging a likelihood of confusion between the RightChoice mark of the opposed application and the mark(s) (CLEARCHOICE DENTAL IMPLANTS, CLEARCHOICE

DENTAL IMPLANT CENTER, ClearChoice [stylized] & Design) of Opposer's pleaded registrations.¹ See 15 U.S.C. § 1052(d).

B. Description of the Record

The record consists of the following materials, which were submitted by Opposer:

Certified copy of the U.S. Patent and Trademark Office ("PTO") file for the opposed application (Opposer's First Notice of Reliance ["NOR1"], Exhibit A)²

Status and Title copy of Opposer's pleaded U.S. Registration No. 3,225,921 (NOR1, Exhibit B)

Status and Title copy of Opposer's pleaded U.S. Registration No. 3,553,219 (NOR1, Exhibit C)

Status and Title copy of Opposer's pleaded U.S. Registration No. 3,685,880 (NOR1, Exhibit D)

Certified copy of the PTO file for application serial no. 77652784 for the mark REAL CHOICE (NOR1, Exhibit G)

A true and correct copy of the web page at <http://www.merriam-webster.com/dictionary/right>, which was accessed by Opposer's counsel on September 17, 2013 (Opposer's Second Notice of Reliance ["NOR2"], Exhibit A)

A true and correct copy of the webpage at <http://www.merriam-webster.com/thesaurus/clear>, which was accessed by Opposer's counsel on August 15, 2013 (NOR2, Exhibit B)

A true and correct copy of excerpts from the pertinent pages of THE SYNONYM FINDER, J.I. Rodale, Warner Books: New York, 1978 (NOR2, Exhibit C)

Copy of *Clear Choice Holdings, LLC v. Implant Direct Int'l*, Opposition No. 91190485 (August 26, 2013) (Opposer's Third Notice of Reliance, Exhibit B).

¹ The Notice of Opposition also pleaded a claim of dilution. Opposer ClearChoice is no longer pursuing, and hereby withdraws, the claim of dilution.

² Opposer recognizes that the file for the opposed application is of record in this opposition pursuant to 37 C.F.R. § 2.122(b).

Applicant did not submit any testimony, notices of reliance or other evidence during its testimony period.

II. STATEMENT OF FACTS

Opposer, ClearChoice is a Colorado limited liability company, located in Greenwood Village, Colorado. *See* Notice of Opposition, ¶ 6, and Applicant’s Answer thereto, ¶ 6. Opposer is the owner of the service mark(s) CLEARCHOICE DENTAL IMPLANTS, CLEARCHOICE DENTAL IMPLANT CENTER, and ClearChoice, including in the following stylization (hereafter sometimes referred to collectively as Opposer’s “**ClearChoice** mark(s)”):



See NOR1 Exhibits B, C and D; 15 U.S.C. § 1057(b). Each of Opposer’s **ClearChoice** mark(s) is registered on the Principal Register, for “dental services, namely, dental implant services.” NOR1 Exhibits B, C & D. ClearChoice’s Registration No. 3,225,921 issued April 3, 2007, and is incontestable (*see* NOR Exhibit B; 15 U.S.C. § 1065); ClearChoice’s Registrations nos. 3,553,219 (NOR1 Exhibit C) and 3,685,880 (NOR1 Exhibit D) issued December 30, 2008 and September 22, 2009, respectively.

Applicant, Goldschlag is a New York professional corporation, located in New York. On March 6, 2009 – long after Opposer’s first registration for its **ClearChoice** mark(s) issued, and long after the first use of the mark of ClearChoice’s Registration No. 3,685,880 – Goldschlag filed the application that is the subject of this opposition, for the mark RightChoice.³ The

³ The drawing submitted by Goldschlag, in fact, shows the mark in this precise format; that is, as a one word combination of upper and lower case letters, with initial caps for the letters “R” and “C”.

application sought registration for “dental implant services”, and claimed a date of first use and first use in commerce of March 6, 2009, the very same date the application was filed. Submitted with the application was a specimen described by Applicant as a “newspaper advertisement”; Applicant represented that this newspaper advertisement “show[ed] the mark as used in commerce on or in connection with any item in the class of listed goods and/or services.” The specimen depicts the opposed RightChoice mark as follows:



See NOR1, Exhibit A.

Applicant Goldschlag has admitted that the services set forth in the opposed application for the RightChoice mark are identical to the services set forth in Opposer’s registrations for its **ClearChoice** mark(s). See Notice of Opposition, ¶ 19, and Applicant’s Answer thereto, ¶ 19.

III. ISSUE PRESENTED

Whether there is a likelihood of confusion between Applicant’s RightChoice mark, and Opposer’s registered and incontestable **ClearChoice** mark(s), as applied to the identical services, namely, dental implant services.

IV. ARGUMENT

To prevail in the present opposition, ClearChoice must establish: (1) its standing to oppose, and (2) at least one statutory ground of opposition to registration. See *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 15 USPQ2d 1842, 1844 (Fed. Cir. 2000). Each of these elements has been met with respect to the opposed application.

A. *ClearChoice Has Standing to Bring Its Opposition Claim*

ClearChoice pleaded, and has made of record its pleaded, registrations for the **ClearChoice** mark(s). ClearChoice thus has shown it has a real interest in the outcome of this opposition proceeding and has a reasonable basis for believing that it would be damaged by the issuance to Goldschlag of the registration it seeks. Accordingly, ClearChoice has established its standing to oppose registration by Applicant of the opposed RightChoice mark. *Id. See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (CCPA 1982).

B. *ClearChoice has Established its § 2d Likelihood of Confusion Claim by a Preponderance of the Evidence*

Of record evidence are Opposer's Principal Register registrations for its **ClearChoice** mark(s), and no counterclaims for cancellation have been pleaded by Goldschlag. Therefore, priority is not an issue in this proceeding. *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164, 1167 (TTAB 2001). Accordingly, the sole issue under ClearChoice's §2(d) claim is whether there is a likelihood of confusion.

A determination of likelihood of confusion is based on an analysis of the factors delineated by *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (C.C.P.A. 1973).⁴ However, not every factor is pertinent to a particular case, nor must each of

⁴ These factors are:

- (1) the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression;
- (2) the similarity or dissimilarity of the goods/services as described in an application or registration or in connection with which a prior mark is used;
- (3) the similarity or dissimilarity of established, likely-to-continue trade channels;
- (4) the conditions under which and buyers to whom sales are made, i.e., impulse versus careful, sophisticated purchasing;

(continued . .

these factors be considered in every case. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed.Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1346, 94 USPQ2d 1257 (Fed. Cir. 2010). Indeed, the analysis may focus on dispositive factors, such as similarity of the marks and goods/services. *See Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

Here the pertinent factors are the similarities (in fact, identity) of the parties' services, trade channels and customers, the similarities of the marks at issue, and Applicant's bad faith intent. Applicant has not presented evidence regarding any other factor (nor any evidence, at all).

1. The services of the parties are identical.

Applicant Goldschlag has admitted that the services set forth in the opposed application are identical to those set forth in Opposer's pleaded, currently existing registrations for its **ClearChoice** mark(s). *See* Notice of Opposition, ¶ 19, and Applicant's Answer thereto, ¶ 19. There can be no doubt of this, in any event; the services identified in the opposed application are

-
- (5) the fame of the prior mark (sales, advertising, length of use);
 - (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 (house mark, "family" mark, product mark);
 - (10) the market interface between applicant and the owner of a prior mark (i.e., issues of consent, laches, estoppel, etc.);
 - (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 established fact probative of the effect of use.

“dental implant services” and the services identified in each of ClearChoice’s registrations are “dental services, namely, dental implant services.” See NOR1, Exhibits B, C and D.

2. The trade channels and customers of the parties are identical.

There are no restrictions in the recitation of services of the opposed application as to channels of trade or prospective customers. Likewise, there are no restrictions in the channels of trade or prospective customers for the services set forth in Opposer’s **ClearChoice** registrations. Therefore, the parties’ dental implant services are presumed to travel in the same channels of trade to the same class of purchasers. See *In re Viterra*, 101 USPQ2d at 1908; *Hewlett-Packard Co. v. Packard Press, Inc.*, 62 USPQ2d at 1005; *In re Max Capital Group Ltd.*, 93 USPQ2d 1243, 1244 (TTAB 2010). See also *Otocom Sys. Inc. v. Houston Computer Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990), and cases cited therein (“The authority is legion that the question of registrability of an applicant’s mark must be decided on the basis of the identification of goods set forth in the application . . .”).

3. RightChoice is confusingly similar to Opposer’s **ClearChoice** mark(s).

The analysis of this factor looks to the similarity of “the marks in their entirety as to appearance, sound, connotation and commercial impression.” *Palm Bay Imps. Inc. v. Veuve Clicquoi Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). However, it is established that similarity in any of the elements of sound, appearance or connotation is sufficient to indicate a likelihood of confusion. See *In re Mack*, 197 USPQ 755, 757 (TTAB 1977); *General Foods Corp. v. Wisconsin Bottling, Inc.*, 190 USPQ 43, 45 (TTAB 1976).

The test is not whether the marks can be distinguished in a side-by-side comparison. See *San Fernando Elec. Mfg. Co. v. JFD Elecs. Components Corp.*, 565 F.2d 683, 196 USPQ 1, 3

(CCPA 1977) (marks must be considered in light of the fallibility of memory). Nor is exact identity necessary to generate confusion. *See Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 673 F.3d 1330, 102 USPQ2d 1061, 1064 (Fed. Cir. 2012); *In re Lansom Oil Co.*, 6 USPQ2d 1041, 1042 (TTAB 1987).

Further, the degree of similarity of marks necessary to support a finding of likely confusion is considerably less where, as here, the parties' services, channels of trade and prospective customers are identical. *See Bridgestone, supra*; *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1773 (TTAB 1992).

In the context of these controlling legal principles, the similarities in appearance and sound of ClearChoice⁵ and RightChoice are readily apparent. Both are two syllable marks ending in the suffix "CHOICE". *See Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 63 USPQ2d 1303, 1311 (Fed. Cir. 2002) (presence of the root element "wave" introduces a strong similarity between WAVE, ACOUSTIC WAVE and opposed POWERWAVE mark); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d at 1773 (ORAL-B vs. ORAL-ANGLE, for toothbrushes); *Kenner Parker Toys, Inc. v. Rose Art Indus.*, 963 F.2d 350, 22 USPQ2d 1453, 1457 (Fed. Cir. 1992) (single syllable suffix "dough" gives PLAY-DOH and FUN DOUGH same commercial impression); *Cunningham v. Laser Golf Corp.*, 15 USPQ2d at 1845 (noting the

⁵ In comparing the marks at issue, it is entirely appropriate to view Opposer's mark as ClearChoice. This is the literal element of ClearChoice's Registration no. 3,685,880, and patently is the dominant portion of the mark. *See In re Max Capital Group, Ltd.*, 93 USPQ2d at 1247; *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Likewise, given the descriptive significance of "dental implants" and "dental implant center", even if the record were limited to Opposer's other two registrations for its **ClearChoice** mark(s), it would be appropriate to focus on CLEARCHOICE as the dominant portion of the mark(s). *See Clear Choice Holdings, LLC v. Implant Direct Int'l*, Opposition No. 91190485 (August 26, 2013), pp. 10-11, and cases cited therein.

“consequent similarities” between LASER and LASERSWING). *See also Bridgestone Americas Tire Operations LLC v. Federal Corp, supra* (similarity of marks based on letter strings “ANZA” and “ENZA” at end of Potenza, Turanza and Milanza marks). Moreover, “right” and “clear” each are one syllable words, with the same number of letters.

ClearChoice and RightChoice also are closely similar in connotation. Among the definitions of “right” are “genuine”, “real” and “conforming to . . . truth.” NOR2, Exhibit A. “Genuine” and “real”, as well as “truth”, in turn, are synonyms for “clear”. NOR2, Exhibit C. The words “authentic” and “downright” also are both synonyms for “clear” and “right”. *Compare* NOR2, Exhibit B *with* NOR2, Exhibit C. Other synonyms which “clear” and “right” have in common include: obvious (obviously); plain (plainly); noticeable (noticeably). *Compare* NOR2, Exhibit B *with* NOR2, Exhibit A. When these terms are coupled as one word with the suffix “CHOICE”, the resultant marks, in overall context, convey a very similar impression. *See Kenner Parker Toys, Inc. v. Rose Art Indus.*, 22 USPQ2d 1457, *citing Spice Islands v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (CCPA 1974) (SPICE TREE and SPICE VALLEY confusingly similar); and *Specialty Brands v. Coffee Bean Distribs.*, 748 F.2d 669, 676, 223 USPQ 1281 (Fed.Cir. 1984) (SPICE ISLAND and SPICE VALLEY confusingly similar).

4. Manifestly, Goldschlag has sought to imitate the **ClearChoice** mark(s)

Bad faith or intent of the applicant bears on the likelihood of confusion analysis (*du Pont*’s “any other established fact probative of the effect of use”). *See L.C. Licensing Inc. v. Berman*, 86 USPQ.2d 1883, 1890 (TTAB 2008). *See also Estrada v. Telefonos de Mexico, S.A.B. de C.V.*, 447 Fed. Appx. 197, 203-204 (Fed. Cir. 2011). Of course, not every imitation is reflective of bad faith intent. However, when the second comer blatantly copies the same style script, font and/or other distinctive design elements of the senior party’s mark, and no excuse or

explanation for it is given at trial, it may – and, indeed, should – be inferred that the copier’s intent was to confuse. *See U.S. Polo Ass’n, Inc. v. PRL USA Holdings, Inc.*, 800 F. Supp.2d 515, 535 (SDNY 2011), *aff’d*, 511 Fed. Appx. 81 (2013); *Metlife Inc. v. Metropolitan National Bank*, 388 F. Supp.2d 223, 234 (SDNY 2005), *both citing Paddington Corp. v. Attiki Importers & Distributors, Inc.*, 996 F.2d 577, 587 (2d Cir.1993) (“...similarities so strong it seems plain that deliberate copying occurred). *See also Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 34 USPQ2d 1526, 1530 (Fed. Cir. 1995); *Holiday Inns, Inc. v. Holiday Inn*, 364 F. Supp. 775, 177 USPQ 640, 646 (D.S.C. 1973), *aff’d per curiam*, 182 U.S.P.Q. 129 (4th Cir. 1974).

Below is ClearChoice’s pleaded and registered mark, and the opposed mark as it appears in the specimen of use submitted by Goldschlag in the opposed application.⁶



It simply defies credulity to believe that the identical “shooting star” effect (the “dot” on the letter “i” in the word “choice”) – a design which is inherently and completely arbitrary and distinctive as to dental implant services – was “created” or selected by Goldschlag coincidentally, or innocently. *See Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695,704 (5th Cir. 1981) *quoting American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 99 USPQ 362, 365 (2d Cir. 1953) (L. Hand J.) (“[A]s soon as we see that a second comer in a market has, for no reason that he can assign, plagiarized the ‘make-up’ of an earlier comer, we need no more; for he at any rate thinks that any differentia he adds will not, or at least

⁶ On the specimen, the mark appears in white lettering on a pink background. *See, supra*, p. 4. The bold, however, is as in the original.

may not, prevent the diversion and we are content to accept his forecast that he is ‘likely’ to succeed.”); *Metlife, Inc.*, 388 F. Supp. At 234 (“Nevertheless, the similarity between the parties’ marks is such that it strains credulity to believe that neither MNB nor the firm it hired to redesign its logo were not consciously influenced by the MetLife logo.”); *GTFM, Inc. v. Solid Clothing Inc.*, 215 F. Supp.2d 273, 297 (SDNY 2002) (“Solid cannot reasonably claim to have acted in good faith. To begin with, the similarities between Solid’s and GTFM’s use of the number “05” are so strong that they could only have occurred through deliberate copying.”); *Caesar’s World, Inc. v. Caesar’s Palace*, 490 F. Supp. 818, 209 USPQ 492, 499 (D.N.J. 1980) (“[T]his Court is asked to believe that the signmaker independently arrived at both the style of lettering and the lack of an apostrophe in the word Caesar. These contentions lack credibility.”); *Atlanta Gas Light Co. v. Roberts*, 388 F. Supp. 1383, 188 USPQ 597, 600 (D.S.C. 1974) (“It is difficult for the court to believe that Mr. Roberts accidentally or innocently chanced upon the same style script as that used by the plaintiffs”); *Holiday Inns, Inc.*, 177 USPQ at 646 (“The Court cannot believe that the defendant accidentally or innocently chanced upon the same style script as that used by the plaintiff . . .”). *See also* 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §23:123 (4th ed. 2014), in particular “*Imitating Details of Format and Font*”.

At the barest minimum, Goldschlag’s blatant copying calls to mind the well-established principle, that a party which knowingly adopts a mark similar to one used by another for the same goods or services does so at its peril, and any doubts about likelihood of confusion must be resolved against the applicant, as the newcomer. *See Hard Rock Café Int’l (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1514 (TTAB 2000); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d at 1774. *See also Bridgestone Americas Tire Operations LLC v. Federal Corp.*, 102 USPQ2d at 1065 (“There is a heavy burden on the newcomer to avoid consumer confusion as to products and their

source.”); *Hewlett-Packard Co. v. Packard Press Inc.*, 62 USPQ2d at 1003 (doubts resolved against newcomer “because the newcomer has the opportunity and obligation to avoid confusion”); *Century 21 Real Estate Corp. v. Century Life of America*, 23 USPQ2d at 1701.

5. All relevant *DuPont* factors strongly show a likelihood of confusion

It is not necessary to compare or balance the pertinent likelihood of confusion factors to reach a decision. All factors weigh strongly in favor of, and dictate, a conclusion of likelihood of confusion, as a matter of law. The respective services, channels of trade and customers of the parties are identical. And, the marks are so closely similar in appearance, sound, connotation and overall commercial impression as to cause confusion or mistake with respect to the source or origin of those services, and/or association as to the parties. No doubt, that is precisely what Applicant intended.

V. CONCLUSION

For all of the reasons set forth above, and based on the evidence of record, ClearChoice has proven its opposition claim under § 2(d) of the Trademark Act, by a preponderance of the evidence. Accordingly, the present opposition should be sustained, and registration on application serial no. 77685491, for the mark RightChoice, refused.

Respectfully submitted,

Dated: July 29, 2014

CLEARCHOICE HOLDINGS, LLC

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CERTIFICATE OF SERVICE

I hereby certify that on this 29th day of July, 2014, a true copy of the foregoing Trial Brief of Opposer was served by first-class mail, postage prepaid, upon Applicant at the following address:

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