

ESTTA Tracking number: **ESTTA629410**

Filing date: **09/26/2014**

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

Proceeding	91191371
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Date	09/26/2014
Attachments	RightChoice Trial Reply Brief.pdf(99941 bytes)

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CLEARCHOICE HOLDINGS, LLC,

Opposer,

v.

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

Applicant.

Opposition No. 91191371

REPLY BRIEF OF OPPOSER

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September 26, 2014

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REPLY BRIEF OF OPPOSER

Opposer, ClearChoice Holdings, LLC (“ClearChoice”), by and through its undersigned counsel, hereby submits the following Reply to Applicant’s Brief on Case (hereafter, “Applicant’s Brief”) in the above captioned proceeding.

I. PRELIMINARY STATEMENT

Applicant’s Brief is an exercise in (attempted) obfuscation of the inescapable conclusion demanded by the record in this proceeding – that concurrent use of RightChoice and ClearChoice, on identical services, rendered through identical channels of trade, to the same customers, is likely to cause confusion, and that this mistaken association is precisely the outcome Applicant Goldschlag sought in adopting the opposed mark.

II. APPLICANT’S ASSERTIONS IN HIS STATEMENT OF CASE AND STATEMENT OF “FACTS” ARE DEVOID OF SUPPORT IN THE RECORD AND SHOULD BE GIVEN NO CONSIDERATION

Conveniently omitted in Applicant’s Brief is the fact that Applicant did not submit any testimony, notices of reliance or other evidence during his testimony period. This, of course, is his right, but Applicant Goldschlag does not have the right to rely in his brief on allegations of

fact which have no evidentiary basis in the record, or on “exhibits”/attachments which nowhere are found in the record.

A. *Goldschlag Cannot Rely on Contentions of Fact without Evidentiary Basis*

Applicant’s Brief is replete with statements of “fact” that are completely lacking in evidentiary basis, which is not surprising, considering Applicant did not make of record any evidence. Thus, for example, there is not a shred of (nor does Applicant’s Brief even attempt to cite to any) evidence in the record to support the statements that:

- “CHOICE . . . is *widely* used in the health, dental, and dental implant industries” (Applicant’s Brief, p. 3, emphasis in original) and/or that “CHOICE is commonly used . . . in marks for similar goods and services” (Applicant’s Brief, p. 6);
- Dental implant “customers are very discriminating in their purchasing decisions” (Applicant’s Brief, p. 3) and/or “consumers are likely to be exceptionally careful and discriminating in choosing a dental implant provider” (Applicant’s Brief, p. 4, and also at pp. 6 and 12);
- “The decision about which dentist to go to . . . is by no means an impulse decision. It is a decision made only after carefully studying the many options available” (Applicant’s Brief, p. 11);
- Applicant continuously has used the opposed mark during the pendency of this opposition proceeding (Applicant’s Brief, p. 13);
- The specimen of record in the opposed application (and which Applicant claimed, under oath, evidenced the opposed mark “as used in commerce”) was a “one-time ad” (Applicant’s Brief, p. 14);
- Opposer ClearChoice’s registered logo (NOR1 Exhibit D¹) is “a commonly used star design” (Applicant’s Brief, p. 14); and/or
- “Applicant does not use that particular stylization/design” (Applicant’s Brief, p. 15).

Factual statements such as these in a party's trial brief can be given no consideration unless they are supported by evidence properly introduced at trial. *See* TBMP § 704.06(b) (2014). *See also Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (“Applicant’s broad and general statements in his brief regarding his asserted marketing experience are not supported by any specific facts, or by any evidence. We can accord no evidentiary value or consideration to unsupported factual statements made by a party in its brief.”); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d 1104, 1110 (TTAB 2007); *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1328 (TTAB 2007). Accordingly, these, and all of Goldschlag’s other, “factual” contentions in Applicant’s Brief which bear no citation to, and are unsupported by, actual evidence in the record, should be ignored.

B. Applicant’s Back-Door Attempt to Submit Trial Evidence by Way of Applicant’s Brief Should Not Be Permitted

Applicant Goldschlag endeavors to submit as evidence and rely upon five (5) “exhibits”, comprising over sixty (60) pages of documents, by way of attachments to Applicant’s Brief. This simply is not permitted. *See* TBMP § 704.05(b) (“Exhibits and other evidentiary materials attached to a party’s brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony.”). *See also Syngenta Crop Protection, Inc. v. Bio-Chek, LLC*, 90 USPQ2d 1112, 1116 (TTAB) 2009); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008):

Exhibits or attachments to briefs are of little or no use in a Board proceeding. The Board sets trial periods during which the parties may submit evidence by filing notices of reliance or by taking testimony. Evidence submitted outside of the trial periods – including that attached to briefs – is untimely, and will not be considered.

Obviously recognizing his failure to make of record exhibits on which Goldschlag now seeks to rely, Applicant asks the Board to take judicial notice, pursuant to Fed. R. Evid. § 201 and TBMP §704.12, of the voluminous materials submitted for the first time well after trial, as attachments to Applicant’s Brief. However, the Board’s procedures clearly require that such a request be made during the requesting party’s testimony period, by notice of reliance accompanied by the necessary information required by Fed. R. Evid. § 201. *See* TBMP § 704.12(b). *See also Litton Business Systems, Inc. v. J.G. Furniture Co.*, 190 USPQ 431, 434 (TTAB 1976); *Sprague Electric Co. v. Electrical Utilities Co.*, 209 USPQ 88, 95 n. 3 (TTAB 1980) (rejecting as untimely effort to make evidence of record in rebuttal period through judicial notice).

This is no mere technicality. Following the required procedure would provide Opposer with the opportunity to be heard which Fed. R. Evid. § 201(e) mandates (*see also* TBMP § 704.12(c)) without significant delay of the proceedings.² *Litton, supra*, at 444. More importantly, it would afford Opposer the opportunity it should be given – and would have been given had the request timely and properly been made at trial – to submit rebuttal evidence.³

Applicant gives no reason why it did not present these materials by Notice of Reliance timely filed during its testimony period – and there is no excuse for this failure. As the Board observed, in *Litton, supra* (p. 434):

² To the extent required, ClearChoice does formally request that it be afforded the required opportunity to be heard. In this regard, it should be noted that Opposer adamantly contests that the “facts” which Applicant seeks the Board to take judicial notice of are “not subject to reasonable dispute” (Fed. R.Civ. 201(b)).

³ Indeed, Opposer respectfully submits, and requests, that should Applicant be allowed to make the materials attached to Applicant’s Brief of record in this proceeding, ClearChoice be afforded the rebuttal period it should have been afforded had this evidentiary submission properly and timely been made at trial, with an opportunity to supplement Opposer’s Reply trial brief, if necessary.

It is pertinent to note Judge Weinstein’s statement, which we paraphrase, that judicial notice should not be used as a device to correct on appeal an almost complete failure to present adequate evidence to the trial court [citation omitted]. Similarly, we should not use judicial notice to remedy plaintiff’s failure to present adequate evidence.

Likewise, Applicant’s attempt to make of record two non-party registrations (Applicant’s Brief, p. 4) also must be rebuffed. Third-party registrations may be made of record in an opposition, but again, this must be done during the proponent party’s testimony period, typically by Notice of Reliance. *See* 37 C.F.R. § 2.122(e) and TBMP §704.03(b)(1)(B). This can be accomplished by providing a plain copy of the registration or a printout of the registration from the U.S. Patent and Trademark Office (“PTO”) database (*id.*), but Goldschlag did not even do that. *See Edom Labs. Inc. v. Lichter*, 102 USPQ2d 1546, 1550 (TTAB 2012); *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1829 n. 8 (TTAB 2012); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d at 1110 (third party registrations mentioned in trial brief); *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH*, 230 USPQ 530, 532 (TTAB 1986) (reference to third-party registration in brief).

Again, Applicant asks the Board to take judicial notice of these two registrations, relying on *In re Chippendales USA, Inc.*, 622 F.3d 1346, 1356, 96 USPQ2d 1681 (Fed. Cir. 2010). However, the TBMP states not once, but *twice*, that the Federal Circuit’s determination to exercise its discretion in this manner in *Chippendales* will not be applied in Board proceedings. *See* TBMP § 704.12(a) (“**Please Note:** . . . Although the court took judicial notice of a third-party registration in [*Chippendales*], the Board does not take judicial notice of either third-party registrations or a party’s own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding.” (emphasis in original); TBMP §704.03(b)(1)(B) (“Although the court took judicial notice of a third-party registration in

[*Chippendales*], as discussed above, the Board does not take judicial notice of either third-party registrations or a party's own registration[s] insofar as the Trademark Rules of Practice specify how to make such registrations of record in an inter partes proceeding.”).

Accordingly, the record in this proceeding should be limited to that set forth at p. 2 of the Trial Brief of Opposer. Any factual contentions must be based upon, and supported by, that record.

III. NONE OF THE *du PONT* FACTORS RAISED IN APPLICANT'S BRIEF WEIGHS AGAINST A FINDING OF LIKELY CONFUSION

Applicant's Brief challenges Opposer's focus on certain of the factors set forth in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (C.C.P.A. 1973) – to wit, the similarity of the ClearChoice and RightChoice marks, Applicant's bad faith intent, and the identity of the parties' respective services, channels of trade, and customers.⁴ As pointed out in the Trial Brief of Opposer (pp. 5-6, and cases cited therein), however, not every factor is pertinent to a particular case, nor must each of them be considered in every case; instead the analysis may focus on dispositive factors. *See also Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002).

Applicant's Brief raises four additional *du Pont* factors. The record reveals that each of these four factors, at best, is neutral, or even further substantiates a likelihood of confusion.

A. There is No Evidence that the Relevant Customers are “Sophisticated”

There is no evidence in the record regarding the nature of customers for dental implant services; there is nothing to indicate that as a group they tend to enjoy any particular

⁴ Although Applicant equivocates somewhat, he does (and, indeed, legally must) concede that the services, channels of trade and customers of the parties are identical (Applicant's Brief, p. 6, n. 5), requiring that each of these three *du Pont* factors weigh heavily in favor of a finding of likelihood of confusion.

sophistication level or otherwise are more educated or discerning generally, or even as to the particular services in question. There is no evidence showing that actual and potential customers for the parties' services are, as Applicant contends, "exceptionally careful and discriminating"; nor is there any evidence to support Applicant's contention that such customers do not act on (relative) impulse, but rather "only after carefully studying the many options available." Although Applicant contends – without any evidence in the record to support this – that dental implants "usually cost. . . thousands of dollars" (Applicant's Brief, p. 11), Applicant Goldschlag advertises and offers such services for \$395 (*see* NOR1, Exhibit A, at specimen of use⁵), less than many consumer electronic products. Moreover, Applicant's services (according to Applicant's Brief, p. 14) are advertised via newspaper, again, just as many common consumer products and services are.

Citing and quoting from *Carefirst of Md., Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1503-04 (TTAB 2005), Applicant's Brief (p. 11) seems to suggest some sort of *per se* rule; that this *du Pont* factor must *always* weigh against likely confusion where any services in the health care field are concerned. However, there is no such broad sweeping principle.⁶ *See In re Main Line Urgent Care Centers, LLC*, TTAB LEXIS 576, *14, Serial No. 85470562 (October 31, 2013):

This reliance is misplaced. . . . Moreover, applicant has not provided any evidence to support its allegation and hence it is not persuasive. Further, even if we accept that purchasers of urgent healthcare services exercise a heightened degree of care

⁵ Opposer properly may rely on this specimen. *See, infra*, pp. 11-12.

⁶ Nor, in this day and age, where flu shots and other medical services are provided at retail drug stores, and medical advice, services and even pharmaceuticals are dispensed over the Internet, could there reasonably be such a *per se* rule regarding the sophistication level of consumers for all manner of health care services and the comparative quantum of care and consideration they exercise in purchasing such services.

in purchasing such services, we are not persuaded that the degree of care will avoid a likelihood of confusion, since the fact that “the relevant class of buyers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar trademarks for similar goods. Human memories even of discriminating purchasers are not infallible.” *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir.1986) (internal citation omitted) Accordingly, we find the *du Pont* factor relating to sophistication of customers to be neutral.

Indeed, the Board only recently found, on no less developed a record, and with regard to the identical (dental implant) services, that this factor is neutral. *See Clear Choice Holdings, LLC v. Implant Direct Int'l*, Opposition No. 91190485, p. 13 (TTAB August 26, 2013). *See also In re Trumpf GmbH + Co. KG*, 2007 TTAB LEXIS 225, *10, Serial No. 79015005 (October 23, 2007), distinguishing *Electronic Design & Sales Inc. v. Electronic Data Systems Corp.*, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992), on which Applicant’s Brief relies, because (as here) the goods (services), channels of trade and customers were the same.

B. There is No Evidence to Support Applicant’s Contention that “the term CHOICE Is Common for Similar Services”

Quite simply, there is absolutely no evidence in the record to support Applicant’s contention that this is a “crowded field”, or in fact, that there are any other pertinent uses (or even registrations) of what Applicant refers to as “CHOICE” marks.⁷ As set forth above, Applicant’s untimely efforts to belatedly make two registrations of record must be rejected.

Further, even if these two registrations properly had been made of record⁸, they would have little, if any probative weight, since there is no evidence in the record of any actual use of

⁷ Hence, it should come as no surprise that the Trial Brief of Opposer “failed to analyze” this *du Pont* factor. (Applicant’s Brief, p. 12)

⁸ Opposer in no way waives its objection to Applicant Goldschlag’s untimely attempt to make these registrations of record by way of statements in Applicant’s Brief. Opposer makes this point only to the extent the Board determines, notwithstanding its clear and express rules to the contrary, to consider such registrations.

the marks which are the subject of these registrations. *See Nike Inc. v. Maher*, 100 USPQ2d 1018, 1028 (TTAB 2011) (existence of four registrations insufficient to persuade Board that term is commonly registered) ; *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d at 1110; *Edison Brothers Stores, Inc. v. Brutting E.B. Sport-Int'l GmbH*, 230 USPQ at 532 n. 11; TBMP § 704.03(b)(1)(B) (“Even when a third-party federal registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown in the registration.”).

The limited information regarding the Examining Attorney’s search in the prosecution of the opposed application (*see Applicant’s Brief*, p. 12) has no evidentiary value, either. A list of third-party marks downloaded from the PTO’s search system, containing the marks and registration/application numbers, “has little, if any, probative value.” *Edom Labs. Inc. v. Lichter*, 102 USPQ2d at 1550. *See also Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d at 1829 n. 8 (TTAB 2012); *Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d at 1110; TBMP §704.03(b)(1)(B). A listing which does not even show the asserted marks, or registration or serial numbers, therefore, cannot possibly have any significance, whatsoever.⁹

Accordingly, given the absence of evidence of any similar marks on similar services, this factor weighs *in favor* of a finding of likelihood of confusion. *Lebanon*, 101 USPQ2d at 1831-32; *Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d at 1328.

C. The Absence of Reported Evidence of Actual Confusion is Not Significant

Applicant contends that the absence of evidence of actual confusion “during a five-year opposition against a use-based application” indicates there is no likelihood of confusion.

⁹ It also is noted that the Examining Attorney apparently searched for the related classes to International Class 10; but the services set forth in the opposed application (and Opposer’s pleaded registrations of record) are in International Class 44.

Applicant's Brief, p.13. The lack of evidence of actual confusion carries little weight. *See J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965)).

Moreover, notwithstanding Applicant's careful wording, there is no evidence in the record of *any* use by Goldschlag of the opposed RightChoice mark, at any time after the filing of the opposed application, let alone for the past five years. Nor is there any evidence in the record of the geographic scope of such alleged use – i.e. whether the parties' respective uses even overlap, geographically – or the extent of such use. Without such evidence, the purported absence of actual confusion is meaningless in the likelihood of confusion analysis. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1847 (Fed. Cir. 2000) (there must be an opportunity for actual confusion); *In re Ginc UK Ltd.*, 90 USPQ2d 1472, 1480 (TTAB 2007) (without evidence of the nature and geographic extent of use of mark, the Board is unable to determine if a meaningful opportunity for actual confusion ever existed); *Gillette Canada Inc. v. Ranir Corp.*, 23 USPQ2d 1768, 1774 (TTAB 1992) (“[T]he absence of any reported instances of actual confusion would be meaningful only if the record indicated appreciable and continuous use by applicant of its mark for a significant period of time in the same markets as those served by oppose under its mark.”). *Cf. Schering-Plough HealthCare Products, Inc. v. Ing-Jing Huang*, 84 USPQ2d at 1328 (absence of actual confusion is “of no moment” given application is based on intent to use and there is no evidence of actual use of the opposed mark).

D. “Fame” is a Neutral Factor

Relying on the Board's holding in *Clear Choice Holdings, LLC v. Implant Direct Int'l*, *supra*, Applicant's Brief (p. 14) points out that Opposer has not proved its ClearChoice mark is famous. But as the Board also held in *Clear Choice Holdings, LLC* (p. 16), that merely renders this *du Pont* factor neutral. *See also Jansen Enterprises, Inc. v. Rind*, 85 USPQ2d at 1110.

IV. APPLICANT'S BAD FAITH INTENT TO COPY IS MANIFEST¹⁰

Applicant Goldschlag cannot deny that he prominently used the opposed mark with a logo identical to Opposer's registered logo, viz:



See Trial Brief of Opposer, pp. 3-4 and 10. To deflect from this damning evidence, Applicant's Brief simply tries to rid the record of it, but this, Applicant cannot do.¹¹

Applicant's Brief (p.15) asserts that the specimen Applicant submitted (and claimed under oath he was using) in the opposed application "is not admissible as evidence of anything." Applicant relies on 37 C.F.R. §2.122(b)(2) to support this proposition. However, that regulation only prohibits Applicant from relying on his own specimen. "The allegations and statements made and documents and things filed in an application or registration may be used as evidence *against* the applicant or registrant." TBMP §704.04 (emphasis in original). See also *Eikonix Corp. v. CGR Medical Corp.*, 209 USPQ 607, 613 n.7 (TTAB 1981) ("While Rule 2.126 provides, inter alia, that specimens submitted with an application cannot be considered as evidence in behalf of applicant unless identified and introduced into evidence during the

¹⁰ Applicant asserts that intent may be taken into account in the likelihood of confusion analysis only "when that issue is not free from doubt." In support of such heightened standard of proof, Applicant's Brief (p. 14) cites *The Board of Trustees of the University of Alabama v. Pitts*, 107 USPQ2d 2001 (TTAB 2013). What that case in fact states (at 2023), is that intent may be taken into account when the *issue of likelihood of confusion* is not otherwise free from doubt; that is, if the absence of a likelihood of confusion clearly is established, intent has no bearing. Indeed, were the *Pitts* case to stand for the proposition that Applicant posits, it would be in direct contravention of *du Pont*, which, unquestionably, is controlling authority.

¹¹ The specter of Applicant relying, under oath, on this specimen to support his § 1(a) claim of use in the opposed application, and then later, in proceedings involving that same application, attempting to disavow such specimen and use is, at best, unseemly.

appropriate trial period, they may nevertheless be used as admissions against interest and the like.”). *Accord Phillips Petroleum Co. v. C.J. Webb, Inc.*, 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971) (in application for mark in typed form, specimens in application used to illustrate one form in which mark may actually be used in order to show similarity with opposer’s mark); *Mason Engineering & Design Corp v. Mateson Chemical Corp.*, 225 USPQ 956, 961 n.11 (TTAB 1985) (Board relied on specimens in application as evidence against applicant).

This evidence reflects more than Applicant’s “mere knowledge” (Applicant’s Brief, p. 15) of Opposer’s ClearChoice mark. This is blatant copying of an arbitrary and very distinctive design.¹² The idea that Applicant could come up with the identical design, purely innocently and coincidentally, stretches beyond credulity. *See generally* Trial Brief of Opposer, pp. 10-11 and the numerous cases/authority cited therein, including 4 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §23:123 (4th ed. 2014), in particular “*Imitating Details of Format and Font*”.

Indeed, the record does not contain any denial by Applicant that this is precisely what he did.¹³ This, alone, distinguishes this case from *Clear Choice Holdings, LLC v. Implant Direct Int’l, supra*, relied upon by Applicant.¹⁴

¹² Applicant’s Brief (p. 14) claims ClearChoice’s registered logo is a “commonly used” design. There is **zero** evidence in the record to support this baseless contention – Applicant’s Brief does not even try to cite to any. This made-up-out-of-whole-cloth assertion, in itself, is evidence of Applicant’s bad faith.

¹³ The assertions in Applicant’s Brief (pp. 14-15) that this was a “one-time ad” and the copied design no longer is used, are nothing more than bare assertions of counsel, unsupported by any evidence in the record, and as set forth above, should not be considered.

¹⁴ Moreover, to the extent that *Clear Choice Holdings, LLC v. Implant Direct Int’l, supra*, stands for the proposition that prior knowledge and intentional copying of a distinctive logo or stylization is insufficient to find bad faith, Opposer respectfully submits that this would be directly contrary to the great weight of authority (cited above) by Opposer. *See, e.g. U.S. Polo Ass’n, Inc.v. PRL USA Holdings, Inc.*, 800 F. Supp.2d 515, 535, 101 USPQ2d 1487 (SDNY 2011), *aff’d*, 511 Fed. Appx. 81 (2013) (issued after, (continued . .

V. THE MARKS AT ISSUE ARE CLEARCHOICE AND RIGHTCHOICE -- NOT “CLEAR” AND “RIGHT” – AND THOSE MARKS ARE CONFUSINGLY SIMILAR

The Trial Brief of Opposer, at pp. 7-9, amply demonstrates that RightChoice and ClearChoice are confusingly similar, particularly in the context of the parties’ identical services, channels of trade and customers, to say nothing of Goldschlag’s intentional copying. ClearChoice will not belabor those points.

Applicant Goldschlag’s contrary analysis suffers from a fatal defect; it treats the marks at issue as if they were “right” and “clear”, rather than RightChoice and ClearChoice. This, of course, is contrary to well established law, which requires a comparison of the marks “in their entireties.” *Palm Bay Imps. Inc. v. Veuve Clicquoi Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005) (quoting *du Pont*, 177 USPQ at 567). It is improper to dissect a mark when determining this factor; even if a mark contains a term which, standing alone, is generic or descriptive, the ultimate conclusion must rest on a comparison of the marks in total. *In re Viterra, Inc.*, 671 F.3d 1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012).

ClearChoice has submitted into evidence a registration which is incontestable. *See* 15 U.S.C. § 1065. There is no disclaimer of “CHOICE” in that, or any other of Opposer’s pleaded registrations for its ClearChoice mark entered into evidence. Likewise, there is no disclaimer of “CHOICE” in the opposed application for the RightChoice mark. Further, contrary to the unsupported assertion of Applicant Goldschlag, there is no evidence in the record of other “choice” marks in use on similar services.

and which cites to, *Starbucks Corp v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97, 92 USPQ2d 1769 (2nd Cir. 2009)); and *Metlife Inc. v. Metropolitan National Bank*, 388 F. Supp.2d 223, 234 (SDNY 2005) (both holding that prior knowledge plus similarities in font, design or stylization so strong it seems plain that deliberate copying has occurred establishes bad faith intent, and both of which were decided under controlling Second Circuit law).

To try and support its faulty analysis, Applicant’s Brief (pp. 7-8) asserts that the first term (actually, they are syllables) of the ClearChoice and RightChoice marks (“clear” and “right”, respectively) are the dominant portions of the marks. However, Applicant Goldschlag provides absolutely no support for this conclusion, and it seems equally, if not more, plausible that “clear” and “right”, as adjectival modifiers of the noun “choice”, are the less significant syllables.

In fact, Applicant Goldschlag’s own use of the RightChoice mark emphasizes the word “Choice”, including, *inter alia*, by the use of the (copied) shooting star design which visually attracts the consumer’s attention to that word/syllable. Likewise, Opposer’s pleaded registration no. 3,685,880 (NOR1, Exhibit D) depicts the mark with the emphasis (in bold) of the term/syllable “Choice”. *See Phillips Petroleum Co. v. C.J. Webb, Inc.*, 170 USPQ at 36. In *Phillips*, the opposed mark was set forth in the application drawing in standard typed form. At first blush, the *Phillips* Court noted, this typed drawing and the opposer’s mark were not that closely similar; however, relying on the specimen in the opposed application, the Court found, as actually used, the opposed mark was, and could be, closely similar to the opposer’s mark. *See also In re Viterra, Inc.*, 101 USPQ2d at 1910 (“[I]llustrations of the mark as actually used may assist the T.T.A.B. in visualizing other forms in which the mark might appear.”).

Indeed, based on *Phillips* and *Viterra*, the close similarity between the opposed mark¹⁵ and at least the mark of Opposer’s registration no. 3,685,880¹⁶, is striking. At minimum, the

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evidence of Applicant's use demonstrates the strong similarity in overall commercial impression of the marks.¹⁷

VI. CONCLUSION

As set forth above and in the Trial Brief of Opposer, and as fully supported by the evidence of record, all of the pertinent *du Pont* factors weigh heavily in favor of a conclusion of likelihood of confusion. The services, channels of trade, and customers of the parties are identical. ClearChoice and RightChoice are closely similar in appearance, sound, connotation, and overall commercial impression, as more than evidenced by Applicant's specimen of use. Further, Applicant's blatant copying is manifest. Each of the factors raised in Applicant's Brief – alleged sophistication of customers, actual confusion, fame of Opposer's mark, and uses of similar marks for similar services – is, at best, neutral. In fact, as to the last factor, this *favours* a conclusion of likelihood of confusion. Therefore, the present opposition should be sustained, and registration on application serial no. 77685491, for the mark RightChoice, refused.

Respectfully submitted,

Dated: September 26, 2014

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¹⁷ Although Applicant's untimely and improper attempt to supplement the record should be rejected (and Opposer does not waive its objection to those submissions), if accepted, they only further support the strong similarity in commercial impression of the RightChoice and ClearChoice marks. Thus, for example, Applicant's proffered Exhibit D shows "unmistakable" as a definition of "clear", and Applicant's proffered Exhibit E shows "unmistaken" as a synonym for "right".

CERTIFICATE OF SERVICE

I hereby certify that on this 26th day of September, 2014, a true copy of the foregoing Reply Brief of Opposer was served on the following counsel of record for Applicant via first class mail, postage prepaid:

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