

ESTTA Tracking number: **ESTTA347056**

Filing date: **05/12/2010**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Eye Store Holdings LLC
Granted to Date of previous extension	05/12/2010
Address	c/o Foster Pepper PLLC 1111 3rd Avenue Suite 3400 Seattle, WA 98101 UNITED STATES

Correspondence information	Nancy V. Stephens Attorney FOSTER PEPPER PLLC 1111 3rd Avenue Suite 3400 Seattle, WA 98101 UNITED STATES stepn@foster.com Phone:206-447-8925
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**Applicant Information**

Application No	77805570	Publication date	01/12/2010
Opposition Filing Date	05/12/2010	Opposition Period Ends	05/12/2010
Applicant	eyestoreRx, LLC Suite 260 5051 Highway Seven Minneapolis, MN 55416 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 2009/02/13 First Use In Commerce: 2009/04/01 All goods and services in the class are opposed, namely: Online retail store services featuring products for the eyes and eye care including contact lenses, eyewear frames, reading glasses, sun glasses, aesthetics, dermatological cosmetics, nutraceuticals, pharmaceuticals, lubricating drops, diagnostics, tests, external eye protection, work eyewear, sports vision and low vision aids along with patient scheduling, ophthalmologist, optometrist and optician referral service, eye exam, symptom checker, a complete eye health knowledgebase, procedure financing and patient payment systems, all through a website
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application No.	77794874	Application Date	07/31/2009
Registration Date	06/01/2010	Foreign Priority Date	NONE
Word Mark	WEB EYE STORE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/12/01 First Use In Commerce: 2008/05/05 On-line retail store services featuring ophthalmic products and accessories; Retail store services featuring ophthalmic products and accessories		

Attachments	77794874#TMSN.jpeg ( 1 page )( bytes ) SEADOCS 51070292 NOP EYESTORERX 1.pdf ( 5 pages )(86914 bytes ) CERTIFICATE OF SERVICE.pdf ( 1 page )(7340 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Nancy V. Stephens/
Name	Nancy V. Stephens
Date	05/12/2010

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

In the matter of Application Serial No. 77805570

Eye Store Holdings, LLC

OPPOSER

v.

APPLICANT

APPLICANT

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Eye Store Holdings, LLC, a Pennsylvania Limited Liability Company, (the “OPPOSER”), with a mailing address of c/o Foster Pepper PLLC, Suite 3400, Seattle, WA 98040 believes it would be damaged by registration of the mark EYESTORERX, in standard form, which is the subject of application Serial No. 77805570 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. APPLICANT, a Delaware corporation, (“APPLICANT”) is the owner of Application Serial No. 77805570, filed on August 16, 2009 (the “Opposed Application”), and seeks to register EYESTORERX (“APPLICANT’s Mark”), in standard form, as a trademark for goods in International Class 35. Specifically, the Opposed Application covers, “online retail store services featuring products for the eyes and eye care including contact lenses, eyewear frames, reading glasses, sun glasses, aesthetics, dermatological cosmetics, nutraceuticals,

pharmaceuticals, lubricating drops, diagnostics, tests, external eye protection, work eyewear, sports vision and low vision aids along with patient scheduling, ophthalmologist, optometrist and optician referral service, eye exam, symptom checker, a complete eye health knowledgebase, procedure financing and patient payment systems, all through a website,” in International Class 35.

2. OPPOSER is the owner of U.S. Application Serial No. 77794874 for WEB EYE STORE covering, “on-line retail store services featuring ophthalmic products and accessories; Retail store services featuring ophthalmic products and accessories” in International Class 35 (“OPPOSER’s Mark”).

3. OPPOSER’s Mark is nearly identical to APPLICANT’s Mark. Both marks contain “EYE STORE” as the dominant element. The OPPOSER’s Mark has a space between the words while there is no space in the APPLICANT’s mark.

4. Both marks contain “EYE STORE” plus one additional element.

5. The element “RX” is understood to mean “prescription.”

6. The element “RX” is commonly disclaimed as descriptive in trademarks on the US trademark register covering “nutraceuticals, pharmaceuticals and goods/services related to the medical or patient services field.

7. OPPOSER’s Mark and APPLICANT’s Mark both contain “EYE STORE” plus one additional descriptive element.

8. The goods covered by the marks are identical. All services covered by OPPOSER’s Mark are covered by APPLICANT’s Mark.

9. OPPOSER and APPLICANT both offer “online retail services.” As such, the channels of trade are identical.

10. OPPOSER and APPLICANT both target consumers who wish to purchase eyewear online. The consumer base is identical.

11. OPPOSER has enjoyed use of the trademark WEB EYE STORE in Interstate Commerce since May 5, 2008 and the mark was first used anywhere in December of 2007. The mark WEB EYE STORE passed examination by the United States Patent and Trademark Office.

12. APPLICANT'S Mark was filed August 16, 2009, more than a year after OPPOSER started using its mark in interstate commerce.

13. APPLICANT'S Mark claims a first use date of April 1, 2009, nearly one year after OPPOSER started using its mark.

14. APPLICANT filed its application on the basis of use attesting that as of April 1, 2009, APPLICANT or its related company, licensee or predecessor in interest, was using APPLICANT'S Mark in commerce, on or in connection with the identified goods and/or services as required by 15 U.S.C. §1051(a).

15. There was no bona fide use of APPLICANT'S MARK in commerce prior to the filing of the use-based application for its registration under Section 1(a) of the Act, 15 U.S.C. § 1051(a).

16. APPLICANT'S Mark when used in connection with the services specified on its application are merely descriptive under 15 U.S.C § 1052(e).

17. OPPOSER'S Application Serial No. 77794874 has a filing date that precedes the Opposed Application's filing date.

18. OPPOSER, or made use of the mark WEB EYE STORE in interstate commerce prior to APPLICANT's filing date.

19. Based on the priority of filing and priority of use dates, OPPOSER's rights in the trademark WEB EYE STORE or EYE STORE covering, “on-line retail store services featuring ophthalmic products and accessories; retail store services featuring ophthalmic products and accessories” in International Class 35 are superior to the APPLICANT's rights to EYESTORE or EYESTORERX covering identical or similar services.

20. OPPOSER has expended energy and resources to develop marketing and promotional activities surrounding the WEB EYE STORE trademark.

21. The USPTO has determined that while the trademark WEB EYE STORE is descriptive, it is capable of functioning as a trademark to identify OPPOSER’S services.

22. As a result of its prior use of the mark and its application on the USPTO register, WEB EYE STORE is entitled to a scope of protection which would encompass the mark EYESTORERX for, “online retail store services featuring products for the eyes and eye care” as EYE STORE is the dominant element of both marks..

23. The mark shown in the Opposed Application, if registered or used, will dilute the value of the mark as a source identifier.

24. If APPLICANT is permitted to register the mark EYESTORERX, for, “online retail store services featuring products for the eyes and eye care including contact lenses, eyewear frames, reading glasses, sun glasses, aesthetics, dermatological cosmetics, nutraceuticals, pharmaceuticals, lubricating drops, diagnostics, tests, external eye protection, work eyewear, sports vision and low vision aids along with patient scheduling, ophthalmologist, optometrist and optician referral service, eye exam, symptom checker, a complete eye health knowledgebase, procedure financing and patient payment systems, all through a website,” damage and injury to OPPOSER will be caused and will result by reason of a likelihood of

confusion between EYESTORERX and OPPOSER's trademark WEB EYE STORE. WEB EYE STORE and OPPOSER will be denied the benefit of its soon to be registered trademark.

25. OPPOSER will be damaged by registration of the mark shown in the Opposed Application on the Principal Register as a registration will give APPLICANT prima facie evidence of its exclusive right to use a mark likely to cause confusion with OPPOSER's proprietary mark.

26. If APPLICANT is granted a registration for the EYESTORERX in International Class 35 covering, "online retail store services featuring products for the eyes and eye care including contact lenses, eyewear frames, reading glasses, sun glasses, aesthetics, dermatological cosmetics, nutraceuticals, pharmaceuticals, lubricating drops, diagnostics, tests, external eye protection, work eyewear, sports vision and low vision aids along with patient scheduling, ophthalmologist, optometrist and optician referral service, eye exam, symptom checker, a complete eye health knowledgebase, procedure financing and patient payment systems, all through a website," it will not only likely create confusion in the marketplace but it will be inconsistent with OPPOSER's superior rights in and to the mark WEB EYE STORE and would unduly narrow the scope of protection to which OPPOSER's trademark is entitled or will be entitled in the future.

WHEREFORE, the OPPOSER prays that the Application, Serial No. 77805570 be denied and refused.

Dated: May 12, 2010

/Nancy V. Stephens/

Nancy V. Stephens, WSBA No. 31510  
J. Christopher Lynch, USPTO No. 34216  
WSBA No. 17462

Foster Pepper PLLC  
Attorneys for OPPOSER Eye Store Holdings, LLC

