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

Proceeding	91201187
Party	Defendant Gunther Eysenbach
Correspondence Address	GUNTHER EYSENBACH 59 WINNERS CIRCLE TORONTO, M4L3Y7 CANADA
Submission	Answer
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Date	09/23/2011
Attachments	2011-09-23 HEALTHBOOK - Answer - FINAL.pdf ( 8 pages )(86376 bytes )

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

Facebook, Inc.  
Opposer,

v.

Gunther Eysenbach,  
Applicant.

Opposition No. 91201187

Application Serial No. 85122420

Mark:

**HealthBook**

**ANSWER**

COMES NOW Gunther Eysenbach (“Applicant”), by and through Counsel, Erik M. Pelton & Associates, PLLC, and Answers the Notice of Opposition to Application Serial No. 85122420 filed by Facebook, Inc. (hereinafter “Opposer”), and assigned Opposition No. 91201187.

Applicant hereby responds, solely for the purpose of this proceeding, to each of the grounds set forth in the Notice of Opposition, as follows:

1. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 1 of the Notice of Opposition, and therefore denies same.
2. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 2 of the Notice of Opposition, and therefore denies same.
3. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 3 of the Notice of Opposition, and therefore denies same.

Applicant also notes that Opposer did not include certified copies of its alleged registrations or information sufficient to demonstrate the current “status and title” of the alleged registrations.

4. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 4 of the Notice of Opposition, and therefore denies same.

5. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 5 of the Notice of Opposition, and therefore denies same.

6. Admitted.

7. Admitted with respect to the attachment of the specimen submitted by Applicant in connection with Applicant's mark as Exhibit C; denied as to the characterization or definition of Applicant's services as alleged in paragraph 7 of the Notice of Opposition.

8. Admitted.

**First Ground for Opposition: Likelihood of Confusion**

9. Paragraph 9 does not call for an admission or denial.

10. Applicant is without information sufficient to form a belief as to the truth of the multiple allegations in paragraph 10 of the Notice of Opposition, and therefore denies same.

11. Denied.

12. Denied.

13. Applicant admits that its services are offered on the "internet." Applicant denies the remaining allegations in paragraph 13.

14. Denied.

15. Denied.

16. Admitted.

17. Applicant admits that Facebook has no control over the nature and quality of the services offered under Applicant's mark. Applicant denies the remaining allegations in paragraph 17.

18. Denied.

**Second Ground for Opposition: Dilution of a Famous Mark**

19. Paragraph 19 does not call for an admission or denial.

20. Applicant is without information sufficient to form a belief as to the truth of the allegations in paragraph 20 of the Notice of Opposition, and therefore denies same.

21. Applicant is without information sufficient to form a belief as to the truth of the allegations in paragraph 21 of the Notice of Opposition, and therefore denies same.

22. Applicant is without information sufficient to form a belief as to the truth of the allegations in paragraph 22 of the Notice of Opposition, and therefore denies same.

23. Applicant is without information sufficient to form a belief as to the truth of the allegations in paragraph 23 of the Notice of Opposition, and therefore denies same.

24. Denied.

25. Denied.

26. Applicant admits that its mark contains the term “book.” Applicant denies the remaining allegations in paragraph 26.

27. Denied.

28. Denied.

**AFFIRMATIVE DEFENSES**

FURTHERMORE, Applicant sets forth the following in support of its defense:

29. Applicant’s Mark and Opposer’s alleged marks are different in sound.

30. Applicant’s Mark and Opposer’s alleged marks are different in appearance.

31. Applicant’s Mark and Opposer’s alleged marks are different in meaning.

32. Applicant's Mark and Opposer's alleged marks are different in commercial impression.
33. Applicant's services and Opposer's services are not identical.
34. Opposer is not the only party entitled to use the word "book" for online services.
35. Numerous third parties use marks featuring "\_\_\_\_\_ BOOK" for services including or related to online and/or social networking services.
36. Numerous third parties own USPTO registrations for marks featuring "\_\_\_\_\_ BOOK" for services including or related to online and/or social networking services, including those featured in the table below.

<b>Mark</b>	<b>Reg. No.</b>	<b>Goods/Services</b>
42books	4015763	Software as a service (SAAS) services featuring software for use in enterprise resource planning (ERP) optimized for small and medium businesses; for use in accounting, transaction processing, tax preparation and planning, business process management, time management, project management, data management, online marketing, social media, blogging, financial planning, administering employee benefits and payroll, and collaboration and sharing of data with others
Trademybook	3996974	Providing a web site where users can post items for sale through on-line classified advertisements featuring academic related goods, namely, class notes and books for universities; Providing an on-line searchable database featuring classified ad listing for universities
	3974426	Providing an online non-downloadable Internet-based system application featuring technology enabling users to manage estate and financial planning activities among professional advisors and their clients
THELOOKBOOK	3879585	Providing an on-line subscription-based directory service featuring information regarding for the fashion and beauty industry
THE SILVER BOOK	3275248	Providing an online computer database in the field of medical information, namely, chronic disease data, medical innovation data and medical data regarding the aging population
DEALBOOK	3378767	providing online business news and information; providing databases featuring information in the field of business; providing online financial news and information; providing databases featuring information in the field of finance; providing newsletters in the fields of business and finance via e-mail;

		providing online newspapers in the business and financial fields
SENIORBOOK	3613993	Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users concerning topics of special interest to senior citizens; Computer services, namely, creating an online community for registered users to form a virtual community and engage in social networking
CHEAPBOOKS	3293887	Business services, namely, promoting the goods and services of other via a global computer network; on-line database services and on-line price comparison services featuring the goods and services of others; Providing search engines for obtaining data on global computer networks
	3317525	Entertainment services, namely, organizing, conducting and providing online and wireless gaming services via the Internet; providing gaming news and information via the Internet; betting services; gambling services; gaming services; casino gaming services; providing online services to others to enable participants to wager on sporting events; Internet wagering services; and providing websites for wagering
THE GREEN BOOK	1137714	Social directory published annually
my yearbook	3160669	Computer services, namely, providing information regarding, and in the nature of, on-line dating, introduction, user information, and social networking services
IN2BOOKS	2828488	Providing educational services, namely, organizing and conduction
KINGDOMBOOK	3858997	Online social networking services provided through an evangelical Christian website; evangelistic and ministerial services, namely, church planting, Christian stewardship, and prayer; and providing a website featuring information about church planting, evangelism, Christian stewardship, Christian leadership development and prayer
Hook Book	3625727	Providing an online directory information service featuring information regarding interpersonal relationships, social networking, classified ad listings, social introduction and dating services
LOOKBOOKS	3800023	Internet based introduction and social networking services

37. The term “book” is weak and diluted in connection with the services of Opposer.

38. Upon information and belief, there has been no actual confusion between Opposer’s alleged marks and Applicant’s mark.

39. Applicant’s mark and Opposer’s alleged marks are not likely to cause confusion, mistake or deception among purchasers as to the source of Opposer’s services

40. Opposer’s mark is not famous for purposes of dilution.

41. Applicant's mark is not likely to cause dilution by blurring of Opposer's alleged marks.

42. Opposer's marks are descriptive and/or generic with respect to the services for which they are utilized.

43. Opposer will not be damaged by the registration of Applicant's mark

44. The Notice of Opposition fails to state claim with specificity regarding the nature of the alleged common law rights asserted by Opposer.

45. The Notice of Opposition fails to state a claim with specificity regarding the nature of Opposer's alleged registered rights asserted as specific registration numbers, marks, and associated goods/services are not identified.

46. Applicant is a small business that is harmed by Opposer's litigation tactics wherein Opposer has attempted to enforce its alleged trademark rights beyond a reasonable interpretation of the scope of Opposer's rights in its alleged marks.

47. Opposer's opposition should be denied under the equitable doctrine of unclean hands.

Applicant hereby appoints Erik M. Pelton, a member of the Bars of the State of New Jersey and the District of Columbia, and Mark L. Donahey, a member of the Bar of the Commonwealth of Virginia, at the firm of:

Erik M. Pelton & Associates, PLLC  
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to act as attorneys in the matter of the cancellation identified above, to prosecute said notice of opposition, to transact all business in the Patent and Trademark Office connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board deny the Notice of Opposition and allow registration of Applicant's mark in Serial No. 85122420 in the United States Patent and Trademark Office.

Dated this 23rd day of September, 2011.



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Attorney for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of ANSWER has been served on the following by delivering said copy on September 23, 2011, via First Class Mail, to counsel for Opposer at the following address:

KATHRYN D DUVALL  
COOLEY LLP  
777 6TH STREET NW SUITE 1100  
WASHINGTON, DC 20001



By: \_\_\_\_\_  
Erik M. Pelton, Esq.