

ESTTA Tracking number: **ESTTA498748**

Filing date: **10/08/2012**

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	Illuminated Publishing, LLC		
Entity	limited liability company	Citizenship	Florida
Address	16545 Hanna Road Lutz, FL 33549 UNITED STATES		

Attorney information	Brittany J. Maxey Maxey Law Offices, PLLC 15500 Roosevelt Blvd., Suite305 Clearwater, FL 33760 UNITED STATES b.maxey@maxeyiplaw.com, s.yang@maxeyiplaw.com Phone:727-230-4949		
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Applicant Information

Application No	85458812	Publication date	10/02/2012
Opposition Filing Date	10/08/2012	Opposition Period Ends	11/01/2012
Applicant	Loving Guidance Inc. P.O. Box 622407 Oviedo, FL 327622407 UNITED STATES		

Goods/Services Affected by Opposition

Class 016. All goods and services in the class are opposed, namely: Educational publications, namely, learning cards, flash cards, activity cards, workbooks, textbooks, activity books, story books, puzzle books, printed puzzles, teacher guides, training manuals, posters and educational booklets in the fields of social-emotional learning

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<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/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	I CHOOSE		
Goods/Services	series of books in the field of character education; educational and entertainment services, namely, providing motivational speaking		

	services in the field of character education
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Attachments	399.001_Notice_of_Opposition_10082012.pdf (6 pages)(130600 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	/Brittany J. Maxey/
Name	Brittany J. Maxey
Date	10/08/2012

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

In the Matter of Trademark Application Serial No. 85458812

For the mark I CHOOSE and DESIGN

Published in the *Official Gazette* on October 2, 2012

Illuminated Publishing, LLC,

Opposer,

v.

Loving Guidance Inc.,

Applicant.

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Illuminated Publishing, LLC (“Opposer”), is a limited liability company organized and existing under the laws of the State of Florida, having a principal address of 16545 Hanna Road, Lutz, Florida 33549, believes it will be damaged by the registration of the mark shown in Application Serial Number 85/458,812, and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer has used, and continues to use, the mark I CHOOSE in commerce in connection with its educational and entertainment services, namely, providing motivational speaking services in the field of character education as early as 2009, and well prior to the filing date of Applicant’s mark. Opposer has made numerous appearances and presentations across classrooms and industry events since 2009.

2. Opposer has used, and continues to use, the mark I CHOOSE in connection with its series of books in the field of character education, that include the titles: “I Choose” (2008); “I Choose Too!” (2010); and “Yo Elijo” (2012), which translates to “I Choose” in Spanish, as early as 2010, and well prior to the filing date of Applicant’s mark. Opposer has, further, been featured in a variety of print media, television news shows, and national radio for its series of books.

3. Opposer intends to adopt the designation I CHOOSE in connection with “educational and entertainment services, namely, providing motivational speaking services in the field of character education” in International Classification 041; and “series of books in the field of character education” in International Classification 016.

4. On information and belief, Loving Guidance Inc. (“Applicant”) is a corporation organized under the laws of Florida, having a principal address of 820 W. Broadway Street, Oviedo, Florida 32765.

5. On information and belief, Applicant filed Application Serial Number 85/458,812 (the “Application”), on October 28, 2011, to register the word plus design mark “I CHOOSE” in connection with “Educational publications, namely, learning cards, flash cards, activity cards, workbooks, textbooks, activity books, story books, puzzle books, printed puzzles, teacher guides, training manuals, posters and educational booklets in the fields of social-emotional learning,” in International Classification 016. The Application was published in the October 2, 2012 issue of the *Official Gazette*.

6. Opposer’s use of the I CHOOSE mark long predates Applicant’s filing date of October 28, 2011 for the word plus design mark I CHOOSE.

7. Opposer has invested substantial sums in advertising and promoting both the goods and services under its I CHOOSE mark. Based on the extensive, substantially exclusive and continuous use of the I CHOOSE mark by Opposer, the relevant consuming public has come to recognize, and does recognize, the I CHOOSE mark as being used by Opposer and to associate and identify Opposer's goods and services. Opposer has therefore established valuable goodwill and exclusive rights in its mark.

8. Applicant's stylized I CHOOSE mark is confusingly similar in appearance, sound, and meaning to Opposer's I CHOOSE mark and when the marks are applied to goods similar to those offered by Opposer, they are likely to be confused with Opposer's mark and mistaken for them.

9. More specifically, Applicant's proposed mark is confusingly similar in terms of appearance, because Applicant merely adds a shaded circle around the term "I." Applicant's proposed mark is identical with respect to the sound of the marks, and the mere addition of the shaded circle around the term "I" does not distinguish the commercial impression of the Applicant's mark from that of Opposer's mark. Based on these factors, the Applicant's mark is confusingly similar to Opposer's mark within the meaning of Section 2(d) of the Trademark Act.

10. On information and belief, the goods sold by the Opposer and Applicant and their channels of trade are similar, and such goods are sold to and marketed to the same or similar class of purchasers.

11. Applicant's mark is so similar to Opposer's mark so as to be likely to create confusion and deceive purchasers into believing that Applicant's goods and/or services originate with or are in some way sponsored, endorsed, licensed, associated, or otherwise authorized or connected with Opposer. Such confusion would irreparably harm and damage Opposer because

Opposer has no control over the nature or quality of the goods provided or produced by Application under the Applicant's stylized I CHOOSE mark.

12. Based on documents in Opposer's possession, Applicant knew of Opposer's mark prior to its application for registration. Specifically, an individual who openly works with and for Applicant *purchased* I CHOOSE goods from Opposer more than forty-five (45) days prior to the date Applicant filed the instant application.

13. Based on the foregoing, Applicant knew it did not have rights in the subject mark of the Application and Applicant submitted its application to the United States Patent and Trademark Office.

14. Applicant knew of Opposer's mark, its goods and services, and that the mark that Applicant was applying for was too similar to Opposer's mark at the time that it was applying for Applicant's mark.

15. Applicant knew that the existence of Opposer's mark was a material fact for the Examining Attorney, and failed to disclose the existence of Opposer's mark to the USPTO at the time of its application, and concealed such fact so as to mislead the Examining Attorney into believing that Applicant was entitled to registration on the principal register.

16. Specifically, Applicant knew at the time it signed the declaration under oath, that to the best of Applicant's knowledge and belief:

no other person, firm corporation, or association has the right to use the mark in commerce, either in identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her knowledge are true; and that all statements made on information and belief are believed to be true;

was false. (emphasis added)

17. Applicant, in bad faith, made material, false statements with the intent to induce authorized agents of the USPTO to issue a registration, and reasonably relying on the truth of said false statements, the USPTO did, in fact, allow this Application for publication.

18. If Applicant is granted the registration opposed herein, it would obtain at least a *prima facie* exclusive right to the use of its mark, which would be a source of significant damage and injury to Opposer due to the similarity between Applicant's alleged mark and Opposer's mark.

19. Opposer would be irreparably harmed and suffer significant damages if Applicant is permitted to benefit from the fraud it has perpetrated on the USPTO and secure a registration on its stylized mark "I CHOOSE", as Opposer would not be allowed to engage in any business in the United States using the "I CHOOSE" trademark which Opposer has consistently utilized in commerce.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and Applicant's application to register the mark "I CHOOSE" be denied in all respects.

Dated: October 8, 2012

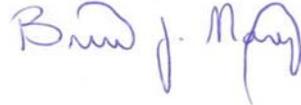
Respectfully Submitted,



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PROOF OF SERVICE

I HEREBY CERTIFY that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been electronically filed and furnished via U.S. Mail to Mr. Terry M. Sanks, Esquire; Beusse Wolter Sanks Mora & Maire, P.A., , Attorney for Applicant, 390 N. Orange Ave., Suite 2500; Orlando, FL 32801-1683 this 8th day of October 2012.



BRITTANY J. MAXEY, ESQUIRE