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

Proceeding	91229918
Party	Defendant Columbia Insurance Company
Correspondence Address	LISA A. IVERSON NEAL & MCDEVITT, LLC 1776 ASH STREET NORTHFIELD, IL 60093  pto@nealmcdevitt.com
Submission	Answer
Filer's Name	Jeffrey T. Norberg
Filer's e-mail	jnorberg@nealmcdevitt.com, docketing@nealmcdevitt.com
Signature	/s/ Jeffrey T. Norberg
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Lifetouch Inc.,  
Opposer,

v.

Columbia Insurance Company,  
Applicant.

Opposition No. 91229918

**ANSWER TO NOTICE OF OPPOSITION**

Columbia Insurance Company (“Applicant”), for its answer to the Notice of Opposition filed by Lifetouch Inc. (“Opposer”) against Applicant’s Application for registration of the trademark LIFETOUCH, Application Serial No. 86/790,036 (the “Application”), pleads as follows:

**ANSWER**

Preamble: Lifetouch Inc., a Minnesota corporation located at 11000 Viking Drive, Suite 400, Eden Prairie, Minnesota 55344 (hereinafter referred to as “Opposer”), believes that it will be damaged by the registration of Trademark Application Serial No. No. 86/790036 for the mark LIFETOUCH owned by Columbia Insurance Company (hereafter referred to as “Applicant”), and hereby opposes said registration. Opposer previously extended the time to oppose Applicant’s application. With the extensions granted, this Notice of Opposition is timely filed. The grounds for opposition are as follows:

**Answer to Preamble:** Answering the preamble on Page 1 of the Notice of Opposition, Applicant denies that Opposer will be damaged by the registration of Trademark Application Serial No. 86/790,036 for the mark LIFETOUCH. Applicant admits that Opposer previously extended the time to oppose the Application. Applicant is without information or belief sufficient to admit or deny the allegations

concerning the remainder of the allegations contained in the preamble, and on that basis, denies those allegations.

1. By the application herein opposed, Applicant seeks to obtain under the provisions of the Lanham Act, registration on the Principal Register of the designation LIFETOUCH for carpet padding in International Class 27 (“Applicant’s LIFETOUCH mark”).

**Answer to Paragraph 1:** Admitted.

2. Since at least as early as 1984, Opposer has been using the LIFETOUCH mark in connection with a broad offering of products and services relating to photography, including personalized photo products, such as decorative as personalized tiles, wall décor, household items (e.g. mugs, water bottles, magnets, desk organizers), accessories for electronics and clothing. Opposer’s primary consumers include students, parents, churches, and businesses, among others.

**Answer to Paragraph 2:** Applicant is without information or belief sufficient to admit or deny the allegations contained in Paragraph 2 of the Notice of Opposition, and on that basis, denies those allegations.

3. Opposer is also actively involved in philanthropic work and is commonly thought of as a community partner. For example, Opposer contributes to child safety programs and scholarship awards, and provides gifts to many non-profit organizations, including the Target scholarship award, and provides gifts to many non-profit organizations, including the Target House at St. Jude Children’s Hospital.

**Answer to Paragraph 3:** Applicant is without information or belief sufficient to admit or deny the allegations contained in Paragraph 3 of the Notice of Opposition, and on that basis, denies those allegations.

4. Consumers are accustomed to associating Opposer with charitable programs affiliated with St. Jude Children’s Hospital, especially when encountering the LIFETOUCH brand in philanthropy.

**Answer to Paragraph 4:** Applicant is without information or belief sufficient to admit or deny the allegations contained in Paragraph 4 of the Notice of Opposition, and on that basis, denies those allegations.

5. Opposer owns numerous registrations and applications for its well-known family of LIFETOUCH marks, including the following, among others (collectively referred to herein as “Opposer’s LIFETOUCH marks” or “LIFETOUCH Marks”): [chart omitted]. Current printouts of information from

the electronic database records of the USPTO showing the current status and title of the registrations are attached hereto as Exhibit A.

**Answer to Paragraph 5:** Applicant admits that Opposer is the registered owner of the registrations and applications listed in the chart in Paragraph 5 and attached as Exhibit A of the Notice of Opposition, which registrations and applications speak for themselves. Applicant denies the remaining allegations of Paragraph 5.

6. The registrations listed in the above table have not been canceled, are valid, are in full force and effect, and are incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1115.

**Answer to Paragraph 6:** Applicant admits that the registrations listed in the table in Paragraph 5 are not listed as having been canceled by the United States Patent and Trademark Office. Applicant denies the remaining allegations of Paragraph 6 of the Notice of Opposition, to the extent such a denial is required.

7. Opposer has advertised and promoted its LIFETOUCH marks extensively. Opposer has also made substantial sales of products and services under said marks. As a result of such use and promotion, Opposer's LIFETOUCH marks have developed and represent valuable goodwill inuring to the benefit of Opposer.

**Answer to Paragraph 7:** Applicant is without information or belief sufficient to admit or deny the allegations contained in Paragraph 7 of the Notice of Opposition, and on that basis, denies those allegations.

8. Opposer's LIFETOUCH Marks are famous within the meaning of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), and became famous before Applicant filed Applicant's LIFETOUCH mark and/or commenced use of Applicant's LIFETOUCH mark.

**Answer to Paragraph 8:** Denied.

9. Opposer has priority with respect to the marks at issue in this proceeding. Opposer or its predecessors in interest adopted and commenced use of the term LIFETOUCH as a trademark long before Applicant adopted the LIFETOUCH mark. Opposer or its predecessors in interest's usage of Opposer's LIFETOUCH marks commenced over thirty (30) years prior to Applicant's filing date of its application.

**Answer to Paragraph 9:** Applicant denies that Opposer has priority with respect to the marks at issue in this proceeding. Applicant is without information or belief sufficient to admit or deny the remaining allegations contained in Paragraph 9 of the Notice of Opposition, and on that basis, denies those allegations.

10. Applicant's LIFETOUCH mark is confusingly and deceptively similar to Opposer's previously used and duly registered LIFETOUCH Marks.

**Answer to Paragraph 10:** Denied.

11. Applicant's LIFETOUCH mark is identical in appearance, sound and meaning to Opposer's LIFETOUCH standard character marks.

**Answer to Paragraph 11:** Denied.

12. Applicant's goods are also related to Opposer's goods and services. Opposer offers a variety of personalized home décor products, and has offered personalized floor coverings in the past. Consequently, carpet padding is related to Opposer's product offerings. In addition, carpet padding is within Opposer's natural zone of expansion.

**Answer to Paragraph 12:** Applicant denies that its goods are related to Opposer's goods and services. Applicant is without information or belief sufficient to admit or deny the remaining allegations contained in Paragraph 12 of the Notice of Opposition, and on that basis, denies those allegations.

13. Upon information and belief, Applicant, through a licensee, participates in a charitable program wherein a percentage of sales of LIFETOUCH carpet padding are donated to St. Jude Children's Research Hospital.

**Answer to Paragraph 13:** Admitted.

14. Applicant's sale of LIFETOUCH carpet padding in affiliation with a charity for St. Jude Children's Hospital is further likely to lead to source confusion in the marketplace.

**Answer to Paragraph 14:** Denied.

15. Upon information and belief, Opposer's and Applicant's products and services are sold and marketed, at least in part, in the same channels of trade to the same consumers or class of consumers.

**Answer to Paragraph 15:** Denied.

16. Due to the similarity between Applicant's LIFETOUCH mark, and the previously used and duly registered LIFETOUCH Marks, the related nature of the goods and services at issue, customers and potential customers are likely to believe that Applicant's goods are affiliated with, or sponsored by Opposer, resulting in a likelihood of confusion in the marketplace, and damage to Opposer.

**Answer to Paragraph 16:** Denied.

17. The use and registration by Applicant of the LIFETOUCH mark for Applicant's goods is likely to cause confusion or to cause mistake or deception in trade and among purchasers and potential purchasers, with Opposer's previously used and duly registered LIFETOUCH Marks, again resulting in damage to Opposer.

**Answer to Paragraph 17:** Denied.

18. Because of the related nature of the goods and services at issue, and the identical nature of the marks, use and registration of the term LIFETOUCH by Applicant is likely to cause confusion, mistake, or deception that Applicant's goods are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.

**Answer to Paragraph 18:** Denied.

19. Applicant's use and registration of the LIFETOUCH mark is likely to dilute the distinctive quality of Opposer's famous LIFETOUCH Marks, again resulting in damage to Opposer.

**Answer to Paragraph 19:** Denied.

20. Registration of the mark shown in Application Serial No. 86/790036 will cause damage to Opposer under the provisions of Section 2 of the U.S. Trademark Act, 15 U.S.C. Section 1052, pursuant to the allegations stated above.

**Answer to Paragraph 20:** Denied.

WHEREFORE, Applicant requests that the Notice of Opposition be dismissed in its entirety and that judgment be entered against Opposer and in favor of Applicant.

Respectfully submitted,

Date: October 17, 2016

/Jeffrey T. Norberg/\_\_\_\_\_

Lisa A. Iverson  
Jeffrey T. Norberg  
Neal & McDevitt, LLC  
1776 Ash Street  
Northfield, IL 60093  
(847) 441-9100  
[lisa.iverson@nealmcdevitt.com](mailto:lisa.iverson@nealmcdevitt.com)  
[jnorberg@nealmcdevitt.com](mailto:jnorberg@nealmcdevitt.com)  
[docketing@nealmcdevitt.com](mailto:docketing@nealmcdevitt.com)  
Attorneys for Applicant

## CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** has this 17th day of October 2016 been sent by prepaid first class mail to the below-identified attorney for Opposer at his place of business:

Scott W. Johnston  
Merchant & Gould P.C.  
P.O. Box 2910  
Minneapolis, MN 55402-0910

/Jeffrey T. Norberg/\_\_\_\_\_