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

Proceeding	92062783
Party	Defendant First Opinion Corporation
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

FIRST OPINION, INC.,
Petitioner,

v.

FIRST OPINION CORPORATION,
Registrant.

Cancellation No. 92062783

**AMENDED ANSWER TO PETITION FOR CANCELLATION AND AFFIRMATIVE
DEFENSES**

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

First Opinion Corporation (“Registrant”), hereby submits amended answer to the Petition for Cancellation filed by First Opinion, Inc., (“Petitioner”) against Registrant’s U.S. Registration Nos. 1,335,327 and 1,644,040 for the marks FIRST OPINION (“FIRST OPINION Marks”) in connection with “pre-recorded computer programs” in International Class 9 and in connection with “computerized medical diagnostic and advice services” in International Class 42, respectively.

1. Answering Paragraph 1 of the Petition to Cancel, Registrant is without sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained therein, and accordingly denies the allegations set forth in Paragraph 1.

2. Answering Paragraph 2 of the Petition to Cancel, Registrant is without sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained therein, and accordingly denies the allegations set forth in Paragraph 2.

3. Answering Paragraph 3 of the Petition to Cancel, Registrant admits the allegations set forth in Paragraph 3 of the Petition to Cancel.

4. Answering Paragraph 4 of the Petition to Cancel, Registrant admits the allegations set forth in Paragraph 4 of the Petition to Cancel.

5. Answering Paragraph 5 of the Petition to Cancel, Registrant admits the allegations set forth in Paragraph 5 of the Petition to Cancel.

6. Answering Paragraph 6 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 6 of the Petition to Cancel.

7. Answering Paragraph 7 of the Petition to Cancel, Registrant denies the allegation set forth in Paragraph 7 of the Petition to Cancel that “Petitioner [sic] fraudulently filed” the “Combined Declaration of Use and Renewal Registration” and denies the allegation set forth in Paragraph 7 that “there was no use of the FIRST OPINION Marks at that time to support renewal of the Second Registration.” Registrant denies that Exhibit B is “made part of the record” as set forth in Paragraph 7 of the Petition to Cancel.

8. Answering Paragraph 8 of the Petition to Cancel, Registrant is without sufficient knowledge or information to form a belief as to the truth or falsity of the allegations contained therein, and accordingly denies the allegations set forth in Paragraph 8.

9. Answering Paragraph 9 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 9 of the Petition to Cancel.

10. Registrant re-asserts its responses to Paragraphs 1 through 9 of this Petition for Cancellation.

11. Answering Paragraph 11 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 11 of the Petition to Cancel.

12. Answering Paragraph 12 of the Petition to Cancel, Registrant admits the allegation set forth in Paragraph 12 of the Petition to Cancel that it did not file any Declaration and Renewal, but denies that this is evidence of the abandonment of the First Registration. Registrant denies that Exhibit C is “made part of the record” as set forth in Paragraph 12 of the Petition to Cancel.

13. Answering Paragraph 13 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 13 of the Petition to Cancel that the “Declaration and Renewal was fraudulently filed because there was no use to support the Second Registration at that time.” Registrant denies that Exhibit D is “made part of the record” as set forth in Paragraph 13 of the Petition to Cancel.

14. Answering Paragraph 14 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 14 of the Petition to Cancel.

15. Answering Paragraph 15 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 15 of the Petition to Cancel that “Registrant has not used its Website or any other website or social media for the FIRST OPINION Marks since at least as early as 2004.” Registrant denies that Exhibit E is “made part of the record.” Furthermore, to the extent that this allegation is or may be based on alleged facts that Registrant’s specimen submitted with its Section 8 Declaration is somehow deficient and should not have been accepted by the Examining Attorney, Registrant believes that such an attack is inappropriate. The

Trademark Trial and Appeal Board (“TTAB”) has previously observed in a similar context that “fairness dictates that the *ex parte* question of the sufficiency of the specimen not be the basis for sustaining an opposition.” *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989). *See also, Granny’s Submarine Sandwiches, Inc. v. Granny’s Kitchen, Inc.*, 199 USPQ 564, 567-68 (TTAB 1978).

16. Answering Paragraph 16 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 16 of the Petition to Cancel. Registrant also denies the implied allegations that Registrant abandoned the FIRST OPINION Marks.

17. Answering Paragraph 17 of the Petition to Cancel, Registrant admits Iliff is the President of Registrant, that he shares the same address as Registrant, and that on November 16, 2015, Iliff filed an intent-to-use application under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b), for the FIRST OPINION Marks in connection with “computer software for providing medical advice” in International Class 9 (“Intent-to-Use Application”). Registrant further admits that this Intent-to-Use Application was assigned Serial No. 86822045. Registrant denies that Application Serial No. 86822045 is “nearly identical” to the goods and services listed in the Registrations. Registrant denies that Registrant filed Application Serial No. 86822045 through Iliff to obtain a “duplicate” registration and also denies the allegations that Registrant has abandoned the Registrations through non-use for at least the past three years.

18. As Paragraph 18 purports to be a legal statement, and as there are no allegations in this paragraph, no response from Registrant is required to Paragraph 18 of the Petition to Cancel.

19. Answering Paragraph 19 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 19 of the Petition to Cancel.

20. Answering Paragraph 20 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 20 of the Petition to Cancel.

21. Registrant re-asserts its responses in Paragraphs 1 through 20 of this Petition for Cancellation.

22. As Paragraph 21 purports to be a legal statement, and as there are no allegations in this paragraph, no response from Registrant is required to Paragraph 21 of the Petition to Cancel.

23. Answering Paragraph 23 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 23 of the Petition to Cancel.

24. Answering Paragraph 24 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 24 of the Petition to Cancel.

25. Answering Paragraph 25 of the Petition to Cancel, Registrant admits the allegations set forth in Paragraph 25 of the Petition to Cancel.

26. Answering Paragraph 26 of the Petition to Cancel, Registrant admits the allegations set forth in Paragraph 26 of the Petition to Cancel.

27. Answering Paragraph 27 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 27 of the Petition to Cancel.

28. Answering Paragraph 28 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 28 of the Petition to Cancel.

29. Answering Paragraph 29 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 29 of the Petition to Cancel.

30. Answering Paragraph 30 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 30 of the Petition to Cancel.

31. Answering Paragraph 31 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 31 of the Petition to Cancel.

32. Answering Paragraph 32 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 32 of the Petition to Cancel.

33. Answering Paragraph 33 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 33 of the Petition to Cancel.

34. Answering Paragraph 34 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 34 of the Petition to Cancel.

35. Answering Paragraph 35 of the Petition to Cancel, Registrant denies the allegations set forth in Paragraph 35 of the Petition to Cancel.

AFFIRMATIVE DEFENSES

Registrant moves to amend its description of services in the alternative under Section 18. There may also be affirmative defenses to the claims alleged by Petitioner that are currently unknown to Registrant. Therefore, Registrant reserves the right to amend its Answer to allege any additional affirmative defenses currently unknown to Registrant, in the event that discovery of additional information indicates that they are appropriate.

FIRST AFFIRMATIVE DEFENSE

Registrant moves to amend its identification of services in the alternative under Section 18 in the event the TTAB finds that such a restriction is appropriate to either avoid a likelihood of confusion between the Petitioner's pending application or to qualify the use that Registrant has made of its mark FIRST OPINION. Registrant moves to amend the registration to narrow or limit the identification of the services in Registration No. 1644040 which currently reads

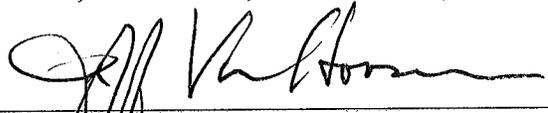
“computerized medical diagnostic and advice services” to either “computerized medical diagnostic and advice services provided to doctors and medical personnel” or “computerized medical diagnostic and advice services, excluding providing advice as to health, wellness or medical information.” Under the Lanham Act Section 18, the Trademark Trial and Appeal Board is given the equitable power to restrict the services in a trademark registration and may serve as affirmative defense to the claims alleged. Petitioner alleges that it is harmed by Registrant’s registration and also that the Registrant has not used the mark FIRST OPINION as to “computerized medical diagnostic and advice services.” To the extent that Petitioner intends to continue to rely on such harm, and/or intends to rely on facts that Registrant’s services were more limited in nature, the amendments offered above would be appropriate defense.

WHEREFORE, Registrant prays that Petitioner’s Petition for Cancellation be dismissed in its entirety.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: April 22, 2016

By: 

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Attorneys for Registrant,
First Opinion Corporation

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **AMENDED ANSWER TO PETITION TO CANCEL AND AFFIRMATIVE DEFENSES** upon Petitioner's counsel by depositing one copy thereof in the United States Mail, first-class postage prepaid, on April 22, 2016, addressed as follows:

Thomas E. Zutic
DLA Piper LLP
500 Eighth Street NW
Washington, DC 20004

A handwritten signature in black ink, appearing to read "Julia Roberts", written in a cursive style.

Julia Roberts

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