

09/15/2003TTAB

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

VERILUX, INC.	)	Serial No. 76/396,211
	)	
Opposer,	)	Opposition No. 91156531
	)	
v.	)	Mark: INDOOR SUNSHINE
	)	
LINAYA GAIL HAHN,	)	Published in Official
	)	Gazette January 14, 2003
Applicant.	)	

**APPLICANT’S ANSWER TO NOTICE OF OPPOSITION**

Applicant LINAYA GAIL HAHN (“Applicant”) hereby answers the Notice of Opposition filed in connection with the above-captioned cause as follows:

Notice of Opposition - ¶ 1

Applicant seeks to register INDOOR SUNSHINE as a trademark for use with respect to “full spectrum lighting products, namely wall lights, illuminating light boxes, fluorescent lighting tubes, and electric light bulbs” in class 11 (hereinafter “Applicant’s goods”) with the filing of an intent-to-use application.

Answer - ¶ 1

Admitted, but applicant further states that the application was erroneously filed as a Section 1(b) intent-to-use, and that the mark subject to the application has in fact been used in commerce since November, 1989. Applicant was in the process of amending the application when this Notice of Opposition was filed.

Notice of Opposition - ¶ 2

Applicant's application for INDOOR SUNSHINE was filed as an intent-to-use application on April 10, 2002 and was awarded Ser. No. 76/396,211.

Answer - ¶ 2

Applicant admits that it filed an intent-to-use application for INDOOR SUNSHINE on April 10, 2002, but further states that it subsequently undertook efforts at amending this application on February 27, 2003, when it amended its statement of use over three months before this opposition was instituted for this proceeding.

Notice of Opposition - ¶ 3

Since 1956 Opposer has been engaged in the business of manufacturing and distributing full spectrum lighting products including, but not limited to, light bulbs, full spectrum fluorescent tubes, light therapy systems, and lamps (hereinafter "Opposer's goods").

Answer - ¶ 3

Applicant presently lacks knowledge sufficient to admit or deny the allegations in Paragraph Three (3).

Notice of Opposition - ¶ 4

Opposer has used, since at least as early as November 1, 1998, and continues to use in commerce, the mark SUNSHINE STIMULATOR for "electrical lighting fixtures," which mark has been awarded Ser. No. 75/914,223 with a filing date of February 9, 2000, and published for opposition.

Answer - ¶ 4

Applicant presently lacks sufficient knowledge to admit or deny the allegations in Paragraph Four (4) regarding Opposer's use of the SUNSHINE STIMULATOR mark in commerce. Applicant admits that the United States Patent and Trademark Office awarded and published for opposition the SUNSHINE STIMULATOR mark, with Ser. No. 75/914,223 and filing date February 9, 2000.

Notice of Opposition - ¶ 5

Opposer has used, since at least as early as June 1, 1999, and continues to use in commerce, the mark SUNSHINE IN A BOX for "full spectrum lighting systems consisting of electric lighting fixtures, or fluorescent lighting tubes, or incandescent light bulbs," which has been awarded Registration No. 2,379,703 with an issue date of August 22, 2000.

Answer - ¶ 5

Applicant presently lacks sufficient knowledge to admit or deny the allegations in Paragraph Five (5) regarding Opposer's use of the SUNSHINE IN A BOX mark in commerce. Applicant admits that the United States Patent and Trademark Office awarded the SUNSHINE IN A BOX mark Registration No. 2,379,703 for "full spectrum lighting systems consisting of electric lighting fixtures, or fluorescent lighting tubes, or incandescent light bulbs."

Notice of Opposition - ¶ 6

Opposer has used, since at least as early as September, 2000, and continues to use in commerce, the mark SUNSHINE IN A LAMP for "apparatus for lighting, namely,

desk lamps and floor lamps,” which has been awarded Ser. No.76/433,554 with a filing date of July 24, 2002, and published for opposition.

Answer - ¶ 6

Applicant presently lacks sufficient knowledge to admit or deny the allegations in Paragraph Six (6) regarding Opposer’s use of the SUNSHINE IN A LAMP mark in commerce. Applicant admits that the United States Patent and Trademark Office awarded and published for opposition the SUNSHINE IN A LAMP mark, with Ser. No.76/433,554 and filing date February 9, 2000.

Notice of Opposition - ¶ 7

The marks SUNSHINE SIMULATOR, SUNSHINE IN A BOX, and SUNSHINE IN A LAMP, taken as a whole, form Opposer’s Family of SUNSHINE marks.

Answer - ¶ 7

Applicant presently lacks knowledge or information sufficient to affirm or deny the statements contained in Paragraph Seven (7).

Notice of Opposition - ¶ 8

Opposer claims common-law rights in and to Opposer’s Family of SUNSHINE marks.

Answer - ¶ 8

Applicant presently lacks knowledge or information sufficient to affirm or deny the statements contained in Paragraph Eight (8).

Notice of Opposition - ¶ 9

By virtue of Opposer’s use in commerce of Opposer’s Family of SUNSHINE marks in the United States in connection with Opposer’s goods, the relevant trade and

public have come to associate such goods bearing Opposer's Family of SUNSHINE marks with Opposer.

Answer - ¶ 9

Denied.

Notice of Opposition - ¶ 10

Opposer's dates of first use and/or the filing dates of Opposer's Family of SUNSHINE marks in connection with Opposer's goods predates Applicant's filing date for the application to register INDOOR SUNSHINE herein opposed.

Answer - ¶ 10

Applicant presently lacks knowledge or information sufficient to affirm or deny the statements contained in Paragraph Eight (10).

Notice of Opposition - ¶ 11

On information and belief, Applicant's goods and Opposer's goods are substantially similar and related.

Answer - ¶ 11

Denied.

Notice of Opposition - ¶ 12

Applicant's INDOOR SUNSHINE mark, as applied to Applicant's goods set forth in the application herein opposed, so resembles Opposer's Family of SUNSHINE marks as applied to Opposer's goods that it is likely to cause confusion, mistake and/or deception.

Answer - ¶ 12

Denied.

Notice of Opposition - ¶ 13

The respective marks are nearly identical in sound and appearance.

Answer - ¶ 13

Denied, further stating that the allegations in Paragraph 13 are made in bad faith. Opposer did not attempt to use the mark INDOOR SUNSHINE until after the opposition was filed.

Notice of Opposition - ¶ 14

The mark, INDOOR SUNSHINE, as used by Applicant, incorporates a prominent portion of Opposer's Family of SUNSHINE marks, i.e., the word "sunshine."

Answer - ¶ 14

Applicant denies the allegations contained in Paragraph Fourteen (14), further stating that Opposer is not entitled to the exclusive use of the word "sunshine"

Notice of Opposition - ¶ 15

If Applicant is permitted to register INDOOR SUNSHINE for Applicant's goods, confusion of the trade and public is likely to result, such confusion resulting in damage and injury to Opposer.

Answer - ¶ 15

Applicant denies the allegations contained in Paragraph Fifteen (15).

Notice of Opposition - ¶ 16

If Applicant is permitted to register INDOOR SUNSHINE for the goods set forth in the application herein opposed, confusion of the relevant trade and public resulting in damage and injury to Opposer would be likely to result. Any persons familiar with the goods of Opposer would be likely to assume, in error, that Applicant's goods are goods

sponsored by or produced under license from or otherwise affiliated with Opposer, or as goods that are a part of Opposer's line of products.

Answer - ¶ 16

Applicant denies the allegations contained in Paragraph Sixteen (16).

Notice of Opposition - ¶ 17

If Applicant is permitted to register INDOOR SUNSHINE for the goods set forth in the application herein opposed, any defect, objection to or fault found with Applicant's goods sold under that mark would necessarily reflect on and seriously injure the reputation that Opposer has established for its goods sold under Opposer's Family of SUNSHINE marks.

Answer - ¶ 17

Applicant denies the allegations contained in Paragraph Seventeen (17).

Notice of Opposition - ¶ 18

If Applicant were granted a registration for INDOOR SUNSHINE, the mark herein opposed, it would obtain thereby at least a *prime facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Opposer.

Answer - ¶ 18

Applicant denies that the registration of INDOOR SUNSHINE would be a source of damage and injury to Opposer.

WHEREFORE, Applicant prays that registration of the mark of Application No.

76/396,211 be granted and that this opposition be denied.

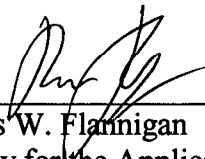
**AFFIRMATIVE DEFENSES**

- 1.) For its first affirmative defense, Applicant alleges that the Notice of Opposition fails to state a claim upon which relief can be granted under the Lanham Act.
- 2.) For its second affirmative defense, Applicant alleges that Opposer has failed to mitigate his damages, if any.
- 3.) For its third affirmative defense, Applicant alleges that Opposer's claims are barred by the doctrine of waiver.
- 4.) For its fourth affirmative defense, Applicant alleges that Opposer's claims are barred by the doctrine of equitable estoppel.
- 5.) For its fifth affirmative defense, Applicant alleges that Opposer's claims are barred by the doctrine of acquiescence.
- 6.) For its sixth affirmative defense, Applicant alleges that Opposer's claims are barred by the doctrine of abandonment.
- 7.) For its seventh affirmative defense, Applicant alleges that the claims are barred for the reason that Opposer has not attained fame for its mark within the meaning of 15 U.S.C. 1125(c). Opposer initiated use of the mark INDOOR SUNSHINE after July, 2003, when changes were made in Opposer's web page to reflect INDOOR SUNSHINE. Opposer's printed materials have not been changed to reflect INDOOR SUNSHINE. Opposer's metatags have not been changed to reflect use of the mark INDOOR SUNSHINE.
- 8.) For its eighth affirmative defense, Applicant alleges that Applicant disclaimed all use of the word "sunshine" except as it pertains to the mark INDOOR SUNSHINE.



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Respectfully submitted,  
Linaya Gail Hahn

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**CERTIFICATE OF MAILING**  
 37 C.F.R. § 1.10  
 I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail to the addressee named below before 5:00 p.m. on the date of August 26, 2003.

By:   
 Thomas Flannigan

08-28-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #58

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
Box TTAB Fee

By UPS—Second Day Air

Dear Sir or Madam:

Enclosed please find our answer to the Notice of Opposition filed in reference to the above-captioned matter.

On July 14, 2003, I moved for an extension of time which the Board has not yet ruled on. As I explained in that motion, my wife, 44 years of age, gave birth on August 13, 2003. This has required significant amounts of my attention. Since I am a sole practitioner who is unable to delegate my work, the answer that is enclosed herein is being filed slightly delayed. I apologize for any inconvenience that this may have caused the Board.

Respectfully submitted,

Thomas Flannigan

Encl.  
Cc: Wesley W. Whitmyer Jr.

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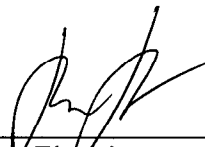
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**CERTIFICATE OF SERVICE**

The undersigned, an attorney, certifies that the Answer to Notice of Opposition was served on the attorney representing the Opposer by placing a copy in the U.S. mail at Three First National Plaza, 70 W. Madison St., Chicago, Illinois, with postage prepaid, before the hour of 5:00 p.m. on August 26, 2003.

  
 \_\_\_\_\_  
 Thomas Flannigan