

07/24/2003TTAB

TTAB

LAW OFFICES OF THOMAS FLANNIGAN

70 WEST MADISON STREET, SUITE 5330

CHICAGO, ILLINOIS 60602

TELEPHONE (312) 236-9335

FACSIMILE (312) 236-9339

E-MAIL: PASSPORT@PRODIGY.NET



07-15-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

July 11, 2003

156,531

Box TTAB No Fee

Assistant Commissioner for Trademarks

ATTN: Team A (Jill Taylor, Andrew Bagsly, Cindy Greenbaum)

2900 Crystal Drive

Arlington, VA 22202-3513

Re: Opposition pending for INDOOR SUNSHINE (Serial No. 76396211)

Dear Sir or Madam:

I am an attorney representing an individual seeking to obtain a trademark for the above-stated matter, and was instructed to contact you by our trademark examiner, Tracy Cross. An opposition to our INDOOR SUNSHINE mark has recently been filed and it seems that administrative infirmities within the PTO have prevented one of our filings from being processed properly.

Below I have set forth a chronology of the correspondence that relate to this matter, all of which are enclosed with this letter:

- 1.) April 10, 2002 – INDOOR SUNSHINE trademark was filed with the USPTO as a Section 1(b) “intent to use” application;
- 2.) February 27, 2003 – “Statement of Use” amendment mailed establishing use of INDOOR SUNSHINE in commerce since January 1, 2003 sent via UPS Second Day Air (Tracking Number: 1ZF A5 876 37 1000 007 4);
- 3.) March 31, 2003 – Inquiry to the trademark examiner as to why Statement of Use was not entered into system;
- 4.) April 14, 2003 – Second inquiry as to why the TARR system showed receipt of papers while the Statement of Use was not specifically entered into the system;
- 5.) June 6, 2003 – Opposition instituted for INDOOR SUNSHINE; and
- 6.) July 8, 2003 – TARR system search revealed that our Statement of Use amendment was still not processed, but “PAPER RECEIVED” entries for March 3, 2003, April 3, 2003, and April 17, 2003, indicate that the Statement of Use was received prior to the opposition.

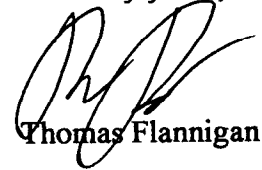
07/24/2003 TTAB

Numerous phone conversations with our trademark examiner have revealed that it was a processing backlog in the PTO which prevented our Statement of Use from being processed expeditiously. We were told that our filing would be processed and retroactive to the date of receipt. As of July 9, 2003, however, the trademark examiner informed me that she cannot complete the filing because she has lost jurisdiction over the file due to the pending TTAB proceeding. I have since been directed to speak with you.

As you can see from the above chronology, our Statement of Use was filed *prior to the opposition*. I understand that jurisdiction is lost when an opposition is filed, but it makes no sense why the Opposition should have been processed before our Statement of Use. Moreover, if the Statement of Use is not fully processed, the effects on the pending TTAB proceeding will be significant.

At your earliest convenience, could you please contact my office in regards to this matter? I thank you in advance for your prompt attention to this matter.

Sincerely yours,



Thomas Flannigan

TWF: tm
Encl.
cc: Tracy Cross
Tina Craven
Linaya Hahn

07/24/2003TTAB

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TELEPHONE (312) 236-9335

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E-MAIL: FLANNIGANT@AOL.COM

April 10, 2002

Commissioner for Trademarks
Box New App/Fee
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Trademark Application for INDOOR SUNSHINE

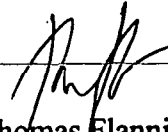
Dear Commissioner:

I am the attorney for Linaya Gail Hahn, the applicant in the above-captioned matter. Please address all correspondence and related forms for this matter to the above address. Enclosed please find the following items for registration of the trademark:

1. A completed, signed and dated Trademark application;
2. A drawing page with required heading;
3. A check in the amount of \$325.00 payable to the Commissioner of Patents and Trademarks.

If you have any questions please do not hesitate to contact me.

Yours sincerely,



Thomas Flannigan

TWF: aa
Enclosures
cc: Linaya Gail Hahn

07/24/2003TTAB

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TELEPHONE (312) 236-9335

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February 27, 2003

BY UPS 2nd DAY AIR

United States Patent and Trademark Office
Assistant Commissioner for Trademarks
ATTN: Tracy Cross (Law Office 103)
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Statement of Use for INDOOR SUNSHINE (Serial No.: 76396211)

Dear Ms. Cross:

Please find enclosed a Statement of Use as required with a §1(b) Intent to Use Application for the trademark INDOOR SUNSHINE.

Per the fee for this statement, please bill my credit card for the total fee of \$100:
Cardholder: Thomas Flannigan; Visa # 4388 5230 1830 0165; Expiration date: 04/05.

If you have any questions or comments, please do not hesitate to contact me.

Sincerely yours,


Thomas Flannigan

TWF: mb
Encl.



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| Tracking Number | Status | Delivery Information | |
|---|-----------|----------------------|--------------------|
| 1. 1Z FA5 876 37 1000 007 4 Detail | Delivered | Delivered on: | Mar 3, 2003 9:24 A |
| | | Delivered to: | ARLINGTON, VA, U |
| | | Signed by: | RATSHACK |
| | | Service Type: | 2ND DAY AIR |

Tracking results provided by UPS: Apr 11, 2003 11:25 A.M. Eastern Time (USA)

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1 **F A 5 8 7 6**

TELEPHONE: **Thomas Flannigan 312-236-9335**

LAW OFC THOMAS FLANNIGAN

70 W MADISON AVE., SUITE 5330

CHICAGO IL **60602 4214**

2 TELEPHONE Ext. 224
Ms. Tracy Cross (703) 308-9103

Assis. Commissioner for Trademarks

2900 Crystal Drive

Arlington, VA 22202-3513

3 WEIGHT DIMENSIONAL WEIGHT

4 2ND DAY AIR CHARGE \$

5 OPTIONAL SERVICES

SATURDAY PICKUP

DECLARED VALUE \$ AMOUNT

C.O.D. \$ AMOUNT

An Additional Handling Charge applies for certain items. See instructions.

6 ADDITIONAL HANDLING CHARGE \$

7 METHOD OF PAYMENT

BILL SHIPPER

BILL RECEIVER

BILL THIRD PARTY

CREDIT CARD

American Express

Diner's Club

MasterCard

Visa

CHECK

8 RECEIVERS / THIRD PARTYS UPS ACCT. NO. OR MAJOR CREDIT CARD NO. EXPIRATION DATE

THIRD PARTY'S COMPANY NAME

STREET ADDRESS

CITY AND STATE ZIP CODE

9 X *[Signature]* DATE OF SHIPMENT 02/13/03

The shipper declares that the released value of each package is \$100, which is the maximum liability for loss or damage to the contents of the package. The shipper is responsible for the value of the contents of the package. The maximum liability for loss or damage to the contents of the package is \$100, which is the maximum liability for loss or damage to the contents of the package. The maximum liability for loss or damage to the contents of the package is \$100, which is the maximum liability for loss or damage to the contents of the package.

RTO/TM/1553 (Rev 4/2000)
OMB No. 0651-0009 (Exp. 08/31/2004)

07/24/2003TTAB

*** Trademark/Service Mark Allegation of Use ***

*** (Statement of Use/Amendment to Allege Use) ***

*** (15 U.S.C. §1051(c) or (d)) ***

*** To the Commissioner for Trademarks ***

<DOCUMENT INFORMATION>

<TRADEMARK/SERVICEMARK ALLEGATION OF USE>

<VERSION 1.2>

<TRADEMARK/SERVICEMARK INFORMATION>

<MARK> "INDOOR SUNSHINE"

<SERIAL NUMBER> 76396211

<LAW OFFICE ASSIGNED> TMEG Law Office 103

<APPLICANT INFORMATION>

<NAME> Linaya Gail Hahn

<STREET> 942 Twisted Oak Lane

<CITY> Buffalo Grove

<STATE> IL

<COUNTRY> USA

<ZIP/POSTAL CODE> 60089

<GOODS AND SERVICES INFORMATION>

<ALL GOODS AND/OR SERVICES IN APPLICATION/NOTICE OF ALLOWANCE> Yes

~ The applicant is using or is using through a related company the mark in commerce on or in connection with all the goods/services listed in the Application/Notice of Allowance. ~

<FEE INFORMATION>

<TOTAL FEES PAID> 100

<NUMBER OF CLASSES> 1

<USE INFORMATION>

<SPECIMEN DESCRIPTION> Drawing page showing a door opening and a curved arrow, entering the door over the word mark "INDOOR SUNSHINE"

<FIRST USE ANYWHERE DATE> 11/01/1989

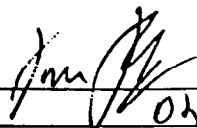
<FIRST USE IN COMMERCE DATE> 01/01/2003

<SIGNATURE AND OTHER INFORMATION>

~ **Declaration:** Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq., as amended). Applicant is the owner of the mark sought to be registered, and is using or is using through a related company the mark in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. ~

07/24/2003 TAB

The undersigned being hereby warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of this document, declares that he/she is properly authorized to execute this document on behalf of the Owner; and all statements made of his/her own knowledge are true and that all statements made on information and belief are believed to be true. ~

<SIGNATURE>  * please sign here*
<DATE> 02-27-03
<NAME> Thomas Flannigan
<TITLE> Attorney for Applicant
<TELEPHONE NUMBER> 312-236-9335
<E-MAIL ADDRESS> passport@prodigy.net

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

on 02-27-03

Date



Signature

Thomas Flannigan

Typed or printed name of person signing certificate

07/24/2003TTAB

LAW OFFICES OF THOMAS FLANNIGAN

70 WEST MADISON STREET, SUITE 5330

CHICAGO, ILLINOIS 60602

TELEPHONE (312) 236-9335

FACSIMILE (312) 236-9339

E-MAIL: FLANNIGANT@AOL.COM

March 31, 2003

United States Patent and Trademark Office
Assistant Commissioner for Trademarks
ATTN: Tracy Cross (Law Office 103)
2900 Crystal Drive
Arlington, VA 22202-3513

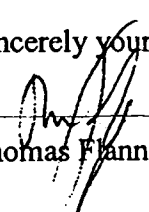
Re: Statement of Use for INDOOR SUNSHINE (Serial No.: 76396211)

Dear Ms. Cross:

On February 27, 2003, I sent a correspondence to your office requesting that the enclosed Statement of Use be filed for the trademark INDOOR SUNSHINE, as required with a §1(b) Intent to Use Application. The enclosed TARR report for the trademark does not reflect that the Statement of Use has been placed on file with your office, nor have I received a notification stating such.

At your earliest convenience, could you please verify that this Statement of Use has been filed, and contact me regarding same. I thank you in advance for your prompt response to this matter.

Sincerely yours,


Thomas Flannigan

TWF: mb

Encl.

Cc: Linaya Hahn

07/24/2003TTAB

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E-MAIL: PASSPORT@PRODIGY.NET

April 14, 2003

United States Patent and Trademark Office
Assistant Commissioner for Trademarks
ATTN: Tracy Cross (Law Office 103)
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Statement of Use for INDOOR SUNSHINE (Serial No.: 76396211)

Dear Ms. Cross:

We have previously sent you two correspondences as well as a Statement of Use pertaining to our intent to use application for registration of the trademark INDOOR SUNSHINE. (These correspondences and the Statement of Use have been enclosed).

We have yet to receive notification from your office regarding the filing of this Statement. As well, a recent review of the enclosed TARR report for the trademark does not reflect the filing. I would ask that you please review your records pertaining to the trademark, and contact me as soon as possible to discuss our Statement of Use.

Sincerely yours,


Thomas Flannigan

TWF: mb
Encl.

07/24/2003TTAB

TTAB

OPPOSITION
03031-N0055A WWW/KGB

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

| | |
|-------------------|---|
| -----X |) |
| VERILUX, INC., |) |
| |) |
| Opposer, |) |
| |) |
| v. |) |
| |) |
| LINAYA GAIL HAHN, |) |
| |) |
| Applicant. |) |
| -----X |) |

~~U.S. PATENT & TRADEMARK OFFICE~~

05-16-2003

U.S. Patent & TMOs/TM Mail Rpt. Ct. #40

Opposition No. _____

In Re: Trademark Application

| | | |
|-----------|---|------------------|
| Applicant | : | LINAYA GAIL HAHN |
| Ser. No. | : | 76/396,211 |
| Filed | : | April 10, 2002 |
| Trademark | : | INDOOR SUNSHINE |
| Published | : | January 14, 2003 |

NOTICE OF OPPOSITION

In the matter of trademark application Serial No. 76/396,211, filed April 10, 2002 and published for opposition in the Official Gazette of January 14, 2003:

NOW COMES VERILUX, INC., a Connecticut corporation, having a principal place of business at 9 Viaduct Road, Stamford, CT 06907 (hereinafter "Opposer"), by its duly authorized attorneys, who believes it will be damaged by registration of the trademark INDOOR SUNSHINE, assigned Ser. No. 76/396,211 applied for by LINAYA GAIL HAHN, an individual residing at 942 Twisted Oak Lane Buffalo Grove IL 60089 (hereinafter "Applicant"), and hereby opposes same.

Certification of Mailing: I hereby certify that this correspondence is today being deposited with the U.S. Postal Service as first class mail in an envelope addressed to: Box TTAB-FEE, Assistant Commissioner of Trademarks; 2900 Crystal Drive; Arlington, VA 22202-3513.

May 13, 2003
Date

Anne Cassone
Anne Cassone

07/24/2003TTAB

The grounds for opposition are as follows:

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.
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.
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").
4. Opposer has used, since at least as early as November 1, 1998, and continues to use in commerce, the mark SUNSHINE SIMULATOR 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.
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.
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.
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.

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

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.

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.

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

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.

13. The respective marks are nearly identical in sound and appearance.

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."

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.

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

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otherwise affiliated with Opposer, or as goods that are a part of Opposer's line of products

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.

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

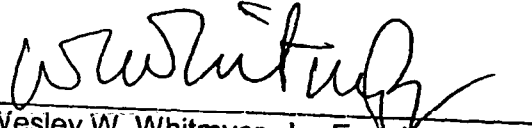
WHEREFORE, Opposer prays that registration of the mark of application No. 76/396,211 be refused and that this opposition be sustained.

A duplicate copy of this Notice of this Opposition is enclosed herewith.

Applicant is enclosing the United States Patent & Trademark Office Credit Card Payment form to cover the filing fee of \$300.00. Any additional fees or deficiencies deemed to be due and owing in connection with this opposition may be charged to Deposit Account No. 19-4516 and any overpayment may be credited thereto.

Respectfully submitted,
VERILUX, INC.

Date: May 13, 2003

By: 
Wesley W. Whitmyer, Jr., Esquire
Kathryn Grant Belleau, Esquire
St. Onge Steward Johnston & Reens LLC
986 Bedford Street
Stamford, CT 06905-5619
203 324-6155
Attorneys for Opposer

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-07-11 11:47:36 ET

Serial Number: 76396211

Registration Number: (NOT AVAILABLE)

Mark



(words only): INDOOR SUNSHINE

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2003-06-06

Filing Date: 2002-04-10

Registration Date: (DATE NOT AVAILABLE)

Law Office Assigned: LAW OFFICE 103

Attorney Assigned:
CROSS TRACY L Employee Location

Current Location: 845 - TT/AB

Date In Location: 2003-07-04

CURRENT APPLICANT(S)/OWNER(S)

1. Hahn, Linaya Gail

Address:

Hahn, Linaya Gail

942 Twisted Oak Lane

Buffalo Grove, IL 60089

United States

Country of Citizenship: United States

Legal Entity Type: Individual

Phone Number: 847-459-4455

Fax Number: 847-495-4492

GOODS AND/OR SERVICES

Full spectrum lighting products, namely wall lights, illuminating light boxes, fluorescent lighting tubes, and electric light bulbs

International Class: 011

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

Disclaimer: "INDOOR"

Description of Mark: The mark consists of the phrase "INDOOR SUNSHINE" and the logo as depicted on the attached drawing page.

PROSECUTION HISTORY

2003-06-06 - Opposition instituted for Proceeding

2003-04-17 - PAPER RECEIVED

2003-04-03 - PAPER RECEIVED

2003-03-03 - PAPER RECEIVED

2003-02-06 - Extension of time to oppose - Filed

2003-01-14 - Published for opposition

2002-12-25 - Notice of publication

2002-11-08 - Approved for Pub - Principal Register (initial exam)

2002-11-05 - Examiner's amendment mailed

2002-10-15 - Communication received from applicant

2002-10-15 - PAPER RECEIVED

2002-08-22 - Non-final action mailed

2002-08-09 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent (Owner)
Thomas Flannigan (Attorney of record)

THOMAS FLANNIGAN
LAW OFFICES OF THOMAS FLANNIGAN
70 WEST MADISON, SUITE 5330
CHICAGO, IL 60602

Phone Number: 312-236-9335
Fax Number: 312-236-9339
