

TTAB

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

INSPIRATION SOFTWARE, INC.)
)
Opposer,)
)
v.)
)
WINDSOR, TIFFANY M.)
)
Applicant.)

Opposition No. 91157769



04-16-2004

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

Box TTAB FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

Sir:

**OPPOSER'S OPPOSITION TO APPLICANT'S
MOTION FOR SUMMARY JUDGMENT**

Introduction

For reasons which follow, opposer Inspiration Software, Inc. ("Inspiration Software") requests that the Board deny Applicant's Motion for Summary Judgment as a Matter of Law filed and served by mail on March 9, 2004. Applicant's motion is supported by certain exhibits relating to records of the U.S. Patent and Trademark Office, but there are no affidavits/declaratuons about any facts.

The Board should deny applicant's motion because there are genuine issues of material fact concerning most of the pertinent factors upon which the Board makes a likelihood-of-confusion ("LOC") determination. Genuine issues of material fact exist concerning at least the

following LOC factors: similarity of the marks, goods/services, trade channels, strength of the mark, and applicant's intent in choosing the mark. Applicant provides no testimonial support for its assertion that there are no genuine issues of material fact.

On December 1, 2003, the Board denied applicant's motion to dismiss finding that it was "based upon a misunderstanding of the difference between a proper pleading and proving the claim on the merits. The latter is not an issue in a motion to dismiss; whether opposer can prove that a likelihood of confusion exists is a matter for trial."

In applicant's presently pending Motion for Summary Judgment as a Matter of Law, applicant argues that opposer has provided insufficient evidence to show that consumers are likely to be confused. Accordingly, applicant states that opposer "has not demonstrated the damage likely to accrue to it as a result" of applicant's registration. Applicant also argues that opposer "has failed to allege any facts to show a likelihood of confusion of goods".

Applicant is again rearguing its motion to dismiss, as well as reaching conclusions that are not pertinent to the Board's LOC determination. Prior to testimony periods, opposer is not required to "demonstrate the damage likely to accrue as a result" of applicant's registration. Further, the Board's December 1, 2003 order ruled that opposer's pleading was sufficient.

The present opposition involves applicant's mark **INSPIRED AT HOME** for "printed materials and publications in the field of arts and crafts, namely, magazines, periodicals, newsletters, books, booklets and pamphlets, in International Class 16." As noted in opposer's Notice of Opposition, opposer owns U.S. trademark and service mark registrations for the mark **INSPIRATION**. Opposer's **INSPIRATION** mark is used for the following goods and services: computer programs in the field of idea development through visual diagramming, outlining and

text creation, in International Class 9; computer education training, in International Class 41; and computer software design for others, in International Class 42.

Opposer's market is the education market, which includes K-12, colleges, universities, and the adult education industry including corporate training and lifelong learning. Opposer also owns allowed U.S. Trademark Application Serial No. 76/075,245 for the mark INSPIRED for "computer software for use as a writing tool in education, home and business". Opposer's use of INSPIRATION is senior to applicant's use of INSPIRED AT HOME, and Opposer's allowed intent-to-use application for INSPIRED is senior to applicant's use of INSPIRED AT HOME.

Argument

In applicant's Memorandum of Points and Authorities in Support of Motion for Summary Judgment, applicant essentially bootstraps the merits of the opposition, including genuine issues of material fact, into its argument. Opposer disagrees with applicant's approach, and urges the Board to allow the opposition to continue based upon the allegations in opposer's Notice of Opposition, and based upon the genuine issues of material fact that exist concerning the LOC determination.

First, applicant has a difficult burden because it must show the Board there are no genuine issues of material fact. In her motion for summary judgment, applicant attempts to meet this burden without having conducted any discovery herself, and without any declarations/affidavits to support her assertions.

According to the Board, the following standards apply to motions for summary judgement:

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. See, for example, Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, including all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Chesapeake Bank v. Chesapeake Bank of Maryland, 2004 TTAB Lexis 49 (TTAB 2004).

Under the pertinent standard, the Board should deny applicant's motion because there are genuine issues of material fact involving most of the thirteen factors the Board uses to make a likelihood-of-confusion determination. See, *In re E. I. duPont deNemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Among the *duPont* factors for which there are genuine issues of material fact, the following are possibly the most critical to the Board's determination:

(i) similarity of the marks, (ii) similarity of the parties' goods/services; (iii) similarity of the parties' trade channels; (iv) the strength of opposer's mark; and (v) applicant's intent in choosing the mark.

As described above, opposer is a senior user of INSPIRATION and has senior rights to INSPIRED. Applicant's goods identification is broad enough to pose a trademark problem with respect to opposer's trademark/service mark rights in INSPIRATION and INSPIRED. Opposer owns prior rights in its INSPIRATION and INSPIRED marks, and applicant's INSPIRED AT HOME mark is confusingly similar to opposer's marks. Under 15 U.S.C. § 1057(b), opposer INSPIRATION registrations are *prima facie* evidence that opposer owns its marks and has the right to use them in commerce. Those registrations also carry a presumption of damage from registration of a confusingly similar mark like applicant's.

Second, with respect to the merits, and in contrast to applicant's assertions to the contrary, opposer's INSPIRATION mark is famous within its industry, and should be entitled to a broad scope of protection. Applicant's mark is similar to opposer's registered INSPIRATION mark and identical to opposer's INSPIRED mark (the latter being the subject of opposer's allowed U.S. Trademark Application Serial No. 76/075,245 for "computer software for use as a writing tool in education, home and business").

Applicant's goods are also related to opposer's goods based upon the broadly worded goods identification present in applicant's published application. In addition, for purposes of applicant's motion, that goods identification means applicant's goods are marketed similarly to opposer's since there is no market restriction in it.

Consistent with the notice pleading principle of the Federal Rules of Civil Procedure, as adopted by the Trademark Trial and Appeal Board, opposer has alleged facts sufficient to support this proceeding. Further, as noted above, there are genuine issues of material fact concerning several key LOC factors such as similarity of the marks, goods/services and trade

channels, strength of opposer's mark, and applicant's intent in choosing her mark.

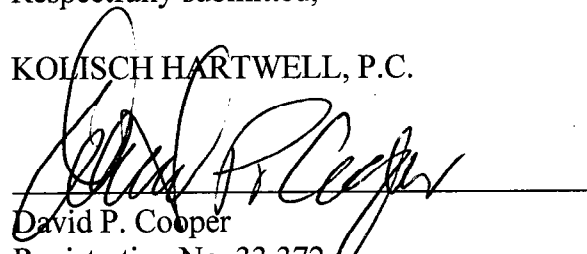
Applicant admits that genuine issues of material fact exist in her own motion and supporting memorandum because she indicates that opposer takes a position opposite hers with respect to similarity of the marks and goods/services, and with respect to the strength of opposer's mark.

Accordingly, the Board should deny applicant's motion for summary judgment and let the opposition continue to the testimony periods. Opposer also notes that it is today filing a Motion to Reset Discovery and Testimony Periods.

Dated: April 13, 2004.

Respectfully submitted,

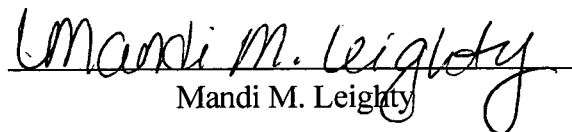
KOLISCH HARTWELL, P.C.



David P. Cooper
Registration No. 33,372
Of Attorneys for Opposer
520 S.W. Yamhill Street, Suite 200
Portland, Oregon 97204
Telephone: (503) 224-6655
Facsimile: (503) 295-6679

CERTIFICATE OF MAILING

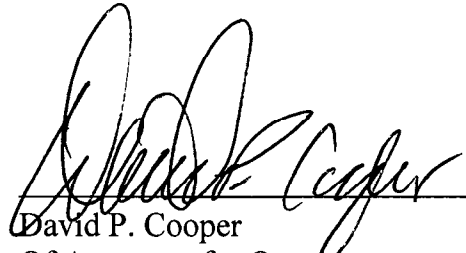
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: ATTN: Trademark Trial and Appeal Board, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514 on April 13, 2004.



Mandi M. Leighty

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT was served on applicant, by service on its attorney Deborah S. Sweeney of Michelman & Robinson, LLP located at 15760 Ventura Blvd., Suite 500, Encino, California 91436, by mailing same via first class mail, postage prepaid, in a sealed envelope to the aforementioned address on April 13, 2004.



David P. Cooper
Of Attorneys for Opposer