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

Proceeding	91190326
Party	Plaintiff TeleTracking Technologies, Inc.
Correspondence Address	Stanley D. Ference III Ference & Associates LLC 409 Broad Street Pittsburgh, PA 15143 UNITED STATES uspto@ferencelaw.com
Submission	Opposition/Response to Motion
Filer's Name	Stanley D. Ference III
Filer's e-mail	uspto@ferencelaw.com
Signature	/Stanley D. Ference III/
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 77/561,677  
For the mark IDTRAC  
Published in the Official Gazette on January 20, 2009

TeleTracking Technologies, Inc.,	)	
	)	Opposition No. 91190326
Opposer,	)	
	)	
vs.	)	
	)	
SecurLinx Holding Corporation,	)	
	)	
	)	
Applicant.	)	
_____	)	

**OPPOSER’S OPPOSITION TO APPLICANT’S  
MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS**

**Introduction**

TeleTracking Technologies, Inc. (“Opposer”), by and through its undersigned counsel, hereby opposes the Motion for Partial Judgment on the Pleadings filed by SecurLinx Holding Corporation (“Applicant”). Applicant’s motion should be denied because, based on the undisputed facts appearing in the pleadings and with all reasonable inferences drawn in favor of Opposer, it is clear that there are genuine issues of material fact that preclude a finding that likelihood of confusion cannot exist as a matter of law.

**Opposer's Allegations Assumed to be True for Purposes of this Motion**

For purposes of this motion, all factual allegations in Opposer's Notice of Opposition are deemed to be true, all denials are deemed to be false, and all reasonable inferences from the pleadings are to be drawn in favor of Opposer. *Ava Enterprises Inc. v. P.A.C. Trading Group, Inc.*, 86 U.S.P.Q.2d 1659 (T.T.A.B.2008). As such, the following facts alleged by Opposer in the Notice of Opposition are deemed to be true for the purposes of this motion:

- Opposer has been using its TRACKING-formative trademarks, common-law and otherwise, for many years. (Notice of Opposition, ¶ 3)
- Opposer has been using its TRACKING family of marks since at least as early as 1998. (Notice of Opposition, ¶ 3)
- Opposer is the owner of trademark application Serial No. 78/742,212 for PREADMITTRACKING for computer software providing patient information to hospitals in International Class 009. (Notice of Opposition, ¶ 4)
- Opposer is the owner of trademark application Serial No. 77/242,817 for TELETRACKING for consulting services in the health care field in International Class 044 and for computer software for use in the health care field to enhance operational efficiencies in International Class 009. (Notice of Opposition, ¶ 4)
- Opposer is the owner of common-law trademark TRANSPORTTRACKING for providing healthcare information to assist in workflow automation. (Notice of Opposition, ¶ 4)

- Opposer's use of the TRACKING trademarks has been valid and continuous and has not been abandoned. (Notice of Opposition, ¶ 5)
- Opposer's Registration and Common-Law usages of its TRACKING family of trademarks are symbolic of the extensive and valuable goodwill and consumer recognition built up by Opposer through substantial amounts of time, effort, and considerable sums of money, in advertising, marketing, and promotion. (Notice of Opposition, ¶ 5)
- Applicant has filed trademark application Serial No. 77/561,677 for the mark IDTRAC for computer software for use in the extraction, analysis, and comparison of biometric information regarding individuals derived from documents, pictures, and databases" in International Class 009. (Notice of Opposition, ¶ 6)
- Use by applicant of the trademark IDTRAC is likely to result in confusion, mistake or deception with Opposer's TRACKING family of trademarks, or in the belief that applicant or its products/service are in some way legitimately connected with, licensed or approved by Opposer. (Notice of Opposition, ¶ 7)
- Applicant did not have a bona fide intent to use the mark IDTRAC in commerce at the time of filing in connection with all of the identified goods asserted in its trademark application and the application therefore is void. (Notice of Opposition, ¶ 8)

- Applicant is not the owner of the mark sought to be registered and the application for IDTRAC therefore is void. (Notice of Opposition, ¶ 9)
- The application for the mark is void as the mark was assigned in violation of 15 U.S.C. § 1060. (Notice of Opposition, ¶ 10)

**There are Genuine Issues of Material Fact That Preclude a Finding That Likelihood of Confusion Cannot Exist as a Matter of Law**

The Board may only grant a judgment on the pleadings if, after taking all factual allegations in Opposer's Notice of Opposition as true and drawing all reasonable inferences from the pleadings in favor of Opposer, the Board finds that not one single issue of material fact remains and Applicant is entitled to judgment purely as a matter of law. *Ava Enterprises Inc.* at 1659 (T.T.A.B.2008). In addition, this test is based solely on the undisputed facts appearing in the pleadings, namely Opposer's Notice of Opposition and Applicant's Answer. *Id.* Furthermore, uncertainty regarding the existence of likelihood of confusion should be resolved in favor of the prior registrant. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q. 2d 1001, 1004 (Fed. Cir. 2002). It is clear that the pleadings viewed in the light most favorable to Opposer raise multiple issues of material fact such that the Board cannot find that Likelihood of Confusion does not exist purely as a matter of law.

One issue of material fact involves the scope of Opposer's family of TRACKING marks in light of the goodwill and consumer recognition Opposer has built up through considerable advertising and marketing efforts. The main thrust of Applicant's motion is that one single DuPont factor, the factor concerning the similarity or dissimilarity of the marks in their entirety, is dispositive such that the Board should find no likelihood of

confusion as a matter of law. (See Motion for Partial Judgment on the Pleadings, p. 3). Applicant then attempts to advance this claim by dissecting and scrutinizing Opposer's individual marks. However, this attempt is rather misguided because Opposer has pled a family of marks. (Notice of Opposition, ¶¶ 3, 5, and 7). As such, this DuPont factor is not determined on the basis of whether Applicant's mark is similar to Opposer's individual marks, but whether Applicant's mark would be likely to be viewed as a member of Opposer's TRACKING family of marks. *The Black & Decker Corporation v. Emerson Electric Co.*, 84 USPQ2d 1482, 1491 (TTAB 2007).

The scope of Opposer's family of TRACKING marks and whether Applicant's mark would be viewed as a member of said family clearly raises an issue of material fact. This point is also echoed in Applicant's motion, wherein Applicant states that a family of marks "must be shown by competent evidence." (Motion for Partial Judgment on the Pleadings, p. 7, quoting *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006)). As indicated above, Opposer has sufficiently pled a family of marks (Notice of Opposition, ¶¶ 3, 5, and 7). Thus, this issue should clearly be evaluated in the context of a complete evidentiary record.

Another issue of material fact involves the similarities and dissimilarities of Applicant's mark and Opposer's marks. The law is clear that marks must be compared in their entireties and not simply through a side-by-side comparison of the individual features of the marks. *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688 (Fed. Cir. 1993). In addition, although there are differences between the marks, there are definitely similarities and "similarities weigh more heavily than differences." *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 351 (C.A.Cal., 1979). Furthermore, the basis of the

comparison is not a rigid, technical analysis. Rather, the focus is on “the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks.” *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). On the contrary, Applicant’s arguments in the motion are centered on a side-by-side, methodical comparison of the individual features of the marks. The significance of the similarities and dissimilarities of the marks should be evaluated based on a complete factual record.

In addition, Applicant’s arguments in the motion analyzing the similarities and dissimilarities of the marks draw on information that is not part of the pleadings. For example, Applicant asserts that “Opposer’s marks all begin with consonants, for which part of the breathing channel is constricted during pronunciation to generate audible friction.” (Motion for Partial Judgment on the Pleadings, p. 4). This allegation is definitely not based solely on undisputed facts appearing in the pleadings. Furthermore, Applicant asserts that by omitting the ‘k’ in its spelling of the formative TRACK in its mark it is presenting a “...streamlined, sleek, and/or modernized impression as compared to the lengthy, conventional, and/or traditional impression conveyed by Opposer’s marks.” (Motion for Partial Judgment on the Pleadings, p. 6). Applicant then alleges that “Opposer’s marks accentuate this difference with the additional inclusion of the suffix ‘ING’.” (Motion for Partial Judgment on the Pleadings, p. 6). These allegations are also clearly not based on the undisputed facts appearing in the pleadings. As such, the Board should either find that material issues of fact have been raised or refuse to consider such evidence as it falls outside of the pleadings.

Furthermore, the cases cited by Applicant in the motion are inapposite in that they are factually distinguishable from this opposition and, most importantly, not one of the cases involves a motion for judgment on the pleadings. (Motion for Partial Judgment on the Pleadings, p. 6). On the contrary, each of the cases cited by Applicant was decided after the establishment of an evidentiary record.

Still another issue of material fact involves the channels of trade and the prospective purchasers of the goods and services covered by Applicant's mark and Opposer's family of marks. Applicant's pleading does not provide information about the channels of trade or prospective purchasers for the goods and services covered by Applicant's mark. Thus, it is presumed that the goods encompass all goods of the type described, move in all normal channels of trade, and are available for purchase by all potential customers. *In re Elbaum*, 211 U.S.P.Q. 639 (P.T.O. T.T.A.B.1981). As such, the channels of trade and the prospective purchasers should be more fully evaluated in the context of a complete factual record.

As described herein, the pleadings present genuine issues of material fact concerning at least Opposer's family of marks, whether Applicant's mark would be viewed as belonging to Opposer's family of marks, the similarities and dissimilarities of the marks, and the channels of trade and prospective purchasers of the goods and services covered by the subject marks. For these reasons, judgment on the pleadings would be inappropriate at this point in the opposition and Applicant's motion should be denied.



## Conclusion

The genuine issues of material fact established herein should compel denial of Applicant's motion. Opposer's Notice of Opposition is legally sufficient and Opposer should be provided with a full opportunity to prove its case. Based on the undisputed facts appearing in the pleadings and with all reasonable inferences drawn in favor of Opposer, it is clear that there are genuine issues of material fact that preclude a finding that likelihood of confusion cannot exist as a matter of law. Thus, Opposer respectfully requests that Applicant's motion be denied.

Respectfully Submitted,

FERENCE & ASSOCIATES LLC

Dated: September 15, 2009

By: /Stanley D. Ference III/  
Stanley D. Ference III  
Registration No. 33,879

FERENCE & ASSOCIATES LLC  
409 Broad Street  
Pittsburgh, PA 15143  
(412) 741-8400 - Phone  
(412) 741-9292 - Facsimile

Attorney for Opposer  
TeleTracking Technologies, Inc.

**CERTIFICATE OF TRANSMISSION AND SERVICE**

I certify that the foregoing OPPOSER'S OPPOSITION TO APPLICANT'S  
MOTION FOR PARTIAL JUDGMENT ON THE PLEADINGS is being electronically  
filed with:

Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

and is being served by first-class mail, postage pre-paid, to:

Michael B. Pallay, Esquire  
Steptoe & Johnson PLLC  
P.O. Box 2190  
Clarksburg, West Virginia 26302

Attorney for Applicant

this 15th day of September, 2009.

/Stanley D. Ference III/  
Stanley D. Ference III