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

Proceeding	91190333
Party	Defendant Midwest Index, Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

STORAGE SOLUTIONS, INC.	)	
	)	Opposition No. 91190333
Opposer,	)	
	)	Application Serial No. 77/510,125
v.	)	Mark: INTEGRATED FILING
	)	SOLUTIONS and design
MIDWEST INDEX, INC.,	)	
	)	
Applicant.	)	

**ANSWER**

Applicant Midwest Index, Inc. (“Applicant”), by its attorneys Ice Miller LLP, as for its Answer against Opposer Storage Solutions, Inc. (“Opposer”), states and alleges as follows:

1. Opposer is an Ohio corporation, and maintains its headquarters in Phoenix, Arizona.

**ANSWER:**

Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in paragraph 1 of the Notice of Opposition and, therefore, denies the same.

2. Opposer has been in the business of selling, among other things, file folders, labels, filing cabinets, movable shelving, lateral track shelving systems, mail room tables and sorters, and other filing and storage orientated components in commerce throughout the United States since at least as early as 1990.

**ANSWER:**

Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in paragraph 2 of the Notice of Opposition and, therefore, denies the same.

3. Opposer is the owner of U.S. Federal Trademark Registration No. 2,320,660, registered on February 22, 2000, for the mark FILING SOLUTIONS plus design for file folders made of paper and color coded labels made of paper and plastic in International Class 16, and office furniture namely, stationary metal filing cabinets, high density movable shelving, lateral track shelving systems, mail room table and sorters, metal filing cabinets with imitation wood fronts and metal rotating filing cabinets in International Class 20.

**ANSWER:**

Applicant admits that Opposer is the registrant of record for Registration No. 2,320,660, which identifies the goods set forth in paragraph 3 of the Notice of Opposition.

4. Opposer's federally registered FILING SOLUTIONS mark was first used in interstate commerce at least as early as February 1990, which is well before the filing date of Applicant's intent-to-use application Serial No. 77/510,125, which Applicant filed with the United States Patent and Trademark Office ("USPTO") on June 27, 2008.

ANSWER:

Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in paragraph 2 of the Notice of Opposition and, therefore, denies the same, except that Applicant admits it filed its application Serial No. 77/510,125 on the alleged date, and specifically denies the allegations of paragraph 4 to the extent they suggest Opposer's mark is a word mark.

5. Opposer's FILING SOLUTIONS registered mark Exhibit A is herein placed into evidence and made part of the record by the attached current printout of information from the electronic database records of the USPTO showing the current status of the marks.

ANSWER:

Applicant admits that Exhibit A displays the current status of the marks at issue, but denies the allegations of paragraph 4 to the extent they suggest Opposer's mark is a word mark.

6. Opposer's use of the aforementioned FILING SOLUTIONS trademark has been continuous from a date prior to the filing date of Applicant's Application Serial No. 77/510,125 for INTEGRATED FILING SOLUTIONS.

ANSWER:

Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in paragraph 6 of the Notice of Opposition and, therefore, denies the same.

7. Opposer's FILING SOLUTIONS mark is symbolic of the extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promoting the mark.

ANSWER:

Applicant lacks knowledge or information sufficient to form a belief as to the allegations contained in paragraph 7 of the Notice of Opposition and, therefore, denies the same.

8. Upon information and belief, Applicant is an Illinois corporation.

ANSWER:

Admitted.

9. Applicant has filed an application with the USPTO, Serial No. 77/510,125 ("Applicant's Application"), seeking to have INTEGRATED FILING SOLUTIONS registered as a trademark for *filing systems, namely, document files, file folders, paper expanding files, paper file jackets, self-adhesive paper and synthetic labels, printed paper charts and printed forms, file pockets, card files, file boxes for storage of business and personal records and magazines, index tabs, metal document clips and poly sleeves and pockets* in International Class 016 based upon Applicant's intent to use the mark interstate commerce.

ANSWER:

Applicant admits that it has filed the captioned application for INTEGRATED FILING SOLUTIONS for use with the listed goods, but denies the allegations contained in paragraph 9 of the Notice of Opposition to the extent they suggest Applicant's mark is a word mark.

10. Upon information and belief, Applicant has used its INTEGRATED FILING SOLUTIONS mark in commerce, and said use is likely to cause confusion with respect to Opposer's federally registered FILING SOLUTIONS mark.

ANSWER:

Applicant admits that it has used its INTEGRATED FILING SOLUTIONS plus design mark in commerce. Applicant denies the remainder of the allegations of paragraph 10.

11. Applicant's Application was published for opposition in the Official Gazette on May 12, 2009.

ANSWER:

Admitted.

12. Applicant's INTEGRATED FILING SOLUTIONS mark and Opposer's federally registered FILING SOLUTIONS mark are virtually identical in spelling and pronunciation, with the exception of the addition of the word "INTEGRATED," and are in the same International

Class 016.

ANSWER: Applicant admits that its design mark and Opposer's design mark share two words. Applicant denies the remainder of the allegations of paragraph 12 of the Notice of Opposition.

13. Moreover, the respective goods of Opposer and Applicant are highly related, substantially similar, and are promoted through the same channels of trade for provision to, sale to, and use by, the same class of purchasers.

ANSWER:

Denied.

14. Upon information and belief, Applicant's use of its INTEGRATED FILING SOLUTIONS mark is likely to cause confusion and mistake in the marketplace, and deceive customers and members of the public to believe that Applicant's goods emanate from and/or are sponsored or approved by Opposer, which is not true.

ANSWER:

Denied.

15. Upon information and belief, the registration of Applicant's INTEGRATED FILING SOLUTIONS mark is likely to continue to cause such confusion, mistake and/or deception in the marketplace as to the origin of the respective parties' products, and would permit Applicant to continue to trade upon the substantial goodwill of Opposer's business, symbolized and recognized by its aforesaid FILING SOLUTIONS registration to the detriment and damage of Opposer.

ANSWER:

Denied.

16. Furthermore, any defect, objection or fault found with Applicant's goods under the INTEGRATED FILING SOLUTIONS mark would necessarily reflect upon and seriously injure the reputation which Opposer has established for its goods marketed under its federally registered FILING SOLUTIONS mark.

ANSWER:

Denied.

17. Applicant's use of the mark INTEGRATED FILING SOLUTIONS, for which

registration is sought, is without the Opposer's consent or permission.

ANSWER:

Applicant denies the allegations of paragraph 17 to the extent they suggest Applicant's mark is a word mark. Applicant admits that its use of INTEGRATED FILING SOLUTIONS plus design is without the Opposer's consent or permission.

**AFFIRMATIVE DEFENSES**

1. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's pleaded mark because the respective marks are not confusingly similar. Any similarity, if at all, between Applicant's mark and Opposer's pleaded mark would arise from the term "FILING" which, upon information and belief, has been used and registered by third parties in connection with filing systems and materials. Furthermore, the term "FILING" in Opposer's mark was disclaimed by the Opposer in obtaining its mark. Accordingly, any purported similarity between Applicant's mark and Opposer's pleaded mark cannot be based on the term "FILING."

2. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's pleaded mark because the respective marks are not confusingly similar. The Applicant's term "INTEGRATED" is the dominant word in Applicant's mark when spoken, by virtue of its position as the first word in the mark. By comparison, Opposer's mark is dominated by the term "FILING SOLUTIONS." A consumer is therefore likely to identify Applicant's goods on hearing the term "INTEGRATED," whereas a consumer is likely to identify Opposer's goods on hearing the term "FILING" or "FILING SOLUTIONS."

3. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's pleaded mark because the respective marks are not confusingly similar.

There is little likelihood of confusion between the two marks based on the term "FILING SOLUTIONS." The term "FILING SOLUTIONS" is by definition and by connotation nearly identical to the term "FILING SYSTEMS." The term "FILING SYSTEMS" and "FILING SYSTEM" have been used in third-party marks for filing systems and materials. Accordingly, the term "FILING SOLUTIONS" in Opposer's pleaded mark is weak, any purported similarity between Applicant's mark and Opposer's pleaded mark cannot be based on the term "FILING SOLUTIONS."

4. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's pleaded mark because the respective marks are not confusingly similar. The visual design of Applicant's mark is visually distinctive from Opposer's mark. Opposer's mark sets the term "FILING SOLUTIONS" in all lower case and at a slant. Applicant's mark, by comparison, is horizontal, dominated by the term "INTEGRATED" set in all caps in a much larger font than the term "FILING SOLUTIONS," which is set below the term "INTEGRATED." A consumer is therefore, unlikely to confuse Applicant's or Opposer's pleaded mark by visual comparison, as the term "INTEGRATED" dominates Applicant's design mark.

5. There is no likelihood of confusion, mistake or deception between Applicant's mark and Opposer's pleaded mark because the respective marks are not confusingly similar. The terms "FILING" and "FILING SOLUTIONS" alone are descriptive terms. Therefore, absent an associated design, any purported similarity between Applicant's mark and Opposer's mark cannot be based on the term "FILING" or "FILING SOLUTIONS."

Wherefore, Applicant respectfully requests that Applicant's application, Serial No. 77/510,025 be upheld and that the trademark INTEGRATED FILING SOLUTIONS plus design in International Class 16 be registered.

Dated: July 30, 2009

/Anthony Nimmo/

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Attorneys for Applicant

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of Applicant's forgoing ANSWER was served on attorneys for Opposer on July 30, 2009, by first class mail, as follows:

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/Anthony Nimmo/  
One of the Attorneys for Plaintiff