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

Proceeding	91202418
Party	Defendant Ryan E. Alley
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding:	Innovation Law Group, Ltd., Opposer-Plaintiff v. Ryan E. Alley, DBA Ryan Alley Intellectual Property Law, Applicant-Defendant
Opposition No.:	91202418
Serial No:	85/342,228
Mark:	BUILDING ASSETS FROM IDEAS

July 15, 2014

CORRECTED DEFENDANT'S MAIN BRIEF UNDER 37 C.F.R. § 2.128(a)(1)

Applicant-Defendant, Ryan E. Alley, doing business as Ryan Alley Intellectual Property Law, (hereinafter "Applicant") hereby re-submits its main brief on the merits seeking dismissal of all claims under §§ 2(d) and 43(c) in Opposition 91202418 against Application 85/342,228, "Building Assets from Ideas" (hereinafter, "Applicant Mark") to replace the Brief of July 14 containing many errors.

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DESCRIPTION OF THE RECORD

The record consists entirely of declaration evidence and exhibits thereto submitted pursuant to the Stipulation approved by Board Order of October 31, 2013 (Dkt. No. 37).

Opposer's declarations include the following submitted on December 5, 2013 (Dkt. Nos. 38, 39):

- Declaration of Kirk Thomas
- Declaration of Diane van Os, with Exhibits A, B
- Declaration of expert Laurel Black, with Exhibit A
- Declaration of Richard Parks
- Declaration of Robert F. Dennis, with Exhibit A
- Confidential Declaration of Jacques M. Dulin, with Exhibits 1-22

Applicant's declarations include the following submitted February 28, 2014 (Dkt. Nos. 40-44):

- Declaration of Ryan E. Alley[1], with Exhibits 1-18, 20, and 21, Confidential Exhibits 19 and 20, and Exhibits A1-PPP1
- Confidential Declaration of Ryan E. Alley[2], with Exhibit Alley-1

Opposer's rebuttal declarations include the following submitted on April 14, 2014 (Dkt. No. 53):

- Rebuttal Declaration of Jacques M. Dulin, with Exhibits 23-26
- Rebuttal Declaration of Laurel Black
- Corrected Confidential Declaration of Ryan E. Alley, resubmitted as non-confidential

[1] Pursuant to the Board Order of June 30, 2014 (Dkt. No. 56), a corrected version of this declaration was submitted on July 15, 2014 and replaces the original.
[2] Pursuant to the Board Order of June 30, 2014 (Dkt. No. 56), a corrected, non-confidential version of this declaration was submitted on July 15, 2014 and replaces the original. Although no longer confidential, this submission is cited as "Conf. Alley Decl." in order to differentiate from the first Alley Declaration, "Alley Decl."

STATEMENT OF THE ISSUES

- Likelihood of Confusion between Applicant Mark and Opposer's federally-registered and state-law-based marks under § 2(d) of the Trademark Act.
- Dilution of Opposer's marks by Applicant Mark.

RECITATION OF THE FACTS

Applicant and Opposer are readily-distinguishable providers of professional services in the highly-specialized field of Intellectual Property (hereinafter "IP") Law. (Alley Decl. ¶¶ 1, 2; Conf. Dulin Decl. ¶ 2) Opposer's principal, Jacques Dulin, conceived and used the phrase "transforming ideas into business assets" in 1996 and used the same at several different law firms until mid-2000, when he began using the phrase solely in connection with Opposer Innovation Law Group (hereinafter, "ILG"). (Conf. Dulin Decl. ¶¶ 3, 6(d)) Dulin at some point also began using the phrase "ideas are assets" in connection with ILG. Dulin sought and received three federal trademark registrations that include the "transforming . . ." phrase, including Registrations 2,090,854; 3,129,158; and 3,215,068 (hereinafter, "Opposer Marks"), only the '854 and '158 registrations being for legal services relating to IP law. (Conf. Dulin Decl. Exs. 1-3) Opposer has standing and priority in Opposer Marks to maintain an opposition under the same. (Board Order of June 1, 2012; Dkt. No. 15)

Opposer, however, selected Marks that are very weak due to their descriptiveness of IP legal services, and through paltry policing have not come to be uniquely identified in any way with Opposer. Opposer has used Opposer Marks in connection with the ILG name and contact information for the past 14 years, and recorded in exacting detail the results of such marketing,

without any evidence of confusion. (Conf. Dulin Decl. ¶¶ 8-10; Alley Decl. ¶ 11) Opposer has only once policed Opposer Marks against third-party marketplace uses of a "transforming . . ."-like phrase. (Conf. Alley Decl. ¶¶ 9-11) This lack of confusion and minimal policing is in the context of 67 different IP third parties using marks and descriptions of IP legal services that set out an explicit equivalence between ideas and business assets, mostly in the form of "turning/transforming ideas into assets." Each of these uses are listed with exact pin cites in the Declaration of Ryan E. Alley, Paragraphs 20-23 on pages 11-31, and can be summarized as such:

- 12 distinct US IP legal services providers - IP attorneys and law firms - for years using stand-alone slogans "transforming ideas into assets" and "turn/ing ideas into assets" (Alley Decl. ¶ 23, Exs. A1-A3, A10, A11 B1, B2, B4, C1-C3, D1-D2, E1, F3, G1-G2, H1, I1, K1-K3, K6, S1, OO1), at least one of which is a large IP firm with thousands of issued patents that has used "Transforming Ideas into Assets℠" as a stand-alone service mark for over 6 years across several media. (Alley Decl. ¶ 23, Exs. A1-A13).
- 12 distinct US IP legal services providers for years describing their practice with the terms "[turn]/ing ideas into assets" (Alley Decl. Exs. A4-9, A13, B3, B4, F1, H2-H3, H2-I3, J1-J2, L1, M1, N1, O1, P1, S1, MM1).
- 4 distinct IP-issuing offices – WIPO and the Danish, Norwegian, and Canadian Patent Offices - using stand-alone slogans and describing legal IP protection with terms like "Turning ideas into assets" (Alley Decl. Exs. AA1-AA5, BB1-BB3, CC1-CC2, DD1). Moreover, the World Intellectual Property Organization has been describing IP to small entities as "turning ideas into business assets" for over 10 years (Alley Decl. Exs. AA2, AA5) and across hundreds of different sources (Alley Decl. Ex. AA4).

- 15 distinct US IP educators, commentators, and brokers for years using slogans and educational descriptions of IP acquisition in the form "[turn]/ing ideas into assets" (Alley Decl. Exs. R3, FF1-FF3, GG2, HH1, II1, JJ1, KK1-KK2, LL1, QQ1-QQ2, TT1, UU1-UU3, VV1, XX1, YY1, BBB1).
- 11 distinct English-speaking IP providers in other jurisdictions using slogans and practice descriptions for IP legal services accessible in the US in the form "[turn]/ing ideas into assets" (Alley Decl. Exs. CCC1, DDD1, EEE1, FFF1, GGG1, HHH1, III1, KKK1, MMM1-MMM2, NNN1, OOO1).
- Along with the above uses, 22 distinct IP practitioners, educators, and commentators describing and marking IP legal services as involving changing an "idea" or "concept" into a "value"-bearing "asset," "capital," or "fortune." (Alley Decl. Exs. F2, K4, Q1-Q3, R1-R2, R4-R7, T1, U1, V1-V3, W1-W3, X1, Y1-Y2, Z1-Z3, EE1, GG1, GG3, MM2, NN1, PP1, RR1, SS1, WW1, ZZ1-ZZ2, AAA1, LLL1-LLL3).

All of the above uses are in the English language and accessible from the US, and the overwhelming majority of these uses are live on the Internet and indexed in public search engines. (Alley Decl. ¶¶ 20, 21)

The lack of confusion and policing despite rampant third-party uses similar to Opposer Marks is explained by the evidence of descriptiveness in the same as well as the sophistication and care of IP legal services consumers. As for descriptiveness, services in IP law are fairly described as professional services by registered attorneys that necessarily involve changing ideas into assets. (Alley Decl. ¶ 22) Several dictionaries define IP as a commercial "asset" derived from an "idea" (Alley Decl. Ex. PPP1), and the dozens of uses set out above show that

in English the phrase "turning ideas into assets" commonly describes legal services for such IP. (Alley Decl. ¶¶ 20, 21) Opposer offers no contrary dictionary definitions or third-party descriptions of different understandings of legal services in IP; instead, Opposer admits several of the above uses are descriptive of IP legal services.

As for care in the consumption of legal services in IP, the evidence of record includes the two most recent AIPLA Reports of the Economic Survey, showing extreme costs in IP legal services. (Alley Decl. ¶ 18; Conf. Exs. 19, 20) A 2009 survey of consumers of legal services by BTI Consulting Group shows that selection of a service provider is nearly always driven by the identity and personal characteristics of the underlying attorney or agent, without regard for marketing. (Alley Decl. ¶¶ 15, 16(2), Exs. 7, 8). Moreover, many state bar associations and consumer information services specifically advise even potential consumers of legal services to thoroughly research the professional attributes of the actual person providing any legal service before consummating engagement. (Alley Decl. ¶¶ 16(1), 17; Exs. 9-18) Opposer offers no contrary evidence of expenses or sophistication in pursuing IP legal services, noting only that …

In 2011 Applicant conceived the mark "Building Assets from Ideas" for its new practice within this highly-specialized professional environment populated with many third party uses more similar to Opposer Marks. (Alley Decl. ¶ 3) Applicant Mark was selected for its "building" lead-in being unique while well-matching Applicant's "building"-block logo as seen on its website. (Alley Decl. ¶ 3; Conf. Dulin Decl. Ex. 20) Applicant filed an application for registration of the word mark "Building Assets from Ideas" on June 9, 2011, receiving application number 85342228. (Alley Decl. ¶ 5) The application was in the field of "legal services in IP," a field related to Opposer Marks' "legal services relating to IP." (Board Order of June 1, 2012)

Prior to filing, Applicant conducted a search of the USPTO database for related marks using "building" and construction equivalents with "idea" and "asset," which returned no results. (Alley Decl. ¶ 5) A search using a build/construction term, and not transfiguring/magical terms, was of an appropriate scope; as shown by dictionary evidence as well as visual observation, the selected Applicant Mark with the "Building Assets . . ." phrase is very different in meaning and appearance than Opposer Marks with the mostly descriptive "Transforming Ideas . . ." phrase. (Alley Decl. ¶¶ 25-27; Exs. 21, 22) From dictionaries and common usage, "building" has an entirely different meaning, appearance, and protectable commercial impression from "transforming," and the remainder of the Marks are anyway further distinct. (Id.) Not only was Applicant mark thus filed in good faith, but following almost three years of continuous, prominent use, not a single instance of confusion between Applicant and Opposer or their very different Marks has been uncovered, despite both being viewed by tens of thousands of IP consumers in the US. (Alley Decl. ¶¶ 7-11; Dulin Conf. Decl. ¶¶ 9, 10)

In July 2011, Applicant was contacted by Dulin, who threatened an Opposition if the registration on Applicant Mark was not abandoned. (Alley Decl. ¶ 6) Applicant had no knowledge of Dulin or Opposer Marks prior to this interaction. (Id.) Applicant continued prosecuting its application and defending this opposition in good faith based on the extreme weakness of Opposer Marks, the marked differences between Opposer and Applicant Marks, the rarified nature of IP legal services, and further because the extent of any confusion between Applicant and Opposer Marks was vanishingly small. In addition to the cost and identity-driven nature of selecting an IP professional, IP legal services are highly regulated and in practice always presented with confusion-eliminating dominating information. Particularly,

evidence of binding regulations of IP legal services and actual marketing show that a slogan must be and is presented to even potential consumers with true identity of the legal service provider. (Alley Decl. ¶¶ 13, 14; Exs. 4-6, A1-OOO1) In sum, there is zero chance that even the most ill-informed and simple segment of the population would actually confuse Applicant for Opposer or vice versa as a source of IP legal services when encountering either Applicant Mark or Opposer Marks.

ARGUMENT

I. THERE IS NO LIKELIHOOD OF CONFUSION

Whether a mark is likely to confuse consumers as to the source of the goods or services depends on all relevant factors set out in In re E.I. du Pont Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973). Each of the relevant DuPont factors must be weighed for Applicant or Opposer based on the preponderance of the evidence on each factor, which Opposer bears the burden of establishing. Chanel, Inc. v. Makarczyk, ___ U.S.P.Q.2d ____, Opp. No. 91208352 at 7 (T.T.A.B. May 27, 2014); *see also* Cunningham v. Laser Golf Corp., 222 F.3d 943, 951 (Fed. Cir. 2000).

In order to simplify this proceeding, Applicant has stipulated to Opposer's standing and priority in Opposer Marks. (Board Order of June 1, 2012)[3] As such this opposition is reduced to an analysis of the DuPont factors to determine a likelihood of confusing Applicant and Opposer based on the Marks. The relevant factors are argued below in turn primarily with respect to Opposer Mark 2,090,854, the oldest of Opposer Marks having the "transforming ideas into business assets" phrase at issue here. The state-law-based "Ideas are Assets" mark is addressed at the end of this section.

Ultimately, there is no likelihood that any consumer of IP legal services will think Opposer is Applicant, or vice versa, upon encountering Applicant or Opposer Marks. Opposer Marks are weak slogans - nearly descriptive, utterly common, and rarely policed - such that

[3] This stipulation concedes standing and priority in only Opposer Marks, defined above as Registrations 2,090,854; 3,129,158; and 3,215,068. Opposer makes a well-off-the-mark attempt in its Main Brief, pages 26-27, to introduce for the first time Registration 4,301,077 to this proceeding. The new '007 Registration was never pled nor introduced in Opposer's trial period. Moreover, Opposer does not have priority in Registration '077, which has a first use after that of Applicant Mark, the filing of this Opposition, and the June 1, 2012 Board Order.

nobody would look to most parts of these slogans to discern a service source. In the limited aspects where consumers might consider Opposer Marks as unique or associated with a particular provider, they markedly differ from Applicant Mark. These differences would be well-appreciated in the IP legal services marketplace, which is populated by careful consumers seeking expensive, commercial, professional services provided by a licensed attorney. Even if the most careless and myopic consumer did somehow take Applicant Mark to suggest Opposer as the source of a service, several regulations and the nature of how all IP legal services are marketed and provided would immediately correct that nearly impossible mistake. In sum, Applicant and Opposer Marks are more than capable of co-existing in the highly-specific field of IP-related legal services without any confusion, just as dozens of other closer uses by third-party IP providers have done for years.

A. **Opposer Marks are Weak**

The DuPont Factors "Dissimilarity of the Marks," "Fame of the Prior Mark," and "Number and Nature of Similar Marks on Similar Goods," are argued together in this section. Opposer Marks are extremely weak given their descriptiveness, have not come to be associated with Opposer in the minds of consumers, and are in widespread use on third-party services. These showings of weakness inform each of the above factors - usage on similar marks shows descriptiveness as well as being an independent DuPont factor, and comparison under the first factor should discount descriptive and commonly-used aspects of the mark.

1. Opposer Marks are Mostly Descriptive

Opposer admits that the phrases "Transforming Ideas into Assets" and "turning ideas into business assets" are descriptive in Exhibits A1-PPP1. Particularly, Opposer states "Exhibits A1-PPP1 . . . are simply fair uses of the English language to descriptively state an idea" and directly labels Exhibits A3 and AA1 containing these phrases as a "description" qualifying as fair use. (Opp. Main Brief, p. 37; Opp. Main Brief Appx., pp. 4, 14, 36, filed June 14, 2014, (Dk. No. 55)). Opposer further cites caselaw agreeing that "descriptive" uses support non-infringing fair usage. (Opp. Main Brief Appx. p. 4, n. 2 (citing KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111 (2004))) Although Opposer styles some of these descriptive admissions as objections, it cites no caselaw supporting exclusion of third-party descriptive usage as evidence of mark weakness in a registrability dispute before the Board. *Cf.* In re Nat. Data Corp., 753 F.2d 1056, 1059-60 (Fed. Cir. 1985) (accepting prose in publication articles as evidence of descriptiveness because "[t]hird-party *usage* can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade") (emphasis added); *see also* In re Zanova, 59 U.S.P.Q.2d 1300 (T.T.A.B. 2001) (considering prose in articles for mark descriptiveness). Thus, Opposer's numerous, repeated and direct statements that Exhibits A1-PPP1 are "descriptive" as used by IP providers, in its Main Brief, Appendix thereto, and Motion of March 17, 2014 (Dkt. No. 46), can only be admissions of the descriptiveness of these Exhibits' uses, including "Transforming Ideas into Assets" and "turning ideas into business assets."

Even without Opposer's admissions, the evidence of record well establishes that the phrases "transforming ideas into assets" and "turning ideas into business assets" and the general impression of changing an idea into an asset are descriptive of IP legal services.

Dictionary and third-party uses showing this description are set out in exacting, pin-cited detail in the Alley Declaration pages 11-31 for Exhibits A1-PPP1 and again summarized in the Recitation of Facts section above. It is worth reiterating, however, that these descriptive uses include eighteen different US IP attorneys using the phrases "transform/ing ideas into [] assets" (Alley Decl. Exs. A1, B1, D1, G1, I1, J1) and "turn/ing [] ideas into assets" (Alley Decl. Exs. C1, E1, F1, G2, H1, I2, L1, M1, N1, O1, P1, R3, S1, OO1) to describe and caption their IP legal services. Dozens of IP organizations, educators, commentators and foreign IP legal services providers have further arrived at the same English phrase with the form and words "[change]/ing [] ideas into [] assets" to describe IP services. (Alley Decl. Exs. AA1-DD1, FF1-FF4, GG2, II1-MM1, UU1, VV1, XX1, YY1, AAA1-III1, KKK1, MMM1-OOO1) Altogether, there are 67 different parties in evidence, all of whom have publicly used converting ideas into assets as a description or hallmark of IP law. (Alley Decl. ¶ 21) This is competent and overwhelming evidence to show descriptiveness of mark terms. Specialty Brands v. Coffee Bean Distributors, Inc., 748 F. 2d 669, 675 (Fed. Cir. 1984) ("Third-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade"); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 917 (C.C.A.P. 1976) (same for unused registrations).

The widespread description of IP legal services as turning ideas into business assets makes sense - dictionaries define "intellectual property" as ideas set into asset form that can be commercially exploited. (Alley Decl. Ex. PPP1) For example, IP is defined by general and specialized dictionaries as an "asset that consists of . . . ideas"; "an intangible . . . translated into a tangible form"; "valuable assets a . . . business can own"; and an "intellect" product "that has commercial value." (Id.) Under these definitions, the field at issue - legal services in IP - are

legal services that work to make ideas into the assets. It thus follows that all the above IP-involved parties would articulate and mark legal services in IP with terms like "turning ideas into assets" in order to accurately describe the subject matter to which they refer. In sum, the words, phrasing, and broad impression given by "transforming ideas into assets" are descriptive of legal services in IP given the usage and definitions of record.

Because the forms and words "transform/ing," "ideas" and "assets" and broad impression of changing an idea into an asset are descriptive of IP legal services, Opposer Marks cannot have scope over these forms, words, or broad meanings. Rather, these terms and general meanings must remain available to current and future users in the field of IP legal services. *See* Sure-Fit Products Co. v. Saltzon Drapery Co., 254 F.2d 158, 159-160 (C.C.P.A. 1958) (a mark cannot "preempt the field" of a descriptive term). Moreover, because Opposer Marks, taken as a whole phrase "transforming ideas into business assets," includes mostly descriptive - and at best highly suggestive - terms and meanings in the field of IP legal services, Opposer Marks must be given narrower scope[4] when identifying confusingly similar uses. *See* Sure-Fit, 254 F.2d at 160 ("where a party chooses a trademark which is inherently weak, he will not enjoy the wide latitude of protection"); King Candy Co. v. Eunice's King's Kitchen, Inc., 496 F.2d 1400, 1401 (C.C.P.A. 1974) (confusion is unlikely with descriptive terms); In re Central Soya Co., Inc., 220

[4] Opposer at times has defended against these arguments of weakness as an impermissible collateral attack on Opposer Marks. This is a strawman; Applicant has never sought cancellation of Opposer Marks. Applicant and Opposer Marks, along with many of the third party uses, are more than capable of coexisting in the IP legal marketplace without confusion, and have done so for years. *See* Nat. Data Corp., 753 F.2d at 1059-60 ("a showing of descriptiveness or genericness of part of a mark does not constitute an attack on the registration")

U.S.P.Q. 914, 917 (T.T.A.B. 1984) (even highly suggestive marks have a limited scope of exclusivity) ; *see also* Chamber of Commerce of the US v. US Hispanic Chamber of Commerce, Opposition 92045876 at 37 (T.T.A.B. Dec. 31. 2002) (nonprecedential).

2. Large Numbers of Similar Marks are in Use

The marketplace for IP legal services is flooded with slogans and marketing about "transforming" and "turning" "assets into ideas" from dozens of IP services providers. Unlike the argument in Section A(1), *supra*, about *descriptiveness* of Opposer Marks as shown by other English uses of their terms, the argument and evidence in this section is of *actual US marketplace exposure* to similar marks. That is, many elements of Opposer Marks have been so widely used by third party IP legal service providers that the public has become accustomed to seeing these terms and, as an independent DuPont factor, is less likely to confuse them as emanating from Opposer. *See*, Carl Karcher Enterprises Inc. v. Stars Restaurants Corp., 35 U.S.P.Q.2d 1125, 1131 (T.T.A.B. 1995). Although many of these third party uses are addressed in the Recitation of Facts, in Section A(1), *supra*, and set out with exact location, pin cites, and dates in the Alley Declaration Exhibits A1-OOO1, the most notable extensive uses are recounted below.

Hoffman and Barron, a large IP law firm with thousands of issued patents (Alley Decl. Ex. A12), uses "Transforming Ideas into Assets" as a service mark prominently throughout its website (Id. Exs. A1, A2) and in several IP-law articles in legal publications (Id. Exs. A3, A10, A11). The firm noticeably states that it "transforms ideas into assets" in several pieces of marketing distributed at large national conferences (Id. Exs. A4-A9), on third party websites (Id. Exs. A13), and on its own website (Id. Exs. A1, A2). These uses have been occurring for several

years, from 2008 and potentially as early as 2002 (Id. Exs. A3, A10). Another four IP practices use the same slogan "Transforming Ideas into Assets" and "Transforming ideas into valuable IP assets" on their websites and marketing (Id. Exs. B1, D1, G1, I1, J1), many for several years (Id. Ex. D2, G1, J2). Another nine providers of IP legal services market with closely-related phrases like "turn" and "turning" "ideas into assets" (Id. Exs. C1-C3, E1, F1, F3, H1, I2, N1, O1, P1, R3, OO1) and another ten use phrases with the same "ideas into assets" meaning (Id. Exs. F2, H2-H3, K1-K6, T1, U1, V1-V3, W1-W3, X1, Y1-Y2). This is a very large number of US IP legal services providers using most all of Opposer Marks for their distinct practices. (Alley Decl. ¶ 23)

Consumers are further bombarded with IP books, seminars, and commentary using terms like: "Turning Ideas into Assets" as an inventor's workshop title in 2012 (Id. Exs. FF1-FF4); a 2006 book on IP titled "Turn Your Great Ideas into Valuable Assets" (Id. Exs. KK1-KK2); "Turning Innovation into Assets" used as topic for a 2009 IP presentation to university inventors (Id. Ex. II1); a 2001 IP publication with an article subtitled using the phrase "turn ideas into assets" (Id. Ex. LL1); 2007 and 2008 events by a large IP law firm titled "Turning Ideas into Profits" (Id. Exs. QQ1-QQ2); 2013 Designers' conference with a presentation on IP called "Ideas are Assets" (Id. Ex. PP1); a 2001 book on IP titled "Creating Fortunes from Your Ideas" (Id. Ex. MM2); "Turning Ideas into Assets" used as a title of a 2010 workshop on IP & Patents (Id. Exs. GG1-GG2); a 2013 US Small Business Administration event on IP called "Ideas to Assets" (Id. Ex. EE1); an IBM IP guide for small enterprises instructing "Turning ideas into assets is one of the most critical functions for companies"; (Id. Ex. JJ1); "Ideas as Assets" as a title for an IP-related post on a patent-aggregator's blog (Id. Ex. NN1); a 2001 bestselling book on IP by an IP Hall of Fame member titled "From Ideas to Assets" (Id. Exs. R1, R2, R4-R7); the

World Intellectual Property Organization repeatedly warning small and medium enterprises since 2002 that IP protection is crucial in "turning ideas into business assets" (Id. Exs. AA1-AA5). This is just a sampling; over a dozen additional uses of similar phrases in the US IP legal marketplace are pin cited in the Alley Declaration, pages 11-28 and in Exhibits A1-ZZ2.

All of the third-party uses include aspects of Opposer Marks, like an "Ideas to Assets" ordering or a general connotation of "IP legal services convert ideas into assets." Many of the third-party uses include the exact "transforming" or very close "turning" as a direct lead-in to "ideas into assets." Most of the third party uses submitted in evidence are much closer to Opposer Marks in wording, phrasing, and meaning than Applicant Mark. (Alley Decl. ¶ 23)

The third-party uses are extensive throughout the US market for IP legal services. Not only are Exhibits A1-ZZ2 numerous and unique, many of the uses have been available for years from multiple, independent sources and at several different venues all within the US. This is competent evidence to show extensive use through Internet materials. In re Broadway Chicken Inc., 38 U.S.P.Q.2d 1559, 1565, n.16 (T.T.A.B. 1996) (large number of one-off business listings sufficient to show extensive third party use); Rocket Trademarks Pty Ltd. v. Phard S.p.A, 98 U.S.P.Q.2d 1066, 1077 (T.T.A.B. 2011) (finding mark weakness due to third party Internet usage); *see also* Chamber of Commerce, Opposition 92045876 at 46-47 (nonprecedential) ("as to many of the particular third-party [Internet listings], the record includes references to them from multiple sources, which, when considered together, tend to corroborate each other on the question of these third parties' use of their marks"); Mfrs. Tech. Inst., Inc. v. Pinnacle Coll., LLC, Opposition 91195896 at 20-21 (T.T.A.B. Sept. 4, 2013) (nonprecedential) (finding 5 internet uses of a mark to demonstrate mark weakness).

Given the rampant and diverse use of "transforming ideas into assets" and very close variants throughout the field of IP law, the consuming public has become accustomed to seeing such slogans on IP legal work and are much less likely to confuse them with Opposer Marks. Palm Bay Imports v. Veuve Clicquot Prods., 396 F.3d 1369, 1373-74 (Fed. Cir. 2005). The DuPont factor "Extent of Third-Party Use of Similar Marks" should be weighed for Applicant. Moreover, in the comparison analysis in A(4), *infra*, the descriptive and commonly-used aspects of Opposer Mark set out in this section and in A(1), *supra*, should be given less weight vis-à-vis Applicant Mark, reducing similarities between the two under that distinct DuPont factor.

3. Response to Opposer Arguments on Usage and Descriptiveness

Opposer argues that non-trademark uses, such as descriptive prose found on some of the Alley Declarations A1-PPP1 are not available to show descriptiveness of Opposer Marks. (Opp. Main Brief at 36-37) Opposer cites no caselaw for this point, but appears to confuse statutory fair use defense under 15 U.S.C. § 1115 with a showing of weakness of in an asserted mark. (Id.) It is well established that third-party uses and registrations, regardless of actual marketplace use, can be used to show *descriptiveness* in a mark. Nat. Data Corp., 753 F.2d at 1059-60 ("[t]hird-party *usage* can demonstrate the ordinary dictionary meaning of a term") (emphasis added); Tektronix, 534 F.2d at 917 (unused registrations useable like a dictionary to show descriptiveness); Zanova, 59 U.S.P.Q.2d at 1300 (considering prose in articles for mark descriptiveness). As such, third party uses, regardless of whether they constitute infringement, are always useable to show descriptiveness, just as they are used in Section A(1), *supra*.

Opposer next argues that descriptions from foreign sources must be disregarded in US Oppositions, including Alley Declaration Exhibits AAA1-OOO1 mostly from the UK, Australia, and Canada. (Opp. Main Brief at 37) This argument is unsupported. The cases cited by Applicant, In re Opus One Inc. and Aktieselskabet Af 21 v. Fame Jeans, deal with exclusion of foreign evidence of *US marketplace customs* and foreign use for *US priority rights*, respectively, not proper sources of *English* definitions. *See* Opus One, 60 U.S.P.Q.2d 1821, n.7 (T.T.A.B. 2001); Aktieselskabet Af 21, 77 U.S.P.Q.2d 1861 (T.T.A.B. 2006). No known case stands for the principal that English uses accessible from the US from abroad cannot show meaning or descriptiveness of English terms. An English speaker anywhere can competently proffer the meaning of a term in English. Indeed, the Board often considers foreign, English-speaking sources for mark definitions and term meanings. *See, e.g.*, In re Simon Shiao Tam, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013) (citing OED for meaning of a term in a mark); *see also* The Keg Rights Ltd. P'ship v. Keggers, L.P., Opposition 91193534 at 3, 10 (T.T.A.B. February 1, 2013) (nonprecedential) (same).

Lastly, Opposer has introduced no dictionary or third party uses showing any contrary meaning of "transforming ideas into business assets." Nor does Opposer dispute the substance of the third party uses (although Opposer does launch a litany of frivolous evidentiary objections to the same, addressed in the Appendix) or offer any evidence discrediting the numerous third party uses. Only Applicant's proffered dictionaries and third party uses showing Opposer Marks to be composed of mostly common, descriptive elements and public inurement to many aspects of Opposer Marks, are in evidence. As such, Opposer has not established by a preponderance of any evidence suggestiveness, arbitrariness, or fancifulness in Opposer Marks, or strength or distinctive features of its Marks based on the same.

4. Applicant Mark is More Different than Similar to Opposer Marks

When comparing marks under the first DuPont factor, the marks as a whole must be compared for similarities in sound, appearance, connotation, and commercial impression. Recot, Inc. v. Becton, 214 F.3d 1322, 1326 (Fed. Cir. 2000). While an entire mark must be considered, the analysis under this factor fairly places more emphasis on unique, non-descriptive mark aspects to reflect how consumers actually remember a mark and prevent trademarks from capturing common or descriptive words necessary to depict a good or service. Nat. Data Corp., 753 F.2d at 1060 (consumers "rely more on the non-descriptive portion of each mark" to distinguish the same); Tektronix, 534 F.2d at 916-917 ("a common, highly suggestive portion is usually insufficient to support a finding of likelihood of confusion"); Sure-Fit, 254 F.2d at 159-160. The case E. L. Bruce Co. v. American Termicide, 285 F.2d 462, 464 (C.C.P.A. 1960), is a good example of this emphasizing. In E.L. Bruce, an Applicant's "termicide" mark was unlikely to be confused with Opposer's "terminix" registration because the identical prefixes "termi" were highly suggestive of the products at issue - termite extermination - and given little weight in the likelihood of confusion analysis; the distinct suffixes "cide" and "nix" instead formed the basis to distinguish the marks. Id. As such, the showing of descriptiveness and widespread use of aspects of Opposer Marks in sections A(1) and A(2), *supra*, inform how Opposer and Applicant Marks are perceived by the IP legal services consumer and ultimately compared for similarities under this primary DuPont factor.

As shown and admitted above in Sections A(1) and A(2), Opposer Marks have very few non-descriptive or unique words, grammatical form, or meaning. The use of "transforming" and the similar "turning" to introduce "ideas into assets" is very common and describes how IP

legal services depend on converting ideas into assets. Given this descriptiveness, it is likely that Opposer Marks have protectable sound, appearance, connotation, or commercial impression only against the exact phrase "transforming ideas into business assets" and possibly against this phrase with additional words added therein. Stretching to cover broader opinions of suggestiveness, Opposer Marks may have some protectable connotation and commercial impression where "transform" suggests a specific type of conversion – like a magical and transfiguring change in fundamental nature, such as where idea is consumed and "transformed" into a business asset. (Alley Decl. Ex. 21 ("transform" synonyms including "transfigure," "metamorphose," "transmute," "transubstantiate")) As such, a generous comparison of Opposer Marks under the first factor might rely on this less common "alchemizing" impression of "transforming" ideas into business assets as a suggestive aspect of the mark entitled to some trademark protection.

Consumers exposed to Opposer Marks may be further more likely to remember or rely on "transform" as a dominant aspect of Plaintiff's Mark because it is the leading and operative term. *See* Palm Bay Imports, 396 F.3d at 1372 (identifying a first word as dominant in a mark due to its position); Presto Products, Inc. v. Nice-Pak Products, Inc., 9 U.S.P.Q.2d 1895, 1897 (T.T.A.B. 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser"). Thus, despite its common usage to describe IP legal services, a comparison of Opposer Mark under the first DuPont factor might, if anything, focus on the "transform" leading word and as a suggestion of a radical metamorphosis.

Defendant's Mark does not use "transform" but instead leads with "build" as the operative "-ing" present participle or gerund. "Building" does not sound or appear like

"transforming." The terms have different starting hard consonants "b" and "tr," have different numbers of syllables, have different linguistic internal flow, and have mutually exclusive lengths and letters, aside from the –ing ending required by the generic form. (Alley Decl. ¶ 24)

"Build" and "transform" are not synonyms. (Alley Decl. Exs. 21, 22) Moreover, "building" does not share the metamorphic, "magical/unexplained/unseen radical change in nature" impression of "transforming." (Id.) Instead, "building" gives an impression of directly, manually constructing or assembling a larger whole from individual pieces whose nature does not change and can be seen as built into the larger whole ("building wooden logs into a cabin"). (Alley Decl. ¶ 25; Ex. 22) This is fanciful in that ideas cannot be physically put together, and one cannot directly see or detect an idea - it is intangible - in an asset based on the same. (Alley Decl. ¶ 25) "Transforming" lacks this sweat-of-the-brow fanciful connotation, instead suggesting magically/effortlessly changing and consuming one thing to create another thing of a completely different character that does not directly reflect the manual work done or base materials ("transforming wooden logs into fire and ash"). (Alley Decl. ¶ 25; Ex. 21) As such, Applicant Mark leads with a dominant word having significant differences in protectable appearance, sound, connotation, and commercial impression from Opposer Marks.

Although Opposer Marks are even more descriptive and common when looking at non-leading words, Applicant Mark is still easily distinguishable in appearance, sound, and meanings in full wording. Opposer Marks use the more common idea-into-asset ordering, causing the introductory gerund or participle to work on "ideas," as in "transforming ideas. . ." Applicant Mark reverses the order of "idea" and "asset" and uses a different preposition, causing "assets" to be the worked-upon noun as in "building assets. . ." Further, Applicant

mark omits the "business" term, resulting in a much shorter overall spoken phrase and allowing "building" to directly work on "assets." (Alley Decl. ¶ 25) These reversals, omissions, and prepositional changes cause the two Marks, in their entireties, to look different when seen and sound different when spoken. (Alley Decl. ¶ 26) Moreover, the differences in operative, leading words "transform" and "build" coupled with the change in direct objects for these leading words results in different direct actions on different subjects between the Marks. (Id.) This elevates the "asset" term in Applicant mark to much more importance than in Opposer Marks and the third-party descriptions. (Id.)

In sum, Opposer Marks - "Transforming ideas into business assets" - and Applicant Mark - "Building assets from ideas" - when compared in their entireties with consideration of leading and non-descriptive aspects, have significant differences in protectable appearances and sounds as well as connotations and commercial impressions. The two marks are readily distinguishable for their differing words, lengths, orders, spoken sounds, meanings, and suggestions. Because Opposer and Applicant Marks do not share any aspect that the public would rely upon, the two Marks are not likely to confuse consumers exposed to the same. This factor should be weighed for Applicant.

5. Response to Opposer Arguments on Differences between the Marks

Opposer takes the breathtaking position that Opposer Marks are entitled to a protectable commercial impression of "turning ideas into protected [IP], an important business asset." (Opp. Main Brief at 44) As Opposer would have it, Opposer Marks have scope over all

expressions of: **Ideas → Assets**, because according to Opposer's expert, "ideas" and "asset" are the dominant words and the Marks have a same "message." (Id. at 45)

These arguments are against the great weight of the evidence. The Alley Declaration Exhibits A1-PPP1 clearly establish, as argued above, that "ideas" and "assets" are the most common, descriptive portions of Opposer Marks, appearing in nearly every third party usage, often in the form "Ideas into Assets." Applicant's evidence and arguments above further shows that the underlying message of changing assets into ideas is descriptive. Neither Opposer nor its expert address the substance of Applicant's dictionary and third party evidence or offer any countervailing dictionary or third party uses to show non-descriptiveness. Moreover, finding confusion based on Opposer's requested scope of "**Ideas → Assets**" necessary to reach Applicant Mark appropriates everything with this descriptive changing-ideas-into-assets meaning. This would certainly usurp other registrations currently used by IP lawyers, like "Creating Value from Ideas®" (Alley Decl. Exs. Q1-Q3) and "From Ideas to Profits®" (Id. Exs. W1-W3). This would also have the effect of impermissibly permitting Opposer Marks to lock up all slogans expressing an IP lawyer's function of making ideas into assets. *See* Sure-Fit, 254 F.2d at 160. As such, Opposer has simply not engaged its arguments of dominant mark portions and comparison of the Marks with its admissions and the evidence of descriptiveness and non-uniqueness nor produced a preponderance of (or any) evidence of protectable suggestiveness or fancifulness in Opposer Marks, let alone in all forms of making "ideas into assets."

Opposer further cites their expert's testimony that "building" is the same as "transforming" in the two Marks. (Opp. Main Brief at 45) Again, neither Opposer nor its expert proffer any dictionary evidence of these terms, nor do they address the substance of Applicant's

dictionary evidence showing these two terms are not synonyms (Alley Decl. Exs. 21, 22). But even Opposer's expert illustrates how "building" and "transforming" are readily-distinguished species of the generic "creating." In her example of "transforming," the expert states "transforming *a pile* of bricks and lumber into a new form that has a new function." (Opp. Main Brief at 45 (emphasis added)) Yes, when transforming *a pile* into a structure, the pile is consumed/disappears and becomes something else with a new form and function. But the bricks and lumber are not transformed; rather, the bricks and lumber are built into the structure with no change in form. This nicely illustrates the quite distinct types of creating conveyed by the two terms and Marks.

Opposer at other points dissects out the "business" portion of Opposer Marks to compare it with the leading "Building" in Applicant Mark. (Opp. Main Brief at 43) Again, Opposer offers no evidence as to how "business" is a dominant portion of Opposer Mark or why a consumer would select out a fourth word serving as an adjective in a five-word slogan and confuse it to a starting word serving as an operative gerund or participle in a four-word slogan. Nor does Opposer explain how this rearrangement of marks comports with its contrary assertion that "idea" and "asset" are the two dominant terms. Rather, as argued above, the consumer is much more likely to remember and associate the leading "Transforming Ideas" with Opposer, and the readily-distinguishable "Building Assets" with Applicant given their leading, dominant placements without regard for the trailing and more descriptive portion of Opposer Mark.

Lastly, Opposer cites several inapposite cases to support a finding of likelihood of confusion even in the face of descriptive or widely-used mark portions. Opposer believes that

Magnavox Co. v. Multivox Corp. of Am., 341 F.2d 139 (C.C.P.A. 1965) supports a finding of likelihood of confusion here because the Marks here have confusable, protectable aspects like "Magnavox" and "Multivox" Marks. (Opp. Main Brief at 38, 44, 46) This is very faulty case analogizing. Magnavox dealt with one-word marks of identical length, leading letter, and syllables and – critically – *no descriptive aspects*. Magnavox, 341 F.2d at 141 (holding "vox" suffix not descriptive of goods at issue). Moreover, the court found confusion in Magnavox based also on the similarity of the leading, less common "Multi" and "Magna" in addition to the non-descriptive, non-English "vox" suffix. Id. at 142.

The present case, however, deals with Marks that are long English-word-only slogans having commonly-used, descriptive elements and led with very distinct big words. There is simply no comparison with the non-descriptive, one-word marks of Magnavox. The other cases cited for this proposition by Opposer are equally inapt by involving arbitrary or suggestive, short word marks; the cases are further distinct as involving marks on consumer goods with very different DuPont factors in play. *See* KOS Pharms., Inc. v. Andrx Corp., 369 F.3d 700 (3d Cir. 2004) (one-word, arbitrary, highly similar ADVICOR and ALTOCOR for pharmaceuticals); Nikon Inc. v. Ikon Corp., 987 F.2d 91 (2d Cir. 1993) (one-word, highly similar, arbitrary NIKON and IKON for cameras); Earthquake Sound Corp. v. Bumper Industries, 352 F.3d 1210 (9th Cir. 2003) (dealing with exceptionality and fees, not DuPont factors).

Opposer continues its arguments on "significant precedent in the TTAB and federal courts" with Board opinions in Bennett Law Office, PC v. Burrus Intellectual Property Law Group, Opposition No. 91177164 (T.T.A.B. Mar. 26, 2009) (nonprecedential) and Fraser Stryker Meusey Olson Boyer & Bloch, P.C. v. Fellers, Snider, Blankenship, Bailey & Tippens, P.C.,

Opposition No. 91166088 (T.T.A.B. June 25, 2007) (nonprecedential). (Opp. Main Brief at 46). Although Opposer never identifies them as such, Bennet and Fraser are nonprecedential. Moreover, Opposer completely misses the holding of Fraser, which is distinguishable from the facts at bar. In Fraser, the Applicant's mark *included the entire arbitrary graphical* Opposer's mark. Fraser at 9-10. Here, however, Applicant Mark adopts only the common, descriptive words "ideas" and "assets" and description of IP law as changing ideas into assets. There is no comparison[5] between a likelihood of confusion using wholly-swallowed arbitrary, graphical marks and mutually distinct, lengthy slogan word marks. Bennet is equally distinguishable for involving marks that wholly appropriated protectable aspects of another; the nonprecedential Bennet case is discussed in further detail below, in section B.

In sum, Opposer never grapples with the strong record evidence of descriptiveness and widespread use of Opposer Marks that would lead consumers to discount any similar portions of the Marks. Nor does Opposer offer any real dictionary, consumer survey, usage, or other evidence to underpin its grandiose understanding of the protectable scope of Opposer Marks or support its convenient mark dissections and reformulations. Opposer's caselaw is further unavailing as completely inapt to the type of marks and factors at play in this case as well as being nonprecedential in places.

[5] N.B. Opposer on page 48 of its Main Brief incorrectly matched Applicant Mark with the Opposer's mark in Fraser.

6. Opposer Marks are not Famous

Opposer Marks are not famous, nor do they have any marketplace presence to accord Opposer any weight under this DuPont factor. As seen in Applicant's evidence of record and section A(2), *supra*, Opposer Marks have proven no barrier to entry for dozens of similar marks to the IP marketplace. (Alley Decl. ¶¶ 21-23) These third parties have likely used these marks because they, like Applicant, have never heard of Opposer or Opposer Marks after several years in legal IP services. (Alley Decl. ¶ 6)

Moreover, Opposer Marks are utterly unpoliced in the actual marketplace. Opposer has only once successfully policed its marks against another "transforming ideas/assets" marketplace use, after the commencement of this Opposition. (Conf. Dulin Decl. ¶ 7(e), Ex. 13; Conf. Alley Decl. ¶¶ 9-12) Applicant still uncovered all allegedly policed uses without knowledge of, and despite of, Opposers "policing" actions. (Alley Decl. Exs G1-G2, SS1) All other actions taken by Opposer have been against parties adopting its name or in USPTO, non-marketplace actions. (Conf. Dulin Decl. ¶ 7(c)-(d)) Even in the one other USPTO action against an "ideas are assets" mark, an opposition was directed toward a small applicant who abandoned its mark, likely to avoid the expense of defending even a meritless opposition. (Id.) Several other more similar applications have not been opposed, like "Creating Value from Ideas" (Alley Decl. Ex. Q2) and "Turning Concepts into Assets" (Alley Decl. Ex. K1). And as for the actual marketplace where consumers are exposed to marks, several closer uses by third party IP practitioners have been ongoing for years. (Alley Decl. ¶¶ 20-22, Exs. A1-A13)

Opposer offers no evidence showing Opposer Marks having a weighable marketplace presence. Opposer Marks have been used by Opposer since 2000, prior to which Opposer's

principal used them with different parties. (Conf. Dulin Decl. ¶ 6(d)) Opposer alleges spending money on marketing and policing Opposer Marks, and Opposer alleges receiving a specific number of inquiries in the past 10 years as a result of such marketing. (Id. ¶¶ 8-10) These values appear small, and Opposer does not anyway offer any comparative marketing expense or impact data for similarly-situated parties in the IP legal market by which to judge the relative size of its spending and results. Moreover, in all uses Opposer has *presented Opposer Marks in conjunction with a prominent source identifier*, like the ILG name and contact information. (Dulin Conf. Decl. Exs. 5-10, 21) As such, it is not possible to measure any marketplace impact of Opposer Marks based on Opposer's evidence, and thus no strength can be given to Opposer Marks. *See* Top Tobacco, L.P. v. North Atlantic Operating Co., 101 U.S.P.Q.2d 1163 (T.T.A.B. 2011) (mark could not be accorded strength in DuPont analysis due to insufficient marketplace context for sales values and mark exposure).

Opposer further cites the testimony of three former colleagues and clients familiar with Opposer Marks as evidence of fame of the same. (Opp. Main Brief at 41-42) None of the testifying colleagues or clients were aware of Opposer Marks before meeting or being personally referred to Opposer or Opposer's principal. (van Os Decl. ¶ 5; Parks Decl. ¶¶ 4-5; Dennis Decl. ¶¶ 4-5) As such, the Opposer's proffered testimony does not reflect an awareness of Opposer Marks or a connection of the same with Opposer in the unassociated public or among potential consumers. Rather, the evidence includes only parties, including Applicant, who learned of Opposer Mark only after they became personally or professionally aware of Opposer first. (Id.; Alley Decl. ¶ 11)

In sum, there is no evidence of fame or marketplace awareness to show strength in Opposer Mark, and fame as a DuPont factor should not weigh for Opposer. From sections A(1)-(6) together discussing weaknesses and distinctions in Opposer Marks, three factors "Dissimilarities of the Marks" and "Number and Nature of Similar Marks in Use on Similar Goods" and "Fame of the Prior Mark" weigh for Applicant.

B. **Legal Services in IP are Consumed with Great Care**

1. IP Legal services are Expensive, Commercial, Discretionary, and Individualized

Parties considering legal services in IP exercise great care in selecting a provider. Even reckless and uninformed IP consumers will take time and effort in engaging with an IP provider, because of the remarkable cost of even basic IP law services, the discretionary and commercial nature of IP procurement, and the identity-based nature of professional legal services.

As to expense, even the simplest transaction in patents, trademarks, and copyrights costs hundreds of dollars in professional fees, with yet additional government fees required for many transactions. (Alley Decl. Ex. 19, p. 16 (28); Ex. 20, p. 20 (27)). Costs for a single whole procurement (e.g., preparation and prosecution of a patent or trademark to issue) are in the thousands of dollars. (Id.) Enforcement services in IP start in the thousands and extend into the priceless. (Id. Ex. 19, p. 23 (35); Ex. 20, p.27 (34))[6]. The least sophisticated IP consumer will pay even more, because they will require additional legal counseling and attorney time, and are more likely to require expensive remedial services. (Alley Decl. ¶ 18) The extreme expenses

[6] N.B. these values are reported in thousands.

involved in IP legal services are on par with a major investment for an individual and often represent significant portions of budgets for corporate R&D. (Alley Decl. Ex. 19, p. 15 (7); Ex. 20, p. 19 (6)) Extreme costs call for extreme care in researching and selecting an IP service provider, if any. *See* Electronic Design & Sales v. Electronic Systems, 954 F.2d 713, 718-719 (Fed. Cir. 1992) ("There is always less likelihood of confusion where goods are expensive.") (internal citations omitted).

IP legal services are discretionary and commercial. Unlike fields like criminal or immigration law, IP activities do not vindicate basic freedoms and are not required to practice rights available to the average citizen. IP interactions are a business decision taken with respect to finances and market share, much like decisions made in commercial law. (Alley Decl. ¶ 19) Moreover, IP legal services are completely discretionary - acquisition, enforcement, and really any IP interaction can be done *pro se* without the identified services. *See, e.g.*, 37 C.F.R. § 1.31. Because services in IP are a wholly optional business decision, consumers will have and take the time to exercise due care in researching IP services and distinguishing among providers before proceeding with representation, if any. *See* Electronic Design, 954 F.2d at 719 (quoting Pignons SA de Mecanique v. Polaroid Corp., 657 F. 2d 482, 489 (1st Cr. 1981) ("Courts have found less likelihood of confusion where goods are . . . purchased after careful consideration.")).

Lastly, legal services in IP are highly specialized, professional, and individual. Decisions on legal services in IP are made with regard to personal characteristics of the providing professional, not slogans or marketing. (Alley Decl. ¶¶ 16-17; van Os Decl. ¶ 7) A personal referral or interaction that reveals these characteristics of a servicing professional is much more likely to play a role in IP legal services provider than a slogan. (Parks Decl. ¶ 4) It makes sense

that all advice geared toward unsavvy consumers recommends an interview or referral in selecting an attorney. (Alley Decl. ¶ 17, Exs. 9-18) And it makes sense that Opposer's principal was able to port Opposer Marks between three different firms, using them as a personal slogan, without causing confusion, because of this individual-based nature of legal services in IP. (Conf. Dulin Decl. ¶ 6). A study of the legal market by BTI Consulting confirmed that personal interactions and referrals dominated advertising when selecting an attorney. (Alley Decl. Exs. 7, 8) Put another way, clients hire an attorney, not a firm or its marketing. Moreover, engagement with legal services in IP nearly always requires personal interaction with an attorney and an explanation of services and fees; that is, there is no commoditized box of IP legal services awaiting a distracted purchaser to mistake what they are buying. (Alley Decl. ¶ 17) In this way even an extremely unsophisticated person rushing for IP legal services will have to go through several personal, informative interactions with any prospective attorney before commencing services in the field at issue.

2. Response to Opposer Arguments of Non-Sophistication

Opposer attempts to widen the field of applicable services to include all types of non-commercial law that might involve less sophisticated purchasing conditions. (Opp. Main Brief at 34) Opposer has offered no evidence as to how the listed services "legal services in IP" would include something like "Divorce" law. (Rebuttal Dulin Decl. ¶ 8) Divorce services is for "legal services in divorce," which none of the involved Marks include. At base, Opposer does not contest or offer any alternative definitions of "IP," which many dictionaries define as being "commercial" properties that are "assets" derived from "ideas." (Alley Decl. Ex. PPP1) As such,

Applicant's argument and evidence of the care in consuming commercial, professional services and the expense of IP are in accord with the field of services at issue in this Opposition, while Opposer's observations of consumers in non-IP fields are not.

Opposer further attempts to show unsophistication through scam-prevention warnings for invention promoters and government copyists. (Opp. Main Brief at 34) These warnings are not for the field of legal services in IP and may be directed at *pro se* applicants who have forgone the field at issue; the warnings themselves distinguish invention promoters from legal services in IP. (Conf. Dulin Decl. Ex. 18 "If you have hired a patent attorney or agent, ask them about the invention promoter/promotion firm"; Conf. Dulin Ex. 19, knock-off USPTO correspondence that would be intercepted if IP legal services provider were correspondent) In sum, dissatisfaction with an invention promotion company and confusion by unrepresented applicants due to near exact copying does not reflect how consumers find and select representation in IP law.

Where Opposer's lay witness allegedly show lack of sophistication, they actually show some careful consumer practices. For example, the Parks Declaration testifies to a small inventor finding patent counsel through personal referral and considering Mr. Dulin's professional experience and personal technical expertise in selecting patent counsel. (Parks Decl. ¶¶ 4, 6) As a further example, the van Os Declaration offers hearsay testimony that an unsophisticated and foreign supervisor looked to professional' technical capability in selecting IP legal services. (van Os Decl. ¶ 7) Where Applicant identifies the least-sophisticated market segment, IP-unaware individuals seeking IP legal services, he testifies as to their extreme care in selecting a provider. (Alley Decl. ¶ 12; *cf.* Opp. Main Brief at 35 editing the same) Similarly, where Opposer's declarants speak generally about the most "unsophisticated" consumers in the field, they

actually support, and do nothing to gainsay, the extreme expense, commercial discretion, and identify-driven nature in selecting IP legal services providers as shown and argued by Applicant,

Lastly, where Opposer attempts to cite the nonprecedential Bennet opinion to show non-sophisticated consumers of IP law, it is inapt. Id., Opposition No. 91177164 (T.T.A.B. Mar. 26, 2009) (nonprecedential). Bennet involved a broader field of all legal services. Id. at 1-2. Bennet did not deal with the much larger record of the instant case or evidence of extreme costs and several involved personal requirements in finding IP legal services providers. Id. at 3. Bennet was anyway decided largely on similarity of the marks at issue in that case, with consumer sophistication being only a peripheral issue. Id. at 8-11. Even if it dealt with the exact same facts as the instant case, the nonprecedential Bennet would not need to be followed[7], but the differing fields, different evidence of record, differences in Marks, and differences in mark strength in the instant case compel ignoring Bennet.

In sum, the expense, the commercial and discretionary nature, and the individualized process of IP legal services requires great care in selecting an IP legal provider. At least one court has said as much, in Dudley v. HealthSource Chiropractic, Inc., 585 F. Supp.2d 433 (W.D.N.Y. 2008), where consumer confusion between marks was unlikely because the relevant

[7] Anyway, if analogizing nonprecedential opinions, the previously-cited Chamber of Commerce, Opposition 92045876, is much closer to the facts of the instant opposition. That opposition dealt with a similar number and type of third-party uses and somewhat professional services like those at issue here, although the marks in Chamber of Commerce were much more similar than here.

field was for an "individualized service by a trained licensed professional." This DuPont factor weighs for Applicant.

C. **The Extent of Potential Confusion is De Minimus**

Even if the tiny segment of consumers that might theoretically somehow confuse Applicant and Opposer Marks actually did so, the confusion would immediately stemmed by Applicant and Opposer's different names and personal characteristics well before any services were initiated among that vanishingly small population. Opposer Marks are used on a single niche service – those offered from a single office by a registered, licensed patent attorney. (Conf. Dulin Decl. ¶ 6) Due to these licensing requirements and the nature of how legal services are actually conducted, potential consumers are highly aware of and able to rely on any legal service's source, i.e., the identity of the attorney or organization providing the service. The ABA Model Rules for attorney advertising require that all public promotional material include an identification of the provider. (Alley Decl. Ex. 4) A strong majority of jurisdictions covering nearly the entire nation and US attorneys have adopted this rule as a minimum. (Id. ¶ 13, Ex. 5) The USPTO has adopted this rule. (Id. Ex. 6) Indeed, every piece of advertising evidence includes at least an attorney or organization name in addition to any slogan. (Id. Exs. A1-Z3, AAA1-OOO1) Thus, the public, to say nothing of actual consumers of legal services in IP, is always presented with a source in combination with a slogan like that in the Marks, fully stopping the already tiny degree to which any confusion of the Marks might extend into actual consumption or association. *See* Knight Textile Corp. v. Jones Investment Co., 75 U.S.P.Q.2d 1313 (T.T.A.B. 2005) (addition of source to descriptive mark eliminated likelihood of confusion).

Lastly, this is not the commonly-dismissed argument about how the Marks and parties themselves market that ignores a lack of field restrictions in the pled registrations. *Cf.* Octocom Systems v. Houston Computer Services, Inc., 918 F.2d 937, 942-43 (Fed. Cir 1990). Rather this argument speaks to the nature of the unrestricted field of services in the pled registrations, legal services in IP, and how that entire field actually works with marketplace practices that aggressively safeguard against misleading advertising. *See* Witco Chemical Co. v. Whitfield Chemical Co., 418 F.2d 1403 (C.C.P.A. 1969) ("the practicalities of the commercial world" must be accounted for in determining likelihood of confusion); *see also* Triumph Machinery Co. v. Kentmaster Manufacturing Co. Inc., 1 U.S.P.Q.2d 1826 (T.T.A.B. 1987) (even with "purchaser overlap" between unrestricted fields, "the possibility of confusion is a remote one. The Trademark Act, however, does not talk in terms of remote possibilities of confusion but, rather, the likelihood of such confusion's occurring in the marketplace.") This DuPont factor should be weighed for Applicant.

D. **There has been No Actual Confusion over Many Years**

Applicant and Opposer have never been confused in the three years of mutual operation under the Marks with nationwide exposure to the Marks. (Conf. Dulin Decl. ¶¶ 9, 10; Alley Decl. ¶ 9, Ex. 2) Search engines, which perform competent linguistic analysis of language online, do not confuse the Marks where they are advertised online. (Alley Decl. ¶ 10, Ex. 3); *see also* Mfrs. Tech. Inst., Opposition 91195896 at 7 (nonprecedential) (admitting search engine results as relevant to consumer confusion). Even more impressive, there is no evidence in record that Opposer (or Applicant) has ever been confused with any of the third-party IP legal services

providers, despite their number, years of use, and much closer usages discussed in Section A above and discussed in detail in the Alley Declaration through Exhibits A-PPP1. As an example, the law firm Hoffman and Baron has used the mark "transforming ideas into assets" for at least the past 6 years throughout several different media and events while procuring thousands of patents for nationwide clients. (Alley Decl. ¶ 23, Exs. A1-A13) If confusion of Opposer Mark were ever likely, Opposer would certainly have been confused with Hoffman & Baron's much closer and much more extensive third-party use, to say nothing of the other several IP lawyers using the same terms. Opposer takes careful note of all client interactions (Conf. Dulin Decl. ¶ 9); if such confusion occurred, it would certainly have made its way into the record here. Given this lack of actual confusion with overwhelming opportunity for the same, the DuPont factor "Concurrent Use" should be weighed for Applicant, and the DuPont factor "Actual Confusion" should be neutral. *See*, Top Tobacco, 101 U.S.P.Q.2d at 1174-5 (absence of actual confusion weighs for Applicant where there has been a sufficient time and opportunity for actual confusion); G.H. Mumm & Cie v. Desnoes & Geddes, Ltd., 917 F.2d 1292, 1295 (Fed. Cir. 1990) (lack of actual confusion for many years showed confusion was unlikely).

E. Opposer and Applicant Marks' Services Overlap but have Distinct Trade Channels

Applicant stipulates to similarity between the field of services in Applicant and Opposer Marks and the weighing of this DuPont factor for Opposer. (Board Order of June 1, 2012; Dkt. No. 15) However, the *presumption* of same trade channels given similar fields of uses should not apply here. Rather, as shown in Sections B and C above and evidence cited therein, legal services in IP are so identity- and referral-driven that the channels between consumer and

provider – referrals and personal interaction - for one professional are entirely distinct from those of another professional due to their personal differences and distinct referral networks. Thus, any presumption of similarity of trade channels has been overcome by competent evidence to the contrary about the related field of services. The DuPont factor of "Similarity of Trade Channels" should be, at best, neutral.

F. **But Maybe There's Bad Faith in Mark Adoption??**

Opposer acknowledges that good faith adoption will not weight for Applicant here but continues to insinuate that Applicant "put his head in the sand" and adopted Applicant Mark fraudulently. (Opp. Main Brief at 36; *see also* Opp. Complaint ¶¶ 10, 11 (accusing Applicant of violating a federal criminal fraud statute)) Applicant has produced direct evidence detailing his pre-filing search, rationale for the same, and how that search did not uncover Opposer Marks. (Alley Decl. ¶ 5) Applicant has further produced written, documentary evidence of when and how Applicant Mark was conceived and first used with no knowledge of Opposer or its Marks. (Alley Decl. ¶ 4, Ex. 1) Obviously, upon eventually learning of Opposer Marks, Applicant believed and continues to believe that Applicant Mark is registerable in light of the evidence of record and defending this Opposition. Opposer does not address any of Applicant's evidence but instead labels it "not credible" and trots out Opposer's Principal and a former colleague to testify that they would have found Opposer's Mark in their own searches. (Rebuttal Dulin Decl. ¶ 4; van Os Decl. ¶ 11) This does not come close to showing that Applicant actually knew of Opposer's Mark, let alone that Applicant *further* believed Applicant Mark to be confusing with Opposer's mark yet adopted and applied to register Applicant Mark for deceptive advantage. *See* Sweats Fashions v. Pannill Knitting Co., 833 F.2d 1560, 1565 (Fed. Cir. 1987), (to weigh in

DuPont analysis, "an inference of 'bad faith' requires something more than mere knowledge of a prior similar mark."); First International Services Corp. v. Chuckles Inc., U.S.P.Q.2d 1628, 1633 (T.T.A.B. 1988) (likelihood of confusion analysis requires evidence that Applicant intended to trade off the success of a prior known mark in adopting a similar mark). Quite frankly, Opposer's continuing to make this argument of bad faith is offensive to Applicant and a waste of everyone's time.

G. **Balancing the Factors**

The number of third party uses, the differences between the marks, the careful conditions of sale, the lack of any confusion, and the *de minimus* extent of any possible confusion here all weigh for Applicant. The similarity of the marks weighs for Opposer. Balancing these factors 5-1, there is no likelihood of confusion here between Applicant and Opposer Marks. Opposer does not argue or otherwise support its common law claim to "Assets are Ideas" and there is further no protectable scope in that mark and thus no likelihood of confusion in it. There is no likelihood of confusion here between Applicant Mark and any state-rights-based usage by Opposer.

II. THERE IS NO DILUTION

Opposer's dilution claim fails for a failure to properly plead fame requisite to carry a dilution claim. *See* Polaris Indus., Inc. v. DC Comics, 59 U.S.P.Q.2d 1798 (T.T.A.B. 2000). Opposer Marks are anyway not famous, nor does Opposer otherwise argue or support its dilution claim.

This opposition should be dismissed.

Respectfully submitted,

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

Proceeding:	Innovation Law Group, Ltd., Opposer-Plaintiff v. Ryan E. Alley, DBA Ryan Alley Intellectual Property Law, Applicant-Defendant
Opposition No.:	91202418
Serial No:	85/342,228
Mark:	BUILDING ASSETS FROM IDEAS

July 15, 2014

APPENDIX TO DEFENDANT'S MAIN BRIEF

Applicant objects to the following Evidence proffered by Opposer:

- Confidential Declaration of Jacques M. Dulin of Dec. 5, 2013
- Declaration of expert Laurel Black of Dec. 5, 2013
- Rebuttal Declaration of Jacques M. Dulin and Exhibits 23-26 submitted therewith of Apr. 14, 2014
- Rebuttal Declaration of expert Laurel Black of Apr. 14, 2014

The Confidential Declaration of Jacques M. Dulin is objected to for bias and inconsistency. Dulin is the Principal of Opposer and has a personal interest in prevailing in this proceeding. Moreover, Dulin has repeatedly shown a willingness to misstate facts in Opposer's favor and does so at least twice his sworn Declarations.

In the first instance, Opposer alleges to have diligently policed Opposer Marks and alleged that his policing of a Ferrier blog through its comments section was satisfactory because the offending blog thread was terminated and no longer active. (Conf. Dulin Decl. ¶ 7). The thread, however, remains accessible with the allegedly policed use. (Conf. Alley Decl. ¶¶ 9-11;

Alley Decl. Ex. SS1) Further, Dulin's comment is still visible on the blog and reveals no attempt at policing. (Id.) The second instance is with regard to Opposer ILG's "continuous use" of Opposer Marks since 1996. ILG's continuous use of Opposer Marks from 1996 is not possible, because ILG admittedly did not exist continuously until 2000. (Conf. Alley Decl. ¶¶ 2-8). In his rebuttal Declaration, Dulin admits that Opposer Marks were for personal use, not Opposer ILG's use prior to 2000. (Rebuttal Dulin Decl. ¶ 3) These factual misstatements show Dulin's willingness to misconstrue facts in this proceeding, and his testimony should be given accordingly less weight.

The Declarations of Laurel Black are objected to under FRE 702. Particularly, Black has no training or experience in marketing for legal services in IP. Rather, she is a general brand consultant with no special knowledge, expertise, or familiarity with the IP legal services marketplace. (Black Decl. ¶¶ 1-3, Ex. A) As such, Black's testimony directed toward the commercial impression and confusable meaning in the niche IP legal services marketplace is not helpful to the Board to understand the Marks at issue in the context of the controlling field of use. FRE 702(a). Moreover, Black's testimony does not cite any dictionary or common usage in explaining the Mark's definition and commercial impact or otherwise explain how Black came to the conclusions of Mark significance or strength as indicators of sources of IP legal services. As such, Black's testimony is not based on sufficient facts and does not explain its method of reaching its conclusions of commercial impression of the Marks in IP legal services. FRE 702(b), (c). Black's testimony should be either excluded or given only lay weight in light of these shortcomings under FRE 702.

The Rebuttal Declaration of Jacques M. Dulin and exhibits thereto are objected to as including impermissible rebuttal evidence where they include additional evidence of policing (Rebuttal Dulin Decl. ¶ 9, Exs. 23-25), mark fame (Rebuttal Dulin Decl. ¶ 7), and additional registrations (Rebuttal Dulin Decl. ¶ 13, Exs. 23, 24, 26) that should have been pled and, at a minimum, proffered with all other evidence of registrations, and fame policing during Opposer's trial period. This new rebuttal evidence is not offered to undercut any point in Applicant's case in chief, but rather to shore up Opposer's initial case. Applicant has never seen these additional registrations, policings, or fame and as such never has any ability to debunk or offer evidence about the same. "It is axiomatic that rebuttal testimony may be used only to rebut evidence offered by the defendant." Life Zone Inc. v. Middleman Group Inc., 87 U.S.P.Q.2d 1953, 1958 (T.T.A.B. 2008).

Lastly, Opposer makes 91 pages worth of objections to Applicant's Evidence in its Appendix. (Opp. Main Brief Appx.) Many of these objections are utterly meritless. Unfortunately, Applicant ran out of time to respond to each and every objection individually, and asks the Board to deny Opposer's objections where excessive and frivolous. The objections are addressed in bulk categories below where feasible.

First, Opposer repeatedly objects to nearly every piece of Applicant's evidence of third party use as "not produced during discovery." This is not a valid ground of objection; no Board Order compelling discovery was every sought or entered in this case. Nobelle.com LLC v. Qwest Communications International Inc., 66 U.S.P.Q.2d 1300, 1303 (TTAB 2003); TBMP §§ 527.01(a); 411.02. Moreover, public third party uses may be submitted, regardless of their being provided to an opposing party or a board order in place. *See* Rocket Trademarks, 98 U.S.P.Q.2d at 1070 (T.T.A.B. 2011) (accepting Internet evidence authenticated with testimony, despite evidence never being produced to opposing counsel with Board order in place). Most frustratingly, many of the objected to evidence was submitted to Opposer before discovery closed on July 18, 2013.[8] (Board Order of June 10, 2013, Dkt. No. 29, setting discovery to close on July 18, 2013). As such, Opposer's objections due to non-production should all be overruled.

Second, Opposer repeatedly objects to evidence of "third party use" as irrelevant descriptive fair use. As argued in the Brief, third party usage, regardless of infringing status, is always relevant to show descriptiveness. Nat. Data Corp., 753 F.2d at 1059-60 ("[t]hird-party

[8] Applicant would be happy to provide sworn testimony to this effect with emails showing true production prior to this date. Also, Opposer misstates in the Appendix, page 6, that Discovery closed on November 30, 2012. The cited Board Order clearly establishes otherwise.

usage can demonstrate the ordinary dictionary meaning of a term") (emphasis added); Tektronix, 534 F.2d at 917 (unused registrations useable like a dictionary to show descriptiveness); Zanova, 59 U.S.P.Q.2d at 1300 (considering prose in articles for mark descriptiveness); Rocket Trademarks, 98 U.S.P.Q.2d at 1077. Thus, Opposer's objections due to irrelevancy/fair use should be overruled.

Opposer's somewhat ironically includes, in its excessive objections, complaints that Applicant's evidence is excessive. (Opposer Appx. at 5) Outside of the AIPLA report, Applicant and Opposer submitted a similar volume of evidence (~400 pages). As argued in the Brief, and discussed in the Broadway Chicken, Chamber of Commerce, and related cases on page 20 of the Brief, evidence of public use usually requires several corroborating uses from multiple sources to show public inurement to the same. The AIPLA reports were submitted in excerpts as well and pin-cited, but could not be further reduced without losing relevant data and methodology required to authenticate the reports. Frustratingly again, Applicant spent considerable time and effort submitting only unique, excerpted, and PIN CITED public uses of relevant phrases in the Alley Declaration paragraph 20 chart. Opposers complaints/objections of an excessive record should be overruled.

Opposer makes several hearsay objections against the submitted instructional Exhibits 9-18. Commands, instructions, and counsel are rarely hearsay – they are not submitted for their truth, but rather to show that they are spoken and for their effect on the listener, just as they are in Applicant's Brief. That is, it does not matter if guidance like "always ask for referrals when seeking and attorney and interview a potential IP attorney" is bad advice or factually incorrect;

the evidence is offered only to prove that it is advice offered to the consuming public. This is not hearsay.

Lastly, Opposer makes several objections to Google data and Wayback Machine evidence as hearsay and unreliable. Applicant has authenticated this data, and Opposer itself relies on and authenticates Wayback Machine evidence through its expert Kirk Thomas. Moreover, data is not hearsay. United States v. Moon, 512 F.3d 359, 362 (7th Cir.2008) ("[D]ata are not `statements' in any useful sense. Nor is a machine a `witness against' anyone. If the readings are `statements' by a `witness against' the defendants, then the machine must be the declarant. Yet how could one cross-examine a gas chromatograph?"); United States v. Lamons, 532 F.3d 1251, 1263 (11th Cir.2008) ("[T]he witnesses with whom the Confrontation Clause is concerned 345*345 are human witnesses[.]"); United States v. Washington, 498 F.3d 225, 230-31 (4th Cir.2007) ("[T]he raw data generated by the machines do not constitute `statements,' and the machines are not `declarants.' As such, no out-of-court statement implicating the Confrontation Clause was admitted into evidence ...."); *see also* Wright & Graham, § 6371.4. All Opposer's evidentiary objections should be overruled.