ESTTA Tracking number: **ESTTA621657**

Filing date: **08/15/2014**

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

Proceeding	91202418
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Date	08/15/2014
Attachments	2014-08-15-ILG v. ALLEY-Opposer's Reply Brief w Appendix.pdf(808619 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application
Serial No. 85/342,228
For the mark BUILDING ASSETS FROM IDEAS
Published in the Trademark *Official Gazette* on November 1, 2011

Innovation Law Group, Ltd., Opposer, v. Ryan E. Alley, DBA Ryan Alley Intellectual Property Law, Applicant.	Opposition No. 91202418 **OPPOSER'S REPLY BRIEF**

Opposer, Innovation Law Group, Ltd. ("Opposer" or "Innovation Law Group"), through its undersigned counsel, hereby submits its Reply Brief in support of its opposition to the attempted registration of the mark BUILDING ASSETS FROM IDEAS by Applicant, Ryan E. Alley, DBA Ryan Alley Intellectual Property Law ("Applicant").

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I. OBJECTION TO APPLICANT'S TARDY "CORRECTED" BRIEF.

Applicant admits that he "ran out of time", filed an error-filled trial brief on the deadline, then filed a "corrected" trial brief a day late. However, a review of the documents reveals that Applicant did more than make corrections in the "corrected" brief; he added additional case law and entirely new arguments. Opposer objects to Applicant's admittedly late-filed brief and requests that it be stricken. Opposer's response to the arguments in Applicant's late-filed brief is not a waiver of Opposer's objection, which is maintained.

II. REPLY TO APPLICANT'S ARGUMENTS.

A. Applicant Misstates the Standard.

Applicant misstates the standard by arguing that: "Each of the relevant *DuPont* [Sic] 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." (Applicant's "Corrected" Brief (hereafter, "Brief"), pg. 13.) This is wrong. First, only the factors for which evidence has properly been made of record should be considered. "As the *duPont* court explains, the relevant factors, '*when of record*, must be considered.'" *Cunningham v. Laser Golf Corp*., 222 F.3d 943, 946 (Fed. Cir. 2000), *quoting Application of E.I. duPont de Nemours & Co*., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) (emphasis in original). Second, there is no authority for requiring Opposer to overcome a separate burden-of-proof hurdle for each factor individually. Instead, the Board should weigh and consider all the admissible evidence, and then refuse registration if, on balance, Opposer has proven "by a preponderance of the evidence that there was a likelihood of confusion between the two marks." *See, e.g., id*. at 951.

B. Applicant Admits Standing and Priority.

Applicant did not dispute that Applicant has standing to challenge the registration of Applicant's mark, and has priority as memorialized in the Board's order of June 1, 2012. (Brief, pg. 13.)

C. Likelihood of Confusion.

1. Applicant Admits that the Parties' Services are Legally Identical.

Applicant did not dispute that the parties' services should be considered legally identical for purposes of determining likelihood of confusion. This "key" factor—identity of the services—weighs strongly in favor of likelihood of confusion. *Accord, Mattel Inc. v. Funline Merchandise Co*., 81 USPQ2d 1372, 1374 (TTAB 2006) (key considerations are similarities between the marks and goods recited in both parties' registrations).

2. Applicant Argues that the Parties Have Distinct Trade Channels, But *Completely Ignores The Internet*.

Applicant argues that because each attorney has different personal referral networks, they should be found to have different channels of trade under *duPont*. (Brief, pg. 40-41.) But "[t]he authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application ***regardless*** of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which sales of the goods are directed." *Octocom Sys., Inc. v. Houston Computer Servs., Inc*., 918 F.2d 937, 942 (Fed. Cir. 1990) (citing *numerous cases*, (emphasis supplied)). Here, the services are not limited to any particular trade channels, but rather cover all trade channels for legal services in IP. And as patent attorneys registered before the USPTO, their patent practices are nationwide. "Moreover, although a registrant's current business practices may be quite narrow, they may change at any time from, for example, industrial sales to individual consumer sales." *CBS Inc. v. Morrow*, 708 F.2d 1579, 1581 (Fed. Cir. 1983), *citing San Fernando Electric Manufacturing Co. v. JFD Electronics Components Corp*., 565 F.2d 683, 685, 196 USPQ 1, 2 (CCPA 1977). Parties that choose to recite services in their trademark application that exceed their actual services will be held to the broader scope of the application. *See Octocom Sys*., 918 F.2d at 943 (stating that a broad application "is not narrowed by testimony that the applicant's use is, in fact, restricted"). Notably, Applicant failed to provide

any evidence of his own "personal referral network", much less define it[1]. Here, Applicant did not restrict his statement of services to a channel of trade consisting of his existing personal network of customers. Moreover, Applicant glaringly ignores the channel of trade ubiquitously at everyone's fingertips, the Internet. In fact, other than the parties' present personal referral networks, their channels of trade are identical—websites on the Internet, USPTO and bar listings on the Internet, phone numbers listed on the Internet, and the list goes on. *See, e.g.,* Applicant's Specimen of Use (website printout); J. Dulin Decl. (Confidential), ¶ 9 ("We keep a call record of all telephone and website inquiries for our IP services …"). Applicant's argument that the trade channels at issue are anything other than legally identical is baseless and should be rejected.

This factor—identical channels of trade—weighs in favor of likelihood of confusion. *du Pont,* 476 F.2d at 1361, 177 USPQ at 567.

3. Applicant Admits that the Target Consumers are Legally Identical.

Applicant does not dispute that Applicant's and Opposer's recited intellectual property legal services would be bought by the same classes of purchasers. This factor—identical classes of purchasers—weighs in favor of likelihood of confusion. *duPont,* 476 F.2d at 1361, 177 USPQ at 567.

4. Applicant Is Wrong on the Law and the Facts of Consumer Sophistication.

a. The Least Sophisticated Consumers Are the Relevant Ones.

Applicant argues that "the IP legal services marketplace [is] populated by careful consumers seeking expensive, commercial, professional services provided by a licensed attorney." (Brief, pg. 14.) Although the services recited in the application can be provided to sophisticated IP professionals, Board precedent requires that the likelihood of confusion decision be based "on the least sophisticated potential purchasers." *Stone Lion Capital Partners, L.P. v.*

[1] Applicant has no knowledge of Opposer's personal referral network, which includes many years of working in the Washington DC metro area and persons who have lived and worked in Government, including the US PTO, and in DC law schools and patent/trademark firms. Finally, assuming a "personal referral network" is a channel of trade, the ***nature of the channel per se*** is what is identical, not different.

Lion Capital LLP, 746 F.3d 1317, 1325 (Fed. Cir. 2014) ("Although the services recited in the application also encompass sophisticated investors, Board precedent requires the decision to be based 'on the least sophisticated potential purchasers.'"), *quoting Gen. Mills, Inc. v. Fage Dairy Proc. Indus. S.A.*, 100 U.S.P.Q.2d 1584, 1600 (T.T.A.B.2011), *judgment set aside on other grounds*, 2014 WL 343267 (T.T.A.B. Jan. 22, 2014). *See also, Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir.1991) (stating, in the context of a trademark infringement case, that "when a buyer class is mixed, the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the ***least sophisticated consumer*** in the class") (emphasis added).

b. Applicant's Professed Lack of Understanding of How Divorce and Other Non-Commercial Legal Matters Can Fall Within IP Legal Services Does Not Refute the Evidence.

Experienced IP practitioners know that IP matters come up in a wide variety of legal contexts. *See* J. Dulin Rebuttal Decl. (filed April 14, 2014), ¶ 8. For instance, each time there is a divorce, any IP owned by one of the spouses, such as a patent, trademark, or copyright applicant or owner, may be part of the marital estate and handled as part of the divorce. *See, e.g., Enovsys LLC v. Nextel Commc'ns, Inc.*, 614 F.3d 1333, 1335-44 (Fed. Cir. 2010) (analyzing California divorce law to determine patent ownership issues). Similar issues arise with bankruptcy, succession planning, and other areas of law as set forth in Opposer's declaration paragraph 8 cited *supra*. Applicant counters that some dictionaries mention that IP relates to commercial matters, so IP consumers must all be sophisticated. (Brief, pg. 35.) In contrast to Applicant's theoretical dictionary-based arguments, Opposer's testimony on this topic is based on decades of actual experience with real IP legal practices. Accordingly, Applicant's "Response to Opposer Arguments of Non-Sophistication" should be accorded no weight.

c. Applicant Argues—Incredibly—that IP Scam-Prevention Warnings Are Not Directed to Consumers of IP Legal Services.

Applicant argues that "scam-prevention warnings for invention promoters and government copyists … 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." (Brief, pg. 36.) Applicant's argument is nonsense. ***Of course*** IP scam-prevention warnings are directed to precisely the same consumers to which IP legal service providers market—inventors and authors—the creators of IP. It is because of these scam-prevention warnings that many inventors and authors decide to consult IP counsel, as the warnings suggest they should. *See* J. Dulin Decl. (Confidential), ¶ 11, Ex. 18. That inventors and authors are often duped by invention promoters and government copyists is certainly telling regarding their frequent lack of sophistication in selecting service providers.

This factor—which even the USPTO recognized as having a substantial segment of unsophisticated consumers of IP legal services—weighs in favor of likelihood of confusion. *Accord, Stone Lion Capital Partners, L.P.*, 746 F.3d at 1325; *du Pont,* 476 F.2d at 1361, 177 USPQ at 567.

5. <u>Applicant's "Third-Party" Evidence,[2] Were It To Be Considered, Is Not Probative</u>.

Applicant argues in its brief that there is extensive use by third parties of marks containing the same or similar terms as Opposer's mark in connection with IP-related services, such that consumers could easily distinguish between the parties' marks when viewed in their entireties.[3] (*See, e.g.,* Brief, pg. 7-9.) In support, it relies on numerous alleged third-party uses and registrations. *See, e.g., id*., at pg. 7-9, 27. On this record, even if Opposer's evidentiary objections are overcome and all of Applicant's alleged evidence is considered, the Board cannot conclude that there has been the impact in the marketplace that Applicant asserts. **First**, third-

[2] Opposer has objected to the admissibility of Mr. Alley's declaration(s) and purported evidence and Opposer stands on those objections and does not waive them by responding to them in this Reply. Rather, Opposer addresses Applicant's purported evidence in the alternative, in the event the Board does consider Mr. Alley's declaration(s) and any of its exhibits over the objections of Opposer.

[3] At pages 15, 47 and 48 of his Corrected Brief, Applicant quotes *In re Nat. Data Corp*., 753 F.2d 1056, 1059-60 (Fed. Cir. 1985) as stating that "[t]hird-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade." Not only is that unnecessary and irrelevant for this case, *In re Nat. Data Corp*. states no such thing.

party registrations are not evidence that the registered marks actually have been used in commerce. **Second**, the alleged evidence of third-party uses is not accompanied by any non-hearsay evidence indicating the length of time said uses have been in use, the degree of exposure, or the popularity of such uses or marks vis-à-vis the relevant purchasing public. The precedential TTAB case *Top Tobacco, L.P.* is directly on-point:

> North Atlantic argues in its brief that there is extensive use by third parties of marks containing the term CLASSIC, for tobacco-related products, and "[i]t is clear … that both consumers and the Trademark Office have easily distinguished among these marks when viewing them in their entireties." Brief, p. 26. In support, it relies on numerous third-party registrations for marks containing the term CLASSIC as well as several examples of use of the same term either as an element of a mark or being used in the description of the goods. … On this record, we cannot conclude that there has been such an impact in the marketplace as a result of the term CLASSIC being widely used in marks on tobacco products. Third-party registrations, as acknowledged by the parties, are not evidence that the registered marks actually have been used in commerce. As to the evidence of actual use of the term CLASSIC in third-party marks on tobacco products, this is not accompanied by any other evidence indicating the length of time said marks have been in use, the degree of exposure, or the popularity of such marks vis-à-vis the relevant purchasing public. Accordingly, this factor remains neutral in our analysis.

Top Tobacco, L.P., 101 U.S.P.Q.2d 1163, 2011 WL 6099691, *8-9 (Trademark Tr. & App. Bd. Nov. 21, 2011).

Third, even if various combinations of the words in Opposer's mark or analogous words have been used descriptively by others, their descriptive use "does not entitle applicant to use the words in a confusingly similar ***trademark*** manner."[4] *See Specialty Brands, Inc. v. Coffee Bean*

[4] To address a confusing aspect of Applicant's Brief, Opposer has objected that fair uses of various phrases are not third-party "**trademark**" uses and thus are irrelevant under the sixth *duPont* factor. *duPont*, 476 F.2d at 1361. In response, Applicant argues that Opposer's fair use objections constitute admissions of descriptiveness. (Brief, pg. 15.) But Applicant is not claiming descriptive fair use of Opposer's Mark; rather, Applicant is claiming that its similar phrase is a ***trademark***. Thus, Applicant's arguments regarding descriptive fair use are inapplicable. Then at pages 15, 47 and 48 of his Corrected Brief, Applicant quotes *In re Nat. Data Corp*., 753 F.2d 1056, 1059-60 (Fed. Cir. 1985) as stating that "[t]hird-party usage can demonstrate the ordinary dictionary meaning of a term or the meaning of a term to those in the trade." However, *In re Nat. Data Corp*. neither states that nor anything similar. Nonetheless, if Applicant is now citing these numerous alleged third-party uses for the limited purpose of showing the meaning of various words in normal English (*In re Zanova*, 59 U.S.P.Q.2d 1300

Distributors, Inc., 748 F.2d 669, 675-76 (Fed. Cir. 1984) ("Descriptive use of the word "spice" does not entitle applicant to use the word in a confusingly similar trademark manner.") (emphasis added).

Accordingly, even if Applicant's evidence is considered, the sixth *duPont* factor regarding the number and nature of similar *marks* in use on similar goods should remain neutral in the Board's analysis. *See Top Tobacco, L.P.*, 101 U.S.P.Q.2d 1163. *Accord, AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403; 177 USPQ 268, 269 (CCPA 1973) (even the registration of other, arguably confusing marks does not give applicant the right to register another confusing mark).

6. Applicant Admits That His Mark On His Website Was Not Searchable.

Applicant does not dispute that his mark was not searchable via the Internet during the relevant time period. *See* K. Thomas Decl. (filed December 5, 2013), ¶¶ 5-13. *See also,* J. Dulin Decl. (Confidential), ¶ 12, Ex. 20. Nonetheless, Applicant argued that confusion is unlikely because there was not yet a record of actual confusion. The Board has already decided that this is an irrelevant point in this case that has no bearing on the question of likelihood of confusion. *See* Dkt. # 29, pg. 6, fn. 6. For at least both these reasons, the actual confusion factor is neutral.

7. Applicant Failed to Rebut Opposer's Evidence that TRANSFORMING IDEAS INTO BUSINESS ASSETS is Strong.

a. Applicant provided no testimony from others, expert or otherwise; just his own uninformed and obviously-biased, self-serving opinions

In arguing that "Opposer Marks are Weak" (Brief, pg. 14), Applicant provided no testimony from others, expert or otherwise; just his own obviously-biased, self-serving opinions regarding marketing and public-perception matters in which he has no training or independent experience. (This is equally true of Applicant's four other arguments that "Applicant Mark is

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(T.T.A.B. 2001), cited by Applicant), then Applicant's cites are entirely unnecessary and excessively prolix. Unlike *In re Zanova*, where there was a question whether the term "Itools" had a non-trademark meaning, here none of the words in the marks are claimed to be a coined term; they are plain English. So the point remains that the cites objected-to for not being trademark uses, in fact are not trademark uses and are irrelevant.

More Different than Similar to Opposer Marks," "Legal Services in IP are Consumed with Great Care," "The Extent of Potential Confusion is De Minimus," and "Opposer and Applicant Marks' Services Overlap but have Distinct Trade Channels," (Brief, pg. 14-41).) Throughout his briefing, ***Applicant substitutes pure speculation for competent evidence***. (*See, e.g.*, Brief, pg. 31-32, "These third parties have ***likely*** used these marks because they, like Applicant, have never heard of Opposer…."; "an opposition was directed toward a small applicant who abandoned its mark, ***likely*** to avoid the expense of defending even a meritless opposition."; "These [spending] values ***appear*** small[.]", emphasis added.) Applicant's arguments based on his subjective beliefs and speculations should be excluded. *Corporacion Habanos, S.A.*, 102 U.S.P.Q.2d 1085 (Trademark Tr. & App. Bd. Feb. 16, 2012) ("testimony that is based upon 'subjective belief' or 'unsupported speculation' is excluded."), *citing Harris v. Koenig*, 815 F.Supp.2d 6, 2011 WL 2531257, at *1, (D.D.C. June 27, 2011) (*quoting Ambrosini v. Labarraque*, 101 F.3d 129, 135-36 (D.C. Cir. 1996)).

In stark contrast, Opposer provided unbiased competent expert evidence (unrebutted by Applicant). Notably, nationally renowed expert, Laurel Black, extensive qualifications include:

> 2. I am the principal of Laurel Black Design, a corporation (herein LBD), located in Port Angeles, WA. As part of LBD, I provide local, regional and national clients with award-winning corporate identity, brand building, communications and business collateral. My work though LBD has received national and local recognition regularly since 1992. In particular, brand identities I have created or supervised though LBD have consistently earned awards in national design competitions. Throughout my many years of experience in the branding industry, I have developed particular expertise in developing and evaluating trademarks for products and service marks for goods, as well as tag lines. As part of my duties at LBD I regularly create and evaluate marks and tag lines for clients, with an emphasis on understanding the likely impact of the sight, sound and meaning of the marks, including the impact on consumers of tag lines associated with the clients' goods and services in the clients' market, when communicated through the clients' marketing channels, especially in view of competitors' marks and tag lines. [Testimony Declaration of Laurel Black, paragraph 2.]

Substantively, Ms. Black's testimony is compelling, and again unrebutted by Applicant:

> 5. Both of the marks at issue are word marks as distinct from logos or composite marks (logos + words), and both function as branding "taglines," telling the prospective client the strategic goals the respective firms offer, with respect to

providing the legal services. Taglines, also known as slogans, function to provide prospects with a condensation of the essence of the service or product offered, so they can quickly "get" what the firm can do for them. Such taglines are intended, in connection with services, to motivate the prospect to make initial contact, or in the case of an Internet presence, to click on the "Contact Us" button on the firm's web page. Such contact motivation is a key goal of professional services brand development taglines.

6. In this regard, the Registered mark of the Opposer is very distinctive in telling a prospect what the Opposer's suite of services does for them. It conveys a sense of process for the prospect, who we know has an idea, yet who may not have a clear concept of his or her goal. The taglines under consideration here are also distinctive in providing this goal: the development of the idea into an asset. For unsophisticated inventors, the taglines crystallize a path to a goal. For sophisticated inventors, or entrepreneurs and executives whose responsibility is to protect the Intellectual Property of a company, the tagline appears concisely expressive, and therefore shows that the firm understands that the company needs to convert its IP into assets, exactly what the prospect seeks. The insights provided by the tagline also self-evidently serve a client retention and loyalty-building purpose.
7. In analyzing the two marks, I note first that the dominant words are the same: "IDEAS" and "ASSETS." These dominant words are linked in phrasing conveying the meaning that one devolves from or into the other. That is done by a present participle of an action verb. Although the order of the dominant words is inverted in the Applicant's mark, the prepositions are converse, "FROM" being the inverse of "INTO," such that the meaning is the same. That is, inverting the order requires using the converse prepositions in order for the tagline to convey the necessary meaning. This usage does not constitute a significant difference in the sense of the message, in my opinion.
8. This is reinforced by the meaning of the present participles used: "BUILDING" meaning to develop or give form by combining materials or parts; and "TRANSFORMING" meaning to change the form, nature or function. For example, in constructing a building, one transforms a pile of bricks and lumber into a new form that has a new function. Significantly, the Applicant did not use "CONSTRUCTING", but rather used a transformational word, "BUILDING." There is essentially no difference between "BUILDING ASSETS FROM IDEAS" and "BUILDING IDEAS INTO ASSETS." Further, the contact motivational incentive of "BUILDING" is no different, essentially, than "TRANSFORMING."
9. The Registered mark also uses the modifier "BUSINESS" as to "ASSETS", viz "BUSINESS ASSETS" as the result of the "TRANSFORMING" process. In my opinion, that is not a critical difference for several reasons. This speaks to the entrepreneur and the businessman. And on reflection, an individual unsophisticated inventor will have another realization that the "ASSETS" goal is not some inchoate asset, but an asset from which he can make money. The individual inventor does not need or want a patent to put on the wall for show, but has a monetizing goal. Thus, the tagline additionally incents the inventor by providing a focused goal.

10. Accordingly, I conclude that Applicant's mark is a mere variation of the Registered mark, conveying the same meaning and functioning in the same way as a contact incentive, with the only differences being syntax. In my opinion, speaking as they do to the same class of trade and offering identical services via the Internet, there is a likelihood of confusion between them.

Indeed, as shown in Exhibit 21 to the Dulin testimony declaration, the gears on Opposer's web site rotate so that it demonstrates **Ideas → Assets**, and the converse **Assets ← Ideas**:

Applicant's total failure to provide any informed, non-biased testimony starkly contrasts with Opposer's corroboration of its arguments with testimony from several knowledgeable, disinterested witnesses in addition to Opposer's principal. With Opposer's evidence of long use and advertising of its incontestable marks unrebutted by any competent evidence, the proven strength of Opposer's mark should favor a likelihood of confusion.

8. <u>The Marks Are Confusingly Similar</u>.

a. Applicant Improperly Dissects the Marks Instead of Considering Each as a Whole.

Applicant argues that "nobody would look to most parts of these slogans to discern a service source." (Brief, pg. 14.) But that is an irrelevant argument, because the marks are to be

considered in their entireties. *Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d 1399, 1402, 181 USPQ 272, 273–74 (CCPA 1974); *see Franklin Mint Corp. v. Master Mfg. Co*., 667 F.2d 1005, 1007, 212 USPQ 233, 234 (CCPA 1981) ("It is axiomatic that a mark should not be dissected and considered piecemeal; rather, it must be considered as a whole in determining likelihood of confusion."). Then Applicant argues: "In the limited aspects where consumers might consider Opposer Marks as unique or associated with a particular provider, they markedly differ from Applicant Mark." (Brief, pg. 14.) Again, Applicant's argument is meaningless rhetoric, because the marks must be considered as a whole, not "limited aspects" of the marks. Applicant repeatedly falls into the trap of tediously dissecting the marks side-by-side and analyzing their nuanced linguistic differences in excruciating detail. (*See, e.g*., Brief, pg. 28 ("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.")) Further it ignores the function of a slogan as pointed out succinctly in the Black Declaration, quoted above. Mark component dissection is not what consumers do, nor is it how likelihood of confusion is analyzed. "The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison[.]" TMEP §1207.01(b), c*iting Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1897 (Fed. Cir. 2000). Applicant's specious musings are not only biased but are plainly irrelevant.

b. Applicant Conflates "Commercial Impression" with the Scope of the Trademark Right.

Opposer has presented competent evidence of what is obvious on its face, namely that the high-level commercial ***impression*** of both parties' marks is essentially "**Ideas → Assets**". But Applicant seizes on this to set-up, then knock-down, a straw-man argument that Opposer never made, namely, that Opposer has the right to stop ***all*** uses of any marks that share that overall commercial impression. (Brief, pg. 26-27.) Opposer never argued that it has the right to stop others from using any and all marks that share the overall commercial impression "**Ideas → Assets**". While the commercial impression is important, it is just one piece of the likelihood of

confusion analysis. *duPont*, 476 F.2d at 1361 (Factor (1): "The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.")

c. Likelihood of Confusion Exists Regardless Whether Confusion is Later Cured.

Applicant ignores what happens on the Internet, where just the trademarked slogan may be visible, and then the consumer follows the link to the competitor's page, all before the true identity is revealed. Applicant's repeated excuse is that "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" due to "several regulations and the nature of how all IP legal services are marketed and provided …." (Brief, pg. 13-14; 33-35.) Specifically, Applicant argues that the client intake process will inform the client of the attorney's true identity before a sale is consummated, so there will be no likelihood of confusion. (*Id.*) But Applicant's repeated theme misses the point: by the time a consumer has engaged with Opposer as a result of his confusingly similar slogan mark, it is too late—the damage has already been done. This is initial interest confusion, and Opposer has the right to prevent this. *See HRL Associates Inc. v. Weiss Associates Inc.*, 12 U.S.P.Q.2d 1819, 1989 WL 274391 (Trademark Trial & App. Bd. 1989), *aff'd on other grounds*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840 (Fed. Cir. 1990) (Initial interest confusion is actionable under Lanham Act § 2(d) in PTO *inter partes* proceedings.) McCarthy is on-point in explaining initial interest confusion and why it is actionable in cases like this one, even where there may be an extended purchasing process by sophisticated consumers. *See* 4 McCarthy on Trademarks and Unfair Competition § 23:6 (4th Ed.).[5]

[5] **Initial Interest Confusion Defined**. Infringement can be based upon confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion. *See Bruzga*, "Sophisticated Purchaser Defense Avoided Where Pre-Sale Confusion is Harmful," 78 Trademark Rep. 659 (1988). Most courts now recognize the initial interest confusion theory as a form of likelihood of confusion which can trigger a finding of infringement. [extensive citations omitted] …
Initial Interest Confusion on the Internet: … *Promatek Industries, Ltd. v. Equitrac Corp.*, 300 F.3d 808, 63 U.S.P.Q.2d 2018 (7th Cir. 2002), *as amended*, (Oct. 18, 2002) (…"Customers

Likewise, even if the parties' true identities are eventually revealed to consumers, consumers may be confused whether the parties are somehow sponsored, connected, or otherwise affiliated, especially since the services are identical. This too constitutes an impermissible likelihood of confusion, separate and apart from initial interest confusion. *See generally,* 4 McCarthy on Trademarks and Unfair Competition § 23:8 (4th ed.) ("Whose confusion and about what?—Confusion as to affiliation, connection, or sponsorship"); *Champions Golf Club v. Champions Golf Club*, 78 F.3d 1111, 38 U.S.P.Q.2d 1161 (6th Cir. 1996) (In case of alleged confusion between two golf courses, both named CHAMPIONS, the

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believing that they are entering the first store rather than the second are still likely to mill around before they leave. The same theory is true for websites.") …

Extended Purchasing Process. Initial interest confusion analysis may be applied to a purchasing process that is drawn out over a period of time. For example, the likelihood that a potential purchaser of a specialized computer program may be drawn to the junior user, thinking it was the senior user, is actionable "confusion" even if over the course of several months of the purchasing decision-making process, the buyer's confusion is dissipated. Such a senior user who is the opposer may suffer injury "if a potential purchaser is initially confused between the parties' respective marks in that opposer may be precluded from further consideration by the potential purchaser in reaching his or her buying decision." *HRL Associates, Inc. v. Weiss Associates, Inc*., 12 U.S.P.Q.2d 1819, 1989 WL 274391 (T.T.A.B. 1989), *aff'd on other grounds*, 902 F.2d 1546, 14 U.S.P.Q.2d 1840 (Fed. Cir. 1990) (Initial interest confusion is actionable under Lanham Act § 2(d) in PTO inter partes proceedings. A senior user/opposer may suffer injury "if a potential purchaser is initially confused between the parties respective marks in that opposer may be precluded from further consideration by the potential purchaser in reaching his or her buying decision." Here, the likelihood of initial interest, pre-sale confusion overcomes the sophisticated purchaser defense. The court of appeals expressly avoided reaching the issue of initial interest confusion.). …

Even though the customer subsequently may realize the true source of the product before the sale is consummated, the confusing similarity of appearance has attracted the consumer and induced him or her to consider purchasing the product. "Defendant has already accomplished what it set out to do, which is to confuse the consumer at the point when he first reaches for the product on the shelf. It is at that point that the damage is done." [*McNeil-PPC v. Guardian Drug Co*., 984 F. Supp. 1066, 45 U.S.P.Q.2d 1437, 1443 (E.D. Mich. 1997).]

An Analogy. The analogy to trademark initial interest confusion is a job-seeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or a "typo." The misrepresentation has enabled the job-seeker to obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.

4 McCarthy on Trademarks and Unfair Competition § 23:6 (4th ed.).

issue is not whether golfers are confused about which course they are playing on, but rather, whether the courses are affiliated. "[T]his is the ultimate question to be answered in the likelihood of confusion inquiry. … The relevant question is whether a golfer, albeit sophisticated, would likely be confused about affiliation between the two clubs [both named CHAMPIONS]."); *Hartman, "Subliminal Confusion: The Misappropriation of Advertising Value*," 78 Trademark Rep. 506 (1988). *See also, Famous Horse Inc. v. 5th Ave. Photo Inc*., 624 F.3d 106, 108, 96 U.S.P.Q.2d 1963, 2010-2 Trade Cas. (CCH) ¶ 77278 (2d Cir. 2010); *Ferrari S.p.A. Esercizio Fabriche Automobili e Corse v. McBurnie*, 11 U.S.P.Q.2d 1843, 1989 WL 298658 (S.D. Cal. 1989); *Ferrari S.p.A. Esercizio Fabriche Automobili E Corse v. Roberts*, 944 F.2d 1235, 20 U.S.P.Q.2d 1001, 1009–1010 (6th Cir. 1991) ("The Lanham Act, however, was intended to do more than protect consumers at the point of sale. … Ferrari's reputation in the field could be damaged by the marketing of [defendant's] replicas … despite the absence of point of sale confusion.").

The bottom line is that likelihood of confusion exists regardless whether confusion is later cured, a point that is not addressed at all in Applicant's arguments.

d. Opposer's Nonprecedential Cases Are Persuasive.

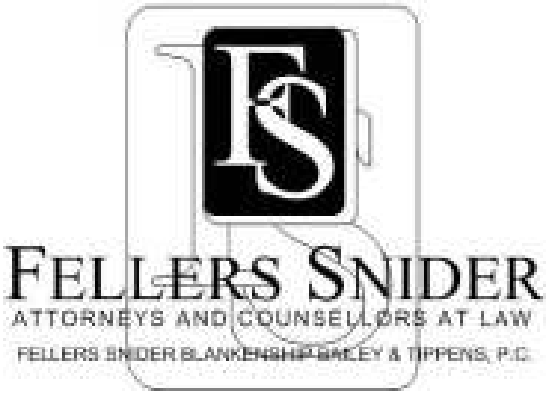
Bennett Law Office, PC[6] is properly cited pursuant to TBMP 801.03 for its persuasive value in reaching a similar conclusion on similar facts. Similarly, *Fraser Stryker Meusey Olson Boyer & Bloch, P.C.* is properly cited pursuant to TBMP 801.03 for its persuasive value in reaching a similar conclusion on similar facts.

See also, In re Luxuria s.r.o., 100 USPQ2d 1146, 1151 n.7 (TTAB 2011) (parties may cite to non-precedential decisions, but they are not binding on the Board). While non-precedential, these cases are informative and persuasive here. In *Bennett Law Office, PC v.*

[6] Applicant's falsely claims that Opposer stated that *Benett Law* Office was significant precedent in the TTAB. *See*, Brief p. 29. Yet, if one reads Opposer's brief the reference to significant precedent in the TTAB and Federal Courts is in another earlier paragraph citing different cases. *See,* Opposer's Main Brief, p. 46.

Burrus Intellectual Property Law Group, OPPOSITION 91177164, 2009 WL 1017290 (Trademark Tr. & App. Bd. Mar. 26, 2009), a factually analogous case between two law firms, the Board observed that "[t]he purchasers of legal services consist of the full range of the general public." *Id*. at *3 "Thus, while we can assume that at least a substantial portion of the purchasing public will exercise care in choosing an attorney, even knowledgeable, careful consumers are not necessarily knowledgeable about trademarks and are not immune from confusion, especially when the services are identical." *Id*., citing *In re General Electric Company*, 180 USPQ 542 (TTAB 1973). Even though the legal services here are IP-related, the same reasoning still applies, because a good portion of inventors and authors are drawn from the general public that is unknowledgeable about trademarks and apt to be confused by similar marks since the services are identical. *Accord, id*.

Moreover, in *Fraser Stryker Meusey Olson Boyer & Bloch, P.C. v. Fellers, Snider, Blankenship, Bailey & Tippens, P.C.*, OPPOSITION 91166088, 2007 WL 1893925 (Trademark Tr. & App. Bd. June 25, 2007), another factually analogous case between two law firms, the applicant argued that there was no likelihood of confusion because "Applicant has incorporated into its mark the actual identity of the source of the services, as well as the services being offered." *Id*. at *4. But the Board still found a likelihood of confusion, even though the Applicant's full firm name was written directly on the mark:



Applicant's Mark, Ruled Confusingly Similar, Notwithstanding Firm's Name On The Mark

Opposer's Mark

Thus, *Fraser* is thus another example of why Applicant's primary argument—that consumers will eventually figure out who he is—is no defense to likelihood of confusion.

For at least all the foregoing reasons, the BUILDING ASSETS FROM IDEAS mark is likely to cause confusion, either by improperly diverting initial interest away from Opposer, or by leading Innovation Law Group's customers and prospective customers to believe that Applicant's IP legal services are somehow affiliated or associated with Innovation Law Group's long-established TRANSFORMING IDEAS INTO BUSINESS ASSETS practice, e.g., as an affiliate physically local to the US Patent and Trademark Office. The Parties' Marks are sufficiently similar, in view of the identity of the Parties' services and the other factors discussed previously, that there is a likelihood of confusion. *duPont*, 476 F.2d at 1361, 177 USPQ at 567. This is true regardless whether the Board determines that Opposer's mark is weak or strong. *See King Candy Co. v. Eunice King's Kitchen, Inc*., 496 F.2d 1400, 182 USPQ 108, 109 (CCPA 1974) (likelihood of confusion is to be avoided as much between weak marks as between strong marks).

9. <u>Doubts as to Likelihood of Confusion are Resolved Against the Newcomer</u>.

Though Innovation Law Group believes that the merits of this case point strongly in its favor, should the Board possess any remaining doubt as to the likelihood of confusion, any such doubts should be resolved against the newcomer. "It is well settled that one who adopts a mark similar to another for closely related goods acts at his peril and any doubt there might be must be resolved against him." *Carlisle Chern. Works, Inc. v. Hardman & Holden Ltd*., 434 F.2d 1403, 1405 (CCPA 1970). *See also, A.T. Cross Company v. Jonathan Bradley Pens, Inc*., 470 F.2d 689, 692 (2d Cir.1972) (Friendly, J.) ("It should be known by this time that this Court does not look with much favor on the businessman who, out of the wealth of words available, chooses as a trademark one which comes as close as he dares to a well-known mark on the identical product").

10. Applicant's Trial Brief Makes Admissions Regarding Descriptiveness That Are Fatal To His Trademark Application Under Federal Circuit Precedent

While Applicant never pled that Opposer's registrations are invalid for descriptiveness, Applicant has argued at length that Opposer's mark TRANSFORMING IDEAS INTO BUSINESS ASSETS is descriptive of legal services relating to intellectual property law[7]. According to Federal Circuit precedent, Applicant cannot take the wholly inconsistent position of asserting that his mark BUILDING ASSETS FROM IDEAS is ***not*** descriptive of legal services in intellectual property in order to get a registration on the Principal Register yet, when opposed, assert that Opposer's no more descriptive mark for the same services is interfering with ordinary language usage. *Specialty Brands, Inc.*, 748 F.2d at 675-76, quoting *Squirtco v. Tomy Corp.,* 697 F.2d 1038, 1043, 216 USPQ 937, 940 (Fed.Cir.1983) (Applicant cannot take "wholly inconsistent" position of asserting that the mark is not descriptive of its goods in order to get a registration on the Principal Register and, when opposed, "assert that the opposer is interfering with ordinary language usage"). Specifically, in *Squirtco*, the Federal Circuit held:

> Tomy's further argument that SquirtCo should not be allowed to interfere with another's ordinary language usage of "squirt" is wholly without merit. This opposition does not raise a question of ordinary language usage. SquirtCo, as opposer [with the mark SQUIRT for soft drinks], seeks to preclude the recognition afforded by a registration of the proprietary rights which Tomy claims in SQUIRT SQUAD for toys. Tomy cannot, on the one hand, assert that SQUIRT SQUAD is not descriptive of its goods, which it must do in order to entitle it to registration on the Principal Register, and when opposed, assert that the opposer is interfering with ordinary language usage. This position is wholly inconsistent with the fact of Tomy's application.

SquirtCo v. Tomy Corp., 697 F.2d 1038, 1043 (Fed. Cir. 1983).

While prohibited by the Federal Circuit, that tactic is exactly what Applicant has employed here:

> 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.

[7] Of course, Applicant ignores that such a position is legally precluded by virtue of the fact that Opposer's registrations are incontestable.

(Brief, pg. 17.)

Applicant further alleges "the rampant and diverse use of 'transforming ideas into assets' and very close variants throughout the field of IP law" and alleged "competent and overwhelming evidence to show descriptiveness of mark terms[.]" (Brief, pg. 16, 15-22.) Applicant even argues that the record lacks "any evidence [of] suggestiveness, …" (Id. at pg. 22.). Absent any alleged suggestiveness, the allegedly abundant evidence of descriptiveness necessarily means that Opposer's mark is *allegedly* merely descriptive. *See, e.g., In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987) (reciting test to determine "[w]hether a given mark is suggestive or merely descriptive …"). Not only does Applicant confuse the burdens of proof, but Opposer's evidence of its incontestable registrations establish, as a matter of law, that its mark is *not* descriptive. Opposer's argument is merely an inappropriate collateral attack on Opposer's incontestable registrations.

Even apart from the legally deficient collateral attack against Opposer's registrations, Applicant's arguments apply at least equally to Applicant's own mark "building assets from ideas" for the same services.[8] In fact, Applicant's Mark is admitted as more descriptive than Opposer's, because Applicant argues that the word "transforming" in Opposer's mark is the only *possibly* suggestive aspect of the mark. (Brief, pg. 24 ("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")) (emphasis added.)

The death knell inconsistency in Applicant's argument is that Applicant's mark uses the straightforward term "building" instead of the allegedly "magical" word "transforming." (Brief,

[8] Note that by pointing out Applicant's fatal admissions against his own interest, Opposer neither necessarily concurs with Applicant's arguments nor waives its objections to Applicant's alleged evidence.

pg. 24.) Applicant's "building" assets phrase is thus necessarily less distinctive than Opposer's allegedly "magical" (*See id.* pg. 24) "transforming" assets phrase.

As an afterthought and in an attempt to extract himself from the quicksand, Applicant weakly asserts that the word "building" is *fanciful* (Brief, pg. 25). Yet that assertion is wholly inconsistent with Applicant's many pages of arguments and hundreds of pages of purported evidence allegedly showing that Opposer's mark is nothing more than descriptive of the services. (*Compare*, Brief, pg. 15-24.) If Opposer's more distinctive term is "descriptive," then how can Applicant have any hope of establishing that his admittedly less distinctive term is *not* descriptive. Accordingly, the substance of Applicant's arguments and alleged evidence necessarily establishes that his own mark does not distinguish his services from others but rather is merely a description — if not a generic statement — of the services of an IP lawyer. (*See* Applicant's Brief, pg. 15-24.) As such, Applicant is not entitled to registration of his mark.

Under the law, Applicant is judicially estopped from taking a position inconsistent with his lead argument that Opposer should not be allowed to interfere with another's ordinary language usage of "the forms and words "transform/ing," "ideas" and "assets" and broad impression of changing an idea into an asset" because those are allegedly "descriptive of IP legal services[.]" (Brief, pg. 17.) *See, e.g., Rissetto v. Plumbers and Steamfitters Local 343*, 94 F.3d 597, 600, 605 (9th Cir.1996) ("Judicial estoppel, sometimes known as the doctrine of preclusion of inconsistent positions, precludes a party from gaining an advantage by taking one position, and then seeking a second advantage by taking an incompatible position," either in the same action or in different actions.)

Applicant cannot, on the one hand, assert that "building assets from ideas" is not descriptive of IP legal services, which it must do in order to entitle it to registration on the Principal Register, and when opposed, assert that Opposer is interfering with ordinary language usage. "This position is wholly inconsistent with the fact of [Applicant's] application." *SquirtCo.*, 697 F.2d at 1043. Accordingly, Applicant's mark should be refused registration on this separate basis, which arose for the first time due to Applicant's own admissions in

Applicant's trial brief. *Accord, Specialty Brands, Inc.,* 748 F.2d at 675-76; *SquirtCo,* 697 F.2d at 1043; 15 U.S.C. § 1052(e)(1) ("No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—… (e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them").

III. CONCLUSION.

Opposer respectfully submits that a preponderance of the evidence indicates that there is a likelihood of confusion, and thus Opposer's Opposition should be sustained.

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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. 85/342,228
For the mark BUILDING ASSETS FROM IDEAS
Published in the Trademark *Official Gazette* on November 1, 2011

Innovation Law Group, Ltd.,

Opposer,

v.

Ryan E. Alley, DBA Ryan Alley Intellectual Property Law,

Applicant.

Opposition No. 91202418

APPENDIX IN REPLY TO APPENDIX TO DEFENDANT'S MAIN BRIEF

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The Confidential Declaration of Jacques M. Dulin of Dec. 5, 2013 is objected to by Applicant for bias, because Jacques M. Dulin is the principal of Opposer. But that is why his declaration was limited for the most part to hard facts, not subjective opinions. In contrast, Applicant's declaration, which is subject to even more incentives for bias since he is the applicant and is acting as his own advocate, is not at all limited to facts, but rather comprises mostly self-serving unsubstantiated opinions and speculation.

The Confidential Declaration of Jacques M. Dulin of Dec. 5, 2013 is next objected to by Applicant for inconsistency, but the two alleged inconsistencies are manufactured by Applicant through spin and word-play. These alleged inconsistencies were addressed in full in Opposer's trial brief and the Rebuttal Declaration of Jacques M. Dulin. First, a blog that no one has posted or commented to since the Opposer complained is, in fact, no longer active, but Applicant argues that this is a lie because the inactive blog can still be found on the Internet. This is pure semantics, not an inconsistency. The truth remains that Opposer policed its mark and the blog consequently became inactive. Second, Applicant objects to Opposer stating that "it" has used its marks continuously since 1996. But as shown in the record all along, "[a]ll references in this Opposition proceeding to ILG are references to Innovation Law Group, Ltd. and its predecessors, and that includes me." *See* J. Dulin Rebuttal Decl. (filed April 14, 2014), ¶ 3. Again, Applicant objection is to semantics, nothing substantive.

The Declarations of Laurel Black are objected to by Applicant under FRE 702 because Ms. Black's extensive training and experience in marketing and trademark selection has not been specifically for legal services in IP. But there is no requirement that Ms. Black's marketing expertise be in precisely the market presently at issue. *See Corporacion Habanos, S.A.,* 102 U.S.P.Q.2d 1085 (Trademark Tr. & App. Bd. Feb. 16, 2012) ("Rule 702 does not specify any particular means for qualifying an expert, requiring only that the witness possess the "knowledge, skill, experience, training, or education" necessary to "assist" the trier of fact.") (quoting Fed. R. Evid. 702); *Betterbox Commc'ns Ltd. v. BB Technologies, Inc*., 300 F.3d 325, 328 (3d Cir. 2002) ("Schulte's lack of experience in marketing the precise type of computer

components sold by these companies does not establish that the District Court abused its discretion in ruling that his qualifications met the standard of Rule 702.") Ms. Black's expertise is undeniable.

> 2. I am the principal of Laurel Black Design, a corporation (herein LBD), located in Port Angeles, WA. As part of LBD, I provide local, regional and national clients with award-winning corporate identity, brand building, communications and business collateral. My work though LBD has received national and local recognition regularly since 1992. In particular, brand identities I have created or supervised though LBD have consistently earned awards in national design competitions. Throughout my many years of experience in the branding industry, I have developed particular expertise in developing and evaluating trademarks for products and service marks for goods, as well as tag lines. As part of my duties at LBD I regularly create and evaluate marks and tag lines for clients, with an emphasis on understanding the likely impact of the sight, sound and meaning of the marks, including the impact on consumers of tag lines associated with the clients' goods and services in the clients' market, when communicated through the clients' marketing channels, especially in view of competitors' marks and tag lines. [Testimony Declaration of Laurel Black, Paragraph 2.]

Ms. Black brings real-world experience to evaluating the impact of trademarks and taglines on consumers, and her independent analysis provides a helpful unbiased perspective.

The Rebuttal Declaration of Jacques M. Dulin and exhibits thereto are objected to by Applicant 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). But this evidence is provided to factually rebut Applicant's unfounded arguments that Opposer's marks are merely descriptive and that Opposer lied about policing its mark. Accordingly, this rebuttal evidence was submitted for the proper purpose of denying, explaining, and discrediting applicant's assertions. *See The Ritz Hotel Limited v. Ritz Closet Seat Corp*., 17 USPQ2d 1466 (TTAB 1990) ("one may, on rebuttal, introduce facts and witnesses appropriate to deny, explain or otherwise discredit the facts and witnesses of applicant.")

Applicant's primary response to Opposer's objections—in his late-filed "Corrected" Main Brief—is that "Applicant ran out of time to respond" to them. (Applicant Brief, pg. 47.) Opposer did not seek to overburden Applicant or the Board with objections, but Opposer's numerous objections were occasioned by Applicant's numerous exhibits, to which Opposer was duty bound to timely object.

Applicant admits that at least a portion of his profuse "Internet evidence" was never produced during discovery. (Applicant Brief, pg. 47.) But Applicant asserts that this is nonetheless acceptable, citing *Rocket Trademarks,* 98 U.S.P.Q.2d at 1070 (T.T.A.B. 2011). But in *Rocket Trademarks,* the exhibits were objected to on the ground that they were not previously produced in response to opposer's document requests. *Id*. The Board in *Rocket Trademarks* ruled that there was no failure to comply with the document requests, because the documents ***did not exist*** at the time of the discovery requests. *Id*. But here, in contrast, the objection is both a failure to produce in discovery and that under Fed. R. Civ. P. 26(a)(1), at the start of the case Applicant was required to disclose "basic information about evidence that the disclosing party may use to support a claim or defense." Fed. R. Civ. P. 26(a)(1). Applicant was also under a continuing duty to timely supplement these initial disclosures, regardless of any discovery requests. Fed. R. Civ. P. 26(e). But Applicant did not do this, and instead chose to sandbag Opposer with a tremendous amount of unexplained website printouts at or after the close of discovery. Under Rule 37(c)(1), a party may not offer as evidence information that, without substantial justification, was not included in an initial disclosure or by supplemental disclosure. Fed. R. Civ. P. 37(c)(1). There was no justification for admittedly sandbagging Opposer with prolix production ***after*** the close of discovery.

Applicant argues that its citations to non-trademark fair uses of various phrases is relevant "like a dictionary to show descriptiveness." (Applicant Brief, pg. 48.) But Applicant is not claiming fair use of Opposer's Mark; rather, Applicant is claiming that its similar phrase is a ***trademark***. Thus, Applicant's argument's regarding non-trademark fair use makes no sense, as explained *supra,* at footnote 3. Nonetheless, Applicant argues that it was necessary to submit

approximately 400 pages of third-party registration and website evidence to show "public inurement" to the mark. (Applicant Brief, pg. 48.) But since third-party registrations are not evidence that the registered marks actually have been used in commerce, and the alleged evidence of third-party uses is not accompanied by any non-hearsay evidence indicating the length of time said uses have been in use, the degree of exposure, or the popularity of such uses or marks vis-à-vis the relevant purchasing public, Applicant's alleged evidence proves nothing. *Top Tobacco, L.P.*, 101 U.S.P.Q.2d 1163, 2011 WL 6099691, *8-9 (Trademark Tr. & App. Bd. Nov. 21, 2011). Accordingly, Applicant's voluminous alleged evidence is objectionable as belated, unnecessarily prolix, confusing, irrelevant, and unnecessarily burdening Opposer with the necessity of lengthy objections and the Board with review thereof.

Regarding hearsay, Applicant indicates that none of his alleged Internet evidence is offered for the truth of the matters asserted therein, but rather for its effects on an unidentified "listener". (Applicant Brief, pg. 48.) However, Applicant has provided no evidence that there have been any listeners. Thus, even if the statements are not hearsay, they are irrelevant. *Top Tobacco, L.P.*, 101 U.S.P.Q.2d 1163, 2011 WL 6099691, *8-9.

Finally, Applicant argues that his purported Google data and Wayback Machine printouts are neither hearsay nor unreliable. First, with respect to the Google data, regardless whether it is hearsay, it is without proper foundation and is accordingly inadmissible without authenticating and explanatory testimony from Google regarding the meaning of the data and its reliability. Accord, *United States v. Camez*, 2:12-CR-0004-APG-GWF, 2013 WL 6158402 (D. Nev. Nov. 21, 2013) (Order denying Google's motion to quash subpoena to appear and testify at trial to authenticate information obtained from Google and to provide foundation by explaining Google's data and policies and practices). Second, the Wayback Machine printouts are not admissible without competent foundation provided by someone with personal knowledge of how the website works and how reliable its contents are. *See, e.g., United States v. Bansal*, 663 F.3d 634, 667-68 (3d Cir. 2011) (directly on-point regarding Wayback Machine evidence; i.e., it

needs to be authenticated by someone with personal knowledge of how the website works and how reliable its contents are).

Here, Applicant is not qualified and does not purport to be qualified to lay the necessary foundation by testifying how the Wayback Machine website presently works and how reliable its contents are. Accordingly, Opposer's objections should be sustained.

Likewise, all of Opposer's objections that Applicant failed to address should be sustained as waived, since Applicant had time to sandbag Opposer with hundreds of pages of irrelevant purported website printouts but then "ran out of time" to respond to the objections that Applicant's actions necessitated.

INNOVATION LAW GROUP, LTD.

Dated: August 15, 2014

By: / s / Neil D. Greenstein
Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S REPLY BRIEF WITH APPENDIX** is being served on Applicant's Attorney of Record, by emailing said copy, in accordance with an email service agreement, on August 15, 2014 to the following:

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