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

Proceeding	91245121
Party	Plaintiff Alzheimer's Disease and Related Disorders Association
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Alzheimer's Disease and Related Disorders Association, Inc.	:	
	:	
Opposer,	:	
	:	Opposition No. 91245121
v.	:	
	:	
Alzheimer's New Jersey, Inc.	:	
	:	
Applicant.	:	

ALZHEIMER'S DISEASE AND RELATED DISORDERS ASSOCIATION, INC.'S CONSENTED MOTION TO RE-FILE ITS REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND RESPONSE TO APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT

Opposer, Alzheimer's Disease and Related Disorders Association, Inc. ("Alzheimer's Association"), respectfully submits this Consented Motion to Re-File its Reply in Support of its Motion for Summary Judgment and Response to Applicant's Cross Motion for Summary Judgment (the "Response"). In support of its Motion, Alzheimer's Association states as follows:

On November 14, 2019, Alzheimer's Association timely, but inadvertently, filed its Response to Applicant's Cross Motion for Summary Judgment in a pending matter before the Board (Opp. No. 91251201) involving the same parties.¹ Despite having inadvertently mis-filed its Response, Alzheimer's Association served Applicant's counsel with the Response by email and mail on November 14, 2019.

¹ The Motion appears as Docket No. 9 in that Proceeding. Opp. No. 91251201 has been suspended pending the outcome in this Proceeding.

Attached as Exhibit 1 is a copy of Alzheimer's Association's Reply in Support of its Motion for Summary Judgment and Response to Applicant's Cross Motion for Summary Judgment. Alzheimer's Association respectfully requests that it be considered as timely filed in the above-captioned Proceeding.

Applicant, Alzheimer's New Jersey Inc., consents to this Motion.

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CERTIFICATE OF MAILING

I undersigned certified that the foregoing CONSENTED MOTION TO RE-FILE ITS REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND RESPONSE TO APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA) this 18th day of November, 2019 with copies sent by electronic mail to:

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EXHIBIT 1

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

Alzheimer's Disease and Related Disorders Association, Inc.	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91245121
	:	
Alzheimer's New Jersey, Inc.	:	
	:	
Applicant.	:	

**ALZHEIMER'S DISEASE AND RELATED DISORDERS
ASSOCIATION, INC.'S REPLY IN SUPPORT OF ITS MOTION
FOR SUMMARY JUDGMENT AND RESPONSE TO
APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT**

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Alzheimer's Disease and Related Disorders Association, Inc. ("Alzheimer's Association" or "Opposer") respectfully submits its Reply in Support of its Motion for Summary Judgment (Dkt. No. 7 and 8) and Responds to Applicant, Alzheimer's New Jersey, Inc.'s ("Applicant"), Cross-Motion for Summary Judgment (Dkt. No. 10).

I. INTRODUCTION

The issues relevant to the Alzheimer's Association's Motion for Summary Judgment are the factors that inform a likelihood of confusion analysis. Rather than directly address those issues, Applicant misapplies fundamental trademark principles, adopts untenable legal positions, and raises untimely, eleventh hour legal theories to avoid an obvious conclusion. A likelihood of

confusion exists between Applicant's mark,  and Opposer's mark .

In an attempt to distract from the similarity in the marks, Applicant miscasts this Proceeding as part of a personal vendetta stemming from its disaffiliation from Alzheimer's Association. However, as Applicant itself points out, Alzheimer's Association did not seek to stop Applicant from organizing fundraising walks until Applicant decided to revise its mark to parrot that of the Alzheimer's Association. This is not the proverbial "David and Goliath" tale – except insofar as "David" is capitalizing on "Goliath's" size and fame. Applicant is hoping that it might divert fundraising dollars from the Alzheimer's Association's extraordinarily successful WALK TO END ALZHEIMER'S campaign by adopting a confusingly similar mark for identical services.

The parties' history is significant but only to the extent that, prior to its disaffiliation from the Alzheimer's Association, Applicant was entitled to use the WALK TO END ALZHEIMER'S in New Jersey as part of the Alzheimer's Association's WALK TO END ALZHEIMER'S long-standing, national campaign. Garza Aff. at ¶¶ 5, 6, 11, 23, 25 and Ex. E thereto; Roy Decl. at ¶ 4

and Ex. B at ¶¶; Zaentz Aff. at ¶ 6 and Ex. A thereto.¹ Applicant's involvement in these walks was as "Alzheimer's Association, Greater New Jersey Chapter." Nov. 14, 2019 Roy Decl. at ¶ 2, Ex. O (Applicant acknowledging on its own website that it was "formerly known as Alzheimer's Association, Greater New Jersey Chapter.") It is precisely the parties' former affiliation that makes it even more likely that consumers encountering Applicant's WALK TO END ALZHEIMER'S mark are more likely to believe that source of the mark, and the recipient of their fundraising dollars and efforts, is the Alzheimer's Association.

Applicant's focus on the extent to which it organized walks, its business status, the parties' disputes related to their disaffiliation, and transition issues following disaffiliation serve only to obfuscate the actual issues before the Board and have no bearing on the trademarks that are the subject of this dispute.

II. RESPONSE TO APPLICANT'S STATEMENT OF UNDISPUTED FACTS

Alzheimer's Association respond as follows to Applicant's Statement of Undisputed Facts:

1. Since its incorporation on or about March 14, 1985 and continuing to present, Applicant has always been a legally separate entity with its own 501(c)(3) tax exempt status that has engaged in charitable fundraising to support direct care and services in New Jersey for the benefit of persons and their families suffering from Alzheimer's disease; at no point has Applicant ever been owned by Opposer.

Response: Alzheimer's Association objects to this fact on the basis that it is not material to summary judgment but does not dispute it.

2. On April 23, 1988 Applicant and Opposer entered into a Statement of Relationship ("SOR") to memorialize their affiliation in order to further the parties' joint purposes relative to Alzheimer's disease. Zaentz Aff. at ¶ 6 and Exhibit A at ALZNJTAB0219 at § 2.2(a)-(e).

¹ Unless otherwise indicated by date, all references to the Garza Affidavit and Roy Declaration are to the sworn statements submitted with Alzheimer's Association's Motion for Summary Judgment (Dkt. Nos. 7 and 8). All references to the Taylor Declaration and Zaentz Affidavit are to the sworn statements submitted with Applicant's Response and Cross Motion for Summary Judgment (Dkt. No. 10).

Response: Alzheimer's Association does not dispute that the parties entered into an SOR but responds that the terms of the SOR speak for themselves.

3. During the time of the parties' affiliation under the SOR, Applicant and Opposer shared the monies raised from both of the parties [*sic*] fundraising efforts which resulted in an allocation of certain fundraising proceeds; the entirety of the funds raised by Applicant did not go exclusively to Opposer.

Response: Alzheimer's Association objects to this fact on the basis that it is not material to summary judgment. Subject to its objection, disputed. The parties' relationship was governed by the Statement of Relationship and Shared Fundraising Policy. Zaentz Aff. at Ex. A, § 7.

4. Applicant has always, including at all times during the parties' affiliation under the SOR, organized and created its own walks in order to raise money for its own purposes; Applicant has never organized said walks for Opposer's sole benefit or on its behalf. Zaentz Aff. at ¶ 8.

Response: Alzheimer's Association objects to this fact on the basis that it is not material to summary judgment. Subject to its objection, disputed. The WALK TO END ALZHEIMER'S events in New Jersey were organized as part of Alzheimer's Association's national WALK TO END ALZHEIMER'S campaign using the Alzheimer's Association's alz.org website as well as Alzheimer's Association's WALK TO END ALZHEIMER'S trademarks. Prior to its disaffiliation Applicant "represent[ed] the Association and its mission in the Territory..." and used the WALK TO END ALZHEIMER'S marks pursuant to a license. Zaentz Aff. at Ex. A, §§ 4.3, 5, 6; Garza Aff. at ¶¶ 6, 11 and Ex. E thereto.

5. Effective December 17, 2015 Applicant terminated its affiliation with Opposer under the SOR due in part to Opposer's lack of commitment to support local programs and services. Zaentz Aff. at ¶ 9 and at Exhibit B.

Response: Alzheimer's Association objects to this fact on the basis that it is not material to summary judgment. Subject to its objection, Alzheimer's Association does not dispute that the affiliation was effective in 2015, but disputes the date it was confirmed, which was on February 6, 2016. Garza Aff. at ¶ 24. Alzheimer's Association further disputes the basis for the disaffiliation,

which Applicant represented at the time, was "in response to a National Alzheimer's Association vote to end its existing affiliation agreements with all local independent Chapters...and merge them into one nation-wide, non-profit organization with national – not local governance..." Nov. 14, 2019 Roy Decl. at ¶ 2, Ex. O.

6. Despite Applicant terminating its relationship with Opposer, Opposer continued to use marketing materials referencing Applicant in order to confuse donors. Zaentz Aff. at ¶¶ 11-18.

Response: Alzheimer's Association objects to this fact on the basis that it is not material to summary judgment as it does not relate in any way to the subject marks and references alleged actions that occurred in 2016, prior to the filing of Applicant's trademark application. Subject to its objections, denied. *See* Taylor Decl. at Ex. D, p. 4.

7. Additionally, Opposer has engaged in several unsuccessful litigations in an effort to divert bequests from Applicant. Zaentz Aff. at ¶ 19 and Exhibits G and H.

Response: Alzheimer's Association objects to this fact on the basis that it constitutes improper argument and is not material to summary judgment as it relates to disputes regarding donor intent following the Applicant's disaffiliation and does not relate in any way to the subject trademarks. Subject to its objections, denied. The pleadings in those litigation proceedings speak for themselves.

8. On April 3, 2012, Opposer registered the word mark "WALK TO END ALZHEIMER'S" and expressly disclaimed "WALK" and "ALZHEIMER'S". Decl. of Shima Roy, Esq. ("Roy Decl.") at Ex. "A".


Response: Undisputed.

9. Applicant owns and on October 4, 2016 registered the word mark "WALK TO FIGHT ALZHEIMER'S" ("Applicant's Word Mark") on the principal register, registration no. 5,053,635 for Class 36 goods and services. Decl. of Lisa D. Taylor, Esq. ("Taylor Decl.") at ¶¶ 3-6 and Exhibit "A" attached thereto; and Zaentz Aff. at ¶¶20-21.

Response: Undisputed.

10. Applicant's Word Mark does not include any of the non-disclaimed words or even letters contains in Opposer's Word Mark and, even though Applicant's Word Mark was for Class 36 services, Opposer did not oppose Applicant's Word Mark. *Id.*


Response: Alzheimer's Association objects on the basis that the statement contains improper argument. Subject to its objection, disputed. WALK TO FIGHT ALZHEIMER'S and WALK TO END ALZHEIMER'S contain the same words and letters. Roy Decl. at ¶ 14 and Ex. M thereto; Taylor Decl. at Ex. B.

11. Applicant owns and on January 9, 2018 registered the following design mark under registration no. 5,373,234:  for Class 36 goods and services including charitable walk-based fundraising for Alzheimer's disease ("Applicant's First Design Mark". Taylor Decl. at ¶¶ 7-9 and Exhibit B attached thereto; and Zaentz Aff. at ¶¶ 22-23.

Response: Undisputed.

12. Opposer filed an extension of time to oppose Applicant's First Design Mark but, ultimately, Opposer never filed an opposition to Applicant's First Design Mark.

Response: Undisputed.

13. On February 14, 2018, Applicant filed an application (serial no. 87797112) to use the following design mark : which is also for Class 36 goods and services including charitable walk-based fundraising for Alzheimer's disease ("Applicant's Mark") and same is the subject of this litigation.

Response: Undisputed.

14. Applicant's Mark incorporates Applicant's Word Mark and is essentially the same design as Applicant's First Design Mark other than for changes in color scheme. *Id.*

Response: Alzheimer's Association objects to this Statement on the basis that it constitutes improper argument and legal conclusions. Subject to its objections, disputed. The mark that is the subject of this Opposition is markedly different in connotation, appearance and shape

and also has a different description of goods. Roy Decl. at ¶ 14 and Ex. M thereto; Taylor Decl. at Ex. B.

15. More than nine months after Applicant filed Applicant's Mark, on November 28, 2018, Opposer filed an application for the following design mark bearing Serial No. 88209214:



("Opposer's Design Mark" together with "Opposer's Word Mark" referred herein as "Opposer's Marks"). *Id.*

Response: Alzheimer's Association does not dispute that it filed a trademark application for the above referenced mark on November 28, 2018, but clarifies that the first use in commerce date for that mark is September 1, 2011. Ex. B to Roy Decl. at ¶ 4; *see also* Garza Aff. at ¶¶ 5, 6, 11, 23, 25 and Ex. E (showing use of the Mark prior to 2018) thereto.

16. Applicant's Mark includes a depiction of the State of New Jersey; sneakers; and the source of the mark, Alzheimer's New Jersey, none of which are present in Opposer's Marks. *Id.*

Response: Alzheimer's Association objects to this Statement to the extent the citation does not support it and it constitutes impermissible argument. Subject to its objections, Alzheimer's Association disputes Applicant's characterization of its mark, and responds that the mark speaks for itself. Taylor Decl. at Ex. B.

17. Applicant's Mark does not share any non-disclaimed words or letters in Opposer's Marks and makes no reference to Opposer. *Id.*

Response: Alzheimer's Association objects to this Statement on the bases that the citation does not support it, it is not material to summary judgment, and it constitutes impermissible argument. Subject to its objections, Alzheimer's Association responds that the marks speaks for themselves. Roy Decl. at ¶ 14 and Ex. M thereto; Taylor Decl. at Ex. B.

18. Applicant's Mark does not contain an arrow or a near full circle as contained in Opposer's Design Mark. *Id.*

Response: Alzheimer's Association objects to this Statement on the bases that the citation does not support it, it is not material to summary judgment, and it constitutes impermissible

argument. Subject to its objections, Alzheimer's Association disputes the characterization of its WALK TO END ALZHEIMER'S Design Mark and responds that the marks speaks for themselves. Roy Decl. at ¶ 14 and Ex. M thereto; Taylor Decl. at Ex. B

19. Neither Applicant's Mark nor Opposer's Marks claim any specific shape as a part of their respective marks. *Id.*

Response: Alzheimer's Association objects to this Statement to the extent the citation does not support it, it constitutes impermissible argument, and is not material to summary judgment. Subject to its objections, denied. The shapes of the marks are properly considered when assessing the marks in their entirety. Alzheimer's Association further responds that the marks speaks for themselves. Roy Decl. at ¶ 14 and Ex. M thereto; Taylor Decl. at Ex. B.

20. Applicant prominently featured its marks on numerous products and advertising materials all the while emphasizing the local New Jersey services rendered by Applicant, and in so doing raised nearly \$750,000 in 2017 through its walks. Zaentz Aff. at ¶¶25-27, Exhibits "I" and "J."

Response: Alzheimer's Association objects to this Statement on the bases that it constitutes improper argument as to what is emphasized in the mark and is not material to summary judgment. To the extent a response is required, denied on the basis that the cited Exhibits I and J do not feature the mark at issue in this Opposition.

21. Opposer has not submitted any evidence of sending cease and desist letters relative to Opposer's Design Mark. See Shima Roy Decl. at Ex. L.

Response: Denied. The cited evidence contains cease and desist letters regarding Opposer's marks that have been asserted in this Opposition. Roy Decl. at ¶ 13, *citing* Ex. L.

22. This is because walk-based fundraising has been well-established and numerous other walk-based fundraising exists that Opposer has not opposed. Taylor Decl. at Exhibits "F"- "H" and Zaentz Aff. at ¶ 28.

Response: Alzheimer's Association objects to this Statement on the bases that it constitutes improper argument, is not material to summary judgment and is not supported by the .

To the extent a response is required, Alzheimer's Association does not dispute that it has not opposed all other "walk-based fundraising".

23. On December 5, 2018, Opposer filed its Notice of Opposition and in doing so did not plead when Opposer's Marks became famous other than to simply state "Alzheimer's Association's marks have become famous." Opposer's opposition at ¶ 7.

Response: Alzheimer's Association objects to this Statement on the basis that it constitutes improper argument and legal conclusions. Subject to its objections, Alzheimer's Association states that its pleadings speak for themselves.

III. APPLICANT MISAPPLIES THE DU PONT FACTORS

Applicant engages in a contrived analysis of the *du Pont* factors as part of its wholly results oriented analysis. Applicant disregards well-established standards that require an examination of the marks in their entirety in favor of comparing each element separately. Incredibly, Applicant contends that the goods and services offered under the marks are different and, ignoring basic trademark law, it contends the channels of trade are distinct because Applicant only uses its mark in New Jersey. It also disregards the spectrum on which the strength and fame of a mark is assessed in a likelihood of confusion analysis, opting instead for a legally erroneous "all or nothing" approach to that factor. As further evidence of the weakness of its likelihood of confusion analysis, Applicant argues that the existence of any fundraising walks – totally unrelated to, and different from, the marks at issue – constitute proof of similar marks for similar services. Applicant raises no credible questions of fact or issues of law that call into doubt Alzheimer's Association's contention that a likelihood of confusion exists between the marks.

A. Similarity of the Marks and Goods Covered by the Marks

The parties do not dispute that, to properly assess the similarity between trademarks, the Board must determine "'whether the marks are sufficiently similar in terms of their commercial impression' such that persons who encounter the marks would be likely to assume a connection

between the parties." *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368 (Fed. Cir. 2012) (quoting *Leading Jewelers Guild, Inc. v. LJOH Holdings, LLC*, 82 USPQ 2d 1901, 1905 (TTAB 2007)). In fact, Applicant acknowledges that the marks must be considered as a whole "and cannot be dissected." App. Br. at p. 8. Yet, the entirety of Applicant's analysis of the first *du Pont* factor, the similarities between the subject marks – consists of a deconstruction of each mark and a side by side comparison of each element. See App. Br. at pp. 9-10 (comparing each and every element of the marks separately from the whole – even whether the lettering is centered).

In an effort to reach its favored conclusion, Applicant never addresses the "overall commercial impression" of the marks nor does it approach its analysis from the perspective of an ordinary consumer "who normally retains a general rather than a specific impression of the marks." *L'Oreal S.A. v. Marcon*, 102 USPQ 2d 1434, 1438 (TTAB 2012). Applicant also misapprehends basic trademark principles by contending that only claimed features of a mark are relevant in a *du Pont* analysis. See App. Br. at p. 10 (dismissing the similar rectangular shapes of the marks because the rectangular shape "is simply not a claimed design feature of either mark"). Using the proper criteria to assess similarity, it is clear that the marks present the same overall commercial impression.



Not only are the operative words in the marks identical but for "END" and "FIGHT", Applicant has copied Alzheimer's Associations' purple and white color scheme.

Applicant also cannot ignore the identity between most of the dominant features of the marks, which result in their similarity in sound and connotation because Opposer has disclaimed "walk" and "Alzheimer's". This issue was examined quite fully by the Federal Circuit *In re Nat'l*

Data Corp., 753 F.2d 1056, 1060 (Fed. Cir. 1985). In that case, the applicant appealed a Board ruling of likelihood of confusion between its applied-for mark, CASH MANAGEMENT EXCHANGE, and the registrant's mark, CASH MANAGEMENT ACCOUNT. The applicant argued that "cash management" was descriptive and that the Board erred in not focusing only on the non-descriptive terms in the respective marks, "exchange" and "account". *Id.* at 1059.

The Federal Circuit affirmed the Board's decision, holding that descriptive words necessarily play a role in creating confusion, and to disregard them – as Applicant urges the Board to do in this Proceeding – would undermine the principle that "marks must be considered as the public views them, that is, in their entirety." *Id.* at 1060; *see also Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ 2d 1881, 1900-01 (TTAB 2006); *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ 2d 1765, 1768 (TTAB 2015), *citing In re Shell Oil Co.*, 992 F.2d 1204 (Fed. Cir. 1993) ("[A] disclaimer with the Patent and Trademark Office does not remove the disclaimed matter from the purview of determination of likelihood of confusion.") Indeed, the Federal Circuit authority upon which Applicant relies, *Cunningham v. Laser Golf Corp.*, 222 F.3d 943 (Fed. Cir. 2000) relies on *National Data* for its conclusion that a likelihood of confusion existed as between the marks in that case.²

B. Applicant Cannot Credibly Argue that the Goods and Services Covered by the Marks are Distinct

Another critical factor in the similarity analysis is the similarity between applicant and opposer's goods and services. *Edom Labs., Inc. v. Lichter*, 102 USPQ 2d 1546, 1549 (TTAB 2012). Incredibly, Applicant contends that the goods and services covered by the marks are

² The facts in *Cunningham* are also distinguishable. The marks at issue in that case were LASER and LASERSWING. The court determined that "swing" was descriptive and given the shared similarities between the mark, could be accorded less weight. 222 F.3d at 947. This case is much more akin to *National Data*, where the marks are identical except for one word.

dissimilar. Both parties' marks cover charitable fundraising services related to Alzheimer's Disease. *See* Roy Decl. at ¶¶ 2, 3, and 14 and Exs. A, B and M thereto.

Applicant again, advocates a legal position based on a fundamental misapprehension of basic trademark law by claiming the goods and services are different because:

Opposer's Marks are expressly limited to "educational and informational programs...and scientific research on Alzheimer's disease" and "charitable fundraising services in the nature of a pledged walkathon." In contrast, Applicant's Mark is not so limited and is aimed to also "help those in need"; to "support medical procedures"; to fundraise for "Alzheimer's care" and for "on-line charitable fundraising."

App. Br. at p. 12. As an initial matter, Applicant engages in self-serving, incomplete recitations of Alzheimer's Association's goods and services. But even that is of no consequence. The identified services need not be identical or even competitive to find a likelihood of confusion. *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086 (Fed. Cir. 2000). "[L]ikelihood of confusion can be found 'if the respective [services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source.'" *Coach Servs.*, 101 USPQ 2d at 1722 (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ 2d 1715, 1724 (TTAB 2007)). The applied-for goods and services are both targeted to raising money for research and programs relating to Alzheimer's disease and for walk events in furtherance of the same. No amount of tortured reasoning alters that conclusion.

C. Applicant Has No Credible Response to the Argument that the Goods and Services Are Directed to the Same Participants and Travel in the Same Channels of Trade

Nowhere in its brief does Applicant address the *du Pont* factors that examine the similarity of established trade channels and the conditions under which, and buyers to whom, sales are made. This is because there is no question that these factors favor Alzheimer's Association. The marks are directed to individuals interested in raising awareness of Alzheimer's Disease.

Although Applicant does not expressly address "channels of trade," it argues that the goods and services offered under the marks are different because "Applicant's Mark is intended for local New Jersey residents." *See* App. Br. at p. 12. This argument disregards basic trademark principles. Nothing in the description of goods suggests as much and the effect of a U.S. trademark registration is to afford rights in the registered mark across the U.S. There is no authority to support the proposition that a confusingly similar mark may be registered with the U.S. Patent & Trademark Office because the user intends only to use it in one particular state. Alzheimer's Association uses its marks in every state. *Garza Aff.* at ¶ 9 and Ex. C thereto. And, it is well established that, "absent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers." *In re Viterra, Inc.*, 671 F.3d 1358, 1362 (Fed. Cir. 2012). Applicant cannot offer any facts to overcome the conclusion that this factor favors Opposer.

D. Strength and Fame Are Measured on a Spectrum in a Likelihood of Confusion Analysis

Applicant approaches this factor as an "either or" proposition – the mark is famous or it is not. That approach is legally incorrect. A mark may have acquired sufficient public recognition and renown to demonstrate that it is a strong mark for likelihood of confusion purposes without meeting the stringent requirements to establish that it is a famous mark for dilution purposes. *Palm Bay Imports v. Veuve Cliquot Ponsardin*, 396 F.3d 1369, 1374-75 (Fed. Cir. 2005) (Likelihood of confusion fame "varies along a spectrum from very strong to very weak."); *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 47 (1st Cir. 1998) ("The standard for fame and distinctiveness required to obtain anti-dilution protection is more rigorous than that required to seek infringement protection."); *see also Carefirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ 2d 1492, 1507 (TTAB 2005) (likelihood of confusion "[f]ame is relative...not absolute.")

The evidence provided by the Alzheimer's Association is sufficient to demonstrate the fame of its WALK TO END ALZHEIMER'S Marks. The fame of a mark may be measured in a number of ways, including “by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident.” *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1355 (Fed. Cir. 2011), *citing Bose Corp. v. QSC Audio Prods. Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002). Contrary to Applicant's overstatement of the law, sales and advertising figures are acceptable indicia of fame. And, contrary to Applicant's assertions, the Federal Circuit in *Bose* did not seek out comparable sales and advertising numbers. Rather, the Court examined those figures in light of other evidence confirming its significance. *Bose*, 293 F.3d at 1375-76 (“In this case, the sales and advertising numbers for ACOUSTIC WAVE and WAVE have to be seen both in the context of how the products are presented in the advertising and sales material (here with sufficient independence from the famous house mark) and in the context of the continuous and extensive critical consideration the marked products have enjoyed.”).

The Alzheimer's Association's fundraising figures, which have been substantiated by numerous documents produced in this Proceeding, including Annual Reports, business records, and a consumer survey are so significant that they unquestionably show the strength of the WALK TO END ALZHEIMER'S Mark. Garza Aff. at ¶¶ 14-15 at Exs. F, G and J thereto. The third party recognition – from local newspapers and the Denver Broncos – and consumer awareness survey showing one quarter of the general population recognizes the WALK TO END ALZHEIMER'S Marks provides more than enough context for its advertising and sales figures. Roy Decl. at ¶¶ 5-12 and Exs. D-K thereto; Garza Aff. at ¶ 20 and Ex. J thereto. Applicant's own fundraising figures provide the comparable context that Applicant claims does not exist. Applicant attests that it raised

\$750,000 in its 2017 Walk to Fight Alzheimer's. Zaentz Aff. at ¶ 26. In contrast, Alzheimer's Association raised almost \$89 million dollars. Garza Aff. at ¶ 14 and Exs. G (AA517), F (AA272) thereto.

Applicant's focus on a portion of an article that mentioned Alzheimer's Association ranks generally in the top 35 non-profit fundraising organizations is irrelevant to an analysis of the strength of the WALK TO END ALZHEIMER'S Marks. *See* App. Br. at 14, *citing* Taylor Decl. at Ex. E (AA326). It is simply a testament to the standing and reputation of the Alzheimer's Association amongst other non-profits in the U.S. What Applicant does not acknowledge, is the fact that the third party article it cites corroborates the fame of the WALK TO END ALZHEIMER'S Marks. Not only does it state that Alzheimer's Association's WALK TO END ALZHEIMER'S is the largest "walk" event of its kind in the U.S., it supports Alzheimer's Association's claim that the walk, which "unites over 450,000 participants" occurs in "over 600 communities across all 50 states". Taylor Decl. at Ex. E (AA325); *see also* Garza Aff. at ¶¶ 9, 12, 14 and Exs. C and F thereto.

Applicant's contention that the marks have not achieved any level of fame because Alzheimer's Association has only produced any cease and desist letters that relate to unauthorized use of the WALK TO END ALZHEIMER'S Marks is yet another nonsensical argument. *See* App. Br. at p. 14. Not only does it ignore the cease and desist letters produced by Alzheimer's Association that *directly relate* to its Marks (*see* Roy Decl. at ¶ 13 and Ex. L thereto), it suggests that the Alzheimer's Association cannot claim fame of THE WALK TO END ALZHEIMER'S Marks because did not police every fundraising walk no matter what the mark or cause. App. Br. at 14, *citing* Taylor Decl. at Exs. F-H. That argument should be dismissed out of hand.

For purposes of a likelihood of confusion analysis, Alzheimer's Association has demonstrated that this factor favors it.

E. No Similar Marks on Similar Goods Exist

There are no similar marks on similar goods and services that exist other than Applicant's mark. In yet other tortured attempt to 'move the needle' on a *du Pont* factor, Applicant points to any and all evidence it could gather relating to fundraising walks as evidence of similar marks on similar goods. Incredibly, Applicant even cites the "Memory Walk & Jog" *in Australia* as a similar mark on similar goods under this factor. *See* Taylor Decl. at Ex. H (ALZNJTAB0050-57). What Applicant does not appreciate is that those "marks" (it is not clear nor has Applicant established whether these "walks" rise to the level of trademark use) are not "similar" by virtue of the fact that they are "walks", have a purple component, or use the word "Alzheimer's". *See e.g.*, Taylor Ex. at Ex. G (ALZNJ0025). Alzheimer's Association does not claim that its registration precludes any entity from holding fundraising walks or from using the word "Alzheimer's" in its marketing.

Even a cursory review of those "marks" demonstrates the futility of Applicant's argument. None of them even approach Alzheimer's Association's WALK TO END ALZHEIMER'S except that they relate to walks, and some to Alzheimer's Disease. *See* Taylor Decl. at Ex. G (citing use of slogans such as: 4th Annual Alzheimer's Walk 2018; Running 4 Answers; Walk of Love; Alzheimer Tennessee Walk; Step Forward Give Hope Alzheimer's Walk; Alzheimer's Texas Walk; Walk4Alzheimer's; Walk to End Epilepsy; Pancreatic Cancer Research Walk; Walk + Run END epilepsy; AIDS WALK NEW YORK. (ALZNJTAB0023, 26-27, 38, 40, 58, 62, 65, 67, and 84)). Applicant's reliance on totally distinct trademark registrations fares no better. *See* Taylor Decl. at Ex. F (citing marks such as WALK TO END LUPUS NOW (ALZNJTAB0187), AVON 39 THE WALK TO END BREAST CANCER (ALZNJTAB0155-57), and STEP OUT WALK

TO FIGHT DIABETES (ALZNJTAB088-90). Applicant's reliance on this evidence is misguided at best, and misleading at worst.

F. Applicant Has No Response to the Alzheimer's Association's Analysis of the Bad Faith and Actual Confusion *du Pont* Factors

Applicant does not, and cannot, deny that it used THE WALK TO END ALZHEIMER'S Marks for many years in furtherance of the WALK TO END ALZHEIMER'S events in New Jersey. Roy Decl. at ¶ 12 and Ex. K thereto. Applicant also cannot deny that, since its disaffiliation, both it and the Alzheimer's Association organize and carry out Alzheimer's walks in New Jersey. It is therefore, not a "presumption" to conclude that use of a confusingly similar mark is evidence of bad faith. This is especially true given that the commercial impression of the marks as to the source of their goods is considered from the vantage point of an average consumer.

Applicant's refrain that the Alzheimer's Association tried to confuse consumers *in 2015 and 2016 before Applicant even filed its trademark application* has no legal significance. Those alleged acts not only predate Applicant's filing, but also have no relation to any of the marks at issue in this Proceeding and should thus be summarily disregarded. Moreover, this factor does not apply to Alzheimer's Association, who has priority in the Marks.

Not a single relevant *du Pont* factor favors Applicant and no questions of fact exist as to any those factors. Accordingly, a finding of likelihood of confusion in favor of Alzheimer's Association is appropriate.

IV. APPLICANT FAILS TO ADDRESS ANY OF THE LEGAL DEFICIENCIES WITH ITS ASSERTED EQUITABLE DEFENSES

Rather than address its actual asserted equitable defenses, which fail as a matter of law, Applicant attempts to raise an entirely new equitable defense (the *Morehouse* defense). Applicant's failure to respond to Alzheimer's Association's arguments that its asserted equitable

defenses fail as a matter of law is tantamount to a concession that it cannot sustain those defenses. Applicant's untimely Morehouse defense fails both procedurally and substantively.

A. The *Morehouse* Defense is Untimely and Does Not Apply Here

Procedurally fatal to its attempt is the fact that Applicant did not plead the defense in its Answer to the Opposition. Nov. 14, 2019 Roy Decl. at ¶ 3, Ex. P (Dkt. No. 4). As a threshold matter, the *Morehouse* defense is thus untimely and Applicant is barred from asserting it in summary judgment:

We additionally note, however, that Applicant, for the first time in its supplemental briefing, seeks judgment in its favor based on the "prior registration" or *Morehouse* defense. Applicant, however, did not plead this defense in either of its answers. ***A party may not obtain summary judgment on an unpleaded claim or defense. Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG***, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008); *see also* TBMP § 528.07(a) (2015). Accordingly, the Board has given no consideration to Applicant's "prior registration" or *Morehouse* defense. Should Applicant wish to pursue this defense at trial, amendment of the answers is necessary.

Omega SA v. Alpha Phi Omega, 118 USPQ 2d 1289 (TTAB 2016); *Playboy Enter., Inc. v. Mavety Entertainment Group Ltd.*, Opp. No. 104,765, 2000 TTAB LEXIS 201 at *6-7 (TTAB Mar. 27, 2000) (denying summary judgment on the *Morehouse* defense because it was not pleaded), *citing Paramount Pictures Corp. v. White*, 31 USPQ 2d 1768 (TTAB 1994); TBMP § 314 (A party may not obtain summary judgment on an unpleaded claim or defense, nor may a party defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an unpleaded claim or defense).

Never having asserted an affirmative defense based on the *Morehouse* defense, Applicant cannot now, at this late stage, try to raise it under the guise of a laches, equitable estoppel, or acquiescence defense. TBMP § 311.02(b) (recognizing the *Morehouse* defense as separate from laches, acquiescence, and equitable estoppel); *see also Paletaria La Michoacana, Inc. v. Productos Lacteos Tocumbo S.A. de C.V.*, 247 F. Supp. 3d 76, 101 (D.D.C. 2017) ("It is true that the

Morehouse defense is an equitable defense in the nature of laches or acquiescence. But simply referring to the defenses of laches and acquiesce is not the same as raising the Morehouse defense." (internal quotations and citations omitted)); Nov. 14, 2019 Roy Decl. at ¶ 3, Ex. P (Dkt. No. 4).

Even if Applicant had timely raised the *Morehouse* defense, it is inapplicable on these facts.³ The *Morehouse* defense applies is rarely granted. This is because the threshold for finding identity between a prior registered mark and an applied-for mark is high. *Mag Instrument Inc. v. Brinkmann Corp.*, 96 USPQ 2d 1701, 1713 (TTAB 2010), *aff'd* (Fed. Cir. 2011) ("For purposes of the *Morehouse* defense, the two marks must be 'substantially identical,' meaning that they are either literally identical or legally equivalent."). Here, Applicant cannot meet either prong of the defense. *First*, the prior registered marks are so different in their visual impression, that it cannot be said Applicant's marks are the same.⁴ *Second*, there is not an identity of goods and services as required by the defense.

Neither of these prior registrations are sufficiently similar to the applied-for mark to give rise to the *Morehouse* defense. The applied-for mark is distinctly different from the prior registrations, and properly the subject of this Opposition, because it approximates Alzheimer's Association's in a manner distinct from Applicant's prior registrations. Namely, the applied-for mark – unlike the prior marks and like Alzheimer's Association's mark – is entirely purple and white (with white lettering) and contained within a rectangular shape. As such, the similarities in the sound of the mark are emphasized in a manner not present in the prior registrations:

³ Alzheimer's Association notes that neither registration upon which the defense is presumably based is incontestable.


⁴ Applicant appears to rely on U.S. Reg. No. 5,053,635 (a word mark for WALK TO FIGHT ALZHEIMER'S) and U.S. Reg. No. 5,373,234 (a design mark for WALK TO FIGHT ALZHEIMER'S) to support the defense.



The focal point of the prior registered design mark, on the other hand, is the green lettering (*see*



) and, of course, Applicant's word mark is entirely distinct.

In such circumstances, the Board has declined to apply the *Morehouse* defense. For instance, in *Disney Enter. v. Ronica Holdings Ltd.*, the Board determined that the applicant could not rely on the *Morehouse* defense because the prior registration and opposed registration (which were identical graphics) were at slightly different angles (). Opp. No. 91218136, 2015 TTAB LEXIS 128, at *14-15 (TTAB Apr. 29, 2015). Specifically, the Board has ruled that the design portion of the subject marks is equally important to the word portion. *Vanderbilt Univ. v. Vanderbilt Mortgage & Finance, Inc.*, Opp. No. 91183673, 2010 TTAB LEXIS 207, at *8 (TTAB May 11, 2010) ("We are not persuaded by applicant's arguments that the Board should view the word portion of each mark as dominant and consider the design element in the registered mark to be either a "secondary" or merely "background" feature."); *Green Spot (Thailand) Ltd. v. Vitasoy Int'l Holdings Ltd.*, 86 USPQ 2d 1283, 1286 (TTAB 2008) ("[H]ere the marks are so different in their visual impressions that even if we were to agree with the applicant that the marks are similar in pronunciation or meaning, any similarities are outweighed by the differences."); *GSG Enter. Inc. d/b/a Learning Tree Univ. v. Learning Tree Int'l, Inc.*, Opp. Nos. 86,313 and 87, 206, 2000 TTAB LEXIS 253, at *6 (TTAB May 9, 2000) (refusing to apply the *Morehouse* defense when, *inter alia* "the registered design marks are not lined for color, as are the applied-for marks.")

If the identification of goods or services in the new registration is broader than in the prior registration, even though some goods or services are within the prior registration, the defense will not apply. *Bausch & Lomb Inc. v. Leupold Stevens Inc.*, 1 USPQ 2d 1497, 1500 (TTAB 1986). Although similar, the description of goods and services in the applied-for mark are arguably more broad than those in the prior registrations. Namely, the applied-for mark covers "charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Alzheimer's care and research", a service not covered in the prior word mark registration. *See* Taylor Decl. at Ex. A (ALZNJTAB0140). Similarly, the "walks and other special events" covered by the applied-for mark are not limited to Alzheimer's care and research, but apply more broadly and generally to Alzheimer's. *Id.* at ALZNJTAB0134. Board has refused to apply the *Morehouse* defense even when the goods in the application and prior registration were, in part, identical, or otherwise closely related, because the application included goods different from goods listed in the prior registration. *Bausch & Lomb*, 1 USPQ 2d at 1500.

B. Applicant Does Attempt to Meet its Burden Prove Prejudice Nor Does it Respond to Any Argument That its Pleaded Equitable Defenses of Laches, Acquiescence, or Equitable Estoppel Fail As a Matter of Law

As recognized by the Board, "the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings." TBMP § 311.02(b);. This is because they are not available when an opposition has been timely filed. *Id.*; *Nat'l Cable Television Ass'n Inc. v. Am. Cinema Editors Inc.*, 937 F.2d 1572, 1582 (Fed. Cir. 1991). Importantly, Applicant does not deny that Alzheimer's Association timely filed this Opposition and all three equitable defenses fail as a matter of law. *Christian Broadcasting Network Inc. v. ABS-CBN Int'l*, 84 USPQ 2d 1560, 1573 (TTAB 2007) (acquiescence and equitable estoppel are identical defenses). Even if Applicant could somehow overcome this absolute bar to its defenses, it has not even attempted to establish

both unreasonable delay and prejudice from the alleged delay. *Nat'l Cable*, 937 F.2d at 1582 (burden is on the party asserting the defense "to establish both unreasonable delay and prejudice from the delay").

C. No Basis Exists for an Unclean Hands Affirmative Defense

In an attempt to salvage its affirmative defense for unclean hands, Applicant again engages in an eleventh-hour revision of the record in this case to add factual bases to the defense. Even if those attempts were not untimely, the defense still fails because Applicant has failed to identify any relevant evidence to support it.

The sole basis asserted for the defense are 2016 representations (following the parties' disaffiliation) by the Alzheimer's Association on its website that the walks using its WALK TO END ALZHEIMER'S Marks and conducted in furtherance of the Alzheimer's Association's WALK TO END ALZHEIMER'S campaign were "formerly in Paramus". Roy Decl. at ¶ 4 (Ex. C, Supp. Ans. to Int. No. 5). Applicant has utterly failed to provide any evidence to show how this activity relates to Alzheimer's Association's claim for likelihood of confusion. It cannot do so because the alleged conduct (for which it offers no facts other than the Alzheimer's Association's accurate statement that THE WALK TO END ALZHEIMER'S was "formerly in Paramus", occurred in 2016 – *two years before Applicant filed its application for the subject mark*.⁵ As such, it has no bearing on, or relation to, Alzheimer's Association's claim of likelihood of confusion in this Opposition. *Tatuaje Cigars, Inc. v. Nicaragua Tobacco Imports, Inc.*, 2010 TTAB LEXIS 380, at *5 (TTAB 2010) ("The defense of unclean hands must be related to opposer's claim and,

⁵ It bears noting that, while Applicant persists in describing the WALK TO END ALZHEIMER'S events in New Jersey prior to its disaffiliation as Applicant's walks (*see* App. Br. at p. 18 ("It was Applicant which conducted these walks")), the argument ignores that the marks used in furtherance of the walks – the subject of this Proceeding – belonged to Opposer as did all rights in the WALK TO END ALZHEIMER'S campaign. *Zaentz Aff.* at Ex. A, §§ 3.3, 6.

therefore, applicant has not asserted a viable affirmative defense of unclean hands."), *citing Tony Lama Co., Inc. v. Anthony DiStefano*, 206 USPQ 176, 179 (TTAB 1980) ("[T]he concept of unclean hands must be related to a plaintiff's claim, and misconduct unrelated to the claim in which it is asserted as a defense does not constitute unclean hands.")

In defense of this legally sound argument, Applicant contends that its unclean hands defense applies to this Opposition because it had a word mark for WALK TO FIGHT ALZHEIMER'S as of October 4, 2016. *See* App. Br. at p. 18. That contention is nonsensical. The actions taken in furtherance of its unclean hands defense must relate to the applied-for mark. It does not.

Even if it was proper, Applicant's attempt to bolster this defense with facts raised for the first time in its Cross-Motion/Response fail for the same reasons. Applicant now contends that Alzheimer's Association had "unclean hands" by virtue of its "attempts to divert consumers away from Applicant following Applicant's disaffiliation." *See* App. Br. at p. 18. Even assuming that were true – which it is not – those acts, all of which allegedly occurred in 2015 and 2016 not only predate the application for the applied-for mark but wholly are unrelated to the applied-for mark. *See* Zaentz Aff. at ¶¶ 11-12, 14-15, 17-18.

D. Applicant Has No Response to the Request for Summary Judgment on its Defense for Failure to State a Claim

Rather than concede even a glaringly obvious legal principle, Applicant puts forward an incomprehensible response to the argument that failure to state a claim upon which relief can be granted is not an affirmative defense. *Blackhorse v. Pro Football, Inc.*, 98 USPQ 2d 1633, 1637 (TTAB 2011); *The John W. Carson Foundation v. Toilets.com, Inc.*, 94 USPQ 2d 1942, 1949 (TTAB 2010) ("The asserted defense of failure to state a claim is not a true affirmative defense because it relates to an assertion of the insufficiency of the pleading of opposer's claim rather than

a statement of a defense to a properly pleaded claim.") Failure to state a claim is simply unavailable as an affirmative defense. It should not, as Applicant claims, be "permitted to stand" because it is "an amplification of Applicant's denials in its answer". *See* App. Br. at p. 18. Applicant's conclusory attempt to rely on the arguments made in its Response/Cross Motion for Summary Judgment as support for its purported affirmative defense⁶ is improper and simply reveals its fundamental misunderstanding of the difference between the bases for summary judgment a dismissal for failure to state a claim.

V. QUESTIONS OF FACT EXIST AS TO WHETHER WALK TO END ALZHEIMER'S IS FAMOUS FOR PURPOSES OF ITS DILUTION CLAIM

To prevail on its affirmative cross-motion for summary judgment as to Alzheimer's Association's dilution claim, Applicant has the burden to show that no questions of material fact exist. *Celotex Corp. v. Catrett*, 477 U.S. 317, 324 (1986). Importantly, a genuine issue of material fact exists if sufficient evidence is presented that a reasonable fact finder could decide the question in favor of the moving party. *See Opryland USA, Inc. v. Grout American Music Show, Inc.*, 970 F.2d 847, 850 (Fed. Cir. 1992).

Applicant ignores this burden and, instead, relies on its response to Alzheimer's Association's arguments regarding the strength of its marks under the *du Pont* factors, which assess the strength of a mark on a spectrum and is not a binary analysis. "Fame for likelihood of confusion and dilution is not the same." *Lacoste Alligator S.A. v. Maxoly, Inc.*, 91 USPQ 2d 1594, 1598, n. 8, *citing Palm Bay*, 396 F.3d at 1375. In doing so, Applicant fails to address the

⁶ Incredibly, Applicant simply asserts that "[f]or the reasons forth herein [presumably meaning its pleading overall], Opposer has simply failed to set forth a claim of likelihood of confusion or dilution and thus Opposer's Opposition must be dismissed." *See* App. Br. at p. 18.

elements of a dilution claim or even present any arguments as to why there is no question of fact as to each of them. *See* 15 U.S.C. § 1125(c)(1).

Notwithstanding, Alzheimer's Association has produced sufficient evidence to, at least, create a question of fact as to each of those factors. Alzheimer's Association has put forth evidence regarding: (i) the degree of acquired distinctiveness of its WALK TO END ALZHEIMER'S Marks, including evidence demonstrating engagement by over two million participants in the WALK TO END ALZHEIMER'S in the past five years, \$400,000,000 million in fundraising dollars, recognition as the world's largest fundraising event for Alzheimer's Disease awareness, programs and research. *Garza Aff.* at ¶¶ 13-17 and Exs. F-H thereto; (ii) the extent to which it has engaged in exclusive use of the mark. *Id.*; and (iii) the degree of recognition of the mark. *Id.*; *Roy Decl.* at ¶¶ 5-13 and Exs. D-L thereto. Applicant addresses none of these facts, all of which are supported by Alzheimer's Association's business records and verified by third party sources, in its Cross Motion.

To the extent the Board determines that the claim has not been properly pleaded, and the Board finds that questions of fact exist that preclude summary judgment, Alzheimer's Association requests that it be permitted to properly plead the claim following the Board's determination of the motions. *Omega*, 118 USPQ 2d 1289, 1290 (TTAB 2016) (granting time for Opposer to properly plead its dilution claim following summary judgment ruling).

VI. PLAINTIFF'S CROSS -MOTION IS UNTIMELY

A party must file its motion for summary judgment "before the day of the deadline for the first testimony period" and "any summary judgment motion filed thereafter is untimely." TBMP § 528.02. The deadline for the first testimony period in this matter was September 25, 2019 (Dkt. No. 2). Applicant did not file its cross motion until October 15, 2019, well after that deadline. (Dkt. No. 10). As such Opposer respectfully submit that the Board disregard it as untimely.

VII. CONCLUSION

For the foregoing reasons, Opposer, Alzheimer's Association, respectfully requests that the Board: (i) grant summary judgment on Opposer's claim for likelihood of confusion; (ii) enter summary judgment in favor of Opposer on Applicant's defenses of laches, estoppel, acquiescence, unclean hands, and failure to state a claim; and (iii) suspend this Proceeding pending a determination of Opposer's Motion for Summary Judgment pursuant to TBMP § 528.03.

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*Attorney for Opposer, Alzheimer's Disease
and Related Disorders Association*

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

Alzheimer's Disease and Related
Disorders Association, Inc.

Opposer,

v.

Alzheimer's New Jersey, Inc.

Applicant.

Opposition No. 91245121

DECLARATION OF SHIMA S. ROY

I, Shima S. Roy, do hereby declare under penalty of perjury as follows:

1. I am an attorney at the law firm of Baker McKenzie LLP and counsel for Opposer, Alzheimer's Disease and Related Disorders Association, Inc. ("Alzheimer's Association" or "Opposer") in the above-captioned Proceeding. I make this Declaration to provide the Board with documents in support of Alzheimer's Association's Motion for Summary Judgment.

2. Attached as Exhibit O is a true and correct copy of an excerpt from Applicant's own website at <https://www.alznj.org/about/>.

3. Attached as Exhibit P is a true and correct copy of Applicant's Answer and Affirmative Defenses filed in the above-captioned matter (Docket No. 4).

I declare under penalty of perjury that the foregoing is true and correct.

Dated: November 14, 2019



Shima S. Roy

Exhibit O



About Us

Over 600,000 people in New Jersey are impacted by Alzheimer's

Since 1985, we have been here for **New Jersey** and we will continue to be here for our community, providing care and support for New Jersey families today and helping to advance research for a cure tomorrow. As Alzheimer's New Jersey® (formerly known as Alzheimer's Association, Greater New Jersey Chapter) our commitment to local programs and services is stronger than ever.

In December 2015, the **Board of Directors** of the Alzheimer's Association, Greater New Jersey Chapter **announced its decision to disaffiliate** from the National Alzheimer's Association® in order to maintain our status as an independent, stand-alone non-profit organization committed to serving New Jersey. Our Board made this decision in response to a National Alzheimer's Association vote to end its existing affiliation agreements with all local independent Chapters across the country and merge them into one nation-wide, non-profit organization with national – not local governance – a move that our Board believes would drastically reduce our **local programs and services**.

Get to know Alzheimer's New Jersey™!



generosity as well as our time and energy to our local communities.

We have a new name with a dedication to local programs and services that is stronger than ever.

Our Vision

Improve the lives of people in New Jersey who are affected by Alzheimer's disease and other dementias; offering continuous hope, and support.

Our Mission

To respond to the needs of people in New Jersey who are affected by Alzheimer's disease and other dementias, by providing programs and community partnerships that increase awareness and access to services.

Visionary Leaders



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Kenneth C. Zaentz, CFRE
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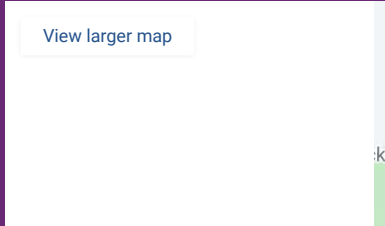
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Exhibit P

ESTTA Tracking number: **ESTTA945080**

Filing date: **01/03/2019**

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

Proceeding	91245121
Party	Defendant Alzheimer's New Jersey
Correspondence Address	LISA D. TAYLOR, ESQ. INGLESINO, WEBSTER, WYCISKALA & TAYLOR 600 PARSIPPANY ROAD, SUITE 204 600 PARSIPPANY ROAD, SUITE 204 PARSIPPANY, NJ 07054 ltaylor@iwt-law.com no phone number provided
Submission	Answer
Filer's Name	Lisa D. Taylor, Esq.
Filer's email	jmcdonnell@iwt-law.com, ltaylor@iwt-law.com
Signature	/Lisa D. Taylor, Esq./
Date	01/03/2019
Attachments	Answer to Notice of Opposition.PDF(54471 bytes)

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

ALZHEIMER’S DISEASE AND RELATED
DISORDERS ASSOCIATION,

Opposition No. 91245121

Opposer,

Mark:

v.

WALK TO FIGHT ALZHEIMER’S

ALZHEIMER’S NEW JERSEY,

Applicant.

ANSWER TO NOTICE OF OPPOSITION WITH AFFIRMATIVE DEFENSES

The following is the Answer of Applicant, Alzheimer’s New Jersey (the “Applicant”), owner of Federal Trademark Application Serial No. 87797112 for the mark WALK TO FIGHT ALZHEIMER’S (hereinafter the “Applicant’s Mark”), by and through its Counsel, Inglesino, Webster, Wyciskala & Taylor, LLC, to the Notice of Opposition filed on December 4, 2018 by Alzheimer’s Disease and Related Disorders Association (hereinafter the “Opposer”). Applicant hereby states as follows:

1. With respect to paragraph 1 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations, and therefore denies same.
2. With respect to paragraph 2 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations, and therefore denies same.
3. With respect to paragraph 3 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations, specifically

whether Opposer is the current correct and proper owner of the claimed registration and whether the registration is currently valid and subsisting. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

4. With respect to paragraph 4 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations, and therefore denies same.

5. With respect to paragraph 5 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to Opposer's date of first use for its mark; whether Opposer is the current correct and proper owner of the claimed mark, and whether such registration is currently valid and subsisting, therefore, Applicant is without knowledge and information sufficient to form a belief as to the allegations as written and must deny.

6. With respect to paragraph 6 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to Opposer's date of first use for its mark; whether Opposer is the current correct and proper owner of the claimed mark, and whether such registration is currently valid and subsisting, therefore, Applicant is without knowledge and information sufficient to form a belief as to priority and must deny.

7. With respect to paragraph 7 of the Notice of Opposition, Applicant denies the allegations therein.

8. With respect to paragraph 8 of the Notice of Opposition, Applicant admits the allegations contained therein.

9. With respect to paragraph 9 of the Notice of Opposition, Applicant admits the allegations contained therein.

10. With respect to paragraph 10 of the Notice of Opposition, Applicant denies the allegations contained therein.

11. With respect to paragraph 11 of the Notice of Opposition, Applicant admits that Applicant's Mark features the words "Walk to Fight" but denies the remaining allegations contained therein.

12. With respect to paragraph 12 of the Notice of Opposition, Applicant denies the allegations contained therein.

13. With respect to paragraph 13 of the Notice of Opposition, Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations, and therefore denies same.

14. With respect to paragraph 14 of the Notice of Opposition, Applicant denies the allegations contained therein.

15. With respect to paragraph 15 of the Notice of Opposition, Applicant denies the allegations contained therein.

16. With respect to paragraph 16 of the Notice of Opposition, Applicant denies the allegations contained therein.

AFFIRMATIVE DEFENSES

17. The Notice of Opposition fails to state a claim upon which relief can be granted.

18. Applicant alleges on information and belief that as a result of Opposer's own acts and/or omissions, the opposition is barred by the doctrine of laches.

19. Applicant alleges on information and belief that the opposition is barred by the doctrine of estoppel.

20. Applicant alleges on information and belief that as a result of its own acts and omissions, Opposer has waived any right to pursue its opposition.

21. Applicant alleges on information and belief that the opposition is barred by the doctrine of unclean hands.

22. Applicant alleges on information and belief that the opposition is barred by the doctrine of acquiescence.

23. Applicant's mark is unique and distinctive from Opposer's mark.

24. The wording in Applicant's mark and Opposer's mark are different.

25. Applicant's mark and Opposer's mark are different in appearance.

26. Opposer's mark contains the word "END" which is not present in Applicant's mark.

27. Applicant's mark contains the word "FIGHT" which is not present in Opposer's mark.

28. Applicant's mark contains the words "Alzheimer's New Jersey" above the logo, which clearly identifies the entity that the mark is associated with.

29. The color purple is used in numerous trademarks for organizations that provide services for people dealing with the disease referred to as Alzheimer's.

30. The word "Walk" is registered in numerous trademarks in connection with various charitable organizations that sponsor walks to raise funds for their causes.

31. Opposer's mark does not qualify for anti-dilution protection under the Lanham Act because Owner's mark is not famous.

32. Applicant's mark and Opposer's mark are not likely to cause confusion, mistake or deception to customers.

33. Applicant's mark and Opposer's mark are not likely to disparage or falsely suggest a trade connection between Opposer and Applicant.

34. Applicant's mark and Opposer's mark are not confusingly similar in appearance, sound, connotation or meaning.

35. Applicant expressly reserves the right to plead additional affirmative and other defenses should any such defenses be revealed by discovery in this case.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board reject the Notice of Opposition and permit registration of Applicant's Mark in Application Serial Number 87797112 in the United States Patent and Trademark Office.

Dated: January 3, 2019

Respectfully submitted,

By: /s/ Lisa D. Taylor
Lisa D. Taylor, Esq.
Inglesino, Webster, Wyciskala & Taylor, LLC
600 Parsippany Road, Suite 204
Parsippany, New Jersey 07054
Telephone (973) 947-7111
Facsimile (973) 887-2700
Attorneys for Applicant
Alzheimer's New Jersey

CERTIFICATE OF SERVICE

I hereby certify that on January 3, 2019, Joni Noble McDonnell, Esq., served a true and complete copy of the foregoing Answer to Notice of Opposition by electronic mail upon:

Lisa Gates, Esq.,
Baker & McKenzie, LLP
300 E. Randolph Street, Suite 5000
Chicago, IL 60601
lisa.gates@bakermckenzie.com
Attorney for Opposer
Alzheimer's Disease and Related Disorders Association

By: /s/ Lisa D. Taylor
Lisa D. Taylor, Esq.

CERTIFICATE OF FILING AND SERVICE

The undersigned certifies that the foregoing REPLY IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT AND RESPONSE TO APPLICANT'S CROSS-MOTION FOR SUMMARY JUDGMENT is being filed electronically via the Electronic System for Trademark Trials and Appeals (ESTTA) this 14th day of November, 2019 with copies sent by United States first-class mail and electronic mail to:

Lisa D. Taylor
Inglesino, Webster, Wyciskala & Taylor
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Parsippany, New Jersey 07054
ltaylor@iwt-law.com

/Shima S. Roy/