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

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| Proceeding | 91245121 |
| Party | Defendant Alzheimer's New Jersey |
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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,

Opposer,

v.

ALZHEIMER'S NEW JERSEY, INC.,

Applicant.

Opposition No. 91245121

**APPLICANT'S REPLY BRIEF IN OPPOSITION TO MOTION FOR SUMMARY
JUDGMENT AND IN SUPPORT OF CROSS-MOTION FOR SUMMARY JUDGMENT**

**I. The *du Pont* Factors Favor Applicant, Alzheimer's New Jersey, Inc.
a. The Marks Are Not Similar**

Although true that the marks at issue must be considered in their respective entireties, the “fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.” *Federal Foods, Inc. v. Fort Howard Co.*, 192 USPQ 24, 29 (CCPA 1976). There is no impropriety in assigning more or less weight to a particular feature of a mark. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 110 USPQ2d. 1157, 1161 (Fed. Cir. 2014). For example, if a particular feature is descriptive or generic, then there is accepted rationale for giving less weight to that portion of the mark. *In re Nat'l Data Corp.*, 224 USPQ 749, 751 (Fed. Cir. 1985).

First, contrary to Opposer, Alzheimer's Disease and Related Disorders Association, Inc.'s (“Opposer”) assertion, Applicant, Alzheimer's New Jersey, Inc. (“Applicant” or “ALZNJ”) did address the commercial impression of the marks at issue. More specifically, ALZNJ identified that there is “no same source confusion present”, see ALZNJ's Cross-Motion Memorandum of Law (“ALZNJ's Br.”) at p. 7, and that “Applicant's Mark contains source identifying

information... Thus, when considering the marks in their entireties, consumers would be unlikely to assume a common source”, *id.* at p. 11. In contrast, the extent of Opposer’s overall commercial impression analysis is that “Opposer’s Marks and Applicant’s Mark...emanate from the same source.” *See* Opposer’s Moving Memorandum of Law (“Opposer’s Br.”) at p. 10. However, for the reasons set forth previously in ALZNJ’s Br., the overall commercial impression is not that the marks share a common source but that Applicant’s Mark emanates from “Alzheimer’s New Jersey” as expressly indicated thereon. In an abundance of clarity, the overall commercial impression of Applicant’s Mark is that same does not emanate from the same source as Opposer’s Marks and that Applicant’s Mark relates to ALZNJ’s efforts in New Jersey.

Second, Opposer takes issue with ALZNJ identifying the differences between the marks at issue but ignores that Opposer went through a similar analysis. *See* Opposer’s Br. at p. 11. It is axiomatic that identifying the differences in the marks is part of the *du Pont* analysis. As noted in ALZNJ’s Br., the marks at issue are simply not substantially similar in sound, appearance, or connotation to convey the same overall commercial impression.

Lastly, ALZNJ has not taken the position that the descriptive words “Walk” and “Alzheimer’s” should be completely disregarded. Rather, ALZNJ made clear that descriptive terms simply have less significance in a likelihood of confusion analysis. *See* ALZNJ’s Br. at p. 8. Thus, while “Walk” and “Alzheimer’s” play a role, it is in a reduced capacity. Moreover, the non-disclaimed words, “End” and “Fight” are the most prominent words and, more importantly, are completely different words, share no letters, do not sound the same, do not have the same meaning, and are not pronounced the same. Additionally, Opposer’s Mark contains the word “Alzheimer’s Association” whereas Applicant’s Mark contains the word “Alzheimer’s New Jersey”.

In short, Opposer fails to address or raise any issues of material of fact that the marks at issue are different and that they are not similar in sound, appearance, or connotation. Applicant's Mark merely incorporates Applicant's First Design Mark and Applicant's Word Mark, both of which are registered for class 36 goods and services. Opposer is simply attempting a collateral attack on these previously registered marks. Therefore, it is respectfully submitted that Applicant's Mark and Opposer's Marks are not similar and thus this *du Pont* factor favors ALZNJ.

b. There is no Common Source Confusion as to Goods and Channels

As a preliminary matter, the dissimilarity of the marks outweighs all of the remaining *du Pont* factors. *Kellogg Co. v. Pack'em Enter. Inc.*, 14 USPQ2d 1545, 1550 (TTAB 1990). Therefore, it is respectfully submitted that even if these factors favor Opposer, that the dissimilarity between the marks is sufficient to find no likelihood of confusion.

In any event, the issue is not whether ALZNJ's and Opposer's goods are likely to be confused but whether "there is a likelihood that purchasers will be misled into the belief that they emanate from a common source." *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1624 (TTAB 1989). As noted above, there is no concern that ALZNJ's goods and services emanate from Opposer. Applicant's Mark expressly identifies "Alzheimer's New Jersey" with an accompanying depiction of the State of the New Jersey and thus eliminates any concern that ALZNJ's good and services emanate from a common source as Opposer. Additionally, as noted in ALZNJ's Br., ALZNJ's goods and services, and corresponding channels, differ from those of Opposer. Therefore, given the substantial dissimilarities between the subject marks, it is respectfully submitted that there is no likelihood of confusion in this regard.

c. Opposer's Mark Does Not Fall on the Strong Spectrum of Fame

Opposer incorrectly characterizes ALZNJ's position with regard to fame. ALZNJ does not assert that the fame element under *du Pont* is an "either or" proposition. Rather, ALZNJ's position is that Opposer's Mark does not fall on the strong end of fame for the purposes of a likelihood of confusion determination. Even if Opposer's Mark fell on the strong end of the fame spectrum, same is not enough to outweigh the other *du Pont* factors. *Coach Servs., Inc. v. Triumph Learning, LLC*, 101 USPQ2d 1713, 1723 (Fed. Cir. 2012).

Further, it is the duty of Opposer to clearly prove its claim that its mark is famous. *Blue Man Prods. Inc. v. Tarmann*, 75 USPQ2d 1811, 1819 (TTAB 2005). However, Opposer does not provide any context for its claim that its mark is famous. Instead, Opposer can only provide raw data. "Raw numbers of product sales and advertising expenses may have sufficed in the past to prove fame of a mark, but raw numbers alone in today's world may be misleading." *Bose Corp. v. QSC Audio Products, Inc.*, 293 F.3d 1367, 1375 (Fed. Cir. 2002). Opposer "has failed to submit any evidence to demonstrate (1) how its sales and advertising figures compare to its competitors in the industry, (2) how many times consumers encounter [Opposer's Marks], or (3) any context for its achievements...Without comparative numbers or market share percentages, it is difficult to place the apparent success or renown of [Opposer's Marks] mark into context." *International Beauty Exchange, Inc. v. K&N Distributors*, 2019 WL 4670665, at *7 (TTAB Sept. 20, 2019).

Opposer has not carried the heavy burden of clearly establishing that its marks are famous. In a last minute attempt to rectify this defect, Opposer makes the misguided assertion that "Applicant's own fundraising figures provide the comparable context that Applicant claims does not exist." The requirement of context is not merely between a large non-profit and one local New Jersey non-profit. Rather, it is predicated upon the market as a whole and Opposer simply fails to submit any evidence of same. Notably, the information that has been provided establishes that

Opposer's marks fall on the weak end of the fame spectrum. *See* Declaration of Lisa D. Taylor ("Taylor Decl."). at **Ex. E**.

Therefore, it is respectfully submitted that Opposer has failed to produce any evidence of fame relative to its claim for likelihood of confusion claim and that same favors ALZNJ.

d. There Exist Similar Marks on Similar Goods

ALZNJ has produced numerous other registrations and evidence of how those marks are used. The third-party registrations evidence numerous third-parties, under class 36 goods and services, using the color purple, the word "Walk", and the word "Alzheimer's" throughout the United States. Opposer's arguments that it cannot "police every fundraising walk" confirms that Opposer has not properly protected its alleged marks and that these elements are commonly used for fundraising. Opposer has also not produced any cease and desist letters relative to Opposer's Design Mark which is not yet registered.

Opposer's sole argument is that the none of the third-party marks "even approach Alzheimer's Association's WALK TO END ALZHEIMER'S" without then providing any analysis. Opposer also alleges that it is not claiming that "its registration precluded any entity from holding fundraising walks or from using the word "Alzheimer's" in its marketing" but this is the very basis for Opposer's current opposition and its assertion that "WALK TO FIGHT ALZHEIMER'S" is confusing similarly with "WALK TO END ALZHEIMER'S".

e. Opposer has Acted in Bad Faith and there Exist No Actual Confusion

First, Opposer does not address, at all, ALZNJ assertion that there has been no actual confusion. Second, as to bad faith, Opposer has not produced any evidence in support of its assertion of bad faith which is predicated entirely upon its likelihood of confusion claim and the parties' prior affiliation. These presumptions do not support a claim for bad faith. In contrast,

ALZNJ has presented evidence of Opposer's bad faith during the time Applicant's Marks were in use. See ALZNJ's Br. at p. 16.

For these reasons, it is respectfully submitted that the balancing of the *du Pont* factors favor ALZNJ thereby warranting the denial of Opposer's Motion for Summary Judgment and the granting of ALZNJ's Cross-Motion for Summary Judgment.

II. There Exists No Basis to Dismiss ALZNJ's Affirmative Defenses
a. ALZNJ Has a Valid Morehouse Defense

ALZNJ has properly asserted the Morehouse defense which "is an equitable defense in the nature of laches or acquiescence." *Tbc Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311 (TTAB 1989). In its Answer, ALZNJ expressly pleads that Opposer is barred by the doctrines of laches, estoppel, waiver, and acquiescence. Additionally, a claim under the Morehouse defense is equivalent to a claim that Opposer fails to state a claim upon which relief can be granted, as pled in ALZNJ's Answer.

Moreover, there is no issue of surprise. In Opposer's moving brief, Opposer made clear that ALZNJ asserted that the "sole basis for the affirmative defense is Applicant's allegation that Alzheimer's Association 'exercised an inexcusable delay to the detriment of [Applicant]' **by not objecting to Applicant's other "Walk to Fight Alzheimer's" marks, which matured to registration**, and the only evidence provided to support the allegation are the prior registrations themselves.'" See Opposer's Br. at p. 19 (emphasis added). Thus, together with the equitable defenses asserted by ALZNJ and Opposer's knowledge of ALZNJ's Morehouse Defense, it is respectfully submitted that same has been properly pled. *Gaming and Leisure Properties, Inc. v. Global Logistic Properties Ltd.*, 91226379, 2017 WL 3670414, at *2 (TTAB Apr. 11, 2017)("A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if the defense raises factual issues that should be determined on the merits. Applicant's defenses are not

clearly articulated, but can be construed as grounded in *Morehouse*...or independently as the equitable defenses of laches and estoppel. TBMP § 311.02(b)").

However, in the event that the Board is of the opinion that ALZNJ's Morehouse defense is not clearly stated, it is respectfully requested that ALZNJ be granted leave to amend its Answer to clarify same as this issue is one that should be addressed on the merits and in equity.

Additionally, the Morehouse defense is applicable here because Applicant's Mark and Applicant's First Design Mark are substantially identical and owned by ALZNJ.



(Applicant's First Design Mark **previously registered**)



(Applicant's Mark pending)

As is evident from even a cursory review of Applicant's First Design Mark and Applicant's Mark, the two marks are substantially identical from a visual perspective. The lone difference being a slight change in color with the addition of the color green and inverting the white and purple colors. The wording in the two marks is the same; "Fight" is emphasized the same in both marks, both marks incorporate the colors purple and white; and the marks share the exact same design elements.

Additionally, both Applicant's First Design Mark and Applicant's Mark are for the identical class 36 goods and services:

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| <p>Applicant's First Design Mark: (See Taylor Decl. at Ex. B)</p> | <p>CLASS 36: Charitable fundraising; Charitable fundraising services; Charitable fundraising services by means of running and walking events; 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 research and care; Charitable fundraising services by means of organizing and conducting special events; Charitable fundraising services by means of organizing walks and other special events for Alzheimer's care and research; Charitable fundraising services for promoting research, education and other activities relating to Alzheimer's; Charitable fundraising services for</p> |
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|--------------------------|---|
| | support of Alzheimer's research and care; Charitable fundraising to support Alzheimer's research and care; Charitable foundation services , namely, providing fundraising activities to support medical research and procedures for those in need; Charitable services, namely, fundraising services by means of organizing special events for Alzheimer's research and care; On-line charitable fundraising. |
| Applicant's Mark: | CLASS 36: Charitable foundation services, namely, providing fundraising activities to support medical research and procedures for those in need; Charitable fundraising; 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; Charitable fundraising services for Alzheimer's care and research; Charitable fundraising services; Charitable fundraising services by means of organizing and conducting special events; Charitable fundraising services by means of organizing walks and other special events for Alzheimer's; Charitable fundraising services for promoting research, education and other activities relating to Alzheimer's care and research; Charitable fundraising to support Alzheimer's care and research; Charitable services, namely, fundraising services by means of organizing special events for Alzheimer's care and research; On-line charitable fundraising. |

Thus, the services and goods under Applicant's First Design Mark and Applicant's Mark are one in the same. Opposer's assertion that the goods and services under Applicant's Mark are broader than its prior registration is without merit. Opposer claims that Applicant's First Design Mark does not cover the same goods and services but, as bolded above, both marks cover the same goods and services which are aimed at charitable fundraising and Alzheimer's research and care.

Therefore, it is respectfully submitted that ALZNJ has properly asserted a valid Morehouse defense and thus ALZNJ should be entitled to summary judgment.

b. ALZNJ Has Valid Defenses of Laches, Acquiescence, Equitable Estoppel, Unclean Hands, and Failure to State a Claim.

ALZNJ's equitable defenses of laches, acquiescence, and equitable estoppel "may be based on an opposer's failure to object to a registration of substantially the same mark for substantially the same goods and services as those in the opposed application." *Gaming and Leisure Properties, Inc.*, 2017 WL 3670414 at *3 (internal citations omitted) As above, Opposer has failed to timely

object to these prior registrations and thus is barred by these equitable defenses. ALZNJ also has a valid Unclean Hands defense. A component of this defense, which is essentially ignored by Opposer, is that Opposer has been utilizing ALZNJ's marks in order to divert consumers away from ALZNJ and to Opposer since ALZNJ's disaffiliation.

Lastly, as to ALZNJ's Failure to State a Claim defense, ALZNJ has provided authority for why the Failure to State a Claim must stand; it is an amplification of ALZNJ's denials in its Answer. In contrast, Opposer provides no legal authority for the dismissal of this defense.

III. ALZNJ is Entitled to Summary Judgment of the Dilution Claim as there is no Evidence of when Opposer's Marks Became Famous

First, ALZNJ is entitled to summary judgment because Opposer has not pled when Opposer's Marks became famous nor has Opposer provided any evidence, even at this Motion for Summary Judgment stage, indicating when its marks allegedly became famous and thus there are no questions of fact. As such, at this late hour to permit Opposer to amend its opposition to correct these deficiencies would be wholly prejudicial to ALZNJ. Therefore, for this reason alone, it is respectfully submitted that ALZNJ is entitled to summary judgment as to Opposer's dilution claim.

Second, Opposer ignores that since it cannot demonstrate a strong presence of fame as to its likelihood of confusion claim, it cannot satisfy a claim for fame as to its dilution claim. *Fruit of the Loom, Inc. v. Riley, et al.*, 77177120, 2012 WL 1881494, at *6 (TTAB May 7, 2012)(“Because we have found above that opposer has not met its burden of demonstrating that its FRUIT OF THE LOOM mark, or any of its other marks, is famous for purposes of our likelihood of confusion determination, opposer cannot prevail on this record on its claim of dilution which requires a stronger showing of fame.”)

Thus, ALZNJ is entitled to Summary Judgment as to the Dilution claim.

IV. ALZNJ's Cross-Motion is Timely and Opposer's Reply Brief is Over the Page Limitation and Should Not Be Considered.

ALZNJ's Cross-Motion for Summary Judgment is timely because when Opposer filed its Summary Judgment Motion "the case [was] suspended by the Board with respect to all matters not germane to the motion." TBMP §528.03. This same rule expressly provides for the filing of cross-motions for summary judgment. Thus Opposer's September 20, 2019 summary judgment motion stayed the deadline for the first testimony period and thus ALZNJ's Cross-Motion is timely.

Furthermore, Opposer's reply is 30 pages long. Pursuant to the Board's October 16, 2019, Order, Opposer's reply was to be limited to 25 pages. Notably, "because 37 C.F.R. § 2.127(a) does not require an index of cases and authorities or a table of contents, should a party elect to include these items, they will count as part of the page limit for the brief." TBMP §502.02(b). Since Opposer has submitted a reply over the page limitation, same should not be considered. *See e.g. Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1141 (TTAB 2011) (reply brief not considered because it exceeded the page limit). Opposer also submits a document labeled as Exhibit O which was not produced in discovery and should not be considered on a motion for summary Judgment.

CONCLUSION

For the foregoing reasons, Applicant, Alzheimer's New Jersey, Inc. respectfully requests that the Board grant Applicant's Cross-Motion for Summary Judgment dismissing Opposer's Opposition in its entirety and denying Opposer's Motion for Summary Judgment.

DATED: December 3, 2019 By: /Lisa D. Taylor/
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CERTIFICATE OF FILING AND SERVICE

The undersigned certifies that on this 3rd day of December, 2019, I caused a true and accurate copy of Applicant, Alzheimer's New Jersey, Inc.'s Memorandum in further support of its Cross-Motion for Summary Judgment and in further opposition to Opposer, Alzheimer's Disease and Related Disorders Association's Motion for Summary to be filed with the Trademark Trial and Appeal Board's ESTAA filing system and to be served *via* email to the following:

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DATED: December 3, 2019

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