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

Proceeding	91253702
Party	Defendant Forevernote Inc.
Correspondence Address	LINDSAY J. HULLEY RUTAN & TUCKER, LLP 611 ANTON BOULEVARD 14TH FLOOR COSTA MESA, CA 92626 trademarks@rutan.com no phone number provided
Submission	Answer
Filer's Name	Meredith Williams
Filer's email	madams@rutan.com, lhulley@rutan.com, mwilliams@rutan.com, trademarks@rutan.com, dnakata@rutan.com, mconour@rutan.com
Signature	/Meredith Williams/
Date	03/09/2020
Attachments	Answer to Notice of Opposition - FOREVERNOTE.pdf(116257 bytes)

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

EVERNOTE CORPORATION,

Opposer,

v.

FOREVERNOTE INC.

Applicant.

Opposition No. 91253702

Serial No. 88/619,740

Mark: FOREVERNOTE

ANSWER TO NOTICE OF OPPOSITION

Applicant, Forevernote Inc. (“Applicant”), by and through its undersigned counsel, hereby responds to the Notice of Opposition filed by opposer Evernote Corporation (“Opposer”) (the “Opposition”) opposing registration of Application Serial No. 88/619,740 (the “Application”). Applicant responds to the Opposition as follows:

Regarding the first unnumbered introductory paragraph of the Opposition, Applicant admits that it applied for the mark FOREVERNOTE for “Downloadable mobile application for ordering custom print and digital memory books, scrapbooks, personal archives, family archives, wedding albums, diaries, vacation albums, family albums, family histories, photograph albums, birthday albums, and special event albums for others and for delivery thereof” in Class 9, and for “Preparation of custom print and digital memory books, scrapbooks, personal archives, family archives, wedding albums, diaries, vacation albums, family albums, family histories, photograph albums, birthday albums, and special event albums for other” in Class 45 (the “FOREVERNOTE Mark”), Application Serial No. 88/619,740, but denies that Opposer will be damaged by the issuance of a registration for the FOREVERNOTE Mark. Applicant has insufficient knowledge

or information as to the truth of the remaining allegations contained in the first unnumbered introductory paragraph of the Opposition regarding Opposer, and therefore denies said allegations.

1. Applicant denies that Opposer has adequately set forth allegations establishing that it owns “a family of marks.” To the extent that Opposer cites U.S. trademark records with respect to its pleaded registrations, those records are the best evidence of their content, and therefore, reference is hereby made to the same. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 1 of the Opposition, and therefore denies said allegations.

2. The allegations contained in Paragraph 2 of the Opposition require no response, as Opposer merely refers to its cited marks in Paragraph 1 as the “EVERNOTE Marks.”

3. Applicant admits that Opposer appears to own the cited registrations, but Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 3 of the Opposition, and therefore denies said allegations. To the extent that Opposer cites U.S. trademark records with respect to its pleaded registrations, those records are the best evidence of their content, and therefore, reference is hereby made to the same.

4. Applicant admits that Opposer appears to be the owner of the pleaded registrations. To the extent that Opposer cites U.S. trademark records with respect to those registrations, those records are the best evidence of their content, and therefore, reference is hereby made to the same.

5. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 5 of the Opposition, and therefore denies said allegations. Applicant further notes that Opposer does not allege that its registered services including memory book-making services and Applicant is unaware of Opposer providing any such services. On that

basis, Applicant specifically denies that Opposer has registered any marks for memory book-making services” or any related goods or services.

6. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 6 of the Opposition, and therefore denies said allegations.

7. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 7 of the Opposition, and therefore denies said allegations.

8. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 8 of the Opposition, and therefore denies said allegations.

9. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 9 of the Opposition, and therefore denies said allegations.

Applicant specially denies that Opposer’s Marks are strong.

10. Applicant admits that it filed the Application to register the mark FOREVERNOTE for goods and services in Classes 9 and 45, but denies that these goods and services involve turning Applicant’s customers’ cherished memories into customized keepsake books create any likelihood of confusion with Opposer’s note-taking app or related services.

11. Applicant admits that Opposer’s asserted filing and registration dates appear to predate Applicant’s filing date. Applicant has insufficient knowledge or information as to the truth of the allegations contained in Paragraph 11 of the Opposition as to Opposer’s actual use, and therefore denies said allegations.

12. Applicant denies the allegations of Paragraph 12 of the Opposition.

13. Applicant denies the allegations of Paragraph 13 of the Opposition.

14. Applicant denies the allegations of Paragraph 14 of the Opposition.

For its affirmative assertions to amplify Applicant's denial that there is a likelihood of confusion between Opposer's registration and the Application, Applicant alleges as follows:

1. Opposer does not have exclusive rights to utilize the descriptive term "EVERNOTE" for all application services and should not be permitted to monopolize marks that are not confusingly similar to Opposer's mark, especially where Opposer's mark and Applicant's mark are distinguishable as used in commerce and Opposer's goods and services are distinguishable from the goods and services of Applicant.

2. Opposer has acquiesced to similar competitive marks which exist in the marketplace for other note-related software, as well as registrations for goods and services in International Classes 9 and/or 42 – i.e. Opposer's same classes, while Applicant's mark is for goods and services in Classes 9 and 45 – including but not limited to: Reg. No. 5,754,040 ("FILNOTE" for "Computer software, recorded, for use in data processing, use as electronic note processing"), Reg. No. 5,568,273 ("CHROMA NOTE" for "Downloadable software application for create, storing, and organizing notes and reminder alerts"), Reg. No. 5,340,900 ("MIXNOTE" for "Computer application software for mobile phones, namely, software for use in taking notes and memo; Computer application software for mobile phones, namely, software for use in editing images; Computer application software for mobile phones, namely, software for use in recording voice; Computer operating programs; Computer operating programs and computer operating systems; Computer programs for word processing; Computer programs for image processing; Computer programs for recording sound; Recorded computer operating programs"), Reg. No. 5,244,113 ("TRIVIANOTE" for "Software for online study tools, note-taking, and creating social games based on notes; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer

software for educational purposes; Computer application software for mobile phones, namely, software for online study tools, note-taking, and creating social games based on notes; Computer application software for education, namely, software for creating study tools.”), Reg. No. 4,867,861 (“C NOTES” for “Computer software for writing clinical notes for physicians, medical related service providers, dentists and dental related service providers based on a touch sensitive computer screen.”), Reg. No. 4,738,985 (“GATHERNOTE” for “Computer application software for mobile phones, tablets and handheld computer devices, namely, software for use in database management and electronic storage of data that allows the user to organize projects, keep all the relevant information in one place, take photos, add notations, draw dimensions, record audio notes, pin information to the photo, add tags, search and filter.”), Reg. No. 4,668,273 (“BOX NOTES” for “Computer software for capturing, organizing, searching, storing, synchronizing, recognizing, sharing, editing and transmitting any number of typed or imaged notes within a collaborative work environment”), Reg. No. 4,478,735 (“COLORNOTE” for “computer application software for mobile phones, namely, software for saving, storing, organizing, sharing, displaying, searching and linking notes, for generating reminders and alarms regarding stored notes and for synchronizing notes between mobile devices and online databases”), Reg. No. 4,418,082 (“INTELLINOTE” for “Computer software for use in capturing, storing, organizing, linking, tagging, sharing, searching, analyzing, enhancing and delivering digital information, namely, tasks, emails, notes, questions and answers, audio files, video files, data and text from external business systems, images, and multimedia files”), Reg. No. 4,423,932 (“TAPNOTES” for “Computer software for recording voice, text and data as indexed meeting or classroom notes on mobile phones, tablet, and notebook computers”), Reg. No. 4,377,759 (“ARCNOTE” for “Computer software for adding notes to digital content”), Reg. No. 4,308,686

(“SOUNDNOTE” for “Downloadable software for use in note-taking”), Reg. No. 1,209,743 (“SKINNY NOTE” for “Computer application software for mobile phones, tablets, computers, namely, software for notes, task and office management”), Reg. No. 1,201,167 (“TURBONOTE” for Downloadable computer software for sticky note memo program for personal information management.”), Reg. No. 4,180,884 (“GOODNOTES” for “Software application for use in note-taking, namely, software application for recording, organizing, editing and transmitting audio and visual information and images in electronic form”), Reg. No. 3,913,914 (“SIMPLENOTE” for “Computer application software for mobile phones, namely, software for creating, managing, and synchronizing notes.; Computer software for the collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; Computer software for wireless content delivery; Computer software that provides web-based access to applications and services through a web operating system or portal interface”), Reg. No. 2,844,710 (“ONENOTE” for “computer software for use in note-taking, namely, computer software for recording, organizing, editing and transmitting audio and visual information and images in electronic form; computer software for viewing and editing meeting agendas and to-do lists; computer software for reminding users of dates and events; computer software for accessing shared documents (notes); computer software for use in accessing and transmitting information to computer networks, namely, computer software for emailing notes and publishing notes on computer networks.”).

3. Opposer’s rights in its marks are limited based on the substantial number of third party uses of marks which are similar to those of Opposer and some of which are used in connection with goods which are more closely related to the goods of Opposer than are those of Applicant.

4. Opposer suffered no damages nor will it suffer damages in the future by the registration of Applicant's mark.

5. Applicant reserves its right to raise any and all affirmative defenses based on information it learns, through discovery or otherwise, which would serve as the basis for an additional defense up to the time including after trial.

WHEREFORE, Applicant respectfully requests that the Opposition be dismissed in its entirety, with prejudice, and that Application Serial No. 88/619,740 be allowed to proceed towards registration.

This Answer to the Opposition is being submitted electronically through ESTTA.

Dated: March 9, 2020

Respectfully submitted,

/Meredith Williams/

Michael Adams
Meredith Williams
RUTAN & TUCKER, LLP
611 Anton Boulevard, Suite 1400
Costa Mesa, California 92626
(714) 641-5100
madams@rutan.com
mwilliams@rutan.com
dnakata@rutan.com
trademarks@rutan.com

Attorneys for Applicant
Forevernote Inc.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that she is one of the attorneys for Applicant Forevernote Inc., in the above-captioned Opposition proceeding and that on the date which appears below, she caused a copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION** to be served on the following, via electronic mail:

Opposer's Attorney of Record:

Jennifer L. Barry
Latham & Watkins LLP
12670 High Bluff Drive
San Diego, CA 92130
jennifer.barry@lw.com
brett.frazer@lw.com
ipdocket@lw.com
alethia.corneil@lw.com

Dated: March 9, 2020

/Meredith Williams/
Meredith Williams