

ESTTA Tracking number: **ESTTA1059520**

Filing date: **06/02/2020**

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

Proceeding No.	91253702
Filing Party	Plaintiff Evernote Corporation
Other Party	Defendant Forevernote Inc.
Pending Motion	There is no motion currently pending and no other motion is being filed concurrent with this consent motion.
Attachments	2020_06_02_Joint Motion to Suspend Proceeding.pdf(218953 bytes)

Consent Motion for Suspension in View of Civil Proceeding

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Evernote Corporation hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Evernote Corporation has secured the express consent of all other parties to this proceeding for the suspension requested herein.

Certificate of Service

The undersigned hereby certifies that a copy of this filing has been served upon all parties, at their address of record by Email on this date.

Respectfully submitted,

/s/ Jennifer L. Barry

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06/02/2020

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

In re Application No. 88/619740
Filed: September 17, 2019
Published: January 21, 2020
Trademark: **FOREVERNOTE**

Evernote Corporation,)	
)	Opposition No. 91253702
Opposer,)	
v.)	
)	
Forevernote Inc.,)	
)	
Applicant.)	
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JOINT MOTION TO SUSPEND PROCEEDING

Pursuant to 37 C.F.R. § 2.117 and Rule 510.02(a) of the Trademark Trial and Appeal Board’s Manual of Procedure, Opposer Evernote Corporation (“Opposer”) and Applicant Forevernote Inc. (“Applicant”) hereby jointly request the suspension of this opposition proceeding pending the outcome of the civil action, *Forevernote, Inc. v. Evernote Corporation*, Case No. 3:20-CV-00957-BAS-BGS, pending in the U.S. District Court for the Southern District of California. A copy of the complaint filed by Applicant against Opposer in that matter is attached as Exhibit A. The parties stipulate to this suspension and request that this matter be immediately suspended.

Dated: June 2, 2020

Respectfully submitted,

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EXHIBIT A

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7 Attorneys for Plaintiff
FOREVERNOTE, INC., a Delaware corporation
8

9 UNITED STATES DISTRICT COURT
10 SOUTHERN DISTRICT OF CALIFORNIA
11

12 FOREVERNOTE, INC., a Delaware
corporation,

13 Plaintiff,

14 vs.

15 EVERNOTE CORPORATION, a
16 Delaware corporation,

17 Defendant.
18

Case No. **'20CV0957 BAS BGS**

COMPLAINT FOR:

- 19 (1) **DECLARATORY JUDGMENT
OF NON-INFRINGEMENT OF
TRADEMARK**
- 20 (2) **DECLARATORY JUDGMENT
OF NO UNFAIR
COMPETITION**

JURY TRIAL DEMANDED

Date Action Filed: May 22, 2020
Trial Date: TBD
21

22 Plaintiff Forevernote, Inc., (“Plaintiff” or “Forevernote”) alleges as follows
23 for their Complaint against Defendant Evernote Corporation (“Defendant” or
24 “Evernote”).

NATURE OF ACTION

25
26 1. This is an action seeking a declaratory judgment under 28 U.S.C.
27 §§ 2201 and 2202 that Plaintiff’s use of the mark FOREVERNOTE for customized
28 keepsake bookmaking services does not constitute trademark infringement of

1 Evernote Corporation’s EVERNOTE mark for a note-taking software application
2 under 15 U.S.C § 1114, nor false designation of origin or unfair competition under
3 15 U.S.C § 1125 and/or Business and Professions Code §§ 17200 et seq.

4 **JURISDICTION AND VENUE**

5 2. This Court has original jurisdiction over the subject matter of this
6 action. Original jurisdiction for any civil action arising under the Lanham Act, 15
7 U.S.C. §§ 1051 *et seq.*, is conferred on this Court pursuant to 15 U.S.C. § 1121(a)
8 and 28 U.S.C. § 1338(a).

9 3. Further, a case of actual controversy within the Court’s jurisdiction
10 exists between the parties concerning their respective trademark rights. The Court is
11 authorized to declare the rights of the parties in this case pursuant to the Federal
12 Declaratory Judgments Act, 28 U.S.C. §§ 2201-2202.

13 4. This Court has supplemental jurisdiction over the state law claims
14 under 28 U.S. Code § 1367 (a).

15 5. This Court has personal jurisdiction over Evernote Corporation because
16 Evernote Corporation is, on information and belief, a Delaware corporation, with a
17 place of business in San Diego, California, and has engaged in substantial business
18 activities in the State of California and, specifically, in this judicial district.

19 6. Venue is proper in this judicial district, pursuant to 28 U.S.C. § 1391(b)
20 and § 1391(c), because Defendant is located in this district, and because a
21 substantial part of the events giving rise to the claims alleged herein occurred in this
22 judicial district.

23 **THE PARTIES**

24 7. Forevernote, Inc., is a Delaware corporation, with its principal place of
25 business located at 2800 28th Street, Suite 302, Santa Monica, California 90405.

26 8. Upon information and belief, Evernote Corporation is a Delaware
27 corporation with a place of business located at 12651 High Bluff Drive, Suite 300,
28 San Diego, California 92130.

FACTUAL ALLEGATIONS

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9. Plaintiff Forevernote was founded in 2019 to create a way for people to turn personal memories into custom keepsake books to be shared and cherished.

10. Forevernote’s team of professionals provide a highly personalized service, setting up a fun and convenient phone interview with the customer and/or their loved ones. Based on these interviews and photos provided by the client, Forevernote’s editors and designers turn the stories and images shared into beautiful, high quality print and/or digital keepsake books.

11. The entire process is designed around client service, connecting each customer to a real person trained to elicit and recollect personal stories. Plaintiff’s services even include an optional add-on of certified translation to capture memories and stories from non-English speakers. Those stories and the customer’s pictures are then expertly crafted by Plaintiff’s editing and graphics team into a book for the user to treasure and share for a lifetime and even across generations.

12. While Forevernote’s services are convenient and affordable compared to competing services (which can charge upwards of \$2,000 and/or require more work on the client’s part), the service is a meaningful investment given the level of professional service involved. Specifically, Plaintiff’s packages start with the “Moments” package—available for \$199.00—which includes the personal 30-40 minute phone interview, an audio recording of that interview, professional transcription and book design, the addition of up to 10 personal photos, and a downloadable digital eBook that is typically 15-20 pages capturing 1-3 short stories. Plaintiff’s highest level package is the “Stories” package—available for \$999.00—which includes five 30-40 minutes personal phone interviews (individual or with a loved one), audio recordings of the interviews, professional transcription and book design, the addition of up to 50 personal photos, and a downloadable digital eBook that is typically 60-100 pages capturing 7-10 short stories. As such, consumers carefully consider purchasing Plaintiff’s services.

1 13. On September 17, 2019, Forevernote filed trademark application serial
2 number 88/619,740 based on an intent to use the mark “FOREVERNOTE” (the
3 “FOREVERNOTE Mark”) in connection with these services, i.e. preparing custom
4 print and digital memory books, as well as a downloadable mobile application for
5 clients to use in connection with these highly specialized and customized services.
6 While Plaintiff has since begun using its FOREVERNOTE Mark for its services
7 creating custom print and digital memory book, it has not yet created a mobile app
8 to put clients in touch with its professional interview and book design team.

9 14. On December 12, 2019, Defendant Evernote sent Plaintiff a letter
10 asserting Evernote’s “concern about potential consumer confusion between its
11 software products, including the Evernote App” and the services offered by
12 Forevernote per its application, requesting that Plaintiff abandon its application for
13 the FOREVERNOTE Mark and “[c]ease all current use of” that mark.

14 15. On January 10, 2020, Plaintiff responded to Evernote’s cease and desist
15 request with a letter thoroughly explaining Forevernote’s services and laying out
16 how, in view of the parties’ distinct services, marks, marketing channels, and other
17 relevant factors, there is no likelihood of confusion between the parties’ marks.

18 16. Among other things, Forevernote’s letter pointed out that reasonable
19 consumers will and do readily grasp the difference between Evernote’s note-taking
20 app (designed to help customers keep themselves organized) (the “Evernote App”)
21 and Forevernote’s highly customized and service-driven customer experience,
22 which is designed to craft, preserve, and share life stories. Consumer confusion is
23 thus unlikely in part because of the parties having fundamentally different services.

24 17. Furthermore, Forevernote’s letter responding to Evernote’s stated
25 concern pointed out that consumers will readily ascertain the differences between
26 the parties marks in view of the crowded field of “note”-formative marks for note-
27 taking applications. While the distinctions between Forevernote’s services and the
28 Evernote App would be enough of their own to dispel potential consumer confusion,

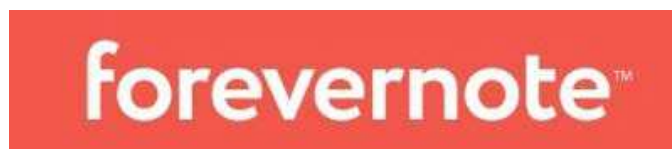
1 Forevernote’s letter highlighted over 20 registered trademarks and over 20 notes
2 currently in use for note-taking applications. This crowded field of note-formative
3 marks in use for computer software and apps—which are all far more similar to the
4 Evernote App than are Forevernote’s keepsake book-making services—renders
5 confusion even more unlikely between the parties’ distinct services.

6 18. Forevernote’s letter also pointed out that the parties use their marks in
7 different ways that create highly distinct commercial impressions, providing the
8 following illustration pulled from both parties’ actual use:



13
14 19. Since sending its response letter, Forevernote has further discovered
15 that Evernote, in fact, has a brand style guide that requires using the Evernote in a
16 very particular manner, including capitalizing “Evernote” (whereas both of the “e”s
17 in Plaintiff’s mark are lower-cased), using the “Mads the Elephant” logo mark, and
18 using a particular primary color palette (of green/black) and secondary color palette
19 (of light green/white/gray). A true and correct copy of Defendant’s brand style
20 guide, collected from the Evernote website, is attached hereto as **Exhibit A**.

21 20. Forevernote does not use a capital “E” in the FOREVERNOTE Mark,
22 does not use the “Mads the Elephant” logo or any confusingly similar design mark,
23 and does not use Evernote’s color palette. Instead, Plaintiff typically uses a soft
24 blue and/or warm red color palette, as shown in the image above and in following
25 logo used by Plaintiff on all of its social media pages (Facebook, Instagram,
26 LinkedIn, and Twitter):



1 21. Plaintiff’s trademark application was approved and published by the
2 United States Patent and Trademark Office (“USPTO”) on January 21, 2020. This
3 approval and publication means that the USPTO examining attorney reviewed the
4 existing federal trademark registrations and found no likelihood of confusion
5 between those registrations and Plaintiff’s FOREVERNOTE Mark.

6 22. On January 28, 2020, Evernote filed an opposition to Plaintiff’s
7 application before the USPTO Trademark Trial and Appeal Board (the “TTAB”)
8 based on Defendant’s registrations for the mark EVERNOTE (the “EVERNOTE
9 Mark”) for Defendant’s note-taking software application.

10 23. Defendant’s opposition before the TTAB asserts that Plaintiff’s
11 applied-for FOREVERNOTE Mark used for creating customized keepsake books
12 creates a likelihood of confusion with Defendant’s EVERNOTE mark used for the
13 Evernote App (the “EVERNOTE Mark”). Forevernote answered on March 9, 2020,
14 noting, *inter alia*, many of the same facts recited in its January 10, 2020 letter
15 showing that consumer confusion is not likely to occur between the parties’ marks.

16 24. During the initial discovery conference on April 7, 2020, counsel for
17 Forevernote inquired of Evernote’s counsel whether—in view of the facts raised by
18 Forevernote’s letter and answer—there was any prospect of settlement, such as by
19 reaching terms of a coexistence addressing any of Evernote’s outstanding concerns.
20 Evernote did not have any proposal, demanding that Forevernote abandon its mark
21 completely. Evernote served discovery requests on Forevernote that same day.

22 25. After Forevernote served its own discovery to Evernote, counsel for
23 Evernote reached out by email on May 4, 2020, requesting to suspend all TTAB
24 proceeding deadlines (including responding to both parties’ outstanding discovery)
25 and indicating that “unless we can reach a resolution in the very near term, we are
26 going to have to move this dispute into litigation in federal court.”

27 26. Forevernote agreed to Evernote’s requested extension of all deadlines
28 to facilitate the parties’ discussion of settlement.

1 Evernote Corporation pursuant to 28 U.S.C. §§ 2201 and 2202, as there is an actual
2 and existing justiciable controversy between Plaintiff and Defendant relating to the
3 EVERNOTE Mark and Plaintiff’s FOREVERNOTE Mark.

4 34. Specifically, Evernote Corporation has alleged, and Plaintiff denies,
5 that Plaintiff’s use of the FOREVERNOTE Mark used for a service designed to
6 create customized keepsake memory books infringes Evernote Corporation’s
7 EVERNOTE Mark used for the Evernote App.

8 35. Evernote’s allegation of infringement, along with its sending a cease
9 and desist letter, filing a TTAB opposition proceeding, and further explicitly
10 threatening Forevernote with litigation all demonstrate that the parties have adverse
11 legal interests in relation to the use of their respective marks, and that there is an
12 actual controversy regarding Plaintiff’s right to use the FOREVERNOTE Mark in
13 connection with its services.

14 36. Evernote’s allegations of trademark infringement, as set forth above,
15 create a real and substantial dispute between Plaintiff and Evernote relating to the
16 use of the FOREVERNOTE Mark. The allegations further create a real and
17 substantial apprehension on the part of Plaintiff that Evernote will file a lawsuit
18 against it asserting claims for trademark infringement under 15 U.S.C. § 1114.

19 37. Plaintiff seeks a declaratory judgment of non-infringement of
20 Evernote’s EVERNOTE Mark.

21 38. A judicial declaration of non-infringement is necessary and appropriate
22 at this time pursuant to 28 U.S.C. § 2201 so that Plaintiff may ascertain its rights
23 and duties with respect to the FOREVERNOTE Mark, including but not limited to
24 (a) whether Plaintiff will be allowed to continue using its mark in connection with
25 its custom keepsake book-making services and (b) whether Plaintiff will be allowed
26 to obtain a federal registration for its FOREVERNOTE Mark based on its federal
27 trademark application serial number 88/619,740 proceeding to registration.

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COUNT II

Declaratory Judgment of No Unfair Competition

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39. Plaintiff incorporates paragraphs 1 through 39 as if fully set forth herein.

40. This is an action for a declaratory judgment and further relief against Evernote Corporation pursuant to 28 U.S.C. §§ 2201 and 2202, as there is an actual and existing justiciable controversy between Plaintiff and Defendant relating to the EVERNOTE Mark and Plaintiff’s FOREVERNOTE Mark.

41. Specifically, Evernote Corporation has alleged, and Plaintiff denies, that Plaintiff’s use of the FOREVERNOTE Mark used for a service designed to create customized keepsake memory books constitutes unfair competition in violation of § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), and/or California Business and Professions Code §§ 17200 *et seq.*

42. Evernote’s allegation of unfair competition, along with its sending a cease and desist letter, filing a TTAB opposition proceeding, and further explicitly threatening Forevernote with litigation, all demonstrate that the parties have adverse legal interests in relation to the use of their respective marks, and that there is an actual controversy regarding Plaintiff’s right to use the FOREVERNOTE Mark in connection with its services.

43. Plaintiff seeks a declaratory judgment that Plaintiff’s use of the FOREVERNOTE Mark in connection with goods in commerce does not constitute unfair competition under the § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), or California law, including but not limited to California Business and Professions Code §§ 17200 *et seq.*

44. A judicial declaration of no unfair competition is necessary and appropriate at this time pursuant to 28 U.S.C. § 2201 so that Plaintiff may ascertain its rights and duties with respect to the FOREVERNOTE Mark, including but not limited to (a) whether Plaintiff will be allowed to continue using its mark in

1 connection with its custom keepsake book-making services and (b) whether Plaintiff
2 will be allowed to obtain a federal registration for its FOREVERNOTE Mark based
3 on its federal trademark application serial number 88/619,740 proceeding to
4 registration.

5 **PRAYER FOR RELIEF**

6 WHEREFORE, Plaintiff Forevernote, Inc., prays for entry of a declaratory
7 judgment against Defendant Evernote Corporation, as follows:

8 1. Declaring that Plaintiff’s use of the FOREVERNOTE Mark does not
9 constitute trademark infringement under 15 U.S.C. § 1114;

10 2. Declaring that Plaintiff’s use of the FOREVERNOTE Mark does not
11 constitute unfair competition under 15 U.S.C. § 1125(a);

12 3. Declaring that Plaintiff’s use of the FOREVERNOTE Mark does not
13 constitute unfair competition under Business and Professions Code §§ 17200 et seq.;

14 4. Declaring and certifying to the Director of the USPTO that Plaintiff’s
15 application serial number 88/619,740 for the FOREVERNOTE Mark may, pursuant
16 to any subsequent decision by the TTAB, proceed to registration despite Evernote’s
17 opposition thereto in view of absence of likely confusion between the marks;

18 5. Awarding Plaintiff attorneys’ fees, costs, and other expenses incurred
19 as a result of this controversy; and

20 6. Granting such further and other relief as this Court deems just and
21 proper.

22
23 Dated: May 22, 2020

RUTAN & TUCKER, LLP
MICHAEL D. ADAMS
MEREDITH L. WILLIAMS
SARAH E. GILMARTIN

24
25
26 By: /s/ Michael D. Adams

27 Michael D. Adams
Attorneys for Plaintiff
FOREVERNOTE, INC., a Delaware
28 corporation

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DEMAND FOR JURY TRIAL

Forevernote, Inc. demands a trial by jury on all issues so triable.

Dated: May 22, 2020

RUTAN & TUCKER, LLP
MICHAEL D. ADAMS
MEREDITH L. WILLIAMS
SARAH E. GILMARTIN

By: /s/ Michael D. Adams
Michael D. Adams
Attorneys for Plaintiff
FOREVERNOTE, INC., a Delaware
corporation

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **MOTION TO SUSPEND** has been served on June 2, 2020, by emailing said copy to Counsel for Applicant:

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