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Filing date: **08/03/2020**

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

Proceeding	91263563
Party	Plaintiff Pinson & Tang LLC
Correspondence Address	MUNIRA JESANI BLANK ROME LLP 717 TEXAS AVENUE 1400 HOUSTON, TX 77002 UNITED STATES Primary Email: houstontrademarks@blankrome.com Secondary Email(s): mjesani@blankrome.com 7136328628
Submission	Motion to Amend Pleading/Amended Pleading
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Signature	/Munira Jesani/
Date	08/03/2020
Attachments	Amended Notice of Opposition - FINAL.pdf(25018 bytes) Exhibit A.pdf(132101 bytes) Exhibit B.pdf(12236 bytes)

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

In re Application of Simplify Compliance, LLC

Application No.: 88/607,193

Filed: September 6, 2019

Mark: CDI POCKET GUIDE

Pinson & Tang LLC,	:	
a Texas limited liability company,	:	
	:	
Opposer,	:	
	:	Serial No. 88/607,193
v.	:	
	:	Opposition No. 91263563
Simplify Compliance, LLC,	:	
a Delaware limited liability	:	
company,	:	
	:	
Applicant.	:	

Hon. Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451
Attn.: Trademark Trial and Appeal Board

FIRST AMENDED NOTICE OF OPPOSITION

Opposer Pinson & Tang LLC, a Texas limited liability company located at 5127 Jackson Street, Houston, TX 77004, filed its Notice of Opposition on July 13, 2020 and now amends its Notice of Opposition as a matter of course, by submitting this

First Amended Notice of Opposition within 21 days of the Notice of Opposition.

Opposer believes that it would be damaged by the registration of the mark shown in Application Serial No. 88/607,193 and hereby opposes the same under the provision of Section 13 of the Trademark Act of July 5, 1946, as amended, 15 U.S.C. § 1063.

As grounds of opposition, it is alleged that:

1. Opposer is the senior user of CDI POCKET GUIDE.

Opposer has made continuous and extensive use of the distinctive CDI POCKET GUIDE mark, which has developed widespread public recognition and appeal. Opposer has used the CDI POCKET GUIDE mark on or in connection with quick reference pocket guides in the field of clinical documentation improvement (hereinafter, the "Goods") since at least as early as October 1, 2008.

2. Opposer is the exclusive owner of all rights, title, and interest in and to the CDI POCKET GUIDE mark in connection with the Goods and it filed U.S. Trademark Application No. 88/611,017 for CDI POCKET GUIDE on September 10, 2019. See printout from the USPTO database attached as Exhibit A.

3. Serial No. 88/607,193 was cited as a prior pending application against Opposer's application in a non-final office

action. Action on Opposer's application may be suspended pending final disposition of Serial No. 88/607,193, because Opposer's mark may be refused registration under Section 2(d) of the Trademark Act based on a likelihood of confusion with U.S. Trademark Application No. 88/607,193 because the mark is identical to Opposer's mark and the goods overlap with Opposer's Goods.

4. Through Opposer's extensive and continuous use of the CDI POCKET GUIDE mark, the mark has acquired substantial goodwill in connection with the Goods.

5. Opposer's extensive marketing, promotion, and use of the CDI POCKET GUIDE mark in commerce in the United States since at least as early as October 1, 2008, have caused customers, prospective purchasers, and the public generally to immediately associate the CDI POCKET GUIDE mark with Opposer and to expect a variety of pocket guides bearing the CDI POCKET GUIDE mark to have a connection with, or association with, Opposer.

**APPLICANT'S MARK IS CONFUSINGLY SIMILAR
TO THE MARK OWNED BY OPPOSER**

6. Opposer repeats and realleges the allegations contained in paragraphs 1 through 5 above, as if fully set forth herein.

7. On September 6, 2019, Applicant filed Application No. 88/607,193 for registration of the mark CDI POCKET GUIDE (hereinafter "Applicant's Mark") for "Quick reference pocket guide in the field of clinical documentation improvement" in International Class 16. The application was published for opposition in the Official Gazette dated June 23, 2020. See printout from the USPTO database attached as Exhibit B.

8. Application No. 88/607,193 was filed under Section 1(a) of the Trademark Act of July 5, 1946 based on alleged use in commerce in the United States since at least as early as December 31, 2011.

9. Opposer's use of the CDI POCKET GUIDE mark predates Applicant's application filing date.

10. Opposer's use of the CDI POCKET GUIDE mark predates Applicant's claimed date of first use in commerce of the CDI POCKET GUIDE mark in the United States.

11. Applicant's Mark is identical to Opposer's CDI POCKET GUIDE mark.

12. Applicant's Mark is identical in sight, sound, and meaning to Opposer's CDI POCKET GUIDE mark.

13. The use and registration of Applicant's Mark to identify its goods is likely to cause confusion, mistake, and

deception as to the source, origin, sponsorship, or association of the goods and will injure Opposer.

14. Any defects, objections, or faults found with the goods sold and rendered by Applicant under Applicant's Mark, because of the false association with Opposer, would inflict upon and seriously injure the reputation of Opposer.

15. The grant of a Certificate of Registration to Applicant for Applicant's Mark would be inconsistent with and in derogation of Opposer's prior rights and would therefore cause damage and injury to Opposer and deception of and confusion to the public.

APPLICANT HAS NO RIGHTS IN CDI POCKET GUIDE AND COMMITTED FRAUD IN FILING AND PROSECUTING THE APPLICATION

16. Opposer repeats and realleges the allegations contained in paragraphs 1 through 15 above, as if fully set forth herein.

17. Opposer began using CDI POCKET GUIDE on quick reference pocket guides authored by Dr. Richard Pinson and Cynthia Tang (the principals of Pinson & Tang LLC), in 2008. Opposer owns all copyright in the guides and has registrations evidencing the same.

18. In 2010, Opposer and Applicant executed a Content License Agreement ("the Agreement"). Opposer licensed to

Applicant the rights to print, publish, distribute, and sell the quick reference pocket guides. In 2011, Applicant began using CDI POCKET GUIDE, as a licensee, in connection with the print, publication, distribution, and selling of the pocket guides. Updated versions of the guides were released annually.

19. On July 25, 2019, Opposer submitted a notice of termination of the Agreement to Applicant. The Agreement terminated on September 30, 2019. This terminated Applicant's license to print, publish, distribute, and sell the quick reference pocket guides, including the license to use the CDI POCKET GUIDE trademark.

20. Applicant did not have ownership rights in the CDI POCKET GUIDE trademark at any time; thus, Applicant's filing and prosecution of Applicant's Mark as owner of the mark, constitutes fraud on the USPTO.

20. Additionally, the specimen of use submitted by Applicant is an image of the 2019 CDI Pocket Guide. If Applicant is still selling this guide, such conduct infringes Opposer's trademark rights in the CDI Pocket Guide. If Applicant has ceased selling this guide, then Applicant has no use on which to base its application, which was filed under Section 1(a) of the Trademark Act of July 5, 1946. Opposer has reviewed Applicant's

website, which does not appear to offer the 2019 CDI Pocket Guide.

APPLICANT HAS ACTED IN BAD FAITH

21. Because Applicant had been successfully selling the quick reference pocket guides for years as a licensee, Applicant's customers were expecting Applicant to release an annual update of the quick reference pocket guide in 2020.

22. Because the Agreement had terminated, upon information and belief, Applicant created its own pocket guide, titled "ACDIS Pocket Guide", which infringes Opposer's copyright in its pocket guide. Opposer has separately initiated communication with Applicant regarding this infringement issue.

23. Applicant began a targeted false advertising campaign in August 2019 to retain this customer base. Specifically, Applicant made several statements which Opposer believes are misleading and an attempt to trade off the goodwill of CDI POCKET GUIDE. A few examples are produced below:

- "New look, new feel - **same trusted CDI authority**"

This statement implies that the ACDIS Pocket Guide is authored by the same CDI authorities, Dr. Pinson and Ms. Tang.

- "Get your **annual** pocket guide from the one source you truly trust"

This statement implies that the ACDIS Pocket Guide is a continuation of the yearly publication of the CDI Pocket Guide authored by Dr. Pinson and Ms. Tang.

- "ACDIS always delivers the essential information you need, and ***our 2020 ACDIS Pocket Guide continues in that tradition.***"

This statement implies that the ACDIS Pocket Guide is simply the 2020 version of the CDI Pocket Guide.

24. Applicant's targeted false advertising resulted in at least one instance of customer confusion, in which customers believed they were receiving the CDI Pocket Guide authored by Dr. Pinson and Ms. Tang.

25. Applicant's conduct shows bad faith and an attempt to trade off the goodwill in the CDI POCKET GUIDE trademark.

WHEREFORE, Opposer prays that this opposition be sustained, and that Application Serial No. 88/607,193 be refused registration.

Respectfully submitted,

Pinson & Tang LLC

Date: August 3, 2020

By: /Munira Jesani/
Munira Jesani
Attorney for Opposer

BLANK ROME LLP
717 TEXAS AVENUE
SUITE 1400
HOUSTON, TX 77002

EXHIBIT A

Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 88611017

Filing Date: 09/10/2019

*NOTE: Data fields with the * are mandatory under TEAS Plus. The wording "(if applicable)" appears where the field is only mandatory under the facts of the particular application.*

The table below presents the data as entered.

Input Field	Entered
TEAS Plus	YES
MARK INFORMATION	
*MARK	CDI Pocket Guide
*STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	CDI Pocket Guide
*MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Pinson & Tang LLC
*STREET	5127 Jackson St
*CITY	Houston
*STATE (Required for U.S. applicants)	Texas
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. and certain international addresses)	77004
PHONE	713-927-1980
EMAIL ADDRESS	XXXX
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
LEGAL ENTITY INFORMATION	
*TYPE	LIMITED LIABILITY COMPANY
* STATE/COUNTRY WHERE LEGALLY ORGANIZED	Texas
GOODS AND/OR SERVICES AND BASIS INFORMATION	
*INTERNATIONAL CLASS	016
*IDENTIFICATION	Quick reference pocket guides in the field of clinical

	documentation improvement
*FILING BASIS	SECTION 1(a)
FIRST USE ANYWHERE DATE	At least as early as 10/01/2008
FIRST USE IN COMMERCE DATE	At least as early as 10/01/2011
SPECIMEN FILE NAME(S)	\\TICRS\EXPORT17\IMAGEOUT17\886\110\88611017\xml1\FTK0003.JPG
SPECIMEN DESCRIPTION	digital image of a product currently used in commerce
ADDITIONAL STATEMENTS INFORMATION	
*TRANSLATION (if applicable)	
*TRANSLITERATION (if applicable)	
*CLAIMED PRIOR REGISTRATION (if applicable)	
*CONSENT (NAME/LIKENESS) (if applicable)	
*CONCURRENT USE CLAIM (if applicable)	
CORRESPONDENCE INFORMATION	
*NAME	Pinson & Tang LLC
*STREET	5127 Jackson St
*CITY	Houston
*STATE (Required for U.S. addresses)	Texas
*COUNTRY	United States
*ZIP/POSTAL CODE	77004
PHONE	713-927-1980
*EMAIL ADDRESS	ctang@pinsonandtang.com
*AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
FEE INFORMATION	
APPLICATION FILING OPTION	TEAS Plus
NUMBER OF CLASSES	1
FEE PER CLASS	225
*TOTAL FEE PAID	225
SIGNATURE INFORMATION	
* SIGNATURE	/Cynthia Tang/
* SIGNATORY'S NAME	CYNTHIA TANG
* SIGNATORY'S POSITION	Principal
SIGNATORY'S PHONE NUMBER	713-927-1980
* DATE SIGNED	09/10/2019



Trademark/Service Mark Application, Principal Register

TEAS Plus Application

Serial Number: 88611017

Filing Date: 09/10/2019

To the Commissioner for Trademarks:

MARK: CDI Pocket Guide (Standard Characters, see [mark](#))

The literal element of the mark consists of CDI Pocket Guide. The mark consists of standard characters, without claim to any particular font style, size, or color.

The applicant, Pinson & Tang LLC, a limited liability company legally organized under the laws of Texas, having an address of
5127 Jackson St
Houston, Texas 77004
United States
713-927-1980(phone)
XXXX

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

For specific filing basis information for each item, you must view the display within the Input Table.

International Class 016: Quick reference pocket guides in the field of clinical documentation improvement

Use in Commerce: The applicant is using the mark in commerce on or in connection with the identified goods/services. The applicant attaches, or will later submit, one specimen as a JPG/PDF image file showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, regardless of whether the mark itself is in the standard character format or is a stylized or design mark. The specimen image file may be in color, and the image must be in color if color is being claimed as a feature of the mark.

In International Class 016, the mark was first used by the applicant or the applicant's related company or licensee predecessor in interest at least as early as 10/01/2008, and first used in commerce at least as early as 10/01/2011, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods/services, consisting of a(n) digital image of a product currently used in commerce.

[Specimen File1](#)

The applicant's current Correspondence Information:

Pinson & Tang LLC
5127 Jackson St
Houston, Texas 77004
713-927-1980(phone)
ctang@pinsonandtang.com (authorized).

Email Authorization: I authorize the USPTO to send email correspondence concerning the application to the applicant or the applicant's attorney, or the applicant's domestic representative at the email address provided in this application. I understand that a valid email address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in the loss of TEAS Plus status and a requirement to submit an additional processing fee of \$125 per international class of goods/services.

A fee payment in the amount of \$225 has been submitted with the application, representing payment for 1 class(es).

Declaration

Basis:

If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a):

- The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
- The mark is in use in commerce on or in connection with the goods/services in the application;
- The specimen(s) shows the mark as used on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.

AND/OR

If the applicant is filing the application based on an intent to use the mark in commerce under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e):

- The signatory believes that the applicant is entitled to use the mark in commerce;
 - The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application; and
 - To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.
- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.
- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Declaration Signature

Signature: /Cynthia Tang/ Date: 09/10/2019

Signatory's Name: CYNTHIA TANG

Signatory's Position: Principal

Signatory's Phone Number: 713-927-1980

Payment Sale Number: 88611017

Payment Accounting Date: 09/10/2019

Serial Number: 88611017

Internet Transmission Date: Tue Sep 10 13:51:53 EDT 2019

TEAS Stamp: USPTO/FTK-XXX.XX.XX.XX-20190910135153266

532-88611017-6105b46e7db5a5a53e95fc8387e

352cda33a4adcefdbbb0628faf120c0f037c367-

DA-51531727-20190909184156792129

CDI Pocket Guide

2018

CDI

POCKET
GUIDE

Richard D. Pinson, MD, FACP, CCS
Cynthia L. Tang, RHIA, CCS

EXHIBIT B

From: TMOOfficialNotices@USPTO.GOV
Sent: Tuesday, June 23, 2020 00:40 AM
To: trademarks@bassberry.com
Subject: Official USPTO Notice of Publication Confirmation: U.S. Trademark SN 88607193: CDI POCKET GUIDE: Docket/Reference No. 119831.0800

TRADEMARK OFFICIAL GAZETTE PUBLICATION CONFIRMATION

U.S. Serial Number: 88607193
Mark: CDI POCKET GUIDE
International Class(es): 016
Owner: Simplify Compliance, LLC
Docket/Reference Number: 119831.0800

The mark identified above has been published in the Trademark Official Gazette (TMOG) on Jun 23, 2020.

To Review the Mark in the TMOG:

Click on the following link or paste the URL into an internet browser: <https://tmog.uspto.gov/#issueDate=2020-06-23&serialNumber=88607193>

On the publication date or shortly thereafter, the applicant should carefully review the information that appears in the TMOG for accuracy. If any information is incorrect due to USPTO error, the applicant should immediately email the requested correction to TMPostPubQuery@uspto.gov. For applicant corrections or amendments after publication, please file a post publication amendment using the form available at <http://teasroa.uspto.gov/ppa/>. For general information about this notice, please contact the Trademark Assistance Center at 1-800-786-9199.

Significance of Publication for Opposition:

- * Any party who believes it will be damaged by the registration of the mark may file a notice of opposition (or extension of time therefor) with the Trademark Trial and Appeal Board. If no party files an opposition or extension request within thirty (30) days after the publication date, then eleven (11) weeks after the publication date a certificate of registration should issue.

To check the status of the application, go to http://tsdr.uspto.gov/#caseNumber=88607193&caseType=SERIAL_NO&searchType=statusSearch or contact the Trademark Assistance Center at 1-800-786-9199. Please check the status of the application at least every three (3) months after the application filing date.

To view this notice and other documents for this application on-line, go to http://tsdr.uspto.gov/#caseNumber=88607193&caseType=SERIAL_NO&searchType=documentSearch. NOTE: This notice will only become available on-line the next business day after receipt of this e-mail.