

ESTTA Tracking number: **ESTTA172489**

Filing date: **11/01/2007**

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

Proceeding	91175524
Party	Plaintiff Inspiration Software, Inc.
Correspondence Address	David P. Cooper Kolisch Hartwell, P.C. 520 S.W. Yamhill Street, Suite 200 Portland, OR 97204 UNITED STATES coop@khpatent.com
Submission	Opposition/Response to Motion
Filer's Name	David P. Cooper
Filer's e-mail	mandi@khpatent.com,cooper@khpatent.com
Signature	/david p. cooper/
Date	11/01/2007
Attachments	20071101 Opposer's Opposition to Applicant's Motion for Summary Judgment.pdf (8 pages)(113058 bytes) Exhibit A Applicant's Motion for Summary Judgment 9-27-07.pdf (30 pages)(1194831 bytes) Opp 1st set of Interrogatories 8-22-07.pdf (12 pages)(150767 bytes) Opp 1st Set of Req for Admissions 8-22-07.pdf (4 pages)(108818 bytes) Opp. 1st Req for Production of Docs 8-22-07.pdf (5 pages)(114164 bytes)

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

INSPIRATION SOFTWARE, INC.)	
)	Opposition No. 91175524
Opposer,)	
)	OPPOSER'S OPPOSITION
v.)	TO APPLICANT'S MOTION
)	FOR SUMMARY JUDGMENT
INSPIRED DESIGN, LLC)	
)	
Applicant.)	

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

Sir:

Introduction

For reasons which follow, opposer Inspiration Software, Inc. requests that the Board deny Applicant's Motion for Summary Judgment ("Applicant's SJ Motion") filed on September 27, 2007.

The Board should deny applicant's motion because there are genuine issues of material fact concerning most of the pertinent factors upon which the Board makes a likelihood-of-confusion ("LOC") determination. Genuine issues of material fact exist concerning at least the following LOC factors: similarity of the marks, goods/services, trade channels, strength of the mark, and applicant's intent in choosing the mark. In addition to the above reasons, opposer requests that the Board deny Applicant's SJ Motion because it is premature. Opposer should be allowed to receive applicant's responses to opposer's discovery requests, and to otherwise proceed with the opposition through testimony periods and final briefing. Prior to testimony periods, opposer is not required to "demonstrate the damage likely to accrue as a result" of applicant's registration.

On October 1, 2007, opposer received Applicant's SJ Motion and APPLICANT'S BRIEF IN SUPPORT OF ITS MOTION FOR SUMMARY JUDGMENT ("Applicant's Supporting Brief"). Applicant's Supporting Brief is attached as Exhibit A, and it includes a one-page Introduction followed by what appear to be three or four exhibits. Following the Introduction are several pages from the USPTO website that include a listing of other oppositions naming opposer. There is no coversheet to this document. Next follows a cover sheet entitled Exhibit B followed by the Declaration of Michele Behrenwald ("the Behrenwald Declaration"), president and owner of applicant. Another coversheet entitled Exhibit C follows with what appears to be a copy of applicant's federal trademark-service mark application for INSPIRED DESIGN. Then, there is a coversheet for Exhibit D with what appears to be a copy of opposer's Notice of Opposition for the present opposition.

Referring to Exhibit A, there is no discussion of the pertinent law and caselaw, and there is no application of law to facts. There is also no Certificate of Service. Opposer is assuming Nov. 1, 2007 is the deadline for opposition of Applicant's SJ Motion based upon the 9-27-07 date applicant's attorney signed that motion, thereby allowing opposer 30 days plus five extra days for mail service.

Opposer is somewhat at a loss to understand the legal basis for applicant's SJ Motion, but it will respond below as best that it can. Exhibit D to Applicant's Supporting Brief provides opposer's allegations, and Exhibit C provides applicant's application. Opposer does not understand how either of these is relevant to a summary judgment ruling. Opposer also does not understand the significance of the summary pages that appear to be from the USPTO website and list oppositions naming opposer.

Applicant's only testimonial support for its assertion that there are no genuine issues of material fact exist and summary judgment is proper is offered by applicant's president and

owner, testimony that cannot possibly be persuasive due to its inherent bias. Nonetheless, the Behrenwald Declaration includes applicant's legal conclusion that opposer's and applicant's marks are different, their goods and services are different, and that pertinent consumers would not be confused.

Notably, and in contrast to the Notice of Opposition, the Behrenwald contests that opposer's trademark/service mark rights are limited to the goods/services recited in opposer's federal registrations listed in paragraphs 3 and 4 of that Notice of Opposition. In so doing, applicant dismisses opposer's other trademark/service mark rights in its family of marks including its INSPIREDATA mark, and its INSPIRED mark (see paragraphs 5 and 6 of the Notice of Opposition), as well as dismisses the broad scope of protection opposer believes it has based upon paragraphs 2, 7 and 9 of the Notice of Opposition.

Nowhere does applicant mention that it has filed Applicant's SJ Motion during an extension period granted by opposer to respond to Opposer's discovery requests, unsigned copies of which are attached collectively as Exhibit B. Those discovery requests include a first set of Requests for Production of Documents, Interrogatories, and Requests for Admission. Opposer granted the extension twice to further settlement discussions. Applicant apparently decided instead to file Applicant's SJ Motion to leverage settlement. If the Board denies Applicant's SJ Motion, opposer and reinstates the proceedings it suspended by Order dated October 4, 2007, opposer will be able to receive applicant's discovery responses by resetting a new deadline with applicant.

Facts

The present opposition involves applicant's mark INSPIRED DESIGN for "books in the field of business management and operation; books in the field of personal development; religious books; gifts, namely picture books, story books, flash cards, children's books, blank journal books, and decals; greeting cards; pictures; paintings, in International Class 16; games, namely board

games and card games; toys, namely pet toys, in International Class 28; consulting services in new business start-up, business organization and management, and product and business-services development; auctioneering, in International Class 35 educational services, namely conducting seminars, workshops, lectures and classes in the fields of leadership, management, personal development, entrepreneurship, invention and creativity, educational services, namely, one-on-one mentoring in the field of career management; career counseling; charitable services, namely, educational mentoring and development of youth; operating instructions camps for youth, in International Class 41; and providing information on techniques for improving personal creativity; personal growth and motivation consulting services; personal lifestyle consulting services, in International Class 45”.

Applicant filed its intent-to-use application on June 21, 2005 and is accorded that date as its priority date if it uses the mark and files a Statement of Use evidencing that use in the required time period. As noted in opposer’s Notice of Opposition, opposer owns U.S. trademark and service mark registrations for the mark INSPIRATION. Opposer’s INSPIRATION mark is used for the following goods and services: computer programs in the field of idea development through visual diagramming, outlining and text creation, in International Class 9; computer education training, in International Class 41; and computer software design for others, in International Class 42.

Opposer’s market is the education market, which includes K-12, colleges, universities, and the adult education industry including corporate training and lifelong learning. Opposer also owns allowed U.S. Trademark Application Serial No. 78/734,800 for the mark INSPIRED for “computer software for use as a writing tool in education, home and business”. Opposer’s use of INSPIRATION is senior to applicant’s priority date for INSPIRED DESIGN, and opposer’s other applications for INSPIRED and INSPIREDATA form a family of marks that provide a broad scope

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.