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

Proceeding	91214329
Party	Defendant Kevin Alan Tussy
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Attachments	SEEDCP.0022T - Applicant's Opposition to Traditional Medicinals Motion for Summary Judgment (Brief Only).pdf(112289 bytes) SEEDCP.0022T - Applicant's Opposition to Traditional Medicinals Motion for Summary Judgment (Declarations).pdf(5932991 bytes)

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

In the Matter of Trademark Application No.: 85/694,743
Mark: WEIGHTLESS WATER
Filed on: August 3, 2012
Published for Opposition: September 20, 2013

)	
)	Opposition Number: 91214329
TRADITIONAL MEDICINALS INC.)	
Opposer,)	APPLICANT’S OPPOSITION TO
)	OPPOSER’S MOTION FOR
)	SUMMARY JUDGMENT
vs.)	
)	
)	
KEVIN ALAN TUSSY)	
Applicant.)	
_____)	

Applicant Kevin Alan Tussy (the “Applicant”) by and through his attorneys, Weide and Miller Ltd., submits this opposition to the motion for summary judgment (the “Motion”) filed by the Opposer Traditional Medicinals Inc. (the “Opposer”) on the basis that genuine issues of material fact exist which preclude the grant of Opposer’s Motion. This Opposition is based on and supported by the following memorandum of law, the papers on file in this matter, the attached declarations of Kevin Alan Tussy and Ryan Gile and the exhibits attached thereto, and any oral argument allowed by the Board.

I. INTRODUCTION

Applicant filed an intent-to-use application for the registration of the trademark “Weightless Water” (the “Proposed Mark”) on August 3, 2012. The Examining Attorney who examined Applicant’s application for the Proposed Mark noted a possible likelihood of confusion with Opposer’s mark, “Weightless” (“Opposer’s Mark”). However, after the Examining Attorney considered the arguments in Applicant’s Response to Office Action and worked directly with Applicant to revise the description of goods for the Proposed Mark, namely “bottled water and flavored bottled water, excluding teas, that is not nutritionally

fortified with vitamin and mineral nutritional supplements” (the “Proposed Goods”), to specifically avoid an overlap with Opposer’s Mark, the Examining Attorney allowed the Proposed Mark to proceed to publication. On September 10, 2013, Opposer filed a request for extension of time to file an opposition, which request was granted until January 8, 2014. Opposer filed its opposition to Applicant’s trademark on January 7, 2014. After the close of discovery, Opposer filed its Motion on October 21, 2014.

The opposition procedure is intended to remedy oversight or error in the examination process. *See* 2 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 20.01[1] (3d ed. 1992) (opposition proceedings provide “a backstop to purely *ex parte* examination of trademark applications”). With regard to the Proposed Mark, the Examining Attorney has made no error in determining that there is no likelihood of confusion between the Proposed Mark and Opposer’s Mark. Opposer includes many of the same arguments in its Motion as the Examining Attorney did in her Office Action. However, what Opposer has not done in its Motion is meet its burden of establishing that there are no disputed issues of material fact in this action. In its Motion, the Opposer makes misleading and self-serving statements and attempts to muddy the waters by presenting those statements as undisputed facts.¹ Even if the Applicant were to concede that the Proposed Mark is substantially similar to the Opposer’s mark (which Applicant does not), there are still issues of material fact in dispute that relate directly to the determination of a likelihood of confusion between the Proposed Mark and Opposer’s Mark, specifically, the alleged strength and fame of the Opposer’s Mark, relatedness of the goods, dissimilarity of packaging, and dissimilarity of trade channels.

II. APPLICANT’S RESPONSE TO OPPOSER’ STATEMENT OF FACTS

Applicant hereby responds to Opposer’s statement of facts as follows:

1. **Opposer states:** TradMed, one of the largest US manufacturers of herbal teas, TradMed owns and sells herbal tea and related products under a number of trademarks.

¹*See, e.g.*, page 8 of the Motion (“Under the undisputable facts, TradMed’s use and Applicant’s identified goods are related within the meaning of the Trademark Act.”); page 6 of the Motion (“There is no real dispute that Applicant’s WEIGHTLESS WATER mark is substantially identical to TradMed’s WEIGHTLESS trademarks.”).

Applicant's response: Applicant does not dispute that Opposer is a manufacturer of herbal teas. Applicant does not have sufficient information to know if Opposer is one of the largest such manufacturers in the United States, and therefore **disputes** that fact. Applicant further disputes that Opposer's status as a large manufacturer of herbal teas, even if true, is entirely irrelevant where Opposer has failed to provide evidence establishing that its market size has any impact on the strength or fame of the specific mark at issue in this Opposition.

Applicant does not dispute that Opposer owns and sells herbal tea and related products under a number of trademarks.

2. **Opposer states:** Since at least as early as 1979, TradMed continuously has used the trademark WEIGHTLESS in connection with herbal tea and related products.

Applicant's response: Applicant does not have sufficient information to know if Opposer has been using the Opposer's Mark since 1979 or to know with what "related" products on which Opposer has been using Opposer's Mark, and therefore **disputes** those facts. Moreover, Applicant has not provided any documentary evidence showing such continuous usage since 1979.

3. **Opposer states:** As of this proceeding, TradMed is the only entity to use WEIGHTLESS for any type of beverage, and there has been no evidence produced of any significant third party use, advertising or sales of any beverages under the WEIGHTLESS designation of source, of course, other than TradMed.

Applicant's response: Applicant **disputes** this. TradMed is not using WEIGHTLESS in connection with a beverage, but rather in connection with tea bags sold in a box and advertised and promoted as a diuretic weight loss aid. Moreover, at least in the past (during the same time as TradMed was purportedly using the WEIGHTLESS mark for its dietary herbal tea supplement and while TradMed had one existing registration for the WEIGHTLESS trademark), there was at least one other company that obtained a trademark registration (and thus established some degree of use) for the exact mark WEIGHTLESS for among other things, with milk and yogurt based food beverages. *See* U.S. Trademark Registration number 1,856,865, WEIGHTLESS. This registration was cancelled in 2001. *See* Declaration of Ryan Gile (the "Gile Declaration") ¶ 3 and Exhibit A thereto.

4. **Opposer states:** For over three decades, TradMed's WEIGHTLESS tea products have been sold in retail stores and by online retailers throughout the United States, including in national retail chains such as Whole Foods, Target, Kroger, Safeway and Amazon.com.

Applicant's response: Applicant **disputes** this statement to the extent that Opposer refers to products in the plural and to the extent that TradMed has not provided any documentary support in this case of sales for WEIGHTLESS teas going back three decades nor shown to whom such teas were sold. Only one product is currently for sale on the Opposer's website which uses the Opposer's Mark and evidence indicates that at most the same product (diuretic herbal weight loss tea bags) may have been sold under two flavour varieties at one point (regular Weightless and Weightless Cranberry) and are the only products to have been sold under the Opposer's Mark. *See* Gile Declaration, ¶4 and Exhibit B thereto (Opposer's Response to RFA ¶ 40); Gile Declaration, ¶5 and Exhibit C thereto (KAT000229-KAT000239); and Gile Declaration, ¶6 and Exhibit D thereto (recent screenshots from Opposer's website).

5. **Opposer states:** Typical packaging for its tea prominently features TradMed's WEIGHTLESS mark.

Applicant's response: Undisputed to the extent that Opposer is referring to the diuretic herbal weight loss tea bags that TradMed markets using the Opposer's Mark.

6. **Opposer states:** Presently, TradMed's WEIGHTLESS products are generally offered and sold to retail consumers for approximately \$5.49 per carton of 16 teabags, using the typical packaging that prominently displays the WEIGHTLESS brand.

Applicant's response: Applicant **disputes** this statement to the extent that Opposer refers to products in the plural. Opposer currently markets only one product under the Opposer's Mark. *See* Gile Declaration, ¶6 and Exhibit D thereto.

7. **Opposer states:** Despite TradMed's long extensive, exclusive, and ongoing use of the WEIGHTLESS trademark for beverages, Applicant submitted a trademark application for WEIGHTLESS WATER (Serial 85694743) on August 3, 2012 for "bottled water and

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