

This Opinion is not a
Precedent of the TTAB

Mailed: April 12, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Timber Dental LLC

v.

Tooth, LLC

Opposition No. 91234587

Lake James H. Perriguet of Law Works LLC,
for Timber Dental, LLC.

Winston O. Huff of W.O. Huff & Associates, PLLC,
for Tooth, LLC.

Before Cataldo, Ritchie, and Lynch,
Administrative Trademark Judges.

Opinion by Ritchie, Administrative Trademark Judge:

On November 28, 2016, Tooth, LLC (“Applicant”) applied to register DENTISTRY DONE DIFFERENTLY, in standard character form, for “dentist services,” in International Class 44.¹ Pursuant to a requirement from the Trademark Examining Attorney, Applicant disclaimed the exclusive right to use the term “DENTISTRY” apart from the mark as shown.

¹ Application Serial No. 87249627 was filed on November 28, 2016 under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), alleging Applicant’s bona fide intent to use in commerce.

Timber Dental, LLC (“Opposer”) filed a notice of opposition, alleging, in the ESTTA cover sheet, prior common law rights to the term DENTISTRY DONE DIFFERENTLY. The notice further states:

Opposer is the owner of non-abandoned service mark DENISTRY DONE DIFFERENTLY [sic] (“Opposer’s Mark”). Opposer has used Opposer’s Mark in interstate commerce continuously for years prior to Applicant’s intent to use application in association with the sale and marketing of Dental Services.²

Although Opposer misspells its alleged mark in the body of the notice, it clarifies that the marks are “identical.”³ Opposer alleges its priority of use and that “[t]he registration of Applicants Mark [sic] to Applicant will cause the relevant purchasing public to erroneously assume and thus be confused, misled, or deceived, that Applicant’s Services are offered by, licensed by, controlled by, sponsored by, or in some way connected, related or associated with Opposer, in violation of Section 2(d) of the Lanham Act.”⁴

Applicant denied the salient allegations of the amended notice.⁵ Only Opposer filed a brief.

² 1 TTABVUE 4 (para. 6).

³ 1 TTABUE 5 (para. 11). Opposer also spelled Applicant’s DENTISTRY DONE DIFFERENTLY mark as DENISTRY DONE DIFFERETLY in paragraph 4 of the Notice.

⁴ *Id.* (para. 14). The notice alleges other grounds which Opposer did not pursue in its trial brief. We consider those claims to be waived. *See Alcatraz Media, Inc. v. Chesapeake Marine Tour Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner’s pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived); *aff’d*, 565 F. App’x 900 (Fed. Cir. 2014) (mem.); *Knight Textile Corp. v. Jones Inv. Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (pleaded dilution ground not pursued on brief deemed waived).

⁵ Applicant included some affirmative defenses which Applicant did not pursue, and we deem these to be waived as well.

I. The Record and Evidentiary Issues

The record includes the pleadings and, by operation of Trademark Rule 2.122(b), 37 C.F.R. § 2.122(b), the file of the subject application. In addition, Opposer submitted a declaration of its owner, Matthew Kathan, DDS, with exhibits thereto, dated April 18, 2018.⁶

Applicant did not submit any evidence or testimony.

II. Standing and Priority

Standing is a threshold issue that must be proven in every inter partes case. *See Empresa Cubana Del Tabaco v. Gen. Cigar Co.*, 753 F.3d 1270, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *see also Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982) (“The facts regarding standing . . . must be affirmatively proved.”) To have standing, a plaintiff must have a real interest, *i.e.*, a personal stake in the outcome of the proceeding and a reasonable basis for its belief that it will be damaged. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-28 (Fed. Cir. 1999). Opposer did not plead ownership of a trademark application or registration. However, Opposer did introduce testimony that it uses the mark DENTISTRY DONE DIFFERENTLY for “dental services.”⁷ We find that Opposer has established its standing.

⁶ Opposer states on brief that it will “rely on evidence including . . . plaintiff and defendant’s interrogatories, admissions and responses, current internet advertisements and commentary . . .” 8 TTABVUE 7. As noted in Opposer’s description of the record, however, none of these were included, and we give them no consideration.

⁷ 7 TTABVUE 8.

To establish priority on a likelihood of confusion claim brought under Trademark Act Section 2(d), a party may rely on its own prior proprietary rights in a mark through ownership of a prior registration, actual use, or through use analogous to trademark use, such as use in advertising brochures, trade publications, catalogues, newspaper advertisements and Internet websites that creates a public awareness of the designation as a trademark identifying the party as a source. *See* Trademark Act §§2(d) and 45, 15 U.S.C. §§ 1052(d) and 1127. *See also Giersch v. Scripps Networks, Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009); *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996).

Inasmuch as Opposer has not pleaded ownership of any registered trademark, it must rely on common law use of its pleaded mark DENTISTRY DONE DIFFERENTLY as a trademark or use analogous to trademark use to prove priority. The mark must be distinctive, inherently or otherwise, and plaintiff must show priority of use. *See Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40 (CCPA 1981) There is no allegation or evidence that DENTISTRY DONE DIFFERENTLY is not distinctive of Opposer's pleaded "dental services," and we find that while the mark is suggestive, on this record it appears to be inherently distinctive.

Applicant's filing date is November 28, 2016. Applicant has not introduced any testimony of any earlier use of its mark, and this is the earliest date upon which Applicant may rely. Opposer, as noted, has not pleaded any application or registration on which to establish priority. Opposer's witness, Matthew Kathan, DDS,

testified that he is the owner of Opposer.⁸ He further testified that Opposer has been using the mark DENTISTRY DONE DIFFERENTLY for “dental services” since “the day we opened” in 2014.⁹ Dr. Kathan testified that Opposer has used the mark “continuously” since 2014, rendering “dental services” to patients from various states around the country.¹⁰ However, Dr. Kathan went on to connect his testimony regarding use of the mark to various exhibits showing Opposer’s promotional materials, which do not display the mark DENTISTRY DONE DIFFERENTLY, but

instead show the marks as



or



Dr. Kathan’s testimony includes authentication of Opposer’s mark as displayed on a web page (Ex. 1), business cards (Ex. 2), a window graphic (Ex. 3), an interior wall (Ex. 4), Instagram (Ex. 5), and a billboard (Ex. 9). Thus, when considered in its entirety, we find that his testimony regarding the mark DENTISTRY DONE DIFFERENTLY referred to use of marks that contain that wording along with other matter.

This evidence does not establish use of the mark that Opposer pleads in its notice and argues on brief, DENTISTRY DONE DIFFERENTLY. Rather, as Opposer

⁸ 7 TTABVUE 8.

⁹ *Id.*

¹⁰ 7 TTABVUE 8, 16.

alludes to at one point in its brief, Opposer's mark includes at least the word "FAMILY" in the literal element of its mark, and most uses include TIMBERDENTAL FAMILY DENTISTRY DONE DIFFERENTLY (and design).¹¹ Dr. Kathan also notes this in reference to Exhibit 1, saying: "This document comes from our website and it has Timber Dental Dentistry Done Differently on it."¹² He also makes this observation with regard to the Instagram photo in Exhibit 12,¹³ and the billboard shown in Exhibit 9.¹⁴ The actual mark referenced by Dr. Kathan, as shown on the exhibits is as follows:¹⁵



As noted, the entire literal element contained in Opposer's mark is TIMBERDENTAL FAMILY DENTISTRY DONE DIFFERENTLY or FAMILY DENTISTRY DONE DIFFERENTLY. This is not the same as the mark pleaded, and sought to be proven on brief, by Opposer. The mark pleaded by Opposer is simply DENTISTRY DONE DIFFERENTLY, which is a different mark. The Court of Appeals for the Federal Circuit has addressed the issue of what constitutes the "same mark" in *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812 (Fed. Cir. 2001):

¹¹ 8 TTABVUE 8.

¹² 7 TTABVUE 9.

¹³ 7 TTABVUE 12

¹⁴ 7 TTABVUE 15.

¹⁵ 7 TTABVUE 20.

A proposed mark is the “same mark” as previously-registered marks for the purpose of Trademark Rule 2.41(b) if it is the “legal equivalent” of such marks. A mark is the legal equivalent of another if it creates the **same, continuing commercial impression such that the consumer would consider them both the same mark**. Whether marks are legal equivalents is a question of law subject to our *de novo* review. No evidence need be entertained other than the visual or aural appearance of the marks themselves. *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159, 17 USPQ2d 1866, 1868 (Fed. Cir. 1991). (emphasis added)

We do not find DENTISTRY DONE DIFFERENTLY to be the “same mark” as



or



. The former gives the commercial impression of dentistry services of some unspecified sort rendered in a different manner. The latter more specifically reference “family dentistry” in particular as rendered in a different manner. As such, they do not have the same commercial impression.

Opposer did not seek to amend its pleading to substitute or include a claim of priority and likelihood of confusion based on the marks actually used. Furthermore, we cannot find, without more, that the pleadings have been amended by consent to include the marks as used, since Applicant did not submit any evidence, cross-examine Opposer’s witness, or submit a brief. *See P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini*, 570 F.2d 328, 196 USPQ 801, 804 (CCPA 1978) (Finding respondent was not given “fair notice” of petitioner’s arguments not included in petition).

Opposer did not plead or seek to argue on brief the merits of its case with respect to the different marks in which it established priority. Instead, Opposer pleaded, and argued, priority of the mark DENTISTRY DONE DIFFERENTLY. Given that this is not the mark for which Opposer has established use, Opposer has failed to prove its priority. Furthermore, Opposer cannot prevail on its claim of likelihood of confusion because it has submitted no evidence that it owns DENTISTRY DONE DIFFERENTLY as “a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States.” Trademark Act § 2(d).

Decision: The opposition is dismissed.