

FILED

UNITED STATES DISTRICT COURT  
EASTERN DISTRICT OF VIRGINIA  
ALEXANDRIA DIVISION

2006 MAR 17 A 10:53

CLERK US DISTRICT COURT  
ALEXANDRIA VIRGINIA

Civil Action No.

1:06cv-00029

GBL/TRJ

GoSMILE, Inc., a Corporation of Delaware

Plaintiff,

v.

Jon W. Dudas, Under Secretary of  
Commerce for Intellectual Property and  
Director of the U.S. Patent and Trademark  
Office,

Defendant.

**ACTION FOR REVIEW OF FINAL DECISION OF U.S. PATENT AND  
TRADEMARK OFFICE TRADEMARK TRIAL AND APPEAL BOARD UNDER  
15 U.S.C. § 1071(b)**

**I. INTRODUCTION**

1. In this Civil Action, GoSMILE, Inc. (GoSMILE) requests review and reversal of the final decision dated January 20, 2006, of the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office (USPTO) in U.S. Trademark application Serial No. 76/518,244, for the mark "GOSMILE PM" (the mark) for goods in International Class 3 of the USPTO Trademark Classification Schedule.

2. This Civil Action is filed pursuant to Section 21(b) of the Lanham Act, 15 U.S.C. § 1071(b). Pursuant to 15 U.S.C. § 1071(b), the deadline for filing this Civil Action is 60 days from the date of the final decision of the TTAB. Accordingly, this filing is timely.

**II. THE PARTIES**

3. The Plaintiff is GoSMILE, Inc. (GoSMILE), a corporation of Delaware, having a place of business at 110 East 42<sup>nd</sup> Street, Suite 1100, New York, NY 10017.

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4. The Defendant is the Under Secretary of Commerce for Intellectual Property and Director of the USPTO, a United States Government agency. He is sued in that capacity. The USPTO is physically located at 401 Dulany Street, Alexandria, VA 22314, within this District. The USPTO's mailing address is P.O. Box 1451, Alexandria, VA 22313-1451, also within this District.

### **III. JURISDICTION AND VENUE**

5. This Court has jurisdiction over this Civil Action pursuant to 28 U.S.C. § 1331 (Federal question) and 15 U.S.C. § 1071(b).

6. This Court has venue over this Civil Action pursuant to 28 U.S.C. § 1391(e)(1)(2) in that the Federal agency is located within this District and a substantial part of the events giving rise to the claim occurred in this District.

### **IV. FACTUAL BACKGROUND**

7. On May 29, 2003, GoSMILE filed application Serial No. 76/518,244 (the application) setting forth a bona-fide intent to use the mark "GOSMILE PM" for "toothpaste marketed and sold in high end retail department stores as well as in spas, salons, resorts, doctors' offices, dentists' offices and high end hotels, in International Class 3."

8. In the application as originally filed, GoSMILE identified its prior Registration No. 2,566,285 for "GO SMILE" covering a tooth whitening system comprised of peroxide gels in International Class 3. GoSMILE's Registration No. 2,566,285 was originally filed in the name of "Jonathan Levine" as a sole proprietor. It was assigned to GoSMILE herein in an Assignment dated December 10, 2003, and recorded in the records of the USPTO at Reel 002892, beginning at Frame 0509, on December 16, 2003.

9. During the course of the prosecution of the application, the only Amendment that was entered was a disclaimer of "PM" apart from the mark as shown. This disclaimer was

entered in response to the explanation made by the Examining Attorney, in an Office Action mailed November 6, 2003, that "The wording is merely descriptive because it identifies the period of use of the toothpaste - in the evening and afternoon hours or in the PM."

10. On July 23, 2004, the Examining Attorney mailed a Final Refusal alleging that the mark "GOSMILE PM" would create a likelihood of confusion with the mark "P.M." as set forth in U.S. Registration No. 2,574,192.

11. In support of registration of the mark, GoSMILE presented evidence of third party use of "PM" and "P.M." in an effort to demonstrate the relative weakness of those expressions and therefore to support registrability. In its final decision, the TTAB disregarded this evidence.

12. An Oral Hearing before the TTAB was conducted on September 20, 2005. During the course of the Hearing, GoSMILE brought to the attention of the TTAB their own precedential decision in *Knight Textile Corp. v. Jones Investment Co., Inc.*, 75 USPQ 2d 1313 (TTAB 2005). The TTAB's decision in *Knight Textile* was published after all briefing had been concluded before the TTAB. GoSMILE believes the *Knight Textile* case is substantially "on all fours" with the circumstances of GoSMILE's application for registration of the mark. In its final decision, the TTAB did not cite or distinguish its decision from *Knight Textile*. On January 20, 2006, the TTAB rendered its final decision affirming the Examining Attorney's refusal to register the mark.

13. Although the application was filed pursuant to Section 2(b) of the Lanham Act, 15 U.S.C. § 1051(b), based upon a bona-fide intent to use the mark, the mark is now in use in interstate commerce.

**V. SOLE COUNT. INAPPROPRIATE REFUSAL TO REGISTER**

14. In refusing registration, the USPTO failed to fully consider evidence GoSMILE presented during the course of prosecution of the application in support of registration.

15. In refusing registration, the USPTO failed to follow the TTAB's precedential decisions and those of Federal Courts.

16. In support of registration, GoSMILE wishes to present to this Court additional documentary and testimony-based evidence.

WHEREFORE, GoSMILE prays that this Court will:

(1) consider the evidence GoSMILE presented during the course of the prosecution of the application before the USPTO;

(2) consider additional evidence GoSMILE shall present herein; and

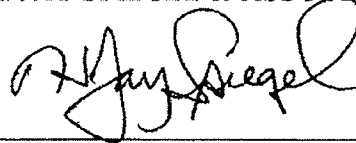
(3) take into account Federal Court and TTAB precedents, and, in light thereof:

(4) enter an Order reversing the decision of the TTAB and directing the USPTO to publish the application for opposition in accordance with the rules and regulations of the USPTO.

(5) GoSMILE requests that the Court grant such other relief as the Court deems just and appropriate.

Respectfully submitted,

H. JAY SPIEGEL & ASSOCIATES



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VA State Bar No. 20647

Counsel to Plaintiff

GoSMILE, Inc.

### CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

<p><b>I. (a) PLAINTIFFS</b>      GosMILE, Inc., a Corporation of Delaware</p> <p><b>(b)</b> County of Residence of First Listed Plaintiff      <u>New York</u> (EXCEPT IN U.S. PLAINTIFF CASES)</p> <p><b>(c)</b> Attorney's (Firm Name, Address, and Telephone Number)      H. Jay Spiegel &amp; Associates, P.O. Box 11, Mount Vernon, VA 22121 (703) 619-0101</p>	<p><b>DEFENDANTS</b>      Jon W. Dudas, Under Secretary of Commerce for Intellectual Property and Director of the U.S. Patent and Trademark Office</p> <p>County of Residence of First Listed Defendant _____ (IN U.S. PLAINTIFF CASES ONLY)</p> <p>NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.</p> <p>Attorneys (If Known) _____</p>
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<p><b>II. BASIS OF JURISDICTION</b> (Place an "X" in One Box Only)</p> <p><input type="checkbox"/> 1 U.S. Government Plaintiff      <input type="checkbox"/> 3 Federal Question (U.S. Government Not a Party)</p> <p><input checked="" type="checkbox"/> 2 U.S. Government Defendant      <input type="checkbox"/> 4 Diversity (Indicate Citizenship of Parties in Item III)</p>	<p><b>III. CITIZENSHIP OF PRINCIPAL PARTIES</b>(Place an "X" in One Box for Plaintiff and One Box for Defendant)</p> <table border="1" style="width:100%; border-collapse: collapse;"> <tr> <th colspan="2"></th> <th>PTF</th> <th>DEF</th> <th colspan="2"></th> <th>PTF</th> <th>DEF</th> </tr> <tr> <td rowspan="2">Citizen of This State</td> <td><input type="checkbox"/> 1</td> <td><input type="checkbox"/> 1</td> <td>Incorporated or Principal Place of Business In This State</td> <td><input type="checkbox"/> 4</td> <td><input type="checkbox"/> 4</td> <td></td> <td></td> </tr> <tr> <td><input type="checkbox"/> 2</td> <td><input type="checkbox"/> 2</td> <td>Incorporated and Principal Place of Business In Another State</td> <td><input type="checkbox"/> 5</td> <td><input type="checkbox"/> 5</td> <td></td> <td></td> </tr> <tr> <td>Citizen or Subject of a Foreign Country</td> <td><input type="checkbox"/> 3</td> <td><input type="checkbox"/> 3</td> <td>Foreign Nation</td> <td><input type="checkbox"/> 6</td> <td><input type="checkbox"/> 6</td> <td></td> <td></td> </tr> </table>			PTF	DEF			PTF	DEF	Citizen of This State	<input type="checkbox"/> 1	<input type="checkbox"/> 1	Incorporated or Principal Place of Business In This State	<input type="checkbox"/> 4	<input type="checkbox"/> 4			<input type="checkbox"/> 2	<input type="checkbox"/> 2	Incorporated and Principal Place of Business In Another State	<input type="checkbox"/> 5	<input type="checkbox"/> 5			Citizen or Subject of a Foreign Country	<input type="checkbox"/> 3	<input type="checkbox"/> 3	Foreign Nation	<input type="checkbox"/> 6	<input type="checkbox"/> 6		
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**IV. NATURE OF SUIT** (Place an "X" in One Box Only)

CONTRACT	TORTS	FORECLOSURE/PENALTY	BANKRUPTCY	OTHER STATUTES	
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	<p><b>PERSONAL INJURY</b></p> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	<p><b>PERSONAL INJURY</b></p> <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability <p><b>PERSONAL PROPERTY</b></p> <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability <input type="checkbox"/> 510 Motions to Vacate Sentence <p><b>Habeas Corpus:</b></p> <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <p><b>PROPERTY RIGHTS</b></p> <input type="checkbox"/> 820 Copyrights <input type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark <p><b>SOCIAL SECURITY</b></p> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) <p><b>FEDERAL TAX SUITS</b></p> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 830 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes

**V. ORIGIN** (Place an "X" in One Box Only)

1 Original Proceeding       2 Removed from State Court       3 Remanded from Appellate Court       4 Reinstated or Reopened       5 Transferred from another district (specify)       6 Multidistrict Litigation       7 Appeal to District Judge from Magistrate Judgment

**VI. CAUSE OF ACTION**

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):  
15 U.S.C. 1071

Brief description of cause:  
Review of Final Decision of USPIO TIBAB Refusing Registration of Trademark

**VII. REQUESTED IN COMPLAINT:**

CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23      DEMAND \$ \_\_\_\_\_      CHECK YES only if demanded in complaint:  
 JURY DEMAND:       Yes       No

**VIII. RELATED CASE(S) IF ANY**      N/A      (See instructions):      JUDGE \_\_\_\_\_      DOCKET NUMBER \_\_\_\_\_

DATE      MARCH 17, 2006      SIGNATURE OF ATTORNEY OF RECORD      *H. Jay Spiegel*      EDVA No. 10419

FOR OFFICE USE ONLY

RECEIPT # \_\_\_\_\_ AMOUNT \_\_\_\_\_ APPLYING IFP \_\_\_\_\_ JUDGE \_\_\_\_\_ MAG. JUDGE \_\_\_\_\_