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

In the matter of  
Trademark Application Serial No. 76/503,229  
Published: November 11, 2003  
Mark: ELANE



05-10-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Elance, Inc.

Opposer,

vs.

Manheim Auctions, Inc.,

Applicant.

Opposition No. \_\_\_\_\_

Express Mail mailing label No. <u>EV 381623222 US</u>
Date of Deposit <u>May 10, 2004</u>
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Trademarks, 2900 Crystal Dr., Arlington, VA 22202-3514.
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NOTICE OF OPPOSITION

Opposer, Elance, Inc., a Delaware corporation having its principal place of business at 820A Kifer Road, Sunnyvale, California 94086, believes it will be damaged by registration of the mark shown in Application Serial Number 76/503,229, and hereby opposes that application, alleging as grounds for its opposition that:

1. As is evidenced by the publication of the ELANE service mark application in the Official Gazette on page TM 417 of the November 11, 2003 issue, Applicant Manheim Auctions, Inc. seeks to register the mark ELANE as a service mark in International Class 35 for "online auction services in which users participate in a live auto auction on a real-time basis remotely via a global computer network." Applicant's application for the mark ELANE was filed on April 1, 2003, claiming first use dates of August 13, 2002.

2. Opposer Elance, Inc. is the owner of the following U.S. Trademark registration:

<u>Mark</u>	<u>Reg. No.</u>	<u>Reg. Date</u>	<u>Class: Goods/Services</u>
ELANCE	2,772,962	October 14, 2003	Class 35: Business services, namely, providing an online marketplace for buyers and sellers of goods and/or services on a global computer network; advertising the goods and services of others via a web site on a global computer network; providing business consultation and business information, namely, tracking, analyzing and generating reports for others regarding the operation, use and users of an online marketplace; providing business information, namely, providing an online two-way system for users of an online marketplace to evaluate and provide feedback regarding parties they have interacted with via the online marketplace; invoicing.

Class 36: Providing bill payment and tracking services.

Class 38: Telecommunications services, namely, providing online chat, online bulletin boards and online message boards featuring topics of general interest in the field of business and the rendering

of professional services; network conferencing services provided on a website on a global computer network to enable buyers and sellers of professional services to negotiate and collaborate on business projects from any location.

Class 42: Computer services, namely, digital content protection; hosting web sites for others; providing an online calendar; providing temporary use of online non-downloadable software used to define the scope of, schedule, track and fulfill professional service projects, and to identify, source, negotiate and collaborate with, evaluate and provide feedback on vendors of professional services projects.

The September 1999 date of first use and first use in commerce of the above-referenced ELANCE service mark is prior to the filing date of Applicant's use-based application for the ELANE mark, and prior to Applicant's claimed date of first use and first use in commerce of the ELANE mark. This Registration of Opposer is valid and subsisting and is prima facie evidence of Opposer's exclusive right to use the mark in commerce in connection with the services specified in said Registration. In view of the similarity of the respective marks and the related nature of the services of the respective parties, Applicant's service mark so resembles Opposer's registered service mark as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

3. Opposer Elance, Inc. is also the owner of the following U.S.

Trademark application:

<u>Mark</u>	<u>Serial No.</u>	<u>App. Date</u>	<u>Class: Goods/Services</u>
ELANCE	76/200,300	January 26, 2001	Class 9: Computer software, namely, software to identify and define the scope

and components of projects; project management software.

Class 35: Accounting services and automated billing services; business consultation services provided via the internet, namely, identifying, monitoring the performance of, reporting on, and managing projects and project vendors, and acting as an intermediary for businesses to locate service providers, receive and evaluate bids through online bidding comparison functionality, notify selected providers and communicate project requirements via an internet website.

Class 36: Electronic payment, namely, electronic processing and transmission of bill payment data; providing accounts, generating invoices and arranging for the payment of third party invoices via electronic means; financial analysis; and providing financial information, namely, generating financial reports.

Class 42: Computer consultation services in the field of identifying and defining the scope and components of projects and project management; Internet related services, namely, identifying, contracting with, monitoring the performance of, reporting on, and managing projects and project vendors; computer services, namely, integration of accounting, invoicing, payment and reporting into electronic revenue payment systems.

This application for the ELANCE mark was filed based on Opposer's intent to use the mark in commerce, and was filed prior to both the filing date of Applicant's application for the ELANE mark, and the August 13, 2002 date of first use and first use in

commerce claimed by Applicant in the ELANE application. Opposer's application for the ELANCE mark is valid and subsisting and is evidence of Opposer's intent to use said mark in commerce on or in connection with the goods and services specified in said application. In view of the similarity of the respective marks and the related nature of the goods and services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's ELANCE trademark and service mark as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

4. Prior to both the date of filing of Applicant's application for the ELANE mark, and the August 13, 2002 date of first use and first use in commerce claimed by Applicant in the ELANE application, Opposer, Elance, Inc., adopted and began using, has been using, and is now using the ELANCE trade name and service mark in commerce in connection with the type of services described in Opposer's ELANCE registration. Said trade name and service mark use has been valid and continuous since the date of first use and has not been abandoned. The ELANCE trade name and service mark is symbolic of extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising and promotion.

5. In view of the similarity of the respective marks and the related nature of the services of the respective parties, it is alleged that Applicant's mark so resembles Opposer's ELANCE trade name and service mark previously used in the United States, and not abandoned, as to be likely to cause confusion or to cause mistake or to deceive, thereby causing loss, damage and injury to Opposer and the purchasing public.

WHEREFORE, Opposer prays that this Notice of Opposition be sustained, that Applicant's Trademark Application Serial No. 76/503,229 be rejected, and that

- Applicant be denied registration of ELANE as a service mark for the services specified in that application.

This Notice of Opposition is being submitted along with the requisite \$300.00 fee. Please charge any additional fees required to our Deposit Account No. 50-0261.

Respectfully submitted,

Date: May 10, 2004

By:   
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