

ESTTA Tracking number: **ESTTA253145**

Filing date: **12/04/2008**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	United Business Media LLC		
Entity	limited liability company	Citizenship	Delaware
Address	600 Community Drive 4th Floor Manhasset, NY 11030 UNITED STATES		

Attorney information	Susan L. Heller Greenberg Traurig, LLP 2450 Colorado Ave., Suite 400E Santa Monica, CA 90404 UNITED STATES latm2@gtlaw.com Phone:3105866568		
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**Applicant Information**

Application No	77519449	Publication date	11/04/2008
Opposition Filing Date	12/04/2008	Opposition Period Ends	12/04/2008
Applicant	National Rural Electric Cooperative Association 4301 Wilson Boulevard Arlington, VA 22203 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 042. First Use: 1997/03/31 First Use In Commerce: 1997/03/31 All goods and services in the class are opposed, namely: Providing scientific research and related technical information in the field of electrical cooperatives
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	2726321	Application Date	08/18/2000
Registration Date	06/17/2003	Foreign Priority Date	NONE
Word Mark	CRN		

Design Mark	<b>CRN</b>
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1989/06/00 First Use In Commerce: 1989/06/00 PUBLICATIONS, NAMELY, MAGAZINES IN THE FIELD OF COMPUTERS, COMPUTER RELATED PRODUCTS AND HIGH TECHNOLOGY Class 042. First use: First Use: 1994/11/00 First Use In Commerce: 1994/11/00 ONLINE SERVICES, NAMELY, PROVIDING AN INTERNET WEBSITE FEATURING INFORMATION ON COMPUTERS, COMPUTER RELATED PRODUCTS AND HIGH TECHNOLOGY

U.S. Registration No.	3464639	Application Date	07/20/2006
Registration Date	07/08/2008	Foreign Priority Date	NONE

Word Mark	CRN TECH
Design Mark	<b>CRN Tech</b>
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 2007/01/29 First Use In Commerce: 2007/01/29 Publications, namely, magazines and newsletters in the field of computers computer related products and high technology Class 042. First use: First Use: 2007/01/29 First Use In Commerce: 2007/01/29 Online services, namely, providing an internet website featuring information on computers computer related products and high technology

U.S. Registration No.	2750653	Application Date	10/09/1998
Registration Date	08/12/2003	Foreign Priority Date	NONE
Word Mark	CRN ENTERPRISE PARTNER		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1999/02/22 First Use In Commerce: 1999/02/22 Publications, namely, newspapers and magazines in the field of computers, computer related products and high technology

U.S. Registration No.	2016983	Application Date	04/13/1995
Registration Date	11/19/1996	Foreign Priority Date	NONE

Word Mark	CRN TEST CENTER
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 042. First use: First Use: 1994/05/23 First Use In Commerce: 1994/05/23 providing third-party laboratory testing services for others in the field of computer products and computer-related products
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Attachments	76112097#TMSN.gif ( 1 page )( bytes ) 78980238#TMSN.jpeg ( 1 page )( bytes ) crn_42.pdf ( 8 pages )(271345 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/slh/gl/
Name	Susan L. Heller
Date	12/04/2008



The grounds for opposition are as follows:

1. UBM owns both common law rights and federal registrations for the mark CRN in connection with a wide variety of goods and services, including print publications, newspapers and magazines, providing online services, providing an internet website, and providing third-party laboratory testing services, among others.

2. UBM owns the mark and the federal registration for CRN which is identical to the word mark being opposed.

In addition, UBM owns three (3) additional marks and federal registrations which feature the mark CRN as its key component, namely, CRN TECH, CRN TEST CENTER, CRN ENTERPRISE PARTNER. The additional terms in these three (3) registrations, namely, “tech,” “test center” and “enterprise partner” are descriptive, and therefore, have been disclaimed in the registrations.

Together, these four (4) marks comprise the family of CRN marks owned by UBM (herein collectively, the “CRN Marks”):

TRADEMARK	CLASS: GOODS / SERVICES	APP NO.	REG NO.	STATUS
		APP DATE.	REG DATE.	
CRN	16: Publications, namely, magazines in the field of computers, computer related products and high technology  42: Online services, namely, providing an internet website featuring information on computers, computer related products and high technology	76112097  18-Aug-00	2726321  17-Jun-03	REGISTERED
CRN TECH	16: Publications, namely, magazines and newsletters in the field of computers computer related products and high technology  42: Online services, namely, providing an internet website featuring information on computers computer related products and high technology	78980238  20-Jul-06	3464639  8-Jul-07	REGISTERED
CRN ENTERPRISE PARTNER	16: Publications, namely, newspapers and magazines in the field of computers, computer related products and high technology	75568318  9-Oct-98	2750653  12-Aug-03	REGISTERED
CRN TEST CENTER	42: Providing third-party laboratory testing services for others in the field of computer products and computer-related products	74661225  13-Apr-95	2016983  19-Nov-96	REGISTERED

3. UBM (through its predecessor in interest) first used the CRN mark in 1989 in commerce in connection with print publications, magazines and related goods, and first used the mark in 1994 in connection with the offering of online services, namely, an internet website featuring information on computers, computer related products and high technology, and has continuously used the mark in commerce in connection with these goods and services since these dates.

UBM (through its predecessor in interest) first used the CRN TEST CENTER mark in 1994 in commerce in connection with providing third-party laboratory testing services and related goods and services, and has continuously used the mark in commerce since that date.

UBM (through its predecessor in interest) first used the CRN ENTERPRISE PARTNER mark in 1999 in commerce in connection with publications, namely, newspapers and magazines

in the field of computers, computer related products and high technology, and has continuously used the mark in commerce since that date.

UBM (through its predecessor in interest) first used the CRN TECH mark in 2007 in commerce in connection with publications, namely, magazines and newsletters in the field of computers, computer related products and high technology, as well as online services, namely, providing an internet website featuring information on computers, computer related products and high technology, and has continuously used the mark in commerce since that date.

4. UBM and its predecessors in interest have published publications under the CRN mark for over 19 years. Currently, total readership for the print publications under the CRN mark exceeds 540,000 consumers, and the publications have a qualified circulation of 115,000 consumers. Moreover, in 2007, UBM's print magazine *CRN* was named a Media Power 50 publication by *BtoB Magazine*, putting *CRN* in the company of *The Wall Street Journal*, *The New York Times*, and NBC's Meet The Press. UBM's annual sales under the CRN Marks exceeds \$21 million per year, with nearly \$14 million in revenue per year generated by the CRN online services alone.

UBM is also the owner of the domain name registration for CRN.com, a "top 5,000" website based on web traffic that attracts more than 1.2 million visitors and more than 2.2 million page views per month. From the U.S. alone, more than 900,000 consumers visit UBM's website CRN.com and generate nearly 1.8 million page views per month.

As a result of UBM's extensive use of the CRN Marks, the CRN Marks are closely associated with UBM's long-standing reputation for quality and excellence in the print publications, online publications, online services, and laboratory testing industries. As such, the purchasing public has come to know, rely upon, and recognize the goods and services of UBM by such marks. Through many years of use and the expenditure of significant sums and effort,

the distinctive CRN Marks have also achieved fame and worldwide recognition and now represent enormous value and goodwill.

5. UBM also owns many registrations throughout the world for the mark CRN.

6. UBM has provided goods and services under the CRN Marks throughout the United States through numerous channels of trade, including significant use on the Internet. In addition, UBM has devoted substantial advertising dollars to promote its goods and services under the CRN Marks and foster wide recognition of the marks by consumers. As a result of these efforts, as well as the inherent and acquired distinctiveness of the marks, the CRN Marks have become well-known and famous, and are therefore entitled to a broad scope of protection.

7. The public associates the CRN Marks with UBM's goods and services. The CRN Marks therefore function as source indicators for UBM's goods and services, and as such, they are the exclusive property right of UBM.

8. Trademark Application Serial No. 77/519,449, sought to be opposed, is for the identical mark CRN ("Applicant's Mark") for use in connection with closely related services, namely: "Providing scientific research and related technical information in the field of electrical cooperatives" in International Class 42.

9. The instant application was filed by Applicant on July 10, 2008, and lists a first use in commerce date of March 31, 1997.

10. The instant application was published for opposition on November 4, 2008. The deadline to file an opposition is Thursday, December 4, 2008. Accordingly, Applicant has timely filed this Notice of Opposition.

11. The instant application was filed without UBM's authorization, consent, or prior knowledge.

12. UBM's first use of its mark CRN in 1989 far predates Applicant's declaration of its first use of the identical mark CRN in 1997.

13. Applicant's Mark is identical to UBM's registered mark for CRN. Applicant's Mark is also the major feature and central component for UBM's registrations for the marks CRN TECH, CRN ENTERPRISE PARTNER and CRN TEST CENTER.

The goods and services for both parties are closely related. Therefore, Applicant's Mark is likely to cause confusion with UBM's marks CRN, CRN TECH, CRN ENTERPRISE PARTNER and CRN TEST CENTER.

14. Both parties' goods and services include and/or are related to publications and online services industries, and are offered to consumers through overlapping channels of trade.

15. Because the marks are identical and/or are overlapping and are used in connection with closely related goods, registration and concurrent use of Applicant's Mark is likely to cause, confusion, mistake and/or deception among the consuming public regarding the source, affiliation and/or sponsorship between UBM and its goods and services, and Applicant and its services. Furthermore, consumers familiar with UBM's CRN Marks would be likely to consider the services of Applicant offered under Applicant's Mark as emanating from or sponsored by UBM, and to purchase or use such services as those of UBM, resulting in injury to UBM. Any such confusion would inevitably result in lost business to UBM.

16. Additionally, because of the fame acquired by UBM's CRN Marks, registration of Applicant's Mark will cause dilution.

17. The registration of Applicant's Mark for the services identified would be inconsistent with UBM's rights in its CRN Marks, and will cause damage to UBM and UBM's rights in its CRN Marks.

18. By virtue of the foregoing, Applicant's application should be rejected, and registration of Applicant's mark should be denied and refused.

Submitted herewith is the amount of \$300 representing the required filing fee paid by deposit account. Authorization is hereby provided to charge any deficiency to Deposit Account 50-2638.

Respectfully submitted,

GREENBERG TRAUERIG, LLP

Dated: December 4, 2008

By: \_\_\_\_\_



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Attorneys for United Business Media LLC

**CERTIFICATE OF SERVICE**

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Mail, first-class postage prepaid, on December 4, 2008, addressed as follows:

Elizabeth C. Buckingham  
Dorsey & Whitney LLP  
50 South Sixth Street  
Suite 1500  
Minneapolis, MN 55402-1498

  
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Grace Linker  
Sr. Trademark Paralegal