

ESTTA Tracking number: **ESTTA329091**

Filing date: **01/27/2010**

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	SmartMoney
Granted to Date of previous extension	01/27/2010
Address	1755 Broadway New York, NY 10019 UNITED STATES

Attorney information	Bridgette Fitzpatrick, Esq. The Hearst Corporation 300 W. 57th Street - 40th floor Office of General Counsel New York, NY 10019 UNITED STATES bfitzpatrick@hearst.com, sfavitta@hearst.com Phone:212-649-2059
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Applicant Information

Application No	77739666	Publication date	09/29/2009
Opposition Filing Date	01/27/2010	Opposition Period Ends	01/27/2010
Applicant	Longshore Asset Management, LLC 2029 Century Park East, Suite 1400 Los Angeles, CA 90067 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 036. First Use: 2009/04/20 First Use In Commerce: 2009/04/20 All goods and services in the class are opposed, namely: Advice relating to investments; Brokerage services for capital investments; Capital investment consultation; Capital investment services; Equity capital investment; Financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; Financial investment in the field of Real Estate; Financial investment services, namely, administering the issuance, underwriting and distribution of securities; Financial planning and investment advisory services; Financial services in the nature of an investment security; Financial services, namely, a total portfolio offering for high net worth clients consisting of both separate accounts and mutual funds for equity and fixed income investments; Financial services, namely, administration of transactions involving funds drawn from securities, stocks, funds, equities, bonds, cash, or other types of financial investments in retirement plans using a check or negotiable order of withdrawal over a global data network; Financial services, namely, administration of transactions involving funds drawn from securities, stocks, funds, equities, bonds, cash, or other types of financial investments in retirement plans using a credit or debit card over a global data network</p>
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
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.	1419142	Application Date	06/06/1983
Registration Date	12/02/1986	Foreign Priority Date	NONE
Word Mark	SMARTMONEY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1983/03/22 First Use In Commerce: 1983/03/22 Magazine Dealing with Financial Investments and Related Issues		

U.S. Registration No.	1730322	Application Date	01/28/1991
Registration Date	11/03/1992	Foreign Priority Date	NONE
Word Mark	SMARTMONEY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1992/03/02 First Use In Commerce: 1992/03/02 magazine dealing with business and financial matters		

U.S. Registration No.	2177037	Application Date	08/05/1994
Registration Date	07/28/1998	Foreign Priority Date	NONE
Word Mark	SMARTMONEY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/09/01 First Use In Commerce: 1997/09/01 providing access to an interactive computer data base in the field of investment, business and financial news and information for the adult investor; providing access to computer bulletin boards and electronic bulletin boards in the field of investment, business and financial news and information for the adult investor		

U.S. Registration No.	2559094	Application Date	10/09/1997
Registration Date	04/09/2002	Foreign Priority Date	NONE
Word Mark	SMARTMONEY		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 041. First use: First Use: 2001/08/10 First Use In Commerce: 2001/08/10 Television broadcasting services

U.S. Registration No.	3383644	Application Date	01/27/2000
Registration Date	02/19/2008	Foreign Priority Date	NONE

Word Mark	SMARTMONEY
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 009. First use: First Use: 2000/01/25 First Use In Commerce: 2000/01/25 COMPUTER SOFTWARE FOR PROVIDING INVESTMENT, BUSINESS AND FINANCIAL NEWS AND INFORMATION VIA THE GLOBAL COMPUTER NETWORK, VIA LOCAL COMPUTER NETWORKS, AND FOR USE ON PERSONAL COMPUTERS, EXCLUDING PROGRAMS DESIGNED FOR ACADEMIC USE FOR STUDENTS
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U.S. Registration No.	3411400	Application Date	03/12/2007
Registration Date	04/15/2008	Foreign Priority Date	NONE

Word Mark	SMARTMONEY MOBILE
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 038. First use: First Use: 2006/03/01 First Use In Commerce: 2006/03/01 Communications by mobile phones; Electronic data transmission; Wireless communications services, namely, transmission of graphics to mobile telephones
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Attachments	75904311#TMSN.gif (1 page)(bytes) 77128553#TMSN.jpeg (1 page)(bytes) Notice of Opp SuperSmart Money.pdf (10 pages)(778822 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	/Bridgette Fitzpatrick/
Name	Bridgette Fitzpatrick, Esq.
Date	01/27/2010

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

SMARTMONEY)	
)	In re Serial No. 77/739,666
Opposer,)	
)	
v.)	Mark: SUPERSMART MONEY
)	
Longshore Asset Management, LLC.)	Opposition No. _____
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22314

Commissioner:

Opposer **SmartMoney**, a New York partnership, the general partners of which are Hearst SM Partnership and Dow Jones & Company, Inc. and which is located at 1755 Broadway, New York, NY 10019, will be damaged by registration of the mark underlying application Serial No. 77/739,666 and therefore opposes that application under 15 U.S.C. § 1063 and 37 C.F.R. §§ 2.101 and 2.104(a). The grounds for the opposition are as follows:

1. Applicant Longshort Asset Management, LLC (“Applicant”) has filed an application to register the mark **SuperSmart Money** in Class 36 for “Advice relating to investments; brokerage services for capital investments; capital investment consultation; capital investment services; equity capital investment; financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; financial investment in the field of real

estate; financial investment services, namely, administering the issuance, underwriting and distribution of securities; financial planning and investment advisory services; financial services in the nature of an investment security; financial services, namely, a total portfolio offering for high net worth clients consisting of both separate accounts and mutual funds for equity and fixed income investments; financial services, namely, administration of transactions involving funds drawn from securities, stocks, funds, equities, bonds, cash, or other types of financial investments in retirement plans using a check or negotiable order of withdrawal over a global data network; financial services, namely, administration of transactions involving funds drawn from securities, stocks, funds, equities, bonds, cash, or other types of financial investments in retirement plans using a credit or debit card over a global data network”. The application claims a date of first use in commerce of April 20, 2009. Applicant’s application was published for opposition in the *Official Gazette* on September 29, 2009. Opposer requested and received an extension of time in which to oppose the application.

2. Beginning more than (26) twenty-six years ago, through its predecessors in interest, Opposer has used in commerce throughout the United States its **SmartMoney** mark in connection with a business and financial magazine, which is also called “the Wall Street Journal Magazine”, since at least as early as March 22, 1983 and has a monthly paid circulation of over 800,000. Opposer’s **SmartMoney** mark is subject to Registration No. 1,419,142 for a “magazine dealing with financial investments and related issues” in Class 16, this registration is incontestable; and Registration No. 1,730,322 for a “magazine dealing with business and financial matters” in Class 16, this registration is incontestable.

3. Opposer has expanded the means by which it provides information in the fields of investment, business, and finance, and now offers that information and provides related services via electronic means, including via interactive computer databases, broadcasting and through the internet. Opposer has also continuously operated its website www.smartmoney.com since 1997. Opposer's **SmartMoney** mark is subject to Registration No. 2,177,037 for "providing access to an interactive computer database in the field of investment, business and financial news and information for the adult investor" in Class 42, this registration is incontestable; Registration No. 2,559,094 for "television broadcasting services" in Class 41, this registration is incontestable; Registration No. 3,383,644 for "computer software for providing investment, business and financial news and information via the global computer network, via local computer networks, and for use on personal computers, excluding programs designed for academic use for students" in Class 9; and Opposer also holds a Registration for the mark **SmartMoney Mobile**, Registration No. 3,411,400 for "communications by mobile phones; electronic data transmission, wireless communications services, namely, transmission of graphics to mobile telephones" in Class 38.

4. Opposer's **SmartMoney** magazine and its website www.smartmoney.com have won three National Magazine Awards and **SmartMoney.com** has also been named Best Overall Personal Finance Site two years in a row from *Yahoo! Internet Life*, and consistently been named a "Best of The Web" from *Forbes.com Magazine*. Since 1997, **SmartMoney.com** has delivered breaking market news, commentary and analysis, in addition to over 95 financial planning worksheets and calculators, an interactive stock profile tool, portfolio management system and its Map of the Market, which allows users to visualize the market in a single view, which has

earned **SmartMoney.com** continued critical acclaim from both the financial and Web development industries.

5. As a result of widespread advertising and promotion by Opposer and its predecessors in interest, the **SmartMoney** mark has acquired a high degree of recognition, fame, and distinctiveness as a symbol of the high quality financial, investment, and business information goods and services offered by Opposer prior to the filing date of Applicant's application. The public and the trade are familiar with and identify the **SmartMoney** mark exclusively with Opposer, and goods and services associated with the mark therefore are understood by the public and the trade to be produced, marketed, and supplied by the Opposer.

6. Opposer's **SmartMoney** mark serves as an inherently distinctive indicator of the origin of the investment, business, and financial information goods and services offered by the **SmartMoney** brand.

7. Opposer's **SmartMoney** mark is an important factor employed by the public and the trade in identifying the source of Opposer's goods and services and is distinctive of those goods and services.

8. On May 18, 2009, Applicant applied to register the mark **SuperSmart Money** on the Principal Register. This application was assigned Serial No. 77/739,666.

9. The opposed application prominently includes the words "SMART" and "MONEY", this wording is virtually identical to Opposer's **SmartMoney** mark, and it is undeniable that the mark in its entirety is very similar. The additional word "SUPER" placed in front of "SMART" does not distinguish Applicant's use of **Smart Money** from Opposer's **SmartMoney** mark. Moreover, the Applicant's uses its mark in the identical stylized way as

Opposer uses its **SmartMoney** mark (see the attachments of Applicant's specimen of use and Opposer's mark for comparison). The marks therefore are similar in appearance and commercial impression, particularly as they are used in connection with the parties' closely related goods and services, which, on information and belief, will be marketed to the same consumers.

10. The relevant public and trade are likely to be confused and will believe mistakenly that the financial, investment and business services offered or to be offered under the **SuperSmart Money** mark emanates from Opposer's **SmartMoney** mark, or are authorized, licensed, endorsed, or sponsored by Opposer. Registration of Applicant's mark thus would be inconsistent with Opposer's prior rights in its well-known **SmartMoney** mark.

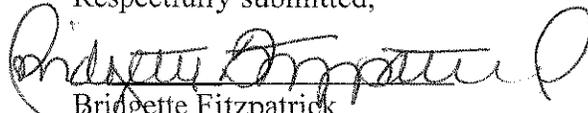
11. Opposer will be damaged by the registration of the **SuperSmart Money** mark because the mark so resembles Opposer's previously used, federally registered, and well-known **SmartMoney** mark as to be likely, when used in connection with the services identified in application Serial No. 77/739,666, to cause confusion, or to cause mistake, or to deceive, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

12. Opposer will additionally be damaged by registration of Applicant's **SuperSmart Money** mark because the mark diluted and is likely to dilute the distinctiveness of Opposer's famous **SmartMoney** mark by eroding consumers' exclusive identification of that mark with Opposer, and/or by tarnishing and degrading the positive association and prestigious connotations of the famous **SmartMoney** mark, and/or by otherwise lessening the capacity of Opposer's **SmartMoney** mark to identify and distinguish the goods and services of Opposer.

13. Opposer therefore requests that application Serial No. 77/739,666 be refused, and this Opposition be sustained in favor of Opposer.

This 27th day of January, 2010.

Respectfully submitted,


Bridgette Fitzpatrick

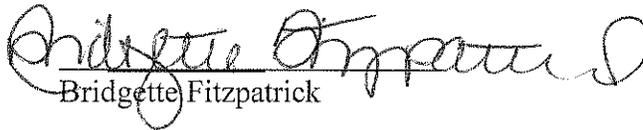
HEARST COMMUNICATIONS, INC.
300 West 57th Street
New York NY 10019
Bfitzpatrick@hearst.com
(212) 649-2059 (telephone)
(646) 280-2059 (facsimile)
Attorney for Opposer

CERTIFICATE OF SERVICE

This is to certify that the attached Notice of Opposition has been served upon Applicant's filing correspondent by depositing a copy in the United States mail as first class mail, postage pre-paid, addressed as follows:

Anthony DiPietra, Esq.
Ingber & Associates, P.L.C.
2029 Century Park, E. Ste 1400
LA, CA 90067-2915

This 27th day of January, 2010

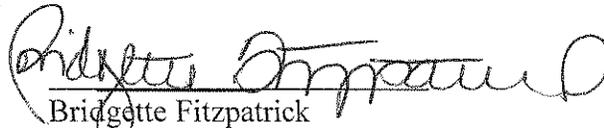

Bridgette Fitzpatrick

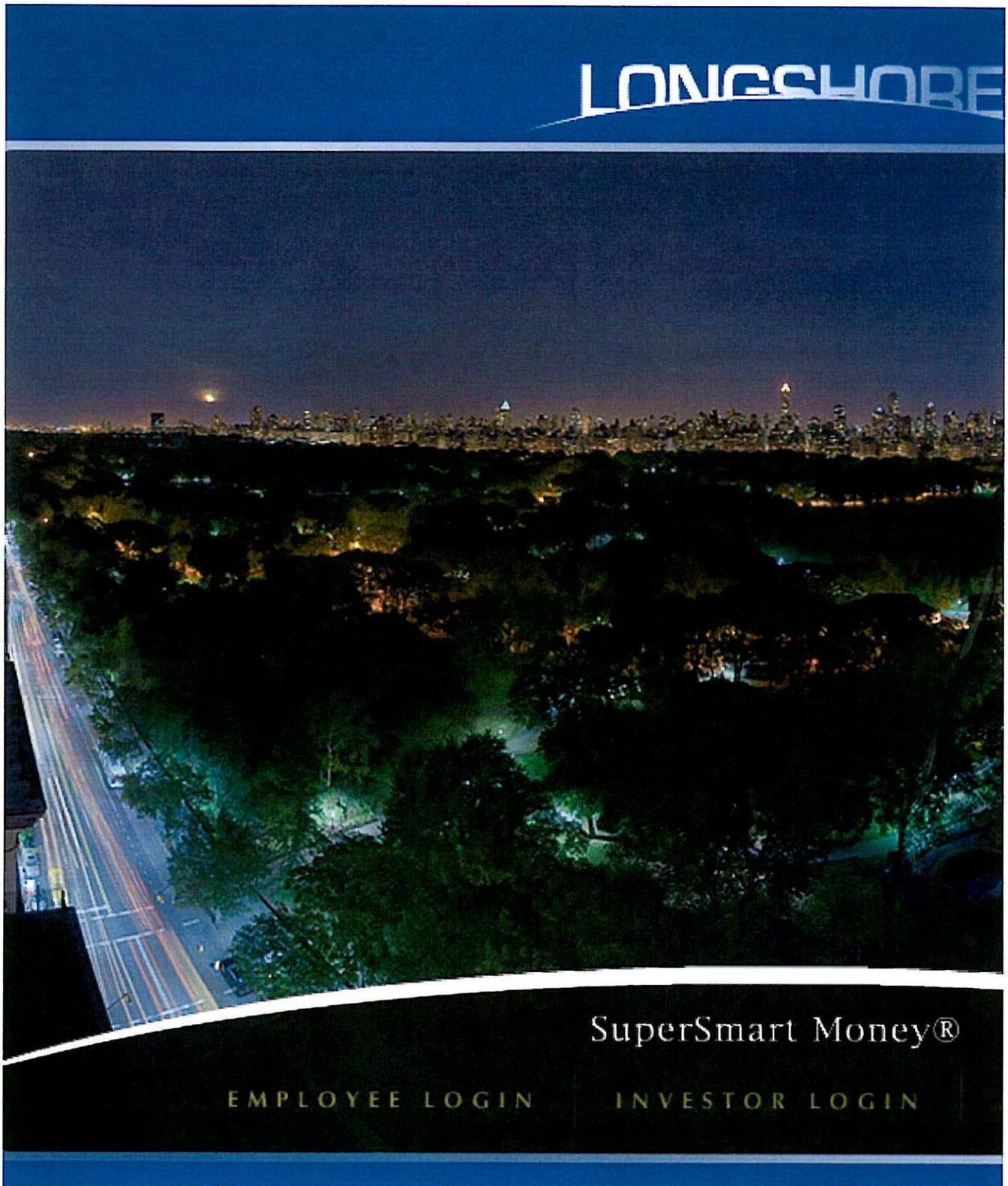
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Ingber & Associates, P.L.C.
2029 Century Park, E. Ste 1400
Los Angeles, CA 90067-2915

This 27th day of January, 2010


Bridgette Fitzpatrick



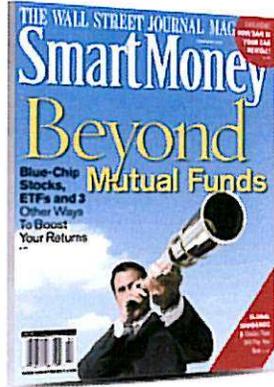
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