

ESTTA Tracking number: **ESTTA373519**

Filing date: **10/15/2010**

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	Critical Path, Inc.
Granted to Date of previous extension	10/17/2010
Address	PO Box 853 Selah, WA 98942 UNITED STATES

Attorney information	Patrick H. Ballew Ballew Law PO Box 428 Yakima, WA 98907 UNITED STATES amatt@ballewlaw.us Phone:509-453-1319
----------------------	---

Applicant Information

Application No	77859527	Publication date	04/20/2010
Opposition Filing Date	10/15/2010	Opposition Period Ends	10/17/2010
Applicant	Critical Path Training, LLC 13820 Old St. Augustine Rd. Ste 113-312 Jacksonville, FL 32258 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2008/11/01 First Use In Commerce: 2009/05/01 All goods and services in the class are opposed, namely: Business training; Education services, namely, conducting software training courses and distribution of training materials in connection therewith; educational services, namely, developing curriculum for others in the field of software training

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85073625	Application Date	06/29/2010
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CRITICAL PATH		

Design Mark	CRITICAL PATH
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2007/10/29 First Use In Commerce: 2008/04/28 Professional development services, namely providing continuing education and professional training courses

Attachments	85073625#TMSN.jpeg (1 page)(bytes) CP3.T01OPP_Opposition-10-15-10.pdf (3 pages)(44308 bytes) Exhibit A - Opposition.pdf (4 pages)(53966 bytes)
-------------	--

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	/patrick h ballew/
Name	Patrick H. Ballew
Date	10/15/2010

1
2
3
4
5
6
7
8
9
10
11

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

<p>CRITICAL PATH, INC.</p> <p>Opposer,</p> <p>vs.</p> <p>CRITICAL PATH TRAINING, LLC,</p> <p>Applicant.</p>	<p>In the Matter of Application Serial No: 77/859,527 Published in the <i>Official Gazette</i> On: April 20, 2010 Mark: CRITICAL PATH TRAINING and Design</p> <p>Opposition No.:</p> <p>NOTICE OF OPPOSITION</p>
---	--

12 BOX TTAB FEE
13 Assistant Commissioner for Trademarks
14 PO Box 1451
15 Alexandria, Virginia 22313-1451

16
17
18
19
20
21
22

NOTICE OF OPPOSITION

16 Opposer Critical Path, Inc. a Washington State corporation, having its principal place of
17 business at PO Box 853, Selah, Washington 98942, believes that it will be damaged by
18 registration of the mark CRITICAL PATH TRAINING and Design in International Class 41,
19 Serial No. 77/859,527('527), filed October 28, 2009, by Critical Path Training, LLC
20 ("Applicant"), which was published in the *Official Gazette* on April 20, 2010, and hereby
21 opposes the same.

22 As grounds for this opposition it is alleged that:

23 1. Applicant has filed a trademark application for CRTICAL PATH TRAINING in
24 International Class 41 for "Business training; Education services, namely, conducting software
25 training courses and distribution of training materials in connection therewith; educational
26
27

1 services, namely, developing curriculum for others in the field of software training.” Opposer
2 objects to registration of this mark.

3 2. Opposer has been providing professional development services, namely providing
4 continuing education and professional training courses under the CRITICAL PATH trademark
5 since at least as early as October 29, 2007, and in interstate commerce since at least as early as
6 April 28, 2008, has continuously used the CRITICAL PATH mark since that time, and is
7 presently using the CRITICAL PATH mark.

8 3. On June 29, 2010, Opposer filed Application Serial No. 85/073,625 to register
9 CRITICAL PATH for use with “providing professional development services, namely providing
10 continuing education and professional training courses” in International Class 35 (Opposer’s
11 ‘625 App.).

12 4. Granting the rights of a federal registration to Applicant’s ‘527 application is
13 inimical to the superior rights of the Opposer under the Trademark Act Section 2(d), 15 U.S.C.
14 Section 1052(d), because Opposer has established prior first use (by one year) of the CRITICAL
15 PATH trademark.

16 5. In an office dated October 14, 2010, the Trademark Attorney in charge of
17 Examination of Petitioner's United States trademark application for CRITICAL PATH, issued
18 the following refusal to register:

19
20 The examining attorney refuses registration under Trademark Act
21 Section 2(d), 15 U.S.C. Section 1052(d), because the applicant’s
22 mark, when used on or in connection with the identified services,
23 so resembles the mark in U.S. Application No. 77/859,257 as to be
likely to cause confusion, to cause mistake, or to deceive. TMEP
Section 1207.01.

24 See *Office Action No. 1*, Mailing Date 10/14/10, for Serial No.
25 85/073,625 a copy of which is attached to this Petition as **Exhibit**
26 **A.**
27

To: Critical Path, Inc. (amatt@ballewlaw.us)
Subject: U.S. TRADEMARK APPLICATION NO. 85073625 - CRITICAL PATH - CP3.T01
Sent: 10/14/2010 10:59:28 AM
Sent As: ECOM105@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2
Attachment - 3
Attachment - 4
Attachment - 5
Attachment - 6
Attachment - 7
Attachment - 8
Attachment - 9
Attachment - 10
Attachment - 11
Attachment - 12

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85073625

MARK: CRITICAL PATH

85073625

CORRESPONDENT ADDRESS:

PATRICK H. BALLEW
BALLEW LAW
PO BOX 428
YAKIMA, WA 98907-0428

CLICK HERE TO RESPOND TO THIS LETTER:
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Critical Path, Inc.

CORRESPONDENT'S REFERENCE/DOCKET

NO:

CP3.T01

CORRESPONDENT E-MAIL ADDRESS:

amatt@ballewlaw.us

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 10/14/2010

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

Likelihood of Confusion

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2911295, 2911133, and 3779779. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361-62, 177 USPQ 563, 567 (C.C.P.A. 1973); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1584 (TTAB 2007); *see also In re Dixie Rests. Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997). The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

In this case, the applicant's mark, CRITICAL PATH, is highly similar to the registrants' marks, CRITICAL PATH TRAINING and CRITICAL PATH STRATEGIES. The applicant has merely deleted a term from the registrants' marks. The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Optica Int'l*, 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrants' marks.

Furthermore, the applicant's services are closely related to the registrants' services and goods. The applicant's services are "Professional development services, namely providing continuing education and professional training courses." The '295 and '133 registrant's services and goods are "Educational services, namely, conducting workshops in the field of business planning and account sales methodologies and strategies" and "Printed instructional and teaching materials in the field of business strategy for sales and major account planning." The '779 registrant's services are "Business training; Education services, namely, conducting software training courses and distribution of training materials in connection therewith; educational services, namely, developing curriculum for others in the field of software training." The applicant's identification of services is broad enough to encompass all of the registrants' services.

Because the marks are highly similar and the services are closely related, there is a substantial likelihood that consumers would be confused as to the source of the services.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

Applicant must respond to the requirement(s) set forth below.

Identification of Services

The identification of services is indefinite and must be clarified because the subject matter of continuing education and training course has not been specified. *See* TMEP §1402.01. Applicant may adopt the following identification, if accurate:

Providing continuing business education courses; providing on-line training courses in the field of professional development in Class 41.

If applicant adopts the suggested amendment of the identification of goods and/or services, then applicant must amend the classification to International Class 41. *See* 37 C.F.R. §§2.32(a)(7), 2.85; TMEP §§805, 1401.

An applicant may amend an identification of services only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at <http://tess2.uspto.gov/netathtml/tidm.html>. *See* TMEP §1402.04.

Inquiry on Significance

Applicant must specify whether the wording "CRITICAL PATH" has any significance in the professional development or trade or industry or as applied to the goods/services described in the application. *See* 37 C.F.R. §2.61(b); TMEP §§808.01(a), 814.

The applicant should also note the following potential grounds for refusal.

Prior-Pending Application

The filing date of pending Application Serial No. 77/859527 precedes applicant's filing date. *See* attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Response

If applicant has questions about the application or this Office action, please telephone the assigned trademark examining attorney at the telephone number below.

/Ronald McMorrow/
Examining Attorney
Law Office 105
(571) 272-9306

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.