

ESTTA Tracking number: **ESTTA435957**

Filing date: **10/17/2011**

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	AndrewRothlein
Granted to Date of previous extension	12/14/2011
Address	308 Roaring Brook Road Chappaqua, NY 10514 UNITED STATES

Correspondence information	AndrewRothlein 308 Roaring Brook Road Chappaqua, NY 10514 UNITED STATES pt321211@yahoo.com, PeaTV@AOL.com
----------------------------	---

Applicant Information

Application No	85180453	Publication date	08/16/2011
Opposition Filing Date	10/17/2011	Opposition Period Ends	12/14/2011
Applicant	Independent Television Service, Inc. Suite 410 651 Brannan San Francisco, CA 94107 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2006/09/30 First Use In Commerce: 2006/09/30 All goods and services in the class are opposed, namely: entertainment services, namely, television and motion picture programming on a global computer network; production and distribution of motion pictures and television programs via cable television, a global computer network, internet, wire and wireless networks to public television and non-public television audiences; providing information via the internet in the field of narrative and documentary motion pictures; and entertainment services, namely, providing non-downloadable narrative and documentary motion pictures via a global computer network, internet, wire and wireless networks
--

Applicant Information

Application No	85180355	Publication date	08/23/2011
Opposition Filing Date	10/17/2011	Opposition Period Ends	
Applicant	Independent Television Service, Inc. Suite 410 651 Brannan Street San Francisco, CA 94107 UNITED STATES		

Goods/Services Affected by Opposition

Class 038. First Use: 2006/09/30 First Use In Commerce: 2006/09/30
 All goods and services in the class are opposed, namely: Video streaming services and transmission services of audio visual works via a global computer network, Internet, cable, broadband, copper, and optical and wireless networks; broadcasting transmissions of audio visual works, messages and information via a global computer network, Internet, cable, broadband, copper, optical and wireless networks

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2879305	Application Date	03/30/2003
Registration Date	08/31/2004	Foreign Priority Date	NONE
Word Mark	ITV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2003/03/30 First Use In Commerce: 2003/03/30 Providing information online in the field of current events and entertainment online news reporting presentations News analysis and features distribution via the Internet News agencies, namely, gathering and dissemination of news via the Internet Providing entertainment services, namely, providing information and links to other websites in the fields of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images		

U.S. Application No.	77037086	Application Date	11/05/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ITV		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/03/30 First Use In Commerce: 2003/03/30 Providing entertainment and educational services, namely, providing presentations of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images, and providing factual entertainment or		

	educational information in the fields of current events, music, and sports, and providing news presentations via the Internet or other communications networks
--	--

Attachments	ITVS Opposition 85180453 IC 41 pdf.pdf (3 pages)(347604 bytes) ITVS Opposition 85180355 IC 38 pdf.pdf (3 pages)(347481 bytes) 77037086#TMSN.jpeg (1 page)(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	/Andrew Rothlein/
Name	AndrewRothlein
Date	10/17/2011

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

Andrew Rothlein,
Opposer

v

Serial No. 85180453 (ITVS)

Independent Television Service, Inc.,
Applicant

NOTICE OF OPPOSITION

Andrew Rothlein (hereinafter referred to as Registrant), does hereby tender notice of opposition to registration of the mark, ITVS, Serial No. 85180453 (hereinafter referred to as Applicant's proposed mark) based on the existence of a likeliness of confusion between the Applicant's proposed mark with both the registered mark (2879305, ITV) and the proposed mark (77037086, iTV) of the Registrant and based on the priority of the Registrant's marks in both cases.

The Board will note the similarity of both the marks and the *services in question*. With regard to the similarity in marks (ITVS v ITV/iTV), it is fundamental that the mere addition of a term does not obviate the similarity between the marks nor does it overcome the likeliness of confusion. With regard to services, the likeliness of confusion is clearly observed in the similarity of the service descriptions listed below:

"IC 041. US 100 101 107. G & S: entertainment services, namely, television and motion picture programming on a global computer network; production and distribution of motion pictures and television programs via cable television, a global computer network, internet, wire and wireless networks to public television and non-public television audiences; providing information via the internet in the field of narrative and documentary motion pictures; and entertainment services, namely, providing non-downloadable narrative and documentary motion pictures via a global computer network, internet, wire and wireless networks." (Applicant's proposed mark)

"IC 042. US 100 101. G & S: Providing information online in the field of current events and entertainment online news reporting presentations News analysis and features distribution via the Internet News agencies, namely, gathering and dissemination of news via the Internet Providing entertainment services, namely, providing information and links to other websites in the fields of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images." (Registrant's mark, ITV, 2879305)

"IC 041. US 100 101 107. G & S: Providing entertainment and educational services, namely, providing presentations of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images, and providing factual entertainment or educational information in the fields of current events, music, and sports, and providing news presentations via the Internet or other communications networks." (Registrant's proposed mark, 77037086)

APPLICANT'S PRIOR REGISTRATION

Registrant concedes that Applicant's prior registration affords some standing. Its service description (ITVS, 2154718) is:

"IC 041. US 100 101 107. G & S: entertainment services, namely, production, distribution, and programming of television programs and motion pictures of independent producers distributed to public television and non-public television audiences."

The difference, however, is although the nature of the services is similar to the Applicant's proposed mark (and to those of the Registrant), the method of service delivery (Internet/Global Computer Network) is a new development and with it comes an unmistakable likeliness of confusion. The Board will note that in an application that has been pending before the Commission since May 5, 2006 (#78877958; itv), the examining attorney has recently withdrawn her refusal based on likeliness of confusion with Registrant's mark (2879305, ITV) that has similar services only after the Applicant narrowed its proposed goods and services to not include transmission through a global computer network, Internet. (That application was refused for other reasons, however.)

CONCLUSION

Justification has now been established that the Applicant's proposed mark should not be registered in its present form. Registrant would consider withdrawing opposition should the Applicant decide to narrow its proposed service delivery method to not include the Internet/global computer network or amend it so that it expressly excludes services provided by the Registrant.

The Registrant thanks the Board for its examination of the facts of this case and the established precedents relevant to it.

Respectfully,

Andrew Rothlein

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

Andrew Rothlein,
Opposer

v

Serial No. 85180355 (ITVS)

Independent Television Service, Inc.,
Applicant

NOTICE OF OPPOSITION

Andrew Rothlein (hereinafter referred to as Registrant), does hereby tender notice of opposition to registration of the mark, ITVS, Serial No. 85180355 (hereinafter referred to as Applicant's proposed mark) based on the existence of a likelihood of confusion between the Applicant's proposed mark with both the registered mark (2879305, ITV) and the proposed mark (77037086, iTV) of the Registrant and based on the priority of the Registrant's marks in both cases.

The Board will note the similarity of both the marks and the *services in question*. With regard to the similarity in marks (ITVS v ITV/iTV), it is fundamental that the mere addition of a term does not obviate the similarity between the marks nor does it overcome the likelihood of confusion. With regard to services, the likelihood of confusion is clearly observed in the similarity of the service descriptions listed below:

"IC 038. US 100 101 104. G & S: Video streaming services and transmission services of audio visual works via a global computer network, Internet, cable, broadband, copper, and optical and wireless networks; broadcasting transmissions of audio visual works, messages and information via a global computer network, Internet, cable, broadband, copper, optical and wireless networks." (Applicant's proposed mark)

"IC 042. US 100 101. G & S: Providing information online in the field of current events and entertainment online news reporting presentations News analysis and features distribution via the Internet News agencies, namely, gathering and dissemination of news via the Internet Providing entertainment services, namely, providing information and links to other websites in the fields of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images." (Registrant's mark, ITV, 2879305)

"IC 041. US 100 101 107. G & S: Providing entertainment and educational services, namely, providing presentations of fictional and non-fictional stories, jokes, riddles, art, plays, photographs, and animated images, and providing factual entertainment or educational information in the fields of current events, music, and sports, and providing news presentations via the Internet or other communications networks." (Registrant's proposed mark, 77037086)

APPLICANT'S PRIOR REGISTRATION

Registrant concedes that Applicant's prior registration affords some standing. Its service description (ITVS, 2154718) is:

"IC 041. US 100 101 107. G & S: entertainment services, namely, production, distribution, and programming of television programs and motion pictures of independent producers distributed to public television and non-public television audiences."

The difference, however, is although the nature of the services is similar to the Applicant's proposed mark (and to those of the Registrant), the method of service delivery (Internet/Global Computer Network) is a new development and with it comes an unmistakable likeliness of confusion. The Board will note that in an application that has been pending before the Commission since May 5, 2006 (#78877958; itv), the examining attorney has recently withdrawn her refusal based on likeliness of confusion with Registrant's mark (2879305, ITV) that has similar services only after the Applicant narrowed its proposed goods and services to not include transmission through a global computer network, Internet. (That application was refused for other reasons, however.)

CONCLUSION

Justification has now been established that the Applicant's proposed mark should not be registered in its present form. Registrant would consider withdrawing opposition should the Applicant decide to narrow its proposed service delivery method to not include the Internet/global computer network or amend it so that it expressly excludes services provided by the Registrant.

The Registrant thanks the Board for considering its position.

Respectfully,

Andrew Rothlein

