

ESTTA Tracking number: **ESTTA499386**

Filing date: **10/10/2012**

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	Dwell Media, LLC
Granted to Date of previous extension	10/17/2012
Address	550 Kearny Street, Suite 710 San Francisco, CA 94108 UNITED STATES

Attorney information	D. Peter Harvey Harvey Siskind LLP 4 Embarcadero Center, 39th Floor San Francisco, CA 94111 UNITED STATES pharvey@harveysiskind.com, mstratton@harveysiskind.com, clee@harveysiskind.com Phone:415-354-0100
----------------------	---

### Applicant Information

Application No	85520883	Publication date	06/19/2012
Opposition Filing Date	10/10/2012	Opposition Period Ends	10/17/2012
Applicant	Limitless Group LLC 32nd Floor 521 Fifth Avenue New York, NY 10175 UNITED STATES		

### Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Hotel Services
---

### Applicant Information

Application No	85520894	Publication date	06/12/2012
Opposition Filing Date	10/10/2012	Opposition Period Ends	
Applicant	Limitless Group LLC 32nd Floor 521 Fifth Avenue New York, NY 10175 UNITED STATES		

### Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Hotel Services
---

## 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.	2452089	Application Date	10/08/1999
Registration Date	05/15/2001	Foreign Priority Date	NONE
Word Mark	DWELL		
Design Mark	DWELL		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/06/00 First Use In Commerce: 1999/06/00 Magazines in the field of modern home design Class 042. First use: First Use: 2000/01/00 First Use In Commerce: 2000/01/00 Providing On-line magazine in the field of modern home design		

U.S. Registration No.	3638812	Application Date	11/12/2008
Registration Date	06/16/2009	Foreign Priority Date	NONE
Word Mark	DWELL		
Design Mark			
Description of Mark	The mark consists of the word "dwell" in all lower case, sans serif font, with the lower left corners of the letters "l" cut at an angle from upper left to lower right.		
Goods/Services	Class 016. First use: First Use: 2000/09/01 First Use In Commerce: 2000/09/01 Magazines in the field of modern interior and architectural design		

U.S. Registration No.	3660406	Application Date	11/12/2008
Registration Date	07/28/2009	Foreign Priority Date	NONE
Word Mark	DWELL		

Design Mark	<h1>dwell</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2006/06/15 First Use In Commerce: 2007/02/01 Providing a website featuring videos, slideshows, podcasts, and online journals in the field of modern interior and architectural design and sustainable design		

U.S. Registration No.	3639000	Application Date	11/14/2008
Registration Date	06/16/2009	Foreign Priority Date	NONE
Word Mark	DWELL		
Design Mark	<h1>dwell</h1>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2003/01/00 First Use In Commerce: 2003/01/00 Arranging contests and competitions in the field of modern architectural, interior and furniture design		

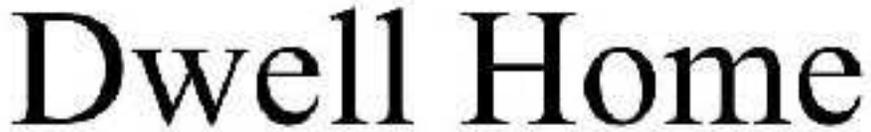
U.S. Registration No.	4020163	Application Date	02/05/2010
Registration Date	08/30/2011	Foreign Priority Date	NONE
Word Mark	DWELL MEDIA		

Design Mark	<h1>DWELL MEDIA</h1>		
Description of Mark	NONE		
Goods/Services	<p>Class 016. First use: First Use: 2010/07/01 First Use In Commerce: 2010/09/01 Magazines in the field of modern interior and architectural design and sustainable design</p> <p>Class 041. First use: First Use: 2010/07/01 First Use In Commerce: 2011/01/01 Providing a website featuring podcasts in the field of modern interior and architectural design and sustainable design; providing a website featuring online journals, namely, blogs in the field of modern interior and architectural design and sustainable design</p> <p>Class 042. First use: First Use: 2010/07/01 First Use In Commerce: 2011/01/01 Providing a website featuring non-downloadable videos, photographs, slideshows, and articles in the field of modern interior and architectural design and sustainable design</p>		

U.S. Registration No.	3671030	Application Date	01/31/2006
Registration Date	08/18/2009	Foreign Priority Date	NONE

Word Mark	DWELL		
Design Mark	<h1>DWELL</h1>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2003/07/01 First Use In Commerce: 2003/07/01 Endorsement services, namely, promoting the architectural designs of others, namely, promoting modern home architectural designs of others; endorsement services, namely, promoting the architectural designs of others, namely, promoting sustainable modern architectural designs of others</p>		

U.S. Registration No.	3372990	Application Date	04/12/2006
-----------------------	---------	------------------	------------

Registration Date	01/22/2008	Foreign Priority Date	NONE
Word Mark	DWELL HOME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2003/01/01 First Use In Commerce: 2003/01/31 Organization of competitions in the field of modern home design Class 036. First use: First Use: 2003/01/01 First Use In Commerce: 2003/01/31 Financial sponsorship of competitions in the field of modern home design		

U.S. Registration No.	3486397	Application Date	04/12/2006
Registration Date	08/12/2008	Foreign Priority Date	NONE
Word Mark	DWELL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2007/02/01 First Use In Commerce: 2007/02/01 Financial sponsorship of exhibitions, seminars, and conferences in the field of modern design Class 041. First use: First Use: 2007/02/01 First Use In Commerce: 2007/02/01 Arranging of exhibitions, seminars and conferences in the field of modern design		

U.S. Registration No.	3255952	Application Date	08/07/2006
Registration Date	06/26/2007	Foreign Priority Date	NONE
Word Mark	DWELL ON DESIGN		

Design Mark	<h1>Dwell on Design</h1>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2006/06/21 First Use In Commerce: 2006/06/21 Arranging of exhibitions, seminars, and conferences in the field of modern design and architecture

Attachments	75800343#TMSN.gif ( 1 page )( bytes ) 77612729#TMSN.jpeg ( 1 page )( bytes ) 77612779#TMSN.jpeg ( 1 page )( bytes ) 77614741#TMSN.jpeg ( 1 page )( bytes ) 77929353#TMSN.jpeg ( 1 page )( bytes ) 78803485#TMSN.jpeg ( 1 page )( bytes ) 78860224#TMSN.jpeg ( 1 page )( bytes ) 78860261#TMSN.jpeg ( 1 page )( bytes ) 78946724#TMSN.jpeg ( 1 page )( bytes ) Notice of Opposition.121010.DWELL HOTEL, etc.pdf ( 7 pages )(179770 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	/Matthew A. Stratton/
Name	Matthew A. Stratton
Date	10/10/2012

1 HARVEY SISKIND LLP  
D. PETER HARVEY (Calif. Bar No. 55712)  
2 email: pharvey@harveysiskind.com  
3 MATTHEW A. STRATTON (Calif. Bar No. 254080)  
email: mstratton@harveysiskind.com  
4 Four Embarcadero Center, 39<sup>th</sup> Floor  
San Francisco, CA 94111  
5 Telephone: (415) 354-0100  
6 Facsimile: (415) 391-7124

7 Attorneys for Opposer,  
Dwell Media, LLC

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

11  
12 DWELL MEDIA, LLC, a Delaware  
limited liability company,

13  
14 Opposer,

15 v.

16 LIMITLESS GROUP, LLC, a Delaware  
limited liability company,

17  
18 Applicant.

**CONSOLIDATED  
NOTICE OF OPPOSITION**

Opposition No.

App. Serial No. 85520883 for THE DWELL HOTEL

App. Serial No. 85520894 for DWELLTEL

19  
20 Dwell Media, LLC, a Delaware limited liability company, having its principal place of business  
21 at 550 Kearny Street, Suite 710, San Francisco, California 94108 (“Dwell”), believes that it will be  
22 damaged by registration of the marks THE DWELL HOTEL shown in Application Serial No. 85520883  
23 and DWELLTEL shown in Application Serial No. 85520894 (collectively, the “Applicant Marks”) filed  
24 by Limitless Group, LLC (“Applicant”), and hereby opposes those applications. As grounds for  
25 opposition, Dwell alleges:

26 **DESCRIPTION OF THE APPLICANT MARKS**

27 1. Applicant filed the word mark THE DWELL HOTEL (App. Serial No. 85520883) on  
28 January 20, 2012 and it was published for opposition in the Official Gazette on June 19, 2012. Applicant

1 filed the word mark DWELLTEL (App. Serial No. 85520894) on January 20, 2012 and it was published  
2 for opposition in the Official Gazette on June 12, 2012.

3 2. The mark shown in App. Serial No. 85520883 consists of the words THE DWELL  
4 HOTEL. The mark shown in App. Serial No. 85520894 consists of the word mark DWELLTEL. The  
5 Applicant Marks each seek registration in Class 43 for “Hotel Services.”

6 3. On July 12, 2012, Dwell requested, and the U.S. Patent and Trademark Office granted, a  
7 90-day extension of time to oppose registration of the mark DWELLTEL (App. Serial No. 85520894).  
8 On July 19, 2012, Dwell requested, and the U.S. Patent and Trademark Office granted, a 90-day  
9 extension of time to oppose registration of the mark THE DWELL HOTEL (App. Serial No. 85520883).

### 10 **DWELL’S FAMILY OF TRADEMARKS**

11 4. Dwell is a well-known leader in the fields of home design, architecture, and real  
12 estate. Its products and services offered under its DWELL and DWELL-formative trademarks  
13 include print and online magazines, competitions, exhibitions, conferences, seminars, and television  
14 programming. Dwell’s influential and highly regarded print magazine, which is distributed  
15 throughout the United States and several foreign countries, has a circulation of several hundred  
16 thousand copies per issue. Dwell’s website, located at [dwell.com](http://dwell.com), which features blogs, videos,  
17 podcasts, slideshows and articles, attracts close to 10,000 visitors each day. Dwell’s annual DWELL  
18 ON DESIGN conference and exhibition on modern design is one of the largest in the country,  
19 attracting thousands of attendees each year from all across the globe. Dwell also licenses its DWELL  
20 and DWELL HOMES trademarks for use in connection with the design, construction, and sale of  
21 houses. Virtually all of Dwell’s offerings concern places to live or stay. Dwell uses its DWELL and  
22 DWELL-formative marks on a nationwide basis.

23 5. Dwell owns numerous U.S. Trademark Registrations for DWELL and DWELL-  
24 formative marks, including the following (“Dwell Registrations”):

- 25 a. DWELL, U.S. Trademark Registration No. 2,452,089 in Class 16 for “Magazines in  
26 the field of modern home design,” filed on October 8, 1999 and registered on May 15,  
27 2001.

- 1 b. DWELL, U.S. Trademark Registration No. 3,638,812 in Class 16 for “Magazines  
2 in the field of modern interior and architectural design,” filed on November 12,  
3 2008 and registered on June 16, 2009.
- 4 c. DWELL, U.S. Trademark Registration No. 3,660,406 in Class 41 for “Providing a  
5 website featuring videos, slideshows, podcasts, and online journals in the field of  
6 modern interior and architectural design and sustainable design,” filed on  
7 November 12, 2008 and registered on July 28, 2009.
- 8 d. DWELL, U.S. Trademark Registration No. 3,639,000 in Class 41 for “Arranging  
9 contests and competitions in the field of modern architectural, interior and  
10 furniture design,” filed on November 14, 2008 and registered on June 16, 2009.
- 11 e. DWELL MEDIA, U.S. Trademark Registration No. 4,020,163 in Class 16 for  
12 “Magazines in the field of modern interior and architectural design and sustainable  
13 design;” Class 41 for “Providing a website featuring podcasts in the field of  
14 modern interior and architectural design and sustainable design; providing a  
15 website featuring online journals, namely, blogs in the field of modern interior and  
16 architectural design and sustainable design;” and Class 42 for “Providing a website  
17 featuring non-downloadable videos, photographs, slideshows, and articles in the  
18 field of modern interior and architectural design and sustainable design,” filed on  
19 February 5, 2010 and registered on August 30, 2011.
- 20 f. DWELL, U.S. Trademark Registration No. 3,671,030 in Class 35 for  
21 “Endorsement services, namely, promoting the architectural designs of others,  
22 namely, promoting modern home architectural designs of others; endorsement  
23 services, namely, promoting the architectural designs of others, namely, promoting  
24 sustainable modern architectural designs of others,” filed on January 31, 2006 and  
25 registered on August 18, 2009.
- 26 g. DWELL HOME, U.S. Trademark Registration No. 3,372,990 in Class 35 for  
27 “Organization of competitions in the field of modern home design” and Class 36  
28

1 for “Financial sponsorship of competitions in the field of modern home design,”  
2 filed on April 12, 2006 and registered on January 22, 2008.

3 h. DWELL, U.S. Trademark Registration No. 3,486,397 in Class 36 for “Financial  
4 sponsorship of exhibitions, seminars, and conferences in the field of modern  
5 design” and Class 41 for “Arranging of exhibitions, seminars and conferences in  
6 the field of modern design,” filed on April 12, 2006 and registered on August 12,  
7 2008.

8 i. DWELL ON DESIGN, U.S. Trademark Registration No. 3,255,952 in Class 41 for  
9 “Arranging of exhibitions, seminars, and conferences in the field of modern design  
10 and architecture,” filed on August 7, 2006 and registered on June 26, 2007.

11 6. Dwell has used the DWELL mark since at least 1999. Over many years, and at  
12 substantial cost, Dwell has built up invaluable goodwill in its family of DWELL and DWELL-  
13 formative trademarks.

14 7. Dwell’s DWELL and DWELL-formative marks are distinctive within the meaning of  
15 15 U.S.C. Sec. 1125(c).

16 8. Dwell’s DWELL mark is famous within the meaning of 15 U.S.C. §1125(c).

17 **LIKELIHOOD OF CONFUSION**

18 9. Applicant applied to register the Applicant Marks after the dates on which Dwell first  
19 used its DWELL and DWELL-formative marks, and after the dates on which Dwell applied to register  
20 the Dwell Registrations. On information and belief, Applicant’s first date of use, if any, of the Applicant  
21 Marks is after the dates on which Dwell first used and applied to register the various Dwell  
22 Registrations.

23 10. The Applicant Marks are likely to cause confusion, mistake, or to deceive, as to source,  
24 sponsorship, or affiliation because their dominant word element is identical or highly similar to those of  
25 Dwell’s Registered Marks, and the services claimed are related to those referenced by Dwell’s  
26 Registered Marks. Dwell is neither affiliated with nor a sponsor of Applicant, and the services identified  
27 by the Applicant Marks do not originate from Dwell.  
28

1 11. Registration of the Applicant Marks would be inconsistent with Dwell's established  
2 trademark rights acquired under the Dwell Registrations and the common law, and would damage Dwell.

3 **DILUTION**

4 12. Dwell's DWELL mark is distinctive and famous.

5 13. Dwell's DWELL mark became distinctive and famous prior to Applicant's filing dates  
6 and use of the Applicant Marks.

7 14. On information and belief, Applicant's use of the Applicant Marks has caused, and is  
8 likely to continue to cause, dilution by blurring of the distinctive quality of Dwell's famous DWELL  
9 mark.

10 15. Registration of the Applicant Marks would be inconsistent with Dwell's established  
11 trademark rights under the aforementioned registrations and common law, and would damage Dwell.

12 **PRAYER**

13 WHEREFORE, Opposer prays that Application Serial Nos. 85520883 and 85520894 be rejected,  
14 no registrations thereon be issued to Applicant, and this Opposition be sustained in favor of Opposer.  
15 Opposer hereby appoints as its attorneys Harvey Siskind LLP, a law firm composed of members of the  
16 Bar of the State of California, with full power to prosecute this Opposition, transact all relevant business  
17 with the U.S. Patent and Trademark Office and the U.S. Courts, and receive all official communication  
18 in connection with this Opposition.

19  
20 Dated: October 10, 2012

Respectfully submitted,

21 HARVEY SISKIND LLP  
22 D. PETER HARVEY  
23 MATTHEW A. STRATTON

24 By           /Matthew A. Stratton/          

Matthew A. Stratton

25  
26 Attorneys for Opposer,  
27 Dwell Media, LLC  
28

1 **CERTIFICATE OF TRANSMISSION**

2 I hereby certify that a true and correct copy of the attached CONSOLIDATED NOTICE OF  
3 OPPOSITION (Serial Nos. 85520883 and 85520894) is being electronically transmitted to the  
4 Trademark Trial and Appeal Board on October 10, 2012.

5  
6 Matthew A. Stratton/  
7 Matthew A. Stratton  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

1 **CERTIFICATE OF MAILING**

2 I hereby certify that a true and correct copy of the attached CONSOLIDATED NOTICE OF  
3 OPPOSITION (Serial Nos. 85520883 and 85520894) was served on Applicant via first-class mail on  
4 October 10, 2012, postage prepaid, addressed to:

5  
6 Jack McCue, Esq.  
7 Keith Sklar, Esq.  
8 McCue, Sussmane & Zapfel, P.C.  
9 521 5th Avenue, 32nd Floor  
10 New York, NY 10175-3299

Limitless Group LLC  
521 Fifth Avenue, 32nd Floor  
New York, NY 10175-3299

11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28  

/Cynthia Lee/  
\_\_\_\_\_  
Cynthia Lee