

ESTTA Tracking number: **ESTTA527375**

Filing date: **03/18/2013**

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

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| Name | Quantum Test Prep |
| Granted to Date of previous extension | 03/20/2013 |
| Address | 1 Yonge Street, Suite 916 Toronto, ON M5E 1E5 CANADA |

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| Attorney information | Douglas Burda BURDA IP P.O. Box 1532 La Jolla, CA 92038 UNITED STATES douglas@burda.co Phone:858-348-5054 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 85651128 | Publication date | 11/20/2012 |
| Opposition Filing Date | 03/18/2013 | Opposition Period Ends | 03/20/2013 |
| Applicant | Berman, Solomon 28 Kingston St. North Andover, MA 01845 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 041. All goods and services in the class are opposed, namely: Educational services, namely, providing classes, seminars, workshops, tutoring, and counseling for high school students and standardized test preparation services |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act section 2(d) |
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Mark Cited by Opposer as Basis for Opposition

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|----------------------|----------|-----------------------|------------|
| U.S. Application No. | 85804808 | Application Date | 12/17/2012 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | QUANTUM | | |

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|---------------------|---|
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 041. First use: First Use: 2011/02/26 First Use In Commerce: 2011/02/26 Education services, namely, providing classes, counseling, programs, seminars, tutoring, workshops in the field of standardized test preparation |

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| Attachments | 85804808#TMSN.jpeg (1 page)(bytes) QUANTUM_Notice of Opposition.TTAB.pdf (4 pages)(63026 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 | /Douglas Burda/ |
| Name | Douglas Burda |
| Date | 03/18/2013 |

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

**IVY LEAGUE TEST PREP
INTERNATIONAL, INC. dba
QUANTUM TEST PREP**

Petitioner,

v.

OPPOSITION NO. _____

MR. SOLOMON BERMAN

Respondent.

NOTICE OF OPPOSITION

Opposer, Ivy League Test Prep International, Inc. dba Quantum Test Prep having its principal place of business at 1 Yonge Street, Suite 916, Toronto, Ontario M5E 1E5, Canada (Quantum) believes it will be damaged by registration of the mark QUANTUM PREP delineated in the United States trademark application serial number of 85651128 (Application), and hereby opposes same on the following grounds:

1. Quantum owns the trademarks and trade names QUANTUM and QUANTUM TEST PREP (Quantum IP).
2. Since at least as early as February 26, 2011, Quantum has continuously used the Quantum IP in interstate commerce in the United States at minimum in association with Quantum's education services, namely, providing classes, counseling, programs, seminars, tutoring, workshops in the field of standardized test preparation (Quantum Services).
3. Quantum has offered, performed and sold the Quantum Services in the United States and abroad, and has investing substantial sums in the development, advertising, and marketing of the Quantum Services under the Quantum IP.

4. On December 17, 2012, Quantum filed a trademark application with the United States Patent and Trademark Office (PTO) for its QUANTUM mark showing a date of first use in interstate commerce in the United States of February 26, 2011, delineated in United States trademark application serial number 85804808.
5. By virtue of Quantum's activities delineated in Paragraphs 2-4 herein, at minimum, the Quantum IP represent valuable goodwill.
6. On June 13, 2012, Mr. Solomon Berman, having an address of 28 Kingston St., North Andover, Massachusetts 01845 (Berman), filed the Application with the PTO on an intent to use basis to register QUANTUM PREP (the Berman Designation) for use with the following services in international class 41:

EDUCATIONAL SERVICES, NAMELY, PROVIDING CLASSES, SEMINARS,
WORKSHOPS, TUTORING, AND COUNSELING FOR HIGH SCHOOL STUDENTS
AND STANDARDIZED TEST PREPARATION SERVICES

(Berman Services).
7. The Application was published for opposition on November 20, 2012, and Quantum filed an Extension of Time to Oppose the Application on December 17, 2012 and an additional Extension of Time to Oppose the Application on January 16, 2013, both of which were duly granted by the Trademark Trial and Appeal Board (TTAB).
8. Quantum's dates of first use of the Quantum IP pre-dates Berman's date of first use of the Berman Designation.
9. Berman's date of first use of the Berman Designation in interstate commerce in the United States could not possibly pre-date Quantum's first use of the Quantum IP in interstate commerce in the United States.
10. The Berman Services are at least substantially similar to the Quantum Services.

11. Berman lodged the Application with full knowledge of Quantum's ownership and use of the Quantum IP.
12. Berman presently seeks registration of the Berman Designation with full knowledge of Quantum's superior ownership and use rights in the Quantum IP.
13. Berman lodged the Application without Quantum's consent or permission.
14. Berman's use and registration of the Berman Designation consists of or comprises a mark which so resembles the Quantum IP, as to be likely, when used on or in connection with the Berman Services, to cause confusion, or to cause mistake, or to deceive, and to create a false impression that Berman and the Berman Services are connected or affiliated with, or licensed or approved by Quantum.
15. Quantum will be damaged by the registration of the Berman Designation in that such designation will give Berman a *prima facie* exclusive right to use the Berman Designation despite the likelihood of confusion, mistake, or deception delineated above, and will allow Berman to trade on Quantum's existing goodwill in the Quantum IP.

WHEREFORE, Quantum respectfully requests that this Opposition be sustained in favor of Quantum and that the Application be refused registration.

March 18, 2013

Respectfully submitted,



Douglas Burda
BURDASM IP
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La Jolla, California 92038
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Email. douglas@burda.co
Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Mr. Robert Berman by mailing said copy on March 18, 2013, via First Class Mail, postage prepaid to the following individual, identified as the attorney of record and correspondent in the Application:

Mr. Brendan Shortell, Esq.
Lambert & Associates
92 State St Ste 200
Boston, Massachusetts 02109-2004

By: 
Douglas Burda