

ESTTA Tracking number: **ESTTA557235**

Filing date: **08/31/2013**

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**

Name	Smith & Jones Advertising, Inc.
Granted to Date of previous extension	08/31/2013
Address	76 MAIN STREET STURBRIDGE, MA 01566 UNITED STATES
Correspondence information	Smith & Jones Advertising, Inc. 76 MAIN STREET STURBRIDGE, MA 01566 UNITED STATES jmclane@imaginethatpatents.com Phone:774-230-1272

**Applicant Information**

Application No	85834876	Publication date	07/02/2013
Opposition Filing Date	08/31/2013	Opposition Period Ends	08/31/2013
Applicant	The Guesty Corp. 297 River Street Troy, NY 12180 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 1985/03/31 First Use In Commerce: 1985/03/31 All goods and services in the class are opposed, namely: Advertising services; Branding services, namely, brand concept and brand development services for others; development, management, and marketing of brands for others
--

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Trademark Act section 1127, Abandonment by action or inaction of Applicant that has caused Applicant's Mark to lose its significance as a trademark; and Trademark Act Section 1 Applicant is not the rightful owner of the Mark

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application/Registration No.	NONE	Application Date	NONE
-----------------------------------	------	------------------	------

Registration Date	NONE
Word Mark	SMITH & JONES
Goods/Services	advertising services, branding services including brand concept and brand development services for others, development, management, and strategic marketing of brands for others

Attachments	Complaint.pdf(90812 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	/Jodi-Ann McLane/
Name	Smith & Jones Advertising, Inc.
Date	08/31/2013

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

SMITH & JONES ADVERTISING, INC.,  
Opposer  
  
V.  
  
THE GUESTY CORP.,  
Applicant

In the matter of trademark application  
Serial No. 85/834,876  
  
Mark: SMITH & JONES  
  
Filed: January 29, 2013  
  
Published: July 2, 2013  
  
Opposition No.:

**NOTICE OF OPPOSITION**

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

Smith & Jones Advertising, Inc., a Massachusetts corporation, located and doing business at 76 Main Street, Sturbridge, MA 01566 (“Opposer”) believes that it will be damaged by registration by The Guesty Corp., a New York corporation, located and doing business at 297 River Street, Troy, NY 12180 (“Applicant”) of the mark SMITH & JONES shown in Application Serial No. 85/834,876 (“Applicant’s Application”). The Opposer believes that it will be damaged by registration of the mark identified in Applicant’s Application, and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. Applicant filed a trademark application which was assigned Application Serial No. 85/834,876 in the United States Patent and Trademark Office (“PTO”) on January 29, 2013 (“Filing Date”) to register the mark SMITH & JONES (“Applicant’s Mark”) for use

in connection with “Advertising services; Branding services, namely, brand concept and brand development services for others; development, management, and marketing of brands for others” (“Applicant’s Services”) in International Class 035 and US Classes 100,101, and 102.

2. Applicant’s Application alleged initial use of Applicant’s Mark in conjunction with the Applicant’s Services on or before March 31, 1985 (“Alleged First Use Date”).
3. On information and belief, Applicant uses the mark SMITH & JONES in connection with healthcare marketing as evidenced by its’ website and specimen filed with the PTO on the Filing Date.
4. Applicant’s Mark was published for opposition in the Official Gazette on July 2, 2013. On August 1, 2013, Opposer timely filed a request for a 30-day extension of time to oppose the Application for Applicant’s Mark, which was granted until August 31, 2013.
5. Opposer is a provider of advertising services, branding services including brand concept and brand development services for others, development, management, and strategic marketing of brands for others (“Opposer’s Services”).
6. Opposer has established common-law rights for the mark SMITH & JONES (“Opposer’s Mark”) through continuous use in commerce in connection with Opposer’s Services since

at least as early as September 30, 1996 and Opposer's Mark is currently in use in commerce in connection with Opposer's Services.

7. On information and belief, Applicant had actual knowledge of Opposer's Mark as used in connection with Opposer's Services and acquiesced to the same over a period of years.
8. On information and belief, various other advertising and marketing agencies across the country use the name Smith & Jones to promote their services, for example:
  - a. Smith & Jones of Incline Village Nevada which, on information and belief has been using the Smith & Jones in connection with advertising and marketing services since 1980 and which was incorporated in Nevada as Smith & Jones in 1983;
  - b. Smith & Jones of Houston Texas which on information and belief has been using Smith & Jones in connection with advertising and marketing services and was incorporated in 2004; and
  - c. Alias Smith & Jones of Anchorage, AK which on information and belief has been using the mark Alias Smith & Jones in connection with design and advertising services since 1996.
9. On information and belief, Smith & Jones of Incline Village Nevada is a senior user to Applicant ("Senior User"), having used the identical mark in connection with the same services prior to the Alleged First Use Date as listed in Applicant's Application.

COUNT I – Lanham Act, 15 USC § 1127 – Abandonment

1. The conduct of the Applicant in allowing concurrent use by Opposer of the same mark in conjunction with the same services, and in allowing concurrent use by third-parties for the same and similar marks in connection with the same services as Applicant has caused Applicant's Mark to lose its significance as a mark and the Applicant's Mark has therefore become abandoned under 15 USC § 1127.

COUNT II – Lanham Act Section 2(d), 15 U.S.C. § 1052(d) – Likelihood of Confusion

1. Applicant's Mark so resembles the mark or trade name previously used in the United States by the Senior User Smith & Jones of Nevada and still in use by the Senior User, as to be likely, when used on or in connection with the services of the Applicant, to cause confusion, or to cause mistake, or to deceive the relevant trade and public.

COUNT III – Lanham Act Section 1, 15 U.S.C. § 1051 - Applicant is not the rightful owner of the Mark

1. That Applicant is not (and was not, at the time of the filing of its application for or that registration) the rightful owner of the registered mark due to the Senior User Smith & Jones of Nevada use of the same mark for the same services.

WHEREFORE, Opposer believes that it will be damaged by registration of the mark SMITH & JONES by Applicant, and respectfully requests that registration of the mark shown in Application Serial No. 85/834,876 be refused and that this Opposition be sustained in favor of Opposer.

The fee required for the Opposition for one class (\$300 USD) is set out at 2.6(a)(17) and the TTAB is submitted herewith.

Dated: August 31, 2013

Respectfully Submitted,  
Smith & Jones Advertising, Inc. (Opposer)

/Jodi-Ann McLane/

Jodi-Ann McLane, Esq.  
Counsel for Opposer  
Imagine That Patents, LLC  
PO Box 555  
Warren, RI 02885  
Phone: (401) 223-5853  
Fax: (866) 610-0507  
jmclane@imaginethatpatents.com

CERTIFICATE OF SERVICE

I, Jodi-Ann McLane, hereby certify that a true and complete copy of the foregoing OPPOSITION has been served on Applicant's counsel at the following addresses of record, by first class mail, postage prepaid, this 31<sup>st</sup> day of August 2013:

Maxine L. Barasch  
KEOHANE & D'ALESSANDRO, PLLC  
1881 WESTERN AVE  
ALBANY, NY 12203-6021

/Jodi-Ann McLane/  
\_\_\_\_\_  
Jodi-Ann McLane, Esq.

Dated: August 31, 2013