

ESTTA Tracking number: **ESTTA567474**

Filing date: **10/28/2013**

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	duPont Publishing, Inc.
Granted to Date of previous extension	11/06/2013
Address	3051 Tech Drive St. Petersburg, FL 33716 UNITED STATES

Attorney information	Gary Tannenbaum Friedman Schuman P.C. 101 Greenwood Avenue5th Floor Jenkintown, PA 19046 UNITED STATES gtannenbaum@fsalaw.com Phone:215-690-3830
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Applicant Information

Application No	85784929	Publication date	07/09/2013
Opposition Filing Date	10/28/2013	Opposition Period Ends	11/06/2013
Applicant	Auto 100 Media, Inc. 2711 CENTERVILLE ROAD SUITE 400 WILMINGTON, DE 19808 GERMANY		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Collection and compilation of information into computer databases in the field of automotive ranking, featuring information relating to various entities in theautomotive ecosystem obtained as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities; providing an online computer database for collecting and reporting information in the field of automotive ranking, featuring information relating to various entities within the automotive ecosystem, where information relating to various entities was gathered as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities; providing an online searchabledatabase featuring automotive ranking data, featuring information relating to various entities gathered as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities</p>
<p>Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer services, namely, providing on-line newsletters in the field of automotive ranking, automobile marketing, and topics of interest to automotive customers</p>
<p>Class 042. First Use: 0 First Use In Commerce: 0</p>

All goods and services in the class are opposed, namely: Providing a web site featuring technology enabling users to view a searchable database of information related to automotive ranking; providing an on-line computer database featuring technology enabling users to view information regarding automotive ranking; Computer services, namely, providing online non-downloadable software enabling users to view a searchable database of information related to automotive ranking

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Applicant lacks the requisite bona fide intent to use the mark in commerce

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	86082614	Application Date	10/04/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	AUTOFLUENCE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 037. First use: First Use: 2011/10/09 First Use In Commerce: 2012/02/01</p> <p>Providing an internet website that features news, research and information about exotic, rare and collectible autos, supercars, muscle cars, classic cars, celebrity-owned autos, auto manufacturers, and other topics of interest to auto enthusiasts; Providing an internet website that features news, research and information about yachts, speedboats, celebrity-owned yachts and speedboats, and other topics of interest to boating enthusiasts; Providing an internet website that features news, research and information about luxury lifestyle gifts and novelties, namely, watches and timepieces, furniture, footwear, jewelry, mobile phone cases, electronic tablet holders, cigars, alcohol, hats, tee shirts, sweatshirts, jackets, handbags, key chains, key fobs, pens, home electronics and headphones; Providing an internet website that features news, research and information about exclusive residences and homes, exotic dwellings, celebrity-owned residences, luxury vacation homes and exclusive real estate investment opportunities, and other topics of interest to luxury real estate investors</p>		

Attachments	86082614#TMSN.jpeg(bytes) NOTICE OF OPPOSITION (00537767).pdf(679097 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	/gary tannenbaum/
Name	Gary Tannenbaum
Date	10/28/2013

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

duPont Publishing, Inc.,

Opposer,

v.

Auto 100 Media Inc.

Applicant.

Opposition No. _____

Serial No. 85/784,929

Filed: November 21, 2012

Published: July 9, 2013

NOTICE OF OPPOSITION

duPont Publishing, Inc., (“duPont Publishing”) opposes Auto 100 Media Inc.’s (“Auto 100 Media”) application to register AUTOFLUENCE (the “Opposed Application”) because duPont Publishing will be damaged by the registration of the Opposed Application.

The grounds for the opposition are as follows:

1. Auto 100 Media seeks to register AUTOFLUENCE as a service mark for the following services:
 - a. International Class 35: Collection and compilation of information into computer databases in the field of automotive ranking, featuring information relating to various entities in the automotive ecosystem obtained as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities; providing an online computer database for collecting and reporting information in the field of automotive ranking, featuring information relating to various entities within the automotive ecosystem, where information relating to various entities was gathered as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities; providing an online searchable database featuring automotive ranking data, featuring information relating to various entities gathered as a result of tracking and analyzing websites, news feeds, social media postings, financial reports, and intellectual property activities;

- b. International Class 41: Computer services, namely, providing on-line newsletters in the field of automotive ranking, automobile marketing, and topics of interest to automotive customers; and
 - c. International Class 44: Providing a web site featuring technology enabling users to view a searchable database of information related to automotive ranking; providing an on-line computer database featuring technology enabling users to view information regarding automotive ranking; Computer services, namely, providing online non-downloadable software enabling users to view a searchable database of information related to automotive ranking.
2. Auto 100 Media filed the Opposed Application on November 21, 2012, based on an alleged *bona fide* intent to use the mark in commerce.
 3. duPont Publishing used the AUTOFLUENCE mark in interstate commerce in connection with the same or substantially similar services before November 21, 2012.

OPPOSER'S BACKGROUND

4. duPont Publishing is a Delaware corporation with a principal place of business located at 3051 Tech Drive, St. Petersburg, Florida 33716.
5. duPont Publishing was founded in 1984, and has been in business continuously since that time publishing magazines directed to the luxury/lifestyle marketplace and creating related products and hosting events directed to the luxury/lifestyle marketplace.
6. duPont Publishing's monthly magazines currently reach subscribers in all 50 states and at least 54 foreign countries.
7. Through duPont Publishing's publications, individuals purchase and sell lavish and luxury items from exotic and collectible autos, elegant homes, sophisticated motor yachts to specialty gifts and gadgets for the affluent lifestyle.
8. Since the beginning of 1996, duPont Publishing has been a very active internet website publisher.
9. duPont Publishing publishes multiple websites, including www.duPontRegistry.com; www.celebritycarmagazine.com and www.autofluence.com, all of which together reach hundreds of thousands of viewers every month.

DUPONT PUBLISHING'S PRIORITY OF USE

10. duPont Publishing owns and publishes the www.autofluence.com website, which is devoted to providing viewers with daily automotive news and exotic car news, as well as information that affects the luxury lifestyle.

11. The www.autofluence.com website first became active and began using the AUTOFLUENCE mark at least as early as February 1, 2012, and has been continuously active at all times since.
12. At least as early as February 1, 2012, and at all times since, the www.autofluence.com website prominently features the mark AUTOFLUENCE on multiple pages throughout the website in close connection with news, research and information about exotic, rare and collectible autos, supercars, muscle cars, classic cars, celebrity-owned autos, auto manufacturers, and other topics of interest to auto enthusiasts.
13. At least as early as February 1, 2012, and at all times since, the www.autofluence.com website also prominently features the mark AUTOFLUENCE on multiple pages throughout the website in close connection with news, research and information about yachts, speedboats, celebrity-owned yachts and speedboats, and other topics of interest to boating enthusiasts.
14. At least as early as February 1, 2012, and at all times since, the www.autofluence.com website also prominently features the mark AUTOFLUENCE on multiple pages throughout the website in close connection with news, research and information about luxury lifestyle gifts and novelties, namely, watches and timepieces, furniture, footwear, jewelry, mobile phone cases, electronic tablet holders, cigars, alcohol, hats, tee shirts, sweatshirts, jackets, handbags, key chains, key fobs, pens, home electronics and headphones.
15. At least as early as February 1, 2012, and at all times since, the www.autofluence.com website also prominently features the mark AUTOFLUENCE on multiple pages throughout the website in close connection with news, research and information about exclusive residences and homes, exotic dwellings, celebrity-owned residences, luxury vacation homes and exclusive real estate investment opportunities, and other topics of interest to luxury real estate investors.
16. The www.autofluence.com website receives over 16,500 unique visitors to its site each month.
17. Over 100 different websites offer back links to www.autofluence.com.
18. duPont Publishing's AUTOFLUENCE has become distinctive in the marketplace as a key destination for news concerning exotic and collectible cars, celebrity cars, luxury property, as well as news and information about all of the same.
19. duPont Publishing has expended tens of thousands of dollars in advertising and promotion for the www.autofluence.com website and its AUTOFLUENCE brand.
20. By virtue of duPont Publishing's continuous and widespread uses of the AUTOFLUENCE mark, duPont Publishing is entitled to a broad scope of protection therefor.

21. duPont Publishing is the owner of United States service mark application for registration serial #86/082,614, which was filed on October 4, 2013, in connection with the following services: Providing an internet website that features news, research and information about exotic, rare and collectible autos, supercars, muscle cars, classic cars, celebrity-owned autos, auto manufacturers, and other topics of interest to auto enthusiasts; Providing an internet website that features news, research and information about yachts, speedboats, celebrity-owned yachts and speedboats, and other topics of interest to boating enthusiasts; Providing an internet website that features news, research and information about luxury lifestyle gifts and novelties, namely, watches and timepieces, furniture, footwear, jewelry, mobile phone cases, electronic tablet holders, cigars, alcohol, hats, tee shirts, sweatshirts, jackets, handbags, key chains, key fobs, pens, home electronics and headphones; Providing an internet website that features news, research and information about exclusive residences and homes, exotic dwellings, celebrity-owned residences, luxury vacation homes and exclusive real estate investment opportunities, and other topics of interest to luxury real estate investors.

COUNT I
LIKELIHOOD OF CONFUSION

22. duPont Publishing repeats and restates the assertions set forth in paragraphs 1 through 21.
23. duPont Publishing's AUTOFLUENCE mark is identical to Auto 100 Media's proposed AUTOFLUENCE mark in sight, sound, meaning and commercial impression.
24. The services provided by Auto 100 Media under its proposed AUTOFLUENCE mark are either identical or closely related to those services currently provided by duPont Publishing under its AUTOFLUENCE mark or within the zone of natural expansion of duPont Publishing's services.
25. Auto 100 Media's identified services will be offered to the same general class of customers or consumers to whom duPont Publishing directs its services under the AUTOFLUENCE mark.
26. Auto 100 Media's proposed mark so closely resembles the AUTOFLUENCE mark previously used in the United States by duPont Publishing that it is likely, when used in connection with Auto 100 Media's services, to cause confusion, mistake or deception as to the source of Auto 100 Media's services to duPont Publishing's detriment.

COUNT II
FALSE SUGGESTION OF CONNECTION WITH DUPONT PUBLISHING

27. duPont Publishing repeats and restates the assertions set forth in paragraphs 1 through 26.
28. The AUTOFLUENCE mark is associated with duPont Publishing and its www.autofluence.com website.

29. The AUTOFLUENCE mark, when used in connection with Auto 100 Media's services, suggests to the public that such services are affiliated with or endorsed by duPont Publishing.
30. duPont Publishing is not connected in any way with Auto 100 Media's proposed use of the AUTOFLUENCE mark.
31. The AUTOFLUENCE mark, when applied to Auto 100 Media's identified services, falsely suggests a connection with duPont Publishing within the meaning of Section 2(a) of the Trademark Act §1052(a).

COUNT III
LACK OF BONA FIDE INTENT

32. duPont Publishing repeats and restates the assertions set forth in paragraphs 1 through 31.
33. Auto 100 Media filed the Opposed Application on an "intent-to-use" basis.
34. Auto 100 Media, acting by and through its attorney, Brian Coleman, Esq., admitted that it was, "... simply going to allow this application to lapse, and will not be using the AUTOFLUENCE brand." (Email dated September 12, 2013, from B. Coleman, Esq. to G. Tannenbaum, Esq.)
35. Auto 100 Media again admitted that, "...we're not going to pursue this brand and risk your wrath. [I]t will lapse in due course as we do nothing." (Email dated September 27, 2013, from B. Coleman, Esq. to G. Tannenbaum, Esq.)
36. Based on these admissions, Auto 100 Media lacks the requisite *bona fide* intention to use the proposed mark in connection with all of the identified services.

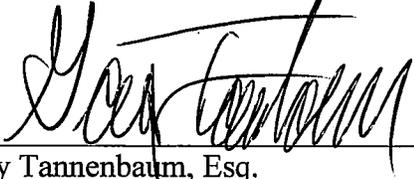
CONCLUSION

WHEREFORE, duPont Publishing prays that the Board sustain the opposition to refuse registration of the Opposed Application.

The 28th day of October, 2013.

Respectfully submitted,

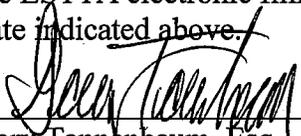
FRIEDMAN SCHUMAN P.C.

By: 
Gary Tannenbaum, Esq.

**CERTIFICATE OF ELECTRONIC
TRANSMISSION**

Date: October 28, 2013

I hereby certify that this paper is being transmitted electronically to the United States Patent and Trademark Office through the ESTTA electronic filing system on the date indicated above.


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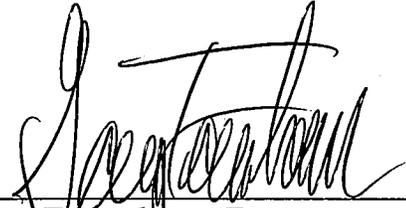
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Attorneys for Opposer,
duPont Publishing, Inc.

CERTIFICATE OF SERVICE

I certify that a true and complete copy of this NOTICE OF OPPOSITION has been served on the Applicant by mailing said copy on October 28, 2013, via First Class Mail, postage prepaid to the address of Applicant's Attorney of Record as listed in the TARR System, which is also listed as the correspondence address for the Applicant, on this date as follows:

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By: 

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