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

Proceeding	91213694
Party	Defendant Shopology
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Submission	Answer
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Date	01/04/2014
Attachments	SHOPOLOGY Answer to Opposition.pdf(322007 bytes) SHOPOLOGY Answer to Opposition - SIGNED VERSION.pdf(2633548 bytes)

January 4, 2014

ANSWER TO OPPOSITION

Applicant Shopology, LLC, Federal Tax ID Number (EIN) #76-0712-947, is asserting legal claim for the intent to use mark SHOPOLOGY as applied for in Application Serial No. 85/907,549, filed April 18, 2013, for “Market research shopping by researchers who pose as customers to evaluate the quality of service delivered” in Class 35. Applicant Shopology, LLC, is responding to a Notice of Opposition by the Opposer who owned now-canceled Registration No. 3,156,228 for the mark SHOPOLOGY covering “e-commerce based personal shopping service for women” in Class 45. This registration expired when the Opposer did not submit an application to renew the mark. Per the United States Patent and Trademark Office (USPTO) Trademark Laws and Federal Statutes §2.182 Time for filing renewal application. An application for renewal must be filed within one year before the expiration date of the registration, or within the six-month grace period after the expiration date of the registration. If no renewal application is filed within this period, the registration will expire. The Opposer’s now-canceled Registration No. 3,156,228 expired October 17, 2012 and the six-month grace period to submit a renewal application ended on April 17, 2013. Therefore the Opposer’s Registration was in default and lapsed on April 18, 2013. The Opposer subsequently submitted an Application Serial No. 86/046,117 for the mark SHOPOLOGY on August 23, 2013 several months after their initial Registration lapsed and well after the Applicant submitted their Intent to Use Application on April 18, 2013.

OPPOSITION #1:

At least as early as March 15, 2004, and well prior to the April 18, 2013 filing date of the Applicant’s intent to use application, Opposer, by itself and through its predecessor-in-interest, has used the mark SHOPOLOGY to promote its online shopping website and offer online shopping concierge services, including personal shopping services, and provision of a searchable Database of retail boutiques.

APPLICANT ANSWER TO OPPOSITION #1: DENY

The Applicant’s intent to use application has priority over Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

January 4, 2014

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OPPOSITION #2:

Opposer owns Application Serial No. 86/046,117 for the mark SHOPOLOGY covering “e-commerce based personal shopping service for women” in Class 45 (the “Services”), which cites a date of first use in interstate commerce in connection with the services of March 15, 2004. Opposer’s first use date is well prior to the filing date of Applicant’s intent to use application.

APPLICANT ANSWER TO OPPOSITION #2: DENY

The Applicant’s intent to use application has priority over Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

OPPOSITION #3:

Opposer also owned now-canceled Registration No. 3,156,228 for the mark SHOPOLOGY covering “e-commerce based personal shopping service for women” in Class 45, which cited a date of first use in interstate commerce of March 15, 2004. This registration lapsed when the Opposer inadvertently missed the deadline to file a declaration of use.

APPLICANT ANSWER TO OPPOSITION #3: DENY

The Opposer did own the now-canceled Registration No. 3,156,228 for the mark SHOPOLOGY however the Opposer purposely allowed the mark to default and did not submit an application to renew. The Applicant’s intent to use application has priority over the Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

January 4, 2014

ANSWER TO OPPOSITION

OPPOSITION #4:

Opposer has made continuous use of its SHOPOLOGY trademark in commerce in connection with the Services since at least as early as March 2004. As such, its trademark rights are valid and subsisting.

APPLICANT ANSWER TO OPPOSITION #4: DENY

It has yet to be proven that the Opposer has made use of the SHOPOLOGY trademark in commerce. As such, the Applicant's intent to use application has priority over Opposer's subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant's application.

OPPOSITION #5:

Opposer has spent a substantial amount of time and resources in commercializing the mark SHOPOLOGY. As a result of Opposer's widespread use of the mark, the mark has attracted a significant amount of recognition and goodwill among consumers.

APPLICANT ANSWER TO OPPOSITION #5: DENY

It has yet to be proven that the Opposer has made use of the SHOPOLOGY trademark in commerce resulting in goodwill among clients or consumers. As such, the Applicant's intent to use application has priority over the Opposer's subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant's application.

January 4, 2014

ANSWER TO OPPOSITION

OPPOSITION #6:

On April 18, 2013, Applicant Shopology, allegedly a Texas limited liability company, filed the application at issue to register the mark SHOPOLOGY for “market research. Shopping by researchers who pose as customers to evaluate the quality of service delivered.” It appears to have later been amended to cover “market research shopping by researchers who pose as customers to evaluate the who pose as customers to evaluate the quality of service delivered” in Class 35.

APPLICANT ANSWER TO OPPOSITION #6: ADMIT

Applicant Shopology, LLC, Federal Tax ID Number (EIN) #76-0712-947, is asserting legal claim for the intent to use mark SHOPOLOGY as applied for in Application Serial No. 85/907,549, filed April 18, 2013, for “Market research shopping by researchers who pose as customers to evaluate the quality of service delivered” in Class 35. As such, the Applicant’s intent to use application has priority over Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

OPPOSITION #7:

The mark that Applicant seeks to register is identical to Opposer’s prior mark SHOPOLOGY. Applicant is seeking to register the mark for services that are the same or closely related to the services for which Opposer has previously registered, applied for and used its mark. Given that the trade channels in the opposed application are not restricted, it is assumed that Applicant’s services will be offered in the identical channels, the public is likely to associate Applicant’s applied-for services under the mark SHOPOLOGY with Opposer or with Opposer’s services, or to believe that Applicant’s services are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

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ANSWER TO OPPOSITION

APPLICANT ANSWER TO OPPOSITION #7: DENY

Applicant Shopology, LLC, Federal Tax ID Number (EIN) #76-0712-947, is asserting legal claim for the intent to use mark SHOPOLOGY as applied for in Application Serial No. 85/907,549, filed April 18, 2013, for “Market research shopping by researchers who pose as customers to evaluate the quality of service delivered” in Class 35. The Opposer’s prior mark is no longer active thus has no legal standing to assert claims that Applicant’s services will be offered in identical channels of trader. As such, the Applicant’s intent to use application has priority over Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

OPPOSITION #8:

For the above reasons, any registration for the mark SHOPOLOGY by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that those services emanate from or are otherwise sponsored or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

By reason of the foregoing, Opposer will be damaged by the registration of the mark SHOPOLOGY to Applicant.

APPLICANT ANSWER TO OPPOSITION #8: DENY

Applicant Shopology, LLC, Federal Tax ID Number (EIN) #76-0712-947, is asserting legal claim for the intent to use mark SHOPOLOGY as applied for in Application Serial No. 85/907,549, filed April 18, 2013, for “Market research shopping by researchers who pose as customers to evaluate the quality of service delivered” in Class 35. The Opposer’s prior mark is no longer active thus has no legal standing to assert claims that Applicant’s services will be offered in identical channels of trader. As such, the Applicant’s intent to use application has priority over Opposer’s subsequently-filed Application Serial No. 86/046,117 as the Opposer has not made any use of the SHOPOLOGY mark in the United States; the Opposer has not made use of its mark in interstate commerce or intrastate commerce within the United States; the Opposer thus cannot claim a date of use that is prior to the filing date of Applicant’s application.

January 4, 2014

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In sum, Opposer has failed to disclose any evidence that points to the existence of a genuine issue of material fact on the issue of priority, likelihood of confusion of mark with the Applicant's services nor evidence of sales, revenue or goodwill for the SHOPOLOGY mark.

WHEREFORE, it is respectfully requested that this opposition brought by the Opposer be denied and dismissed and that registration of the mark SHOPOLOGY be granted to the Applicant.

Dated: January 4, 2014

Respectfully submitted,

Noriess Beauvais

Noriess Beauvais

Shopology
5005 Galleria Drive
Suite 2218
Farmers Branch, TX 75244

Applicant

January 4, 2014

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing ANSWER TO THE NOTICE OF OPPOSITION was served by First-Class mail, postage prepaid, upon the Attorneys for Opposer, this 4th day of January 2014, addressed as follows:

**Mr. Martin Schwimmer
Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, NY 10601**

Noriess Beauvais

Noriess Beauvais

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Dated: January 4, 2014

Respectfully submitted,



Noriess Beauvais

Shopology
5005 Galleria Drive
Suite 2218
Farmers Branch, TX 75244

Applicant

January 4, 2014

CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing ANSWER TO THE NOTICE OF OPPOSITION was served by First-Class mail, postage prepaid, upon the Attorneys for Opposer, this 4th day of January 2014, addressed as follows:

**Mr. Martin Schwimmer
Leason Ellis LLP
One Barker Avenue, Fifth Floor
White Plains, NY 10601**



Noriess Beauvais