

ESTTA Tracking number: **ESTTA667468**

Filing date: **04/17/2015**

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	EDISON MANAGEMENT CO., L.L.C.
Granted to Date of previous extension	04/19/2015
Address	1271 Avenue of the Americas, 39th Floor c/o Triumph Hospitality New York, NY 10020 UNITED STATES

Attorney information	Ralph N. Gaboury, Esq. Cox Padmore Skolnik & Shakarchy LLP 630 Third Avenue 19th Floor New York, NY 10017 UNITED STATES gaboury@cpslaw.com Phone:212-953-6633
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Applicant Information

Application No	86287975	Publication date	10/21/2014
Opposition Filing Date	04/17/2015	Opposition Period Ends	04/19/2015
Applicant	Kinetescape Holdings, LLC 108 W. Second Street, Suite 101 Los Angeles, CA 90012 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. First Use: 2006/11/11 First Use In Commerce: 2006/11/11 All goods and services in the class are opposed, namely: Bar and restaurant services; Cocktail lounges
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	The registration of the mark in the application will give color of exclusive statutory rights to applicant in violation and derogation of the prior and superior rights of opposer.

Marks Cited by Opposer as Basis for Opposition

U.S. Application	86402371	Application Date	09/22/2014
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No.			
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HOTEL EDISON		
Design Mark	<p style="text-align: center;">HOTEL EDISON</p>		
Description of Mark	NONE		
Goods/Services	Class 043. First use: First Use: 1969/00/00 First Use In Commerce: 1969/00/00 Hotel services		

U.S. Application No.	86402425	Application Date	09/22/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EDISON GREEN ROOM		
Design Mark	<p style="text-align: center;">EDISON GREEN ROOM</p>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Dinner theaters; Entertainment in the nature of dance performances; Entertainment in the nature of theater productions; Entertainment services in the nature of live musical performances; Presentation of live show performances Class 043. First use: First Use: 0 First Use In Commerce: 0 Bar services; Restaurant services		

U.S. Application No.	86402445	Application Date	09/22/2014
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EDISON DINER		

Design Mark	EDISON DINER
Description of Mark	NONE
Goods/Services	Class 043. First use: First Use: 0 First Use In Commerce: 0 Bar services; Restaurant services

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	CAFE EDISON		
Goods/Services	Restaurant services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	EDISON BALLROOM		
Goods/Services	Entertainment in the nature of dance performances; Entertainment services in the nature of live musical performances; Presentation of live show performances Bar services; Restaurant services		

Related Proceedings	92060466
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Attachments	86402371#TMSN.png(bytes) 86402425#TMSN.png(bytes) 86402445#TMSN.png(bytes) Notice of Opposition to THE EDISON word mark app 86287975 4-17-2015.pdf(54276 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	/Ralph Gaboury/
Name	Ralph N. Gaboury, Esq.
Date	04/17/2015

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

In the matter of trademark registration App. Ser. No. 86287975

For the mark: THE EDISON

Date of application: May 21, 2014

Date of publication: October 21, 2014

EDISON MANAGEMENT CO., L.L.C.,

Opposer,

v.

KINETESCAPE HOLDINGS, LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Edison Management Co., L.L.C. (“EMC” or “Opposer”), a New York limited liability company, with an address at c/o Triumph Hospitality, LLC, 1271 Avenue of the Americas, 39th Floor, New York, NY 10020, will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same in its entirety. To the best of Opposer’s knowledge, the name and address of the current owner of the application is Kinetescape Holdings, LLC, 108 W. Second Street, Suite 101, Los Angeles, CA 90012 (“Kinetescape” or “Applicant”).

The grounds for opposition are as follows:

1. For many decades, EMC and its predecessors-in-interest have operated the HOTEL EDISON located near Times Square in New York City at 228 West 47th Street. Thomas Edison himself turned on the lights for the first time at the HOTEL EDISON during its grand opening in 1931.

2. In connection with its hotel services, EMC has also offered restaurant and bar services co-branded with its HOTEL EDISON service mark. For many decades, EMC has used or licensed the use of EDISON-based marks in connection with the offering of restaurant services and bar services at the hotel, including the CAFE EDISON since at least 1985, along with THE EDISON DINER, THE EDISON GREEN ROOM, and the EDISON BALLROOM (collectively, the HOTEL EDISON and other EDISON-based marks owned and used by EMC are referred to hereafter as the “EDISON Marks”).

3. EMC has invested substantial monetary and other resources in the EDISON Marks, which through advertising and promotion has resulted in tremendous value and recognition of the EDISON Marks throughout the United States and the world. In fact, the HOTEL EDISON not only attracts tourists from around the world visiting New York City, but has also been featured in several Hollywood movie and television productions, including the feature films *The Godfather* (1972) and *Bullets Over Broadway* (1994). In 2002, for its fifth season premier, the producers of the television series *Sex and the City* filmed a scene at the hotel’s CAFE EDISON.

4. To protect the nationwide goodwill associated with EMC’s EDISON Marks, EMC has filed the following federal trademark registration applications for use in connection with hotel, restaurant and bar services in Class 043: App. Ser. No. 86402371 for HOTEL EDISON, App. Ser. No. 86402425 for EDISON GREEN ROOM, and App. Ser. No. 86402445 for EDISON DINER. EMC plans to file additional federal trademark registration applications in connection with the EDISON Marks, including additional applications for use of the marks in connection with hotel, restaurant and bar services in Class 043.

5. Notwithstanding Opposer's preexisting rights in and to the EDISON Marks, on May 21, 2014, decades after Opposer began using the EDISON Marks in commerce, Applicant filed its application for registration of THE EDISON, for use in connection with "Bar and restaurant services; Cocktail lounges" in class 043, alleging a date of first use in commerce of November 11, 2006. The Application was assigned Serial No. 86287975 (the "Opposed Application").

6. As discussed above, EMC uses the EDISON Marks in connection with restaurant and bar services identical to those listed in the Opposed Application, and has done so for decades prior to the date of first use alleged in the Opposed Application. In addition, from the beginning – use of the word EDISON for EMC's hotel has connoted a connection with Thomas Edison, who is widely credited with inventing the first commercially viable electric light bulb. As discussed above, Thomas Edison himself turned on the lights at the HOTEL EDISON for the first time in 1931. The Opposed Application connotes the same connection with Thomas Edison, especially because it will be used in conjunction with the light bulb design mark in Reg. No. 3721237, also owned by Applicant and listed as a related property on the application (the "Applicant's Light Bulb Design"). Applicant's Light Bulb Design features an image of a vintage-style light bulb – drawn to be reminiscent of light bulbs from the early 20th Century. As such, Applicant's use of THE EDISON in connection with the same restaurant and bar services offered by EMC for decades, is likely to cause confusion, to the damage of EMC.

7. Applicant's use of THE EDISON, as depicted in the Application, in connection with the services listed in the Application suggests that Applicant is trading deceptively off the valuable goodwill that Opposer has developed in its EDISON Marks. Accordingly, Opposer will be damaged by registration of the mark in the Application because consumers are and will be

likely to believe, falsely, that Applicant's services are authorized, sponsored or approved by Opposer or that Opposer is otherwise affiliated or connected with Applicant, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

8. Applicant's use of THE EDISON as depicted in the Opposed Application has and will continue to damage Opposer because Applicant's use is confusingly similar to EMC's EDISON Marks being used on identical and closely related services. As such, Applicant's use of THE EDISON as depicted in the Opposed Application is likely to cause confusion, deception, and/or mistake among the consuming public in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

9. Opposer will be further damaged by the Opposed Application because the registration will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, as Opposer has and will be damaged by the Opposed Application, Opposer respectfully requests that the Opposed Application be denied. Submitted herewith is the required filing fee to cover the filing of this Notice of Opposition.

Dated: April 17, 2015



Ralph N. Gaboury

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SHAKARCHY LLP

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