

ESTTA Tracking number: **ESTTA695780**

Filing date: **09/14/2015**

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	What to Expect, LLC
Granted to Date of previous extension	10/07/2015
Address	511 South Arden Boulevard Los Angeles, CA 90020 UNITED STATES

Attorney information	Tamara F. Carmichael LOEB & LOEB LLP 345 Park Avenue New York, NY 10154 UNITED STATES chdoCKET@loeb.com, tcarmichael@loeb.com, aprovencio@loeb.com Phone:212-407-4000
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**Applicant Information**

Application No	86517551	Publication date	06/09/2015
Opposition Filing Date	09/14/2015	Opposition Period Ends	10/07/2015
Applicant	Allard, James C 7655 79th Ave SE Seattle, WA 98040 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Series of non-fiction books in the field of aging and growing old, including issues such as one's financial, health, family, marriage, insurance, and communityengagement situations
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**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

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

U.S. Registration No.	2260967	Application Date	05/19/1998
Registration Date	07/13/1999	Foreign Priority	NONE

		Date	
Word Mark	WHAT TO EXPECT		
Design Mark	<b>WHAT TO EXPECT</b>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1984/00/00 First Use In Commerce: 1984/00/00 SERIES OF BOOKS DEALING WITH PREGNANCY, PARENTING, CHILDREN, INFANTS AND CHILD DEVELOPMENT ISSUES		

U.S. Registration No.	2419604	Application Date	04/28/1998
Registration Date	01/09/2001	Foreign Priority Date	NONE
Word Mark	WHAT TO EXPECT KIDS		
Design Mark	<b>WHAT TO EXPECT KIDS</b>		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/05/31 First Use In Commerce: 2000/05/31 SERIES OF NON-FICTION BOOKS DEALING WITH PARENTING, CHILDREN, INFANTS AND CHILD DEVELOPMENT		

U.S. Application No.	85706946	Application Date	08/17/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WHAT TO EXPECT		
Design Mark	<b>WHAT TO EXPECT</b>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2007/12/00 First Use In Commerce: 2007/12/00		

	<p>Electronic publications, namely, books featuring pregnancy, parenting, children, infants and child development issues recorded on computer media</p> <p>Class 038. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00          Providing an online forum, online chat rooms and electronic bulletin boards for transmission of messages among users in the field of pregnancy, parenting, children, infants and child development issues</p> <p>Class 041. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00          (Based on Use in Commerce) Educational and entertainment services, namely, providing a website featuring information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; online journals, namely, blogs in the field of pregnancy, parenting, children, infants and child development issues; (Based on Intent to Use) entertainment services, namely, an on-going television program featuring topics relating to pregnancy, parenting, children, infants and child development issues; entertainment services, namely, production of movies featuring topics relating to pregnancy, parenting, children, infants and child development issues; educational and entertainment services, namely, providing a website featuring non-downloadable videos in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing a website featuring physical fitness or educational counseling information in the area of child development issues; providing information and news in the field of physical fitness or educational counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of physical fitness or educational counseling information in the area of child development issues</p> <p>Class 044. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00          Providing a website featuring health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing information and news in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring non-downloadable videos in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring health and psychological counseling information in the area of child development issues; providing information and news in the field of health and psychological counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of health and psychological counseling information in the area of child development issues</p> <p>Class 045. First use: First Use: 2005/04/00 First Use In Commerce: 2005/04/00          Providing a website featuring emotional and spiritual counseling information in the area of child development issues; providing information and news in the field of emotional and spiritual counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of emotional and spiritual counseling information in the area of child development issues</p>
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U.S. Application No.	85706954	Application Date	08/17/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WHAT TO EXPECT JUNIOR		

Design Mark	<p style="text-align: center;"><b>WHAT TO EXPECT JUNIOR</b></p>
Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Electronic publications, namely, books featuring pregnancy, parenting, children, infants and child development issues recorded on computer media</p> <p>Class 016. First use: First Use: 0 First Use In Commerce: 0 Series of books featuring pregnancy, parenting, children, infants and child development issues</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Providing an online forum, online chat rooms and electronic bulletin boards for transmission of messages among users in the field of pregnancy, parenting, children, infants and child development issues</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 educational and entertainment services, namely, providing a website featuring information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; on-line journals, namely, blogs in the field of pregnancy, parenting, children, infants and child development issues; entertainment services, namely, an on-going television program featuring topics relating to pregnancy, parenting, children, infants and child development issues; entertainment services, namely, production of movies featuring topics relating to pregnancy, parenting, children, infants and child development issues; educational and entertainment services, namely, providing a website featuring non-downloadable videos in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing a website featuring physical fitness or educational counseling information in the area of child development issues; providing information and news in the field of physical fitness or educational counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of physical fitness or educational counseling information in the area of child development issues</p> <p>Class 044. First use: First Use: 0 First Use In Commerce: 0 providing a website featuring health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing information and news in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring non-downloadable videos in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring health and psychological counseling information in the area of child development issues; providing information and news in the field of health and psychological counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of health and psychological counseling information in the area of child development issues</p>

	<p>ment issues</p> <p>Class 045. First use: First Use: 0 First Use In Commerce: 0</p> <p>providing a website featuring emotional and spiritual counseling information in the area of child development issues; providing information and news in the field of emotional and spiritual counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of emotional and spiritual counseling information in the area of child development issues</p>
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Attachments	<p>75488025#TMSN.png( bytes )</p> <p>75475654#TMSN.png( bytes )</p> <p>85706946#TMSN.png( bytes )</p> <p>85706954#TMSN.png( bytes )</p> <p>Not of Opposition 86517551 WHAT TO EXPECT WHEN YOU'RE AGING.pdf(25246 bytes )</p>
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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	/Tamara F. Carmichael/
Name	Tamara F. Carmichael
Date	09/14/2015

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

**In the Matter of Application Serial No. 86/517,551 for the Mark:  
WHAT TO EXPECT WHEN YOU'RE AGING  
Published in the *Official Gazette* on June 9, 2015**

WHAT TO EXPECT LLC,	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	
JAMES C. ALLARD,	)	
Applicant.	)	
_____	)	

**NOTICE OF OPPOSITION**

Opposer, What To Expect LLC (“Opposer”), a Delaware limited liability company, located and doing business at 511 South Arden Boulevard Los Angeles California 90020, believes it will be damaged by the registration of the trademark WHAT TO EXPECT WHEN YOU’RE AGING in International Class 16 in Application Serial No. 86/517,551, filed by James C. Allard (“Applicant”), and hereby opposes the same.

As grounds for this opposition, Opposer alleges:

1. Opposer owns a series of books, as well as online materials and other resources dealing with pregnancy, parenting, children, infants and child development issues under the WHAT TO EXPECT trademark, including the world famous best seller “What To Expect When You’re Expecting”, which has been in publication since 1984.

2. Since long prior to the filing of Applicant’s Application Serial No. 86/517,551, Opposer has been and is using “WHAT TO EXPECT”, in addition to other marks incorporating “WHAT TO EXPECT”, as a trade name, service mark, and/or trademark for a series of books and related goods and services (the “WHAT TO EXPECT Marks”).

3. Opposer is the owner of a number famous WHAT TO EXPECT marks, including an incontestable trademark registration for the mark WHAT TO EXPECT (U.S. Trademark Reg. No. 2,260,967) in Class 16 for a series of books dealing with pregnancy, parenting, children, infants and child development, which is evidence of our client’s exclusive right to use this mark in commerce.

4. Opposer owns registrations and applications for its WHAT TO EXPECT Marks with the United States Patent and Trademark Office (“PTO”), including, but not limited to:

MARK	REG. OR APP. #	GOODS/SERVICES
WHAT TO EXPECT	2,260,967	IC 016: series of books dealing with pregnancy, parenting, children, infants and child development issues
WHAT TO EXPECT KIDS	2,419,604	IC 016: series of non-fiction books dealing with parenting, children, infants and child development
WHAT TO EXPECT	85/706,946  Allowed 04/28/2015	<p>IC 009: Electronic publications, namely, books featuring pregnancy, parenting, children, infants and child development issues recorded on computer media.</p> <p>IC 038: Providing an online forum, online chat rooms and electronic bulletin boards for transmission of messages among users in the field of pregnancy, parenting, children, infants and child development issues.</p> <p>IC 041: Educational and entertainment services, namely, providing a website featuring information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; on-line journals, namely, blogs in the field of pregnancy, parenting, children, infants and child development issues; entertainment services, namely, an on-going television program featuring topics relating to pregnancy, parenting, children, infants and child development issues; entertainment services, namely, production of movies featuring topics relating to pregnancy, parenting, children, infants and child development issues; educational and entertainment services, namely, providing a website featuring non-downloadable videos in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing a website featuring physical fitness or educational counseling information in the area of child development issues;</p>

MARK	REG. OR APP. #	GOODS/SERVICES
		<p>providing information and news in the field of physical fitness or educational counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of physical fitness or educational counseling information in the area of child development issues.</p> <p>IC 044: Providing a website featuring health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing information and news in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring non-downloadable videos in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring health and psychological counseling information in the area of child development issues; providing information and news in the field of health and psychological counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of health and psychological counseling information in the area of child development issues.</p> <p>IC 045: Providing a website featuring emotional and spiritual counseling information in the area of child development issues; providing information and news in the field of emotional and spiritual counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of emotional and spiritual counseling information in the area of child development issues.</p>
WHAT TO EXPECT JUNIOR	85/706,954  Allowed 07/01/2014	<p>IC 009: Electronic publications, namely, books featuring pregnancy, parenting, children, infants and child development issues recorded on computer media</p> <p>IC 016: Series of books featuring pregnancy, parenting, children, infants and child development issues</p> <p>IC 038: Providing an online forum, online chat rooms and electronic bulletin boards for transmission of messages among users in the field of pregnancy, parenting, children, infants and child development issues</p> <p>IC 041: educational and entertainment services, namely, providing a website featuring information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing information in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children;</p>

MARK	REG. OR APP. #	GOODS/SERVICES
		<p>on-line journals, namely, blogs in the field of pregnancy, parenting, children, infants and child development issues; entertainment services, namely, an on-going television program featuring topics relating to pregnancy, parenting, children, infants and child development issues; entertainment services, namely, production of movies featuring topics relating to pregnancy, parenting, children, infants and child development issues; educational and entertainment services, namely, providing a website featuring non-downloadable videos in the field of exercise and fitness before and after pregnancy, parenting concerning education and entertainment of children; providing a website featuring physical fitness or educational counseling information in the area of child development issues; providing information and news in the field of physical fitness or educational counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of physical fitness or educational counseling information in the area of child development issues</p> <p>IC 044: providing a website featuring health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing information and news in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring non-downloadable videos in the field of health information related to pregnancy, parenting information concerning health of children and health information concerning infants; providing a website featuring health and psychological counseling information in the area of child development issues; providing information and news in the field of health and psychological counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of health and psychological counseling information in the area of child development issues</p> <p>IC 045: providing a website featuring emotional and spiritual counseling information in the area of child development issues; providing information and news in the field of emotional and spiritual counseling information in the area of child development issues; providing a website featuring non-downloadable videos in the field of emotional and spiritual counseling information in the area of child development issues</p>

Opposer's Registration Nos. 2,260,967 and 2,419,604 are valid, subsisting, and owned by Opposer, and are also incontestable pursuant to 15 U.S.C. §§1064 and 1115(b).

5. “What To Expect When You’re Expecting,” is a famous pregnancy guide, originally published in 1984. This publication is the longest-running book ever on the New York Times bestseller list, a record which currently stands at 703 weeks, and has been touted by USA Today as one of the “25 Most Influential Books” of the past twenty-five years. Read by 93% of expectant mothers, “What To Expect When You’re Expecting” has been translated into over 40 languages and has sold over 40 million copies worldwide.

6. Since 1984, Opposer and its predecessors-in-interest have added at least eighteen (18) additional publications to the WHAT TO EXPECT series, namely:

- (a) What to Eat When You’re Expecting (1986)
- (b) What to Expect: The First Year (1989)
- (c) What to Expect: The Toddler Years (1994)
- (d) What to Expect at Bedtime (2000)
- (e) What to Expect When the Babysitter Comes (2000)
- (f) What to Expect When You Go To The Doctor (2000)
- (g) What to Expect When the New Baby Comes Home (2001)
- (h) What to Expect at a Playdate (2001)
- (i) What to Expect: Pregnancy Planner (2002)
- (j) What to Expect When You Go To The Dentist (2002)
- (k) What to Expect: Baby-sitter’s Handbook (2003)
- (l) What to Expect at Preschool (2003)
- (m) What to Expect When Mommy's Having a Baby (2004)
- (n) What to Expect When You Use The Potty (2004)
- (o) What to Expect: Eating Well When You're Expecting (2005; follow-up to What to Eat When You're Expecting)
- (p) What to Expect: Pregnancy Journal & Organizer (2007)
- (q) What to Expect Before You’re Expecting (2009)
- (r) What to Expect: The Second Year (2011)

The series has sold over 40 million copies.

7. Opposer also operates a website at [www.whattoexpect.com](http://www.whattoexpect.com). Opposer’s website offers information on pregnancy, parenting and child development, as well as online forums and

interactive tools for parents, expecting parents and others. Opposer claims common law trademark rights in the mark WHAT TO EXPECT in connection with these services.

8. As a result of the extensive investment Opposer and its predecessors-in-interest have made in the WHAT TO EXPECT series and trademark, the relevant purchasing public has come to associate Opposer and its products and services with the WHAT TO EXPECT Marks. As a result, Opposer's WHAT TO EXPECT Marks have acquired distinctiveness in connection with these products and services.

9. Further, due to use by Opposer and its predecessors-in-interest since 1984 of the composite mark "WHAT TO EXPECT WHEN" in connection with the famous publication "What To Expect When You're Expecting" as well as subsequent books in Opposer's series of books (including, "What To Expect When The New Baby Comes Home," "What To Expect When Mommy's Expecting," "What To Expect When The Babysitter Comes," "What To Expect When You Go To The Doctor," and "What To Expect When You Go To The Dentist"), the relevant purchasing public has come to associate Opposer as the source of products and services offered for sale and sold under the "WHAT TO EXPECT WHEN" brand.

10. Due to the fame of the WHAT TO EXPECT Marks and book series, Opposer sold its film rights to Lionsgate, which released a film entitled "What To Expect When You're Expecting" based on Opposer's WHAT TO EXPECT book series in May 2012, which film starred such celebrities as Cameron Diaz, Jennifer Lopez, Anna Kendrick, Dennis Quaid and Chris Rock.

11. Opposer has not consented, and does not consent, to Applicant's use and/or registration of the mark "WHAT TO EXPECT WHEN YOU'RE AGING" in connection with a "series of non-fiction books in the field of aging and growing old, including issues such as one's

financial, health, family, marriage, insurance, and community engagement situations” in International Class 16 (“Applicant’s Goods”).

### **COUNT I – LIKELIHOOD OF CONFUSION**

12. Opposer realleges the allegations in Paragraphs 1 through 11.

13. Applicant’s use and/or registration of “WHAT TO EXPECT WHEN YOU’RE AGING” in connection with Applicant’s Goods would be likely to cause confusion, mistake, and/or deception in that consumers are likely to believe that Applicant’s Goods are Opposer’s goods, or the goods of a person or company that is sponsored, authorized or licensed by, or in some other way legitimately connected with, Opposer.

### **COUNT II – DILUTION**

14. Opposer realleges the allegations of Paragraphs 1 through 13.

15. Prior to Applicant’s filing date, Opposer’s WHAT TO EXPECT Marks became distinctive and famous in accordance with 15 U.S.C. § 1125(c).

16. Applicant’s use and/or registration of “WHAT TO EXPECT WHEN YOU’RE AGING” in connection with Applicant’s Goods is likely to cause dilution of Opposer’s famous WHAT TO EXPECT Marks.

### **COUNT III – FALSE ASSOCIATION**

17. Opposer realleges the allegations of Paragraphs 1 through 16.

18. Applicant’s use and/or registration of “WHAT TO EXPECT WHEN YOU’RE AGING” in connection with Applicant’s Goods falsely suggest a connection with Opposer and Opposer’s WHAT TO EXPECT family of marks and related goods and services in violation of Section 2(a) of the Trademark Act.

**WHEREFORE**, Opposer respectfully requests that this opposition be sustained and that Application Serial No. 86/517,551 be denied registration.

Please debit our Deposit Account No. 502547 for the filing fee and for any additional necessary fees.

Please address all correspondence to Tamara Carmichael, Esq., Loeb & Loeb LLP, 345 Park Avenue, New York, New York, 10154.

Date: New York, New York  
September 14, 2015

LOEB & LOEB LLP

By: /s/ Tamara Carmichael  
Tamara Carmichael  
Sara J. Crisafulli  
345 Park Avenue  
New York, New York 10154  
Telephone: (212) 407-4000  
Facsimile: (212) 407-4990

*Attorneys for Opposer  
What to Expect LLC*

**CERTIFICATE OF SERVICE**

I, Angela Ocasio Provencio, hereby certify that a copy of this **NOTICE OF OPPOSITION** has been served upon Applicant:

JAMES C. ALLARD  
7655 79TH AVE SE # 7655  
MERCER ISLAND, WASHINGTON 98040-5522

via first class mail, postage prepaid, on September 14, 2015.

/s/ Angela Ocasio Provencio

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