

ESTTA Tracking number: **ESTTA716478**

Filing date: **12/22/2015**

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	Alfred Club, Inc.
Granted to Date of previous extension	12/23/2015
Address	55 West 19th St. 4th Fl New York, NY 10011 UNITED STATES

Attorney information	Judd D. Lauter Cooley LLP 1299 Pennsylvania Ave. NW, Suite 700 Washington, DC 20004 UNITED STATES jlauter@cooley.com, jcullum@cooley.com, trademarks@cooley.com, gthunell@cooley.com Phone:202-728-7052
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Applicant Information

Application No	86395092	Publication date	08/25/2015
Opposition Filing Date	12/22/2015	Opposition Period Ends	12/23/2015
Applicant	Alfred Inc. 564 Church St. Toronto, Ontario, M4Y2E3 CANADA		

Goods/Services Affected by Opposition

Class 037. First Use: 2013/12/00 First Use In Commerce: 2013/12/00 All goods and services in the class are opposed, namely: Dry cleaning; Shoe repair; Shoe shining
Class 039. First Use: 2013/12/00 First Use In Commerce: 2013/12/00 All goods and services in the class are opposed, namely: Delivery of goods; Delivery of goods bymail order

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	86584363	Application Date	04/01/2015
Registration Date	NONE	Foreign Priority	10/06/2014

		Date	
Word Mark	ALFRED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2013/10/00 First Use In Commerce: 2013/11/20 Administering membership club programs in the field of home services outsourcing by curating service providers and vendors based on consumer needs and periodically arranging for delivery and implementation of home services; agency services for matching providers and customers of home services; staffing and placement services in the field of temporary household assistants; outsourcing services in the nature of arranging procurement of goods and services of others in the field of household management</p> <p>Class 039. First use: First Use: 2013/10/00 First Use In Commerce: 2013/11/20 Pick up, transport and delivery of personal property and goods; laundry pick-up and delivery services</p> <p>Class 045. First use: First Use: 2013/10/00 First Use In Commerce: 2013/11/20 Running errands for others; personal shopping for others; providing non-medical personal assistant services for others in the nature of planning, organizing, coordinating, arranging and assisting individuals to perform home services</p>		

U.S. Application No.	86584371	Application Date	04/01/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	HELLO ALFRED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable computer and mobile software for computers, mobile phones and handheld computers, for use in scheduling, arranging and coordinating home services</p>		

	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Administering membership club programs in the field of home services outsourcing by curating service providers and vendors based on consumer needs and periodically arranging for delivery and implementation of home services; agency services for matching providers and customers of home services; staffing and placement services in the field of temporary household assistants; outsourcing services in the nature of arranging procurement of goods and services of others in the field of household management</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0 Pick up, transport and delivery of personal property and goods; laundry pick-up and delivery services</p> <p>Class 045. First use: First Use: 0 First Use In Commerce: 0 Running errands for others; personal shopping for others; providing non-medical personal assistant services for others in the nature of planning, organizing, coordinating, arranging and assisting individuals to perform home services</p>
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U.S. Application No.	86584366	Application Date	04/01/2015
Registration Date	NONE	Foreign Priority Date	10/06/2014
Word Mark	ALFRED		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable computer and mobile software for computers, mobile phones and handheld computers, for use in scheduling, arranging and coordinating home services</p>		

Attachments	<p>86584363#TMSN.png(bytes) 86584371#TMSN.png(bytes) 86584366#TMSN.png(bytes) Notice of Opposition re ALFRED.pdf(115515 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	/Judd D. Lauter/
Name	Judd D. Lauter

Date	12/22/2015
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of application Serial No. 86/395,092
For the Trademark ALFRED (*stylized*)
Published in the Official Gazette on August 25, 2015

ALFRED CLUB, INC.,)	
)	
Opposer,)	
)	Opposition No.
v.)	
)	
ALFRED, INC.,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer Alfred Club, Inc. (“Alfred Club”), a Delaware limited liability company having its principal place of business at 55 West 19th St, 4th Fl, New York, New York 10011, believes that it will be damaged by the issuance of a registration for the mark ALFRED (*stylized*) (“Applicant’s Mark”), as applied for in Application Serial No. 86/395,092, filed on September 15, 2014 by Alfred, Inc., a Canadian corporation with a mailing address of 564 Church St., Toronto, Ontario Canada M4Y2E3 (“Applicant”).

As grounds for opposition, Alfred Club alleges that:

1. Alfred Club is a rapidly growing company which has developed an innovative approach to offering on-demand home services including, but not limited to, grocery shopping, house keeping, laundry pick-up and delivery, errand running, and personal shopping. The Alfred Club mobile app allows users to build a profile and subscription plan which facilitates their ability to accomplish a variety of household tasks via a dedicated manager. More than just a

delivery service, Alfred Club offers a broad range of services to users, including household chores, replacing supplies on an as-needed basis, and running errands. The Alfred Club managers call upon local businesses to obtain the goods and services requested by users and managers learn over time the preferences and needs of the users to which they are assigned, thereby offering additional convenience and value to users.

2. Since at least as early as November 20, 2013, and prior to Applicant's September 15, 2014 application filing date and December 2013 claimed first use date, Alfred Club has continuously used the mark ALFRED in U.S. interstate commerce in connection with its on-demand home services.

3. Alfred Club has also adopted and is actively using the mark HELLO ALFRED in U.S. interstate commerce in connection with its software and services.

4. Alfred Club has expended considerable effort and expense in developing its offering and promoting that offering under its ALFRED and HELLO ALFRED marks (together, the "ALFRED marks") and its user base has grown rapidly. Alfred Club has been the recipient of favorable press coverage and has been recognized for its innovative approach, including being awarded the 2014 San Francisco TechCrunch Disrupt award in September 2014. As a result, the ALFRED marks are widely recognized in the marketplace as indicators of the source of Alfred Club's high quality app and services and the marks symbolize the substantial and valuable goodwill Alfred Club has earned in the marketplace.

5. In addition to owning common law trademark rights in the ALFRED marks, Alfred Club owns the following pending U.S. trademark applications (collectively, the "ALFRED Filings"):

TRADEMARK	FILING INFORMATION	GOODS/SERVICES
ALFRED	<p>Filed: April 1, 2015</p> <p>Application No.: 86584363</p> <p>First Use Date: At least as early as Nov 20, 2013</p> <p>Priority Date: Oct 6, 2014</p>	<p>IC 035: Administering membership club programs in the field of home services outsourcing by curating service providers and vendors based on consumer needs and periodically arranging for delivery and implementation of home services; agency services for matching providers and customers of home services; staffing and placement services in the field of temporary household assistants; outsourcing services in the nature of arranging procurement of goods and services of others in the field of household management.</p> <p>IC 039: Pick up, transport and delivery of personal property and goods; laundry pick-up and delivery services.</p> <p>IC 045: Running errands for others; personal shopping for others; providing non-medical personal assistant services for others in the nature of planning, organizing, coordinating, arranging and assisting individuals to perform home services.</p>
ALFRED	<p>Filed: April 1, 2015</p> <p>Application No.: 86584366</p> <p>Priority Date: Oct 6, 2014</p>	<p>IC 009: Downloadable computer and mobile software for computers, mobile phones and handheld computers, for use in scheduling, arranging and coordinating home services</p>
HELLO ALFRED	<p>Filed: April 1, 2015</p> <p>Application No.: 86584371</p>	<p>IC 009: Downloadable computer and mobile software for computers, mobile phones and handheld computers, for use in scheduling, arranging and coordinating home services</p> <p>IC 035: Administering membership club programs in the field of home services outsourcing by curating service providers and vendors based on consumer needs and periodically arranging for delivery and implementation of home services; agency services for matching providers and customers of home services; staffing and placement services in the field of temporary household assistants; outsourcing services in the nature of arranging procurement of goods and services of others in the field of household management</p> <p>IC 039: Pick up, transport and delivery of personal property and goods; laundry pick-up and delivery services</p> <p>IC 045: Running errands for others; personal shopping for others; providing non-medical personal assistant services for others in the nature of planning, organizing, coordinating, arranging and assisting individuals to perform home services</p>

6. On September 15, 2014—just days after Alfred Club received the TechCrunch Disrupt award—Applicant filed use-based Application Serial No. 86/395,092 for the mark ALFRED (*stylized*) in connection with “dry cleaning; shoe repair; shoe shining” in Class 37 and “delivery of goods; delivery of goods by mail order” in Class 39 (the “ALFRED Stylized Application”).

7. In connection with filing the ALFRED Stylized Application, Applicant’s attorney of record, Matthew H. Swyers, submitted a sworn declaration dated September 15, 2014 to the United States Patent and Trademark Office (“PTO”) in which he attested that all statements in the ALFRED Stylized Application were believed to be true. The ALFRED Stylized Application stated that Applicant’s Mark was in use in United States commerce on or in connection with the claimed services as of December 2013.

8. On July 16, 2015, the PTO issued Office Actions against Alfred Club’s Application Serial Nos. 86/584,363 for ALFRED and 86/584,371 for HELLO ALFRED in which the ALFRED Stylized Application was cited as a potential obstacle to registration of the ALFRED marks in Class 39.

9. The ALFRED Stylized Application was published in the *Official Gazette* on August 25, 2015. On September 3, 2015, Alfred Club filed a Request for Extension of Time to Oppose which was granted, extending the time to oppose to December 23, 2015. This Opposition is timely filed.

**FIRST GROUND FOR OPPOSITION:
LIKELIHOOD OF CONFUSION**

10. Alfred Club incorporates by reference Paragraphs 1 through 9, inclusive, as if fully set forth herein.

11. Applicant’s Mark is identical to Alfred Club’s ALFRED mark in sight, sound,

meaning, and overall commercial impression.

12. The services Applicant alleges it offers under Applicant's Mark, as identified in the ALFRED Stylized Application, are identical and/or closely related to the services Alfred Club provides under its ALFRED mark. In addition, and upon information and belief, Applicant and Alfred Club offer their respective services through the same primary channel of trade, namely, the Internet and via downloadable mobile applications.

13. Alfred Club is not affiliated with or connected to Applicant or its services, nor has Alfred Club endorsed or sponsored Applicant or its services.

14. There is no issue as to priority of use. Alfred Club's first use date of the ALFRED mark predates Applicant's alleged first use date of December 2013 for its ALFRED mark.

15. If Applicant is permitted to register Applicant's Mark in connection with the services identified in the ALFRED Stylized Application, the consuming public will likely be confused or mistaken into believing the services Applicant provides either emanate from, or are endorsed, sponsored, or otherwise approved by Alfred Club because (i) the parties' marks are identical; (ii) the parties' services are overlapping and related; and (iii) the parties' offerings are made available in the same trade channels. Alfred Club has no control over the nature and quality of Applicant's services and any deficiency, objection, or fault found in connection with such services marketed under Applicant's Mark would necessarily reflect upon and harm the reputation that Alfred Club has established for the goods and services offered under its ALFRED mark.

16. Applicant's registration of Applicant's Mark will cause substantial harm to Alfred Club's prior existing, superior, and valuable rights in its ALFRED mark, and will interfere with

Alfred Club's enjoyment of those rights. As such, for the reasons set forth herein, registration of Applicant's Mark should be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

**SECOND GROUND FOR OPPOSITION:
FRAUD**

17. Alfred Club incorporates by reference Paragraphs 1 through 16 inclusive, as if fully set forth herein.

18. Alfred Club is informed and believes, and on that basis alleges, that Applicant had not used and was not using Applicant's Mark in U.S. commerce on or in connection with any of the services listed in the ALFRED Stylized Application at the time the Application was filed. On information and belief, to date Applicant has not used Applicant's Mark in U.S. commerce on or in connection with any of the services listed in the ALFRED Stylized Application.

19. On information and belief, the representations Applicant made to the PTO on September 15, 2014 regarding use of Applicant's Mark were false. On information and belief, Applicant knew that the representations were false.

20. On information and belief, Applicant's false statements were made with the intent to induce authorized agents of the PTO to grant a registration for Applicant's Mark, and reasonably relying on the truth of said false statements, the PTO has allowed the ALFRED Stylized Application to proceed to publication.

21. On information and belief, Applicant was aware of Alfred Club and its ALFRED mark at the time the ALFRED Stylized Application was filed. On information and belief, Applicant filed the ALFRED Stylized Application after learning of Alfred Club's success during the TechCrunch Disrupt conference in 2014. On information and belief, Applicant intentionally

misrepresented its use of its mark in the United States in order to claim priority of common law rights over those established by Alfred Club in its ALFRED mark.

22. In view of the above allegations, Applicant is not entitled to maintain the ALFRED Stylized Application since Applicant, on information and belief, committed fraud in the prosecution of the ALFRED Stylized Application.

23. If the ALFRED Stylized Application is not refused registration, Applicant will own the prima facie exclusive right to use Applicant's Mark in connection with services that overlap with Alfred Club's services offered or intended to be offered by Alfred Club under the ALFRED marks. The continued existence of the ALFRED Stylized Application is therefore causing damage and injury to Alfred Club by preventing Alfred Club from registering its ALFRED marks.

Wherefore, Alfred Club prays that this Opposition be sustained, and that Application Serial No. 86/395,092 be refused.

Respectfully submitted,

COOLEY LLP

Date: December 22, 2015

By: /Janet L. Cullum/
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Attorneys for Alfred Club, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on the date indicated below, a true and correct copy of this **Notice of Opposition** was placed in the United States Mail via First Class Mail, addressed to Applicant's counsel of record:

Matthew H. Swyers
344 Maple Ave., West, Suite 151
Vienna, VA 22180-5612

Date: December 22, 2015

/Judd D. Lauter/
Judd D. Lauter