

ESTTA Tracking number: **ESTTA724582**

Filing date: **02/03/2016**

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	Accentium Web Pvt Ltd
Granted to Date of previous extension	02/03/2016
Address	20 Rajpur Road Delhi, 110054 INDIA

Correspondence information	Vivek Pahwa CEO Accentium Web Pvt Ltd 21-C, Sector 18 Gurgaon, Har 122015 INDIA vivek@accentium.com Phone:+919811500700
----------------------------	---

Applicant Information

Application No	86634009	Publication date	10/06/2015
Opposition Filing Date	02/03/2016	Opposition Period Ends	02/03/2016
Applicant	PEOPLE INTERACTIVE (INDIA) PRIVATE LIMITED 2nd FLOOR, 205 MUMBAI MAHARASHTRA, 400018 INDIA		

Goods/Services Affected by Opposition

Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Matchmaking services that are done through websites, personal interaction, print media, television and other media; providing an online computer database for matchmaking purposes; and dating services
--

Grounds for Opposition

The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is generic	Trademark Act section 2(e)(1)
Other	Judicial Estoppel, Title 15 U.S.C Section 1069

Attachments	Opposition_Feb_3_2016.pdf(107651 bytes)
-------------	--

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/vivek pahwa/
Name	Vivek Pahwa
Date	02/03/2016

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

In the Matter of:
Serial No.: 86634009
Mark: SHAADI.COM
Filed on: May 19, 2015
Published on: October 6, 2015

ACCENTIUM WEB PRIVATE)	
LIMITED)	
)	
OPPOSER)	Opposition No: _____
)	
v.)	
)	
PEOPLE INTERACTIVE (INDIA))	
PRIVATE LIMITED)	
)	
APPLICANT)	
)	

NOTICE OF OPPOSITION

Opposer, Accentium Web Private Limited, having a place of business at 20 Rajpur Road, Delhi 110054, India (hereinafter “Opposer”), believes that it will be damaged by registration of the mark “SHAADI.COM” (serial number: 86634009), and hereby opposes registration of the same.

Opposer owns the domain name, “secondshaadi.com”, which it registered on January 5, 2006, and which it uses to operate a website that offers matrimonial, matchmaking, and dating services. Opposer believes that registration of the mark “SHAADI.COM” will grant the applicant, People Interactive (India) Private Limited (hereinafter “Applicant”), a corporation of India, having a place of business at Shiv-e-Numh Building, 2nd Floor, 205 Dr. Annie Besant Road, Worli, Mumbai 400018, India, the exclusive right to use the descriptive and generic term “shaadi” in connection with matrimonial, matchmaking, and dating services, and will unfairly expose Opposer to future claims of trademark infringement. As a result, Opposer has a personal interest in the outcome of this proceeding beyond that of the general public, and thus has standing.

The grounds for opposition are as follows:

Descriptiveness Refusal - 2(e)(1)

1. Applicant previously attempted to register the mark "SHAADI.COM" in 2004 (serial number: 78389691) under International Classes 42 and 45. Applicant described its goods and services as follows: Marriage bureaus, Marriage counselling, Dating services, Matrimonial services for match making through websites, personal interaction, print media, television and other media, Providing an on-line computer database in the fields of matrimonial services, Dating Services & marriage counselling.
2. In an Office Action Outgoing document dated October 20, 2004 (serial number: 78389691), the examining attorney issued a Substantive Refusal stating, "The examining attorney refuses registration on the Principal Register because the proposed mark merely describes a feature and characteristic of the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.*" The examining attorney went on to say, "This mark immediately names the purpose and a feature and characteristic of the services, namely that the applicant features weddings or marriages. . . . Accordingly, the mark is refused registration on the Principal Register under Section 2(e)(1)."
3. In its Response to Office Action, dated April 19, 2005 (serial number: 78389691), Applicant argued that the mark "SHAADI.COM" was not merely descriptive, but rather "suggestive of the services identified thereby." Applicant also deleted Class 42 from its application.
4. In an Office Action Outgoing, dated May 15, 2005 (serial number: 78389691), the examining attorney issued a Final Substantive Refusal stating, "The examining attorney refused registration on the Principal Register because the proposed mark merely describes a feature and characteristic of the services. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1); TMEP section 1209 *et seq.* . . . The trademark-examining attorney has considered applicant's arguments carefully and found them unpersuasive for the reason(s) below. The test is not whether from consideration of only the mark, one could determine or speculate what the good or services are. Instead, the issue is whether the mark would inform one who knows what the goods are about a particular feature, characteristic, purpose or intended use of the goods. A term need not describe all of the purposes, functions, characteristics or features of the goods and/or services to be merely descriptive. For the purpose of a

Section 2(e)(1) analysis, it is sufficient that the term describe only one attribute of the goods and/or services to be found merely descriptive. . . . Marriage bureaus and marriage services provide weddings. Please see the attached evidence from Google that shows that marriage bureaus and marriage services feature weddings. Also enclosed are the definitions of these services that indicate that they feature weddings and marriages. . . .”

5. In Applicant's Response to Office Action, dated November 14, 2005 (serial number: 78389691), it stated “Applicant hereby modifies its description of services as stated herein to remove any reference to matrimonial and/or marriage services. Applicant requests that the application proceed to publication. Alternatively, if the Examining Attorney still refuses registration of the mark on the Principal Register after the modification of the services description proposed herein, the Applicant requests that the Application be amended to seek registration of the mark on the Supplemental Register.” Applicant went on to propose a modified description of goods and services for Class 45 as follows: Matchmaking services that are done through websites, personal interaction, print media, television and other media; providing an online computer database for matchmaking purposes; and dating services.

6. According to the Trademark Status & Document Retrieval (TSDR) page assigned to Applicant's mark, “SHAADI.COM”, serial number: 78389691, the application was amended from the Principal to the Supplemental Register on November 16, 2005.

7. On November 18, 2005, the examining attorney issued a Notice of Suspension (serial number: 78389691), which stated, “Action on this application is suspended pending receipt of a true copy, a photocopy, a certification, or a certified copy of a foreign registration from the applicant's country of origin.”

8. On December 15, 2006, Applicant's application (serial number: 78389691) was declared abandoned.

9. Amendment of the application (serial number: 78389691) from the Principal to the Supplemental Register on November 16, 2005, and the examining attorney's issuance of a Notice of Suspension on November 18, 2005, despite Applicant's modification to its goods and services in its November 14, 2005 response, which consisted of the removal of any reference to matrimonial and/or marriage services, clearly indicates that the examining attorney determined that the mark “SHAADI.COM” remained merely descriptive of the modified

description of goods and services proposed by the Applicant, and was thus ineligible to be registered on the Principal Register.

10. Applicant's current application for International Class 45 (serial number: 86634009) claims the following goods and services: Matchmaking services that are done through websites, personal interaction, print media, television and other media; providing an online computer database for matchmaking purposes; and dating services. This description is EXACTLY the same as Applicant's final modification to its goods and services in its Response to Office Action dated November 14, 2005 (serial number: 78389691), which was refused registration on the Principal Register.

11. Since the Applicant is currently applying to register the same mark "SHAADI.COM" (serial number: 86634009) under the same class, using an identical description of goods and services as that which it proposed in its final response, dated November 14, 2005, in the matter of its 2004 application (serial number: 78389691), which was substantively refused registration on the Principal Register, Applicant should again be denied registration on the same grounds, namely that the mark is merely descriptive of the goods and services being offered. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

Descriptiveness Refusal - 2(e)(1)

12. According to Google Translate (translate.google.com), the English translation of the Hindi word "shaadi" is marriage. Google also lists the following words as translations of the Hindi word "shaadi": wedding, nuptials, nuptial, matrimony, wedlock, match, splice.

13. According to the Hindi-English dictionary Shabdkhosh (shabdkhosh.com), the English translations of the Hindi word "shaadi" are as follows: marriage, matrimony, nuptials, wedding, nuptial, match, splice, wedlock.

14. In the Office Action Outgoing document dated October 20, 2004 in regards to Applicant's 2004 application for the mark "SHAADI.COM" (serial number: 78389691), the examining attorney suggested, "The applicant may adopt the following: SHAADI translates to wedding or marriage."

15. Applicant recently filed a Petition for Cancellation, dated November 30, 2015 (proceeding number: 92062719), directed against Shadi.com division of Ampak Billing Corp., in a attempt to cancel registration numbers 3374700 and 3396843. In its Petition for Cancellation, Paragraph 8, Applicant stated, “Shaadi’ is the Hindi word for marriage or wedding.”

16. According to Oxford Dictionary (oxforddictionaries.com), the term “matchmaking” refers to “The arranging of marriages or initiation of romantic relationships between others.”

17. According to Wiktionary (wiktionary.com), the term “matchmaking” refers to “An attempt to make two people romantically interested in each other, especially an attempt to set up a date between people or to arrange a marriage.”

18. According to Merriam-Webster (merriam-webster.com), the term “matchmaker” refers to “one that arranges a match” or “one who tries to bring two unmarried individuals together in an attempt to promote a marriage.”

19. Applicant's description of goods and services for the mark “SHAADI.COM” in its current application (serial number: 86634009) is as follows: Matchmaking services that are done through websites, personal interaction, print media, television and other media; providing an online computer database for matchmaking purposes; and dating services.

20. Since the most prominent portion of Applicant's mark “SHAADI.COM” is “SHAADI”, which means marriage or wedding or matrimony, it merely describes a purpose or feature or characteristic of the services listed in the application (serial number: 86634009).

21. Consequently, Applicant's mark is merely descriptive for the services being offered by the Applicant and thus ineligible for registration on the Principal Register. Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1).

Genericness Refusal - TMEP Section 1209.01(c)

22. Opposer repeats and realleges the allegations contained in Paragraphs 12 through 15 of this Opposition as if fully set forth herein.

23. In Paragraph 3 of Applicant's recently filed Petition for Cancellation, dated November 30, 2015 (proceeding number: 92062719), against Shadi.com division of Ampak Billing Corp., regarding cancellation of registration numbers 3374700 and 3396843, Applicant claimed it was the “owner of the well-known 'Shaadi.com' website, one of the oldest and largest matrimonial businesses in the world.” Applicant went on to claim that “Shaadi.com has redefined the way millions of people meet for marriage. . . .” In Paragraph 5 of the same Petition for Cancellation, Applicant claimed it was “the first to provide online matrimonial/matchmaking services in India under the mark SHAADI.COM. . . .” Applicant goes on to claim, “It has matched more than 3.2 million members and has more than 30 million users registered for both online and offline matrimonial services.” In Paragraph 6 of the same Petition for Cancellation, Applicant claims it “openly, continuously, and extensively used the SHAADI.COM mark and domain name in connection with matrimonial/matchmaking services. . . .”

24. Since, according to Applicant's own claims, it is utilizing the mark “SHAADI.COM” in connection with matrimonial services AND the most prominent portion of that mark, which is “SHAADI”, literally translates to marriage or wedding or matrimony, Applicant's mark is generic for the services described in its current application (serial number: 86634009) and thus ineligible for registration on both the Principal and Supplemental Registers. TMEP Section 1209.01(c)

Descriptive Refusal - 2(e)(1) and Judicial Estoppel - 15 U.S.C. Section 1069

25. The doctrine of judicial estoppel prevents a party from asserting a factual position that is directly contrary to another taken in the same or a previous judicial proceeding (Rand G. Boyers, *Precluding Inconsistent Statements: The Doctrine of Judicial Estoppel*, 80 Nw. U. L. REV. 1244, 1269 (1986)).

26. In a prior application by Applicant for an almost identical mark, “SHAADI”, serial number 78133242, in response to a Motion to Compel (opposition number: 91168260), dated September 7, 2006, filed

by Shadi.com division of Ampak Billing Corp., Applicant was penalized by the Board in an order dated February 1, 2007, for Applicant's "failure to file a timely response to the requests for admissions." In that same order the Board granted that opposer's requests to have its admissions admitted without contest.

27. A subset of the admissions that Applicant was forced to admit, listed in the Motion to Compel (opposition number: 91168260), is listed below:

Matrimonial service organizations have the right to use the term "shaadi" descriptively in connection with the offering of matrimonial services.

Matchmaking service organizations have the right to use the term "shaadi" descriptively in connection with the offering of matchmaking services.

Dating service organizations have the right to use the term "shaadi" descriptively in connection with the offering of dating services.

28. Based on these admissions, Applicant is estopped from claiming that the term "shaadi" is NOT descriptive in connection with the offering of matrimonial, matchmaking, and dating services.

Consequently, Applicant should be denied registration of the mark "SHAADI.COM" since by Applicant's own admission, the term "SHAADI", which is the most prominent portion of the mark "SHAADI.COM" (serial number: 86634009), can be used descriptively in connection with Applicant's services. 15 U.S.C. Section 1069.

Wherefore, Opposer respectfully requests that this Opposition be granted and Applicant's mark be denied under any or all the causes of action stated herewith.

Date: February 3, 2016

Respectfully submitted,

By: /Vivek Pahwa/
Vivek Pahwa, CEO
Accentium Web Private Limited
20 Rajpur Road, Delhi 110054
India
Email: vivek@accentium.com

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of the foregoing NOTICE OF OPPOSITION was mailed this 3rd day of February 2016 by overnight courier to the following correspondence address for Applicant:

NARESH KILARU
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DISTRICT OF COLUMBIA 20001-4413
UNITED STATES
Email: docketing@finnegan.com

By: /Vivek Pahwa/
Vivek Pahwa