

ESTTA Tracking number: **ESTTA732463**

Filing date: **03/09/2016**

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	Partners In Leadership IP, LLC
Granted to Date of previous extension	03/12/2016
Address	27555 Ynez Road, Suite 300 Temecula, CA 92591 UNITED STATES

Attorney information	Jessica C. Sganga Knobbe, Martens, Olson & Bear, LLP 2040 Main Street, 14th Floor Irvine, CA 92614 UNITED STATES efiling@knobbe.com Phone:(949) 760-0404
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Applicant Information

Application No	86723664	Publication date	01/12/2016
Opposition Filing Date	03/09/2016	Opposition Period Ends	03/12/2016
Applicant	Atomic Learning, Inc. 15088 22nd Ave NE Little Falls, MN 56345 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing online training courses in the field of personal and professional development and the distribution of digitalcourse material in connection therewithto a defined group of users
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing temporary use of online non-downloadable learning management softwarethat allows users to administer courses, manage course material and communicatewith a defined group of users

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2551878	Application Date	05/12/2000
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Registration Date	03/26/2002	Foreign Priority Date	NONE
Word Mark	SEE IT, OWN IT, SOLVE IT, DO IT		
Design Mark	SEE IT, OWN IT, SOLVE IT, DO IT		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 Business consulting services; business management services Class 041. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 Conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations		

U.S. Registration No.	2580901	Application Date	05/12/2000
Registration Date	06/18/2002	Foreign Priority Date	NONE
Word Mark	SEE IT		
Design Mark	SEE IT		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 Business consulting services; business management services Class 041. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations		

U.S. Registration No.	2551877	Application Date	05/12/2000
Registration Date	03/26/2002	Foreign Priority Date	NONE
Word Mark	DO IT		

Design Mark	DO IT
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 BUSINESS CONSULTING SERVICES; BUSINESS MANAGEMENT SERVICES Class 041. First use: First Use: 1990/01/17 First Use In Commerce: 1990/01/17 CONDUCTING SEMINARS, WORKSHOPS, BUSINESS OPERATION TRAINING, AND ONE-ON-ONE TRAINING IN THE FIELDS OF BUSINESS MANAGEMENT AND BUSINESS OPERATIONS

Attachments	76047454#TMSN.png(bytes) 76047544#TMSN.png(bytes) 76047365#TMSN.png(bytes) Notice of Opposition.pdf(1222198 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	/jessica c. sganga/
Name	Jessica C. Sganga
Date	03/09/2016

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

Partners in Leadership IP, LLC,

Opposer,

v.

Atomic Learning, Inc.,

Applicant.

Application No. 86/723,664

Opposition No.

I hereby certify that this correspondence and all marked attachments are being transmitted by electronic mail to the United States Patent and Trademark Office at <http://www.uspto.gov> on

March 9, 2016

(Date)



Jessica Sganga

NOTICE OF OPPOSITION

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Partners in Leadership IP, LLC, a Nevada Limited Liability Company, located and doing business at 27555 Ynez Road, Suite 300, Temecula, California 92591 (“Opposer”), believes that it will be damaged by the registration of the mark shown in Application Serial No. 86/723,664 (“Application”), and hereby opposes the same.

A description of the Application is as follows:

Mark:	LEARNIT. DOIT. SEEIT. PROVEIT.
Serial No.:	86/723,664
Filing Date	August 13, 2015
Publication Date:	January 12, 2016
Services:	Class 41: Providing online training courses in the field of personal and professional development and the distribution of digital course material in connection therewith to a defined group of users Class 42: Providing temporary use of online non-downloadable learning management software that allows users to administer courses, manage course material and communicate with a defined group of users
Filing Basis:	Intent to use

Owner: Atomic Learning, Inc. (“Applicant”)

As grounds for opposition, it is alleged that:

1. For many years prior to filing date of the Application, Opposer has and continues to offer business consulting services, business management services, and business training services (“Opposer’s Services”).

2. Since at least as early as 1990, Opposer has and continues to offer Opposer’s Services under its “SEE IT, OWN IT, SOLVE IT, DO IT ®, SEE IT®, and DO IT® marks (“Opposer’s Marks”). As a result of its investment in Opposer’s Marks, and the popularity and widespread commercial success of Opposer’s Services offered in connection with Opposer’s Marks, Opposer has developed a tremendous amount of goodwill and consumer recognition in Opposer’s Marks.

3. To protect its valuable intellectual property rights, Opposer owns the following U.S. trademark registrations for Opposer’s Marks (collectively, “Opposer’s Registrations”).

4. Opposer is the owner of and relies on incontestable U.S. Trademark Registration No. 2,551,878 (the “’878 Registration”) for the mark SEE IT, OWN IT, SOLVE IT, DO IT® for “Business consulting services; business management services” in International Class 35 and “Conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations” in International Class 41, which registered on the Principal Register on March 26, 2002. Said registration is based on an application filed in the United States Patent and Trademark Office (“PTO”) on May 12, 2000 and claims a date of first use of January 17, 1990. The registration date, filing date, and first use date of Opposer’s mark are all long before the filing date of Applicant’s Application. True and correct copies of the specifics of the ’878 Registration obtained from the PTO’s TESS and Assignment databases are attached hereto as Exhibit 1 and made of record.

5. Opposer is the owner of and relies on incontestable U.S. Trademark Registration No. 2,580,901 (the “’901 Registration”) for the mark SEE IT® for “Business consulting services; business management services” in International Class 35 and “conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations” in International Class 41, which registered on the Principal Register on June 18, 2002. Said registration is

based on an application filed in the PTO on May 12, 2000 and claims a date of first use of January 17, 1990. The registration date, filing date, and first use date of Opposer's mark are all long before the filing date of Applicant's Application. True and correct copies of the specifics of the '901 Registration obtained from the PTO's TESS and Assignment databases are attached hereto as Exhibit 2 and made of record.

6. Opposer is the owner of and relies on incontestable U.S. Trademark Registration No. 2,551,877 (the "'877 Registration") for the mark DO IT® for "business consulting services; business management services" in International Class 35 and "conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations" in International Class 41, which registered on the Principal Register on March 26, 2002. Said registration is based on an application filed in the PTO on May 12, 2000 and claims a first use date of January 17, 1990. The registration date, filing date, and first use date of Opposer's mark are all long before the filing date of Applicant's Application. True and correct copies of the specifics of the '877 Registration obtained from the PTO's TESS and Assignment databases are attached hereto as Exhibit 3 and made of record.

7. Opposer's Registrations are incontestable. As such, Opposer's Registrations constitute conclusive evidence of the validity of the registered marks and of the registration of the marks, of Opposer's ownership of its registered marks, and of Opposer's exclusive right to use the registered marks in commerce as provided in Section 33 of the Trademark Act.

8. Opposer's Registrations are valid, subsisting, unrevoked, and uncancelled. As such, they constitute *prima facie* evidence of the validity of Opposer's ownership of the marks shown therein and of the exclusive right of Opposer to use said marks in commerce in connection with services named therein without condition or limitation. Opposer's Registrations also constitute notice to Applicant of Opposer's claim of ownership of the marks shown therein as provided in Sections 7(b), 22, and 33(a) of the Trademark Act.

9. In addition to the protection afforded to Opposer by its federal registrations, Opposer has extensive common law rights in Opposer's Marks in connection with Opposer's Services and the services identified in Opposer's Registrations throughout the United States. Opposer's common law rights in

Opposer's Marks were established long before and predate the filing date of Applicant's Application. Opposer's rights in Opposer's Marks are prior to and superior to Applicant's Application.

10. If Applicant is allowed to register the mark in Applicant's Application, Applicant's corresponding *prima facie* exclusive right to use the LEARNIT. DOIT. SEEIT. PROVEIT. mark nationwide will conflict with Opposer's lawful and *prima facie* exclusive right to use Opposer's Marks nationwide and its common law rights.

11. Applicant's LEARNIT. DOIT. SEEIT. PROVEIT. mark is highly similar to Opposer's Marks. Additionally, Applicant seeks registration for services identical or closely related to Opposer's Services and the services identified in Opposer's Registrations. As such, when Applicant's LEARNIT. DOIT. SEEIT. PROVEIT. mark is used on or in connection with the services identified in Applicant's Application, it is likely to cause confusion, or to cause mistake or to deceive the trade and purchasing public into believing that Applicant's services originate with Opposer or are otherwise authorized, licensed or sponsored by Opposer, within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). In view of Opposer's prior statutory and common law trademark rights, Applicant is not entitled to registration of the Application pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

12. By reason of the foregoing, Opposer will be damaged by registration of Application Serial No. 86/723,664 for the LEARNIT. DOIT. SEEIT. PROVEIT. mark.

WHEREFORE, Opposer prays that Application Serial No. 86/723,664 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: March 9, 2016

By: 

Diane M. Reed
Jessica C. Sganga
2040 Main Street
Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
efiling@knobbe.com
Attorneys for Opposer,
Partners in Leadership IP, LLC

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **NOTICE OF OPPOSITION** upon Applicant by depositing one copy thereof in the United States Registered Mail, first-class postage prepaid on March 9, 2016, addressed as follows:

ANN K. FORD
DLA PIPER LLP US
500 8TH ST NW
WASHINGTON, DISTRICT OF COLUMBIA UNITED STATES 20004-2131



Pamela Paseual

EXHIBIT 1

**Trademarks > Trademark Electronic Search System (TESS)**

TESS was last updated on Wed Mar 9 03:20:58 EST 2016

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Record 1 out of 1[TSDR](#) | [ASSIGN Status](#) | [TTAB Status](#) (Use the "Back" button of the Internet Browser to return to TESS)**SEE IT, OWN IT, SOLVE IT, DO IT**

Word Mark SEE IT, OWN IT, SOLVE IT, DO IT

Goods and Services IC 035. US 100 101 102. G & S: Business consulting services; business management services. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

IC 041. US 100 101 107. G & S: Conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76047454

Filing Date May 12, 2000

Current Basis 1A

Original Filing Basis 1A

Published for Opposition January 1, 2002

Registration Number 2551878

Registration Date March 26, 2002

Owner (REGISTRANT) PARTNERS IN LEADERSHIP, LLC LIMITED LIABILITY COMPANY CALIFORNIA 27555 Ynez Road, Suite 201 Temecula CALIFORNIA 92591

(LAST LISTED OWNER) PARTNERS IN LEADERSHIP IP, LLC LIMITED LIABILITY COMPANY 27555 YNEZ ROAD, SUITE 300 TEMECULA CALIFORNIA 92591

Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Diane M. Reed
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120401.
Renewal 1ST RENEWAL 20120401
Live/Dead Indicator LIVE

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Trademark Assignment Abstract of Title

Total Assignments: 3Serial #: [76047454](#)

Filing Dt: 05/12/2000

Reg #: [2551878](#)

Reg. Dt: 03/26/2002

Registrant: PARTNERS IN LEADERSHIP, LLC

Mark: SEE IT, OWN IT, SOLVE IT, DO IT

Assignment: 1Reel/ Frame: [2917/0262](#)

Recorded: 08/17/2004

Pages: 4

Conveyance: CONVERSION

Assignor: [PARTNERS IN LEADERSHIP, LLC](#)

Exec Dt: 06/30/2004

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

Assignee: [PARTNERS IN LEADERSHIP IP, LLC](#)

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NEVADA

27555 YNEZ ROAD, SUITE 300

TEMECULA, CALIFORNIA 92591

Correspondent: KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 MAIN STREET, 14TH FLOOR

IRVINE, CA 92614

Assignment: 2Reel/ Frame: [4016/0230](#)

Recorded: 07/07/2009

Pages: 6

Conveyance: ASSIGNS THE ENTIRE INTEREST

Assignor: [PARTNERS IN LEADERSHIP IP, LLC II](#)

Exec Dt: 12/31/2008

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NONE

Assignee: [PARTNERS IN LEADERSHIP IP, LLC](#)

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NONE

27555 YNEZ ROAD, SUITE 300

TEMECULA, CALIFORNIA 92591

Correspondent: CYNTHIA NEZIK

27555 YNEZ ROAD, SUITE 300

TEMECULA, CA 92591

Assignment: 3Reel/ Frame: [5629/0001](#)

Recorded: 09/23/2015

Pages: 12

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Assignors: [PARTNERS IN LEADERSHIP, LLC](#)

Exec Dt: 09/15/2015

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

[PARTNERS IN LEADERSHIP IP, LLC](#)

Exec Dt: 09/15/2015

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NEVADA

Assignee: [MONROE CAPITAL MANAGEMENT ADVISORS, LLC, AS ADMINISTRATIVE AGENT](#)

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: DELAWARE

311 SOUTH WACKER DRIVE, SUITE 6400

CHICAGO, ILLINOIS 60606

Correspondent: HOLLY MILLER

222 NORTH LASALLE STREET - 24TH FLOOR

CHICAGO, IL 60601

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EXHIBIT 2

**Trademarks > Trademark Electronic Search System (TESS)**

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Word Mark SEE IT

Goods and Services IC 035. US 100 101 102. G & S: Business consulting services; business management services. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

IC 041. US 100 101 107. G & S: conducting seminars, workshops, business operation training, and one-on-one training in the fields of business management and business operations. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76047544

Filing Date May 12, 2000

Current Basis 1A

Original Filing Basis 1A

Published for Opposition March 26, 2002

Registration Number 2580901

Registration Date June 18, 2002

Owner (REGISTRANT) Partners In Leadership, LLC LIMITED LIABILITY COMPANY CALIFORNIA 27555 Ynez Road, Suite 201 Temecula CALIFORNIA 92591

(LAST LISTED OWNER) PARTNERS IN LEADERSHIP IP, LLC LIMITED LIABILITY COMPANY 27555 YNEZ ROAD, SUITE 300 TEMECULA CALIFORNIA 92591

Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record Diane M. Reed
Type of Mark SERVICE MARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20120627.
Renewal 1ST RENEWAL 20120627
Live/Dead Indicator LIVE

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Trademark Assignment Abstract of Title

Total Assignments: 3Serial #: [76047544](#)

Filing Dt: 05/12/2000

Reg #: [2580901](#)

Reg. Dt: 06/18/2002

Registrant: Partners In Leadership, LLC

Mark: SEE IT

Assignment: 1Reel/ Frame: [2917/0262](#)

Recorded: 08/17/2004

Pages: 4

Conveyance: CONVERSION

Assignor: [PARTNERS IN LEADERSHIP, LLC](#)

Exec Dt: 06/30/2004

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

Assignee: [PARTNERS IN LEADERSHIP IP, LLC](#)

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NEVADA

27555 YNEZ ROAD, SUITE 300

TEMECULA, CALIFORNIA 92591

Correspondent: KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 MAIN STREET, 14TH FLOOR

IRVINE, CA 92614

Assignment: 2Reel/ Frame: [4016/0230](#)

Recorded: 07/07/2009

Pages: 6

Conveyance: ASSIGNS THE ENTIRE INTEREST

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Exec Dt: 12/31/2008

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: NONE

Assignee: [PARTNERS IN LEADERSHIP IP, LLC](#)

Entity Type: LIMITED LIABILITY COMPANY

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TEMECULA, CA 92591

Assignment: 3Reel/ Frame: [5629/0001](#)

Recorded: 09/23/2015

Pages: 12

Conveyance: NOTICE OF GRANT OF SECURITY INTEREST IN TRADEMARKS

Assignors: [PARTNERS IN LEADERSHIP, LLC](#)

Exec Dt: 09/15/2015

Entity Type: LIMITED LIABILITY COMPANY

Citizenship: CALIFORNIA

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Entity Type: LIMITED LIABILITY COMPANY

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Citizenship: DELAWARE

311 SOUTH WACKER DRIVE, SUITE 6400

CHICAGO, ILLINOIS 60606

Correspondent: HOLLY MILLER

222 NORTH LASALLE STREET - 24TH FLOOR

CHICAGO, IL 60601

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EXHIBIT 3



Trademarks > Trademark Electronic Search System (TESS)

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- HELP

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 - ASSIGN Status**
 - TTAB Status**
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DO IT

Word Mark DO IT

Goods and Services IC 035. US 100 101 102. G & S: BUSINESS CONSULTING SERVICES; BUSINESS MANAGEMENT SERVICES. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

IC 041. US 100 101 107. G & S: CONDUCTING SEMINARS, WORKSHOPS, BUSINESS OPERATION TRAINING, AND ONE-ON-ONE TRAINING IN THE FIELDS OF BUSINESS MANAGEMENT AND BUSINESS OPERATIONS. FIRST USE: 19900117. FIRST USE IN COMMERCE: 19900117

Mark Drawing Code (1) TYPED DRAWING

Serial Number 76047365

Filing Date May 12, 2000

Current Basis 1A

Original Filing Basis 1A;1B

Published for Opposition January 1, 2002

Registration Number 2551877

Registration Date March 26, 2002

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Trademark Assignment Abstract of Title

Total Assignments: 3Serial #: [76047365](#)

Filing Dt: 05/12/2000

Reg #: [2551877](#)

Reg. Dt: 03/26/2002

Registrant: PARTNERS IN LEADERSHIP, LLC

Mark: DO IT

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Assignment: 3Reel/ Frame: [5629/0001](#)

Recorded: 09/23/2015

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