

ESTTA Tracking number: **ESTTA734565**

Filing date: **03/18/2016**

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	WBC Group, LLC
Granted to Date of previous extension	03/20/2016
Address	6333 Hudson Crossing Parkway Hudson, OH 44236 UNITED STATES

Attorney information	Steven Solomon Pearne & Gordon, LLP 1801 East 9th Street Suite 1200 Cleveland, OH 44114 UNITED STATES tmdocket@pearne.com, ascheidler@pearne.com, dklett@pearne.com Phone:2165791700
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Applicant Information

Application No	86406673	Publication date	09/22/2015
Opposition Filing Date	03/18/2016	Opposition Period Ends	03/20/2016
Applicant	Elivate Institute, Inc. 100 Bayview Circle, Suite 315 Newport Beach, CA 92660 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Downloadable electronic publications in the nature of books and newsletters in the field of personal improvement
Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Educational publications, namely, printed books, handouts, and workbooks in the fields of personal improvement

Applicant Information

Application No	86975338	Publication date	09/22/2015
Opposition Filing Date	03/18/2016	Opposition Period Ends	
Applicant	Elivate Institute, Inc. 100 Bayview Circle, Suite 315 Newport Beach, CA 92660 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2013/09/18 First Use In Commerce: 2013/09/18

All goods and services in the class are opposed, namely: Arranging of seminars; Conducting workshops and seminars in personal awareness; Conducting workshops and seminars in self awareness; Conducting workshops and seminars in personal improvement; Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of personal improvement; Education services, namely, providing on-line classes, seminars, conferences, and workshops in the field of personal improvement; Education services, namely, providing classes, seminars, conferences, and workshops in the field of personal improvement; Educational and entertainment services, namely, a continuing program about personal improvement accessible by radio, television, satellite, audio, video and computer networks; Educational and entertainment services, namely, providing motivational and educational speakers; Educational and entertainment services, namely, providing motivational and educational speakers in the field of self- and personal improvement; Educational and entertainment services, namely, providing motivational speaking services in the field of personal improvement; Educational services, namely, conducting classes, seminars, conferences, and workshops in the field of personal improvement and distribution of course materials in connection therewith in printed or electronic format; Educational services, namely, professional coaching of teachers in the field of personal improvement provided on a real-time basis during classroom instruction; Educational services, namely, providing on-line classes, seminars, conferences, and workshops in the field of personal improvement; Entertainment and educational services, namely, the presentation of seminars, workshops and panel discussions, and ongoing television and radio shows in the field of personal improvement; Life coaching services in the field of personal improvement; Organization of seminars; Peer to peer coaching services in the field of personal improvement; Personal coaching services in the field of personal improvement; Professional coaching services in the field of personal improvement; Workshops and seminars in the field of personal improvement

Grounds for Opposition

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

U.S. Registration No.	4756704	Application Date	09/26/2013
Registration Date	06/16/2015	Foreign Priority Date	NONE
Word Mark	ELIVATE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2014/02/06 First Use In Commerce: 2014/03/18 Retail store services featuring the goods of others, namely, exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; retail		

	store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; wholesale store and wholesale distributorship services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; mail order and online retail store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products
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Attachments	86075931#TMSN.png(bytes) MDC-O1252-Notice of Opposition.pdf(276673 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	/stevenjsolomon/
Name	Steven Solomon
Date	03/18/2016

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

WBC GROUP, LLC

Opposer,

v.

ELIVATE INSTITUTE, INC.

Applicant.

Opposition No.: _____

Serial Nos.: 86/406,673 &
86/975,338

Mark: eLIVate

Filed: September 25, 2014

Published: September 22, 2015

NOTICE OF OPPOSITION

The Opposer, WBC Group, LLC (“WBC”), believing it will be damaged by Elivate Institute, Inc.’s (“EII”) registration of the mark eLIVate pursuant to applications serial numbers 86/406,673 (the “673 application”) and 86/975,338 (the “338 application”), hereby opposes the registration of said mark. Hereinafter, WBC may be referred to as the “Opposer,” and EII may be referred to as “Applicant.”

Background

1. The eLIVate mark that is the subject of the ‘673 and ‘338 applications was published for opposition on September 22, 2015. The original deadline for Opposer to file its Notice of Opposition for both applications was October 22, 2015. On September 30, 2015, Opposer requested and was granted a ninety-day extension of the opposition deadline, up to and including January 20, 2016 for both applications. On January 11, 2016, Opposer, with Applicant’s consent, requested and was granted additional sixty-day extensions of the opposition deadline, up to and including March 20, 2016. This

Notice of Opposition is timely filed by that date.

The Parties

2. WBC Group, LLC is a limited liability company organized in the state of Ohio and having an address of 6333 Hudson Crossing Parkway, Hudson, Ohio 44236, United States.

3. Elivate Institute, Inc., on information and belief, is a corporation organized in the state of California and having a place of business at 100 Bayview Circle, Suite 315, Newport Beach, California 92660, United States.

WBC's ELIVATE Mark

4. WBC is the owner of U.S. Reg. No. 4,756,704 for the mark ELIVATE (the "704 registration") for the following services in Class 35:

Retail store services featuring the goods of others, namely, exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; retail store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; wholesale store and wholesale distributorship services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; mail order and online retail store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products.

A printout from the Office's Trademark Status & Document Retrieval ("TSDR") database showing the current status and ownership of the '704 registration is attached as Exhibit A and is incorporated herein by reference.

5. The application from which the '704 registration issued, application serial no. 86/075,931 (the "'931 application"), was filed September 26, 2013. The '704 registration issued June 16, 2015.

6. The '704 registration is valid and subsisting.

EII's eLIVate Applications

7. In the '673 application, EII seeks to register the mark eLIVate for goods described as "downloadable electronic publications in the nature of books and newsletters in the field of personal improvement" in Class 9 and "educational publications, namely, printed books, handouts, and workbooks in the fields of personal improvement" in Class 16.

8. Pursuant to the '338 application, which was created through a request to divide filed in the '673 application on February 5, 2015, EII also seeks to register the mark eLIVate for the following services in Class 41:

Arranging of seminars; Conducting workshops and seminars in personal awareness; Conducting workshops and seminars in self awareness; Conducting workshops and seminars in personal improvement; Continuing education services, namely, providing live and on-line continuing professional education seminars in the field of personal improvement; Education services, namely, providing on-line classes, seminars, conferences, and workshops in the field of personal improvement; Education services, namely, providing classes, seminars, conferences, and workshops in the field of personal improvement; Educational and entertainment services, namely, a continuing program about personal improvement accessible by radio, television, satellite, audio, video and computer networks; Educational and entertainment services, namely, providing motivational and educational speakers; Educational and entertainment services, namely, providing motivational and educational speakers in the field of self- and personal improvement; Educational and entertainment services, namely, providing motivational speaking services in the field of personal improvement; Educational services, namely, conducting classes, seminars, conferences, and workshops in the field of personal improvement and distribution of course materials in connection therewith in printed or electronic format; Educational services, namely,

professional coaching of teachers in the field of personal improvement provided on a real-time basis during classroom instruction; Educational services, namely, providing on-line classes, seminars, conferences, and workshops in the field of personal improvement; Entertainment and educational services, namely, the presentation of seminars, workshops and panel discussions, and ongoing television and radio shows all in the field of personal improvement; Life coaching services in the field of personal improvement; Organization of seminars; Peer to peer coaching services in the field of personal improvement; Personal coaching services in the field of personal improvement; Professional coaching services in the field of personal improvement; Workshops and seminars in the field of personal improvement.

9. The '673 application and the '338 application both have a filing date of September 25, 2014.

10. When filing its application to register the eLIVate mark in Class 41, EII originally claimed a first use date and first use in commerce date of February 14, 2014.

11. On September 2, 2015, EII filed an amendment in the '338 application to claim a date of first use and date of first use in commerce of the eLIVate mark for services in Class 41 of September 18, 2013. The "explanation of filing" EII gave to the USPTO when submitting this amendment was that it was "due to clerical error."

EII's Prior Opposition to WBC's ELIVATE Application

12. On December 24, 2014, EII filed a notice of opposition against WBC's '931 application for the mark ELIVATE on the basis of priority and likelihood of confusion, citing its '673 application. Pursuant to that notice, the Trademark Trial and Appeal Board instituted Opposition No. 91219935.

13. On January 16, 2015, WBC filed a motion to dismiss the opposition pursuant to Fed. R. Civ. P. 12(b)(6), on the basis that EII's notice of opposition

failed to allege facts that, even if assumed to be true, would entitle eLIVate's mark to priority over WBC's ELIVATE mark.

14. EII failed to answer WBC's motion, and on February 17, 2015, the Trademark Trial and Appeal Board granted WBC's motion and dismissed Opposition No. 91219935 *with prejudice*.

Grounds for Opposition

15. Applicant's eLIVate mark is identical to Opposer's ELIVATE mark in sound, appearance, meaning and commercial impression.

16. EII's goods and services promoting "personal improvement" in both its aforementioned applications are highly and closely related to WBC's services supplying physical-fitness and exercise products useful for personal physical improvement. The goods and services of each party are offered and intended to advance the overall well-being of consumers.

17. Applicant's goods and services are provided to the same consumers and by the same channels as Opposer's services.

18. Opposer believes that it will be damaged should the Applicant's eLIVate mark register, that mark being so similar to Opposer's ELIVATE mark in sound, appearance, meaning and commercial impression as to be likely to cause confusion or mistake, or to deceive, as to the source, origin and/or sponsorship of goods or services sold or distributed under the Applicant's mark.

19. Consumers are likely to confuse goods and services offered under Applicant's eLIVate mark with the services offered by Opposer under its ELIVATE mark, and to erroneously believe that the former's goods and services also come from, are

affiliated with or are endorsed by Opposer. As a result, any perceived defects or poor quality of Applicant's goods or services sold under the eLIVate mark are likely to be erroneously attributed to WBC, to the substantial detriment of Opposer.

Conclusion

20. For the foregoing reasons, the present opposition should be sustained, and the Applicant should be refused registration of the eLIVate mark on the goods and services identified in the applications.

This Notice of Opposition is being filed electronically through the ESTTA system. The fee for opposing registration in three classes is being paid on filing through our Deposit Account. If any additional fees are required by the filing of this Notice of Opposition, or if the correct fee for opposing three classes was not paid on filing, then please charge all such fees to our Deposit Account No. 16-0820, and reference Order No. MDC-O1252.

Respectfully submitted,

WBC GROUP, LLC

By: */stevenjsolomon/*
Steven J. Solomon
Donna M. Klett
Pearne & Gordon LLP
1801 East 9th Street, Suite 1200
Cleveland, Ohio 44114-3108
Tel: (216) 579-1700
Fax: (216) 579-6073
Email: tmdocket@pearne.com
Attorneys for Opposer

Certificate of Service

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on the Applicant's attorney of record on the date indicated below, by mailing said copy via First Class Mail, postage prepaid, to:

Paul N. Tauger
WHGC, P.L.C.
1301 Dove Street, Suite 1050
Newport Beach, California 92660

Date: March 18, 2016

/stevenjsolomon/
Steven J. Solomon

One of the Attorneys for Opposer

Exhibit A

Generated on: This page was generated by TSDR on 2016-03-18 12:49:13 EDT

Mark: ELIVATE

ELIVATE

US Serial Number: 86075931

Application Filing Date: Sep. 26, 2013

US Registration Number: 4756704

Registration Date: Jun. 16, 2015

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jun. 16, 2015

Publication Date: Aug. 26, 2014

Notice of Allowance Date: Mar. 31, 2015

Mark Information

Mark Literal Elements: ELIVATE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Retail store services featuring the goods of others, namely, exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; retail store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; wholesale store and wholesale distributorship services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products; mail order and online retail store services featuring exercise and fitness equipment and products, sporting goods, clothing and apparel, athletic clothing, rehabilitative equipment and supplies for physical rehabilitation after playing sports, exercising or injury, and physical- and massage-therapy products

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 06, 2014

Use in Commerce: Mar. 18, 2014

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Amended Use: No

Filed ITU: Yes

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: WBC Group, LLC

Owner Address: 6333 Hudson Crossing Parkway
Hudson, OHIO 44236
UNITED STATES

Legal Entity Type: LIMITED LIABILITY COMPANY

State or Country OHIO
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Michael W. Garvey

Docket Number: MDC-51733

Attorney Primary tmocket@pearne.com
Email Address:

Attorney Email Yes
Authorized:

Correspondent

Correspondent STEVEN J SOLOMON
Name/Address: PEARNE & GORDON LLP
1801 E 9TH ST
STE 1200
CLEVELAND, OHIO 44114-3108
UNITED STATES

Phone: 216-579-1700

Fax: 216-579-6073

Correspondent e- tmocket@pearne.com
mail:

Correspondent e- Yes
mail Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 16, 2015	REGISTERED-PRINCIPAL REGISTER	
May 14, 2015	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
May 13, 2015	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
May 12, 2015	STATEMENT OF USE PROCESSING COMPLETE	65362
Apr. 09, 2015	USE AMENDMENT FILED	65362
May 11, 2015	CASE ASSIGNED TO INTENT TO USE PARALEGAL	65362
Apr. 09, 2015	TEAS STATEMENT OF USE RECEIVED	
Mar. 31, 2015	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Feb. 17, 2015	TTAB RELEASE CASE TO TRADEMARKS	219935
Feb. 17, 2015	OPPOSITION TERMINATED NO. 999999	219935
Feb. 17, 2015	OPPOSITION DISMISSED NO. 999999	219935
Dec. 25, 2014	OPPOSITION INSTITUTED NO. 999999	219935
Sep. 26, 2014	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 26, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 26, 2014	PUBLISHED FOR OPPOSITION	
Aug. 06, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 21, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Jul. 21, 2014	ASSIGNED TO LIE	77312
Jul. 03, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jul. 02, 2014	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jul. 01, 2014	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jul. 01, 2014	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jan. 16, 2014	NOTIFICATION OF PRIORITY ACTION E-MAILED	6326
Jan. 16, 2014	PRIORITY ACTION E-MAILED	6326
Jan. 16, 2014	PRIORITY ACTION WRITTEN	85321
Jan. 09, 2014	ASSIGNED TO EXAMINER	85321
Oct. 05, 2013	NOTICE OF PSEUDO MARK E-MAILED	
Oct. 04, 2013	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 30, 2013	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: May 13, 2015

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91219935](#)

Filing Date: Dec 24, 2014

Status: Terminated

Status Date: Feb 17, 2015

Interlocutory Attorney: GEORGE POLOGEORGIS

Defendant

Name: WBC Group, LLC

Correspondent Address: STEVEN J SOLOMON
PEARNE & GORDON LLP
1801 E 9TH ST, STE 1200
CLEVELAND OH , 44114-3108
UNITED STATES

Correspondent e-mail: tmocket@pearne.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELIVATE	Registered	86075931	4756704

Plaintiff(s)

Name: Elivate Insitute, Inc.

Correspondent Address: PATRICK SOON
WHGC PLC
1301 DOVE STREET, SUITE 1050
Newport Beach CA , 92660
UNITED STATES

Correspondent e-mail: patricksoon@whgclaw.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
ELIVATE	Request For Extension of Time to File Opposition	86406673	

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 24, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Dec 25, 2014	Feb 03, 2015
3	PENDING, INSTITUTED	Dec 25, 2014	
4	D MOT TO DISMISS: FRCP 12(B)	Jan 16, 2015	
5	SUSP PEND DISP OF OUTSTNDNG MOT	Feb 07, 2015	
6	BD DECISION: DISMISSED W/ PREJ	Feb 17, 2015	
7	TERMINATED	Feb 17, 2015	

Type of Proceeding: Extension of Time

Proceeding Number: [86075931](#)

Filing Date: Sep 25, 2014

Status: Terminated

Status Date: Dec 25, 2014

Interlocutory Attorney:

Defendant**Name:** WBC Group, LLC**Correspondent Address:** MICHAEL W. GARVEY
PEARNE & GORDON LLP
1801 E 9TH ST STE 1200
CLEVELAND OH , 44114-3108**Associated marks**

Mark	Application Status	Serial Number	Registration Number
ELIVATE	Registered	86075931	4756704

Potential Opposer(s)**Name:** Elivate Insitute, Inc.**Correspondent Address:** Patrick Soon
WHGC, PLC
1301 Dove Street, Suite 1050
Newport Beach CA , 92660
UNITED STATES**Correspondent e-mail:** soon.patrick@gmail.com**Name:** Elivate Insitute, Inc.**Correspondent Address:** Patrick Soon
WHGC, PLC
1301 Dove Street, Suite 1050
Newport Beach CA , 92660
UNITED STATES**Correspondent e-mail:** patricksoon@whgclaw.com**Associated marks**

Mark	Application Status	Serial Number	Registration Number
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Prosecution History

Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Sep 25, 2014	
2	EXTENSION OF TIME GRANTED	Sep 26, 2014	
3	INCOMING - EXT TIME TO OPPOSE FILED	Sep 25, 2014	
4	EXTENSION OF TIME GRANTED	Sep 26, 2014	