

ESTTA Tracking number: **ESTTA738476**

Filing date: **04/06/2016**

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	WeMesh, Inc.
Granted to Date of previous extension	04/06/2016
Address	340 Brookview Court Ancaster, L9G4C2 CANADA

Attorney information	Bobby Ghajar PILLSBURY WINTHROP SHAW PITTMAN LLP 725 S. Figueroa St., Suite 2800 Los Angeles, CA 90017 UNITED STATES bobby.ghajar@pillsburylaw.com, marcus.peterson@pillsburylaw.com, docket_ip@pillsburylaw.com, la-tmdocketing@pillsburylaw.com
----------------------	--

Applicant Information

Application No	86654939	Publication date	12/08/2015
Opposition Filing Date	04/06/2016	Opposition Period Ends	04/06/2016
Applicant	WeMash, Inc. #602 Studio City, CA 91604 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Software and downloadable software to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content for posting, linking and sharing through electronic messaging and transmission via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Software and downloadable software to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content that can be stored on and accessed from cloud based systems or remote network servers via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Downloadable software for the integration of text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content into an interactive delivery for multimedia applications; Software and downloadable software for mobile phones, tablet computers, mobile telecommunications devices, mobile digital devices, portable devices, personal communications devices, portable media players, handheld computers and hand-held electronic devices, to send and receive electronic messages, text, graphics, images, photos, moving pictures, music, audio, video, audio-video materials and other multimedia content via</p>
--

global communication networks, portable and wireless networks, and various platforms across multiple forms of media
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing an online non-downloadable searchable database of text, graphics, still images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content in the fields of celebrities, news, film, politics, television, political events and affairs, sports, music, history, drama, nature and wildlife, fashion, artistic performances, beauty, science fiction and fantasy for embedding digital content into websites, social media, electronic communications, downloadable and non-downloadable digital content, electronic downloadable publications, and other digital media and design elements of others
Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Providing online non-downloadable software, applications and tools to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content for posting, linking and sharing through electronic messaging and transmission via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Providing online non-downloadable software, applications and tools to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content that can be stored on and accessed from cloud based systems or remote network servers via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Providing online non-downloadable software for the integration of text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content into an interactive delivery for multimedia applications

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4757374	Application Date	05/05/2014
Registration Date	06/16/2015	Foreign Priority Date	NONE
Word Mark	WEMESH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2015/01/10 First Use In Commerce: 2015/01/10 Downloadable mobile software applications for synchronizing multimedia content with audio and text communication; Computer software for synchronizing content between mobile devices		

Attachments	86271330#TMSN.png(bytes) WEMES Opposition.pdf(800994 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 First Class Mail on this date.

Signature	/Marcus Peterson/
Name	Bobby Ghajar
Date	04/06/2016

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

WeMesh Inc.,	§	
	§	
Opposer,	§	Opposition No. _____
	§	
v.	§	Application Ser. No.: 86/654,939
	§	
WeMash, Inc.,	§	Date of Filing: June 8, 2015
	§	
Applicant.	§	Subject Mark: WEMES
	§	
	§	

NOTICE OF OPPOSITION

Opposer WeMesh Inc., a Canadian corporation (“WeMesh” or “Opposer”), having a place of business at 340 Brookview Court, Ancaster L9G4C2, believes that it will be damaged by the registration of U.S. Ser. No. 86/654,939, filed June 8, 2015 for the mark WEMES (hereinafter, the “Applied-for Mark”). The Application was published for opposition on December 8, 2015 and after applying for and obtaining an extension of time to oppose the Application, this Notice of Opposition is timely filed.

WeMesh hereby opposes the Application on the following grounds:

THE WEMESH MARK

1. WeMesh is the developer of a mobile application (“app”) for smartphones and tablets that allows users to synchronize videos to watch them simultaneously across mobile devices while at the same time communicating via text and voice. WeMesh combined two popular mobile activities – watching videos and chatting – into its innovative app.

2. WeMesh has been using the WEMESH mark in connection with the WEMESH app at least as early as summer 2013, including through release of early versions to customers and potential customers, sharing of marketing materials with customers and potential customers, and use of a Facebook page to promote the app.

3. The WEMESH app was officially launched on the Apple iTunes App Store on January 9, 2015, and later that year, in the Google Play store.

4. Since that time, the WEMESH app has been downloaded numerous times, and has received many excellent reviews.

5. On May 5, 2014, WeMesh applied to register the WEMESH mark in connection with “[d]ownloadable mobile software applications for synchronizing multimedia content with

audio and text communication; Computer software for synchronizing content between mobile devices,” in International Class 9.

6. The WEMESH application matured into Registration No. 4757374 on June 16, 2015. The registration is attached as Exhibit A. Thus, in addition to its common law trademark rights, WeMesh enjoys constructive trademark priority as of May 5, 2014.

APPLICANT’S APPLICATION FOR THE “WEMES” MARK

7. Applicant seeks to register the WEMES mark in connection with goods in Class 9 and services in classes 41 and 42.

8. Specifically, Applicant seeks to register WEMES in connection with:

“Software and downloadable software to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content for posting, linking and sharing through electronic messaging and transmission via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Software and downloadable software to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content that can be stored on and accessed from cloud based systems or remote network servers via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Downloadable software for the integration of text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content into an interactive delivery for multimedia applications; Software and downloadable software for mobile phones, tablet computers, mobile telecommunications devices, mobile digital devices, portable devices, personal communications devices, portable media players, handheld computers and hand-held electronic devices, to send and receive electronic messages, text, graphics, images, photos, moving pictures, music, audio, video, audio-video materials and other multimedia content via global communication networks, portable and wireless networks, and various platforms across multiple forms of media” in International Class 9;

“Providing an online non-downloadable searchable database of text, graphics, still images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content in the fields of celebrities, news, film, politics, television, political events and affairs, sports, music, history, drama, nature and wildlife, fashion, artistic performances, beauty, science fiction and fantasy for embedding digital content into websites, social media, electronic communications, downloadable and non-downloadable digital content, electronic downloadable publications, and other digital media and design elements of others” in International Class 41; and

“Providing online non-downloadable software, applications and tools to enable users to integrate, edit, combine, modify, enhance, create and display text,

graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content for posting, linking and sharing through electronic messaging and transmission via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Providing online non-downloadable software, applications and tools to enable users to integrate, edit, combine, modify, enhance, create and display text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content that can be stored on and accessed from cloud based systems or remote network servers via a global computer network, portable and wireless networks and various platforms across multiple forms of media; Providing online non-downloadable software for the integration of text, graphics, images, photos, moving pictures, music, audio, video, audio-visual materials, and other multimedia content into an interactive delivery for multimedia applications” in International Class 42.

9. Upon information and belief, Applicant applied to register the WEMES mark on an “intent-to-use” basis because it had not made trademark use of the term WEMES at the time of WeMash’s application (June 8, 2015).

10. Upon information and belief, at the time Applicant filed the application subject to this opposition, it only intended to use the WEMES mark in connection with a software app.

11. Upon information and belief, since the filing of the WEMES trademark application, Applicant has only used the WEMES mark in connection with a software app.

12. Upon information and belief, Applicant’s founder, Quincy Jones III, worked through his company, QD3 Entertainment, to develop certain services that would eventually lead his company to contemplate creating a mobile app called “Wemes,” which is now offered by Applicant WeMash.

13. Upon information and belief, Applicant’s WEMES app allows users to create videos with text, graphic, or other multimedia overlays (called video memes or “vemes”) and share them with others.

14. Upon information and belief, Applicant’s WEMES app is intended for distribution and download through various app stores, and is not available for download on Applicant’s website.

15. Upon information and belief, Applicant did not advertise its WEMES app, or any services under the WEMES trademark, prior to 2015.

16. Upon information and belief, prior to filing its application to register the WEMES trademark in the United States, WeMash conducted a trademark clearance search.

17. Upon information and belief, the very first result in that trademark search report was WeMesh’s WEMESH application.

18. Accordingly, in addition to constructive notice provided by WeMesh's federal trademark filing, WeMash was actually aware of the WEMESH application at the time it applied to register the WEMES mark on June 8, 2015.

19. As between the parties to this proceeding, WeMesh is the only one with a federal trademark registration; WeMash does not own any trademark registration for the WEMES mark.

20. WeMesh has priority over Applicant's filing of its intent-to-use application. Applicant's application to register the WEMES mark is subsequent to WeMesh's actual and constructive priority date for the WEMESH trademark application.

21. The WEMES mark is nearly identical in sound, appearance, and commercial impression to WeMesh's WEMESH mark, omitting only the letter "h" from WEMESH.

22. Applicant intends use of and/or is using the highly similar WEMES mark on the same or very similar product (mobile application). Accordingly the parties' respective goods and services are identical, directly overlap, and/or are related.

23. There are no restrictions or limitations in Applicant's WEMES trademark application relating to channels of trade or target consumers.

24. Applicant offers for download its WEMES app in the same retail channel as WeMesh, namely, both parties' apps are available in various app stores.

25. WeMesh is not affiliated or connected with Applicant or its goods or services; nor has WeMesh endorsed or sponsored Applicant or its goods or services.

26. As result of the foregoing, purchasers are likely to mistakenly believe that Applicant's WEMES app originates from, is sponsored by, or is in some way associated with WeMesh and its WEMESH app, when it is not.

27. Further, Applicant itself has admitted the likelihood of confusion between the parties' WEMESH and WEMES, alleging in its Federal lawsuit in the Central District of California that "[] WeMesh's use, distribution, offer for sale and/or sale of colorable imitations of [Applicant] WeMash's WEMASH and WEMES marks ... has caused and is likely to cause confusion, deception, and mistake by creating the false and misleading impression that the WeMesh Goods are manufactured or distributed by WeMash, that Defendant WeMesh is affiliated, connected, or associated with WeMash, and/or that WeMash has sponsored, endorsed or approved of Defendant WeMesh."

28. Registration of the WEMES mark would injure WeMesh by causing the public to be confused or mistaken into believing that the goods and services provided by Applicant are endorsed or sponsored by WeMesh. WeMesh has no control over the nature and quality of the goods and services offered by Applicant under the WEMES mark, and WeMesh's reputation and goodwill will be damaged and the value of its rights to the WEMESH mark jeopardized – all to WeMesh's detriment.

29. Any defect, objection, or fault found with Applicant's goods or services marketed under the Applied-for Mark would necessarily reflect upon and injure WeMesh's reputation

30. Accordingly, registration of the WEMES mark will damage WeMesh because the mark is likely, when used on or in connection with the goods and services described in the registration, to cause confusion, or to cause mistake, or to deceive.

WHEREFORE, WeMesh respectfully requests that Application Serial No. 86/654,939 be refused registration.

Respectfully submitted,

WeMesh Inc.

Date: April 6, 2016

By: /s/ Bobby Ghajar
Bobby Ghajar
Marcus Peterson
PILLSBURY WINTHROP SHAW PITTMAN
725 S. Figueroa St., Suite 2800
Los Angeles, CA 90017
(213) 488-7551

CERTIFICATE OF ELECTRONIC TRANSMISSION
DATE OF DEPOSIT
I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.
<u>/s/ Marcus Peterson</u> Marcus Peterson

CERTIFICATE OF SERVICE VIA MAIL

I, Marcus Peterson, Esq., of Pillsbury Winthrop Shaw Pittman LLP, attorneys for Opposer WeMesh Inc., hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served via postage prepaid first class mail on April 6, 2016 on Counsel for Applicant to MICHELLE A. COOKE, Manatt Phelps & Phillips LLP, 11355 W Olympic Blvd, Los Angeles, CALIFORNIA UNITED STATES 90064-1631

/s/ Marcus Peterson

Marcus Peterson

EXHIBIT A

**United States Patent and Trademark Office**

[Home](#) | [Site Index](#) | [Search](#) | [FAQ](#) | [Glossary](#) | [Guides](#) | [Contacts](#) | [eBusiness](#) | [eBiz alerts](#) | [News](#) | [Help](#)

Trademarks > Trademark Electronic Search System (TESS)

TESS was last updated on Wed Apr 6 03:21:03 EDT 2016

[TESS HOME](#)
[NEW USER](#)
[STRUCTURED](#)
[FREE FORM](#)
[BROWSE DICT](#)
[SEARCH OG](#)
[BOTTOM](#)
[HELP](#)
[PREV LIST](#)
[CURR LIST](#)
[NEXT LIST](#)

[FIRST DOC](#)
[PREV DOC](#)
[NEXT DOC](#)
[LAST DOC](#)

[Logout](#) Please logout when you are done to release system resources allocated for you.

[Start](#) List At: OR [Jump](#) to record:

Record 1 out of 2

[TSDR](#)
[ASSIGN Status](#)
[TTAB Status](#)
(Use the "Back" button of the Internet Browser to return to TESS)

WEMESH

Word Mark	WEMESH
Goods and Services	IC 009. US 021 023 026 036 038. G & S: Downloadable mobile software applications for synchronizing multimedia content with audio and text communication; Computer software for synchronizing content between mobile devices. FIRST USE: 20150110. FIRST USE IN COMMERCE: 20150110
Standard Characters Claimed	
Mark Drawing Code	(4) STANDARD CHARACTER MARK
Serial Number	86271330
Filing Date	May 5, 2014
Current Basis	1A
Original Filing Basis	1B
Published for Opposition	September 23, 2014
Registration Number	4757374
International Registration Number	1254981
Registration Date	June 16, 2015
Owner	(REGISTRANT) WEMESH Inc. CORPORATION CANADA 340 Brookview Court Ancaster CANADA L9G4C2

Attorney of Record Lorelei G. Graham

Type of Mark TRADEMARK

Register PRINCIPAL

Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST	NEXT LIST
FIRST DOC	PREV DOC	NEXT DOC	LAST DOC							

[|.HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)

United States of America
United States Patent and Trademark Office

WEMESH

Reg. No. 4,757,374

WEMESH INC. (CANADA CORPORATION)
340 BROOKVIEW COURT

Registered June 16, 2015

ANCASTER, CANADA L9G4C2

Int. Cl.: 9

FOR: DOWNLOADABLE MOBILE SOFTWARE APPLICATIONS FOR SYNCHRONIZING MULTIMEDIA CONTENT WITH AUDIO AND TEXT COMMUNICATION; COMPUTER SOFTWARE FOR SYNCHRONIZING CONTENT BETWEEN MOBILE DEVICES, IN CLASS 9 (U.S. CLS. 21, 23, 26, 36 AND 38).

TRADEMARK

PRINCIPAL REGISTER

FIRST USE 1-10-2015; IN COMMERCE 1-10-2015.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SN 86-271,330, FILED 5-5-2014.

SEAN CROWLEY, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office