

ESTTA Tracking number: **ESTTA747624**

Filing date: **05/20/2016**

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	TPW Management, LLC
Granted to Date of previous extension	05/21/2016
Address	129 Lincoln Ave. Manchester Center, VT 05255 UNITED STATES
Correspondence information	Douglas K. Riley, Esq. Attorney of Record Lisman, Leckerling, PC 84 Pine St., 5th Fl. Burlington, VT 05401 UNITED STATES driley@lisman.com Phone:802-864-5756

**Applicant Information**

Application No	86792643	Publication date	03/22/2016
Opposition Filing Date	05/20/2016	Opposition Period Ends	05/21/2016
Applicant	Yelp, Inc. 140 New Montgomery, 9th Floor San Francisco, CA 94105 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. First Use: 2013/12/04 First Use In Commerce: 2013/12/04 All goods and services in the class are opposed, namely: Providing consumer information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to businesses, restaurants, service providers, events, public services and government agencies, parks and recreational areas, religious organizations and nonprofit organizations
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Registration No.	4308732	Application Date	07/28/2012
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Registration Date	03/26/2013	Foreign Priority Date	NONE
Word Mark	WE KNOW JUST THE PLACE.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2010/10/01 First Use In Commerce: 2010/10/01 Real estate services, namely, vacation home rental management services		

Related Proceedings	U.S. Trademark Reg. No. 4308732: We Know Just the Place
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Attachments	85689447#TMSN.png( bytes ) 20160520102440374.pdf(1210294 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	/Douglas K. Riley/
Name	Douglas K. Riley, Esq.
Date	05/20/2016

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

Applicant: Yelp, Inc.

Application Serial Number: 86792643

Application Filing Date: 10/19/2015

Mark: WE KNOW JUST THE PLACE Publication  
Date 3/22/15

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**NOTICE OF OPPOSITION BY TPW MANAGEMENT, LLC**

TPW Management, LLC, (hereinafter “Petitioner” or “TPW”) by and through its attorneys, Lisman Leckerling, P.C., opposes Trademark Registration Application Serial Number 86792643, filed by Yelp, Inc. (hereinafter “Yelp” or “Applicant”) under 15 USC §1063.

**THE PARTIES**

**Petitioner TPW**

1. TPW is a limited liability company registered in Vermont and has its principal place of business in Manchester Center, Vermont.
2. TPW is a family-owned business that provides professional community and property management, home services, vacation rentals, and real estate sales services. TPW offers and provides services to persons who reside throughout the United States and beyond, who own and rent, or who seek to own and rent, vacation homes.

**Applicant Yelp**

3. Upon information and belief, Yelp is a Delaware corporation with its headquarters in San Francisco, California.

4. Upon information and belief, Yelp owns and operates the “Yelp” Internet site; the site features information concerning local businesses, including ratings and reviews for local businesses around the world, including markets also served by TPW.

#### **TPW’s Services and its Market**

5. TPW began as a technical consulting and community management business in the 1990’s. TPW subsequently expanded its scope and now provides property management, homeowner services, technical consulting, and residential construction services to community associations and homeowners at resort and vacation communities.

6. TPW currently provides property management, home services, vendor sourcing, service referrals, rental management and booking, and sales to over 20,000 rental, sales and service customers and 3000 resort homeowners, in 50 resort area communities.

7. TPW maintains a database of over 500 service vendors and connects its customers to these service providers.

8. TPW helps its more than 20,000 customers find businesses and service providers through property services, rental properties, lodging, concierge services, and referrals.

9. TPW connects property owners to plumbers, electricians, painters, housekeepers, and other service providers as well as connects renters to rental properties.

10. TPW also recommends local restaurants, service providers, and local attractions to property owners and renters.

11. TPW markets services to these customers with its service mark “We Know Just the Place.” (the “TPW Mark”).

12. TPW developed its rental and sales business to complement its home management services business. The TPW Mark has been and is an integral part of that development.
13. TPW creates preferential selection to service providers on behalf of its customers through a historical reference of customer satisfaction, compliance with insurance and payment policies, and work quality.
14. TPW launched an online booking service on June 1, 2012. This service places traveling guests in vacation rental properties (condominium units/homes/rooms). The online booking service relies on, and features prominently, the TPW Mark. TPW markets this service through the internet, its website, marketing brochures, paid per advertisements in print, radio, and internet, Facebook, LinkedIn, paid listings on HomeAway.com, VRBO.com, FlipKey, and by word of mouth.
15. Existing and potential customers access TPW's property management, home services, vacation rental, real estate sales services, and service referrals by online viewing of available services, marketing material, online bookings on TPW websites or through "channel partner" websites, word of mouth/in person, email, telephone, or fax. Channel partners are other web booking engines, such as KAYAK, Priceline.com, booking.com, flip key, HomeAway, VRBO, Air BnB, Expedia, Hipmunk, etc., that are populated with property descriptions, rates, photos, availability, and other information in real time.

#### **The TPW Mark**

16. TPW is the owner of U.S. Trademark Registration No. 4,308,732, duly issued by the United States Patent and Trademark Office on March 26, 2013, for the service mark "We Know Just the Place" for real estate services, namely vacation home rental management services, in International Class #036.

26. Yelp has listed TPW and its services and listed TPW for referral and review to consumers.
27. The Yelp listings can link or connect a Yelp user to the TPW website which will include the TPW trademark “We Know Just the Place.”
28. Upon information and belief, Yelp has also listed Mountain Management, Inc. (d/b/a Wise Vacations), predecessor owner of the TPW Mark, as a referral and included the slogan, “We Know Just the Place” in the Yelp listing.
29. TPW is listed on Yelp’s websites and the TPW Mark is displayed on the webpages of the TPW website.
30. At all times relevant to this matter, Yelp has been, and is, aware of TPW and its use of the TPW Mark.
31. Upon information and belief, on or about October 19, 2015, Yelp filed the instant application, Serial # 86792643, with the United States Patent and Trademark Office to register the service mark “We Know Just the Place” (the “Yelp Application”). In the Yelp Application, Yelp claims that it first used the mark in commerce on 12/4/2013.
32. The service mark claimed by Yelp in the Yelp Application is identical in all respects to the TPW Mark.
33. The Yelp Application claims “We Know Just the Place” as a service mark for “Providing consumer information, namely, compilations, rankings, ratings, reviews, referrals and recommendations relating to businesses. Restaurants, service providers, events, public services and government agencies, parks and recreational areas, religious organizations and nonprofit organizations,” in International Class #035.

17. TPW applied for the registration on or about July 28, 2012, disclosing its first use at least as early as October 1, 2010.
18. TPW acquired the slogan, "We Know Just the Place" as a result of its purchase of Mountain Management, Inc. (d/b/a Wise Vacations), on June 1, 2012.
19. Upon information and belief, Mountain Management, Inc., used the slogan, "We Know Just the Place" consistently from at least 2008 through June 1, 2012, in its marketing materials, online booking engine, property listings, and home service listings.
20. TPW has used and continues to use the TPW Mark in its marketing materials, internet and social media platforms, direct communications and contacts with customers.
21. TPW has made a significant financial investment in its online marketing and booking platform which features the TPW Mark.
22. TPW also sponsors sporting, charitable, and performing arts events where the TPW Mark is featured and displayed to audiences of participants and spectators that range up to tens of thousands of people.
23. TPW has made a substantial investment in the development, support, and marketing of its reputation, name, and TPW Mark. TPW has developed a customized website, online booking engine, and marketing campaign to support and integrate the TPW Mark with its name and reputation.

#### **Defendant Yelp's Unlawful Conduct**

24. Upon information and belief, Yelp is an on-line referral service that connects users with local service providers.
25. TPW has not contracted with, registered, nor signed up with Yelp to create a business profile for TPW.

34. The Yelp advertisements that include the TPW Mark, also advertise vacation destinations.

35. TPW has not authorized Yelp to use or otherwise provided Yelp with its consent to use the TPW Mark.

**Actual Confusion and Likelihood of Confusion**

36. Yelp's use of the phrase "We Know Just the Place" is creating actual confusion in the minds of consumers between the two companies, the services they provide, and will continue to create confusion for and mislead TPW customers, potential consumers, and the public.

37. Yelp solicits and distributes referrals about lodging accommodations, including hotels, hostels, bed and breakfasts, guest houses and mountain huts, as well as services, and other referrals.

38. Yelp uses the TPW Mark in its online advertising, social media, television commercials and other media.

39. Yelp uses the TPW Mark to entice consumers to use its services to find business and service referrals.

40. Yelp relies on search engines like Google, and Yelp's use of the TPW Mark will attract or is geared to attract among others, customers seeking a vacation rental. Upon information and belief, Yelp has used online booking engines for lodging and restaurant reservations.

41. Upon information and belief, Yelp partnered with at least one channel partner, Hipmunk, through which it can make its inventory, including lodging and vacation rentals, available to consumers.

42. Upon information and belief, Yelp has booked vacation properties, throughout the country, through its partnership with Hipmunk.

43. Yelp lists TPW's office locations and provides reviews of TPW's services. TPW and Mountain Management, Inc. (d/b/a Wise Vacations) are listed on Yelp's websites and the slogan "We Know Just the Place" is on these pages or via a click through to TPW's websites.
44. TPW and Yelp both have used a booking service for placing traveling guests in rental properties (condos/homes/rooms).
45. TPW and Yelp both have online services for this purpose and disclose location, rates, and property details.
46. TPW provides consumers with lodging, vacation rentals, service referrals, and other offerings.
47. TPW uses the TPW Mark in soliciting consumers to choose TPW in selecting vacation, lodging, and hotel services.
48. TPW also uses the TPW Mark to promote its referral service, including referrals of local service providers.
49. Yelp is using the TPW Mark to attract potential customers from the same pool of consumers as TPW for lodging accommodations, rental properties, and service referrals.
50. To the consumer, Yelp and TPW appear to be in the same businesses, namely the sourcing of local vendors/service providers for their customers and locating rental and vacation properties.
51. To explain its marketing and use of the phrase "We Know Just the Place" Yelp has published a blog post by Andrea R, VP of Community Management. TPW is engaged in and markets itself to consumers as providing community management. A blog post by someone identified as a Vice-President of Community Management under the TPW Mark is confusing and misleading to consumers.

52. TPW customers, employees, and vendors have begun to question whether TPW acquired Yelp or vice versa as the mark or slogan is identical and the services are similar. Persons renting lodging through TPW or seeking other services or referrals it provides, will be confused when encountering Yelp's use of the TPW Mark TPW customers will mistake the Yelp site and vendors with TPW and its vendors.

53. There is an overlap and similarity in the services provided by TPW and Yelp, and how each markets these services to consumers. Yelp's use of the TPW Mark will cause confusion to consumers and the public.

54. Both Yelp and TPW use the internet and social media to attract customers.

55. Both Yelp and TPW appear together online using the TPW Mark.

56. TPW has an online booking engine for lodging and provides restaurant reservations through its customer service representatives. Yelp lists TPW's office locations and provides reviews of TPW's services.

57. Yelp rates the same vendors TPW lists and suggests or sub-contracts to its customer's homes.

58. Customers will confuse the reviews and comments on the Yelp site and mistake them for TPW recommendations. The trust and credibility TPW has developed with its customers and the public will be degraded by this confusion.

59. The confusion and resulting loss to TPW, its reputation, and the strength of the TPW Mark will continue until Yelp ceases use of the TPW Mark.

60. Yelp's use of the TPW Mark will likely cause confusion among TPW customers, potential customers, and the public regarding the source, sponsorship, affiliation, connection, or identification of the TPW Mark and is likely to continue to cause confusion in the future.

**Dilution of Famous Mark by Blurring (15 U.S.C. § 1125(c))**

61. The TPW Mark is a famous trademark within the meaning of the Anti-Dilution Act, 15 U.S.C. § 1125(c).

62. As a result of Yelp's use of the TPW Mark, the distinctive qualities of the TPW Mark are being and will continue to be diluted.

63. Yelp's acts have diluted and will continue to result in the dilution of the distinctive nature of the TPW Mark through blurring, in violation of 15 U.S.C. § 1125(c).

**Tarnishment of Famous Mark (15 USC § 1125 (c))**

64. On information and belief, Yelp has a reputation within the marketplace that is inferior to that of TPW, in that Yelp's ratings and order of listing of rated businesses are reportedly subject to adjustment by Yelp based on financial consideration that may be provided to (or solicited by) Yelp from the subject businesses.

65. TPW's business involves management of substantial amount of money and property for customers in a fiduciary capacity, and advice to customers concerning their proposed purchases of expensive services and properties. A reputation of absolute honesty and integrity is critical to TPW's success and survival in business.

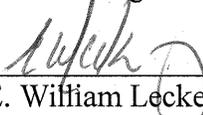
66. The confusion between TPW and Yelp in the consumer's mind caused by Yelp's use of the TPW Mark reflects poorly on TPW, and dilutes the TPW Mark by tarnishment.

WHEREFORE, Petitioner TPW requests that the Board deny the Yelp Application.

DATED at Burlington, Vermont, this 30<sup>th</sup> day of May, 2016.

LISMAN LECKERLING  
Attorneys for Plaintiff  
TPW Management, LLC

By:

  
\_\_\_\_\_  
E. William Leckerling, III, Esq.  
Judith L. Dillon, Esq.  
84 Pine Street, Fifth Floor  
P.O. Box 728  
Burlington, VT 05402-0728  
Tel: (802) 864-5756  
Fax: (802) 864-3629  
[wmleckerling@lisman.com](mailto:wmleckerling@lisman.com)  
[jdillon@lisman.com](mailto:jdillon@lisman.com)

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