

ESTTA Tracking number: **ESTTA748200**

Filing date: **05/24/2016**

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	Entrepreneur Media, Inc.
Granted to Date of previous extension	05/25/2016
Address	18061 Fitch Irvine, CA 92614 UNITED STATES
Attorney information	Patrick Justman 12670 High Bluff Drive San Diego, CA 92626 UNITED STATES patrick.justman@lw.com, thomas.watson@lw.com, alethia.corneil@lw.com, ip-docket@lw.com

Applicant Information

Application No	86513886	Publication date	01/26/2016
Opposition Filing Date	05/24/2016	Opposition Period Ends	05/25/2016
Applicant	The Roos Cohen Group LLC 1 Carlton Avenue Brooklyn, NY 11205 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business strategic planning services; Providing business management information in connection with consulting and advisory services in the field of strategic planning; Providing employment counseling information on how to successfully transition jobs; Brand concept and brand development services for corporate and individual clients
Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Business education and training services in a group setting, namely teaching negotiation strategies, leadership development, business planning

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.	1453968	Application Date	05/14/1985
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Registration Date	08/25/1987	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1983/05/19 First Use In Commerce: 1983/05/19 COMPUTER PROGRAMS AND PROGRAMS USER MANUALS ALL SOLD AS A UNIT</p> <p>Class 016. First use: First Use: 1978/05/02 First Use In Commerce: 1978/05/02 PAPER GOODS AND PRINTED MATTER; NAMELY MAGAZINES, BOOKS AND PUBLISHED REPORTS PERTAINING TO BUSINESS OPPORTUNITIES</p>		

U.S. Registration No.	2263883	Application Date	11/13/1995
Registration Date	07/27/1999	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1992/07/00 First Use In Commerce: 1992/07/00 Advertising and business services, namely, arranging for the promotion of the goods and services of others by means of a global computer network and other computer online services providers; providing business information for the use of customers in the field of starting and operating small businesses and permitting customers to obtain information via a global computer network and other computer online service providers and; web advertising services, namely, providing activelinks to the websites of others</p>		

U.S. Registration No.	2502032	Application Date	11/06/2000
Registration Date	10/30/2001	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR		
Design Mark	<p>ENTREPRENEUR</p>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1991/10/18 First Use In Commerce: 1991/10/18 Arranging And Conducting Trade Show Exhibitions In The Field Of EntrepreneurialActivities, Namely The Start-Up And Operation Of Small Business Enterprises</p> <p>Class 041. First use: First Use: 1991/10/18 First Use In Commerce: 1991/10/18 Educational Services, Namely, Conducting Seminars On The Development And Operation Of Businesses, And Conducting Work Shops On Computer Techno-</p>		

	logy, Telecommunications, Marketing, Financing Options, Real Estate Management, Tax Planning And Insurance
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Attachments	76159837#TMSN.png(bytes) 86_513886.pdf(50925 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	/s/ Patrick Justman
Name	Patrick Justman
Date	05/24/2016

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

In re the Application of The Roos Cohen Group, LLC
Serial No. 86/513886
Filed: January 26, 2015
Published: January 26, 2016
Trademark: EVOLVING ENTREPRENEUR

Entrepreneur Media, Inc.,)
a California corporation,)
)
Opposer,)
v.)
)
The Roos Cohen Group, LLC,)
a New York limited liability company,)
)
Applicant.)
_____)

OPPOSITION NO. _____

NOTICE OF OPPOSITION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Entrepreneur Media, Inc. (“EMI”), a California corporation, with a place of business located at 18061 Fitch, Irvine, California 92614, believes that it will be damaged by registration of the mark **EVOLVING ENTREPRENEUR**, Serial Number 86/513886 for *Business strategic planning services; Providing business management information in connection with consulting and advisory services in the field of strategic planning; Providing employment counseling information on how to successfully transition jobs; Brand concept and brand development services for corporate and individual clients in Class 35 and Business education and training services in a group setting, namely teaching negotiation strategies, leadership development,*

business planning in Class 41. Therefore, in accordance with the provisions of Section 13 of the Trademark Act (15 U.S.C. § 1063), EMI hereby opposes the application of The Roos Cohen Group, LLC (“Roos”) for the mark **EVOLVING ENTREPRENEUR**.

As grounds for the opposition, EMI alleges as follows:

1. EMI owns a family of marks consisting of or incorporating the term ENTREPRENEUR, including but not limited to all of the following (the “EMI Marks”):

TRADEMARK	CLASS: GOODS/SERVICES	REG. NUMBER REG. DATE
ENTREPRENEUR	16: Paper goods and printed matter; namely magazines, books and published reports pertaining to business opportunities First Use in Commerce: May 2, 1978	1453968 Aug. 25, 1987
ENTREPRENEUR	35: Advertising and business services, namely, arranging for the promotion of the goods and services of others by means of a global computer network and other computer online services providers; providing business information for the use of customers in the field of starting and operating small businesses and permitting customers to obtain information via a global computer network and other computer online service providers; web advertising services, namely, providing active links to the websites of others First Use in Commerce: July 1992	2263883 July 27, 1999
ENTREPRENEUR	35: Arranging and conducting trade show exhibitions in the field of entrepreneurial activities, namely the start-up and operation of small business enterprises 41: Educational services, namely, conducting seminars on the development and operation of businesses, and conducting work shops on computer technology, telecommunications, marketing, financing options, real estate management, tax planning and insurance First Use in Commerce: October 18, 1991	2502032 Oct. 30, 2001

2. The registrations for the EMI Marks are valid, unrevoked, uncanceled, and in full force and effect. EMI’s three registrations for ENTREPRENEUR® (Nos. 1453968; 2263883; 2502032) are also incontestable. EMI owns these registrations and the trademarks and all business and goodwill connected therewith. Two copies of the certificates of registration

issued in connection with each trademark registration referenced above, along with status printouts from the U.S. Patent and Trademark Office, are attached as exhibits to this Notice.

3. EMI, and its predecessors in interest, have been and are now engaged in the business of developing, creating, distributing, marketing, advertising, and selling a wide variety of goods and services under the EMI Marks, and in particular under its ENTREPRENEUR[®] trademark (the “ENTREPRENEUR[®] Mark”), including the publication and distribution of magazines and books, conducting seminars and other educational events, providing blogs and online business information, and providing online social networking services. In fact, EMI has been using the ENTREPRENEUR[®] Mark in commerce for over thirty years, having first adopted that mark for magazines at least as early as May 2, 1978.

4. Through careful cultivation of its goods and services provided under the EMI Marks, and in particular the ENTREPRENEUR[®] Mark, EMI has developed an outstanding reputation as an innovator in the field of business start-up and strategy and has established an extremely loyal customer following.

5. EMI has received a tremendous amount of public recognition and acclaim for the products and services provided under its EMI Marks, and in particular under the ENTREPRENEUR[®] Mark. Through EMI’s widespread and continuous use of its family of EMI Marks, including the ENTREPRENEUR[®] Mark, these marks have acquired extensive goodwill, have developed a high degree of distinctiveness, and have become famous, well-known and recognized as identifying goods and services that originate from EMI.

6. Numerous courts have recognized the strength of the EMI Marks, including:

- a. The U.S. District Court for the Central District of California held that “[t]he extensive advertising and public recognition over the past 25 years have established [the ENTREPRENEUR[®] Mark] as a strong mark in the industry”; the ENTREPRENEUR[®] Mark “is a strong distinctive mark, deserving of significant protection”; and the ENTREPRENEUR Mark “has acquired secondary meaning.” *Entrepreneur Media, Inc. v. Smith*, No. 98-3607, 2004 U.S. Dist. LEXIS 24078, at *9-10, 13 (C.D. Cal. June 23, 2004).
- b. The Ninth Circuit reviewed the District Court’s findings and affirmed them on appeal. *Entrepreneur Media, Inc. v. Smith*, 101 Fed. Appx. 212, 215 (9th Cir. 2004).
- c. Both a Magistrate Judge and District Court Judge in the Eastern District of Virginia found the ENTREPRENEUR Mark to be distinctive. *Entrepreneur Media, Inc. v. seattleentrepreneur.com*, No. 11-00409, Docket No. 22 (E.D. Va. Dec. 6, 2011).
- d. The U.S. District Court for the District of Maryland has twice recognized the EMI Marks as valid, strong, and distinctive. *Entrepreneur Media, Inc. v. JMD Entertainment Group, LLC, et al.*, No. RDB-12-1970, Docket No. 30 (D. Md. July 23, 2013); *Id.* Docket No. 47 (April 7, 2014).
- e. The U.S. District Court for the District of Connecticut has recognized that “the EMI Marks, and in particular the ENTREPRENEUR Mark, have acquired extensive goodwill, developed a high degree of distinctiveness and secondary meaning, and become well known and recognized as identifying goods and services that originate from EMI, such that they are deserving of strong protection.” *Entrepreneur Media, Inc. v. Whitehill et al.*, No. 13-cv-01819(MPS), Docket No. 19 (D. Conn. August 19, 2015).

7. Applicant seeks to register **EVOLVING ENTREPRENEUR** mark for services in Classes 35 and 41.

8. Applicant's mark is confusingly similar to EMI's previously used and registered **ENTREPRENEUR**[®] Mark and the EMI Marks, and will be used with identical or closely-related services in Classes 35 and 41. Indeed, Applicant's mark contains the entirety of the **ENTREPRENEUR**[®] Mark. In addition, the **ENTREPRENEUR**[®] Mark is a well-known and famous mark, so consumers are likely to view the "ENTREPRENEUR" of the **EVOLVING ENTREPRENEUR** mark as the predominant portion of the mark. Therefore, the **EVOLVING ENTREPRENEUR** mark is confusingly similar to EMI's previously used and registered **ENTREPRENEUR**[®] Mark and the EMI Marks, such that there will be a likelihood of confusion or mistake among consumers as to an affiliation, connection, or association between EMI and Applicant, or as to the origin, sponsorship, or approval of Applicant's services, all to the damage of EMI.

9. EMI would be damaged, and its superior rights violated, by the registration of Applicant's mark because this registration would: (a) support and assist Applicant in the confusing, misleading, and deceptive use of Applicant's mark; and (b) give Applicant statutory rights and protections to which Applicant is not entitled.

WHEREFORE, EMI believes that it will be damaged by the registration of Applicant's mark and prays that it be denied.

Please recognize the following as attorneys for EMI:

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Please address all communications to Patrick C. Justman of Latham & Watkins LLP.

Dated: May 24, 2016

Respectfully submitted,
LATHAM & WATKINS LLP



By: _____

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Attorneys for Opposer
Entrepreneur Media, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **NOTICE OF OPPOSITION** has been served on May 24, 2016, by mailing said copy via First Class Mail, postage prepaid to:

Amy B. Goldsmith
Tarter Krinsky & Drogin LLP
1350 Broadway
New York, NY 10018

The Roos Cohen Group LLC
1 Carlton Avenue
Brooklyn, New York 11205

A handwritten signature in blue ink, appearing to read "Patrick C. Justman", written in a cursive style.

Patrick C. Justman