

ESTTA Tracking number: **ESTTA411649**

Filing date: **05/27/2011**

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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	Entrepreneur Media Inc.		
Entity	Corporation	Citizenship	CA
Address	2445 McCabe Way Irvine, CA 92614 UNITED STATES		

Attorney information	Jennifer L. Barry Latham & Watkins LLP 600 West Broadway, Suite 1800 (027788-33-US090) San Diego, CA 92101 UNITED STATES ipdocket@lw.com, jennifer.barry@lw.com Phone:(619) 236-1234		
----------------------	---	--	--

Registration Subject to Cancellation

Registration No	3663282	Registration date	08/04/2009
Registrant	Castro, Daniel. R. Building I, Suite 450 12401 Research Blvd Austin, TX 78759 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2009/01/07 First Use In Commerce: 2009/01/07 All goods and services in the class are cancelled, namely: Conducting workshops and seminars in innovation and strategic planning

Grounds for Cancellation

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

Related Proceedings	Opposition Nos. 91197739 and 91199436
---------------------	---------------------------------------

Marks Cited by Petitioner as Basis for Cancellation

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	NONE		

Mark	
Goods/Services	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 active links to the websites of others

U.S. Registration No.	1453968	Application Date	05/14/1985
Registration Date	08/25/1987	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR		
Design Mark			
Description of Mark	NONE		
Goods/Services	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 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		

U.S. Registration No.	2502032	Application Date	11/06/2000
Registration Date	10/30/2001	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR		
Design Mark	ENTREPRENEUR		
Description of Mark	NONE		
Goods/Services	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 Entrepreneurial Activities, Namely The Start-Up And Operation Of Small Business Enterprises 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 Technology, Telecommunications, Marketing, Financing Options, Real Estate Management, Tax Planning And Insurance		

U.S. Registration No.	3519022	Application Date	07/10/2007
-----------------------	---------	------------------	------------

Registration Date	10/21/2008	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Downloadable podcasts in the field of business, current events, lifestyle issues, and developments in science and technology</p> <p>Class 035. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Providing business information and advice via a web site on a global computer network</p> <p>Class 038. First use: First Use: 2002/09/00 First Use In Commerce: 2002/09/00 Broadcasting programs via a global computer network; and streaming of audio and video material via the Internet; telecommunications services, namely, transmission of podcasts</p>		

U.S. Registration No.	3652950	Application Date	08/01/2008
Registration Date	07/14/2009	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR CONNECT		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 2008/07/16 First Use In Commerce: 2008/07/16 ONLINE BUSINESS NETWORKING SERVICES IN THE NATURE OF CREATING AND HOSTING A COMMUNITY FOR REGISTERED USERS TO CREATE PROFESSIONAL PROFILES, TO PARTICIPATE IN GROUP DISCUSSIONS, TO MAKE BUSINESS CONTACTS, AND TO UPLOAD ONTO THE WEBSITE MATERIALS PROMOTING THEIR BUSINESSES, PRODUCTS AND SERVICES</p>		

U.S. Registration No.	3266532	Application Date	12/07/2006
Registration Date	07/17/2007	Foreign Priority Date	NONE
Word Mark	ENTREPRENEURENESPANOL.COM		

Design Mark	ENTREPRENEURENESPANOL.COM
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2006/10/13 First Use In Commerce: 2006/10/13 Advertising and business services, namely, arranging for the promotion of goods and services of others by means of a global computer network and other computer online service providers; providing business information for the use of customers in the field of starting and operating businesses and permitting customers to obtain the aforesaid information via a global computer network and other computer online service providers; Internet advertising services, namely, promoting the goods and services of others by providing a web site with active links to their websites featuring their goods and services

U.S. Registration No.	3470064	Application Date	07/16/2007
Registration Date	07/22/2008	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR PRESS		
Design Mark	ENTREPRENEUR PRESS		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00 Paper goods and printed matter, namely, books, manuals, prepared reports, work books, study guides, legal and business forms, and newsletters concerning advice and information relating to the subjects of starting, running and operating a business, and individuals who succeeded in business, which subjects are of interest to entrepreneurs, new and existing businesses and members of the general public Class 035. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00 On-line ordering services featuring printed and electronically downloadable publications, namely, books, study guides, legal and business forms, and newsletters, concerning advice and information relating to the subjects of starting, running and operating a business and individuals who succeeded in business, which subjects are of interest to entrepreneurs, new and existing businesses and members of the general public		

U.S. Registration No.	3204899	Application Date	03/27/2006
Registration Date	02/06/2007	Foreign Priority Date	NONE
Word Mark	ENTREPRENEUR'S STARTUPS		
Design Mark	ENTREPRENEUR ' S STARTUPS		
Description of Mark	NONE		

Goods/Services	Class 016. First use: First Use: 2006/01/27 First Use In Commerce: 2006/01/27 Paper goods and printed matter; namely, magazines, books, booklets and published reports pertaining to business opportunities
----------------	--

U.S. Registration No.	3924374	Application Date	07/24/2008
-----------------------	---------	------------------	------------

Registration Date	03/01/2011	Foreign Priority Date	NONE
-------------------	------------	-----------------------	------

Word Mark	ENTREPRENEUR ASSIST
-----------	---------------------

Design Mark	ENTREPRENEUR ASSIST
-------------	----------------------------

Description of Mark	NONE
---------------------	------

Goods/Services	Class 038. First use: First Use: 2007/06/15 First Use In Commerce: 2007/06/15 Providing online facilities for real-time interaction between website visitors concerning topics of general interest to entrepreneurs, new and existing businesses and members of the general public Class 042. First use: First Use: 2007/06/15 First Use In Commerce: 2007/06/15 Providing website visitors with online non-downloadable software applications in the field of business planning and productivity for bookmarking, filing and tabbing articles found on websites for quicker retrieval, for creating text documents, spreadsheets and presentations, for customizing business forms and templates, for selecting and downloading a selection of business books, for scheduling event deadlines and appointments with email reminders, and for assisting in the creation of business plans
----------------	--

Attachments	76159837#TMSN.gif (1 page)(bytes) 77226387#TMSN.jpeg (1 page)(bytes) 76691766#TMSN.gif (1 page)(bytes) 76670060#TMSN.gif (1 page)(bytes) 76679564#TMSN.gif (1 page)(bytes) 76657293#TMSN.gif (1 page)(bytes) 76691530#TMSN.gif (1 page)(bytes) 778567_1.pdf (7 pages)(35475 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	/Jennifer L. Barry/
Name	Jennifer L. Barry
Date	05/27/2011

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

ENTREPRENEUR MEDIA INC., a California corporation,)	
)	
Petitioner,)	CANCELLATION NO. _____
)	
v.)	PETITION TO CANCEL
)	
DANIEL R. CASTRO, an individual,)	and
)	
Respondent.)	REQUEST FOR CONSOLIDATION WITH OPPOSITION NOS. 91197739 AND 91199436

Registrant:	Daniel R. Castro
Serial No.	77/651410
Trademark:	ENTREPRENEUROLOGY
Registration No.	3,663,282
International Class:	41
Filed:	January 16, 2009
Registered:	August 4, 2009

Petitioner Entrepreneur Media, Inc. (“EMI”) is a California corporation with its headquarters located at 2445 McCabe Way, Irvine, California 92614. EMI hereby requests the cancellation of Registration No. 3,663,282 (the “ ‘282 Registration”) owned by Respondent Daniel R. Castro (“Castro”) for the mark ENTREPRENEUROLOGY in International Class 41 for “*conducting workshops and seminars in innovation and strategic planning*” (the “Castro Mark”). EMI believes that it is being damaged, and will continue to be damaged, by the continued registration of this mark.

As grounds for cancellation, EMI alleges as follows:

1. EMI owns a family of marks consisting of or incorporating the term ENTREPRENEUR, including all of the following (collectively, the “EMI Marks”):

TRADEMARK	CLASS: GOODS/SERVICES	REG. NO. REG. DATE
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 and; web advertising services, namely, providing active links to the websites of others	2,263,883 July 27, 1999
ENTREPRENEUR	16: Paper goods and printed matter; namely magazines, books and published reports pertaining to business opportunities	1,453,968 August 25, 1987
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	2,502,032 October 30, 2001
ENTREPRENEUR.COM	9: Downloadable podcasts in the field of business, current events, lifestyle issues, and developments in science and technology 35: Providing business information and advice via a web site on a global computer network 38: Broadcasting programs via a global computer network; and streaming of audio and video material via the Internet; telecommunications services, namely, transmission of podcasts	3,519,022 October 21, 2008
ENTREPRENEUR CONNECT	42: Online business networking services in the nature of creating and hosting a community for registered users to create professional profiles, to participate in group discussions, to make business contacts, and to upload onto the website materials promoting their businesses, products and services	3,652,950 July 14, 2009
ENTREPRENEUR ENESPANOL.COM	35: Advertising and business services, namely, arranging for the promotion of goods and services of others by means of a global computer network and other computer online service providers; providing business information for the use of customers in the field of starting and operating businesses and permitting customers to obtain information via a global computer network and other computer online service providers; internet advertising services, namely, promoting the goods and services of others by providing a web site with active links to their websites featuring their goods and services	3,266,532 July 17, 2007
ENTREPRENEUR PRESS	16: Paper goods and printed matter, namely, books, manuals, prepared reports, work books, study guides, legal and business forms, and newsletters concerning advice and information relating to the subjects of starting, running and operating a business, and individuals who succeeded in business, which	3,470,064 July 22, 2008

TRADEMARK	CLASS: GOODS/SERVICES	REG. NO. REG. DATE
	subjects are of interest to entrepreneurs, new and existing businesses and members of the general public 35: On-line ordering services featuring printed and electronically downloadable publications, namely, books, study guides, legal and business forms, and newsletters, concerning advice and information relating to the subjects of starting, running and operating a business and individuals who succeeded in business, which subjects are of interest to entrepreneurs, new and existing businesses and members of the general public	
ENTREPRENEUR'S STARTUPS	16: Paper goods and printed matter; namely, magazines, books, booklets and published reports pertaining to business opportunities	3,204,899 February 6, 2007
ENTREPRENEUR ASSIST	38: Providing online facilities for real-time interaction between website visitors concerning topics of general interest to entrepreneurs, new and existing businesses and members of the general public 42: Providing website visitors with online non-downloadable software applications in the field of business planning and productivity for bookmarking, filing and tabbing articles found on websites for quicker retrieval, for creating text documents, spreadsheets and presentations, for customizing business forms and templates, for selecting and downloading a selection of business books, for scheduling event deadlines and appointments with email reminders, and for assisting in the creation of business	3,924,374 March 1, 2011

2. EMI's registrations of the EMI Marks are valid, unrevoked, uncancelled, and in full force and effect. 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 Petition.

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 registered trademark ENTREPRENEUR® (the "ENTREPRENEUR Mark"), including the publication and distribution of magazines and books, conducting seminars and other educational events, and the distribution

of print and online information and advice, all concerning or of interest to businesses, business owners and would-be business owners. In fact, EMI has been using the ENTREPRENEUR Mark in commerce for over 30 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. The United States District Court for the Central District of California has determined that the ENTREPRENEUR Mark has become and is a strong mark in the industry, as a result of extensive advertising and public recognition over the past 25 years. *Entrepreneur Media, Inc. v. Smith*, No. CV 98-3607 FMC (CTx), 2004 U.S. Dist. LEXIS 24078 (C.D. Cal. June 23, 2004). These findings were affirmed by the Ninth Circuit Court of Appeals. *Entrepreneur Media, Inc. v. Smith*, 101 Fed. Appx. 212 (9th Cir. 2004).

7. According to the '282 Registration, Castro did not begin using the Castro Mark for the identified services ("Castro's Services") until January 2009. EMI first adopted and used the ENTREPRENEUR Mark for magazines at least as early as May 2, 1978, and has used the

ENTREPRENEUR Mark in connection with educational services such as seminars and workshops since at least as early as October 18, 1991. EMI therefore has priority of use with respect to the '282 Registration.

8. The Castro Mark is confusingly similar to EMI's previously used and registered ENTREPRENEUR Mark, and is being used with identical or closely-related services (workshops and seminars in entrepreneurship) such that there is a likelihood of confusion or mistake among consumers as to an affiliation, connection or association between EMI and Castro, or as to the origin, sponsorship, or approval of Castro's Services, all to the damage of EMI.

9. EMI has been, and will continue to be, damaged, and its superior rights violated, by Castro's '282 Registration, in that: (i) the '282 Registration supports and assists Castro in the confusing, misleading, and deceptive use of the Castro Mark; and (ii) the '282 Registration gives Castro statutory rights and protections, to which he is not entitled.

Wherefore, EMI prays that this Petition to Cancel be sustained and that the '282 Registration be canceled.

**REQUEST FOR CONSOLIDATION WITH
OPPOSITION NOS. 91197739 AND 91199436**

EMI hereby respectfully requests that this Petition to Cancel be consolidated with its earlier filed Notices of Opposition, Opposition Nos. 91197739 (filed on December 7, 2010) and 91199436 (filed on April 14, 2011). Castro is the owner of record in all of these three proceedings, and the marks at issue are essentially identical. Accordingly, EMI's claims in all three proceedings have common questions of law and fact.

Dated: May 27, 2011

Respectfully submitted,

LATHAM & WATKINS LLP

By:



Jennifer L. Barry
Latham & Watkins LLP
600 West Broadway, Suite 1800
San Diego, CA 92101
(619) 236-1234 / (619) 696-7419 fax
jennifer.barry@lw.com

*Counsel for Petitioner
Entrepreneur Media, Inc.*

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITION TO CANCEL** has been served on Registrant/Attorney of Record Daniel R. Castro by mailing said copies on May 27, 2011 via First class Mail, postage prepaid to:

Daniel R. Castro
Castro & Baker, LLP
12401 Research Blvd
Building I, Suite 450
Austin, TX 78759



Jennifer L. Barry