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

Ex parte appeal no.	90089140
Appellant	AVID Center
Applied for mark	AVID DIGITALXP
Correspondence address	JOHN M KIM IPLA LLP 4445 EASTGATE MALL SUITE 200 SAN DIEGO, CA 92121 UNITED STATES Primary email: trademarks@ipla.com 858-272-0220 EXT 142
Submission	Request for remand/amendment
Attachments	2022-04-07 - Request for Remand.pdf(117704 bytes) Exhibit A - Consent Agreement.pdf(159011 bytes)
Filer's name	John M. Kim
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Signature	/John M. Kim/
Date	04/07/2022

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

Mark: AVID DIGITALXP)	Examining Attorney:
)	Andrea B. Cornwell
Applicant: AVID Center)	
)	Law Office: 115
Serial No.: 90089140)	
_____)	

REQUEST FOR REMAND FOR ADDITIONAL EVIDENCE

Applicant hereby requests suspension of its Appeal to the Trademark Trial and Appeal Board (the “Board”), filed on December 9, 2021, and respectfully requests the Board to remand the above-identified application to the Examiner of Trademarks for reconsideration to consider additional evidence. TMBP §§ 1207.02, 1209.04.

This request is being made in accordance with additional evidence for the Examiner to review, namely, a consent agreement between the Applicant and ES Holdings, LLC, the owner of the registration for DIGITALXP (Reg. No. 5749610), cited by the Examiner as the sole ground for refusal to register under Trademark Act § 2(d), 15 U.S.C. § 1052(d) against the above-identified application. Attached hereto as Exhibit A is the consent agreement between Applicant and ES Holdings, LLC. Applicant respectfully requests the Board grant the request herein because consent agreements constitute good cause for the Board to grant a request to suspend and remand to the Examiner for further consideration. TMBP § 1207.02 (“...because a consent agreement offered in response to a refusal to register under [2(d)] is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request...is filed at any time prior to the rendering of the Board’s final decision on the appeal.”).

Therefore, the Board must grant Applicant's request for remand to the Examiner to consider the consent agreement submitted hereto because good cause is demonstrated herein and the Board has not rendered a final decision on Applicant's Appeal.

Respectfully submitted,

/John M. Kim/

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Exhibit A

TRADEMARK CONSENT AGREEMENT

This Trademark Consent Agreement is by and between AVID Center, a California corporation with an address of 9797 Aero Drive Suite 100, San Diego, California, 92123, United States (“AVID”) and ES Holdings, LLC, located at 713 Duarte Rd. Suite G887, Arcadia, California, United States (“ESH”).

ESH owns a federal registration for the trademark DIGITALXP (Reg. No. 5749610) which covers “[e]ducational services, namely, providing online courses in the fields of business development and marketing” in Class 41.

AVID has filed to register the trademark AVID DIGITALXP which covers “[d]ownloadable educational course materials in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills; [p]rerecorded training videos in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills; [d]ownloadable webinars in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills” in Class 09, “[i]nteractive educational services, namely, providing virtual training courses in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills and distribution of course materials in connection therewith; [p]roviding educational courses in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills offered through online non-downloadable videos and instructor assistance; [e]ducation services, namely, providing non-downloadable webinars in the fields of virtual teaching, virtual student learning, lessons and activities to facilitate the virtual classroom learning environment, educational leadership, elementary, middle, high school, secondary, and college preparatory core academic subjects, and student success skills” in Class 41, and “[p]roviding temporary use of non-downloadable web based educational application software that enables users to access an educational reference database in the fields of elementary, middle, high school, secondary, and college preparatory core academic subjects, student success skills, virtual teaching, virtual student learning, and lessons and activities to facilitate the virtual classroom learning environment” in Class 42.


Under a separate written agreement, the parties have agreed to certain and specific terms and conditions to assure that confusion in the marketplace between their marks will not occur.

Accordingly, AVID and ESH do not believe there is a likelihood of confusion between the respective marks. AVID and ESH base this conclusion on differences between their respective marks and the goods and services offered under those marks, and differences in their marketing efforts for their respective goods and services. Therefore, ESH hereby consents to AVID's use and registration of the AVID DIGITALXP trademark, as set forth above, and AVID hereby consents to ESH's use and registration of the DIGITALXP trademark, as set forth above.

AVID Center

ES Holdings, LLC

By:  _____
ECA8539C066844D...

By:  _____

Name: David S. Greulich

Name: Eric Siu

Title: Controller

Title: Founder / CEO

Date: 3/16/2022 | 2:49 PM PDT

Date: 03 / 14 / 2022