

ESTTA Tracking number: **ESTTA171046**

Filing date: **10/25/2007**

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	R&L Publishing Ltd.		
Entity	Partnership	Citizenship	Texas
Composed Of:	Sunside LLC, a Texas limited liability company		
Address	200 Swisher Road Lake Dallas, TX 75065 UNITED STATES		

Attorney information	George R. Schultz Schultz & Associates, P.C. 5400 LBJ Freeway Suite 1200 Dallas, TX 75240 UNITED STATES russ.schultz@grspc.com, alissa.digman@grspc.com, sherry.colgrove@grspc.com Phone:214 210 5940		
----------------------	---	--	--

Applicant Information

Application No	78955351	Publication date	10/02/2007
Opposition Filing Date	10/25/2007	Opposition Period Ends	11/01/2007
Applicant	Self Esteem Seminars, Inc. 929 Fruteria Santa Barbara, CA 93110 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Educational services, namely conducting seminars and lectures on the subject of inspiration, self-esteem and personal development; training and teaching in the area of inspiration, self-esteem and personal development; training and teaching in the area of employee development

Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1334275	Application Date	10/09/1984
Registration Date	05/07/1985	Foreign Priority Date	NONE
Word Mark	SUCCESS!		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 016. First use: First Use: 1984/09/01 First Use In Commerce: 1984/09/01 General Interest Magazines

U.S. Application No.	78333143	Application Date	11/25/2003
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SUCCESS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1995/01/12 First Use In Commerce: 1995/01/12 Prerecorded audio tapes, videotapes, and CD ROMs in the fields of professional, personal and financial achievement, and entrepreneurial management, excluding calendars; computer software tutorials for use in the fields of professional, personal and financial achievement, and entrepreneurial management, excluding calendars</p> <p>Class 016. First use: First Use: 1977/07/18 First Use In Commerce: 1977/07/18 Magazine pertaining to the fields of professional, personal and financial achievement, and entrepreneurial management</p> <p>Class 041. First use: First Use: 1995/01/12 First Use In Commerce: 1995/01/12 Conducting educational seminars in the fields of professional, personal and financial achievement, and entrepreneurial management</p>		

U.S. Registration No.	3096744	Application Date	10/07/2004
Registration Date	05/23/2006	Foreign Priority Date	NONE
Word Mark	SUCCESS FROM HOME		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2005/03/00 First Use In Commerce: 2005/03/00 printed publications, namely, magazines, in the field of direct sales and marketing		

Attachments	73502862#TMSN.gif (1 page)(bytes) 78333143#TMSN.jpeg (1 page)(bytes) 78496518#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (22 pages)(656957 bytes)
-------------	---

Signature	/George R Schultz/
Name	George R. Schultz
Date	10/25/2007

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

**In the matter of Trademark
Application Serial No.: 78/955,351**

For the mark: EFFORTLESS SUCCESS

Published in the Official Gazette on: October 2, 2007

R&L PUBLISHING, LTD.

Opposer,

v.

OPPOSITION NO. _____

SELF ESTEEM SEMINARS, INC.

Applicant.

NOTICE OF OPPOSITION

R&L Publishing, Ltd. ("Opposer") believes that it has been and will be damaged by registration of the mark shown in Application No. 78/955,351 (the "Application"), and therefore files this Notice of Opposition pursuant to 15 U.S.C. § 1063, and would respectfully show the Board the following:

I. Parties

1. Opposer is a Texas limited partnership having a principal place of business at 200 Swisher Road, Lake Dallas, Texas 75065.
2. Self Esteem Seminars, Inc. ("Applicant") is believed to be a California corporation having a principal place of business at 929 Fruteria, Santa Barbara, California 93110.

II. Standing

3. Opposer is the owner of the marks "SUCCESS!®", "SUCCESS™" and "SUCCESS FROM HOME®" (collectively, the "SUCCESS Marks").

4. Opposer offers, among other things, magazines and educational seminars in the fields of personal and professional achievement under the SUCCESS Marks ("Opposer's Goods and Services").

5. Opposer or its predecessors-in-interest began promoting Opposer's Goods and Services under one or more of the SUCCESS Marks as early as 1977. Specifically, Opposer or its predecessors-in-interest began using one or more of the SUCCESS Marks in association with magazines at least as early as September of 1977. Since at least January of 1995, Opposer or its predecessors-in-interest have been using one or more of the SUCCESS Marks in association with educational seminars in the fields of personal and professional achievement.

6. Opposer owns incontestable U.S. Registration No. 1,334,275 for the mark "SUCCESS! ®" for use in association with "general interest magazines." The mark was registered on May 7, 1985 and its corresponding registration is valid and subsisting. The date of first use recited in this registration is September 1, 1984. A copy of Registration No. 1,334,275 is attached at Exhibit A. A copy of a printout from the USPTO's Trademark Application and Registration Retrieval ("TARR") database for Registration No. 1,334,275 is attached at Exhibit B.

7. Opposer also owns pending U.S. Trademark Application, Serial No. 78/333,143 for the mark "SUCCESS®" for the following goods and services:

Prerecorded audio tapes, videotapes, and CD ROMs in the fields of professional, personal and financial achievement, and entrepreneurial management, excluding calendars; computer software tutorials for use in the fields of professional, personal and

financial achievement, and entrepreneurial management, excluding calendars in International Class 009;
Magazine pertaining to the fields of professional, personal and financial achievement, and entrepreneurial management in International Class 016; and

Conducting educational seminars in the fields of professional, personal and financial achievement, and entrepreneurial management International Class 041.

The application to register this mark was filed on November 25, 2003. The date of first use recited for the goods in class 16 is July 18, 1977. The dates of first use recited for the goods and services in classes 9 and 41 are January 12, 1995. A copy of a printout from the USPTO's TARR database for Serial No. 78/333,143 is attached at Exhibit C.

8. Opposer also owns U.S. Registration No. 3,096,744 for the mark "SUCCESS FROM HOME®" for use in association with "printed publications, namely, magazines in the field of direct sales and marketing." The mark was registered on May 23, 2006 and is valid and subsisting. The date of first use recited in this registration is March of 2005. A copy of Registration No. 3,096,744 is attached at Exhibit D. A copy of a printout from the USPTO's TARR database for the Registration No. 3,096,744 is attached at Exhibit E.

9. Long before the filing date of the Application, Opposer, or its predecessors-in-interest, adopted and used the SUCCESS Marks in association with Opposer's Goods and Services. Since the adoption of each of the SUCCESS Marks, they have been continuously used in commerce in association with Opposer's Goods and Services.

10. Opposer and its predecessors-in-interest have expended substantial amounts of money, time, and effort in advertising and promoting the SUCCESS Marks. The trade and purchasing public have come to know and recognize the SUCCESS Marks and their associated goods and services as being those of Opposer or those that originate with Opposer or its

predecessors-in-interest. The SUCCESS Marks identify Opposer as a source of Opposer's Goods and Services and distinguishes them from the goods and services of others.

11. The SUCCESS Marks are inherently distinctive or have acquired secondary meaning.

12. By virtue of the excellent quality of Opposer's Goods and Services and general reputation, Opposer has become well known and has acquired an excellent and widespread reputation for the goods and services sold in connection with the SUCCESS Marks. The SUCCESS Marks are symbolic of the extensive goodwill and consumer recognition established by Opposer and its predecessors-in-interest and are indicative of its nationally recognized reputation for excellence in the industry.

13. Applicant has filed an Application to register the mark "EFFORTLESS SUCCESS" ("Applicant's Mark") for use in association with "educational services, namely, conducting seminars and lectures on the subject of inspiration, self-esteem and personal development; training and teaching in the area of inspiration, self-esteem and personal development; training and teaching in the area of employee development" ("Applicant's Services"). The Application to register Applicant's Mark was filed on August 18, 2006. It was filed on an intent to use basis and does not recite a date of first use. The Application was published in the Official Gazette on October 2, 2007.

14. The SUCCESS Marks and Applicant's Mark are substantially similar, both visually and phonetically, and create the same commercial impression.

15. Opposer's Goods and Services are related to Applicant's Services as recited in the Application. On information and belief, the services of Applicant are provided to similar consumers and move in the same channels of trade as those of Opposer.

III. Grounds

Likelihood of Confusion 15 U.S.C. § 1052(d)

16. Under § 2(d) of the Act, 15 U.S.C. § 1052(d), Applicant's Mark so resembles the SUCCESS Marks, which have been previously used in the United States by Opposer and its predecessors-in-interest, registered with the USPTO and not abandoned, that Applicant's Mark when used in association with Applicant's Services is likely to cause confusion, to cause mistake or to deceive consumers into erroneously believing that there is some relationship between Opposer and Applicant or that Opposer has authorized, sponsored or become associated with Applicant's use of Applicant's Mark.

17. Applicant's Mark is confusingly similar to the SUCCESS Marks. The similarity in sight, sound, and appearance between the SUCCESS Marks and Applicant's Mark creates a similar or identical commercial impression.

18. Applicant's Services are so closely related to Opposer's Goods and Services that a likelihood of confusion is created between Opposer and Applicant as to the source of origin of Applicant's Services.

IV. Damage

19. Opposer has superior rights in the SUCCESS Marks as compared to those of Applicant because Opposer and its predecessors-in-interest have used the SUCCESS Marks in commerce continuously and prior to Applicant's first use of Applicant's Mark. Consequently, confusion, mistake or deception in the trade and in the minds of the consuming public between Opposer and Applicant as to the origin of Applicant's Services is likely to occur and be exacerbated with resulting damage to Opposer if the mark in the Application is allowed to be registered.

V. Fees

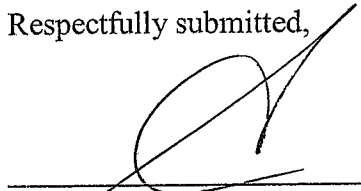
20. Pursuant to 37 C.F.R. 26(a)(6), the required fee of Three Hundred Dollars (\$300.00) has been electronically paid in conjunction with the electronic filing of this Notice.

21. The Board is authorized to charge additional required amounts or issue any credits for overpayments to Deposit Account No. 50-2225.

WHEREFORE, Opposer prays that registration of the mark as shown in Application No. 78/955,351 be denied.

Dated: October 25, 2007.

Respectfully submitted,



George R. Schultz
Reg. No. 35,674
Alissa A. Digman
Reg. No. 54,932

SCHULTZ & ASSOCIATES, P.C.
One Lincoln Centre
5400 LBJ Freeway
Suite 1200
Dallas, Texas 75240
(214) 210-5940 telephone
(214) 210-5941 facsimile

ATTORNEYS FOR OPPOSER
R&L PUBLISHING, LTD.

EXHIBIT A

Int. Cl.: 16

Prior U.S. Cl.: 38

United States Patent and Trademark Office

Reg. No. 1,334,275

Registered May 7, 1985

**TRADEMARK
PRINCIPAL REGISTER**

SUCCESS!

SUCCESS MAGAZINE COMPANY (PARTNER-
SHIP)
342 MADISON AVE.
NEW YORK, NY 10173

FOR: GENERAL INTEREST MAGAZINES,
IN CLASS 16 (U.S. CL. 38).

FIRST USE 9-1-1984; IN COMMERCE
9-1-1984.

OWNER OF U.S. REG. NO. 1,221,662.

SER. NO. 502,862, FILED 10-9-1984.

JAMES WALSH, EXAMINING ATTORNEY

EXHIBIT B

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-10-18 12:36:05 ET

Serial Number: 73502862 Assignment Information Trademark Document Retrieval

Registration Number: 1334275

Mark

SUCCESS!

(words only): SUCCESS!

Standard Character claim: No

Current Status: Registered.

Date of Status: 2006-01-31

Filing Date: 1984-10-09

Transformed into a National Application: No

Registration Date: 1985-05-07

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 830 -Post Registration

Date In Location: 2006-01-31

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. VIDEO PLUS, L.P.

Address:

VIDEO PLUS, L.P.
200 SWISHER ROAD
LAKE DALLAS, TX 75065
United States

Legal Entity Type: Limited Partnership

State or Country Where Organized: Texas

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

General Interest Magazines

Basis: 1(a)

First Use Date: 1984-09-01

First Use in Commerce Date: 1984-09-01

ADDITIONAL INFORMATION

Prior Registration Number(s):

1221662

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2007-08-08 - Automatic Update Of Assignment Of Ownership

2007-07-30 - PAPER RECEIVED

2006-01-31 - Post Registration action correction

2006-01-31 - Section 8 (10-year) accepted/ Section 9 granted

2006-01-31 - Assigned To Paralegal

2005-11-07 - Combined Section 8 (10-year)/Section 9 filed

2005-11-07 - TEAS Section 8 & 9 Received

1990-07-07 - Section 8 (6-year) accepted & Section 15 acknowledged

1990-05-14 - Section 8 (6-year) and Section 15 Filed

1985-05-07 - Registered - Principal Register

1985-02-26 - Published for opposition

1985-02-14 - Notice of publication

1985-01-17 - Notice of publication

1984-12-18 - Approved for Pub - Principal Register (Initial exam)

1984-12-18 - Examiner's amendment mailed

<http://tarr.uspto.gov/servlet/tarr?regser=registration&entry=1334275&action=Request+Status>

10/18/2007

1984-12-13 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Monica B. Mason,

Correspondent

Monica B. Mason,

Fowler White Boggs Banker P.A.

Suite 1900

501 E. Kennedy Blvd.

Tampa, FL 33602

EXHIBIT C

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-10-18 12:37:12 ET

Serial Number: 78333143 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

SUCCESS

(words only): SUCCESS

Standard Character claim: Yes

Current Status: Further action on the application has been suspended.

Date of Status: 2007-09-19

Filing Date: 2003-11-25

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 109

Attorney Assigned:
THOMPSON HEATHER Employee Location

Current Location: L90 -TMEG Law Office 109

Date In Location: 2007-09-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. VIDEO PLUS, L.P.

Address:
VIDEO PLUS, L.P.
200 SWISHER ROAD
LAKE DALLAS, TX 75065
United States

Legal Entity Type: Limited Partnership

State or Country Where Organized: Texas

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

Prerecorded audio tapes, videotapes, and CD ROMs in the fields of professional, personal and financial achievement, and entrepreneurial management, excluding calendars; computer software tutorials for use in the fields of professional, personal and financial achievement, and entrepreneurial management, excluding calendars

Basis: 1(a)

First Use Date: 1995-01-12

First Use in Commerce Date: 1995-01-12

International Class: 016

Class Status: Active

Magazine pertaining to the fields of professional, personal and financial achievement, and entrepreneurial management

Basis: 1(a)

First Use Date: 1977-07-18

First Use in Commerce Date: 1977-07-18

International Class: 041

Class Status: Active

Conducting educational seminars in the fields of professional, personal and financial achievement, and entrepreneurial management

Basis: 1(a)

First Use Date: 1995-01-12

First Use in Commerce Date: 1995-01-12

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2007-09-19 - Report Completed Suspension Check Case Still Suspended

2007-09-19 - Assigned To LIE

2007-08-09 - Applicant/Correspondence Changes (Non-Responsive) Entered

2007-08-08 - Automatic Update Of Assignment Of Ownership

2007-07-30 - PAPER RECEIVED

2006-12-01 - Report Completed Suspension Check Case Still Suspended

2006-12-01 - Assigned To LIE

<http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=78333143&action=Request+Status>

10/18/2007

Latest Status Info

2006-08-16 - Attorney Revoked And/Or Appointed
2006-08-16 - TEAS Revoke/Appoint Attorney Received
2006-04-11 - Report Completed Suspension Check Case Still Suspended
2005-09-21 - Report Completed Suspension Check Case Still Suspended
2005-03-07 - LETTER OF SUSPENSION E-MAILED
2005-03-07 - Suspension Letter Written
2005-02-03 - Teas/Email Correspondence Entered
2005-01-31 - Communication received from applicant
2005-01-31 - TEAS Response to Office Action Received
2004-09-07 - Assigned To Examiner
2004-07-30 - Non-final action e-mailed
2004-07-11 - Assigned To Examiner
2003-12-23 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

George R. Schultz

Correspondent

George R. Schultz
Schultz & Associates, P.C.
5400 LBJ Freeway
Suite 1200
DALLAS, TX 75240
Phone Number: 202-672-5300
Fax Number: 202-672-5399

EXHIBIT D

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 3,096,744

United States Patent and Trademark Office

Registered May 23, 2006

**TRADEMARK
PRINCIPAL REGISTER**

SUCCESS FROM HOME

VIDEO PLUS, INC. (DELAWARE CORPORATION)
200 SWISHER ROAD
LAKE DALLAS, TX 75065

FOR: PRINTED PUBLICATIONS, NAMELY, MAGAZINES, IN THE FIELD OF DIRECT SALES AND MARKETING, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 3-0-2005; IN COMMERCE 3-0-2005.

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

SN 78-496,518, FILED 10-7-2004.

DAVID H. STINE, EXAMINING ATTORNEY

EXHIBIT E

Latest Status Info

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2007-10-18 12:10:34 ET

Serial Number: 78496518 Assignment Information Trademark Document Retrieval

Registration Number: 3096744

Mark

SUCCESS FROM HOME

(words only): SUCCESS FROM HOME

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2006-05-23

Filing Date: 2004-10-07

Transformed into a National Application: No

Registration Date: 2006-05-23

Register: Principal

Law Office Assigned: LAW OFFICE 114

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-04-11

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Video Plus, Inc.

Address:

Video Plus, Inc.
200 Swisher Road
Lake Dallas, TX 75065
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

International Class: 016

Class Status: Active

printed publications, namely, magazines, in the field of direct sales and marketing

Basis: 1(a)

First Use Date: 2005-03-00

First Use in Commerce Date: 2005-03-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2006-06-07 - Assignment Of Ownership Not Updated Automatically

2006-05-23 - Registered - Principal Register

2006-04-07 - Law Office Registration Review Completed

2006-03-10 - Assigned To LIE

2006-03-09 - Allowed for Registration - Principal Register (SOU accepted)

2006-03-05 - Statement of use processing complete

2006-02-16 - Amendment to Use filed

2006-02-16 - TEAS Statement of Use Received

2005-12-20 - Notice of allowance - mailed

2005-09-27 - Published for opposition

2005-09-07 - Notice of publication

2005-06-07 - Law Office Publication Review Completed

2005-05-23 - Assigned To LIE

2005-05-19 - Examiner's amendment mailed

2005-05-18 - Approved for Pub - Principal Register (Initial exam)

Latest Status Info

2005-05-18 - Examiners Amendment -Written
2005-05-11 - Assigned To Examiner
2005-04-11 - Applicant amendment prior to exam entered
2005-04-11 - PAPER RECEIVED
2005-03-25 - TEAS Change Of Correspondence Received
2004-10-15 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

George "Russ" Schultz

Correspondent

George R. Schultz
Schultz & Associates, P.C.
Suite 1200
5400 LBJ Freeway
Dallas TX 75240
Phone Number: 214-210-5940
Fax Number: 214-210-5941
