

ESTTA Tracking number: **ESTTA298055**

Filing date: **07/29/2009**

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	NCS Pearson, Inc.
Granted to Date of previous extension	07/29/2009
Address	5601 Green Valley Drive Bloomington, MN 55437 UNITED STATES
Correspondence information	Daniel J. DeVoe Assistant General Counsel NCS Pearson, Inc. 5601 Green Valley Drive Bloomington, MN 55437 UNITED STATES dan.devoe@pearson.com Phone:(952) 681-3070

Applicant Information

Application No	78851933	Publication date	03/31/2009
Opposition Filing Date	07/29/2009	Opposition Period Ends	07/29/2009
International Registration No.	NONE	International Registration Date	NONE
Applicant	Learna Education Inc. 5259 Lismic Blvd. Mississauga, L5V 1P2 CANADA		

Goods/Services Affected by Opposition


<p>Class 009. All goods and services in the class are opposed, namely: Educational computer software for use in math, language and science learning that may be downloaded from a global computer network; educational computer software for use in math, language and science learning; downloadable electronic educational publications and worksheets in the nature of study guides, notes and worksheets in the field of math, language and science learning; downloadable electronic books featuring topics relating to math, language and science learning recorded on computer media; video recordings, audio recordings and computer software recorded on cd-roms, dvd-roms, and prerecorded cassettes tapes featuring education, namely infant, pre-school, elementary, secondary and post-secondary education, information, namely information on mathematics, English, foreign language and science education; games and entertainment, namely educational computer games, manipulative games, to children, parents and families</p>
<p>Class 041. All goods and services in the class are opposed, namely: Providing a website featuring educational topics relating to mathematics, English, foreign language and science learning and children's</p>

entertainment namely, educational computer games, manipulative games; education services, namely, providing classes, seminars, workshops, tutoring, and mentoring in supplementary, remedial and enrichment education for infant, preschool, elementary, secondary and post-secondary students in the fields of mathematics, English, foreign languages and science education, rendered through learning centers, computer-based education centers and correspondence courses; educational services, namely, conducting on-line programs in supplementary, remedial and enrichment education for infant, preschool, elementary, secondary and post-secondary students in the fields of mathematics, English, foreign language and science education

Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Lack of Applicant's priority Trademark Act section 44(e) based on foreign registration.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3529200	Application Date	03/22/2006
Registration Date	11/04/2008	Foreign Priority Date	NONE
Word Mark	LEARNIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/08/31 First Use In Commerce: 2006/08/31 Instructional software for measuring, assessing and guiding student learning Class 016. First use: First Use: 2006/08/31 First Use In Commerce: 2006/08/31 Printed instructional assessment materials for measuring, assessing and guiding student learning in the fields of math and reading Class 041. First use: First Use: 2006/08/31 First Use In Commerce: 2006/08/31 Educational services, namely, providing online non-downloadable instructional assessment materials in the field of math and reading for measuring, assessing and guiding student learning		

Attachments	78843144#TMSN.jpeg (1 page)(bytes) NCS Pearson-Learna Education Notice of Opposition2009-07-29.pdf (8 pages)(447203 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	/Daniel J. DeVoe/
Name	Daniel J. DeVoe
Date	07/29/2009

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

In the Matter of Trademark Serial No.: 78/851,933
For the mark: **LEARNA**
Published in the Official Gazette on: March 31, 2009

NCS Pearson, Inc.)	
)	
vs.)	Opposition No: _____
)	
Learna Education Inc.)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

This opposition is made to the application of Applicant, Learna Education Inc., for registration of the mark LEARNA, Application Serial No. 78/851,933, published on March 31, 2009. Opposer, NCS Pearson, Inc., has obtained two extensions of time to oppose, expiring on July 29, 2009.

Opposer, NCS Pearson, Inc., believes it will be damaged by the registration of the mark shown in the application, and hereby opposes the same. As grounds for its opposition, Opposer states and alleges as follows:

1. Opposer, NCS Pearson, Inc. is a Minnesota corporation with its principal place of business located at 5601 Green Valley Drive, Bloomington, Minnesota 55437. Opposer is part of a global education company and a leader in education and education technology, providing innovative print and digital education materials for pre-K through professional learning, student information systems and learning management systems, teacher professional development,

career certification programs, and testing and assessment products that set the standard for the industry.

2. On information and belief, Applicant is a Canadian corporation with its principle place of business located at 5259 Lismic Blvd., Mississauga L5V 1P2 Canada.

3. As shown in the assignment recorded at Reel No. 3832/Frame No. 0587 in the records of the Assignment Branch of the U.S. Patent and Trademark Office, Opposer is the owner of Trademark Registration No. 3,529,200 for the mark LEARNIA, registered on November 4, 2008 on the Principal Register. This registration was based on an application filed by Opposer or its predecessor in title on March 22, 2006 of the LEARNIA mark for related goods and services for use with “Instructional software for measuring, assessing and guiding student learning; printed instructional assessment materials for measuring, assessing and guiding student learning in the fields of math and reading; and, educational services, namely, providing online non-downloadable instructional assessment materials in the field of math and reading for measuring, assessing and guiding student learning.”

4. Opposer’s registration is valid and subsisting. Opposer, or its predecessor in title, has used the registered trademark LEARNIA continuously in commerce on or in connection with the registered goods and services since at least as early as August 31, 2006. Opposer has established goodwill in connection with the sale of products under its trademark.

5. On April 1, 2006, Applicant filed an application to register the mark LEARNA, Application Serial No. 78/851,933, on the grounds of Section 44(e) relying on ownership of a foreign registration as a basis for registration in the United States, and Section 1(b) intent-to use. The mark was to be used in connection with “*Educational computer software for use in math, language and science learning that may be downloaded from a global computer network;*”

educational computer software for use in math, language and science learning; downloadable electronic educational publications and worksheets in the nature of study guides, notes and worksheets in the field of math, language and science learning; downloadable electronic books featuring topics relating to math, language and science learning recorded on computer media; video recordings, audio recordings and computer software recorded on cd-roms, dvd-roms, and prerecorded cassettes tapes featuring education, namely infant, pre-school, elementary, secondary and post-secondary education, information, namely information on mathematics, English, foreign language and science education; games and entertainment, namely educational computer games, manipulative games, to children, parents and families; and, providing a website featuring educational topics relating to mathematics, English, foreign language and science learning and children's entertainment namely, educational computer games, manipulative games; education services, namely, providing classes, seminars, workshops, tutoring, and mentoring in supplementary, remedial and enrichment education for infant, preschool, elementary, secondary and post-secondary students in the fields of mathematics, English, foreign languages and science education, rendered through learning centers, computer-based education centers and correspondence courses; educational services, namely, conducting on-line programs in supplementary, remedial and enrichment education for infant, preschool, elementary, secondary and post-secondary students in the fields of mathematics, English, foreign language and science education.”

6. Applicant’s LEARNA mark is (a) substantially identical in appearance, sound and connotation to Opposer’s LEARNIA mark, and (b) proposed for use on goods and services that are the same as, identical to and/or related to Opposer’s registered goods and services; and the

parties' products and services would be offered to, in substantial part, the same potential purchasers in the same markets.

7. Applicant's intended use of LEARNA for which registration is sought is likely to cause confusion, mistake or deception as to the source of origin, sponsorship or approval of Applicant's goods in that purchasers or others are likely to believe that Applicant's goods and services are Opposer's goods and services, or are in some way legitimately connected with, licensed by, or approved by Opposer.

8. Applicant's intended use of LEARNA, for which registration is sought in the application opposed herein, is without Opposer's consent or permission.

9. Applicant's intended use of LEARNA is so similar to Opposer's LEARNIA mark that it impairs the distinctiveness of the LEARNIA mark.

10. The association arising from the similarity of Applicant's LEARNA mark to Opposer's LEARNIA mark will harm the reputation of Opposer's LEARNIA mark.

11. Applicant's LEARNA trademark is so similar to the LEARNIA mark as to be likely to falsely suggest a connection between Applicant and Opposer.

12. In addition Opposer's rights in LEARNIA are superior to those that can be claimed by Applicant, as Opposer's constructive use date of its LEARNIA mark predates Applicant's applicable constructive use date for LEARNA.

13. An applicant may not file an application under §44(e) before the registration in the applicant's country of origin has issued. [TMEP §§1004 *et seq.* regarding §44(e)] Applicant's Trademark/Service Mark Application, Principal Register, Filing Date: 04/01/06, reads in part:

Based on Foreign Registration: Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of Canada registration number _____, registered _____ with a

renewal date of _____ and an expiration date of _____, and translation thereof, if appropriate. 15 U. S.C. Section 1126(e), as amended.

On September 15, 2006, the USPTO Trademark Examiner sent Applicant an Office Action and determined, in part, the following:

APPLICATION FILED PURSUANT TO SECTIONS 1(b) AND 44(e)

Applicant must advise the trademark-examining attorney whether applicant intends to rely solely on the foreign registration as the basis for registration. The foreign registration alone may serve as the basis for obtaining a U.S. registration resulting from this application. Unless applicant indicates otherwise, this Office will presume that the applicant wishes to rely on both Section 1(b) and Section 44(e) as the bases for registration. In this case, although the application may be approved for publication, the mark will not register until an acceptable allegation of use has been filed.

CERTIFICATE OF FOREIGN REGISTRATION REQUIRED - SECTION 44(e)

Applicant must submit a copy of the foreign registration to satisfy the requirement of Trademark Act Section 44(e). 15 U.S.C. §1126(e). If the foreign certificate of registration is not written in English, then applicant must provide an English translation signed by the translator. See TMEP §§1004.01 and 1004.01(b). The application does not presently contain a copy of the foreign registration. An application filed under Section 44(e) must include a true copy, photocopy, certification or certified copy of a foreign registration or a registered extension of protection of an international registration from the applicant's country of origin. If applicant's country of origin does not issue registrations or certificates of extension of protection, applicant may submit a copy of the international registration, showing that protection of the international registration has been extended to applicant's country of origin. TMEP §§1004 et seq. and 1016.

On March 14, 2007, Applicant's attorney sent a Response to Office Action, stating in part, the following:

Section 44(e), Based on Foreign Registration: *Applicant has a bona fide intention to use the mark in commerce on or in connection with the identified goods and/or services, and will submit a copy of [_____ registration number _____ registered _____ with a renewal date of _____ and an expiration date of _____], and translation thereof, if appropriate, before the application may proceed to registration. 15 U.S.C. Section 1126(e), as amended.*

On April 24, 2007, the Trademark Examiner sent a Notice of Suspension indicating that “action on this application is suspended pending receipt of a true copy, a photocopy, a certification, or a certified copy of a foreign registration from applicant’s country of origin.”

14. On February 19, 2009, a Response to Suspension Inquiry or Letter of Suspension was filed in which Applicant submitted a copy of Canada registration number TMA688883 registered 06/01/2007. Subsequently, the mark was published for opposition.

15. On March 31, 2009, the Application was published for opposition. Opposer requested and was granted two extensions of the deadline to file an opposition by the U.S. Patent and Trademark Office Trademark Trial and Appeal Board (“TTAB”), which extended the deadline to file an opposition by ninety days to July 29, 2009. Opposer had an initial meeting with Applicant’s attorney to discuss terms of settlement in this matter, and made several inquiries to and contact with Applicant’s attorney, who has indicated that attempts to establish contact with the Applicant have been unsuccessful. There has been no response by the Applicant to Opposer’s approaches. This Notice of Opposition, filed prior to the expiration of the extension period, is timely.

16. Opposer’s constructive use date for purposes of this opposition is March 22, 2006, Opposer’s U.S. Trademark Application Filing Date for the LEARNIA mark. The constructive use date of a qualified foreign national who files under Section 44(e) and Section 1(b) would be the U.S. Trademark Application filing date of the intent-to-use application. As noted above, Applicant’s U.S. filing date was April 1, 2006. Therefore, Applicant’s constructive use date can be no earlier than April 1, 2006.

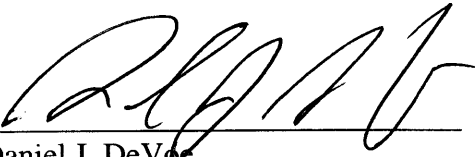
17. Because Opposer's applicable constructive use date (March 22, 2006) predates Applicant's applicable constructive use date (April 1, 2006), Opposer's trademark rights in LEARNIA are superior to any alleged trademark rights in LEARNA of Applicant.

WHEREFORE, eventual use and registration by Applicant of the aforesaid trademark for the aforesaid goods and services would be damaging to Opposer.

THEREFORE, Opposer, NCS Pearson, Inc., respectfully requests that application Serial No. 78/851,933 be rejected and that registration of the mark LEARNA be refused.

Respectfully submitted,

Dated: July 29, 2009




Daniel J. DeVoe
Assistant General Counsel
NCS PEARSON, INC.
5601 Green Valley Drive
Bloomington, Minnesota 55437
Tel.: (952) 681-3070
Fax: (952) 681-3066
E-mail: dan.devoe@pearson.com

Attorney for Opposer

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the NOTICE OF OPPOSITION was served by United States mail on the attorney of record for Applicant, Dean R. Karau, FREDRIKSON & BYRON, P.A., 200 South Sixth Street, Suite 4000, Minneapolis, MN 55402-1425, by mailing it to the address of record by first class mail, postage prepaid, this 29th day of July, 2009.



Daniel J. DeVoe