

ESTTA Tracking number: **ESTTA388904**

Filing date: **01/18/2011**

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	Couch/Braunsdorf Affinity, Inc.
Granted to Date of previous extension	01/16/2011
Address	2561 Territorial Road St. Paul, MN 55114 UNITED STATES

Attorney information	Philip A. Jones Brinks Hofer Gilson & Lione P.O. Box 10395 Chicago, IL 60610 UNITED STATES officeactions@brinkshofer.com
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Applicant Information

Application No	77938413	Publication date	07/20/2010
Opposition Filing Date	01/18/2011	Opposition Period Ends	01/16/2011
Applicant	Meijer, Inc. 2929 Walker Ave., N.W. Grand Rapids, MI 49544 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2010/02/02 First Use In Commerce: 2010/02/02 All goods and services in the class are opposed, namely: Promoting retail and grocery sales by offering a customer incentive award program with features allowing participants to receive special deals or to earn and accrue points to be redeemed at a later date for free or discounted goods and services; promoting the goods and services of others by providing coupons and certificates which may be redeemed for the goods or services of others; advertising agency services, namely, promoting the services of grocery and retail stores through the distribution of point of sale materials

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.	1786961	Application Date	11/16/1990
Registration Date	08/10/1993	Foreign Priority Date	NONE

Word Mark	PERKS
Design Mark	
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1988/03/24 First Use In Commerce: 1988/03/24 providing volume discount buying services to others

U.S. Registration No.	2580914	Application Date	05/17/2000
Registration Date	06/18/2002	Foreign Priority Date	NONE
Word Mark	PERKSCARD		
Design Mark	PERKSCARD		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1997/05/00 First Use In Commerce: 1997/05/00 Buying services, namely, providing volume discounts for consumer products and services		

U.S. Registration No.	3210654	Application Date	10/21/2005
Registration Date	02/20/2007	Foreign Priority Date	NONE
Word Mark	PERKS		
Design Mark	Perks		
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1988/03/24 First Use In Commerce: 1988/03/24 Buying services, namely, providing volume discounts for consumer products and services via a magnetically encoded card		

U.S. Registration No.	3156685	Application Date	04/11/2005
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	PERKSCARD		

Design Mark	<h1>PerksCard</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1997/01/05 First Use In Commerce: 1997/01/05 Buying services, namely, providing volume discounts for consumer products and services

Attachments	76051909#TMSN.gif (1 page)(bytes) 78737799#TMSN.jpeg (1 page)(bytes) 78606012#TMSN.jpeg (1 page)(bytes) 2011-01-18 - Notice of Opposition - Meijer - MPERKS.pdf (10 pages)(106791 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	/Joshua S. Frick/
Name	Joshua S. Frick
Date	01/18/2011

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

COUCH/BRAUNSDORF AFFINITY, INC.)	
)	
Opposer,)	Opposition No. _____
)	
v.)	Serial No. 77/938,413
)	
MEIJER, INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Couch/Braunsdorf Affinity, Inc. (“Perks”), a corporation duly organized and existing under the laws of the State of New Jersey, with its principal place of business in St. Paul, Minnesota, believes it will be damaged by the registration of the MPERKS mark, Serial No. 77/938,413 (the “Opposed Mark”), in the name of Meijer, Inc. (“Applicant”), 2929 Walker Ave., N.W. Grand Rapids, Michigan 49544, and hereby opposes said applications pursuant to 15 U.S.C. § 1063.

In support of this Notice of Opposition, Perks states as follows:

1. Perks is a leading business in the affinity and promotional industry, providing volume discounts for consumer products and services to others. Perks owns and uses in commerce the distinctive service marks PERKS and PERKSCARD in connection with these services.
2. Perks contracts with employers to negotiate discounts and services offered by third parties for employees. Perks provides discount cards under the PERKSCARD mark to employees that may be utilized at third party businesses or over the internet. For example, employees may receive discounts on food, clothing, trips, day care and medical benefits.

3. Over the past 20 years, Perks has grown its business. Perks now has contracts with many national employers. Perks has distributed millions of PERKSCARD discount cards nationwide to employees.

4. PERKS has been used in commerce since at least as early as March 24, 1988, and has been used continuously in commerce since that date. PERKSCARD has been used in commerce since at least as early as May 1997, and has been used continuously in commerce since that date.

5. Perks has invested considerable money, time and effort into the development of the PERKS and PERKSCARD marks. These marks have become assets of incalculable value for Perks as immediately recognizable and well-known indicators of source of the company's high quality services, or at least a single source for the services.

6. Perks owns a number of federal trademark registrations for the PERKS and PERKSCARD marks as set forth below:

Mark	Reg. No.	Reg. Date	Goods/Services	Class
PERKS	1,786,961	August 10, 1993	Providing volume discount buying services to others	35
PERKSCARD	2,580,914	June 18, 2002	Buying services, namely, providing volume discounts for consumer products and services	35
PERKS	3,210,654	February 20, 2007	Buying services, namely, providing volume discounts for consumer products and services via a magnetically encoded card	35
PERKSCARD	3,156,685	October 17, 2006	Buying services, namely, providing volume discounts for consumer products and services	35

7. Copies of the federal registration certificates for the above-referenced marks are attached as Exhibit 1. These federal registrations are valid, subsisting and in full force and effect. Perks' federal registration certificates are prima facie evidence of the validity of these

marks as well as Perks' ownership and exclusive right to use these marks in connection with the identified services. 15 U.S.C. § 1057(b).

8. Perks' right to use in commerce PERKS and PERKSCARD is incontestable pursuant to 15 U.S.C. § 1065.

9. After Perks' first use of the PERKS and PERKSCARD marks, and after the PTO issued federal registrations for the PERKS and PERKSCARD marks, Applicant filed an application to register the Opposed Mark. The application has an identification of services which reads "Promoting retail and grocery sales by offering a customer incentive award program with features allowing participants to receive special deals or to earn and accrue points to be redeemed at a later date for free or discounted goods and services; promoting the goods and services of others by providing coupons and certificates which may be redeemed for the goods or services of others; advertising agency services, namely, promoting the services of grocery and retail stores through the distribution of point of sale materials." in Class 35.

10. Applicant appears to be using the Opposed Mark in association with the identified services.

11. At the time it filed its application to register the Opposed Mark, Applicant had constructive knowledge of Perks' rights in the PERKS and PERKSCARD marks.

12. The Opposed Mark is confusingly similar in sight, sound, and commercial impression to the PERKS and PERKSCARD marks. The registration of the Opposed Mark in association with the identified services is likely to cause confusion as to the source or origin of Applicant's services, and is likely to mislead consumers, all to Perks' damage.

13. The Opposed Mark, as used in connection with the identified services is likely to cause confusion in the minds of the public, and is likely to deceive purchasers. The public, upon seeing the Opposed Mark in connection with Applicant's services, would believe that such services originate with, or have some connection with Perks. Accordingly, registration of the

Opposed Mark would seriously damage Perks, and registration therefore should be refused pursuant to 15 U.S.C. §1052.

WHEREFORE, Perks believes that it will be damaged by registration of the Opposed Mark which is the subject of United States Trademark Application Serial Nos. 77/938,413, and therefore respectfully requests that such registration be refused on the grounds of likelihood of confusion

The Director hereby is authorized to charge the filing fee for this Notice of Opposition to Deposit Account No. 23-1925.

Respectfully submitted,

COUCH/BRAUNSDORF AFFINITY GROUP, INC.

Dated: January 18, 2011

By: /Joshua S. Frick/
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Joshua S. Frick
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Attorneys for Opposer

CERTIFICATE OF SERVICE

I hereby certify that on January 18, 2011 I served a true and correct copy of the foregoing NOTICE OF OPPOSITION on counsel for Applicant by U.S. mail and e-mail addressed as follows:

Robert J. VerHeulen
Robert.VerHeulen@meijer.com
Meijer, Inc.
2929 Walker Ave. N.W.
Grand Rapids, MI 49544-9428

/Joshua S. Frick/
One of the Attorneys for Opposer
Couch/Braunsdorf Affinity, Inc

Exhibit 1

Int. Cl.: 35

Prior U.S. Cl.: 101

United States Patent and Trademark Office **Reg. No. 1,786,961**
Registered Aug. 10, 1993

**SERVICE MARK
PRINCIPAL REGISTER**

PERKS

PERKS UNLIMITED, INC. (NEW YORK COR-
PORATION)
153 MAIN STREET
SAYVILLE, NY 11782

FOR: PROVIDING VOLUME DISCOUNT
BUYING SERVICES TO OTHERS, IN CLASS 35
(U.S. CL. 101).

FIRST USE 3-24-1988; IN COMMERCE
3-24-1988.

SER. NO. 74-116,046, FILED 11-16-1990.

G. MAYERSCHOFF, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 2,580,914

Registered June 18, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

PERKSCARD

PERKS UNLIMITED, INC. (NEW YORK COR-
PORATION)
565 ROUTE 25A
MILLER PLACE, NY 117642600

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 5-0-1997; IN COMMERCE 5-0-1997.

OWNER OF U.S. REG. NO. 1,786,961.

SER. NO. 76-051,909, FILED 5-17-2000.

NICHOLAS ALTREE, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,210,654

Registered Feb. 20, 2007

SERVICE MARK
PRINCIPAL REGISTER

Perks

COUCH BRAUNSDORF/AFFINITY, INC. (NEW
JERSEY CORPORATION)
701 MARTINSVILLE ROAD
LIBERTY CORNER, NJ 07938

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES VIA A MAGNETICALLY
ENCODED CARD, IN CLASS 35 (U.S. CLS. 100, 101
AND 102).

FIRST USE 3-24-1988; IN COMMERCE 3-24-1988.

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

OWNER OF U.S. REG. NOS. 1,786,961, 2,580,914,
AND 3,045,459.

SER. NO. 78-737,799, FILED 10-21-2005.

ESTHER A. BORSUK, EXAMINING ATTORNEY

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,156,685

Registered Oct. 17, 2006

**SERVICE MARK
PRINCIPAL REGISTER**

PerksCard

COUCH/BRAUNSDORF AFFINITY, INC. (NEW
JERSEY CORPORATION)
701 MARTINSVILLE ROAD
LIBERTY CORNER, NJ 07938

FOR: BUYING SERVICES, NAMELY, PROVID-
ING VOLUME DISCOUNTS FOR CONSUMER PRO-
DUCTS AND SERVICES, IN CLASS 35 (U.S. CLS. 100,
101 AND 102).

FIRST USE 1-5-1997; IN COMMERCE 1-5-1997.

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

SER. NO. 78-606,012, FILED 4-11-2005.

HOWARD SMIGA, EXAMINING ATTORNEY