

ESTTA Tracking number: **ESTTA463950**

Filing date: **03/27/2012**

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	ePrize, LLC
Granted to Date of previous extension	04/04/2012
Address	One ePrize Drive Pleasant Ridge, MI 48069 UNITED STATES

Correspondence information	ePrize, LLC One ePrize Drive Pleasant Ridge, MI 48069 UNITED STATES ptopinbox@reedsmith.com, chughes@reedsmith.com Phone:4122883008
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Applicant Information

Application No	85189542	Publication date	12/06/2011
Opposition Filing Date	03/27/2012	Opposition Period Ends	04/04/2012
Applicant	X PRIZE Foundation, Inc. 5510 Lincoln Boulevard, Ste 100 Playa Vista, CA 90094 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. All goods and services in the class are opposed, namely: Promoting awareness of the need for the development and creation of technological innovations and inventions
Class 041. All goods and services in the class are opposed, namely: Providing recognition and incentives by the way of awards to demonstrate excellence in the field of the development and creation of technological innovations and inventions

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration	2892758	Application Date	05/23/2003
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No.			
Registration Date	10/12/2004	Foreign Priority Date	NONE
Word Mark	EPRIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1999/04/00 First Use In Commerce: 1999/04/00 Promoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products</p>		

U.S. Application No.	85337463	Application Date	06/03/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	EPRIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 1999/04/01 First Use In Commerce: 1999/04/01 Promoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products</p>		

U.S. Registration	2918479	Application Date	05/23/2003
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No.			
Registration Date	01/18/2005	Foreign Priority Date	NONE
Word Mark	EPRIZE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1999/11/00 First Use In Commerce: 1999/11/00 Promoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products		

Attachments	76516849#TMSN.gif (1 page)(bytes) 85337463#TMSN.jpeg (1 page)(bytes) 76517024#TMSN.jpeg (1 page)(bytes) E PRIZE opposition (3.27.12).pdf (13 pages)(38372 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	/Kirsten R. Rydstrom/
Name	ePrize, LLC
Date	03/27/2012

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

<p>EPRIZE, LLC</p> <p style="text-align:right">Opposer,</p> <p style="text-align:center">v.</p> <p>X PRIZE FOUNDATION, INC.</p> <p style="text-align:right">Applicant.</p>	<p>Opposition No. _____</p>
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App. No.: 85/189,542
Filing Date: December 2, 2010
Pub. Date: December 6, 2011
Mark: E PRIZE

Box TTAB-FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Opposer ePrize, LLC (“ePrize”) believes that it will be damaged by the registration of the above-identified mark and therefore hereby opposes such registration, pursuant to 15 U.S.C. §§ 1052, 1063 and 37 C.F.R. § 2.101.

As grounds for its opposition, ePrize alleges:

1. ePrize is a limited liability company duly organized and existing under the laws of Michigan and located at One ePrize Drive, Pleasant Ridge, Michigan, 48069.

2. Since its founding in 1999, ePrize has been in the business of providing business and advertising services for its clients in the form of online sweepstakes, points-based loyalty programs, and other promotional campaigns.

3. Since at least as early as April 1999, ePrize has been continuously using its EPRIZE trademark in connection with its provision of its business and advertising services. During this time, ePrize has used its EPRIZE trademark in various forms, including “EPRIZE” and “EPRIZE & *DESIGN*” (collectively, “the EPRIZE Marks”). This use has been continuous to the present day.

4. ePrize has used its EPRIZE and EPRIZE & *DESIGN* marks extensively and continuously in interstate commerce for approximately 12 years, and has acquired considerable goodwill and wide-scale recognition for its marks. The public has come to associate the EPRIZE Marks with ePrize and its services.

5. As a result of ePrize’s extensive marketing efforts and use for nearly 12 years, the EPRIZE Marks have become famous in their industry and represent goodwill of tremendous value to ePrize.

6. In connection with this long-standing use, ePrize sought and obtained a United States Trademark Registration for its EPRIZE mark in connection with “[p]romoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products” in International Class 35. See U.S. Trademark Reg. No. 2,892,758 (“the ‘758 Registration”).

7. The ‘758 Registration issued on January 18, 2005 and claimed a date of first use as early as April, 1999.

8. The '758 Registration was cancelled on May 13, 2011 after ePrize inadvertently failed to timely file its Section 8 declaration. Notwithstanding the cancellation, ePrize's actual use of the mark has been continuous since its first use in 1999 to the present date.

9. Immediately thereafter, on June 3, 2011, ePrize filed Application Serial No. 85/337,463 ("the '463 Application") for the word mark EPRIZE in connection with "[p]romoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products" in International Class 35.

10. The '463 Application is currently pending.

11. ePrize has also sought and obtained a United States Trademark Registration for its EPRIZE & DESIGN mark in connection with "[p]romoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products" in International Class 35. See U.S. Trademark Reg. No. 2,918,479 ("the '479 Registration"). The '479 Registration issued on January 18, 2005.

12. ePrize's use of the EPRIZE & DESIGN mark commenced as early as November 1999.

13. The EPRIZE Marks are a vital asset of ePrize, and ePrize has invested and continues to invest significant effort and resources in promoting and protecting its EPRIZE Marks.

14. Applicant, X Prize Foundation, Inc. (“Applicant”) is a Delaware Corporation located at 5510 Lincoln Boulevard, Suite 100, Playa Vista, CA 90094.

15. By way of U.S. Trademark Application Serial No. 85/189,542 (“the ‘542 Application”), filed on December 2, 2010, Applicant seeks to register the mark E PRIZE (“Applicant’s Mark”) in connection with “[p]romoting awareness of the need for the development and creation of technological innovations and inventions” in International Class 35 and “[p]roviding recognition and incentives by the way of awards to demonstrate excellence in the field of the development and creation of technological innovations and inventions” in International Class 41.

16. The ‘542 Application published for opposition on December 6, 2011. On December 15, 2011, the Trademark Trial and Appeal Board (the “Board”) granted Opposer’s request to extend the time to oppose the ‘542 Application until April 4, 2012.

17. Applicant filed the ‘542 Application on an intent-to-use basis.

18. ePrize’s use of its EPRIZE Marks predates any priority date that can validly be claimed by Applicant for Applicant’s Mark, including the filing date of the ‘542 Application.

19. Applicant’s E PRIZE mark and the services sought by way of the ‘542 Application are so similar to Opposer’s EPRIZE Marks and the services offered by ePrize thereunder that the former are likely to cause confusion, or to cause mistake, or to deceive as to the origin of the respective goods and services, and/or as to the affiliation, connection, or

association of Applicant with ePrize, and/or as to the sponsorship or approval of Applicant's services or activities by ePrize, all to the detriment and damage of ePrize and its EPRIZE Marks.

20. Applicant's use of E PRIZE in connection with the services identified in the '542 Application would also dilute the distinctive character of Opposer's valuable EPRIZE Marks and their established goodwill.

21. In addition, registration of Applicant's E PRIZE mark will provide Applicant with a *prima facie* exclusive right to use its mark thereby creating a potential source of damage to ePrize and will give the impression of Applicant's exclusivity and statutory rights in violation and derogation of the prior and superior rights of ePrize.

22. Opposer will also be harmed if Applicant's '542 Application is allowed to register and ePrize's pending application is denied registration as a result. ePrize's pending '463 Application for EPRIZE has been initially refused registration by the Trademark Examining Attorney based in part on Applicant's '542 Application for E PRIZE. *See* Ex. A, September 26, 2011 Office Action. Citing that the '542 Application has an earlier *filing* date, the Trademark Examining Attorney explained that if Applicant's E PRIZE mark registers, ePrize's EPRIZE mark "may be refused registration under Trademark Act Section 2(d) because of a *likelihood of confusion between the two marks.*" *See id.* (emphasis added)

23. For the foregoing reasons, ePrize will be damaged by the Applicant's registration of E PRIZE.

24. Because a likelihood of confusion exists between the marks and services of ePrize and Applicant, and because ePrize has priority, Applicant is not entitled to registration of its confusingly similar E PRIZE mark for the goods and services claimed in the '542 Application.

WHEREFORE, ePrize, by its undersigned attorneys, respectfully request that its Opposition be sustained and that the registration sought by U.S. Service Mark Application Serial No. 85/189,542 for the mark E PRIZE be denied.

Dated: March 27, 2012

Respectfully submitted,

REED SMITH LLP

By: /s/ Kirsten R. Rydstrom
Kirsten R. Rydstrom
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225 Fifth Avenue
Suite 1200
Pittsburgh, PA 15222

Attorneys for Opposer, ePrize, LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Notice of Opposition has been served on Applicant and Applicant's Attorney of Record by way of First Class U.S. mail to the following:

NICK E. WILLIAMSON
BRYAN CAVE LLP
211 NORTH BROADWAY, STE 3600
ST. LOUIS, MO 63102

X PRIZE FOUNDATION, INC.
5510 LINCOLN BOULEVARD, STE 100
PLAYA VISTA, CA 90094

Dated: March 27, 2012

/s/ Clay P. Hughes

EXHIBIT A

To: ePrize, LLC (ptoipinbox@reedsmith.com)
Subject: U.S. TRADEMARK APPLICATION NO. 85337463 - EPRIZE - 11-182-US
Sent: 9/26/2011 2:52:54 PM
Sent As: ECOM113@USPTO.GOV
Attachments: [Attachment - 1](#)
[Attachment - 2](#)
[Attachment - 3](#)
[Attachment - 4](#)
[Attachment - 5](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 85337463

MARK: EPRIZE

85337463

CORRESPONDENT ADDRESS:

KIRSTEN R. RYDSTROM
REED SMITH LLP
PO BOX 488
PITTSBURGH, PA 15230-0488

CLICK HERE TO RESPOND TO THIS LETTER:

http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: ePrize, LLC

CORRESPONDENT'S REFERENCE/DOCKET

NO:

11-182-US

CORRESPONDENT E-MAIL ADDRESS:

ptoipinbox@reedsmith.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 9/26/2011

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no similar registered mark that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d). However, a mark in a prior-filed pending application may present a bar to registration of applicant's mark.

PRIOR PENDING APPLICATION

The filing date of pending Application Serial No. 85189542 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

SIGNED VERIFICATION REQUIREMENT

The application was not signed and verified, which are application requirements. *See* 15 U.S.C. §1051(a); 37 C.F.R. §§2.33(a)-(b)(1), 2.34(a)(1)(i). Therefore, applicant must verify the statements specified further below in a signed affidavit or declaration under 37 C.F.R. §2.20. *See* 15 U.S.C. §1051(a)(3); 37 C.F.R. §§2.33(a)-(b)(1), (c), 2.193(e)(1); TMEP §§804.02, 806.01(a).

If applicant responds to this Office action online via the Trademark Electronic Application System (TEAS), applicant may satisfy this requirement by answering "yes" to the TEAS response form wizard question relating to submitting a "signed declaration," and following the instructions within the form for signing. *See* 37 C.F.R. §§2.33(a)-(b)(1), (c), 2.193(a), (c)-(d), (e)(1); TMEP §§611.01(c), 804.01(b).

If applicant responds to this Office action on paper, via regular mail, applicant may satisfy this requirement by providing the following statements and declaration at the end of the response, personally signed and dated by a person authorized under 37 C.F.R. §2.193(e)(1). *See* 37 C.F.R. §§2.20, 2.33(a)-(b)(1), (c), 2.193(a), (d); TMEP §§611.01(b), 804.01(b).

STATEMENTS: The undersigned is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered; the mark is in use in commerce and was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date; the specimen shows the mark as used on or in connection with the goods or services listed in the application; the facts set forth in the application are true and accurate; and to the best of the undersigned's knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

DECLARATION: The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any

registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

CLAIM OF OWNERSHIP OF A PRIOR REGISTRATION

If applicant is the owner of U.S. Registration No. 2918479, then applicant must submit a claim of ownership. *See* 37 C.F.R. §2.36; TMEP §812. The following standard format is suggested:

Applicant is the owner of U.S. Registration No. 2918479.

IDENTIFICATION OF SERVICES REQUIREMENTS

THIS REQUIREMENT APPLIES ONLY TO THE SERVICES SPECIFIED THEREIN

The remainder of the identification is acceptable.

Applicant must clarify the words “and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products” in the identification of services by specifying the purpose. *See* TMEP §1402.01.

Applicant may adopt the following identification of services, if accurate. The suggested amendments appear in bold:

Promoting the goods and services of others through the development and implementation of pooled and custom sweepstakes, contests, marketing referral programs, coupons, and promotional products; developing and placing advertisements for others regarding sweepstakes, contests, marketing referral programs, coupons, and promotional products; and, compiling and analyzing the data gathered from participants in sweepstakes, contests, marketing referral programs, coupons, and promotional products **for business marketing purposes**, in international class 35

An applicant may amend an identification of services only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

For an application with more than one international class, called a “multiple-class application,” an applicant must meet all of the requirements below for those international classes based on use in commerce:

- (1) LIST GOODS AND/OR SERVICES BY INTERNATIONAL CLASS: Applicant must list the goods and/or services by international class;

(2) PROVIDE FEES FOR ALL INTERNATIONAL CLASSES: Applicant must submit an application filing fee for each international class of goods and/or services not covered by the fee(s) already paid (confirm current fee information at <http://www.uspto.gov>, click on “View Fee Schedule” under the column titled “Trademarks”); and

(3) SUBMIT REQUIRED STATEMENTS AND EVIDENCE: For each international class of goods and/or services, applicant must also submit the following:

(a) DATES OF USE: Dates of first use of the mark anywhere and dates of first use of the mark in commerce, or a statement that the dates of use in the initial application apply to that class. The dates of use, both anywhere and in commerce, must be at least as early as the filing date of the application.;

(b) SPECIMEN: One specimen showing the mark in use in commerce for each international class of goods and/or services. Applicant must have used the specimen in commerce at least as early as the filing date of the application. If a single specimen supports multiple international classes, applicant should indicate which classes the specimen supports. Examples of specimens for goods are tags, labels, instruction manuals, containers, photographs that show the mark on the actual goods or packaging, or displays associated with the goods at their point of sale. *See* TMEP §§904.03 *et seq.* Examples of specimens for services are signs, photographs, brochures, website printouts, or advertisements that show the mark used in the actual sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*;

(c) STATEMENT: The following statement: “**The specimen was in use in commerce on or in connection with the goods and/or services listed in the application at least as early as the filing date of the application.**”; and

(d) VERIFICATION: Applicant must verify the statements in 3(a) and 3(c) (above) in an affidavit or signed declaration under 37 C.F.R. §2.20. Verification is not required where (1) the dates of use for the added class are stated to be the same as the dates of use specified in the initial application, and (2) the original specimens are acceptable for the added class(es).

See 15 U.S.C. §§1051(a), 1112, 1127; 37 C.F.R. §§2.32(a)(5), 2.34(a)(1), 2.56(a), 2.71(c), 2.86(a), 2.193(e)(1); TMEP §§1403.01, 1403.02(c).

With respect to the specimen requirement in 3(b) above in which a specimen is required for each international class of goods and/or services, the specimen(s) of record is acceptable for International Class(es) 35 only. Applicant must submit additional specimens if different international classes are added to the application.

/Khanh M. Le/
Trademark Examining Attorney
U.S. Patent & Trademark Office
Law Office 113

(571) 272-9435
khanh.le@uspto.gov

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/ mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.