

ESTTA Tracking number: **ESTTA590259**

Filing date: **03/03/2014**

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	Orange Brand Services Limited
Granted to Date of previous extension	03/02/2014
Address	3 More London Riverside London, SE1 2AQ UNITED KINGDOM

Domestic Representative	Dickerson M. Downing Partner Crowell & Moring LLC 590 Madison Avenue New York, NY 10022 UNITED STATES edocket@crowell.com, ddowning@crowell.com, hcostello@crowell.com, ckornett@crowell.com Phone:212 895-4212
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Applicant Information

Application No	85749504	Publication date	09/03/2013
Opposition Filing Date	03/03/2014	Opposition Period Ends	03/02/2014
Applicant	Mullis, Melinda Suite 403 Honolulu, HI 96818 USX		

Goods/Services Affected by Opposition


Class 035. First Use: 2004/12/01 First Use In Commerce: 2006/12/31

All goods and services in the class are opposed, namely: Dissemination of advertising for others via the Internet; online advertising services, namely, providing advertising distribution service to display a random rotation of advertisements on internet web sites; providing advertising campaign management services in the nature of tracking, analyzing, and reporting on consumer data, demographics, and consumer behavioral information, computer network use and users for business purposes, and consumer responses to advertisements and promotional materials; On-line advertising and marketing services; Advertising agencies specializing in marketing strategies to promote business in the food service industry, design of word of mouth, viral, buzz and experiential marketing program; Advertising and business management consultancy; Advertising and publicity services, namely, promoting the goods, services, brand identity and commercial information and news of third parties through print, audio, video, digital and on-line medium; Advertising services, namely, creating corporate logos for others; Advertising services, namely, creating corporate and brand identity for others; Production of advertising materials; Production of advertising matter and commercials; Promoting, advertising and marketing the on-line databases and electronic publications of others

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.	4208120	Application Date	02/23/2001
Registration Date	09/18/2012	Foreign Priority Date	NONE
Word Mark	ORANGE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Advertising, namely, developing and producing advertising campaigns for businesses; developing promotional campaigns for businesses; business management; retail services in the form of store services, mail order services and on-line computer retail services all in the fields of telecommunications, computing, global computer networks, motor racing, the arts, business information, product promotion, financial information, real estate information, stocks and shares information, travel, entertainment, sports, cultural events and restaurants, featuring a bonus incentive program for customers, and promoting the goods and services of others by means of an incentive awards program; business information services, namely, market research, business analysis, business investigation; mail order services featuring general merchandise; facilitating business networking; business research and survey services; business forecasting services; clerical and secretarial services; auctioneering provided on the Internet; transactional processing of Internet sales; public relations; publicity agents; economic forecasting; business information and consulting services concerning the supplying and promoting of commodities and selection of display of goods; consumer information and consulting services provided to the prospective purchasers of commodities and goods; dissemination and compilation of advertising for others via on-line electronic communications network; compilation of directories for publishing on the Internet in the fields of telecommunications, computing, global computer networks, motor racing, the arts, business information, product promotion, financial information, real estate information, stocks and shares information, maintenance and repair of telecommunications installations, networks, telephones and computer equipment, travel, entertainment, sports, cultural events, travel and restaurants; provision of space on websites for others for the purpose of advertising goods and services; computerized database management and data processing services; telephone answering and organization and handling of voice and fax messages; computerized data management and inventory control, provided electronically; art gallery services provided on-line via a telecommunications link; incentive rewards redemption, namely, conducting transactions in the form of</p>		

	redeeming points awarded through a customer loyalty program in return for gifts up to the value of those points
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U.S. Registration No.	4228205	Application Date	12/21/1999
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Registration Date	10/23/2012	Foreign Priority Date	07/16/1999
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Word Mark	ORANGE WORLD
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Design Mark	<h1>ORANGE WORLD</h1>
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Developing and producing advertising campaigns for businesses; developing promotional campaigns for businesses; business management; promoting the goods and services of others by means of a preferred customer program featuring financial discounts, preferential pricing programs and gifts and retail services, namely retail stores, retail distributorships, retail outlets, retail mail order services and computerized on-line retail services in the field of telecommunications, computing, the Internet, motor racing, the arts and business, finance, vehicles, travel, entertainment, all featuring bonus incentive programs for customers; business information services, namely market research, business analysis, business investigation; mail order services featuring general merchandise; business information and consulting services concerning the supplying and promoting of commodities and selection and display of goods; computerized database management; dissemination and compilation of advertising for others via on-line electronic communications network; computerized database management and data processing services for others; telephone answering and telephone answering and organization and handling of voice, fax and text messages; providing an on-line computer database in the field of business and product promotion; incentive rewards redemption, namely, conducting transactions in the form of redeeming points awarded through a customer loyalty program in return for gifts up to the value of those points</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Financing of telecommunications apparatus, systems and installations; charitable fund raising services, namely, organizing charitable collections and fund raising activities; financial sponsorship in the area of sports, cultural activities and the arts; providing extended warranties and insurance for telecommunications and computing equipment and devices, telecommunications and computing networks and systems, broadband and other Internet access services</p> <p>Class 037. First use: First Use: 0 First Use In Commerce: 0 Installation, maintenance and repair of telecommunications apparatus and systems, telephones, mobile telephones and telephone handsets, paging apparatus, radiopaging apparatus, radio telephone apparatus, computers and personal organizers, computers, satellite transmitters and receivers; information and consulting services relating to all the aforementioned; providing an on-line</p>
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computer database in the field of maintenance and repair

Class 038. First use: First Use: 0 First Use In Commerce: 0

Telecommunications and communication services, namely, telephone, facsimile and user to user teleprinter exchange services; electronic message collection and transmission; radio-paging and electronic mail services; electronic transmission and reception of data and of information; providing information in the field of telecommunications via website accessed via a global computer network; electronic data interchange services; providing frame relay connectivity services for the transfer of data; satellite communication services; broadcasting transmission of radio or television programs; providing multiple-user access to the Internet; providing telecommunications connections to the Internet or computer databases; telecommunication gateway services; computer aided transmission of messages and images; communication by computer; leasing and rental of telecommunications equipment; provision of access to an electronic on-line network for information retrieval; providing multiple-user access to the Internet, such access facilities to be provided in a cafe, bar, cafeteria, bistro, restaurant or coffee house setting

Class 041. First use: First Use: 0 First Use In Commerce: 0

Education and training services relating to the field of telecommunications in the form of interactive and distance learning, services provided on-line by a telecommunication or computer network or by telephone or mail; organizing and staging of educational and training initiatives and events which relate to information concerning telecommunications and for use in relation to the operation and management of telecommunications equipment apparatus and installations and the operation and management of a telecommunications network service; educational services relating to business operations, information technology and computers in the form of interactive and distance learning, services provided on-line by a telecommunication or computer network or by telephone or mail; educational and training courses provided over the Internet which relate to information concerning telecommunications and for use in relation to the operation and management of telecommunications equipment apparatus and installations and the operation and management of a telecommunications network service; organizing and staging of cultural and entertainment initiatives, competitions and events in the fields of science, technology, sports, the arts, business, finance, literature, vocations, telecommunications, computing and the Internet; information relating to education or entertainment by means of the Internet, telephone, mail or in person; providing on-line computer games; publication of books and journals provided on-line from a computer database or from a global computer information network; provision of information relating to all the aforesaid services by means of the Internet, telephone, mail or in person; providing an on-line computer database in the field of entertainment, sports and cultural events

Class 042. First use: First Use: 0 First Use In Commerce: 0

Preparation of food and drink; catering services; restaurant services; cafe and cafeteria services; snack bar services; fast-food restaurant services; computer services, namely maintenance, updating and design of computer software and programs for others; computer programming services for others; information services in the field of computers and computer network facilities; on-line computer programming for others; computer rental; design, drawing and commissioned writing, all for the compilation of web pages on the Internet; creating and maintaining web sites for others; hosting the web sites of others; installation and maintenance on computer software; security and fraud prevention information and consultancy services; arranging of insurance security registration services for the protection of mobile telephones and their accessories against loss, theft or damage; horoscope forecasting; weather forecasting; news and current affairs information services; hotel reservation services for others; telecommunication consulting services; database development services; consultation services rendered in conjunction with all the

	aforementioned services; providing an on-line computer database in the field of computing and restaurants
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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	/dmd/
Name	Dickerson M. Downing
Date	03/03/2014

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

In the Matter of Application No. 85-749,504 for
ORANGEROC in International Class 35
Published for opposition in the Official Gazette of
September 3, 2013

ORANGE BRAND SERVICES LIMITED,

Opposer,

Opposition No.

v.

MELINDA MULLIS,

Applicant.

NOTICE OF OPPOSITION

Opposer, Orange Brand Services Limited (“Opposer”), an English company with offices in London, England believes it will be damaged by registration of the mark ORANGEROC as shown in Application Serial No. 85-749,504 and, having been granted timely requests for extensions of time to oppose until March 3, 2014, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is the owner of rights in and to the name and mark ORANGE and variations thereon (“ORANGE Mark”), in the United States and elsewhere, in connection with a wide variety of goods and services including services similar to the services identified in the opposed application (“ORANGE Services”).

2. Opposer’s rights in the ORANGE Mark in connection with ORANGE Services are prior and superior to any rights of Applicant in the mark sought to be registered in the opposed application.

3. Opposer's prior rights in the ORANGE Mark, in part, are reflected by the prior use by a related company of variations of the ORANGE Mark in commerce in connection with ORANGE Services and by its ownership of a number of United States Trademark Registrations covering relevant services including United States Trademark Registration No. 4,208,120 for ORANGE for a wide variety of advertising services and related services in International Class 35 as filed on February 23, 2001, with a foreign filing priority date of November 13, 2000, and registered on September 18, 2012 and United States Trademark Registration No. 4,228,205 for ORANGE WORLD for a wide variety of advertising services and related services in International Class 35 as filed on December 21, 1999, with a foreign filing priority date of July 16, 1999, and registered on October 23, 2012 as well as numerous other ORANGE trademark registrations and applications in the United States.

4. Notwithstanding, Opposer's prior rights in the ORANGE Mark for ORANGE Services in the United States, on or about October 9, 2012, Applicant filed the opposed application to register ORANGEROC, based on a claimed date of first use of December 1, 2004, for "Dissemination of advertising for others via the Internet; online advertising services,..." and other advertising services and related services in International Class 35.

5. Opposer will be damaged by the registration of ORANGEROC, as aforesaid, in that ORANGEROC so resembles Opposer's ORANGE Mark, as to be likely, when applied to the services listed in the application, to cause confusion, mistake and deception, with consequent irreparable damage to Opposer's business and goodwill in violation of Section 2(d) of the United States Trademark Act of 1946 as amended ("Lanham Act") (15 U.S.C. §1052(d)) and otherwise will improperly give the appearance of exclusive statutory ownership rights in marks

incorporating variations of the ORANGE Mark to Applicant in derogation of the prior and superior rights of Opposer.

6. Registration, therefore, should be refused for the reasons set forth above.

WHEREFORE, Opposer requests that this opposition be sustained and that the application by Melinda Mullis to register the mark ORANGERO (Serial No. 85-749,504) be refused.

Opposer will submit payment with the online filing of the Notice, pursuant to 37 CFR §2.6(a)(17), in an amount totaling three hundred dollars (\$300.00) in payment of the requisite fee for filing this Notice of Opposition against the application in one class. Please charge any additional amounts to the undersigned Attorney's Deposit Account No. 05-1323.

Dated: New York, New York
March 3, 2014

Respectfully submitted,

CROWELL & MORING LLP

By:



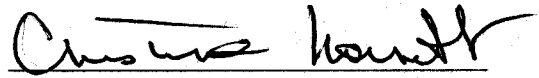
Dickerson M. Downing
Honor Costello, Esq.
590 Madison Avenue
20th Floor
New York, New York 10022-2524

Attorneys for Opposer
Orange Brand Services Limited

CERTIFICATE OF SERVICE

I hereby certify that on the 3rd day of March, 2014, the foregoing Notice of Opposition was served upon Applicant's counsel by depositing same with the U.S. Postal Service, first-class postage prepaid and e-mail, addressed as follows:

Shannon S. Imlay, Esq.
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Christine Kornett