

ESTTA Tracking number: **ESTTA606735**

Filing date: **05/28/2014**

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 parties oppose registration of the indicated application.

Opposers Information

Name	K12 Inc.
Granted to Date of previous extension	05/28/2014
Address	2300 Corporate Park Drive Herndon, VA 20171 UNITED STATES

Name	K12 Management Inc.		
Entity	Corporation	Citizenship	Delaware
Address	2300 Corporate Park Drive Herndon, VA 20171 UNITED STATES		

Attorney information	Susan P. Christoff Cooley LLP 1299 Pennsylvania Ave, NW, Suite 700 Washington, DC 20004 UNITED STATES trademarks@cooley.com, schristoff@cooley.com, mchampion@cooley.com, smobley@cooley.com, pwillsey@cooley.com Phone:2028427800
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Applicant Information

Application No	85935579	Publication date	01/28/2014
Opposition Filing Date	05/28/2014	Opposition Period Ends	05/28/2014
Applicant	Zarca Interactive, Inc. Suite 440 Herndon, VA 20171 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 2006/01/31 First Use In Commerce: 2006/01/31 All goods and services in the class are opposed, namely: Providing data collection for public schools, school districts, counties and communities for business purposes, namely, collection, compilation, data processing, and provision of business information, data, statistics, and indices for public schools, school districts, counties and communities; analysis of public opinion surveys for public schools, school districts, counties and communities; consulting services in the fields of public opinion survey analysis and strategy for public schools, school districts, counties and communities; consulting services in the field of education administration; providing survey design and business research services relating to public opinion surveys; stakeholder survey consulting services in the field of education, namely, consulting on the design and use of stakeholder surveys to assist public schools and</p>

school districts in communicating with parents, teachers, students, community members and other stakeholder groups

Class 042. First Use: 2006/01/31 First Use In Commerce: 2006/01/31

All goods and services in the class are opposed, namely: Design and development of online software for others for use in administering surveys over a computer network; design and development of on-line computer software for others for use in collecting survey data; design and development of online computer software for others for use in enterprise feedback management and community response management for others; Providing use of on-line proprietary, non-downloadable software for customer creation, customization, modification, updating, collection, maintenance, analysis and reporting of on-line single- or multi-page surveys, questionnaires, and other data collection formats, and for publishing, exporting, emailing, printing, and transferring surveys and survey results, reports, analysis; technical support services in the nature of troubleshooting of computer software problems and website application usage problems to users in connection with the creation, modification, updating, collection, maintenance, analysis, reporting and transfer of on-line single- and multi-page surveys, questionnaires and other data collection formats utilizing a website and proprietary non-downloadable on-line software; technical support services, namely, administration and troubleshooting of on-line software and applications

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.	2655115	Application Date	06/20/2000
Registration Date	11/26/2002	Foreign Priority Date	NONE
Word Mark	K12		
Design Mark	K12		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2001/08/06 First Use In Commerce: 2001/08/06 PRINTED TEACHING AND INSTRUCTIONAL MATERIALS FOR USE IN COURSES OF INSTRUCTION AT THE PRESCHOOL AND PRIMARY LEVEL Class 041. First use: First Use: 2001/08/06 First Use In Commerce: 2001/08/06 PRINTED TEACHING AND INSTRUCTIONAL MATERIALS FOR USE IN EDUCATIONAL SERVICES, NAMELY, PROVIDING COURSES OF INSTRUCTION AT THE PRESCHOOL AND PRIMARY LEVEL AND DISTRIBUTING COURSE MATERIAL IN CONNECTION THEREWITH		

U.S. Registration No.	3350144	Application Date	04/26/2006
Registration Date	12/04/2007	Foreign Priority Date	NONE
Word Mark	INSIGHT SCHOOLS		

Design Mark	<h1>Insight Schools</h1>
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2006/01/01 First Use In Commerce: 2006/01/01 Educational services in the nature of on-line secondary schools; Educational services, namely, providing courses of instruction at the secondary level on-line and distributing course materials in connection therewith on-line level; Educational services, namely, conducting on-line classes and tutoring sessions in the field of secondary math, science, social studies and language arts

U.S. Registration No.	3813891	Application Date	11/13/2009
Registration Date	07/06/2010	Foreign Priority Date	NONE

Word Mark	I INSIGHT SCHOOLS
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Design Mark	
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Description of Mark	The mark consists of the wording "INSIGHT SCHOOLS" with a stylized letter "I" within a circle to the left of the word "INSIGHT".
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Goods/Services	Class 041. First use: First Use: 2009/04/10 First Use In Commerce: 2009/04/10 Educational services in the nature of online secondary schools; Educational services, namely, conducting online classes and tutoring sessions in the field of secondary math, science, social studies and language arts; Educational services, namely, providing courses of instruction at the online secondary level and distribution of course material in connection therewith
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Attachments	76075711#TMSN.gif(bytes) 78869879#TMSN.jpeg(bytes) 77872421#TMSN.jpeg(bytes) Opp_K12_INSIGHT.pdf(252372 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	/spc/
Name	Susan P. Christoff
Date	05/28/2014

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

In the matter of Application Serial No. 85/935,579
For the Trademark K12 INSIGHT
Published in the Official Gazette on January 28, 2014

K12 Inc., and)	
K12 Management Inc.,)	
)	
Opposers,)	
)	Opposition No. _____
v.)	
)	
Zarca Interactive, Inc.,)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

K12 Inc. (“K12”) and its wholly owned subsidiary K12 Management Inc. (collectively referred to herein as “Opposers”), both Delaware corporations having a principal place of business at 2300 Corporate Park Drive, Herndon, Virginia 20171, believe they will be damaged by registration of the trademark K12 INSIGHT (the “K12 INSIGHT Mark” or “Applicant’s Mark”), as sought by Zarca Interactive, Inc. (“Applicant”), a Delaware corporation having its principal place of business at 13454 Sunrise Valley Drive, Suite 440, Herndon, Virginia 20171, by means of pending Application Serial No. 85/935579 (the “Application”) filed May 17, 2013. Opposers hereby oppose the Application pursuant to Section 13 of the Lanham Act, 15 U.S.C. § 1063, on the following grounds.

1. For over a decade, and prior to Applicant’s May 17, 2013 application filing date and January 31, 2006 claimed first use date, K12 has used the K12 trade name, trademark and

associated logos in U.S. interstate commerce in connection with its educational services, software, and related course materials.

2. In addition to owning common law trademark rights in the K12 trademark (the “K12 Mark”), K12 owns U.S. Registration No. 2,655,115, issued November 26, 2002, for the K12 Mark in connection with “printed teaching and instructional materials for use in courses of instruction at the preschool and primary level” in International Class 16 and “printed teaching and instructional materials for use in educational services, namely, providing courses of instruction at the preschool and primary level and distributing course material in connection therewith” in International Class 41 (the “K12 Registration”).

3. K12 Management Inc. owns U.S. Registration No. 3,350,144, issued December 4, 2007, for the INSIGHT SCHOOLS mark in connection with “educational services in the nature of on-line secondary schools; educational services, namely, providing courses of instruction at the secondary level on-line and distributing course materials in connection therewith on-line level; educational services, namely, conducting on-line classes and tutoring sessions in the field of secondary math, science, social studies and language art” in International Class 41, and U.S. Registration No. 3,813,891, issued July 6, 2010, for the I INSIGHT SCHOOLS & Design mark in connection with “educational services in the nature of online secondary schools; Educational services, namely, conducting online classes and tutoring sessions in the field of secondary math, science, social studies and language arts; educational services, namely, providing courses of instruction at the online secondary level and distribution of course material in connection therewith” in International Class 41 (the “INSIGHT SCHOOLS Marks” and “INSIGHT SCHOOLS Registrations”). The INSIGHT SCHOOLS Registrations were assigned from Insight Schools, Inc. to K12 Management Inc. on July 1, 2011.

4. Opposers and their predecessors-in-interest have expended considerable effort and expense in promoting their goods and services under the K12 Mark and INSIGHT SCHOOLS Marks. As a result, the K12 Mark and INSIGHT SCHOOLS Marks are widely recognized in the marketplace as source identifiers of the Opposers' high quality products and services and, in the minds of the relevant consuming public, have become associated with the substantial and valuable goodwill of the Opposers.

5. Applicant seeks to register the K12 INSIGHT Mark in connection with the following services:

International Class 35: Providing data collection for public schools, school districts, counties and communities for business purposes, namely, collection, compilation, data processing, and provision of business information, data, statistics, and indices for public schools, school districts, counties and communities; analysis of public opinion surveys for public schools, school districts, counties and communities; consulting services in the fields of public opinion survey analysis and strategy for public schools, school districts, counties and communities; consulting services in the field of education administration; providing survey design and business research services relating to public opinion surveys; stakeholder survey consulting services in the field of education, namely, consulting on the design and use of stakeholder surveys to assist public schools and school districts in communicating with parents, teachers, students, community members and other stakeholder groups

International Class 42: Design and development of online software for others for use in administering surveys over a computer network; design and development of online computer software for others for use in collecting survey data; design and development of online computer software for others for use in enterprise feedback management and community response management for others; Providing use of on-line proprietary, non-downloadable software for customer creation, customization, modification, updating, collection, maintenance, analysis and reporting of on-line single- or multi-page surveys, questionnaires, and other data collection formats, and for publishing, exporting, emailing, printing, and transferring surveys and survey results, reports, analysis; technical support services in the nature of troubleshooting of computer software problems and website application usage problems to users in connection with the creation, modification, updating, collection, maintenance, analysis, reporting and transfer of on-line single- and multi-page surveys, questionnaires and other data collection formats utilizing a website and proprietary non-downloadable on-line software; technical support services, namely, administration and troubleshooting of on-line software and applications.

6. Applicant's Mark, a combination of the two dominant portions of the Opposers' trademarks – the terms "K12" and "INSIGHT" – is highly similar to the K12 Mark and INSIGHT SCHOOLS Marks in appearance, pronunciation, and commercial impression.

7. The services identified in the Application are closely related to the goods and services the Opposers provide under the K12 Mark and INSIGHT SCHOOLS Marks. In addition, Applicant and Opposers offer their respective goods and services through the same channels of trade.

8. Opposers are not affiliated with or connected to Applicant or its services, nor have Opposers endorsed or sponsored Applicant or its services.

9. There is no issue as to priority of use. The claimed first use dates of August 6, 2001 and January 1, 2006, as identified in the K12 Registration and INSIGHT SCHOOLS trademark registration respectively, predate the January 31, 2006 claimed first use date identified in the Application.

10. If Applicant is permitted to register the K12 INSIGHT Mark in connection with the services identified in the Application, the consuming public will likely be confused or mistaken into believing those services either emanate from, or are endorsed, sponsored, or otherwise approved by Opposers because of (i) the similarities between Applicant's Mark and the K12 Mark and INSIGHT SCHOOLS Marks; (ii) related nature of the parties' goods and services; and/or (iii) identical trade channels through which those goods and services are provided. In addition, Opposers have no control over the nature and quality of Applicant's services and any defect, objection, or fault found in connection with such services marketed under the K12 INSIGHT Mark would necessarily reflect upon and seriously injure the reputation

that Opposers have established for the goods and services offered under the K12 Mark and INSIGHT SCHOOLS Marks.

11. Registration of Applicant's Mark will cause substantial harm to the Opposers' prior existing, superior, and valuable rights in the K12 Mark and INSIGHT SCHOOLS Marks, and will interfere with the Opposers' enjoyment of those rights. As such, for the reasons set forth herein, registration of Applicant's Mark should be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

WHEREFORE, based on the foregoing, Opposers request that the Board sustain this Opposition and that registration of Application Serial No. 85/935,579 be refused.

Respectfully submitted,

COOLEY LLP

Dated: May 28, 2014

By:



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*Counsel for K12 Inc.
and K12 Management Inc.*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing NOTICE OF OPPOSITION has been mailed to Applicant via United States Postal Services this 28th day of May, 2014 at the following address:

Ann K. Ford
DLA Piper LLP
500 8th Street NW
Washington, DC 20004-2131

Dated: May 28, 2014



Vicki Vaughan