

ESTTA Tracking number: **ESTTA647420**

Filing date: **12/29/2014**

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	Leo Burnett Company, Inc.
Granted to Date of previous extension	12/28/2014
Address	35 W. Wacker Dr. Chicago, IL 60601 UNITED STATES

Attorney information	David J Davis Baker & McKenzie 300 E. Randolph St.Suite 5000 Chicago, IL 60601 UNITED STATES david.davis@baker.mckenzie.com, chiusptomail@bakermckenzie.com Phone:312-861-8019
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Applicant Information

Application No	85974970	Publication date	07/01/2014
Opposition Filing Date	12/29/2014	Opposition Period Ends	12/28/2014
Applicant	LEO Events, LLC Suite 100 Memphis, TN 38103 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Corporate event management services; corporate event management consultation services; corporate event consultation services, namely, consultation in the fields of special events for business, commercial, promotional or advertising purposes; special event planning for business purposes; corporate event management services, namely, production management services for corporate business events</p>
<p>Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Corporate event consultation services, namely, consultation in the fields of special events for social entertainment purposes; booking services for entertainment, sporting and cultural events; special event planning for social entertainment purposes, namely, production management services for corporate entertainment events; special event planning services for social entertainment purposes; consultation in the field of special event planning services for social entertainment purposes</p>

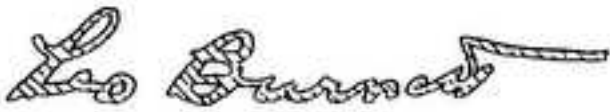
Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Dilution	Trademark Act section 43(c)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2231495	Application Date	06/16/1997
Registration Date	03/16/1999	Foreign Priority Date	NONE
Word Mark	LEO BURNETT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1989/05/00 First Use In Commerce: 1989/05/00 advertising agency services, including,promoting the goods and services of consumer goods, food, restaurant services, automobiles, tobacco, and energy services and products		

U.S. Registration No.	2235675	Application Date	06/16/1997
Registration Date	03/30/1999	Foreign Priority Date	NONE
Word Mark	LEO BURNETT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 1989/05/00 First Use In Commerce: 1989/05/00 advertising agency services, including,promoting the goods and services of consumer goods, food, restaurant services, automobiles, tobacco, and energy services and products		

U.S. Registration No.	3260669	Application Date	06/16/2006
Registration Date	07/10/2007	Foreign Priority Date	NONE
Word Mark	LEOSHE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 035. First use: First Use: 1998/07/20 First Use In Commerce: 1998/07/20 Advertising agency services in all media

U.S. Registration No.	3506977	Application Date	11/06/2006
Registration Date	09/30/2008	Foreign Priority Date	NONE

Word Mark	LEO BURNETT
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Description of Mark	The mark consists of a pencil design in the color black with white shading and the wording "LEO BURNETT" in the color white located in the middle of the pencil; the sharpened wood tip of the pencil is brown having a black pencil lead at the point.
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Goods/Services	Class 035. First use: First Use: 2006/02/23 First Use In Commerce: 2006/02/23 Advertising agency services in all media
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U.S. Registration No.	4091380	Application Date	06/05/2009
Registration Date	01/24/2012	Foreign Priority Date	NONE

Word Mark	LEO BURNETT GROUP
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Description of Mark	NONE
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Goods/Services	Class 035. First use: First Use: 2011/11/21 First Use In Commerce: 2011/11/21 Advertising agency services; business marketing services and business marketing consulting services; advertising services, namely, creating corporate and brand identity for others; advertising and promotional services
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U.S. Registration No.	4253021	Application Date	02/23/2012
Registration Date	12/04/2012	Foreign Priority Date	NONE

Word Mark	THE LEO SHOP
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Design Mark	<h1>THE LEO SHOP</h1>
Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 2012/02/14 First Use In Commerce: 2012/02/14 online retail gift shop

U.S. Registration No.	4256686	Application Date	03/05/2012
Registration Date	12/11/2012	Foreign Priority Date	NONE
Word Mark	THE LEO SHOP EST. 2012 THELEOSHOP.BIZ LEO BURNETT GROUP A HUMANKIND COMPANY A LEO BURNETT GROUP A HUMANKIND COMPANY		

Design Mark	
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Description of Mark	The mark consists of the stylized words "THE LEO SHOP" with a line above and the words "est. 2012" and a line below and the words "theleoshop.biz" in a double circle with the words "LEO BURNETT GROUP" and "HUMANKIND COMPANY" within the double circle separated by dots.
Goods/Services	Class 035. First use: First Use: 2012/03/02 First Use In Commerce: 2012/03/02 online retail gift shop

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	Leo Burnett is also basing this opposition on common law rights in the "LEO" family of marks
Goods/Services	advertising agency services in all media

Related Proceedings	In addition, Leo Burnett is filing a Notice of Opposition against Leo Events' LEO EVENTS Stylized Appln. No. 85/974917 today
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Attachments	75309161#TMSN.png(bytes) 78910399#TMSN.png(bytes) 77037839#TMSN.png(bytes) 77753539#TMSN.png(bytes) 85551038#TMSN.png(bytes) 85560641#TMSN.png(bytes) Leo Burnett Notice of Opposition against LEO EVENTS App No 85974970.pdf(386037 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	/David J. Davis/
Name	David J Davis
Date	12/29/2014

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

Leo Burnett Company, Inc.)	
)	
Opposer,)	Application No. 85/974,970
)	
v.)	
)	Mark: LEO EVENTS
LEO Events, LLC)	
)	
Applicant,)	Opposition No. _____
)	
_____)	

NOTICE OF OPPOSITION

Leo Burnett Company, Inc., a Delaware corporation with its principal place of business at 35 West Wacker Drive, Chicago, IL 60601 ("Leo Burnett" or "Opposer"), believes that it is now or will be damaged by Application No. 85/974,970 for LEO EVENTS ("the subject application") and hereby opposes the registration of the mark that is the subject of Application No. 85/974,970 for the reasons detailed below.

As grounds for its Notice of Opposition, Leo Burnett Company, Inc. hereby alleges:

1. Leo Burnett provides a wide variety of services typical of an advertising agency, including, but not limited to, advertising agency services in all media, consumer research, marketing research, creation of corporate and brand identities, promotional services, conducting marketing studies and consulting services related to its clients' business, marketing, advertising and public relations needs ("Opposer's Services").

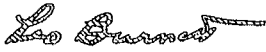


2. The LEO BURNETT agency was founded in 1935 and is responsible for some of the most iconic advertising campaigns and promotions known to consumers in the U.S. and abroad. These campaigns include Tony the Tiger, The Pillsbury Doughboy and The Marlboro Man. Leo Burnett has used in U.S. commerce the service mark "LEO BURNETT" on Opposer's Services since at least as early as 1935 and has used the mark in a wide variety of advertising agency services including in connection with the development and promotion of special events for clients in connection with the executing of their advertising and brand development strategies. Leo Burnett continues to this day to use and promote the "LEO BURNETT" mark in connection with Opposer's Services.

3. Leo Burnett has also used and registered other "LEO"-formative marks such as "LeoShe", and "THE LEO SHOP", among others, and has secured federal trademark registrations for these marks.

4. Leo Burnett, one of the largest and best recognized advertising agencies in the U.S. and world, is often referred to in the advertising industry and by its customers as "Leo" for short and Leo Burnett has acquired longstanding common law rights in LEO alone in connection with Opposer's Services. (The "LEO BURNETT" and the other "LEO"-formative marks are collectively referred as the "LEO Marks".)

5. Leo Burnett's registrations for the LEO Marks include, but are not limited to (collectively "Opposer's Registrations"):

Mark	Registration No.	Date of First Use	Class/Services
LEO BURNETT	2231495	FIRST USE: 19890500. FIRST USE IN	advertising agency services, including, promoting the goods and services of consumer goods, food,

Mark	Registration No.	Date of First Use	Class/Services
		COMMERCE: 19890500	restaurant services, automobiles, tobacco, and energy services and products. (Class 35)
	2235675	FIRST USE: 19890500. FIRST USE IN COMMERCE: 19890500	advertising agency services, including, promoting the goods and services of consumer goods, food, restaurant services, automobiles, tobacco, and energy services and products. (Class 35)
LeoShe	3260669	FIRST USE: 19980720. FIRST USE IN COMMERCE: 19980720	Advertising agency services in all media. (Class 35)
	3506977	FIRST USE: 20060223. FIRST USE IN COMMERCE: 20060223	Advertising agency services in all media. (Class 35)
LEO BURNETT GROUP	4091380	FIRST USE: 20111121. FIRST USE IN COMMERCE: 20111121	Advertising agency services; business marketing services and business marketing consulting services; advertising services, namely, creating corporate and brand identity for others; advertising and promotional services. (Class 35)
THE LEO SHOP	4253021	FIRST USE: 20120214. FIRST USE IN COMMERCE: 20120214	online retail gift shop. (Class 35)
	4256686	FIRST USE: 20120302. FIRST USE IN COMMERCE: 20120302	online retail gift shop. (Class 35)

6. On information and belief, the owner of Application No. 85/974,970 for LEO EVENTS is LEO Events, LLC, a Tennessee corporation having its principal place of business at Suite 100, 265 Front Street Memphis, Tennessee 38103 ("Applicant" or "Leo Events").

7. Leo Events' Application No. 85/974,970 for LEO EVENTS covers the following services: *"Corporate event management services; corporate event management consultation services; corporate event consultation services, namely, consultation in the fields of special events for business, commercial, promotional or advertising purposes; special event planning for business purposes; corporate event management services, namely, production management services for corporate business events"* in International Class 35 and *"Corporate event consultation services, namely, consultation in the fields of special events for social entertainment purposes; booking services for entertainment, sporting and cultural events; special event planning for social entertainment purposes, namely, production management services for corporate entertainment events; special event planning services for social entertainment purposes; consultation in the field of special event planning services for social entertainment purposes"* in International Class 41.

8. On information and belief, Applicant filed the subject application as an Intent-to-Use application based on Section 1(b) on July 1, 2013.

9. Opposer's LEO BURNETT mark was first used in U.S. commerce at least as early as 1935, more than 70 years prior to the July 1, 2013 application filing date of the subject application. Opposer's first use in commerce of the other LEO Marks also long predates the July 1, 2013 application filing date of the subject application.

10. Opposer's Registrations all issued prior to July 1, 2013, and reflect dates of first use in U.S. commerce prior to July 1, 2013.

11. Opposer's long prior use of its LEO Marks gives it clear, and longstanding, priority at common law over Applicant's alleged/proposed and/or actual use in U.S. commerce of the similar LEO EVENTS mark.

12. Opposer's Registrations for LEO BURNETT and the LEO Marks give it priority over Applicant's July 1, 2013 priority date and/or date of first use in U.S. commerce.

13. The services associated with Application No. 85/974,970 are closely related to Opposer's Services. In particular, the application and use of the "LEO EVENTS" trademark in the context of consumer-facing promotional events that are, in essence, a means for presenting a brand advertising message or image to the consuming public, is closely related to Opposer's Services. Among the advertising services Opposer provides to its clients are event marketing, planning and promotion services. Therefore, particularly if Leo Events uses and/or is permitted to register LEO EVENTS for advertising and promotional related event planning services, such as strategic media advice and consulting services to promote a brand or product, or event planning to create a sponsorship in support of an advertising campaign, etc., such use could cause customers to think that LEO EVENTS provides a brand promotion oriented event-planning services that are closely related to the services provided by Leo Burnett or that the LEO EVENTS services are approved or sponsored by Leo Burnett.

14. On information and belief, the services associated with Application No. 85/974,970 are offered or are likely to be offered to the same or related classes of customers who may purchase Opposer's Services.

15. The mark that is the subject of Application No. 85/974,970, LEO EVENTS, is visually, phonetically and connotatively similar to Opposer's LEO Marks. In particular, given

that the "EVENTS" portion in Application No. 85/974,970 is disclaimed, the distinctive portion of Application No. 85/974,970 is "LEO".

16. Leo Events' Application No. 85/974,970 for LEO EVENTS as used and as proposed for registration in connection with the services described therein is likely to cause confusion or mistake with Opposer's prior LEO Marks under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

17. If the mark that is the subject of Application No. 85/974,970 is allowed to proceed to registration in the face of Opposer's prior rights in its LEO Marks, this will result in detriment and damage to Opposer by creating the potential for confusion in the marketplace whereby current or prospective consumers of Applicant's LEO EVENTS services may believe that such services are either offered by Opposer or that Opposer has licensed or otherwise permitted Applicant to use Opposer's prior LEO Marks.

18. If the mark that is the subject of Application No. 85/974,970 is permitted to proceed to registration in the face of Opposer's prior rights in its LEO Marks, Opposer will be further damaged by the issuance of a registration to Applicant affording Applicant presumptions of validity in the LEO Marks and other such presumptions and also by blocking Opposer's ability to obtain a registration of its own for its LEO Marks or other marks containing LEO.

19. As a result of its longstanding use since 1935, LEO BURNETT has become a famous or well-known mark, and became famous long prior to July 1, 2013, Applicant's priority date.

20. Leo Events' registration of LEO EVENTS is likely to dilute by blurring the famous LEO BURNETT mark, in violation of Section 43(c) of the Trademark Act.

WHEREFORE, Opposer requests that Application No. 85/974,970 for the mark LEO EVENTS be rejected pursuant to Section 2(d) and Section 43(c) of the Trademark Act and that

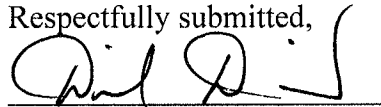
no registration be issued to Applicant thereon and that this Opposition be granted in Opposer's favor.

Opposer hereby appoints Baker & McKenzie to act as attorneys for Opposer, with full power to prosecute this Notice of Opposition, to transact all relevant business with the Patent and Trademark Office and in the United States Courts and to receive all official communications in connection with this Notice of Opposition.

Please charge the statutory filing fee of \$300.00 and any shortfall, excess or missing fees to Deposit Account No. 501-649.

Dated: December 29, 2014

Respectfully submitted,



David J. Davis
BAKER & McKENZIE
300 East Randolph Street
Chicago, IL 60601
(312) 861-8019

CERTIFICATE OF MAILING

The undersigned hereby certifies that the foregoing **Notice of Opposition** was filed via ESTTA and served upon Applicant via the United States Postal Service, as first class mail, postage prepaid, in an envelope addressed as follows:

ROBERT L. BREWER, PAIGE W. MILLS AND MARTHA B. ALL
BASS, BERRY & SIMS PLC
150 3RD AVE S STE 2800
NASHVILLE, TENNESSEE 37201-2017

on December 29, 2014.

A handwritten signature in black ink, appearing to read "David J. Davis". The signature is written in a cursive style with a large initial "D" and "J".

David J. Davis