

ESTTA Tracking number: **ESTTA671865**

Filing date: **05/12/2015**

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    | Edward J Yablon   |             |               |
| Entity  | Individual  | Citizenship | UNITED STATES |
| Address | 115 E 87th St 21-C<br>New York, NY 10128<br>UNITED STATES |             |               |

|                            |   |  |  |
|----------------------------|---|--|--|
| Correspondence information | Edward J Yablon<br>PC-VIP inc<br>115 E 87th St 21-C<br>New York, NY 10128<br>UNITED STATES<br>jeff@answerguy.com Phone:6468273800 |  |  |
|----------------------------|---|--|--|

**Applicant Information**

|                        |   |                        |            |
|------------------------|---|------------------------|------------|
| Application No         | 86448439  | Publication date       | 04/14/2015 |
| Opposition Filing Date | 05/12/2015  | Opposition Period Ends | 05/14/2015 |
| Applicant              | WordPress Foundation<br>660 4th Street #119<br>San Francisco, CA 94107<br>UNITED STATES |                        |            |

**Goods/Services Affected by Opposition**

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| Class 041. First Use: 2003/03/28 First Use In Commerce: 2003/03/28<br>All goods and services in the class are opposed, namely: electronic publishing services, namely, publication of video, text and graphic works of others via the Internet |
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**Grounds for Opposition**

|                                |   |
|--------------------------------|---|
| The mark is merely descriptive | Trademark Act section 2(e)(1)   |
| Other                          | PRIOR USE by others in this context with full knowledge of filing party, BAD FAITH, plus failure to act on and/or defend. |

|             |   |
|-------------|---|
| Attachments | 86448439 trademark opposition.pdf(23980 bytes ) |
|-------------|---|

**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 | /Edward Jeffrey Yablon/ |
| Name      | Edward J Yablon         |
| Date      | 05/12/2015              |

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

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4  
5 In the matter of trademark application Serial No. **86448439**

6 For the mark WORDPRESS

7 Published in the Official Gazette on April 14 2015.

8  
9 Edward Jeffrey Yablon

10                   v.

11 WordPress Foundation

12  
13   NOTICE OF OPPOSITION

14   by

15   Edward Jeffrey Yablon

16   115 East 87<sup>th</sup> Street, Apt 21-C

17   New York NY 10128

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19                   The above-identified opposer believes that he will be damaged by registration of the  
20 mark shown in the above-identified application, and hereby opposes the same.

21  
22                   The grounds for opposition are as follows:

- 23  
24                   ***1) The WordPress Foundation, as custodian of existing registered marks by assignment***  
25                   ***from Automattic Inc., Matt Mullenweg, Wordpress.com, Wordpress.org et.al., filed***  
26                   ***this application on November 7, 2014 for the sole purpose of restricting trade that***  
27                   ***already existed at the time of the application's filing. This stands as both an example of***  
28                   ***BAD FAITH and known circumvention of PRIOR USE of the mark in the context***

1 *sought via this application. Both I as owner and operator of the web site and service*  
2 *The WordPress Helpers (<http://thewordpresshelpers.com>, registered and in service as*  
3 *of November 1, 2014) and others would be gravely and adversely effected should this*  
4 *mark be granted.*

5 2) *While The WordPress Foundation has applied or been granted other, narrow-use*  
6 *trademarks, including 84448426 and 77903009 (use of the mark on clothing),*  
7 *85023661 (Stylized “W”), 78826938 and 78826734 (online software publishing*  
8 *systems), and 77902996 (use of the name “WordCamp” to conduct business events), it*  
9 *has heretofore chosen not to seek protection for the string of letters WORDPRESS to*  
10 *name products or services. FURTHER, This United States Patent and Trademark*  
11 *Office has previously granted registration in 85520246 by a company doing business as*  
12 *ZIPPYKID WORDPRESS HOSTING*

13 3) *The WordPress Foundation has previously and publicly stated that use of the string of*  
14 *letters WORDPRESS is acceptable to it. As such, retroactively restricting such use is*  
15 *inappropriate. Specifically, at <https://wordpress.org/about/domains/> use of the non-*  
16 *registered consecutive-letter mark is allowed for via the phrase “WordPress” in*  
17 *sub-domains is fine, like wordpress.example.com., and further allowance is*  
18 *made for websites that contain the string, even in their main domain name.*

19 4) *The WordPress Foundation has published specific reference at*  
20 *<http://wordpressfoundation.org/trademark-policy/> to its desire to protect (unregistered)*  
21 *trademark in the nine-letter string WORDPRESS, acknowledging the basic tenet of*  
22 *trademark that no-one else should unfairly profit from, trick or confuse people*  
23 *who are looking for official WordPress or WordCamp resources . As such,*  
24 *any entity that takes care to specify their relationship or lack thereof with The*  
25 *WordPress Foundation et.al. cannot be viewed as violating any de facto trademark that*  
26 *may be determined to exist.*

27 5) *The WordPress Foundation is fully aware of the profit-making product WORDPRESS*  
28 *SEO BY YOAST (<https://yoast.com/wordpress/plugins/seo/>), which uses the nine*

1 *consecutive letters WORDPRESS in its official, commercial name. Furthermore,*  
2 *WORDPRESS SEO BY YOAST is promoted by The WordPress Foundation, et.al., at*  
3 *<https://wordpress.org/plugins/wordpress-seo/>.*

4 *6) It is not allowed for The WordPress Foundation or any trademark holder to enforce*  
5 *trademark rights selectively. The WordPress Foundation is aware of the existence of*  
6 *many web sites using the nine-letter string WORDPRESS in web site names, yet*  
7 *chooses to pursue only a small subset of those that do. If any registered or de facto*  
8 *trademark is determined to exist, this failure to enforce consistently must be construed*  
9 *as ABANDONMENT OF TRADEMARK.*

10 *7) Notwithstanding interpretation of the matters mentioned above, and absent a*  
11 *registered trademark covering same The WordPress Foundation has no standing to*  
12 *dictate “acceptable use” of the consecutive letter string WORDPRESS.*

13 *8) As such, and because The WordPress Foundation has demonstrated an arbitrary and*  
14 *capricious approach to trademark management, I petition the Trial and Appeal Board*  
15 *to deny application 86448439 on multiple grounds as set forth above.*

16  
17 By  Date May 12 2015

18 Edward Jeffrey Yablon  
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