

ESTTA Tracking number: **ESTTA745977**

Filing date: **05/12/2016**

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	Elite IT Partners, Inc.		
Entity	Corporation	Citizenship	Utah
Address	719 East Timpanogos Pkwy Suite 1100 Orem, UT 84097 UNITED STATES		

Correspondence information	Brian J. Riddle Attorney of Record, Utah Bar Member Fabain VanCott PC 215 South State Street Suite 1200 Salt Lake City, UT 84111 UNITED STATES briddle@fabianvancott.com Phone:435-671-8206
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Applicant Information

Application No	86145088	Publication date	04/12/2016
Opposition Filing Date	05/12/2016	Opposition Period Ends	05/12/2016
International Registration No.	NONE	International Registration Date	NONE
Applicant	1601054 Alberta LTD 158 Pennsburg Way SE Calgary, Alberta, T2A2J5 CANADA		

Goods/Services Affected by Opposition

Class 042. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: information and technology services in the field of computer consultation; information technology and information security consulting services; computer network configuration services
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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. Application No.	86716651	Application Date	08/06/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ELITE IT PARTNERS		

Design Mark	ELITE IT PARTNERS		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2011/07/13 First Use In Commerce: 2011/07/13 Computer services, namely, remote and on-site management of information technology systems of others		

U.S. Application No.	86716671	Application Date	08/06/2015
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	ELITE IT		
Design Mark	ELITE IT		
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2011/07/13 First Use In Commerce: 2011/07/13 Computer services, namely, remote and on-site management of information technology systems of others		

Related Proceedings	None
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Attachments	86716651#TMSN.png(bytes) 86716671#TMSN.png(bytes) ELITEPARTNER TM Opposition.pdf(119395 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	/Brian J. Riddle/
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Name	Brian J. Riddle
Date	05/12/2016

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

In the Matter of Trademark Application Serial No.: 86145088
For the Mark: ELITEPARTNER
Published in the Official Gazette on: April 12, 2016

Elite IT Partners, Inc.
v.
1601054 Alberta Ltd.

NOTICE OF OPPOSITION

Elite IT Partners, Inc., a Utah corporation, headquartered in Orem, Utah, having a principal place of business at 719 East Timpanogos Parkway, Suite 1100, Orem, Utah, 84097, U.S.A. (hereinafter “Elite IT Partners”), hereby opposes Application Serial No. 86145088 for the mark ELITEPARTNER for “information and technology services in the field of computer consultation; information technology and information security consulting services; computer network configuration services” in International Class 042, filed December 16, 2013, by 1601054 Alberta LTD (“Applicant”), assigned Serial No. 86145088 and published for opposition in the Official Gazette of April 12, 2016. Elite IT Partners (“Opposer”) believes that it would be damaged by such registration, and hereby opposes the registration of Applicant’s mark pursuant to 15 USC § 1063 and 37 CFR § 2.104.

Grounds of Opposition

As grounds of opposition, it is alleged as follows:

1. Since at least July 13, 2011, Opposer has been, and is now, using the marks ELITE IT PARTNERS and ELITE IT in connection with computer services, namely, remote and on-site management of information technology systems of others (“Opposer’s Marks”).

2. Opposer previously filed for registration of ELITE IT PARTNERS on July 13, 2011, in U.S. trademark application Serial No. 85370152 and refiled for registration of ELITE IT PARTNERS on August 6, 2015, in U.S. trademark application Serial No. 86716651.

3. Opposer previously filed for registration of ELITE IT on July 13, 2011, in U.S. trademark application Serial No. 85370124 and refiled for registration of ELITE IT on August 6, 2015, in U.S. trademark application Serial No. 86716671.

4. Opposer has continuously used the Opposer’s Marks in interstate commerce since at least July 13, 2011.

5. Applicant filed to register the proposed mark ELITEPARTNER, Serial Number 86145088, for “information and technology services in the field of computer consultation; information technology and information security consulting services; computer network configuration services,” in International Class 042, on December 16, 2013, claiming a bona fide intent to use the mark in commerce, as is evidenced by publication of said mark in the Official Gazette in April 12, 2016 (“Applicant’s Mark”).

6. Opposer’s use of Opposer’s Marks has been valid and continuous since at least July 13, 2011 and has not been abandoned. Opposer’s Marks are symbolic of extensive goodwill and consumer recognition. As a result of the substantial amounts of time, expense, and effort in advertising and promotion, Opposer has developed exceedingly valuable goodwill in Opposer’s Marks.

7. Applicant’s Mark and Opposer’s Marks are confusingly similar in sound, appearance and meaning.

8. Applicant's services and Opposer's services as identified by their respective marks are very similar and related.

9. On information and belief, Opposer alleges that the services of Opposer and Applicant are offered or will be offered in overlapping channels of trade and offered to the same customers.

10. Applicant's use of and application to register ELITEPARTNER is without the consent or permission of Opposer.

11. Applicant's Mark and Opposer's Marks are likely to be confused by the relevant consuming public.

12. On information and belief, Opposer's first use of Opposer's Marks precedes Applicant's first use of Applicant's Mark in commerce.

13. On information and belief, Opposer's first use of Opposer's Marks precedes the filing of Applicant's application to register Applicant's Mark in the United States Patent and Trademark Office.

14. On information and belief, Applicant was aware of Opposer and Opposer's longstanding use of Opposer's Marks prior to the filing of its application to register Applicant's Mark.

15. As a result of confusing similarity between Opposer's Marks and Applicant's Mark and because the goods and/or services of Applicant and Opposer as identified by their respective marks are very similar and closely related, are offered in overlapping channels of trade, and are directed to the same customers, registration of the proposed mark ELITEPARTNER in connection with Applicant's services is likely to deceive purchasers as to the source or sponsorship of such services, to cause confusion, to cause mistake, or to deceive.

16. Consumers are likely to mistakenly believe that Applicant's services are sponsored, authorized, endorsed by or are associated with or otherwise approved by Opposer because the proposed mark is confusingly similar to Opposer's Marks. Deficiencies or faults in the quality of Applicant's services are likely to reflect negatively upon, tarnish and seriously injure the reputation which Opposer has established for services provided under Opposer's Marks. This confusion is likely to result in loss of revenues to Opposer and damage to Opposer's reputation.

17. Applicant's use of the Applicant's Mark does or is likely to falsely suggest a relationship between Applicant's services and Opposer's services. Such use of the ELITEPARTNER mark is likely to cause confusion, mistake, or deception with respect to the source or sponsorship of Applicant's services. Such use is likely to cause a significant level of sales by Applicant to consumers who would be confused by the use of the proposed mark into believing that Opposer is the source of Applicant's services, resulting in ill-gotten gains by Applicant. Applicant's use of the Applicant's Mark is therefore likely to result in Applicant's trading off and benefiting from the goodwill associated with Opposer's Mark, resulting in ill-gotten gains by Applicant.

For the foregoing reasons, registration of Applicant's Mark sought by Applicant is contrary to the provisions of the Lanham Act, and Opposer would be damaged thereby.

WHEREFORE, Opposer prays that the application for registration of the mark ELITEPARTNER, Serial No. 86145088, be refused and that this Opposition be sustained in favor of Opposer.

The fee required by Sect. 2.6(a)(17) is enclosed herewith.

Opposer hereby appoints Brian John Riddle, member of the Bar of the State of Utah, at Fabian VanCott P.C., 215 South State Street, Suite 1200, Salt Lake City, Utah 84111, to act as attorney in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office, and in the United States courts connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted,

DATE: May 12, 2016

Brian J. Riddle
Attorney for Opposers

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