

ESTTA Tracking number: **ESTTA790625**

Filing date: **12/20/2016**

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

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| Name | Sitecore Corporation A/S |
| Granted to Date of previous extension | 12/21/2016 |
| Address | Vester Farimagsgade 3, 5 Copenhagen, V1606 DENMARK |

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| Attorney information | Dawn Newton Donahue Fitzgerald LLP 1999 Harrison Street 25th Floor Oakland, CA 94612 UNITED STATES dnewton@donahue.com, jhofer@donahue.com, trademarks@donahue.com Phone:(510) 451-3300 |
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Applicant Information

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|------------------------|--|------------------------|------------|
| Application No | 87036827 | Publication date | 08/23/2016 |
| Opposition Filing Date | 12/20/2016 | Opposition Period Ends | 12/21/2016 |
| Applicant | Groupon, Inc. 600 W. Chicago Ave. Chicago, IL 60654 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Promoting the goods and services of others |
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Grounds for Opposition

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| Priority and likelihood of confusion | Trademark Act Section 2(d) |
| Dilution by blurring | Trademark Act Sections 2 and 43(c) |
| Dilution by tarnishment | Trademark Act Sections 2 and 43(c) |

Marks Cited by Opposer as Basis for Opposition

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| U.S. Registration No. | 4546698 | Application Date | 08/14/2013 |
| Registration Date | 06/10/2014 | Foreign Priority Date | NONE |
| Word Mark | OWN THE EXPERIENCE | | |

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| Design Mark | <h1>OWN THE EXPERIENCE</h1> |
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| Description of Mark | NONE |
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| Goods/Services | <p>Class 009. First use: First Use: 2013/09/05 First Use In Commerce: 2013/09/05</p> <p>Computer software, namely, computer software for managing online content, namely, data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content; computer software for managing and editing information contained on the internet, intranet and extranet sites,, namely, development of Internet applications, namely, content management system software (CMS) a system that manages the content that is stored and presented on a single or multiple connected websites, and runson the same website that it is controlling and describes and communicates and manages the goals, information and offerings of the organization that owns the website; computer software which controls the display of dynamic content, namely, data, documents, files, information, text, photos, images, graphics, music, audio, video, and multimedia content on manydevices,, namely, computers, mobile and computers, mobile telephones, handhelddevices and Internet-enabled devices, electronic appliances, robotic agents which access websites; computer software for development of Internet applications, namely, the website itself and related databases, that describe and communicate and manage the goals, information and offerings of the organization that owns the website including, information repositories that support ecommerce transactions, online communities, and automated support assistance for organizations providing information to consumers; downloadable software for the creation, integration, publication, management, and maintenance of content, namely, text, documents, audio, and video; computer software forthe collection, editing, organizing, modifying, book marking, transmission, storage and sharing of data and information; computer software for use in customer relationship management (CRM); computer software for use in the safeguarding of digital files, namely, audio, video, text, binary, still images, graphics and multimedia files; computer software that provides real-time, integrated business management intelligence by combining information from various databases and presenting it in an easy-to-understand user interface; computer software that provides web-based access to applications and services through a web operating system or portal interface; database management software for user/server programs for managing digital marketing; computer software for use as web application development and management software tools for webcontent management; computer software for use as web application development and management software tools for web content management and web site design and maintenance applications that may be downloaded from a global computer network; computer software, namely, software for creating and managing web sites, creating, publishing, managing and organizing content for use on the Internet or an intranet</p> |
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| U.S. Registration No. | 4542438 | Application Date | 08/14/2013 |
| Registration Date | 06/03/2014 | Foreign Priority Date | NONE |

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| Word Mark | OWN THE EXPERIENCE |
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 041. First use: First Use: 2013/09/05 First Use In Commerce: 2013/09/05 Educational services, namely, providing educational speakers in the field of content management, marketing optimization and business strategy; educational services, namely, conducting classes, workshops, training programs, educational programs, seminars, conferences in the field of content management, marketing optimization and business strategy and distributing educational materials in connection therewith; personal coaching services in the field of content management, marketing optimization and business strategy; providing educational services in the nature of course presentations and hands-on exercises in the field of content management, marketing optimization and business strategy; educational services, namely, developing, arranging, and conducting educational conferences and programs and providing courses of instruction in the field of content management, marketing optimization and business strategy; providing on-line training in the form of classes, courses, seminars, and workshops in the field of content management, marketing optimization and business strategy; providing on-line journals, namely, blogs featuring content management, marketing optimization and business strategy |

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| U.S. Registration No. | 4546699 | Application Date | 08/14/2013 |
| Registration Date | 06/10/2014 | Foreign Priority Date | NONE |
| Word Mark | OWN THE EXPERIENCE | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 042. First use: First Use: 2013/09/05 First Use In Commerce: 2013/09/05 Development, installation and maintenance of computer software; and application service provider (ASP), namely, hosting computer software applications of others; design and development of software applications for use in digital marketing; providing on-line, non-downloadable software to create, control, display | | |

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| | <p>and update websites for use by business, marketing and technical office editors and workers; providing on-line, non-downloadable software via an on-line internet based database to disseminate financial information for use by businesses, non-profit businesses, Government, and universities to advance their objectives and goals; providing on-line, non-downloadable software for use in running computer servers which is accessed via web browsers to support browser-to-server communication by businesses, non-profit businesses, government, and universities; research, design, development, maintenance and upgrading of computer software; website design and consulting related thereto; IT integration services; Design, development, and implementation of software for purposes of content management, commerce and multi-channel marketing and experience management to report on social media, brand awareness, customer loyalty and related web monitoring activities in designing and implementing websites for others; providing temporary use of a web-based software application for users to create websites and portals; cloud computing featuring software for use by website users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery (email, SMS, MMS) and content management for web, mobile, print, and social experiences through application service provider (ASP), namely, hosting computer software applications of others; hosting the web sites of others; computer hardware and software consulting services; consulting services in the field of hosting computer software applications; cloud computing featuring software for use in hosted cloud computing services and hosted third party products, namely, software for use in data backup, encrypted file transfer, hosted email, document backup, producing and managing documents; computer services, namely, hosted management of cloud computing systems and applications for others; platform as a service (PAAS) featuring computer software platforms for creating, managing, and deploying cloud computing infrastructure services; platform as a service (PAAS) featuring computer software platforms for use in installation, configuration, and operation of software applications for use in creating, managing, and deploying cloud computing infrastructure services; software as a service (SAAS) services featuring software for use by website users to manage the experience of their customers and their marketing activities including optimization, analytics, commerce, message delivery (email, SMS, MMS) and content management for web, mobile, print, and social experiences in the development, installation and maintenance of computer software; providing temporary use of non-downloadable computer software for web application development and management, creating and managing web sites, creating, publishing, managing and organizing content for use on the Internet or an intranet</p> |
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| Attachments | 86037803#TMSN.png(bytes) 86037808#TMSN.png(bytes) 86037809#TMSN.png(bytes) OWN THE EXPERIENCE Notice of Opposition.pdf(104801 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 | /Dawn Newton/ |
| Name | Dawn Newton |
| Date | 12/20/2016 |

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

In the Matter of Application Serial No. 87/036,827
For the Mark OWN THE EXPERIENCE

SITECORE CORPORATION A/S,

Opposer,

-against-

GROUPON, INC.,

Applicant.

Opposition No.

NOTICE OF OPPOSITION

Opposer, Sitecore Corporation A/S, a corporation of Denmark, having its principal place of business at Vester Farimagsgade 3, 5 Copenhagen, Demark V1606, believes that it will be damaged by registration of the mark OWN THE EXPERIENCE in Serial No. 87/036,827 and hereby opposes the registration of same.

As grounds of this Opposition, it is alleged that:

1. Opposer is the owner of the trademark, OWN THE EXPERIENCE, which has been registered on the Principal Register of the United States Patent & Trademark Office in Classes 9, 41 and 42, as is evidenced by registration numbers 4,546,698, 4,542,438, and 4,546,699.

2. For over three (3) years Opposer has provided, and continues to provide, a variety of goods and services under its OWN THE EXPERIENCE brand. Opposer has invested significant time and resources in developing, promoting and distributing its goods and services under its mark.

3. Opposer has extensively used and promoted its goods and services offered under the OWN THE EXPERIENCE mark across many marketing channels including through websites, email, social media, print, trade shows, syndicated media, billboards, conferences, and events. Opposer has used its OWN THE EXPERIENCE mark to promote its software, which has been adopted around the globe by marketing teams, brand owners and website operators to enable them to better operate and promote their brands. Through this extensive promotion and use, and the success of Opposer's offerings under the mark, Opposer's OWN THE EXPERIENCE mark has come to represent enormous goodwill of Opposer.

4. Applicant has filed an intent to use application seeking to register the identical OWN THE EXPERIENCE mark for "Promoting the goods and services of others" in Class 35, as is evidenced by the publication of this Application Serial No. 87/036,827 in the Official Gazette on August 23, 2016.

5. Opposer's products and services involve the licensing and development of on-line software designed to help third parties promote their goods and services through enhanced on-line marketing strategies. On information and belief, businesses seeking to promote their goods and services are customers of both Opposer and Applicant.

6. Opposer has used its registered trademark, OWN THE EXPERIENCE, in interstate commerce since at least September 5, 2013. On information and belief, there are no prior registrants of this mark which own a live registration. Opposer was using its trademark for years before Applicant filed its intent to use application.

7. If Applicant's OWN THE EXPERIENCE application in Class 35 matures to registration, Opposer believes it will be damaged in that consumers will confuse the identical marks as used by Opposer and Applicant. In addition, Applicant's use of the mark will dilute the

goodwill and consumer recognition developed by Opposer. This will cause great expense and detriment to Opposer.

Wherefore, Opposer requests that registration of Applicant's mark in Application Serial No. 87/036,827, be denied and that this Opposition be sustained.

Dated: December 20, 2016

Respectfully submitted,

DONAHUE FITZGERALD LLP

By: /Julie E. Hofer/

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Attorneys for Opposer
SITECORE CORPORATION A/S

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the following NOTICE OF OPPOSITION was served on this 20th day of December 2016, by first class U.S. mail, postage prepaid, addressed to the attorney for Applicant as follows:

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Dated: December 20, 2016

/Arun Bose/
Arun Bose