

ESTTA Tracking number: **ESTTA817030**

Filing date: **04/26/2017**

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	Winthrop & Weinstine, P.A.
Granted to Date of previous extension	04/26/2017
Address	225 South Sixth Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES

Attorney information	Martha J. Engel Winthrop & Weinstine, P.A. 225 South Sixth Street, Suite 3500 Minneapolis, MN 55402 UNITED STATES trademark@winthrop.com, mengel@winthrop.com, jbriley@winthrop.com
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### Applicant Information

Application No	87106580	Publication date	12/27/2016
Opposition Filing Date	04/26/2017	Opposition Period Ends	04/26/2017
Applicant	James Creedon 7300 Flat Bluff Court McKinney, TX 75070 UNITED STATES		

### Goods/Services Affected by Opposition

Class 041. First Use: 2016/07/17 First Use In Commerce: 2016/07/17 All goods and services in the class are opposed, namely: Educational and entertainment services, namely, a continuing program about law and legal practice accessible by means of audio, video, and websites, and distribution of printed materials in connection therewith; Entertainment services, namely, providing a web site featuring photographic, video and prose presentations featuring information on law and legal practice; Organizing events in the field of law and legal practice for cultural or educational purposes; Providing continuing legal education courses
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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### Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	4759397	Application Date	10/14/2014
Registration Date	06/23/2015	Foreign Priority Date	NONE

Word Mark	LEGAL SOLUTIONS ON TAP
Design Mark	LEGAL SOLUTIONS ON TAP
Description of Mark	NONE
Goods/Services	Class 045. First use: First Use: 2013/03/00 First Use In Commerce: 2013/03/00 Legal services

Attachments	86423068#TMSN.png( bytes ) 13510103_1.pdf(455585 bytes )
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Signature	/Martha J. Engel/
Name	Martha J. Engel
Date	04/26/2017

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

In the matter of Application Serial No.: 87/106,580  
Filed: July 17, 2016  
For the mark: LAW ON TAP  
Published in the *Trademark Official Gazette* on December 27, 2016

Winthrop & Weinstine, P.A.	)	
	)	
Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	
James Creedon	)	
	)	
Applicant.	)	
	)	

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**NOTICE OF OPPOSITION**

Winthrop & Weinstine, P.A. (“Opposer”) believes that it will be damaged by registration of the mark shown in Application Serial No. 87/106,580 (the “Application”) in International Class 41 and hereby opposes the same.

The grounds for this opposition are as follows:

1. James Creedon (“Applicant”) seeks to register LAW ON TAP (the “Mark”) in standard characters as a trademark for use in connection with “educational and entertainment services, namely, a continuing program about law and legal practice accessible by means of audio, video, and websites, and distribution of printed materials in connection therewith; entertainment services, namely, providing a web site featuring photographic, video and prose presentations featuring information on law and legal practice; organizing events in the field of

law and legal practice for cultural or educational purposes; providing continuing legal education courses” in International Class 41 (the “Applicant’s Services”).

2. On December 27, 2016, the Application was published for opposition in the *Trademark Official Gazette*. On January 14, 2017, Opposer filed a Request for Extension of Time to oppose registration of the Mark. The Trademark Trial and Appeal Board granted the extension request, extending the date for filing this Opposition up to and through February 25, 2017, which fell on a Saturday. On February 26, 2017, Opposer timely filed a Request for Extension of Time to oppose registration of the Mark. The Trademark Trial and Appeal Board granted the extension request, extending the date for filing this Opposition up to and through April 26, 2017.

3. Opposer is a full-service law firm offering legal services to individuals and businesses in a wide range of practice areas. Opposer has attorneys in a craft beverage group that represent and counsel breweries, wineries, cideries and distilleries with respect to various legal issues affecting these businesses.

4. Opposer shares legal information and business information, including, but not limited to, on its web site and its social media pages.

5. Opposer has provided, sponsored, or assisted with educational services, including presentations featuring information about the law and legal practice; entertainment services, including hosting and sponsoring events for cultural or educational purposes; and continuing legal education programs.

6. Opposer is the record owner of Trademark Registration No. 4,759,397 for the LEGAL SOLUTIONS ON TAP® mark in standard characters in connection with “legal services” in International Class 45. The Registration claims a first use date of the LEGAL

SOLUTIONS mark anywhere in connection with these services of at least as early as March 2013 and a first use date of the mark anywhere of at least as early as March 2013. The filing date of the Registration is October 14, 2014. The Registration was issued on the Principal Register on June 23, 2015. A true and correct copy of a current printout of information from the electronic database records of the USPTO showing the current status and title of Opposer's registration is attached hereto as Exhibit A.

7. Opposer has spent considerable time, effort, expense, and resources toward developing, promoting, advertising, and popularizing its LEGAL SOLUTIONS ON TAP® mark and the services offered under the LEGAL SOLUTIONS ON TAP® mark.

8. Opposer has provided presentations and education programs featuring information about the law and legal practice where it has used the LEGAL SOLUTIONS ON TAP® mark.

9. Opposer has sponsored events where it has used the LEGAL SOLUTIONS ON TAP® mark.

10. Consumers have come to know, rely upon, and recognize Opposer's LEGAL SOLUTIONS ON TAP® mark as an indicator of the source of the legal services and information about the law and legal practice.

11. Applicant's filing date for the Application is July 17, 2016 ("Applicant's Filing Date").

12. The Application claims a date of first use for the Mark of July 17, 2016.

13. The Application claims a date of first use in interstate commerce for the Mark of July 17, 2016.

14. Opposer has been using the LEGAL SOLUTIONS ON TAP® mark in connection with its services before the claimed first use dates for the Mark in the Application.

15. Opposer's application for the LEGAL SOLUTIONS ON TAP® mark shown in Exhibit A was filed before Applicant's Filing Date.

16. Opposer's LEGAL SOLUTIONS ON TAP® mark and Applicant's LAW ON TAP mark share the same dominant ON TAP phrase.

17. Opposer's LEGAL SOLUTIONS ON TAP® mark and Applicant's LAW ON TAP mark share the identical placement of the same ON TAP phrase at the end of each mark.

18. LEGAL SOLUTIONS and LAW are similar in commercial impression and meaning.

19. Opposer's LEGAL SOLUTIONS ON TAP® mark and Applicant's LAW ON TAP mark are visually similar.

20. Opposer's LEGAL SOLUTIONS ON TAP® mark and Applicant's LAW ON TAP mark sound similar when spoken.

21. Opposer's LEGAL SOLUTIONS ON TAP® mark and Applicant's LAW ON TAP mark create a similar commercial impression.

22. Upon information and belief, consumers are likely to be confused by Applicant's LAW ON TAP mark, as the LAW ON TAP mark is visually similar to and creates a commercial impression similar commercial to Opposer's LEGAL SOLUTIONS ON TAP® mark.

23. Applicant's LAW ON TAP mark is confusingly similar in sight and sound to Opposer's LEGAL SOLUTIONS ON TAP® mark.

24. Applicant's LAW ON TAP mark is confusingly similar in commercial impression to Opposer's LEGAL SOLUTIONS ON TAP® mark.

25. Applicant's LAW ON TAP mark is confusingly similar in meaning to Opposer's LEGAL SOLUTIONS ON TAP® mark.

26. Applicant's proposed LAW ON TAP mark so resembles Opposer's distinctive LEGAL SOLUTIONS ON TAP® mark as to be likely, when used on or in connection with Applicant's Services, to cause confusion, to cause mistake, or to deceive.

27. The "educational and entertainment services, namely, a continuing program about law and legal practice" for which Applicant seeks to register its LAW ON TAP mark are related to the services Opposer offers under its LEGAL SOLUTIONS ON TAP® mark.

28. The "entertainment services, namely, providing a web site featuring photographic, video and prose presentations featuring information on law and legal practice" for which Applicant seeks to register its LAW ON TAP mark are related to the services Opposer offers under its LEGAL SOLUTIONS ON TAP® mark.

29. The "organizing events in the field of law and legal practice for cultural or educational purposes" for which Applicant seeks to register its LAW ON TAP mark are related to the services Opposer offers under its LEGAL SOLUTIONS ON TAP® mark.

30. The "providing continuing legal education courses" for which Applicant seeks to register its LAW ON TAP mark are related to the services Opposer offers under its LEGAL SOLUTIONS ON TAP® mark.

31. The identification of services in Opposer's registration of the LEGAL SOLUTIONS ON TAP® mark in Exhibit A is unrestricted as to the type of consumer of Opposer's services.

32. The identification of goods description in Applicant's Application is unrestricted as to the type of consumer for Applicant's Services.

33. Upon information and belief, Applicant offers Applicant's Services to the same consumers of Opposer's services.

34. The identification of services description in Applicant's Application is unrestricted as to the channels of trade for Applicant's Services.

35. The identification of services in Opposer's registration of the LEGAL SOLUTIONS ON TAP® mark in Exhibit A is unrestricted as to the channels of trade for Opposer's services.

36. Upon information and belief, Applicant's Services travel in the same channels of trade as Opposer's services.

37. Because of the foregoing similarities, clients, consumers, and potential users are likely to be confused that the goods and services that Applicant offers under its LAW ON TAP mark are sponsored, endorsed, or approved by Opposer, or are in some other way affiliated, connected, or associated with Opposer, all to the detriment of Opposer.

38. For all the reasons stated above, Opposer is concerned that Applicant's LAW ON TAP mark is likely to cause consumer confusion, mistake, or deception. Therefore, registration of the mark shown in the Application should be refused under 15 U.S.C. §§ 1052(d) and 1063.

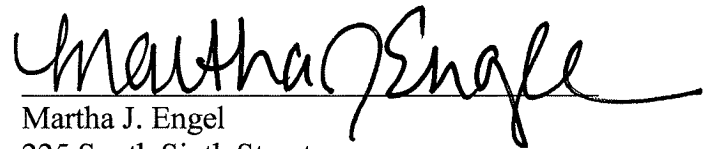
39. Allowing registration of Applicant's LAW ON TAP mark would further damage Opposer, as registration would confer upon Applicant various statutory presumptions to which it is not entitled in view of Opposer's prior use and registration of its LEGAL SOLUTIONS ON TAP® mark.

**WHEREFORE**, Opposer respectfully requests that the Trademark Trial and Appeal Board sustain the opposition and:

1. Reject Application Serial No. 87/106,580, in International Class 41;
2. Refuse registration of LAW ON TAP in connection with all listed services in Class 41; and
3. Award Opposer any further relief the Board deems equitable.

Dated: April 26, 2017

WINTHROP & WEINSTINE, P.A.

A handwritten signature in black ink that reads "Martha J. Engel". The signature is written in a cursive style with a long horizontal flourish extending to the right.

Martha J. Engel  
225 South Sixth Street  
Suite 3500  
Minneapolis, MN 55402  
(612) 604-6400 (Telephone)  
(612) 604-6800 (Facsimile)

Attorney for Winthrop & Weinstine, P.A.

**Exhibit A**

Generated on: This page was generated by TSDR on 2017-04-26 15:30:16 EDT

Mark: LEGAL SOLUTIONS ON TAP

LEGAL SOLUTIONS ON TAP

US Serial Number: 86423068

Application Filing Date: Oct. 14, 2014

US Registration Number: 4759397

Registration Date: Jun. 23, 2015

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Jun. 23, 2015

Publication Date: Apr. 07, 2015

## Mark Information

Mark Literal Elements: LEGAL SOLUTIONS ON TAP

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*.\* identify additional (new) wording in the goods/services.

For: Legal services

International Class(es): 045 - Primary Class

U.S Class(es): 100, 101

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 2013

Use in Commerce: Mar. 2013

## Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

## Current Owner(s) Information

Owner Name: Winthrop & Weinstine, P.A.

Owner Address: Suite 3500  
225 South Sixth Street  
Minneapolis, MINNESOTA 55402  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: MINNESOTA

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Timothy D. Sitzmann **Docket Number:** 9997.216  
**Attorney Primary Email Address:** [trademark@winthrop.com](mailto:trademark@winthrop.com) **Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** TIMOTHY D. SITZMANN  
WINTHROP & WEINSTINE, P.A.  
225 SOUTH SIXTH STREET  
SUITE 3500  
MINNEAPOLIS, MINNESOTA 55402  
UNITED STATES  
**Phone:** 612.604.6689 **Fax:** 612.604.6989  
**Correspondent e-mail:** [trademark@winthrop.com](mailto:trademark@winthrop.com) [sitzmann@winthrop.com](mailto:sitzmann@winthrop.com) [sbell@winthrop.com](mailto:sbell@winthrop.com) **Correspondent e-mail Authorized:** Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Jun. 23, 2015	REGISTERED-PRINCIPAL REGISTER	
Apr. 07, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Apr. 07, 2015	PUBLISHED FOR OPPOSITION	
Mar. 18, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Mar. 02, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70468
Mar. 02, 2015	ASSIGNED TO LIE	70468
Feb. 11, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 10, 2015	EXAMINER'S AMENDMENT ENTERED	88888
Feb. 10, 2015	NOTIFICATION OF EXAMINERS AMENDMENT E-MAILED	6328
Feb. 10, 2015	EXAMINERS AMENDMENT E-MAILED	6328
Feb. 10, 2015	EXAMINERS AMENDMENT -WRITTEN	77654
Feb. 03, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Feb. 03, 2015	NON-FINAL ACTION E-MAILED	6325
Feb. 03, 2015	NON-FINAL ACTION WRITTEN	77654
Jan. 26, 2015	ASSIGNED TO EXAMINER	77654
Oct. 21, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 17, 2014	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information - None

### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Jun. 23, 2015

# United States of America

United States Patent and Trademark Office

## LEGAL SOLUTIONS ON TAP

**Reg. No. 4,759,397**

**Registered June 23, 2015**

**Int. Cl.: 45**

**SERVICE MARK**

**PRINCIPAL REGISTER**

WINTHROP & WEINSTINE, P.A. (MINNESOTA CORPORATION)  
SUITE 3500  
225 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402

FOR: LEGAL SERVICES, IN CLASS 45 (U.S. CLS. 100 AND 101).

FIRST USE 3-0-2013; IN COMMERCE 3-0-2013.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 86-423,068, FILED 10-14-2014.

ROBIN CHOSID, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\* See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**

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

In the matter of Application Serial No.: 87/106,580  
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Winthrop & Weinstine, P.A.	)	
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Opposer,	)	
	)	Opposition No. _____
v.	)	
	)	
James Creedon	)	
	)	
Applicant.	)	
	)	

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**CERTIFICATE OF SERVICE**

Martha J. Engel, certifies that on the 26<sup>th</sup> day of April, 2017, she sent by e-mail, a true and correct copy of the

1. Notice of Opposition

in the above-captioned action to the last known address of the correspondent displayed in the United States Patent and Trademark Office TSDR database, to-wit:

James Creedon  
7300 Flat Bluff Court  
McKinney, TX 75070  
jhcreedon@gmail.com

  
Martha J. Engel

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