

ESTTA Tracking number: **ESTTA819423**

Filing date: **05/08/2017**

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	Shazam Entertainment Limited
Granted to Date of previous extension	05/07/2017
Address	26-28 Hammersmith Grove London, W67HA UNITED KINGDOM

Correspondence information	James L. Scott Warner Norcross & Judd LLP 111 Lyon Street NW 900 Fifth Third Center Grand Rapids, MI 49503 UNITED STATES trademarks@wnj.com Phone:6167522000
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Applicant Information

Application No	86661776	Publication date	11/08/2016
Opposition Filing Date	05/08/2017	Opposition Period Ends	05/07/2017
Applicant	W.B. Mason Co., Inc. 59 Centre Street Brockton, MA 02301 UNITED STATES		

Goods/Services Affected by Opposition

Class 030. First Use: 2014/10/01 First Use In Commerce: 2014/10/31 All goods and services in the class are opposed, namely: Coffee; Coffee beans; Ground coffee beans

Applicant Information

Application No	86661764	Publication date	11/08/2016
Opposition Filing Date	05/08/2017	Opposition Period Ends	
Applicant	W.B. Mason Co., Inc. 59 Centre Street Brockton, MA 02301 UNITED STATES		


Goods/Services Affected by Opposition


Class 030. First Use: 2014/10/01 First Use In Commerce: 2014/10/31 All goods and services in the class are opposed, namely: Coffee; Coffee beans; Ground coffee beans

Grounds for Opposition

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

U.S. Registration No.	3387890	Application Date	03/15/2007
Registration Date	02/26/2008	Foreign Priority Date	NONE
Word Mark	SHAZAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Software for music recognition; databases containing downloadable recorded music files; downloadable electronic wallpaper or other graphical images delivered by telephone or mobile phone		

U.S. Registration No.	3366072	Application Date	10/05/2006
Registration Date	01/08/2008	Foreign Priority Date	NONE
Word Mark	SHAZAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 0 First Use In Commerce: 0 Rental of advertising space; receiving orders for pre-recorded music, ring tones, electronic wallpaper and audio and video recordings of performances by musical artists and transmitting them to and/or causing them to be filled by participating providers of such goods; on-line retail store services featuring downloadable pre-recorded music, pre-recorded audio and video recordings of performances by musical artists, ring tones, electronic wallpaper; promotion, advertising and marketing of on-line websites		

Attachments	77131912#TMSN.png(bytes) 79030720#TMSN.png(bytes) Notice of Opposition.pdf(173653 bytes)
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Signature	/JS/
Name	James L. Scott
Date	05/08/2017

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

Re: Application Serial Nos. 86661776 and 86661764
Published on November 8, 2016

Shazam Entertainment Limited

Opposer,

v.

W.B. Mason Co., Inc.

Applicant

Opposition No.

NOTICE OF OPPOSITION

1. Opposer, Shazam Entertainment Limited, is a United Kingdom limited company with business offices at 26-28 Hammersmith Grove, London, England W67HA.

2. Applicant, W.B. Mason Co., Inc., is a Massachusetts corporation with an address of 59 Centre Street, Brockton, Massachusetts 02301.

3. On June 13, 2015, Applicant filed U.S. Application Serial No. 86661776, to register the mark SHAZAM COFFEE in standard characters for use with the following goods in International Class 30: coffee; coffee beans; ground coffee beans. On June 13, 2015, Applicant filed U.S. Application Serial No. 86661764, to register the mark SHAZAM COFFEE with a design, for use with the following goods in International Class 30: coffee; coffee beans; ground coffee beans. Each application was published in the *Official Gazette* of November 8, 2016. Each application disclaims “COFFEE.”

4. Opposer owns U.S. Trademark Registration Nos. 3387890 and 3366072 for the mark SHAZAM on the Principal Register (“**Opposer’s Registrations**”).

5. Opposer's Registrations are valid and subsisting and in full force and effect.
6. A true and correct copy of a current printout of information from the electronic database records of the USPTO is attached hereto and shows the current status and title of each of Opposer's Registrations.
7. Opposer has for years, and since prior to the filing date of Applicant's applications and prior to Applicant's first use of the mark SHAZAM COFFEE, used the mark SHAZAM in association with software for music recognition and the delivery of audiovisual content generated through the software.
8. Opposer has expended tens of millions of dollars to advertise and promote its content recognition software under the mark SHAZAM, and the SHAZAM application is one of the most downloaded mobile software applications of all time.
9. Opposer's SHAZAM mobile application has been downloaded over 1 billion times, in over 190 countries.
10. Opposer's SHAZAM mark is famous.
11. Opposer's SHAZAM branded software applications have included advertising for leading coffee brands within the United States such that Opposer's SHAZAM application has been associated with the promotion of coffee and other beverages.
12. Opposer has used the SHAZAM mark, and the relevant public recognizes the SHAZAM mark as identifying goods and services emanating exclusively from Opposer, since before Applicant first used the mark SHAZAM COFFEE.
13. Opposer's mark SHAZAM is inherently distinctive as used in connection with Opposer's products and services.

14. Through Opposer's advertising and promotion of software and content delivery services under the SHAZAM mark, the relevant public has come to recognize the mark as signifying Opposer and its products and services, and Opposer has built up extensive and valuable goodwill in the mark.

15. Opposer believes that it will be damaged by registration of the mark in each of Applicant's applications. Opposer, therefore, has standing under Lanham Act §13(a), 15 U.S.C. § 1063(a), to oppose the applications.

16. The goods covered by Applicant's applications are highly similar to, related to, and overlap with the goods and services sold by Opposer under the SHAZAM mark.

17. There is no issue of priority. The date of the opposed application and Applicant's alleged dates of first use is later than Opposer's use of the mark SHAZAM in interstate commerce in the United States.

18. The SHAZAM COFFEE mark in each opposed application is substantially identical in sight, sound and meaning to Opposer's mark SHAZAM.

19. Applicant's applications are not restricted by trade channel. Applicant's products are likely to be offered to an overlapping class of purchasers through the same and similar channels of trade.

20. Each mark in the opposed applications as used in connection with the goods identified in the applications so resembles Opposer's mark SHAZAM that it is likely to cause confusion, mistake or deception as to the origin of Applicant's goods and to confuse, mislead and deceive members of the public into believing that Applicant's goods originate from, or are sponsored, approved, or licensed by Opposer, or are in some way connected to Opposer and its products.

21. Applicant's use of each SHAZAM COFFEE mark in the opposed applications is likely to cause dilution by blurring or tarnishment.

22. Applicant's use and registration of each SHAZAM COFFEE mark for the goods identified in the opposed applications is likely to cause confusion, deception, and/or mistake among the relevant public.

23. Applicant's use and registration of each SHAZAM COFFEE mark for the goods identified in the opposed applications is likely to falsely suggest a connection with Opposer and Opposer's mark SHAZAM.

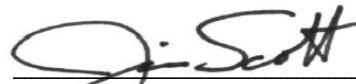
24. If Applicant were granted the registrations herein opposed, it would thereby obtain at least a prima facie exclusive right to use the marks. The registrations would be a source of damage and injury to Opposer.

Opposer requests that the applications be rejected and registration of the marks denied.

Respectfully submitted,

SHAZAM ENTERTAINMENT LIMITED

By: Warner Norcross & Judd LLP



James L. Scott
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111 Lyon Street N.W.
Grand Rapids, MI 49503
(616) 752-2469
Attorneys for Opposer

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Mark: SHAZAM

SHAZAM

US Serial Number: 77131912

Application Filing Date: Mar. 15, 2007

US Registration Number: 3387890

Registration Date: Feb. 26, 2008

Register: Principal

Mark Type: Trademark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Mar. 06, 2014

Publication Date: Dec. 11, 2007

Mark Information

Mark Literal Elements: SHAZAM

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

Foreign Information

Foreign Registration Number: 2356418

Foreign Registration Date: Nov. 22, 2005

Foreign Application/Registration EUROPEAN (EU) OFFICE FOR HARMONIZATION IN THE INTERNAL MARKET (OHIM)
Country: _____

Foreign Expiration Date: Aug. 29, 2011

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: Software for music recognition; databases containing downloadable recorded music files; downloadable electronic wallpaper or other graphical images delivered by telephone or mobile phone

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 44(e)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: Yes	Currently 44E: Yes	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Shazam Entertainment Limited

Owner Address: 26-28 Hammersmith Grove
London UNITED KINGDOM W67HA

Legal Entity Type: COMPANY

State or Country Where Organized: ENGLAND

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Lisa A. Pieroni

Docket Number: Cleveland -

Attorney Primary Email lap@kirschsteinlaw.com

Attorney Email Authorized: Yes

Address:

Correspondent

Correspondent Lisa A. Pieroni

Name/Address: Kirschstein, Israel, Schiffmiller & Pieroni, P.C.

5th Floor

425 Fifth Avenue

New York, NEW YORK UNITED STATES 10016-2223

Phone: 212-697-3750

Fax: 212-949-1690

Correspondent e-mail: lap@kirschsteinlaw.com

Correspondent e-mail Yes
Authorized:

Domestic Representative

Domestic Representative Lisa A. Pieroni

Phone: 212-697-3750

Name:

Fax: 212-949-1690

Domestic Representative e-mail: lap@kirschsteinlaw.com

Domestic Representative e-mail Yes
Authorized:

Prosecution History

Date	Description	Proceeding Number
Feb. 26, 2017	COURTESY REMINDER - SEC. 8 (10-YR)/SEC. 9 E-MAILED	
Mar. 06, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 06, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	76874
Feb. 18, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	76874
Mar. 06, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	76874
Feb. 18, 2014	TEAS SECTION 8 & 15 RECEIVED	
Apr. 12, 2010	APPLICANT/CORRESPONDENCE CHANGES (NON-RESPONSIVE) ENTERED	88888
11-18-2010	TEAS CHANGE OF OWNER ADDRESS RECEIVED	

Apr. 12, 2010	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Feb. 26, 2008	REGISTERED-PRINCIPAL REGISTER	
Dec. 11, 2007	PUBLISHED FOR OPPOSITION	
Nov. 21, 2007	NOTICE OF PUBLICATION	
Nov. 05, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	69712
Nov. 05, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 31, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Oct. 31, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Oct. 31, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Oct. 31, 2007	NOTIFICATION OF FINAL REFUSAL EMAILED	
Oct. 31, 2007	FINAL REFUSAL E-MAILED	
Oct. 31, 2007	FINAL REFUSAL WRITTEN	76638
Oct. 11, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	69712
Oct. 11, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	69712
Oct. 11, 2007	ASSIGNED TO LIE	69712
Aug. 31, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Jun. 28, 2007	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jun. 28, 2007	NON-FINAL ACTION E-MAILED	6325
Jun. 28, 2007	NON-FINAL ACTION WRITTEN	76638
Jun. 26, 2007	ASSIGNED TO EXAMINER	76638
Mar. 20, 2007	NEW APPLICATION ENTERED IN TRAM	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 414

Date in Location: Mar 06 2014

Current Location: TMO LAW OFFICE 114

Date in Location: Mar. 06, 2014

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Mark: SHAZAM

SHAZAM

US Serial Number: 79030720

Application Filing Date: Oct. 05, 2006

US Registration Number: 3366072

Registration Date: Jan. 08, 2008

Register: Principal

Mark Type: Service Mark

TM5 Common Status

LIVE/REGISTRATION/Issued and Active

Descriptor:



The trademark application has been registered with the Office.

Status: A Section 71 and 15 declaration has been accepted and acknowledged.

Status Date: Jan. 29, 2014

Publication Date: Oct. 23, 2007

Mark Information

Mark Literal Elements: SHAZAM

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

Related Properties Information

International Registration [0902971](#)
Number:

International Registration Oct. 05, 2006
Date:

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: Rental of advertising space; receiving orders for pre-recorded music, ring tones, electronic wallpaper and audio and video recordings of performances by musical artists and transmitting them to and/or causing them to be filled by participating providers of such goods; on-line retail store services featuring downloadable pre-recorded music, pre-recorded audio and video recordings of performances by musical artists, ring tones, electronic wallpaper; promotion, advertising and marketing of on-line websites

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 66(a)

Basis Information (Case Level)

Filed Use: No	Currently Use: No	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: Yes	Currently 66A: Yes	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: Shazam Entertainment Limited

Owner Address: 26-28 Hammersmith Grove
London W6 7HA UNITED KINGDOM

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Attorney/Correspondence Information

Attorney of Record**Attorney Name:** Lisa A. Pieroni**Attorney Primary Email** lap@kirschsteinlaw.com**Attorney Email Authorized:** No**Address:****Correspondent****Correspondent** Lisa A. Pieroni**Name/Address:** Kirschstein, Israel, Schiffmiller & Pier
425 Fifth Avenue
5th Floor
NEW YORK, NEW YORK UNITED STATES 10016-2223**Phone:** 212-697-3750**Fax:** 212-949-1690**Correspondent e-mail:** lap@kirschsteinlaw.com**Correspondent e-mail** No
Authorized:**Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Nov. 10, 2016	INTERNATIONAL REGISTRATION RENEWED	
Jun. 06, 2015	NEW REPRESENTATIVE AT IB RECEIVED	
Jan. 29, 2014	NOTICE OF ACCEPTANCE OF SEC. 71 & 15 - MAILED	
Jan. 29, 2014	REGISTERED - SEC. 71 ACCEPTED & SEC. 15 ACK.	68335
Jan. 06, 2014	REGISTERED - SEC. 71 & SEC. 15 FILED	68335
Jan. 27, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Jan. 06, 2014	TEAS SECTION 71 & 15 RECEIVED	
Jun. 17, 2010	CHANGE OF NAME/ADDRESS REC'D FROM IB	
May 08, 2009	FINAL DECISION TRANSACTION PROCESSED BY IB	
Apr. 22, 2008	FINAL DISPOSITION NOTICE SENT TO IB	
Apr. 22, 2008	FINAL DISPOSITION PROCESSED	67445
Apr. 10, 2008	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Jan. 08, 2008	REGISTERED-PRINCIPAL REGISTER	
Oct. 23, 2007	PUBLISHED FOR OPPOSITION	

Oct. 03, 2007	NOTICE OF PUBLICATION	
Sep. 19, 2007	LAW OFFICE PUBLICATION REVIEW COMPLETED	76539
Sep. 19, 2007	ASSIGNED TO LIE	76539
Aug. 13, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 09, 2007	NOTIFICATION OF FINAL REFUSAL EMAILED	
Aug. 09, 2007	FINAL REFUSAL E-MAILED	
Aug. 09, 2007	FINAL REFUSAL WRITTEN	83257
Aug. 07, 2007	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Aug. 07, 2007	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Aug. 07, 2007	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Aug. 07, 2007	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 03, 2007	CHANGE OF NAME/ADDRESS REC'D FROM IB	
Mar. 15, 2007	REFUSAL PROCESSED BY IB	
Feb. 26, 2007	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Feb. 26, 2007	REFUSAL PROCESSED BY MPU	74217
Feb. 24, 2007	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Feb. 23, 2007	NON-FINAL ACTION WRITTEN	83257
Feb. 22, 2007	ASSIGNED TO EXAMINER	83257
Nov. 27, 2006	NEW APPLICATION ENTERED IN TRAM	
Nov. 23, 2006	SN ASSIGNED FOR SECT 66A APPL FROM IB	

International Registration Information (Section 66a)

International Registration Number: 0902971

International Registration Date: Oct. 05, 2006

Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED

Date of International Registration Status: Nov. 23, 2006

Notification of Designation Date: Nov. 23, 2006

Date of Automatic Protection: May 23, 2008

International Registration Renewal Date: Oct. 05, 2026

First Refusal Filed: Yes

First Refusal Flag: yes

Maintenance Filings or Post Registration Information

Affidavit of Incontestability: Section 15 - Accepted

Affidavit of Continued Use: Section 71 - Accepted

TM Staff and Location Information

TM Staff Information

TM Attorney: HERRERA-MARCUS, ROSELL

Law Office Assigned: LAW OFFICE 102

File Location

Current Location: GENERIC WEB UPDATE

Date in Location: Jan. 29, 2014

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