

ESTTA Tracking number: **ESTTA950348**

Filing date: **01/28/2019**

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	Fieldwork Education Limited
Granted to Date of previous extension	01/27/2019
Address	St. Clements House 27-28 Clements Lane London, EC4N7AE UNITED KINGDOM

Attorney information	Ellen A. Rubel Moore & Van Allen PLLC 100 North Tryon Street, Suite 4700 Charlotte, NC 28202 UNITED STATES ear-ptotmcorrespondence@mvalaw.com, ellenrubel@mvalaw.com, kate-cole@mvalaw.com 919-286-8041
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Applicant Information

Application No	87614183	Publication date	07/31/2018
Opposition Filing Date	01/28/2019	Opposition Period Ends	01/27/2019
Applicant	Clarenter, LLC 2801 SW 3rd Avenue, Unit F8 Fort Lauderdale, FL 33315 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 2010/05/31 First Use In Commerce: 2010/05/31 All goods and services in the class are opposed, namely: Educational services, namely, developing educational programs and guidelines for others
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Other	Insufficient evidence of acquired distinctiveness Trademark Act Section 2(f)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
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Registration Date	NONE
Word Mark	INTERNATIONAL PRIMARY CURRICULUM
Goods/Services	Development of international curricula and corresponding guidelines; professional learning and consulting services and corresponding accreditation services

Attachments	Notice of Opposition - INTERNATIONAL PRESCHOOL CURRICULUM.pdf(98016 bytes)
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Signature	/ellenarubel/
Name	Ellen A. Rubel
Date	01/28/2019

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

In the matter of Application Serial Number: 87/614,183
Published in the Official Gazette: July 31, 2018

Fieldwork Education Limited,)	
Opposer,)	
)	
v.)	Opposition Number _____
)	
Clarenter, LLC,)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Fieldwork Education Limited, a company organized under the laws of the United Kingdom having an address of St. Clements House, 27-28 Clements Lane, London EC4N 7AE, United Kingdom, (hereinafter, “Opposer”), believes that it will be damaged by the registration of the mark shown in Application Serial No. 87/614,183 filed on September 19, 2017 in connection with services in International Class 41, and hereby opposes the registration of the same pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.101 *et seq.*

This Notice of Opposition is timely submitted following Opposer’s timely and appropriate filing of a 90-Day Request for Extension of Time to Oppose and its subsequent timely and appropriate filing of a subsequent 60-Day Request for Extension of Time to Oppose Upon Consent, both requests having been granted by the Trademark Trial and Appeal Board.

As grounds of opposition, Opposer alleges that:

1. Opposer has long advertised, marketed, promoted, offered for sale and/or rendered in commerce in and/or with the United States various educational services including but not limited to the development of international curricula and corresponding guidelines, professional learning and consulting services and corresponding accreditation services (“Opposer’s Services”) under its INTERNATIONAL PRIMARY CURRICULUM mark (“Opposer’s Mark”).

2. Since its launch in 2000, Opposer has continuously and substantially exclusively used its INTERNATIONAL PRIMARY CURRICULUM mark around the world and in the United States in connection with Opposer’s Services. At present, there are over 1,000 schools in more than 90 countries, including schools in the United States that subscribe to Opposer’s Services and to which Opposer renders its services.

3. Opposer has continuously used its INTERNATIONAL PRIMARY CURRICULUM mark in and/or with the United States since at least as early as 2004. As a result of Opposer’s continuous and substantially exclusive use in and/or with the United States, the mark has become associated exclusively with Opposer as an identifier of source in the minds of United States consumers. Consequently, Opposer has acquired significant common-law rights in the United States in its INTERNATIONAL PRIMARY CURRICULUM mark.

4. Opposer has spent substantial amounts of time, money and effort developing Opposer’s Mark and in marketing Opposer’s Services under Opposer’s Mark in the United States and globally.

5. Through Opposer’s marketing efforts and sales, Opposer has established a prominent presence in the global marketplace, including in the United States, and has built significant goodwill in Opposer’s Mark.

6. Applicant, Clarenter, LLC, who on information and belief is a Florida limited liability company, filed an application on September 20, 2010 seeking to register the mark INTERNATIONAL PRESCHOOL CURRICULUM (“Applicant’s Mark”) in connection with educational services, namely, developing curriculum for others in the field of preschool education in Class 41 claiming dates of first use anywhere and in interstate commerce of May 31, 2010.

7. Applicant’s application was assigned Serial No. 85/133,072 and was ultimately allowed to register on the Supplemental Register on February 14, 2012 as Registration No. 4,100,341 with a disclaimer of PRESCHOOL apart from the mark as a whole (“Applicant’s Supplemental Register Registration”).

8. On September 19, 2017, Applicant filed the instant application seeking registration of its INTERNATIONAL PRESCHOOL CURRICULUM mark on the Principal Register under Section 2(f) in connection with educational services, namely, developing educational programs and guidelines for others in Class 41 (“Applicant’s Services”).

9. Applicant’s application was assigned Serial No. 87/614,183 and following entry of a disclaimer of PRESCHOOL CURRICULUM apart from the mark as a whole the application was approved for publication on the Principal Register under Section 2(f) (“Applicant’s Application”).

10. The Claim of Acquired Distinctiveness in Applicant’s application was based solely on an unsubstantiated claim that its mark has become distinctive of its services through Applicant’s substantially exclusive and continuous use of Applicant’s Mark in commerce for at least the five years immediately before the date of that statement.

11. On information and belief, Applicant acquired no rights in Applicant's Mark in the United States prior to May 31, 2010, the date of first use in interstate commerce claimed by Applicant in Applicant's Application.

12. On information and belief, Applicant does not currently render Applicant's Services to any schools in the United States, and does not otherwise offer any goods or services under Applicant's Mark to any consumers in the United States.

13. On information and belief, Applicant did not continuously and substantially exclusively rendered Applicant's Services or any other goods or services to any schools in the United States or otherwise to any consumers in the United States for the five year period immediately preceding the filing of Applicant's Application.

14. There is no issue of priority. Opposer's use of Opposer's Mark (a) predates the September 19, 2017 filing date of Applicant's Application, (b) predates the September 20, 2010 filing date and February 14, 2012 registration of Applicant's Supplemental Register Registration and (c) predates the May 31, 2010 date of first use claimed in both Applicant's Application and Applicant's Supplemental Register Registration.

FIRST GROUND FOR OPPOSITION
Likelihood of Confusion

15. Opposer repeats and realleges the allegations of the preceding paragraphs as if fully set forth herein.

16. Opposer has used the INTERNATIONAL PRIMARY CURRICULUM mark in connection with Opposer's Services rendered internationally and in United States commerce prior to Applicant's filing of Applicant's Application.

17. The INTERNATIONAL PRESCHOOL CURRICULUM mark for which Applicant seeks registration by way of Applicant's Application is virtually identical in sight, sound and/or meaning to Opposer's INTERNATIONAL PRIMARY CURRICULUM mark.

18. Applicant's Services for which Applicant seeks to register Applicant's Mark overlap with and/or are substantially similar or related to Opposer's Services.

19. On information and belief, it is expected that Applicant's Services and Opposer's Services will be marketed to the same potential consumers through the same channels of trade.

20. Members of the public who encounter Applicant's Mark and Opposer's Mark used with the same or substantially similar services are likely to conclude that the respective services emanate from the same source.

21. Because of the similarity of Applicant's Mark and Opposer's Mark, the overlapping or related nature of the services, and the overlapping nature of the respective markets, channels of trade and/or consumers, Opposer believes that there will be a likelihood of consumer confusion if Applicant is permitted to register Applicant's Mark for use in connection with Applicant's Services despite Opposer's preexisting and ongoing rights and interest in its INTERNATIONAL PRIMARY CURRICULUM mark.

22. If Applicant is granted the registration herein opposed, Applicant would be placed in a position to deceive or mislead the public as the registration would give Applicant prima facie exclusive rights to Applicant's Mark and all confusingly similar marks, thereby causing damage and injury to Opposer.

23. Because Applicant's mark closely resembles Opposer's Mark and Applicant's Mark is likely, when used in connection with Applicant's Services, to cause confusion, to cause mistake or to deceive consumers and the public, registration of Applicant's Mark in connection

with Applicant's Opposed Services is, therefore, barred under 15 U.S.C. §1052(d) and 15 U.S.C. §1125(a).

24. Accordingly, Opposer asserts, pursuant to 15 U.S.C. §1063, that it will be damaged by the issuance of a registration to Applicant for the mark as sought in Trademark Application Serial No. 87/614,183.

SECOND GROUND FOR OPPOSITION
Insufficient Evidence of Acquired Distinctiveness

25. Opposer repeats and realleges the allegations of the preceding paragraphs as if fully set forth herein.

26. Pursuant to 15 U.S.C. §1052(f), in light of Opposer's continuous use of its INTERNATIONAL PRIMARY CURRICULUM mark during the relevant five year period associated with the allegation of acquired distinctiveness in Applicant's Application, a mere claim of five years use without any substantiating evidence is insufficient to allow for registration of the INTERNATIONAL PRESCHOOL CURRICULUM mark on the Principal Register.

27. Upon information and belief, Applicant's Mark has not become distinctive of Applicant's Services in the United States.

28. Upon information and belief, Applicant's Mark has not acquired distinctiveness in the United States.

WHEREFORE, Opposer prays that Application Serial No. 87/614,183 seeking registration of the INTERNATIONAL PRESCHOOL CURRICULUM mark in International Class 41 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully submitted this 28th day of January, 2019.



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