

ESTTA Tracking number: **ESTTA958472**

Filing date: **03/06/2019**

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	WeWork Companies Inc.
Granted to Date of previous extension	03/06/2019
Address	115 West 18th Street New York, NY 10011 UNITED STATES

Attorney information	Leo Kittay Fross Zelnick Lehrman & Zissu, P.C. 4 Times Square, 17th Floor New York, NY 10036 UNITED STATES lkittay@fzlz.com, lpopp-rosenberg@fzlz.com, ttabfiling@fzlz.com, mgoldstein@fzlz.com 212-813-5900
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Applicant Information

Application No	87933744	Publication date	11/06/2018
Opposition Filing Date	03/06/2019	Opposition Period Ends	03/06/2019
Applicant	WE TALKS ENTERPRISES, LLC 4TH FLOOR 575 LEXINGTON AVENUE NEW YORK, NY 10022 UNITED STATES		

Goods/Services Affected by Opposition


Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring and promoting lectures, panels, discussions, talks and presentations on subject matter that facilitates the empowerment of women in all areas of their professional, business, academic, scientific, political, cultural and social lives
Class 041. First Use: 2018/04/26 First Use In Commerce: 2018/04/26 All goods and services in the class are opposed, namely: (Based on Use in Commerce) Entertainment and educational services, namely, the presentation of seminars, lectures, workshops and panel discussions, and ongoing television and radio talk shows all in the field of public interest concerning subject matter designed to facilitate the empowerment of women in all areas of their professional, business, academic, scientific, political, cultural and social lives (Based on Intent to Use) Providing a website featuring non-downloadable articles in the field of women's empowerment; Providing a website featuring non-downloadable videos on inspirational or motivational topics for women

Class 045. First Use: 0 First Use In Commerce: 0
 All goods and services in the class are opposed, namely: Providing a resource website featuring information in the field of self-development; Providing a website featuring inspirational and motivational news stories about women


Grounds for Opposition

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


Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	4453874	Application Date	03/22/2013
Registration Date	12/24/2013	Foreign Priority Date	NONE
Word Mark	WEWORK		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2010/02/00 First Use In Commerce: 2011/10/00 Providing co-working facilities equipped with private offices, office equipment, mailroom, printing center, receptionist, kitchen, meeting rooms, telecommunications equipment and other office amenities; Business information services; incubation services, namely, providing work space containing business equipment and other amenities to emerging, start-up and existing companies; Business development services, namely, providing start-up support for businesses of others; providing office support services; online business networking services; Administering group purchasing programs and other discount programs, namely negotiating with providers of insurance, banking, credit card processing, travel and transportation services, to enable participant members of a business community to obtain discounts on the purchase of those services from others; computer-assisted business information and research services; assistance and advice regarding business location; arranging and conducting special events, parties, camps, concerts and travel for business purposes</p> <p>Class 041. First use: First Use: 2010/02/00 First Use In Commerce: 2011/10/00 Entertainment and educational services, namely, organizing, conducting and arranging training, classes, seminars, workshops, conferences and exhibitions in the fields of business, technology and social networking; electronic publication of blogs, brochures, magazines, and newsletters on a wide variety of topics; arranging, organizing, conducting and hosting social entertainment events</p> <p>Class 042. First use: First Use: 2013/02/00 First Use In Commerce: 2013/03/22 Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in business and social networking; platforms for providing a web-based on-line portal for customers to participate in business and social</p>		

	<p>networking, engage in virtual communities, manage membership in a co-working and private office facilities service, request and manage office assignments, reserve conference rooms, control employees' useraccess, order printing services, and sign up and pay for vendor services such as catering, benefits and health insurance; computer services, namely, hosting on-line web facilities for others for organizing and conducting online introductions, meetings, gatherings and interactive discussions; computer services, namely, interactive hosting services which allow the user to publish and share their own content and images, and interact with others, on-line; computer services, namely, cloud hosting provider services; computer services, namely, on-site and remote management of IT systems; installation [, updating and maintenance] of computer software; [rental of web servers;]server hosting; technical support services, namely, troubleshooting of computersoftware problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems</p> <p>Class 045. First use: First Use: 2013/02/00 First Use In Commerce: 2013/03/22 Online social networking services; social networking services in the field of business provided via a website</p>
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U.S. Registration No.	5276604	Application Date	11/12/2013
Registration Date	08/29/2017	Foreign Priority Date	NONE
Word Mark	WEWORK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2011/04/02 First Use In Commerce: 2011/04/02 Providing on-line employment information in the field of careers, job listings, job resources and resumes; providing career information; business networking services		

U.S. Registration No.	4015942	Application Date	02/01/2011
Registration Date	08/23/2011	Foreign Priority Date	NONE
Word Mark	WEWORK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 2009/06/13 First Use In Commerce: 2009/09/12 Leasing of office space; Leasing of real estate; Rental of office space

U.S. Registration No.	5119653	Application Date	03/06/2013
Registration Date	01/10/2017	Foreign Priority Date	NONE
Word Mark	WEWORK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 038. First use: First Use: 2014/00/00 First Use In Commerce: 2014/00/00 Digital network telecommunications services; providing multiple user wireless access to the Internet; Telecommunications services, namely, electronic transmission of data and digital messaging via mobile handheld devices and via wired and wireless communication devices; telecommunications services, namely, enabling users to electronically transmit messages, text, multimedia content, videos, audio, animation and images via a global computer network; providing online forums, chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; video conferencing services; providing facilities and equipment for video and telepresence conferencing		

U.S. Registration No.	4838465	Application Date	11/12/2013
Registration Date	10/20/2015	Foreign Priority Date	NONE
Word Mark	WEWORK		

Design Mark	WEWORK
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2013/12/20 First Use In Commerce: 2013/12/20 Computer application software for users to manage membership in a co-working facilities service, reserve conference rooms, participate in business and social networking, engage in virtual communities, search job listings, and sign up and pay for vendor services such as catering, benefits and health insurance

U.S. Registration No.	5380816	Application Date	10/07/2013
Registration Date	01/16/2018	Foreign Priority Date	NONE

Word Mark	WELIVE
Design Mark	WELIVE

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2016/04/04 First Use In Commerce: 2016/04/04 Computer application software for mobile phones and handheld computers, namely, software for members of a residential community to participate in social networking, engage in virtual communities, manage their community membership Class 038. First use: First Use: 2016/04/04 First Use In Commerce: 2016/04/04 Digital network telecommunications services; providing multiple user wireless access to the Internet Class 042. First use: First Use: 2016/04/04 First Use In Commerce: 2016/04/04 Computer services, namely, creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking; providing a web hosting platform for members of a residential community to participate in social networking, engage in virtual communities, manage community membership; computer services, namely, on-site and remote management of IT systems; technical support services, namely, troubleshooting of computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hard-

	<p>ware and software problems</p> <p>Class 043. First use: First Use: 2016/04/04 First Use In Commerce: 2016/04/04 Providing community centers for social gatherings and meetings; providing of drink</p> <p>Class 045. First use: First Use: 2016/04/04 First Use In Commerce: 2016/04/04 online social networking services; personal concierge services for others comprising making requested personal arrangements and reservations, running errands and providing customer specific information to meet individual needs, all rendered in residential complexes</p>
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U.S. Registration No.	5144928	Application Date	04/11/2016
Registration Date	02/21/2017	Foreign Priority Date	NONE
Word Mark	WE MEMBERSHIP		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 2016/03/00 First Use In Commerce: 2016/03/00 Conducting and administering a program for members of a co-working and co-living community that enables program participants to obtain access to a variety of goods, services and benefits offered within the community by affiliated providersexclusively as a benefit to those that are part of the membership program community; providing co-working facilities equipped with office equipment; providing co-working, temporary and shared work spaces, offices, business event spaces, business meeting facilities and office equipment</p>		

U.S. Application No.	86631398	Application Date	05/15/2015
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	WE		
Design Mark			

Description of Mark	NONE
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Computer application software for use with mobile phones and handheld computers for users to manage membership in a coworking facilities service, request and manage office assignments, reserve conference rooms, and control employees' user access</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0 Providing co-working facilities equipped with office equipment; incubation services, namely, providing work space containing business equipment and other amenities to emerging, start-up and existing companies; providing co-working, temporary and shared work spaces, offices, business event spaces, business meeting facilities and office equipment; business operation of commercial real estate, offices and office space, namely, shared office venues with conference facilities</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0 Real estate services, namely, leasing of real property and apartments; management of apartments and buildings; lease of real estate; leasing of office space; leasing of real estate; leasing or renting of buildings; rental of office space</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Platform as a service (PAAS) featuring online, non-downloadable, web-based computer software for providing a web-based on-line portal for customers to manage membership in a co-working and private office facilities service, request and manage office assignments, reserve conference rooms, and control employees' user access</p>

U.S. Application No.	87006295	Application Date	04/19/2016
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	WEWORK
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Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Computer software for members of a residential community to participate in social networking, engage in virtual communities, manage their community membership, make rent payments, and sign up for and manage use of amenities such as library, media room, theater, gym, concierge, restaurants, cafes, and kitchen; computer software for making restaurant reservations, placing orders for delivery of food to residences, and for organizing parties and events; computer software for signing up for classes at fitness and health clubs and exercise facilities and for making appointments for treatments at health spas; Downloadable visitor registration computer software that records entry and exit of visitors and collects visitor information; Downloadable visitor registration computer software that en-</p>
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ables preparation and distribution of signed electronic visitor registration documents; Downloadable visitor registration computer software that enables the printing of visitor badges with photos; Downloadable visitor registration computer software that notifies others of the arrival of a visitor; Downloadable visitor registration computer software that prepares reports of visitors; Protective covers and cases for cell phones, laptops and portable media players; computer bags; headphones; tablet computers

Class 035. First use: First Use: 0 First Use In Commerce: 0

Art galleries; Transportation logistics services, namely, arranging the transportation of goods for others; Consumer survey services; On-line retail store services featuring a wide variety of consumer goods of others; Consulting services in the field of human resources development, namely, for the promotion of employee retention, career growth, and increased productivity for employees and employers

Class 036. First use: First Use: 0 First Use In Commerce: 0

Real estate services, namely, leasing of apartments; management of apartments and buildings; Art brokerage; Advisory services in the field of employee benefits for group healthcare and business insurance offered to employees in addition to standard benefits such as medical, dental, life insurance including short term disability, long term disability, cancer insurance, accidental death and dismemberment; Charitable fund-raising services

Class 039. First use: First Use: 0 First Use In Commerce: 0

Valet parking; valet bicycle parking services; provision of bicycle storage facilities; Parcel shipping services; Postal services, namely, parcel delivery, packaging articles for transportation, rental of mailboxes; Providing a website featuring information regarding transportation services and bookings for transportation services; transport by motorized vehicles; travel arrangement, namely, arranging vehicle transportation; Transportation and delivery of goods; laundry collection services; delivery of goods; arranging the collection of laundry; collection of laundry; arranging the delivery of laundry; delivery of laundry; Warehouse storage; Temporary storage of deliveries; Rental of storage containers; Storage of goods; moving and storage of goods; Flower delivery

Class 041. First use: First Use: 0 First Use In Commerce: 0

Health club services, namely, providing instruction and equipment in the field of physical exercise; providing fitness and exercise facilities; conducting fitness classes; providing swimming pools; libraries; entertainment services, namely, conducting parties for the purpose of dating and social introduction for adults; movie theaters; providing facilities for entertainment purposes, namely, providing media room facilities featuring audio-visual equipment; sporting and cultural activities, namely, organizing community sporting and cultural events; Entertainment services, namely, bowling alleys services; Rental services for audio and video equipment; Translation services; translation services for businesses and travelers; educational and entertainment services, namely, providing motivational and educational speakers; Organizing and conducting an awards ceremony recognizing achievement and excellence in the field of entrepreneurship; Educational services, namely, conducting seminars, workshops, lectures and classes in the fields of media, science, engineering, mathematics, entrepreneurship, popular culture, civics and public advocacy, charitable giving, publishing, psychology, exercise, fitness, and professional advancement

Class 042. First use: First Use: 0 First Use In Commerce: 0

Providing a website featuring information about green architecture, interior design, sustainable community planning and infrastructure development; computer services, namely, cloud hosting provider services; Non-downloadable visitor registration computer software that records entry and exit of visitors and collects visitor information; Non-downloadable visitor registration computer software that enables preparation and distribution of signed electronic visitor registration documents; Non-downloadable visitor registration computer software that

	<p>enables the printing of visitor badges with photos; Non-downloadable visitor registration computer software that notifies others of the arrival of a visitor; and Non-downloadable visitor registration computer software that prepares reports of visitors; providing temporary use of non-downloadable software, also known as software as a service, for members of a residential community to participate in social networking, engage in virtual communities, manage their community membership, make rent payments, and sign up for and manage use of amenities such as library, media room, theater, gym, concierge, restaurants, cafes, and kitchen; providing temporary use of non-downloadable software, also known as software as a service, for making restaurant reservations, placing orders for delivery of food to residences, and for organizing parties and events; providing temporary use of non-downloadable software, also known as software as a service, for signing up for classes at fitness and health clubs and exercise facilities and for making appointments for treatments at health spas; Providing temporary use of online non-downloadable software for providing transportation services, bookings for transportation services and for dispatching motorized vehicles to customers; design and development of computer software</p> <p>Class 043. First use: First Use: 0 First Use In Commerce: 0</p> <p>Providing temporary accommodations; providing temporary housing accommodations; hotel services; online booking and reservation services for temporary lodging; Cafe, bar and restaurant services; providing a website for customers to make restaurant reservations, place orders for delivery of food to residences and offices, and place catering orders for food and beverages; Rental of bed and bath linens; Rental of table linens; Food preparation services featuring meals for delivery or pick-up; providing information in the field of recipes and cooking from a computer database</p> <p>Class 045. First use: First Use: 0 First Use In Commerce: 0</p> <p>Legal information services</p>
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Attachments	<p>85883629#TMSN.png(bytes) 86116984#TMSN.png(bytes) 85231506#TMSN.png(bytes) 85868853#TMSN.png(bytes) 86977013#TMSN.png(bytes) 86084940#TMSN.png(bytes) 86970677#TMSN.png(bytes) 86631398#TMSN.png(bytes) 87006295#TMSN.png(bytes) Notice of Opposition WE TALKS.PDF(23302 bytes)</p>
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Signature	/Laura Popp-Rosenberg/
Name	Laura Popp-Rosenberg
Date	03/06/2019

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

WEWORK COMPANIES INC.,

Opposer,

v.

WE TALKS ENTERPRISES, LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

WeWork Companies Inc. (“Opposer”) believes that it would be damaged by the issuance of a registration for the trademark WE TALKS by We Talks Enterprises LLC (“Applicant”), as applied for in Application Serial No. 87/933,744 (the “Application”), and therefore opposes the same. As grounds for this opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., states as follows:

1. Opposer is a Delaware corporation with an address of 115 West 18 Street, New York, New York, 10011.

2. Opposer, the acknowledged leader in the shared office space industry in the United States, has provided businesses and individuals with workspace, educational and entertainment services relating to entrepreneurship and related goods and services since at least as early as 2010 under the marks WE, WEWORK, and other WE-formative marks (together, “Opposer’s Marks”).

3. Among Opposer’s myriad offerings are entertainment, educational and training services (including providing motivational and educational speakers, as well as events, seminars and conferences in the fields of business and technology), incubation services geared toward

emerging growth companies, business information services (including support for start-up businesses and local corporations), online publications (including blogs, magazines, and newsletters), and special event programming, all of which are promoted and offered under Opposer's Marks.

4. Opposer provides awards known as Creator Awards to recognize and reward achievements in entrepreneurship. Participation in the process includes pitches by entrepreneurs and start-up organizations. The event is hosted by the celebrity Ashton Kutcher and includes involvement by other well-known celebrities and business leaders as judges.

5. As a result of Opposer's reputation, substantial sales success, inestimable popularity, and significant investment in advertising and promotion, Opposer's Marks have become well-known throughout the United States and the world, and consumers have come to recognize Opposer's Marks as exclusively denoting Opposer's goods and services. As such, Opposer is the owner of all right, title, and interest in and to Opposer's Marks in connection with this wide array of goods and services, and Opposer's Marks represent enormous goodwill and are extremely valuable assets to Opposer.

6. Since prior to any date upon which Applicant can rely, Opposer's Marks both separately and together have become uniquely identified with Opposer and have come to identify the services and products of Opposer exclusively.

7. In addition to its common law trademark rights in Opposer's Marks developed through many years of use and promotion, Opposer owns federal trademark registrations for Opposer's Marks, including but not limited to:

<u>Mark</u>	<u>Reg. No.</u>	<u>International Classes</u>
WEWORK	4453874	35, 41, 42 and 45
WEWORK	5276604	35

<u>Mark</u>	<u>Reg. No.</u>	<u>International Classes</u>
WEWORK	4015942	36
WEWORK	5119653	38
WEWORK	4838465	9
WELIVE	5380816	9, 38, 42, 43, and 45
WE MEMBERSHIP	5144928	35

All of the foregoing registrations for Opposer’s Marks are valid, subsisting and in full effect and therefore serve as prima facie evidence of the validity of the marks and of Opposer’s exclusive right to use the marks in connection with the goods and services identified therein, pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(a). In addition, Registration No. 4,015,942 has become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, and therefore serves as conclusive proof of Opposer’s exclusive right to use the WEWORK mark in connection with the services identified therein, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

8. Opposer also owns a pending trademark application for the WE mark for goods and services in International Classes 9, 35, 36 and 42, Serial No. 86631398.

9. Moreover, Opposer owns pending trademark application for WEWORK in connection with, *inter alia*, educational and entertainment services, namely, providing motivational and educational speakers in International Class 41, Serial No. 87006295.

10. According to the online records of the United States Patent and Trademark Office (“USPTO”), Applicant is a New York limited liability company with an address of 575 Lexington Avenue, 4th Floor, New York, New York, 10022.

11. According to the online records of the USPTO, on May 23, 2018, Applicant filed the Application for the mark WE TALKS in connection with the following goods and services based on an intent-to-use the mark under Section 1(b) of the Lanham Act:

- “Digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring and promoting lectures, panels, discussions, talks and presentations on subject matter that facilitates the empowerment of women in all areas of their professional, business, academic, scientific, political, cultural and social lives” in International Class 9;
- “Providing a resource website featuring information in the field of self-development; Providing a website featuring inspirational and motivational news stories about women” in International Class 45; and
- Providing a website featuring non-downloadable articles in the field of women's empowerment; Providing a website featuring non-downloadable videos on inspirational or motivational topics for women” in International Class 41.

12. Applicant also filed the Application for the mark WE TALKS in connection with “Entertainment and educational services, namely, the presentation of seminars, lectures, workshops and panel discussions, and ongoing television and radio talk shows all in the field of public interest concerning subject matter designed to facilitate the empowerment of women in all areas of their professional, business, academic, scientific, political, cultural and social lives” in International Class 41 based on a first use in commerce date of April 26, 2018.

13. In addition, Applicant has adopted the term WE PITCH in connection with a pitch night for entrepreneurs.

14. Upon information and belief, Opposer’s rights in Opposer’s Marks are prior and superior to any rights Applicant may claim in the mark WE TALKS.

15. The mark WE TALKS is highly similar to Opposer’s Marks in appearance, sound, and commercial impression.

16. The goods and services identified in the Application are identical and/or related to the goods and services offered by Opposer under Opposer's Marks and for which Opposer has registered Opposer's Marks.

17. Given the similarities in the parties marks and services, among other factors, use by Applicant of the WE TALKS mark for the goods and services identified in the Application is likely to create the erroneous impression that Applicant's goods and services originate with, are sponsored or approved by, or are otherwise connected with Opposer, Opposer's Marks, or goods and services provided by Opposer. Any use of the WE TALKS mark by Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public, in violation of 15 U.S.C. § 1052(d).

18. Moreover, Opposer's WEWORK mark is famous for goods and services relating to rental of office spaces, and had become famous long before the earliest priority date upon which Applicant can rely. Because the WEWORK mark has become famous, Applicant's use and registration of the WE TALKS mark for the applied-for goods and services will damage Opposer by trading on the enormous goodwill associated with the WEWORK mark and dilute its distinctiveness. Thus, Applicant's use and registration of the WE TALKS mark in connection with the goods and services identified in its Application is likely to cause dilution by blurring of the famous WEWORK mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

19. As a result of the foregoing, registration to Applicant of the WE TALKS mark would be inconsistent with Opposer's prior exclusive rights in Opposer's Marks and would threaten to destroy Opposer's investment and goodwill in Opposer's Marks. Opposer therefore will be injured by registration of the WE TALKS mark.

