

ESTTA Tracking number: **ESTTA959309**

Filing date: **03/11/2019**

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	ESRT Empire State Building, L.L.C.
Granted to Date of previous extension	03/13/2019
Address	111 West 33rd Street New York, NY 10120 UNITED STATES

Attorney information	Eric J. Shimanoff, Esq. Cowan, Liebowitz & Latman, P.C. 114 West 47th Street New York, NY 10036 UNITED STATES ejs@cll.com, trademark@cll.com, fxm@cll.com 2127909200
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**Applicant Information**

Application No	87725562	Publication date	11/13/2018
Opposition Filing Date	03/11/2019	Opposition Period Ends	03/13/2019
International Registration No.	NONE	International Registration Date	NONE
Applicant	Samwit B.V. Zuidkade 6 5462 CD Veghel NETHERLANDS		

**Goods/Services Affected by Opposition**

<p>Class 009. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Computer software for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Computer software packages for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Software applications for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, re-</p>
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views and recommendations on traveling and locations visited; downloadable web applications for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; mobile application for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Magnetic data carriers featuring travel information and maps; recording discs featuring travel information and maps; Compact discs featuring travel information, and DVDs featuring travel information; computers; Electronic publications, downloadable or on data carriers, namely, leaflets, brochures, information bulletins, magazines and books featuring travel information; Data transmission apparatus

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)
Other	No bona fide intent to use mark in commerce for identified goods or services under Trademark Act Section 44(e)

## Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2411972	Application Date	05/13/1999
Registration Date	12/12/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		
Design Mark	<b>EMPIRE STATE BUILDING</b>		
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 entertainment services, namely, providing observation decks in a skyscraper for purposes of sightseeing		

U.S. Registration No.	2413667	Application Date	05/13/1999
Registration Date	12/19/2000	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE BUILDING		

Design Mark	<b>EMPIRE STATE BUILDING</b>
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE

U.S. Registration No.	2429297	Application Date	05/13/1999
Registration Date	02/20/2001	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
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Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top.
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Goods/Services	Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY THE MANAGEMENT AND LEASING OF REAL ESTATE
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U.S. Registration No.	2430828	Application Date	05/13/1999
Registration Date	02/27/2001	Foreign Priority Date	NONE

Word Mark	NONE
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Design Mark	
Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed, spindled top.
Goods/Services	Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 ENTERTAINMENT SERVICES, NAMELY, PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FORPURPOSES OF SIGHTSEEING

U.S. Registration No.	5680158	Application Date	07/02/2018
Registration Date	02/19/2019	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			

Description of Mark	The mark consists of the shape of the exterior of a skyscraper with a pointed spindled top.
Goods/Services	Class 036. First use: First Use: 2017/02/02 First Use In Commerce: 2017/02/02 REAL ESTATE OWNERSHIP SERVICES IN THE NATURE OF COMMERCIAL SERVICES, NAMELY, REAL PROPERTY ACQUISITION AND CONSUMER FINANCING TO FACILITATE COMMERCIAL OWNERSHIP; REAL ESTATE MANAGEMENT SERVICES; REALESTATE MANAGEMENT SERVICES IN THE NATURE OF REAL ESTATE OPERATION; LEASING OF REAL ESTATE; PROVIDING REAL ESTATE INVESTMENT TRUST SERVICES; REAL ESTATE INVESTMENT TRUST MANAGEMENT SERVICES Class 037. First use: First Use: 2017/02/02 First Use In Commerce: 2017/02/02 REAL ESTATE DEVELOPMENT, CONSTRUCTION, CONSTRUCTION PROJECT MANAGEMENT, AND GENERAL BUILDING CONTRACTOR SERVICES FOR COMMERCIAL, RESIDENTIAL, HOTEL, HOSPITAL, EDUCATIONAL, COMMUNITY AND GOVERNMENT REAL ESTATE FACILITIES; CLEANING OF COMMERCIAL PREMISES; REAL ESTATE PROPERTY RENOVATION AND REPAIR SERVICES

U.S. Registration No.	4797995	Application Date	06/25/2014
Registration Date	08/25/2015	Foreign Priority Date	NONE

Word Mark	EMPIRE STATE BUILDING
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 035. First use: First Use: 1999/01/00 First Use In Commerce: 1999/01/00 PROMOTING THE GOODS AND SERVICES OF OTHERS BY LICENSING IMAGES OF AN ICONIC BUILDING; PROVIDING FACILITIES FOR BUSINESS-MEETINGS Class 036. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 REAL ESTATE SERVICES, NAMELY, LEASING OF COMMERCIAL PROPERTY, NAMELY, GIFT SHOPSPACE; LEASING OF RESTAURANT SPACE Class 038. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 RENTAL OF TELECOMMUNICATION FACILITIES;RENTAL OF EQUIPMENT FOR RADIO AND TELEVISION BROADCASTING Class 041. First use: First Use: 1931/05/01 First Use In Commerce: 1931/05/01 ENTERTAINMENT SERVICES, NAMELY, PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FORSIGHTSEERS; ENTERTAINMENT IN THE NATUREOF LASER AND LIGHT SHOWS; PROVIDING FACILITIES FOR FILM AND PHOTO PRODUCTION; PROVIDING FACILITIES FOR SPORTS TOURNAMENTS; EDUCATIONAL SERVICES, NAMELY, PROVIDING DISPLAYS AND EXHIBITS IN THE FIELD OF ENGINEERING, CONSTRUCTION AND SUSTAINABILITY; EDUCATIONAL SERVICES, NAMELY, TRAINING EDU-
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CATORS AND PARENTS IN THE FIELDS OF SOCIAL STUDIES, SCIENCE AND TECHNOLOGY, AMERICAN HISTORY AND GEOGRAPHY AND PROVIDING CURRICULA IN CONNECTION THEREWITH

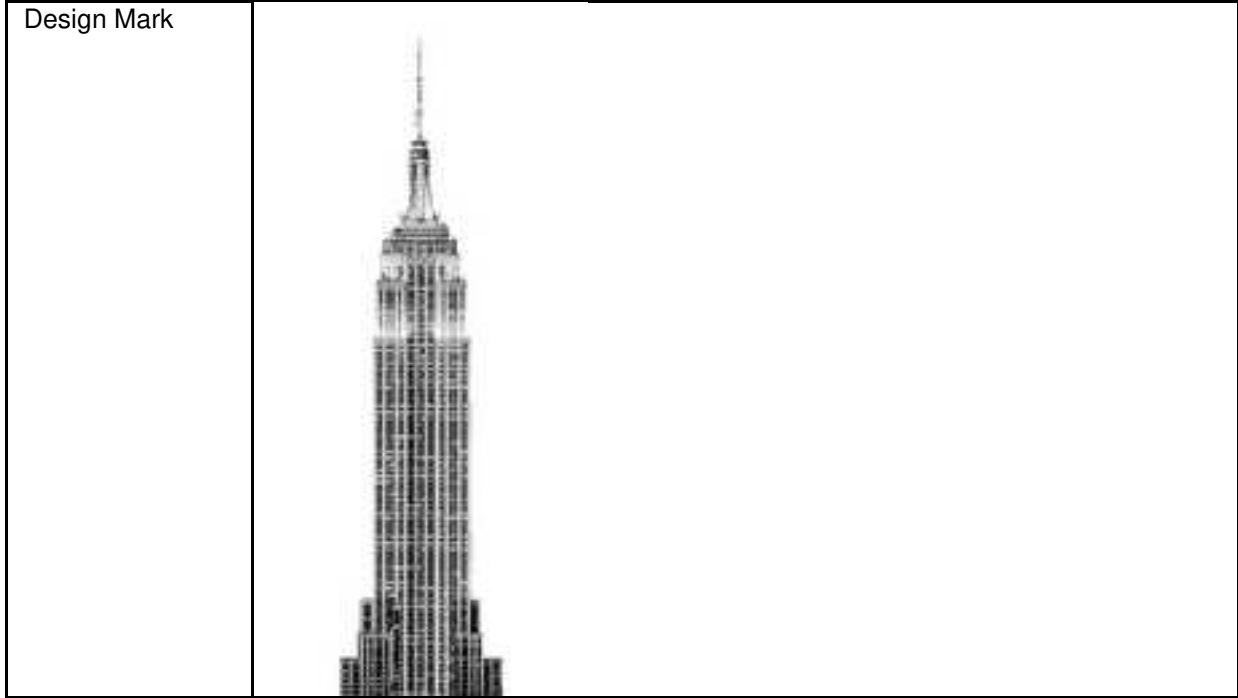
Class 042. First use: First Use: 2014/06/00 First Use In Commerce: 2014/06/00 PROVIDING A WEB SITE THAT GIVES COMPUTER USERS THE ABILITY TO UPLOAD AND SHARE USER-GENERATED IMAGES

Class 043. First use: First Use: 2007/08/00 First Use In Commerce: 2007/08/00 PROVIDING GENERAL PURPOSE FACILITIES FOR MEDIA, CELEBRITY AND BRAND EVENTS; PROVIDING CONFERENCE, EXHIBITION AND MEETING FACILITIES; PROVIDING BANQUET AND SOCIAL FUNCTION FACILITIES

Class 045. First use: First Use: 1994/02/14 First Use In Commerce: 1994/02/14 PROVIDING FACILITIES FOR WEDDING CEREMONIES

U.S. Registration No.	4775666	Application Date	08/08/2014
Registration Date	07/21/2015	Foreign Priority Date	NONE

Word Mark NONE



Description of Mark The mark consists of the shape of the exterior of a skyscraper with a pointed spindled top.

Goods/Services

Class 035. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 PROMOTING THE GOODS AND SERVICES OF OTHERS BY LICENSING IMAGES OF AN ICONIC BUILDING; PROVIDING FACILITIES FOR BUSINESS-MEETINGS

Class 036. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 REAL ESTATE SERVICES, NAMELY, LEASING OF COMMERCIAL PROPERTY, NAMELY, GIFT SHOPSPACE; LEASING OF RESTAURANT SPACE

Class 038. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 RENTAL OF TELECOMMUNICATION FACILITIES; RENTAL OF EQUIPMENT FOR RADIO AND TELEVISION BROADCASTING

Class 041. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06

	<p>ENTERTAINMENT SERVICES, NAMELY PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FOR SIGHTSEERS; ENTERTAINMENT IN THE NATURE OF LASER AND LIGHT SHOWS; PROVIDING FACILITIES FOR FILM AND PHOTO PRODUCTION; PROVIDING FACILITIES FOR SPORTS TOURNAMENTS; EDUCATIONAL SERVICES, NAMELY PROVIDING DISPLAYS AND EXHIBITS IN THE FIELD OF ENGINEERING, CONSTRUCTION AND SUSTAINABILITY; EDUCATIONAL SERVICES, NAMELY TRAINING EDUCATORS AND PARENTS IN THE FIELDS OF SOCIAL STUDIES, SCIENCE AND TECHNOLOGY, AMERICAN HISTORY AND GEOGRAPHY AND PROVIDING CURRICULA IN CONNECTION THEREWITH</p> <p>Class 042. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 PROVIDING A WEB SITE THAT GIVES COMPUTER USERS THE ABILITY TO UPLOAD AND SHARE USER-GENERATED IMAGES</p> <p>Class 043. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 PROVIDING GENERAL PURPOSE FACILITIES FOR MEDIA, CELEBRITY AND BRAND EVENTS; PROVIDING CONFERENCE, EXHIBITION AND MEETING FACILITIES; PROVIDING BANQUET AND SOCIAL FUNCTION FACILITIES</p> <p>Class 045. First use: First Use: 2014/08/06 First Use In Commerce: 2014/08/06 PROVIDING FACILITIES FOR WEDDING CEREMONIES</p>
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U.S. Registration No.	4744135	Application Date	04/02/2013
Registration Date	05/26/2015	Foreign Priority Date	NONE
Word Mark	EMPIRE STATE REALTY TRUST		
Design Mark			
Description of Mark	The mark consists of the words "EMPIRE STATE" with the silhouette of the EmpireState Building in place of the letter "i" all in green above the words "REALTY TRUST" in blue.		
Goods/Services	<p>Class 036. First use: First Use: 2012/02/13 First Use In Commerce: 2013/01/21 PROVIDING REAL ESTATE INVESTMENT TRUST SERVICES; REAL ESTATE INVESTMENT TRUST MANAGEMENT SERVICES; THE MANAGEMENT AND LEASING OF REAL ESTATE</p> <p>Class 037. First use: First Use: 2013/10/07 First Use In Commerce: 2013/10/07 REAL ESTATE DEVELOPMENT AND CONSTRUCTION OF COMMERCIAL, RESIDENTIAL AND HOTEL PROPERTY; CLEANING OF COMMERCIAL PREMISES</p> <p>Class 038. First use: First Use: 2013/10/28 First Use In Commerce: 2013/10/28 RENTAL OF TELECOMMUNICATION FACILITIES; RENTAL OF EQUIPMENT FOR RADIO AND TELEVISION BROADCASTING</p> <p>Class 041. First use: First Use: 2014/02/18 First Use In Commerce: 2014/02/18 ENTERTAINMENT SERVICES, NAMELY, PROVIDING OBSERVATION DECKS IN A SKYSCRAPER FOR PURPOSES OF SIGHTSEEING</p>		

Attachments	75705741#TMSN.png( bytes ) 75705740#TMSN.png( bytes ) 75705772#TMSN.png( bytes ) 75705756#TMSN.png( bytes ) 88022650#TMSN.png( bytes ) 86320449#TMSN.png( bytes ) 86361227#TMSN.png( bytes ) 85893209#TMSN.png( bytes ) UJ NOO.pdf(86771 bytes )
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Signature	/Eric J. Shimanoff/
Name	Eric J. Shimanoff, Esq.
Date	03/11/2019



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

In re Application Serial No. 87725562  
Filed: December 18, 2017  
For Mark: UJ Urban Journalist and Design  
Published in the Official Gazette: November 13, 2018

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ESRT EMPIRE STATE BUILDING, L.L.C., :  
Opposer, : Opposition No.  
v. : **NOTICE OF OPPOSITION**  
SAMWIT B.V., :  
Applicant. :  
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Commissioner for Trademarks  
Attn: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Opposer, ESRT Empire State Building, L.L.C. (“Opposer”), a Delaware limited liability company with offices at 111 West 33rd Street, 12th Floor, New York, NY 10120, believes that it will be damaged by registration of the following UJ URBAN JOURNALIST and Design mark:

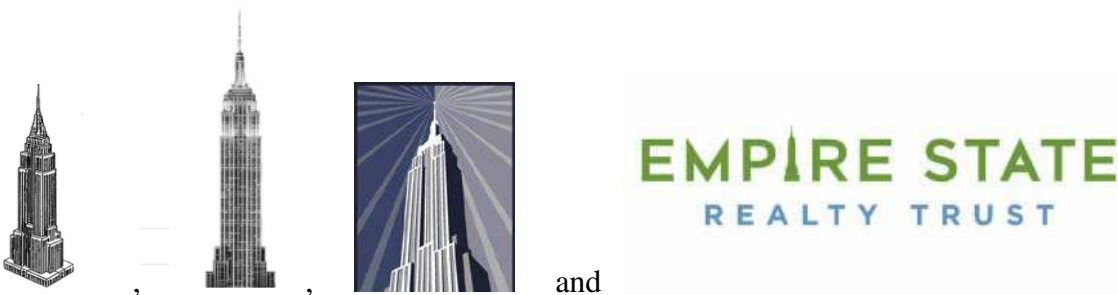


(“Applicant’s Mark”) for “Computer software for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Computer software packages for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Software applications for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; downloadable web applications for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; mobile application for use with travel, which provides travel information, maps and booking services for temporary accommodations, and allows users to store photographs, create travel journals, record travel information and trip details, compare and contrast travel information with other users, share travel tips and post ratings, reviews and recommendations on traveling and locations visited; Magnetic data carriers featuring travel information and maps; recording discs featuring travel information and maps;

Compact discs featuring travel information, and DVDs featuring travel information; computers; Electronic publications, downloadable or on data carriers, namely, leaflets, brochures, information bulletins, magazines and books featuring travel information; Data transmission apparatus” in International Class 9 (“Applicant’s Goods”), as shown in Application Serial No. 87725562 (the “Application”), filed by Samwit B.V. (“Applicant”), a besloten vennootschap (b.v.) organized and existing under the laws of The Netherlands, with an address at Zuidkade 6, 5462 CD Veghel Netherlands, and having been granted an extension of time to oppose up to and including March 13, 2019, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is the owner of the world-famous and iconic Empire State Building, which first opened to the public in 1931. Since long prior to Applicant’s filing date in the Application, or any other claimed priority date, Opposer, its predecessors, and its affiliated and related entities, and/or their licensees, have used the word mark EMPIRE STATE BUILDING and various marks depicting the visual equivalent of the Empire State Building, alone or with other word, letter and/or design elements including, without limitation, in the following distinctive designs:



in connection a wide variety of goods and services, including in International Classes 25, 35, 36, 37, 38, 41, 42, 43 and 45 (collectively, “Opposer’s Empire State Building Marks”).

2. Opposer owns federal registrations for Opposer’s Empire State Building Marks in International Classes 35, 36, 37, 38, 41, 42, 43 and 45, namely, incontestable Registration Nos. 2411972, 2413667, 2429297 and 2430828, and Registration Nos. 5680158, 4797995, 4775666 and 4744135.

3. Opposer’s affiliate and licensee, ESRT Observatory TRS, L.L.C., uses, and owns Registration No. 5188336 for, the following mark



(the “Destination Midtown Mark,” included in the definition of Opposer’s Empire State Building Marks) in connection with “Downloadable Mobile Applications, Namely, Providing A Travel Guide, Maps And Travel Route Planning, And Information Regarding Tourism, Tourist Attractions, Special Events, Hotels, Restaurants And Bars” in International Class 9, “promoting tourism in the New York City Area; business services, namely, organizing an alliance among business owners to promote tourism in the New York City area” in International Class 35, “travel guide and travel information services; travel route planning via a downloadable mobile application” in International Class 39 and “entertainment services, namely, providing information on tourist attractions and providing information on special events for entertainment purposes” in International Class 41. The portion of ESRT Observatory TRS, L.L.C.’s Destination Midtown Mark containing the shape of the top portion of the exterior of a skyscraper with a pointed spindled top is used pursuant to license from, and Registration No. 5188336 exists with the consent of, Opposer. All goodwill from

ESRT Observatory TRS, L.L.C.'s use of that portion of the Destination Midtown Mark inures to the benefit of Opposer.

4. Since long prior to Applicant's filing date in the Application, or any other claimed priority date upon which Applicant may rely, Opposer, its predecessors, and their affiliated and related entities, and/or their licensees, have promoted and advertised the sale and distribution of a wide variety of goods and services bearing or offered in connection with Opposer's Empire State Building Marks, including but not limited to goods and services relating to media, travel and tourism, and have offered such goods and rendered such services in commerce.

5. Opposer has built up highly valuable goodwill in Opposer's Empire State Building Marks, and said goodwill has become closely and uniquely identified and associated with Opposer.

6. On December 18, 2017, Applicant filed an Application for Applicant's Mark for Applicant's Goods, under Sections 44(e) and 1(b) of the Lanham Act, claiming a priority date of June 19, 2017, based on EUTM Application No. 016886608.

7. Upon information and belief, Applicant did not use Applicant's Mark in United States commerce for any of Applicant's Goods covered in the Application prior to its Application filing date or any other claimed priority date on which Applicant may rely.

8. A dominant feature of Applicant's Mark is a visual depiction of a building that is identical or highly similar to the visual equivalent of the Empire State Building.

9. Applicant's Mark and Opposer's Empire State Building Marks are similar in sight and connotation.

10. Applicant's Goods covered by the Application are identical or closely related to the goods offered and services rendered in connection with Opposer's Empire State Building Marks and are the type of goods that consumers would associate with Opposer.

11. Upon information and belief, Applicant intended to create an association with the Empire State Building and Opposer's Empire State Building Marks. Applicant's use of a design meant to look like the Empire State Building, in connection with the word URBAN, which describes the city in which the Empire State Building is located, and for goods related to travel and tourism, apparently is meant evoke an association with Opposer's Empire State Building Marks and the Empire State Building.

12. Applicant's Mark so resembles Opposer's Empire State Building Marks as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's Goods have their origin with Opposer and/or that such goods are approved, endorsed, licensed or sponsored by Opposer or associated in some way with Opposer. Opposer thereby would be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

13. Opposer's Empire State Building Marks are distinctive and famous and were so prior to Applicant's filing date in the Application, or any other claimed priority date, of Applicant's Mark for Applicant's Goods. Registration of Applicant's Mark also will injure Opposer by causing a likelihood of dilution by blurring of the distinctive quality of Opposer's Empire State Building Marks.

14. Upon information and belief, at the time Applicant filed its Application, Applicant lacked a bona fide intent to use Applicant's Mark in connection with all of Applicant's Goods in United States commerce. Upon information and belief, Applicant has not made use of

Applicant's Mark in connection with all of Applicant's Goods in the European Union, the jurisdiction from which Applicant's claimed priority date is based. Applicant's Application therefore should be denied registration under Sections 1(b) and 44(e) of the Lanham Act.

15. Applicant's Mark violates Section 2(a) of the Lanham Act in that it would falsely suggest a connection between Applicant and Opposer. More specifically, Applicant's Mark violates Section 2(a) of the Lanham Act because: (a) Applicant's Mark is the same as, or a close approximation of, the name of or identity previously used by Opposer and/or the Empire State Building; (b) Applicant's Mark would be recognized as such because it points uniquely and unmistakably to Opposer and/or the Empire State Building; (c) Opposer and/or the Empire State Building are not connected with the activities performed by the Applicant under Applicant's Mark; and (d) Opposer's and/or the Empire State Building's name or identity is of sufficient fame or reputation that a connection with Opposer and/or the Empire State Building would be presumed when Applicant's Mark is used in connection with Applicant's Goods.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Eric J. Shimanoff (member of the bar of the State of New York) and the firm Cowan, Liebowitz & Latman, P.C., 114 West 47<sup>th</sup> Street, New York, New York 10036.

Please address all communications to Eric J. Shimanoff, Esq. at the address listed below.

Dated: New York, New York  
March 11, 2019

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

By: /Eric J. Shimanoff/  
Eric J. Shimanoff

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