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Filing date: **07/15/2019**

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

Proceeding	91248617
Party	Defendant Alexandria Real Estate Equities, Inc.
Correspondence Address	JANET L. CULLUM COOLEY LLP 1299 PENNSYLVANNIA AVENUE, NW, STE. 700 WASHINGTON, NY 20004 trademarks@cooley.com no phone number provided
Submission	Answer and Counterclaim
Filer's Name	John Paul Oleksiuk
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Signature	/John Paul Oleksiuk/
Date	07/15/2019
Attachments	2019-07-15 WEARELABS Answer and Counterclaim.pdf(848344 bytes )

Registration Subject to the filing

Registration No.	4818504	Registration date	09/22/2015
Registrant	WEWORK COMPANIES INC. 115 West 18th Street NEW YORK, NY 10011 UNITED STATES Email: ricketts-docket@fzlj.com		

Goods/Services Subject to the filing

<p>Class 035. First Use: 2011/04/01 First Use In Commerce: 2011/04/01 All goods and services in the class are requested, namely: Providing co-working facilities equipped with private offices, office equipment, receptionist, meeting rooms and also featuring a mailroom, printing center, kitchen, telecommunications equipment and other office amenities, all for business purposes; 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 staff services; on-line 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</p>
<p>Class 036. First Use: 2011/04/01 First Use In Commerce: 2011/04/01 All goods and services in the class are requested, namely: Leasing of office space; leasing of real estate; rental of office space</p>
<p>Class 041. First Use: 2011/04/01 First Use In Commerce: 2011/04/01 All goods and services in the class are requested, namely: Educational services, namely, organizing and arranging training, classes, seminars, workshops in the fields of business, technology and social networking</p>

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

In the matter of application Serial No. 88/118,247

WEWORK COMPANIES INC.,	)	
	)	
Opposer,	)	
	)	Opposition No. 91248617
v.	)	
	)	
ALEXANDRIA REAL ESTATE EQUITIES, INC.,	)	
	)	
Respondent.	)	
<hr style="width: 40%; margin-left: 0;"/>		

**ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM**

Applicant Alexandria Real Estate Equities, Inc. (“Applicant”) hereby answers the Notice of Opposition (“Notice”) filed by WeWork Companies Inc. (“Opposer”) against Applicant’s pending trademark application to register the mark WEARELABS (Serial No. 88/118,247) as follows.

Answering the preamble of the Notice, Applicant denies that Opposer will be damaged by the registration of the WEARELABS mark. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in the preamble of the Notice, and on that basis denies the same.

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1, and on that basis denies the same.

2. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 and on that basis denies the same.

3. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3 and on that basis denies the same.

4. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4 and on that basis denies the same.



5. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 5 and on that basis denies the same.

6. Applicant admits that the records of the United States Patent and Trademark Office (“PTO”) identify Opposer as the owner of:

- U.S. Registration No. 4,453,874 for the mark WEWORK in Classes 35, 41, 42, and 45;
- U.S. Registration No. 4,015,942 for the mark WEWORK in Class 36;
- U.S. Registration No. 5,504,982 for the mark WEWORK in Class 42;
- U.S. Registration No. 4,818,504 for the mark WEWORK LABS in Classes 35, 36, and 41.

Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 6 and on that basis denies the same.

7. Applicant admits that the records of the PTO identify Opposer as the owner of:

- Application Serial No. 86/631,398 for the mark WE in Classes 9, 35, 36, and 42;
- Application Serial No. 87/979,850 for the mark  in Classes 9, 35, 36, 41, 42, 43, 44, and 45;
- Application Serial No. 87/643,900 for the mark  in Class 35;
- Application Serial No. 87/597,679 for the mark POWERED BY WE in Classes 9, 20, 35, 36, 37, 41, 42, 43, 44, and 45.

Applicant lacks knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 7 and on that basis denies the same.

8. Applicant's address is 385 E. Colorado Blvd., Suite 299, Pasadena, CA 91101.

9. Admitted.

10. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 10 and on that basis denies the same.

11. Denied.

12. Denied.

13. Denied.

14. Denied.

#### **AFFIRMATIVE DEFENSES**

In asserting the following affirmative defenses, Applicant does not concede that it has the burden of proof as to each separate defense.

1. Opposer fails to state a claim upon which relief can be granted.

2. Opposer's claim is barred by the doctrine of unclean hands.

3. Upon information and belief, one or more of the trademark registrations and applications asserted by Opposer as bases for the Notice are void on the ground that the subject trademark was not in use in commerce in connection with all identified goods and/or services at the time of its filing of (i) the underlying application(s) pursuant to Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), (ii) a verified statement of use under 15 U.S.C. § 1051(d), or (iii) an affidavit of use under 15 U.S.C. § 1058.

Applicant bases its affirmative defenses on the knowledge and information currently available to it, including but not limited to those facts pled in the Counterclaim below, as well as

the contents of the public files for the trademark registrations and applications asserted by Opposer as well as the information published on Applicant's website at wework.com. Applicant reserves its right to assert additional affirmative defenses in the event that further discovery or investigation indicates such defenses are appropriate.

**WHEREFORE**, Applicant requests that the Notice of Opposition be dismissed in its entirety.

**COUNTERCLAIM FOR CANCELLATION OF U.S. REGISTRATION  
NO. 4,818,504 BASED ON FRAUD**

Applicant alleges the following against Registrant in support of its counterclaim for cancellation of U.S. Registration No. 4,818,504 on the grounds of fraud:

1. Applicant Alexandria Real Estate Equities, Inc. is a Maryland corporation, having its principal place of business at 385 E. Colorado Blvd., Suite 299, Pasadena, CA 91101.

2. Upon information and belief, Registrant WeWork Companies Inc. is a Delaware corporation with offices at 115 West 18th Street, New York, NY 10011.

3. Upon information and belief, on or about October 10, 2013, Registrant filed with the PTO an application to register the trademark WEWORK LABS in International Classes 35, 36, 38, 41, 42, 43, and 45. This application was assigned Serial No. 86/088,019.

4. Upon information and belief, on December 23, 2013, the Examining Attorney assigned to review Application Serial No. 86/088,019 for the mark WEWORK LABS issued an office action stating in part:

Applicant must specify whether the term "LABS" has any significance in the applicant's trade or industry or as applied to the goods/services described in the application. *See* 37 C.F.R. §2.61(b); TMEP §§808.01(c), 814.

Failure to respond to this request for information can be grounds for refusing registration. *See In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701 (TTAB 2003); TMEP §814.

5. Upon information and belief, on May 1, 2014, Registrant submitted a Response to Office Action in support of Application Serial No. 86/088,019 for the mark WEWORK LABS stating that “A ‘lab’ refers a place where experiments are performed, and is often used by startup incubators. So the word LABS has significance in connection with class 35, but not for the other classes.” Upon information and belief, the Response to Office Action was signed by Linda M. Goldman, an attorney of record for the Registrant. A copy of this Response to Office Action is attached hereto as Exhibit A. Based on this Response to Office Action, the Examining Attorney issued a further Office Action on July 17, 2014, requiring a disclaimer of “LABS” in Class 35 only. Thereafter, Application Serial No. 86/088,019 matured to Registration No. 4,818,504 in Classes 35, 36, and 41, with “LABS” disclaimed in Class 35 only.

6. The representations that Registrant made to the PTO in its Response to Office Action filed on May 1, 2014 in connection with Application Serial No. 86/088,019 were false. The term “LABS” has significance in connection with Class 35 and also other classes, including Classes 36 and 41.

7. Third parties have disclaimed the term “labs” under analogous circumstances to those of Registrant at least hundreds of times when that term has appeared in marks in Classes 36 and 41.

8. Even Registrant’s own website uses the term “lab” or “labs” in its generic or descriptive sense as shown below, in connection with its services in classes where there was no disclaimer (blue highlights on the term ‘lab’ and ‘labs’ added for clarity):



### On-Demand

Starting at \$45/month 1 day/month included

We Membership is our pay-as-you-go plan. Book a desk for a day or a conference room for an hour at any location.

[Learn More](#)



### WeWork Labs

Pricing Varies

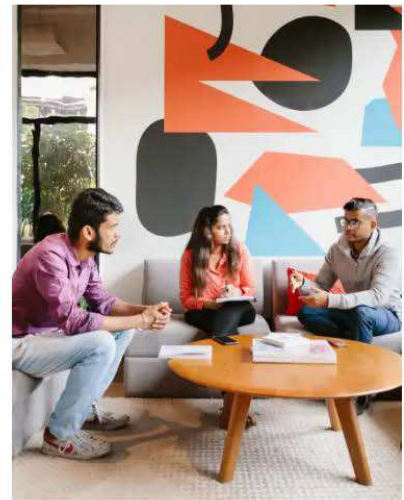
WeWork **labs** helps early-stage startups and entrepreneurs fulfill their destiny by providing the space, global network, and programming they need to thrive.

[Learn More](#)

and:

## Our Startup **Labs**

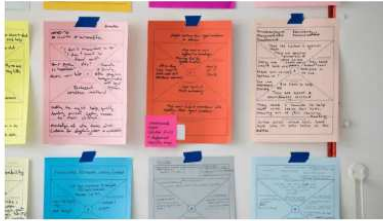
We start with thoughtfully designed spaces that inspire our global community of entrepreneurs to experiment, collaborate and grow. Within these spaces we foster meaningful connections between start-ups and the educational, mentorship and financial resources needed to drive their businesses forward.





### Mentorship

Our global mentor network comprises more than 1,300 professionals. Mentors engage with members one-on-one, in roundtable settings and virtually. Each WeWork Lab also hosts an Entrepreneur in Residence.



### Growth

We create customized educational programming to meet our members' personal and professional development needs. Curriculums are developed and facilitated in partnership with our network of mentors and experts.



### Labs Manager

Each WeWork **lab** is operated by a dedicated Labs Manager. Pulling from their own entrepreneurial experiences and networks, Labs Managers serve as coaches and super-connectors for our members.

9. Upon information and belief, Registrant is a sophisticated trademark owner that has been, at all relevant time periods, fully aware of the significance the representations made to the PTO in connection with Application Serial No. 86/088,019.

10. Upon information and belief, Registrant knew that the representations were false and made those representations with the intent to deceive the PTO and in order to procure broad protection for Registration No. 4,818,504, to which Registrant knew it was not entitled.

11. The PTO relied on those false representations in issuing Registration No. 4,818,504.

12. The PTO would not have issued Registration No. 4,818,504 without a disclaimer in the remaining classes (i.e., Classes 36 and 41) covered by the registration but for Registrant's false representations.

13. Registrant's actions in the procurement of Registration No. 4,818,504 constitute fraud, thereby invalidating Registration No. 4,818,504. Accordingly, Registration No. 4,818,504 should be cancelled in its entirety.



14. As Registrant is relying upon Registration No. 4,818,504 as a basis to oppose Applicant's U.S. trademark application for the mark WEARELABS, Registration No. 4,818,504 is causing damage and injury to Applicant.

**WHEREFORE**, Applicant requests that this Counterclaim for Cancellation be sustained and Registration No. 4,818,504 be cancelled.

Date: July 15, 2019

COOLEY LLP

*/John Paul Oleksiuk/*

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John Paul Oleksiuk  
Susan Piascik Christoff  
Dina Roumiantseva  
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*Counsel for Alexandria Real Estate Equities,  
Inc.*

# EXHIBIT A

## Response to Office Action

**The table below presents the data as entered.**

Input Field	Entered
<b>SERIAL NUMBER</b>	86088019
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 112
<b>MARK SECTION</b>	
<b>MARK</b>	<a href="http://tsdr.uspto.gov/img/86088019/large">http://tsdr.uspto.gov/img/86088019/large</a>
<b>LITERAL ELEMENT</b>	WEWORK LABS
<b>STANDARD CHARACTERS</b>	YES
<b>USPTO-GENERATED IMAGE</b>	YES
<b>MARK STATEMENT</b>	The mark consists of standard characters, without claim to any particular font style, size or color.
<b>GOODS AND/OR SERVICES SECTION (035)(current)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>DESCRIPTION</b>	
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	
<b>FILING BASIS</b>	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (035)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>TRACKED TEXT DESCRIPTION</b>	
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; <del>providing office support services;</del> <a href="#">providing office support staff services</a> ; 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; <del>assistance and advice regarding business location;</del> <a href="#">providing assistance and advice regarding business location, namely, providing business research and analysis of data about specific business locations</a> ; arranging and conducting special events, parties, camps, concerts and travel for business purposes	
<b>FINAL DESCRIPTION</b>	
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 staff 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; providing assistance and advice regarding business location, namely, providing business research and analysis of data about specific business locations; arranging and conducting special events, parties, camps, concerts and travel for business purposes

<b>FILING BASIS</b>	Section 1(b)
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**GOODS AND/OR SERVICES SECTION (036)(no change)**

**GOODS AND/OR SERVICES SECTION (038)(no change)**

**GOODS AND/OR SERVICES SECTION (041)(no change)**

**GOODS AND/OR SERVICES SECTION (042)(current)**

<b>INTERNATIONAL CLASS</b>	042
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**DESCRIPTION**

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 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' user access, 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

<b>FILING BASIS</b>	Section 1(b)
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**GOODS AND/OR SERVICES SECTION (042)(proposed)**

<b>INTERNATIONAL CLASS</b>	042
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**TRACKED TEXT DESCRIPTION**

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 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' user access, order printing services, and sign up and pay for vendor services such as catering, benefits and health insurance;~~ providing a web-based on-line portal for customers to participate in business and social 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' user access, 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, providing an interactive website which allows 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

**FINAL DESCRIPTION**

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; providing a web-based on-line portal for customers to participate in business and social 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' user access, 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, providing an interactive website which allows 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (043)(current)</b>	
INTERNATIONAL CLASS	043
<b>DESCRIPTION</b>	
Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; rental of social function facilities for business and social events	
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (043)(proposed)</b>	
INTERNATIONAL CLASS	043
<b>TRACKED TEXT DESCRIPTION</b>	
Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; <del>rental of social function facilities for business and social events</del> ; <a href="#">rental of social function facilities for business and social events, namely, conferences, seminars, receptions, and parties</a>	
<b>FINAL DESCRIPTION</b>	
Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; rental of social function facilities for business and social events, namely, conferences, seminars, receptions, and parties	
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (045)(current)</b>	
INTERNATIONAL CLASS	045
<b>DESCRIPTION</b>	
Online social networking services; social networking services in the field of business	
FILING BASIS	Section 1(b)
<b>GOODS AND/OR SERVICES SECTION (045)(proposed)</b>	
INTERNATIONAL CLASS	045
<b>TRACKED TEXT DESCRIPTION</b>	
Online social networking services; <del>social networking services in the field of business</del> ; <a href="#">social networking services in the field of business provided via a website and in-person</a>	
<b>FINAL DESCRIPTION</b>	
Online social networking services; social networking services in the field of business provided via a website and in-person	
FILING BASIS	Section 1(b)
<b>ADDITIONAL STATEMENTS SECTION</b>	
MISCELLANEOUS STATEMENT	A 'lab' refers a place where experiments are performed, and is often used by startup incubators. So the word LABS has significance in connection with class 35, but not for the other classes.
<b>SIGNATURE SECTION</b>	
RESPONSE SIGNATURE	/LMG/
SIGNATORY'S NAME	Linda M. Goldman
SIGNATORY'S POSITION	Attorney, California Bar Member
SIGNATORY'S PHONE NUMBER	(650) 988-8500

DATE SIGNED	04/30/2014
AUTHORIZED SIGNATORY	YES
<b>FILING INFORMATION SECTION</b>	
SUBMIT DATE	Thu May 01 19:06:34 EDT 2014
TEAS STAMP	USPTO/ROA-XX.XXX.XXX.XXX- 20140501190634274680-8608 8019-5001967c88537661acf1 593a4d36164abc88075add22f fd6d9a60406362f66f98-N/A- N/A-20140430180902045809

PTO Form 1957 (Rev 9/2005)  
OMB No. 0651-0050 (Exp. 07/31/2017)

## Response to Office Action

### To the Commissioner for Trademarks:

Application serial no. **86088019** WEWORK LABS(Standard Characters, see <http://tsdr.uspto.gov/img/86088019/large>) has been amended as follows:

#### CLASSIFICATION AND LISTING OF GOODS/SERVICES

##### Applicant proposes to amend the following class of goods/services in the application:

**Current:** Class 035 for 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

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

##### Proposed:

**Tracked Text Description:** 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~~; [providing office support staff 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~~; [providing assistance and advice regarding business location, namely, providing business research and analysis of data about specific business locations](#); arranging and conducting special events, parties, camps, concerts and travel for business purposes

Class 035 for 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 staff 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; providing assistance and advice regarding business location, namely, providing business research and analysis of data about specific business locations; arranging and conducting special events, parties, camps, concerts and travel for business purposes

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 042 for 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 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' user access, 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** 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 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' user access, order printing services, and sign up and pay for vendor services such as catering, benefits and health insurance;~~ providing a web-based on-line portal for customers to participate in business and social 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' user access, 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, providing an interactive website which allows 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

Class 042 for 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; providing a web-based on-line portal for customers to participate in business and social 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' user access, 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, providing an interactive website which allows 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 computer software problems; technical support services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 043 for Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; rental of social function facilities for business and social events

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Proposed:**

**Tracked Text Description:** Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; ~~rental of social function facilities for business and social events~~; [rental of social function facilities for business and social events, namely, conferences, seminars, receptions, and parties](#)

Class 043 for Providing day care services; pet day care services; café and restaurant services; cafeteria services; catering services; providing of food and drink; providing conference, exhibition and meeting facilities; providing community centers for social gatherings and meetings; rental of social function facilities for business and social events, namely, conferences, seminars, receptions, and parties

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 045 for Online social networking services; social networking services in the field of business

Original Filing Basis:

**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification



standards of the applicant.

**Proposed:**

**Tracked Text Description:** Online social networking services; ~~social networking services in the field of business~~; [social networking services in the field of business provided via a website and in-person](#)

Class 045 for Online social networking services; social networking services in the field of business provided via a website and in-person  
**Filing Basis: Section 1(b), Intent to Use: For a trademark or service mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to use the mark in commerce on or in connection with the identified goods/services in the application. **For a collective trademark, collective service mark, or collective membership mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by members on or in connection with the identified goods/services/collective membership organization. **For a certification mark application:** As of the application filing date, the applicant had a bona fide intention, and was entitled, to exercise legitimate control over the use of the mark in commerce by authorized users in connection with the identified goods/services, and the applicant will not engage in the production or marketing of the goods/services to which the mark is applied, except to advertise or promote recognition of the certification program or of the goods/services that meet the certification standards of the applicant.

**ADDITIONAL STATEMENTS**

**Miscellaneous Statement**

A 'lab' refers a place where experiments are performed, and is often used by startup incubators. So the word LABS has significance in connection with class 35, but not for the other classes.

**SIGNATURE(S)**

**Response Signature**

Signature: /LMG/ Date: 04/30/2014

Signatory's Name: Linda M. Goldman

Signatory's Position: Attorney, California Bar Member

Signatory's Phone Number: (650) 988-8500

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM** was transmitted via e-mail to Opposer's counsel of record at the following address:

LAURA POPP-ROSENBERG  
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Date: July 15, 2019

*/Dina Roumiantseva/*  
Dina Roumiantseva