

ESTTA Tracking number: **ESTTA1029547**

Filing date: **01/17/2020**

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

| | | | |
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| Name | FRIENDS OF CHAVERIM INC | | |
| Entity | Corporation | Citizenship | New York |
| Address | 2505 Healy Avenue Far Rockaway, NY 11691 UNITED STATES | | |

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| Attorney information | Ben Natter Haug Partners, LLP 745 Fifth Avenue New York, NY 10151 UNITED STATES bnatter@haugpartners.com, docket@haugpartners.com, kkoemm@haugpartners.com no phone number provided |
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Applicant Information

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|--------------------------------|--|---------------------------------|------------|
| Application No | 79177360 | Publication date | 01/14/2020 |
| Opposition Filing Date | 01/17/2020 | Opposition Period Ends | 02/13/2020 |
| International Registration No. | 1276003 | International Registration Date | 07/03/2015 |
| Applicant | Stiftelsen Friends DalvÅrngen 14 SE-169 56 Solna SWEDEN | | |

Goods/Services Affected by Opposition


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| <p>Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Education services, namely, classes, seminars, and workshops in the field of research, education and work to prevent bullying; entertainment and education by means of television and radio regarding research, education, and work to prevent bullying; production, presentation, exhibition and rental of radio and television programmes regarding research, education and work to prevent bullying; production, presentation, distribution, exhibition and rental of motion pictures, films, sound recordings, video recordings, interactive CDs, CD-ROMs and games cartridges for use with electronic games and apparatus regarding research, education, and work to prevent bullying; organisation of exhibitions for cultural, entertainment and educational purposes; organization of sporting events, namely, swimmingmeets, soccer events, football events, tennis events, baseball events, basketball events, ice-hockey events, field hockey events, water polo events, car racingevents, golf events, track and field events, skateboarding events, ice skating events, roller skating events, rollerblading events, pool and billiard events, dart events, weightlifting events, bikingevents, skiing events, snowboarding events, boating events, bowling events, rugby</p> |
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events, snowmobile events, rodeo events, wrestling events, and boxing events;organizing community festivals featuring a variety of activities, namely, sporting events, art exhibitions, flea markets for the purpose of work against bullying; publishing services, namely, research and educational publishing services inthe field of work against bullying; publication of printed matter, books and periodical publications; providing educational information in the academic field of research about bullying for the purpose of academic study and advancement; organisation of exhibitions for cultural oreducational purposes; publication of electronic books or periodicals on-line; education services, namely, providing panel discussions in the field of personal development; publishing services, namely, digital video, audio, and multimedia publishing services; training courses forpersonal development; production of course material, namely, publication of textbooks and workbooks; production of course materials distributed at seminars namely, publication of textbooks and workbooks; publication of newsletters; education services, namely, providing classes, seminars, workshops in the field of therapeutic treatment; arranging of courses in the field of mental training; implementing training procedures in the field of research, education and work against bullying; training services related to the development of children's mental capacity; academies featuring educational services to others about research and work against bullying; publication of texts regarding research, education and work against bullying; education services, namely, mentoring in the field of research, education, and work against bullying; rental of sound recordings; publication ofbooks; education, namely, seminars, workshops and lectures in the field of research, education, and work against bullying; providing of training in the field of research, education and work against bullying; providing information relating to organizing community sporting and cultural activities; teaching and instruction in the field of research, education, and work against bullying for adults andchildren; arranging of courses and lectures in the field of research, education, and work against bullying; arranging of seminars; day camp services for educational purposes; sports and outdoor camps; providing of training in the field of research, education, and work against bullying via the Internet; correspondence courses and distance learning in the field of research, education, and work against bullying; production of educational and instructional materials, namely, reports and booklets in the nature of education and research relating to research, education, and work against bullying

Grounds for Opposition

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| 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) |

Mark Cited by Opposer as Basis for Opposition

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| U.S. Application No. | 88239514 | Application Date | 12/21/2018 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | CAMP CHAVERIM | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 041. First use: First Use: 1997/00/00 First Use In Commerce: 1997/00/00 Providing camps for persons with intellectual and developmental disabilities for | | |

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| | the purposes of ensuring participation in Jewish life |
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| Attachments | 88239514#TMSN.png(bytes) 011720 Notice of Opposition against FRIENDS App. Ser. No. 79177360 (01956909).pdf(179666 bytes) |
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| Signature | //Ben Natter// |
| Name | Ben Natter |
| Date | 01/17/2020 |

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

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|--------------------------|---|----------------|
| Friends of Chaverim Inc, | : | |
| | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No. |
| | : | |
| Stiftelsen Friends, | : | |
| | : | |
| Applicant. | : | |
| | : | |

NOTICE OF OPPOSITION

In the matter of the application of Stiftelsen Friends, a Swedish company (“Applicant”), for registration of the mark FRIENDS in international classes 25, 35, 41, and 44, Application Serial No. 79/177,360, Friends of Chaverim Inc, a New York not-for-profit corporation, at an address of 2505 Healy Avenue, Far Rockaway NY 11691 (“Opposer”), believing it will be damaged by the registration of the mark, hereby opposes the application.

As grounds for opposition, it is alleged that:

1. Opposer has a pending application for the mark CAMP CHAVERIM, Application Serial No. 88/239,514, for conflicting services in international class 41.
2. The English translation of the word “CHAVERIM” is “FRIENDS.”
3. Opposer has used the mark CAMP CHAVERIM in commerce in connection with the services of its application since at least 1997 and has built up considerable goodwill in connection with its mark.

4. Based upon Opposer's prior use of its mark, CAMP CHAVERIM, Opposer's rights in the mark Friends are superior to the rights of the Applicant in connection with the conflicting services in international class 41.

5. Applicant seeks to register the mark FRIENDS, Application Serial No. 79/177,360.

6. Because Applicant's mark contains the English translation of the same word contained in Opposer's mark, and the services of Applicant and Opposer are either identical or related, Applicant's mark is likely, when used on or in connection with the services of Applicant, to cause confusion, mistake, or deception within the meaning of Section 2(d) of the Lanham Act. *See The Board of Regents, The University of Texas System v. Southern Illinois Miners, LLC*, 110 U.S.P.Q.2d (BNA) 1182, 1189 (T.T.A.B. 2014) (finding a likelihood of confusion between the MINERS mark and applicant's standard character MINERS mark and composite mark SOUTHERN ILLINOIS MINERS and miner design, and noting that "[l]ikelihood of confusion is often found where the entirety of one mark is incorporated within another").

7. Based upon Internet research conducted by Opposer through various Internet search engines, Applicant does not have a bona fide intention to use its mark in commerce in connection with all of the listed services in international class 41 contained in the subject application.

8. Fraudulent statements were submitted to the USPTO by Applicant in connection with the prosecution or the subject application, specifically in connection with the Applicant's intention to use the mark in commerce in connection with all listed services in international class 41, with the intent to deceive the USPTO into issuing a registration for the mark.

9. Applicant's pending application for the mark FRIENDS, Application Serial No. 79/177,360, has been cited as a possible basis for refusal of Opposer's application for CAMP CHAVERIM, Application Serial No. 88/239,514.

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

Dated: New York, NY

January 17, 2020

Respectfully submitted,
HAUG PARTNERS LLP

By: /Ben Natter/

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Attorneys for Opposer