

ESTTA Tracking number: **ESTTA1066606**

Filing date: **07/07/2020**

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

Name	Cicero Group, LP
Granted to Date of previous extension	07/08/2020
Address	35 N. RIO GRANDE STREET SALT LAKE CITY, UT 84101 UNITED STATES

Correspondence information	AMY TINDELL HOLLAND & HART, LLP P.O. BOX 8749 ATTN: TRADEMARK DOCKETING DENVER, CO 80201 UNITED STATES Primary Email: docket@hollandhart.com Secondary Email(s): mhorlacher@hollandhart.com, klander-son@hollandhart.com, atidwell@hollandhart.com, ajtindell@hollandhart.com, hihamilton@hollandhart.com 3034732735
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Applicant Information

Application No.	88590977	Publication date	03/10/2020
Opposition Filing Date	07/07/2020	Opposition Period Ends	07/08/2020
Applicant	Joseph Lonsdale 210 OLIVE TREE LANE WOODSIDE, CA 94062 UNITED STATES		

Goods/Services Affected by Opposition


Class 035. First Use: 2016/06/14 First Use In Commerce: 2016/06/14
All goods and services in the class are opposed, namely: Promoting public awareness of social challenges in the fields of healthcare, education, regulation, transportation, housing, and prisons by means of public advocacy; public policy research services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4473334	Application Date	04/04/2012
Registration Date	01/28/2014	Foreign Priority Date	NONE
Word Mark	CICERO GROUP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 Consulting services, namely, providing market research, business data analytics, economic analysis and business strategy consulting		

U.S. Application No.	88931344	Application Date	05/24/2020
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CICERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/10/15 First Use In Commerce: 2007/10/15 Consulting services, namely, providing market research, business data analytics, economic analysis and business strategy consulting; business management consulting and advisory services; public policy consultancy services; government management consulting and advisory services; social sector management consulting and advisory services; consulting services in the field of government organizationalmanagement; consulting services in the field of social sector organizational management		

Attachments	85589525#TMSN.png(bytes) 88931344#TMSN.png(bytes) NOO CICERO w exhibits.pdf(273273 bytes)
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Signature	/Amy Tindell/
Name	Amy Tindell
Date	07/07/2020

1. Opposer is a leader in providing research and consulting services that focus on implementing data-driven strategies for a broad mix of private, public, and social sector organizations across the globe.

2. Since at least as early as 2007, Opposer has used the marks CICERO and CICERO GROUP (collectively, “Opposer’s Mark”) in connection with providing in-house data gathering resources and experience to generate insights, create actionable strategies, and drive transformation with an overarching purpose of helping people create and build lasting capabilities.

3. Opposer works with clients across a variety of sectors across the United States, including education, healthcare, government, retail, entertainment, telecommunication, technology, finance, manufacturing, and industrials.

4. Opposer has invested significant resources into its business and has amassed significant consumer goodwill and brand recognition in its CICERO brand in the United States. As a result of these investments, *Vault.com* ranked Opposer among the “Top 50 Consulting Firms” in 2018, 2019, and 2020. Opposer was also recognized as one of the fastest growing consulting firms in North America according to *Consulting Magazine*’s annual “Fastest Growing Firms” in 2018 and 2019.

5. Opposer owns incontestable Registration No. 4473334 for CICERO GROUP (GROUP disclaimed) for “Consulting services, namely, providing market research, business data analytics, economic analysis and business strategy consulting” in Class 35 (the “Registration”) and U.S. App. Ser. No. 88931344 for CICERO for “Consulting services, namely, providing market research, business data analytics, economic analysis and business strategy consulting; business management consulting and advisory services; public policy consultancy services; government management consulting and advisory services; social sector management consulting and advisory

services; consulting services in the field of government organizational management; consulting services in the field of social sector organizational management” in Class 35. True and correct copies from the USPTO’s TSDR database showing the current status and title of the Registration and App. Ser No. 88931344 are attached as Exhibits 1 and 2.

6. Together with Opposer’s common law rights, the services listed in Opposer’s Registration and App. Ser. No. 88931344 above are hereinafter referred to as “Opposer’s Services.”

7. Applicant’s Application for CICERO INSTITUTE was filed on August 23, 2019 and asserts a first use in commerce date of June 14, 2016.

8. Opposer enjoys priority as a result of its incontestable Registration and common law use of Opposer’s Mark that well precedes Applicant’s asserted first use in commerce date and any priority date upon which Applicant may rely.

9. Applicant’s Mark wholly incorporates Opposer’s Mark. The addition of the descriptive term INSTITUTE, which Applicant has disclaimed, does not distinguish Applicant’s Mark from Opposer’s Mark. Applicant’s Mark is confusingly similar to Opposer’s Mark.

10. Applicant’s Services are similar to, and/or overlap with and/or are related to Opposer’s Services.

11. Applicant’s Services and Opposer’s Services target identical or overlapping groups of purchasers.

12. Registration of Applicant’s Application in connection with Applicant’s Services damages Opposer and its prior, superior rights in Opposer’s Mark, including because consumers are likely to conclude, erroneously, that Opposer and Applicant, their marks, or their services, are related.

13. The registration of Applicant's Application could cause additional harm to Opposer's exclusive right to use and register Opposer's Mark for the same and related services.

COUNT I
Likelihood of Confusion
(15 U.S.C. § 1052(d))

14. Opposer realleges and incorporates by reference the preceding allegations of this Notice of Opposition.

15. Opposer has priority by virtue of its prior use of Opposer's Mark, as well as its prior filed and incontestable Registration.

16. Applicant's Mark so closely resembles Opposer's Mark as to be likely, when used in connection with Applicant's Services, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

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

The filing fee in the amount of \$400 should be charged to Deposit Account No. 082623.

July 7, 2020

Respectfully submitted,

/Amy Tindell/

Amy Tindell

H. Matthew Horlacher

Hope Hamilton

HOLLAND & HART LLP

P.O. Box 8749

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***Attorneys for Opposer
Cicero Group, LP***

STATEMENT REGARDING SERVICE

Consistent with the Trademark Trial and Appeal Board Manual of Procedure Rule 309.02(c)(1) (amended January 14, 2017), service of the above Notice of Opposition will be effected by the Board. To facilitate the Board, the following physical address and email address is available for the Applicant via TSDR:

Joseph Lonsdale
210 Olive Tree Lane
Woodside, California 94062

Julia Spoor Gard
Barnes & Thornburg LLP
11 South Meridian Street
Indianapolis, Indiana 46204-3535

/s/ Amy Tindell
Amy Tindell

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Exhibit 1

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Mark: CICERO GROUP

Cicero Group

US Serial Number: 85589525

Application Filing Date: Apr. 04, 2012

US Registration Number: 4473334

Registration Date: Jan. 28, 2014

Register: Principal

Mark Type: Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: A Sections 8 and 15 combined declaration has been accepted and acknowledged.

Status Date: Mar. 23, 2020

Publication Date: Nov. 12, 2013

Mark Information

Mark Literal Elements: CICERO GROUP

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Disclaimer: "GROUP"

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (..) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Consulting services, namely, providing market research, business data analytics, economic analysis and business strategy consulting

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 1(a)

First Use: Oct. 15, 2007

Use in Commerce: Oct. 15, 2007

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Cicero Group, LP

Composed of: Summit Group Advisor, Inc., a Utah corporation
Owner Address: 35 North Rio Grande Street
Salt Lake City, UTAH UNITED STATES 84102
Legal Entity Type: LIMITED PARTNERSHIP

State or Country UTAH
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: H. Matthew Horlacher
Attorney Primary Email Address: docket@hollandhart.com
Docket Number: 76901.0033
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: H. Matthew Horlacher
Holland & Hart LLP
P.O. Box 11583
Salt Lake City, UTAH UNITED STATES 84110
Phone: 8017995825
Correspondent e-mail: docket@hollandhart.com mhorlacher@hollandhart.com klanderson@hollandhart.com atidwell@hollandhart.com
Correspondent e-mail Authorized: Yes

Domestic Representative

Domestic Representative Name: H. Matthew Horlacher
Domestic Representative e-mail: docket@hollandhart.com
Phone: 8017995825
Domestic Representative e-mail Authorized: Yes

Prosecution History

Date	Description	Proceeding Number
Mar. 23, 2020	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 23, 2020	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77074
Mar. 23, 2020	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77074
Jan. 27, 2020	TEAS SECTION 8 & 15 RECEIVED	
Jan. 22, 2020	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Jan. 22, 2020	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
Jan. 28, 2019	COURTESY REMINDER - SEC. 8 (6-YR) E-MAILED	
Jan. 28, 2014	REGISTERED-PRINCIPAL REGISTER	
Nov. 12, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 12, 2013	PUBLISHED FOR OPPOSITION	
Oct. 23, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 04, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	77976
Oct. 01, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 01, 2013	LIE CHECKED SUSP - TO ATTY FOR ACTION	77976
Oct. 01, 2013	ASSIGNED TO LIE	77976
Mar. 30, 2013	NOTIFICATION OF LETTER OF SUSPENSION E-MAILED	6332
Mar. 30, 2013	LETTER OF SUSPENSION E-MAILED	6332
Mar. 30, 2013	SUSPENSION LETTER WRITTEN	81878
Mar. 28, 2013	NOTICE OF REVIVAL - E-MAILED	
Mar. 28, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 27, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 27, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 27, 2013	PETITION TO REVIVE-GRANTED	88889
Mar. 27, 2013	TEAS PETITION TO REVIVE RECEIVED	
Feb. 12, 2013	ABANDONMENT NOTICE MAILED - FAILURE TO RESPOND	
Feb. 12, 2013	ABANDONMENT - FAILURE TO RESPOND OR LATE RESPONSE	

Jul. 17, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jul. 17, 2012	NON-FINAL ACTION E-MAILED	6325
Jul. 17, 2012	NON-FINAL ACTION WRITTEN	81878
Jul. 17, 2012	ASSIGNED TO EXAMINER	81878
Apr. 13, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 07, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 102

Date in Location: Mar. 23, 2020

Proceedings

Summary

Number of Proceedings: 1

Type of Proceeding: Opposition

Proceeding Number: [91210047](#)

Filing Date: Mar 27, 2013

Status: Terminated

Status Date: May 29, 2013

Interlocutory Attorney: BENJAMIN U OKEKE

Defendant

Name: BMA Brandstätter Rechtsanwälte GmbH

Correspondent Address: TARA HART-NOVA
PHILLIPS LYTLE LLP
INTELLECTUAL PROPERTY GROUP , 3400 HSBC CENTER
BUFFALO NY UNITED STATES , 14203

Correspondent e-mail: thartnova@phillipslytle.com , spiatkowski@phillipslytle.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CICERO	CANCELLED - SECTION 7	79102835	4362701

Plaintiff(s)

Name: Cicero Group, LP

Correspondent Address: TIMOTHY B SMITH
PARR BROWN GEE & LOVELESS PC
185 S STATE STREET, SUITE 1300
SALT LAKE CITY UT UNITED STATES , 84111

Correspondent e-mail: tsmith@parrbrown.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
CICERO GROUP	Section 8 and 15 - Accepted and Acknowledged	85589525	4473334

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 27, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 03, 2013	May 13, 2013
3	PENDING, INSTITUTED	Apr 03, 2013	
4	MOT TO AMEND APPLICATION	May 01, 2013	
5	BD DECISION: SUSTAINED	May 29, 2013	
6	TERMINATED	May 29, 2013	

Exhibit 2

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Mark: CICERO

CICERO

US Serial Number: 88931344

Application Filing Date: May 24, 2020

Register: Principal

Mark Type: Service Mark

TM5 Common Status
Descriptor:



LIVE/APPLICATION/Awaiting Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and has not yet been assigned to an examiner.

Status: New application will be assigned to an examining attorney approximately 3 months after filing date.

Status Date: Jun. 11, 2020

Mark Information

Mark Literal Elements: CICERO

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

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Currently ITU: No

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Currently 44E: No

Filed 44E: No

Currently 66A: No

Filed 66A: No

Currently No Basis: No

Filed No Basis: No

Current Owner(s) Information

Owner Name: Cicero Group, LP

Composed of: Summit Group Advisor, Inc., a Utah corporation

Owner Address: 35 North Rio Grande Street
Salt Lake City, UTAH UNITED STATES 84101

Legal Entity Type: LIMITED PARTNERSHIP

State or Country UTAH
Where Organized:

Attorney/Correspondence Information

Attorney of Record

Attorney Name: H. Matthew Horlacher

Docket Number: 76901.0039

Attorney Primary Email Address: docket@hollandhart.com

Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: H. MATTHEW HORLACHER
HOLLAND & HART LLP
P.O. BOX 11583
SALT LAKE CITY, UTAH UNITED STATES 84110

Phone: 801-799-5825

Correspondent e-mail: docket@hollandhart.com mhorlacher@hollandhart.com klanderson@hollandhart.com ATidwell@hollandhart.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jun. 11, 2020	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 27, 2020	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: NEW APPLICATION PROCESSING

Date in Location: Jun. 11, 2020