

ESTTA Tracking number: **ESTTA1123974**

Filing date: **03/31/2021**

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	Mercado Eletr�nico, S.A.
Granted to Date of previous extension	03/31/2021
Address	AVENIDA CECI, N� 1.850 - SALA 1 BARUERI, 06460-120 BRAZIL

Attorney information	ROY D. GROSS THE ROY GROSS LAW FIRM, LLC 50 WASHINGTON STREET, SUITE 737/745 NORWALK, CT 06854 UNITED STATES Primary Email: roy@rgrosslaw.com Secondary Email(s): paralegal@rgrosslaw.com 2034230235
Docket Number	07215-N0001A

**Applicant Information**

Application No.	88780729	Publication date	12/01/2020
Opposition Filing Date	03/31/2021	Opposition Period Ends	03/31/2021
Applicant	Global Trade Specialists, Inc. 3102 OAK LAWN AVE. DALLAS, TX 75219 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 042. First Use: 2018/01/31 First Use In Commerce: 2018/01/31 All goods and services in the class are opposed, namely: Providing temporary use of non-downloadable cloud-based software for managing imports
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration	4989193	Application Date	07/17/2014
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No.			
Registration Date	06/28/2016	Foreign Priority Date	NONE
Word Mark	M E MERCADO ELETRÃ#NICO		
Design Mark			
Description of Mark	The mark consists of upper case letter "M" in shades of blue and white with the letter "e" in lower case superimposed in white with the words "MERCADO eletrÃ nico" in special letters in gray.		
Goods/Services	<p>Class 035. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/01  Business management assistance; cost price analysis; commercial or industrial management assistance; systematization of information into computer databases; business information; compilation of statistics</p> <p>Class 042. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/01  Computer system design; research and development of new products for others; maintenance of computer software; design, creation, hosting, maintenance of websites for others</p>		

U.S. Registration No.	5511007	Application Date	05/11/2017
Registration Date	07/10/2018	Foreign Priority Date	03/02/2017
Word Mark	MERCADO E		
Design Mark			
Description of Mark	The mark consists of a blue stylized "M" with a white "E" located on the top right corner within the "M". The wording "MERCADOE" is below in black letters. The color white in the mark is for background/shading/transparent purposes and is not claimed as a feature in the mark.		
Goods/Services	<p>Class 035. First use: First Use: 2017/04/03 First Use In Commerce: 2017/04/03  Outsourcing services in the nature of arranging procurement of goods for others; Outsourcing services in the nature of arranging service contracts for others; Purchasing and procurement services, namely, procuring of contracts for others for the purchase of goods and labor contracting services; Providing business intelligence services; Business management consulting; Market research consultation; Business management consultancy, also via the Internet; Negotiation of business contracts for others; Negotiation and conclusion of commercial transactions for third parties; Business advisory services, namely, search for and selection of the best potential suppliers for others; Mediation of contracts for purchase and sale of products; Administrative processing of purchase orders; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Provision of information concerning commercial sales; Consulting in the field of sales methods, sales management, and sales improvement; Information about sales methods; Supply chain management services; Business assistance, management and information services; Invoicing; Auction services; Inventory management, namely, of parts and components for manufacturers and suppliers; Compilation of information into computer databases; Inventory control; Updating and maintenance of data in computer databases; Providing business information, namely, commercial corporate and statistical information provided on-line from a computer database or the Internet; Goods or services price quotations; Procuring of contracts for the purchase and sale of goods and services</p> <p>Class 042. First use: First Use: 2017/04/03 First Use In Commerce: 2017/04/03  Software as a service (SAAS) services featuring software for use in procurement of contracts; Software as a service (SAAS) services featuring software for computing and for use in making contracts; Design and development of com-</p>		

	puter software in the field of logistics, supply chain management and e-business portals; Computer software development in the field of logistics, supply chain management and e-business portals; Platform as a service (PAAS) featuring computer software platforms for use in procurement of contracts; Platform as a service (PAAS) featuring computer software platforms for computing and for use in making contracts; Computer software design; Design, maintenance, development and updating of computer software; Design, updating and rental of computer software; Design and development of software for database management; Maintenance of computer software; Computer software development; Computer software rental; Design and development of operating software for accessing and using a cloud computing network
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U.S. Registration No.	6011314	Application Date	03/06/2019
Registration Date	03/17/2020	Foreign Priority Date	NONE
Word Mark	ME MERCADO ELETRÔNICO		
Design Mark			
Description of Mark	The mark consists of a stylized "M" with a "e" located on the top right corner within the "M". The wording "Mercado Eletrônico" is shown to the right of the stylized "M".		
Goods/Services	<p>Class 035. First use: First Use: 2017/06/03 First Use In Commerce: 2017/06/03 Outsourcing services in the nature of arranging procurement of goods for others; Outsourcing services in the nature of arranging service contracts for others; Purchasing and procurement services, namely, procuring of contracts for others for the purchase of goods and labor contracting services; Providing business intelligence services; Business management consulting; Market research consultation; Business management consultancy, also via the Internet; Negotiation of business contracts for others; Negotiation and conclusion of commercial transactions for third parties; Business advisory services, namely, search for and selection of the best potential suppliers for others; Mediation of contracts for purchase and sale of products; Administrative processing of purchase orders; Electronic commerce services, namely, providing information about products via telecommunication networks for advertising and sales purposes; Provision of information concerning commercial sales; Consulting in the field of sales methods, sales management, and sales improvement; Information about sales methods; Supply chain management services; Business assistance, management and information services; Invoicing; Auction services; Inventory management, namely, of parts and components for manufacturers and suppliers; Compilation of information into computer databases; Inventory control; Updating and maintenance of data in computer databases; Providing business information, namely, commercial corporate and statistical information provided on-line from a computer database or the Internet; Goods or services price quotations; Procuring of contracts for the purchase and sale of goods and services</p> <p>Class 042. First use: First Use: 2017/06/03 First Use In Commerce: 2017/06/03 Software as a service (SAAS) services featuring software for use in procurement of contracts; Software as a service (SAAS) services featuring software for computing and for use in making contracts; Design and development of computer software in the field of logistics, supply chain management and e-business portals; Computer software development in the field of logistics, supply chain management and e-business portals; Platform as a service (PAAS) featuring computer software platforms for use in procurement of contracts; Platform as a service (PAAS) featuring computer software platforms for computing and for use in making contracts; Computer software design; Design, maintenance, development and updating of computer software; Design, updating and rental of computer software; Design and development of software for database management; Maintenance of computer software; Computer software development; Computer</p>		

	software rental; Design and development of operating software for accessing and using a cloud computing network
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Attachments	07215-N0001A-Opposition-88780729.pdf(91941 bytes )
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Signature	/Roy D. Gross/
Name	ROY D. GROSS
Date	03/31/2021

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

Mercado Eletrônico, S.A.,	)	
	)	
Opposer,	)	Opposition No.
	)	US Trademark No. 88/780,729
v.	)	
	)	
Global Trade Specialists, Inc.,	)	
Applicant.	)	

**NOTICE OF OPPOSITION TO APPLICATION NO. 88/780,729**

Opposer, Mercado Eletrônico, S.A. (hereinafter “Mercado Eletrônico” or “Opposer”), by and through its attorneys, hereby opposes U.S. Trademark Application No. 88/780,729 (the “Application”) for the trademark MERCADO for “Providing temporary use of non-downloadable cloud-based software for managing imports” in Class 42 which was filed under Section 1(a) of the Trademark Act on January 31, 2020 by Global Trade Specialists, Inc. (the “Applicant”) whose address is 3102 Oak Lawn Avenue, Dallas, TEXAS UNITED STATES 75219.

Mercado Eletrônico is a corporation under the laws of Brazil having an address of Avenida Ceci, nº1850, Sala 1, Barueri, Sao Paulo 06460-120 BRAZIL, believes it would be

damaged by the registration of the trademark in 88/780,729 and therefore opposes the same.

The grounds for this opposition proceeding are as follows:

1. Opposer owns U.S. Trademark No. 4,989,193 for M E MERCADO ELETRÔNICO for “Computer system design; research and development of new products for others; maintenance of computer software; design, creation, hosting, maintenance of websites for others” in class 042 (as well as services in class 035), which registered on June 28, 2016.

2. Opposer owns U.S. Trademark No. 5,511,007 for MERCADO E for “Software as a service (SAAS) services featuring software for use in procurement of contracts; Software as a service (SAAS) services featuring software for computing and for use in making contracts; Design and development of computer software in the field of logistics, supply chain management and e-business portals; Computer software development in the field of logistics, supply chain management and e-business portals; Platform as a service (PAAS) featuring computer software platforms for use in procurement of contracts; Platform as a service (PAAS) featuring computer software platforms for computing and for use in making contracts; Computer software design; Design, maintenance, development and updating of computer software; Design, updating and rental of computer software; Design and development of software for database management; Maintenance of computer software; Computer software development; Computer software rental; Design and development of operating software for accessing and using a cloud computing network” in class 042 (as well as services in class 035), which registered on July 10, 2018.

3. Opposer owns U.S. Trademark No. 6,011,314 for ME MERCADO ELETRÔNICO for “Software as a service (SAAS) services featuring software for use in procurement of contracts; Software as a service (SAAS) services featuring software for computing and for use in making contracts; Design and development of computer software in the field of logistics, supply chain management and e-business portals; Computer software development in the field of logistics, supply chain management and e-business portals; Platform as a service (PAAS) featuring computer software platforms for use in procurement of contracts; Platform as a service (PAAS) featuring computer software platforms for computing and for use in making contracts; Computer software design; Design, maintenance, development and updating of computer software; Design, updating and rental of computer software; Design and development of software for database management; Maintenance of computer software; Computer software development; Computer software rental; Design and development of operating software for accessing and using a cloud computing network” in class 042 (as well as services in class 035), which registered on March 17, 2020.

4. Applicant filed the Application (US 88/780,729) for MERCADO on January 31, 2020 under 1(a) of the Trademark Act and asserts a date of first use in commerce of January 31, 2018.

5. Applicant’s first use and use in commerce is subsequent to the use of Opposer’s Trademark Nos. 4,989,193; 5,511,007; and 6,011,314.

6. Substantial confusion would result if Applicant’s mark would be allowed to

proceed to registration, as Applicant's mark MERCADO copies the MERCADO in Registrant's Trademarks.

7. Furthermore, upon information and belief, Applicant has not used the mark in commerce and has submitted its application in bad faith.

**WHEREFORE**, Opposer believes that it is being and will continue to be damaged by registration of the Application (US 88/780,729) for MERCADO, and prays that the Application be rejected with the provisions of the Trademark Act, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Respectfully Submitted,

/Roy D. Gross/

Date: March 31, 2021

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*Attorney for Opposer Mercado Eletrônico, S.A.*