

ESTTA Tracking number: **ESTTA1265052**

Filing date: **02/09/2023**

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	Kudos, Inc.		
Entity	Corporation	Citizenship	Canada
Address	500 4TH AVENUE SW, SUITE 2500 CALGARY, T2P 2V6 CANADA		
Attorney information	BENJAMIN ASHUROV KB ASH 2603 CAMINO RAMON, SUITE 200 SAN RAMON, CA 94583 UNITED STATES Primary email: bashurov@kb-ash.com 877.265.1476		
Docket no.	KUDOS01125		

**Applicant information**

Application no.	97262295	Publication date	01/10/2023
Opposition filing date	02/09/2023	Opposition period ends	02/09/2023
Applicant	Kudos Business Services, LLC 2000 DUKE STREET, SUITE 300 ALEXANDRIA, VA 22314 UNITED STATES		

**Goods/services affected by opposition**

Class 035. First Use: Jul 1, 2014 First Use In Commerce: Jul 1, 2014 All goods and services in the class are opposed, namely: Business management consultation in the field of executive and leadership development; Talent management services for businesses, nonprofit organizations, government agencies, business professionals, executives, and managers
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**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. application no.	97426254	Application date	05/24/2022
Registration date	NONE	Foreign priority date	NONE
Word mark	KUDOS		

Design mark	
Description of mark	NONE
Goods/services	Class 035. First use: First Use: Apr 20, 2011 First Use In Commerce: Apr 20, 2011 Business consulting services; Consulting services in the fields of business management and human resources; Consulting services in the field of employee engagement; Consulting services in the field of employee recognition; Consulting services in the field of business analytics; Consulting services in the field of organizational change management

U.S. registration no.	5870821	Application date	11/10/2017
Register	Principal		
Registration date	10/01/2019	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: Apr 20, 2011 First Use In Commerce: Apr 20, 2011 Software as a service (SAAS) services featuring software for use in group collaboration in connection with an online social network; Software as a service (SAAS) services featuring software for use in uploading and sharing of digital files, user directories, photographs, images, videos, messages, emojis, and stickers in connection with an online social network; Software as a service (SAAS) services featuring software for use in in preparing and publishing digital content in the form of user profiles, blogs, image galleries, newsletters, public announcements, and invitations in connection with an online social network; Software as a service (SAAS) services featuring software for use in preparing and publishing digital leader boards in connection with an online social network; Software as a service (SAAS) services featuring software for use ingenerating, tracking, and reporting information, analytics and statistics relating to employee performance, activity and engagement		


U.S. registration no.	5870820	Application date	11/10/2017
Register	Principal		
Registration date	10/01/2019	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			

Description of mark	NONE
Goods/services	Class 009. First use: First Use: Aug 5, 2014 First Use In Commerce: Aug 5, 2014 Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in group collaboration in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in uploading and sharing of digital files, user directories, photographs, images, videos, messages, emojis, and stickers in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in preparing and publishing digital content in the form of user profiles, blogs, image galleries, newsletters, public announcements, and invitations in connection with an online network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in preparing and publishing digital leader boards in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in generating, tracking, and reporting information, analytics and statistics relating to employee performance, activity and engagement

U.S. registration no.	4725411	Application date	07/01/2014
Register	Principal		
Registration date	04/21/2015	Foreign priority date	NONE
Word mark	KUDOS REWARDS		
Design mark			
Description of mark	NONE		
Goods/services	Class 036. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013 Financial transaction services, namely, providing secure commercial transactions and payment options; financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale; providing an internet website portal in the field of financial transaction and payment processing services		

U.S. registration no.	4725423	Application date	07/03/2014
Register	Principal		
Registration date	04/21/2015	Foreign priority date	NONE
Word mark	KUDOS REWARDS		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013 Providing computer software application for use on mobile phones and mobile computing devices featuring technology that enables internet users to submit comments of personal recognition and review		

	Class 042. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013 Providing a web site featuring technology that enables internet users to submit comments of personal recognition and review		
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U.S. registration no.	4725409	Application date	07/01/2014
Register	Principal		
Registration date	04/21/2015	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	Class 036. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013 Financial transaction services, namely, providing secure commercial transactions and payment options; financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale; providing an internet website portal in the field of financial transaction and payment processing services		

U.S. registration no.	4725421	Application date	07/03/2014
Register	Principal		
Registration date	04/21/2015	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	Class 009. First use: First Use: Aug 5, 2014 First Use In Commerce: Aug 5, 2014 Providing computer software application for use on mobile phones and mobile computing devices featuring technology that enables internet users to submit comments of personal recognition and review Class 042. First use: First Use: Jan 1, 2007 First Use In Commerce: Jan 1, 2007 Providing a web site featuring technology that enables internet users to submit comments of personal recognition and review		

U.S. registration no.	4641604	Application date	05/01/2012
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Register	Principal		
Registration date	11/18/2014	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Aug 5, 2014 First Use In Commerce: Aug 5, 2014</p> <p>Computer application software for mobile phones, portable media players, hand-held computers, namely, software for use in the provision of recognition, feedback, and review of of employee, enterprise, product, and business performances</p>		

U.S. registration no.	4534578	Application date	02/28/2013
Register	Principal		
Registration date	05/20/2014	Foreign priority date	NONE
Word mark	KUDOS REWARDS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 035. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013</p> <p>Arranging and conducting incentive reward programs to promote the sale and use of software services in the field of performance review and recognition</p> <p>Class 042. First use: First Use: Jun 21, 2013 First Use In Commerce: Jun 21, 2013</p> <p>Providing a web site featuring technology that enables companies and organizations to administer and manage employee incentive award programs and to promote employee productivity, performance, recognition and morale</p>		

U.S. registration no.	4284697	Application date	08/22/2011
Register	Principal		
Registration date	02/05/2013	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		

Goods/services	Class 035. First use: First Use: Jan 1, 2007 First Use In Commerce: Jan 1, 2007 Providing a web site where users can post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers		
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U.S. registration no.	4224053	Application date	04/20/2011
Register	Principal		
Registration date	10/16/2012	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	Class 042. First use: First Use: Jan 1, 2007 First Use In Commerce: Jan 1, 2007 Software as a Service (SaaS) services featuring peer-to-peer software in the field of an employee recognition and reward system that incorporates the allocation and collection of points that are associated to micro messages that recognize individuals for achievements, efforts and attitudes as well as demonstrated skills that are in alignment with corporate goals and objectives to enhance communication, collaboration and employee engagement to drive corporate performance		

U.S. registration no.	4190212	Application date	12/23/2011
Register	Principal		
Registration date	08/14/2012	Foreign priority date	NONE
Word mark	KUDOS		
Design mark			
Description of mark	NONE		
Goods/services	Class 045. First use: First Use: Jan 1, 2007 First Use In Commerce: Jan 1, 2007 Internet-based social networking services		

Attachments	87680157#TMSN.png( bytes ) 86325473#TMSN.png( bytes ) 85404202#TMSN.png( bytes ) 20230209 FILING COPY Notice of Opposition - KUDOS STRATEGIES.pdf(244231 bytes )
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Signature	/BA/
Name	Benjamin Ashurov
Date	02/09/2023

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

*In the matter of U.S. Application Serial No. 97262295*

*Mark: KUDOS STRATEGIES*

*Class: 35*

**KUDOS INC,**

Opposer,

v.

**KUDOS BUSINESS SERVICES LLC**

Applicant.

TTAB Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a), Opposer Kudos, Inc. (“*Kudos*” or “*Opposer*”) believes it will be damaged by the registration of U.S. Trademark Application Sr. No. 97/262,295, and therefore it submits this Notice of Opposition opposing the registration of the ‘295 Application. As the basis for its Notice of Opposition, Kudos alleges as follows:

**FACTUAL BACKGROUND**

**Opposer’s Use and Registration of KUDOS as a Trademark**

1. Opposer Kudos, Inc. is a Canadian corporation with a principal business address located at 500 4th Avenue SW, Suite 2500 Calgary, Alberta T2P 2V6.
2. Kudos has operated its business in United States commerce since at least as early as the year 2010. Since the time of its founding, Kudos has continuously used the trademark and service mark KUDOS, and related KUDOS-formative marks, in connection with workplace-related information technology and consulting relating to human resource management, employee culture, and employee engagement.
3. For example, in connection with the KUDOS mark, Kudos offers an intracompany

social networking solution which organizations can deploy on an organization-wide basis in order to facilitate and improve communication, interaction, and collaboration in the workplace.

4. Kudos also offers in connection with the KUDOS mark an employee recognition and rewards solution which can be incorporated into the Kudos social network and which may be used by Kudos customers to recognize and reward colleagues their workplace.

5. Kudos also offers in connection with the KUDOS mark analytics-based information and consultancy services providing its clients with data-driven insights relating to the client's organization, its workforce, and its culture.

6. Using these and other similar methods, Kudos regularly provides its clients with information technology, and business and management consultancy services relating to human resources, leadership, and talent management.

7. Kudos owns the internet domain name www.kudos.com. Using this domain name, Kudos operates a website that prominently features the KUDOS mark and also advertises Kudos's goods and services (screenshot below).



8. As advertised by Kudos on its website, Kudos offers its customers “Peer-to-peer recognition tied to your values, culture, and performance” and “Insightful, actionable people



analytics” in order to “Boost engagement, measure impact, strengthen culture.” *See* [www.kudos.com](http://www.kudos.com).

9. Kudos customers include business organizations, non-profit organizations, educational institutions, and government agencies.

10. Kudos has grown rapidly since the time of its emergence around 2010. Presently, Kudos workplace solutions are offered and sold in more than 90 countries, including the United States, which is Kudos’s largest market. As a testament to Kudos’s industry recognition and the strong goodwill of its KUDOS mark and brand, Kudos has been recognized on numerous occasions as an industry leader.

11. Since the time of its first use of the KUDOS mark, Opposer has expended significant time, effort, and resources to advertise and promote its KUDOS mark, and the goods and services offered by Kudos in connection with the KUDOS mark.

12. Kudos has also expended significant time, effort, and resources to protect its mark against unauthorized use by sending cease and desist letter, commencing TTAB proceedings, and filing legal complaints in U.S. District Courts in appropriate cases.

13. The foregoing efforts by Kudos have resulted in the KUDOS mark becoming a symbol of valuable recognition, tremendous goodwill, and strong trademark rights belonging to Kudos. Indeed, the consuming public has come to associate the KUDOS mark with Kudos and it understands KUDOS as an indicator of goods and services that either originate from, or are sponsored by, affiliated with, or associated with Kudos.

14. To register its rights relating to the KUDOS mark, and to notify others of its rights, Kudos has obtained numerous U.S. trademark registrations for KUDOS and similar KUDOS-formative marks (collectively, “KUDOS Marks”), including the following registrations:

<u>Reg. No</u>	<u>Mark</u>	<u>Class and G/S</u>
4,190,212	KUDOS	Class 45: Internet-based social networking services.
4,224,053	KUDOS	Class 42: Software as a Service (SaaS) services featuring peer-to-peer software in the field of an employee recognition and reward system that incorporates the allocation and collection of points that are associated to micro messages that recognize individuals for achievements, efforts and attitudes as well as demonstrated skills that are in alignment with corporate goals and objectives to enhance communication, collaboration and employee engagement to drive corporate performance.
4,284,697	KUDOS	Class 35: Providing a web site where users can post ratings, reviews and recommendations on employers and employees and places of employment for use by employees, employers, business owners, and consumers.
4,534,578	KUDOS REWARDS	Class 35: Arranging and conducting incentive reward programs to promote the sale and use of software services in the field of performance review and recognition.  Class 42: Providing a web site featuring technology that enables companies and organizations to administer and manage employee incentive award programs and to promote employee productivity, performance, recognition and morale.
4,641,604	KUDOS	Class 9: Computer application software for mobile phones, portable media players, handheld computers, and review of employee, enterprise, product, and business performance.
4,725,421	KUDOS	Class 9: Providing computer software application for use on mobile phones and mobile computing devices featuring technology that enables internet users to submit comments of personal recognition and review.  Class 42: Providing a web site featuring technology that enables internet users to submit comments of personal recognition and review.
4,725,409	KUDOS	Class 36: Financial transaction services, namely, providing secure commercial transactions and payment options; financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale; providing an internet website portal in the field of financial transaction and payment processing service.

- 4,725,423 KUDOS REWARDS Class 9: Providing computer software application for use on mobile phones and mobile computing devices featuring technology that enables internet users to submit comments of personal recognition and review.
- Class 42: Providing a web site featuring technology that enables internet users to submit comments of personal recognition and review.
- 4,725,411 KUDOS REWARDS Class 36: Financial transaction services, namely, providing secure commercial transactions and payment options; financial transaction services, namely, providing secure commercial transactions and payment options using a mobile device at a point of sale; providing an internet website portal in the field of financial transaction and payment processing services.
- 5,870,820 KUDOS Class 09: Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in group collaboration in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in uploading and sharing of digital files, user directories, photographs, images, videos, messages, emojis, and stickers in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in preparing and publishing digital content in the form of user profiles, blogs, image galleries, newsletters, public announcements, and invitations in connection with an online network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in preparing and publishing digital leader boards in connection with an online social network; Computer application software for mobile phones, handheld computer and portable media devices, namely, software for use in generating, tracking, and reporting information, analytics and statistics relating to employee performance, activity and engagement.
- 5,870,821 KUDOS Class 42: Software as a service (SAAS) services featuring software for use in group collaboration in connection with an online social network; Software as a service (SAAS) services featuring software for use in uploading and sharing of digital files, user directories, photographs, images, videos, messages, emojis, and stickers in connection with an online social network; Software as a service (SAAS) services featuring software for use in in preparing and publishing digital content in the form of user profiles, blogs, image

galleries, newsletters, public announcements, and invitations in connection with an online social network; Software as a service (SAAS) services featuring software for use in preparing and publishing digital leader boards in connection with an online social network; Software as a service (SAAS) services featuring software for use in generating, tracking, and reporting information, analytics and statistics relating to employee performance, activity and engagement.

15. In addition to the registrations listed above, Kudos also owns U.S. Trademark Application Serial No. 97/426,254, which seeks to register the mark KUDOS in Class 35 for the following goods and services:

Business consulting services; Consulting services in the fields of business management and human resources; Consulting services in the field of employee engagement; Consulting services in the field of employee recognition; Consulting services in the field of business analytics; Consulting services in the field of organizational change management.

16. Kudos also expects its goods and services to continue to evolve in order to meet the evolving needs to its clients and customers.

#### **Applicant and the Opposed Application**

17. Applicant Kudos Business Services, LLC dba Kudos Strategies (“*Applicant*” or “*Kudos Strategies*”) is a limited liability company organized and existing under the laws of the State of Virginia with a principal business address at 200 Duke Street, Suite 300, Alexandria Virginia 22314.

18. Applicant offers workplace consulting services.

19. Applicant owns the domain name www.kudosstrategies.com. Applicant uses the domain name to operate a website that advertises Applicant’s goods and services in connection with the mark KUDOS STRATEGIES (screenshot below).



20. Applicant's website prominently displays the mark KUDOS STRATEGIES and describes Applicant's services as follows: "Whether assessing the current state of your culture, building a talent management strategy, or developing employee talent - we tackle your organizational challenges to transform your business." *See* [www.kudosstrategies.com](http://www.kudosstrategies.com).

21. Applicant also advertises its services as follows: "Intensive analysis of current organizational practices and identifying areas that prevent cohesive workflow"; "Employee and customer/patient experience advisory"; "Employee engagement data analysis, Performance management implementation"; "Employee engagement team action-planning"; "Managerial development training"; "New hire on-boarding and orientations"; "New and in-tact team building"; and "CliftonStrengths executive-level individual and team coaching." *See* [www.kudosstrategies.com/services](http://www.kudosstrategies.com/services).

22. Applicant's website further states that Applicant's services are designed to "Increase productivity," "Lessen employee turnover and absenteeism," "Decrease expenses associated with hiring and training," "Innovate outdated processes," "Identify and prioritize the right improvement initiatives," "Connect employee experience to the metrics that matter," "Create actionable learning and development strategies," "Develop compassionate forward-thinking leaders," and "Turn customers into loyal brand ambassadors." *See* [www.kudosstrategies.com](http://www.kudosstrategies.com).

23. Applicant operates an Instagram page titled “KUDOS STRATEGIES,” using the handle @kudosstrategies. On its Instagram page, Applicant describes its goods and services as follows: “Your strengths-based talent management partner. Let’s integrate effective employee experience practices with your strategic objectives.”

24. On February 14, 2022, Applicant submitted to the USPTO U.S. Trademark Application Sr. No. 97/262,295 (the “295 Application” or “Opposed Application”), seeking to register the mark KUDOS STRATEGIES in Class 35 for the following goods and services:

Business management consultation in the field of executive and leadership development; Talent management services for businesses, nonprofit organizations, government agencies, business professionals, executives, and managers.

25. In response to an Office Action alleging that “Applicant must disclaim the wording “STRATEGIES” because it is merely descriptive of a characteristic, function, feature, purpose, or use of applicant’s services,” Applicant entered the following disclaimer as part of the ‘295 Application: “No claim is made to the exclusive right to use “STRATEGIES” apart from the mark as shown.”

26. After learning about the existence of Applicant’s ‘295 Application, Kudos found the application to be objectionable and contacted Applicant to request that Applicant withdraw the ‘295 Application. Applicant refused Kudos’s request, and Kudos now files this Notice of Opposition asserting the Claims below.

**CLAIM ONE**  
**PRIORITY AND LIKELIHOOD OF CONFUSION**  
**15 U.S.C. § 1052(d)**

27. Kudos incorporates herein each allegation contained in the paragraphs above as if fully recited herein.

28. Kudos has used and registered its KUDOS marks mark prior to any priority date

upon which Applicant may rely for its KUDOS STRATEGIES mark.

29. Applicant's KUDOS STRATEGIES mark is similar to Opposer's KUDOS and KUDOS-formative marks in sight, sound, and commercial impression.

30. The goods and services recited in Applicant's '295 Application overlap with, fall within the scope of, or are competitive with, similar to, or related to the goods and services offered or registered by Kudos in connection with its KUDOS and KUDOS-formative marks.

31. To the extent they do not fall within the scope of the goods and services offered or registered by Kudos, Applicant's goods and services as recited in the '295 Application registration fall within the scope of Opposer's natural zone of expansion.

32. Upon information and belief, the parties' respective channels of trade overlap at least in part.

33. In view of the foregoing, and for such other reasons Kudos will prove at trial, Applicant's use of the mark KUDOS STRATEGIES in connection with the goods and services recited in the '295 Application is likely to cause confusion, cause mistake, or to deceive consumers to falsely believe that Applicant's goods emanate from or otherwise are authorized, sponsored by, or affiliated with Kudos, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d).

34. By reason of the foregoing, Kudos would be harmed by the registration of the '295 Application.

35. Accordingly, the registration of KUDOS STRATEGIES as identified in the '295 Application would be inconsistent with 15 U.S.C. §1052(d), and with Kudos's prior registered and common law rights in and to the KUDOS marks.

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WHEREFORE, because Kudos will be injured by Applicant's registration of the Opposed

Application, Opposer Kudos respectfully requests that the Board sustain this Opposition and deny the registration of the Opposed Application.

Dated: February 9, 2023

Respectfully Submitted,

By: *Benjamin Ashurov*  
Benjamin Ashurov  
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*Attorneys for Opposer*