

ESTTA Tracking number: **ESTTA1002981**

Filing date: **09/18/2019**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	Adweek LLC		
Entity	Corporation	Citizenship	Delaware
Address	261 Madison Avenue New York, NY 10016 UNITED STATES		

Attorney information	Gene S. Winter St. Onge Steward Johnston & Reens LLC 986 Bedford Street Stamford, CT 06905 UNITED STATES AProvino@ssjr.com, Litigation@ssjr.com 2033246155		
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Registration Subject to Cancellation

Registration No.	5111197	Registration date	12/27/2016
Registrants	Berkowitz, Roger One Seafood Way Boston, MA 02110 UNITED STATES Gulko, Lawrence M. 3 Old Bridge Lane Sharon, MA 02067 UNITED STATES		

Goods/Services Subject to Cancellation

Class 041. First Use: 2016/02/21 First Use In Commerce: 2016/02/21 All goods and services in the class are subject to cancellation, namely: Entertainment services in the nature of producing and distributing audio and visual programs via television, radio, satellite, cable, internet, social media, live events, podcast and other media channels and platforms in the fields of business, news and current events

Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)
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Attachments	Petition for Cancellation 5111197.pdf(105856 bytes) Exhibit A.pdf(28640 bytes)
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	Exhibit B.pdf(27880 bytes)
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Signature	/Gene S. Winter/
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Name	Gene S. Winter
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Date	09/18/2019
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF TRADEMARK REGISTRATION NO. 5111197

TRADEMARK: INSIDE THE BRAND
REGISTERED: December 27, 2016

Adweek LLC,	:	
	:	
Petitioner,	:	
	:	Cancellation No.
v.	:	[not yet assigned]
	:	
Lawrence M. Gulko and Roger Berkowitz,	:	
	:	
	:	
Registrants.	:	

PETITION TO CANCEL

Adweek LLC (“Petitioner”) hereby petitions to cancel U.S. Trademark Registration No. 5,111,197 on the following grounds:

1. Petitioner is a Delaware Limited Liability company having a principal place of business at 261 Madison Avenue, New York, NY 10016.
2. According to the records of the USPTO, the current owners of U.S. Registration No. 5,111,197 are Lawrence M. Gulko, a United States citizen, having an address at 3 Old Bridge Lane, Sharon, MA 02067 and Roger Berkowitz, a United States citizen, having an address at One Seafood Way, Boston, MA 02110 (“Registrants”).

A copy of the USPTO database record for U.S. Registration No. 5,111,197 is attached as Exhibit A and made of record.

3. Petitioner is the owner of the following United States trademark application for INSIDE THE BRAND under U.S. Application Serial No. 88-433934 for the following goods and services:

“Downloadable and recorded computer mobile application software for performing social media functions, namely, for the collection, editing, organizing, modifying, book marking, transmission, storage, and sharing of data and information, and for receiving news alerts and information regarding music and entertainment; downloadable electronic publications in the nature of magazines in the fields of advertising and marketing; downloadable

mobile applications for live streaming video and sharing videos for social networking purposes; downloadable software in the nature of a mobile application to enable creating, editing, uploading, posting, showing, displaying, live streaming, sharing, blogging and transmitting of digital media, videos, real-time entertainment and educational content, and information over the internet and via mobile communications devices; downloadable computer software for scheduling the displaying, streaming, sharing and transmission of videos and digital media content at a future point in time; downloadable electronic newspapers; downloadable electronic books, magazines, periodicals, newsletters, journals and articles in the fields of business, advertising and marketing; downloadable podcasts in the field of business, advertising and marketing; downloadable webcasts in the field of business, advertising and marketing”, in Class 9; and

“Providing online magazines in the field of advertising and marketing; providing recognition by way of award programs to demonstrate excellence in the fields of media, advertising, marketing, and on-line marketing and media; educational services, namely, conducting conferences, classes, workshops, and seminars in the field of media, advertising, marketing, and on-line marketing and media, and innovations in those fields; providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of media, advertising, marketing, and on-line marketing and media, and innovations in those fields; on-line publication of electronic magazines and articles featuring the media, advertising, marketing, and on-line marketing and media industry and innovators in those fields; arranging, organizing, conducting, and hosting social entertainment events; entertainment services in the nature of presenting ongoing series featuring media and entertainment, namely, news, comedy, and drama, provided through mobile broadcasts and mobile computer applications; entertainment services, namely, providing on-line reviews of movies, books, music, and computer games; providing entertainment programming in the nature of a series of shows and award shows in the fields of culture, news, music, sports, media events, fashion, lifestyle and general interest delivered by television, satellite and internet; on-line journals, namely, blogs in the field of advertising and marketing; providing on-line, non-downloadable podcasts in the field of business, advertising and marketing; providing on-line, non-downloadable webcasts in the field of business, advertising and marketing”, in Class 41

A copy of the USPTO database record for Application Serial No. 88-433934 (“Petitioner’s Application”) is attached as Exhibit B and made of record.

4. Petitioner’s Application has been refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), based on the Trademark Examining Attorney’s conclusion that the Petitioner’s trademark INSIDE THE BRAND for the applied for goods and services is likely to be confused with Registrants’ trademark INSIDE THE BRAND under U.S. Registration No. 5,111,197, when used on the parties’ identified goods and/or services.

5. On information and belief, Registrants have ceased use of the trademark INSIDE THE BRAND on or in connection with the goods and services identified in U.S. Registration No. 5,111,197 and intends not to resume such use.
6. On information and belief, Registrants have not used the trademark INSIDE THE BRAND on or in connection with the goods and services identified in U.S. Registration No. 5,111,197 for a period of at least three consecutive years.
7. On information and belief, Registrants have abandoned the trademark INSIDE THE BRAND within the meaning of 15 U.S.C. § 1127.
8. Petitioner has been and continues to be damaged by U.S. Trademark Registration No. 5,111,197 as evidenced by the citation of the registration as an obstacle to registration in Petitioner's Application.
9. The fee of \$400 representing 1 class is submitted herewith.

WHEREFORE, Petitioner prays that the Trademark Trial and Appeal Board grant its petition and cancel U.S. Trademark Registration No. 5,111,197.

Respectfully submitted,



September 18, 2019

Gene S. Winter
Jonathan A. Winter
ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 Bedford Street
Stamford, CT 06905
Telephone: (203) 324-6155
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ATTORNEYS FOR PETITIONER

Exhibit A

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Mark: INSIDE THE BRAND

INSIDE THE BRAND

US Serial Number: 86893126

Application Filing Date: Feb. 01, 2016

US Registration Number: 5111197

Registration Date: Dec. 27, 2016

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

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: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Dec. 27, 2016

Publication Date: Jun. 21, 2016

Notice of Allowance Date: Aug. 16, 2016

Mark Information

Mark Literal Elements: INSIDE THE BRAND

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

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: Entertainment services in the nature of producing and distributing audio and visual programs via television, radio, satellite, cable, internet, social media, live events, podcast and other media channels and platforms in the fields of business, news and current events

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: ACTIVE

Basis: 1(a)

First Use: Feb. 21, 2016

Use in Commerce: Feb. 21, 2016

Basis Information (Case Level)

Filed Use: No

Currently Use: Yes

Filed ITU: Yes

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: Berkowitz, Roger
Owner Address: One Seafood Way
Boston, MASSACHUSETTS UNITED STATES 02110
Legal Entity Type: INDIVIDUAL **Citizenship:** UNITED STATES

Owner Name: Gulko, Lawrence M.
Owner Address: 3 Old Bridge Lane
Sharon, MASSACHUSETTS UNITED STATES 02067
Legal Entity Type: INDIVIDUAL **Citizenship:** UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Stanley M. Schurgin **Docket Number:** BANDG-T001XX
Attorney Primary Email Address: tm@preti.com **Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: STANLEY M. SCHURGIN
PRETI FLAHERTY BELIVEAU & PACHIOS LLP
60 STATE STREET
SUITE 1100
BOSTON, MASSACHUSETTS UNITED STATES 02110
Phone: 617.226.3800 **Fax:** 617.226.3801
Correspondent e-mail: tm@preti.com **Correspondent e-mail Authorized:** Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Dec. 27, 2016	REGISTERED-PRINCIPAL REGISTER	
Nov. 22, 2016	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Nov. 19, 2016	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Oct. 12, 2016	STATEMENT OF USE PROCESSING COMPLETE	81929
Sep. 23, 2016	USE AMENDMENT FILED	81929
Oct. 12, 2016	CASE ASSIGNED TO INTENT TO USE PARALEGAL	81929
Sep. 23, 2016	TEAS STATEMENT OF USE RECEIVED	
Aug. 16, 2016	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jun. 21, 2016	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jun. 21, 2016	PUBLISHED FOR OPPOSITION	
Jun. 01, 2016	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
May 17, 2016	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 17, 2016	ASSIGNED TO EXAMINER	82431
Feb. 04, 2016	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Feb. 04, 2016	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Nov. 19, 2016

Exhibit B

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Mark: INSIDE THE BRAND

INSIDE THE BRAND

US Serial Number: 88433934

Application Filing Date: May 16, 2019

Filed as TEAS RF: Yes

Currently TEAS RF: Yes

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



LIVE/APPLICATION/Under Examination

The trademark application has been accepted by the Office (has met the minimum filing requirements) and that this application has been assigned to an examiner.

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Aug. 06, 2019

Mark Information

Mark Literal Elements: INSIDE THE BRAND

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

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: Computer mobile application software for performing social media functions, receiving news alerts and receiving information regarding music and entertainment; downloadable electronic publications in the nature of magazines in the fields of advertising and marketing; downloadable video and live stream mobile applications for social networking; downloadable software in the nature of a mobile application to enable creating, editing, uploading, posting, showing, displaying, live streaming, sharing, blogging and transmitting of digital media, videos, real-time entertainment and educational content, and information over the internet and via mobile communications devices; downloadable computer software for scheduling the displaying, streaming, sharing and transmission of videos and digital media content at a future point in time; digital media content posted, displayed, streamed and shared by others; downloadable electronic books, magazines, periodicals, newsletters, newspapers, journals and articles

International Class(es): 009 - Primary Class

U.S Class(es): 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Mar. 01, 2019

Use in Commerce: Mar. 01, 2019

For: Providing online magazines in the field of advertising and marketing; award programs in the fields of media, advertising, marketing, and on-line marketing and media; educational services, namely, conducting conferences, classes, workshops, and seminars in the field of media, advertising, marketing, and on-line marketing and media, and innovations in those fields; providing recognition and incentives by the way of awards and contests to demonstrate excellence in the field of media, advertising, marketing, and on-line marketing and media, and innovations in those fields; publication of electronic magazines and articles featuring the media, advertising, marketing, and on-line marketing and media industry and innovators in those fields delivered by the internet; arranging, organizing, conducting, and hosting social entertainment events; entertainment services in the nature of presenting ongoing series featuring media and entertainment provided through mobile broadcasts and mobile computer applications; entertainment services, namely, providing on-line reviews; providing entertainment programming in the nature of shows and award shows in the fields of culture, news, music, sports, events, fashion, lifestyle and general interest delivered by television, satellite and internet; blogs; podcasts, webcasts

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class(es):**Class Status:** ACTIVE**Basis:** 1(a)**First Use:** Mar. 01, 2019**Use in Commerce:** Mar. 01, 2019

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: Adweek LLC**Owner Address:** 261 Madison Avenue, 8th Floor
New York, NEW YORK UNITED STATES 10016**Legal Entity Type:** LIMITED LIABILITY COMPANY**State or Country Where Organized:** DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Gene S. Winter**Docket Number:** 03671-T0152A**Attorney Primary Email Address:** tm-pt@ssjr.com**Attorney Email Authorized:** Yes

Correspondent

Correspondent Name/Address: GENE S. WINTER
ST. ONGE STEWARD JOHNSTON & REENS LLC
986 BEDFORD STREET
STAMFORD, CONNECTICUT UNITED STATES 06905-5619**Phone:** 203-324-6155 x4506**Fax:** 203-327-1096**Correspondent e-mail:** tm-pt@ssjr.com**Correspondent e-mail Authorized:** Yes**Domestic Representative - Not Found**

Prosecution History

Date	Description	Proceeding Number
Aug. 06, 2019	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2019	NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2019	NON-FINAL ACTION WRITTEN	85321
Aug. 02, 2019	ASSIGNED TO EXAMINER	85321
Jun. 03, 2019	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 20, 2019	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: MONINGHOFF, KIM TERESA**Law Office Assigned:** LAW OFFICE 113

File Location

Current Location: TMO LAW OFFICE 113 - EXAMINING ATTORNEY ASSIGNED**Date in Location:** Aug. 06, 2019