

ESTTA Tracking number: **ESTTA1333005**
Filing date: **01/09/2024**

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	Asor Fund (RA)		
Entity	non-profit organization	Incorporated or registered in	Israel
Address	24 HEBRON RD JERUSALEM, 9354212 ISRAEL		
Attorney information	ROBYN S. LEDERMAN BROOKS KUSHMAN P.C. 150 W. SECOND ST., SUITE 400N ROYAL OAK, MI 48067-3846 UNITED STATES Primary email: trademarks@brookskushman.com 2483584400		
Docket no.	GLUS0115OC		

Registration subject to cancellation

Registration no.	5721523	Registration date	04/09/2019
Register	Principal		
Registrant	Givable 911 WASHINGTON AVENUE ST. LOUIS, MO 63101 UNITED STATES		

Goods/services subject to cancellation

Class 036. First Use: Aug 15, 2018 First Use In Commerce: Aug 15, 2018
All goods and services in the class are subject to cancellation, namely: Charitable fundraising services for Jewish organizations

Grounds for cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
--------------------------------------	---------------------------------------

Mark cited by petitioner as basis for cancellation

U.S. application no.	90732752	Application date	05/25/2021
Register	Principal		
Registration date	NONE	Foreign priority	05/06/2021

		date	
Word mark	JGIVE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: None First Use In Commerce: None (Based on 44(e)) (Based on Intent to Use) Downloadable computer software and computer application software for mobile phones and for handheld computers for making and managing all types of donations</p> <p>Class 035. First use: First Use: None First Use In Commerce: None (Based on 44(e)) (Based on Intent to Use) Promoting the charitable services of others, namely, providing individuals with information about various charities for the purpose of making donations to charities; promoting the charitable giving of others, namely, tracking and publicizing charitable donations and random acts of kindness; developing and managing the charitable giving programs of others; promotional services in the field of charitable fundraising for nonprofit and charitable organizations for others, namely, raising public awareness for the need of and benefits of charitable giving to organizations promoting a wide variety of causes; market study and analysis of market study; business information services, namely, providing an online compilation of data and statistics on charitable engagement for business purposes; providing on-line web directory services featuring hyperlinks to the websites of charitable organizations or charities; Promoting the goods and services of others by means of distributing advertising and information on the Internet; providing business information concerning volunteering and volunteer projects via on-line computer databases and on-line searchable databases; Business services, namely, assisting others in the establishment of charitable organizations; promotional services to publicize the charitable works of others; business consultancy services relating to management of fund raising campaigns; charitable services in the nature of developing and coordinating volunteer projects for charitable organizations; providing business management for charitable organizations; providing business information for charitable organizations and business information to others for the purpose of making donations to the charities of others; organizing and conducting charity auctions for charitable fundraising purposes; charitable services, namely, arranging in the nature of coordinating the procurement and distribution of in-kind donations of computers and computer peripherals to schools for educational learning and research</p> <p>Class 036. First use: First Use: None First Use In Commerce: None (Based on 44(e)) (Based on Intent to Use) Charitable fund raising; Charitable fundraising services, namely, charitable fundraising and collection of charitable donations for others; providing charitable fund raising services for others via a global computer network; Charitable fundraising services, namely, collection of monetary donations for charitable purposes; providing information relating to charitable donations as part of estate planning; Charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Jewish and Charitable Approved Causes in Israel; Charitable fundraising services by means of providing individuals with the information and opportunity to make monetary donations to their favorite charity; providing information relating to the aforementioned services; all the aforementioned services also provided online; philanthropic services concerning monetary donations and cash contributions via on-line computer databases and on-line searchable databases; providing online information in the field of charitable monetary giving through financial and estate planning; providing information and consulting services in the field of charitable fundraising; philanthropy consultation relating to charitable fundraising; consulting services in the field of charitable fundraising for non-profit and charitable organizations; clearing financial payment transactions via a global computer network; crowdfunding ser-</p>		

	<p>vices; crowdfunding services in the nature of accepting and administering monetary contributions from a group of individuals; charitable and business fundraising services by means of providing individuals, non-profits and businesses with the information and opportunity to accept monetary donations through an interactive website; online business fundraising services; providing fundraising services for others via a global computer network; financial consultation in the field of crowdfunding; providing information relating to charitable fundraising and monetary donations via on-line computer databases and on-line searchable databases; providing financial information to others as to methods for donations to the charities of others; providing information concerning fundraising, collection of monetary donations, financial sponsorship of charitable organizations; charitable fund raising by means of entertainment events; charitable fund raising services; investment of funds for charitable purposes; Charitable fundraising services by means of organizing charitable collections; acceptance of monetary charitable contributions; On Line fund raising services; Charitable Crowd Funding Services; Donor Advised Fund Services; on-line business fund raising services; providing information relating to charitable fundraising; electronic funds transfer; accepting monetary charitable contributions; financial management of funds</p> <p>Class 042. First use: First Use: None First Use In Commerce: None (Based on 44(e)) (Based on Intent to Use) Software as a service (SAAS) services featuring software for Making, Managing and Receiving all types of donations; design and development of computer software and computer application software in the fields of donations and charitable fund raising; Software as a service (SAAS), namely, hosting software for use by businesses and corporations for use in facilitating fundraising, planning corporate philanthropy, and the managing of donor funds; Platform as a service featuring computer software platforms for creating customizable webpages used to solicit monetary donations for charitable and business purposes; computer services, namely, hosting an interactive website that enables users to create and share webpages concerning charitable and business causes; Providing temporary use of online nondownloadable software applications for creating and maintaining virtual communities, for social networking, photo sharing, video sharing, and transmission of photographic images and video concerning their volunteering, fundraising, donating, charities, and charitable life; hosting online web facilities for others to upload, post, and display photographs and videos for sharing with others; Software as a service (SAAS) services, namely, hosting software for use by others in creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking concerning their volunteering, fundraising, donations, charities, and charitable life; Computer services, namely, providing in the nature of hosting an online community for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising</p> <p>Class 045. First use: First Use: None First Use In Commerce: None (Based on 44(e)) Computer services, namely, providing online social networking services through a community website for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising</p>
--	---

Attachments	Petition to Cancel - ASOR FUND v GIVABLE.pdf(388757 bytes)
Signature	/rlederman/
Name	ROBYN S. LEDERMAN
Date	01/09/2024

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

In re Trademark Registration No. 5721523
Filed: August 30, 2018
Registered: April 9, 2019
Trademark: J-GIVABLE

ASOR FUND (RA))	
)	
Petitioner,)	
)	
v.)	Cancellation No. _____
)	
GIVABLE)	
)	
Respondent.)	

PETITION TO CANCEL

VIA ELECTRONIC FILING
Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir/Madam:

Asor Fund (RA) (“Petitioner”), a non-profit organization formed under the laws of Israel and having a principal place of business at 24 Hebron Rd., Jerusalem, Israel 9354212, believes that it is and will continue to be damaged by the Respondent’s continued registration of the mark J-GIVABLE for services in Class 36 as set forth in U.S. Trademark Registration No. 5721523 in the name of Givable (“Respondent”), a charitable, non-profit corporation organized in the State of Missouri and having a principal place of business at 911 Washington Avenue, St. Louis, Missouri, 63101, and hereby petitions to cancel the same.

As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner is a non-profit social impact organization founded in 2014 that provides platforms to make charitable giving accessible to the general public.

2. Petitioner is the owner of the JGIVE Mark (the “JGIVE Mark”) in the United States and elsewhere. Petitioner has used the JGIVE Mark in the United States in connection with

Promoting the charitable services of others, namely, providing individuals with information about various charities for the purpose of making donations to charities; promoting the charitable giving of others, namely, tracking and publicizing charitable donations and random acts of kindness; developing and managing the charitable giving programs of others; promotional services in the field of charitable fundraising for nonprofit and charitable organizations for others, namely, raising public awareness for the need of and benefits of charitable giving to organizations promoting a wide variety of causes; market study and analysis of market study; business information services, namely, providing an online compilation of data and statistics on charitable engagement for business purposes; providing on-line web directory services featuring hyperlinks to the websites of charitable organizations or charities; Promoting the goods and services of others by means of distributing advertising and information on the Internet; business consultancy services relating to management of fund raising campaigns; providing business management for charitable organizations; providing business information for charitable organizations and business information to others for the purpose of making donations to the charities of others (Class 35); Charitable fund raising; Charitable fundraising services, namely, charitable fundraising and collection of charitable donations for others; providing charitable fund raising services for others via a global computer network; Charitable fundraising services, namely, collection of monetary donations for charitable purposes; Charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Jewish and Charitable Approved Causes in Israel; Charitable fundraising services by means of providing individuals with the information and opportunity to make monetary donations to their favorite charity; providing information relating to the aforementioned services; all the aforementioned services also provided online; philanthropic services concerning monetary donations and cash contributions via on-line computer databases and on-line searchable databases; providing online information in the field of charitable monetary giving through financial and estate planning; providing information and consulting services in the field of charitable fundraising; philanthropy consultation relating to charitable fundraising; consulting services in the field of charitable fundraising for non-profit and charitable organizations; clearing financial payment transactions via a global computer network; crowdfunding services; crowdfunding services in the nature of accepting and administering monetary contributions from a group of individuals; charitable and business fundraising services by means of providing individuals, non-profits and businesses with the

information and opportunity to accept monetary donations through an interactive website; online business fundraising services; providing fundraising services for others via a global computer network; financial consultation in the field of crowdfunding; providing information relating to charitable fundraising and monetary donations via on-line computer databases and on-line searchable databases; providing financial information to others as to methods for donations to the charities of others; providing information concerning fundraising, collection of monetary donations; charitable fund raising services; Charitable fundraising services by means of organizing charitable collections; acceptance of monetary charitable contributions; On Line fund raising services; Charitable Crowd Funding Services; on-line business fund raising services; providing information relating to charitable fundraising; electronic funds transfer; accepting monetary charitable contributions; financial management of funds (Class 36); Software as a service (SAAS) services featuring software for Making, Managing and Receiving all types of donations; design and development of computer software and computer application software in the fields of donations and charitable fund raising; Software as a service (SAAS), namely, hosting software for use by businesses and corporations for use in facilitating fundraising, planning corporate philanthropy, and the managing of donor funds; Platform as a service featuring computer software platforms for creating customizable webpages used to solicit monetary donations for charitable and business purposes; computer services, namely, hosting an interactive website that enables users to create and share webpages concerning charitable and business causes; Providing temporary use of online nondownloadable software applications for creating and maintaining virtual communities, for social networking, photo sharing, video sharing, and transmission of photographic images and video concerning their volunteering, fundraising, donating, charities, and charitable life; hosting online web facilities for others to upload, post, and display photographs and videos for sharing with others; Software as a service (SAAS) services, namely, hosting software for use by others in creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking concerning their volunteering, fundraising, donations, charities, and charitable life; Computer services, namely, providing in the nature of hosting an online community for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising (Class 42); Computer services, namely, providing online social networking services through a community website for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising (Class 45).

since at least as early as 2015(the “Petitioner’s Goods and Services”). An example of Petitioner’s use is a screenshot taken from the Internet Archives of Petitioner’s website at <jgive.com> on November 7, 2016, attached hereto as **Exhibit A**.

3. Petitioner is the owner of U.S. Trademark Serial No. 90732752 for JGIVE for

goods and services in Classes 9, 35, 36, 42, and 45:

Class 9: Downloadable computer software and computer application software for mobile phones and for handheld computers for making and managing all types of donations.

Class 35: Promoting the charitable services of others, namely, providing individuals with information about various charities for the purpose of making donations to charities; promoting the charitable giving of others, namely, tracking and publicizing charitable donations and random acts of kindness; developing and managing the charitable giving programs of others; promotional services in the field of charitable fundraising for nonprofit and charitable organizations for others, namely, raising public awareness for the need of and benefits of charitable giving to organizations promoting a wide variety of causes; market study and analysis of market study; business information services, namely, providing an online compilation of data and statistics on charitable engagement for business purposes; providing on-line web directory services featuring hyperlinks to the websites of charitable organizations or charities; Promoting the goods and services of others by means of distributing advertising and information on the Internet; providing business information concerning volunteering and volunteer projects via on-line computer databases and on-line searchable databases; Business services, namely, assisting others in the establishment of charitable organizations; promotional services to publicize the charitable works of others; business consultancy services relating to management of fund raising campaigns; charitable services in the nature of developing and coordinating volunteer projects for charitable organizations; providing business management for charitable organizations; providing business information for charitable organizations and business information to others for the purpose of making donations to the charities of others; organizing and conducting charity auctions for charitable fundraising purposes; charitable services, namely, arranging in the nature of coordinating the procurement and distribution of in-kind donations of computers and computer peripherals to schools for educational learning and research.

Class 36: Charitable fund raising; Charitable fundraising services, namely, charitable fundraising and collection of charitable donations for others; providing charitable fund raising services for others via a global computer network; Charitable fundraising services, namely, collection of monetary donations for charitable purposes; providing information relating to charitable donations as part of estate planning; Charitable fundraising services by means of a website where donors search for and make monetary donations to specific charities or projects aimed at Jewish and Charitable Approved Causes in Israel; Charitable fundraising services by means of providing individuals with the information and opportunity to make monetary donations to their favorite charity; providing information relating to the aforementioned services; all the aforementioned services also provided online; philanthropic services concerning monetary donations and cash contributions via on-line computer databases and on-line searchable databases; providing online information in the field of charitable monetary giving through financial and estate planning; providing information and consulting services in the field of charitable fundraising; philanthropy

consultation relating to charitable fundraising; consulting services in the field of charitable fundraising for non-profit and charitable organizations; clearing financial payment transactions via a global computer network; crowdfunding services; crowdfunding services in the nature of accepting and administering monetary contributions from a group of individuals; charitable and business fundraising services by means of providing individuals, non-profits and businesses with the information and opportunity to accept monetary donations through an interactive website; online business fundraising services; providing fundraising services for others via a global computer network; financial consultation in the field of crowdfunding; providing information relating to charitable fundraising and monetary donations via on-line computer databases and on-line searchable databases; providing financial information to others as to methods for donations to the charities of others; providing information concerning fundraising, collection of monetary donations, financial sponsorship of charitable organizations; charitable fund raising by means of entertainment events; charitable fund raising services; investment of funds for charitable purposes; Charitable fundraising services by means of organizing charitable collections; acceptance of monetary charitable contributions; On Line fund raising services; Charitable Crowd Funding Services; Donor Advised Fund Services; on-line business fund raising services; providing information relating to charitable fundraising; electronic funds transfer; accepting monetary charitable contributions; financial management of funds.

Class 42: Software as a service (SAAS) services featuring software for Making, Managing and Receiving all types of donations; design and development of computer software and computer application software in the fields of donations and charitable fund raising; Software as a service (SAAS), namely, hosting software for use by businesses and corporations for use in facilitating fundraising, planning corporate philanthropy, and the managing of donor funds; Platform as a service featuring computer software platforms for creating customizable webpages used to solicit monetary donations for charitable and business purposes; computer services, namely, hosting an interactive website that enables users to create and share webpages concerning charitable and business causes; Providing temporary use of online nondownloadable software applications for creating and maintaining virtual communities, for social networking, photo sharing, video sharing, and transmission of photographic images and video concerning their volunteering, fundraising, donating, charities, and charitable life; hosting online web facilities for others to upload, post, and display photographs and videos for sharing with others; Software as a service (SAAS) services, namely, hosting software for use by others in creating an on-line community for registered users to participate in discussions, get feedback from their peers, form virtual communities, and engage in social networking concerning their volunteering, fundraising, donations, charities, and charitable life; Computer services, namely, providing in the nature of hosting an online community for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising.

Class 45: Computer services, namely, providing online social networking services through

a community website for users to participate in discussions, get feedback, form virtual communities, and engage in social networking in the field of charitable fundraising.

Petitioner filed this application on May 25, 2021. This application will be referred to as the “752 Application.”

4. Petitioner has expended considerable effort and expense in advertising and promoting the JGIVE Mark and the goods and services associated with the JGIVE Mark in the United States, with the result that the purchasing public has come to know and recognize the goods and services of Petitioner by Petitioner’s mark. Petitioner has exceedingly valuable goodwill established in the JIVE Mark.

5. On August 30, 2018, Registrant filed an application to register the mark J-GIVABLE for “Charitable fundraising services for Jewish organizations in Class 36, with a first use claim of August 15, 2018. The registration issued April 9, 2019, under Registration No. 5721523 (the “Cited Registration”).

6. On February 28, 2022, the U.S. Patent and Trademark Office (“USPTO”) issued an Office Action and a Final Office Action on October 17, 2023, refusing registration of the “752 Application on the ground of likelihood of confusion under Section 2(d), 15 U.S.C. §1052(d), based on the Cited Registration. As a result, Petitioner is suffering harm due to Respondent’s continued registration of the Cited Registration.

Cancellation based on Section 2(d)

7. Registrant’s Mark is likely to cause confusion with Applicant’s JGIVE Mark.

8. There is no issue as to priority. Petitioner used the JGIVE Mark in connection with its goods and services prior to both Registrant’s filing date and claim of first use being of August

30, 2018, and August 15, 2018, respectively.

9. Respondent is the listed owner of the Cited Registration and is not connected to or associated with the Petitioner.

10. Respondent's J-GIVABLE mark is substantially similar to Petitioner's JGIVE Mark.

11. The goods and services identified in the cited Registration are substantially similar to and/or identical to Petitioner's Goods and Services.

12. If Respondent is allowed to maintain the Cited Registration, it would maintain at least a prima facie exclusive right to use J-GIVABLE for the designated services. This registration would continue to be a source of injury and damage to Petitioner's prior and established rights in the JGIVE Mark.

13. The Cited Registration No. 5721523 so resembles Petitioner's Mark and the services identified are so closely related to the Goods and Services of Petitioner as to be likely, when used in connection with Petitioner's goods and services, to cause confusion, or to cause mistake, or to deceive in violation of Section 2(d) of the Lanham Act, 15 USC 1052(d). This is confirmed by the USPTO's rejection of the '752 Application.

Cancellation based on Abandonment

14. Per 15 U.S.C. § 1127, defining the term "Use in commerce" ...a mark "shall be deemed to be in use in commerce – (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services."

15. Further per 15 U.S.C. § 1127, “a mark shall be deemed to be ‘abandoned’...(1) [w]hen its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances” and “Use of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.”

16. The Trademark Trial and Appeal Board has authority under 15 U.S.C. § 1068 to cancel the Registration.

17. Upon information and belief Respondent has not used the J-GIVABLE mark in commerce in the last three years. Upon further information and belief, Respondent has no intent to resume (or begin) use of the J-GIVABLE mark in commerce in connection with the Services.

18. Upon information and belief Respondent does not currently offer or sell any services in connection with the Registered Mark in the United States, and Respondent does not use the Registered Mark in U.S. commerce in connection with the services identified in the Registration since February 28, 2019. This information and belief are based on the Respondent’s purported website at <givable.org> noted in the undated specimen Respondent submitted to the USPTO on August 30, 2018, which is no longer active, the browse history maintained by the Internet Archive for <givable.org>, and Respondent’s social media which has been dormant since December 21, 2018. See attached as **Exhibit B**, screenshots of Respondent’s website at present and a screenshot from the Internet Archive.

19. As described above, Petitioner will be harmed if Respondent is allowed to maintain its registration for J-GIVABLE.

20. Accordingly, Respondent’s J-GIVABLE mark shown in Registration No. 5721523 should be canceled in its entirety based on likelihood of confusion under Section 2(b) of the

Lanham Act, 15 USC 1052(d) and/or abandonment under Section 45 of the Lanham Act, 15 U.S.C. §1127.

WHEREFORE, Petitioner prays that this cancellation be sustained, and Respondent's U.S. Trademark Registration No. 5721523 be cancelled.

The fee required under 37 C.F.R. § 2.6(a)(17) is being paid electronically concurrently with the filing of this Petition to Cancel. If the filing fee is found to be insufficient for any reason, please charge such deficiency or credit any overpayment of fees to Deposit Account 502337.

Respectfully submitted,

A handwritten signature in blue ink, appearing to read "Robyn S. Lederman", with a long horizontal flourish extending to the right.

By: _____
Robyn S. Lederman
Rebecca Cantor
Attorneys for Petitioner

Date: January 9, 2024

BROOKS KUSHMAN P.C.
150 W. Second St., Suite 400N
Royal Oak, MI 48067
Phone: 248-358-4400