

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

Aug, 4, 2004

AMAZON.COM, INC.  
1200 12<sup>th</sup> Avenue South, Suite 1200  
Seattle, Washington 98144,

Opposer,

v.

VON ERIC LERNER KALAYDJIAN  
4226 Scandia Way  
Los Angeles, California 90065,

Applicant.

91122000

Opposition No. 122,000

SECOND

RESPONSE

TO ADMISSIONS

amazon.com v von eric lerner kalaydjian opposition 91122000

applicants second response . trademark trial and appeal board

request for admission 1. admit

august 4,2004

request for admission 2. admit

request for admission 3. deny

request for admission 4. cannot admit or deny

request for admission 5. cannot admit or deny

request for admission 6. cannot admit or deny

request for admission 7 cannot admit or deny

request for admission 8 cannot admit or deny

request for admission 9 cannot admit or deny

request for admission 10 cannot admit or deny

request for admission 11. cannot admit or deny

request for admission 12. cannot admit or deny

request for admission 13 cannot admit or deny

request for admission 14 cannot admit or deny

request for admission 15 cannot admit or deny

request for admission 16 cannot admit or deny

request for admission 17 .DENY

request for admission 18 DENY

request for admission 19 DENY

request for admission 20 cannot admit or deny

request for admission 21 deny

*Handwritten signature and date:*  
J. L. ...  
AUG 4  
2004

opposition 91122000

request for admission	22.	DENY
request for admission	23.	DENY
request for admission	24	DENY
request for admission	25	DENY
request for admission	26	DENY
request for admission	27	DENY
request for admission	28	DENY
request for admission	29	DENY
request for admission	30	DENY
request for admission	31	DENY
request for admission	32	DENY
request for admission	33	DENY
request for admission	34.	admit
request for admission	35.	admit
request for admission	36	deny
request for admission	37	admit
request for admission	38.	deny
request for admission	39	admit
request for admission	40	admit
request for admission	41	DENY

*Handwritten notes:*  
920  
4-2004  
AUC

75/938,128  
75/008,413

AUG, 4, 2004

I von ERIC LERNER KALAYDJIAN  
CERTIFY THAT I HAVE

MAILED A COPY  
OF THESE OPPOSITION

DOCUMENTS TO

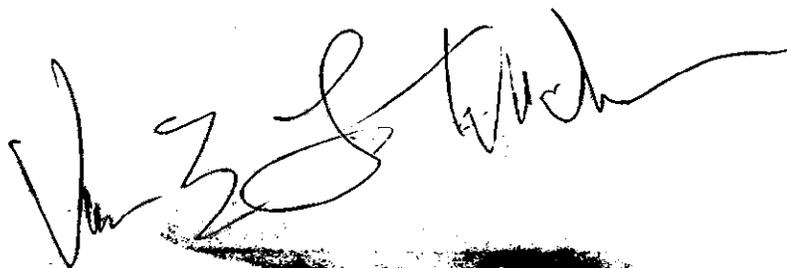
FULBRIGHT

ATTN: JOHN JAWORSKI  
RAWLS

ER 166109085 US

CONFIRMATION NUMBER

U.S. EXPRESS MAIL



# FULBRIGHT & JAWORSKI L.L.P.

A REGISTERED LIMITED LIABILITY PARTNERSHIP  
865 SOUTH FIGUEROA STREET, 29TH FLOOR  
LOS ANGELES, CALIFORNIA 90017  
WWW.FULBRIGHT.COM

SSILBERT@FULBRIGHT.COM  
DIRECT DIAL: (213) 892-9288

TELEPHONE: (213) 892-9200  
FACSIMILE: (213) 680-4518

August 2, 2004

## BY EMAIL AND CERTIFIED MAIL

Von Eric Lerner Kalaydjian  
4226 Scandia Way  
Los Angeles, California 90065-4329  
kamazonian@aol.com

Re: COSMETICSAMAZON Opposition No. 91/122,000

Dear Mr. Kalaydjian:

This will respond to your email of July 7, 2004 concerning Amazon.com's First Sets of Requests for Admissions and Special Interrogatories served on July 1, 2004 in the above-referenced matter.

Please be advised that the Federal Rules of Civil Procedure relating to the service of Special Interrogatories and Requests for Admission govern discovery in trademark oppositions before the Trademark Trial and Appeals Board. *See* 37 CFR § 2.120 (2003). Thus, you were required to serve responses to Amazon.com's first sets of written discovery by July 31, 2004. Pursuant to Rule 36, you are deemed to have admitted all of our requests because you failed to deny them by that time. Fed. R. Civ. P. 36.

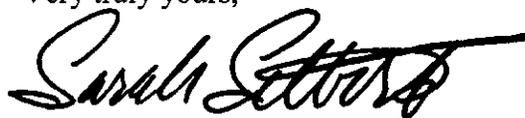
You appear to believe that no response is required because the Opposition was resolved in the Settlement Agreement that you entered with Amazon.com in 2002. That is not the case. In fact, section 1.8 of the Settlement Agreement specifically gives Amazon.com the right to continue its Opposition to the currently pending trademark application Serial No. 75938128 for COSMETICSAMAZON in International Class 35.

By this letter, we make one final request that you to comply with your discovery obligations. Specifically, we ask that you promptly serve substantive responses to our Requests for Admission, admitting or denying each individual request. Further, to the extent you deny any individual Request for Admission, you must also provide us with a written answer to our Interrogatory No. 1. If you fail to provide these additional responses within ten (10) days of the

Von Eric Lerner Kalaydjian  
August 2, 2004  
Page 2

date of this letter, Amazon.com will move forward with its planned motion for summary judgment, and will rely upon the admissions resulting from your failure to respond to the Request for Admission.

Very truly yours,

A handwritten signature in black ink, appearing to read "Sarah Silbert". The signature is written in a cursive, flowing style with a long horizontal stroke extending to the right.

Sarah Silbert

<b>TRADEMARK/SERVICE MARK APPLICATION, PRINCIPAL REGISTER, WITH DECLARATION</b>	<b>MARK (Word(s) and/or Design)</b> COSMETICSAMAZON	<b>CLASS NO. (If known)</b>
<b>TO THE ASSISTANT COMMISSIONER FOR TRADEMARKS:</b>		
<b>APPLICANT'S NAME:</b> Von Eric Lerner Kalaydjian		
<b>APPLICANT'S MAILING ADDRESS:</b> 4226 Scandia Way (Display address exactly as it should appear on registration) Los Angeles, CA 90065		
<b>APPLICANT'S ENTITY TYPE:</b> (Check one and supply requested information)		
X	Individual - Citizen of (Country): United States	
	Partnership - State where organized (Country, if appropriate): _____ Names and Citizenship (Country) of General Partners: _____	
	Corporation - State (Country, if appropriate) of Incorporation: _____	
	Other (Specify Nature of Entity and Domicile): _____	
<b>GOODS AND/OR SERVICES:</b>		
Applicant requests registration of the trademark/service mark shown in the accompanying drawing in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. 1051 et. seq., as amended) for the following goods/services ( <b>SPECIFIC GOODS AND/OR SERVICES MUST BE INSERTED HERE</b> ): Company producing skin tanning preparations, including lotions, creams, gels and oils, sunblock lotion to be applied to the skin and lips, cosmetics and cleaning preparations, including facial soap, body soap bath oil, hair shampoos and conditioners, skin lotions, face and body cleansers, colognes, eau de toilette, and perfumes.		
<b>BASIS FOR APPLICATION:</b> (Check boxes which apply, but never both the first AND second boxes, and supply requested information related to each box checked.)		
[ ]	Applicant is using the mark in commerce on or in connection with the above identified goods/services. (15 U.S.C. 1051(a), as amended.) Three specimens showing the mark as used in commerce are submitted with this application. <ul style="list-style-type: none"> <li>• Date of first use of the mark in commerce which the U.S. Congress may regulate (for example, interstate or between the U.S. and a foreign country): _____</li> <li>• Specify the type of commerce: _____                      (for example, interstate or between the U.S. and a specified foreign country)</li> <li>• Date of first use anywhere (the same as or before use in commerce date): _____</li> <li>• Specify manner or mode of use of mark on or in connection with the goods/services: _____                      (for example, trademark is applied to labels, service mark is used in advertisements)</li> </ul>	
[X]	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services. (15 U.S.C. 1051(b), as amended.) <ul style="list-style-type: none"> <li>• Specify intended manner or mode of use of mark on or in connection with the goods/services: _____                      Servicemark will be used in advertisements                      (for example, trademark will be applied to labels, service mark will be used in advertisements)</li> </ul>	
[ ]	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services, and asserts a claim of priority based upon a foreign application in accordance with 15 U.S.C. 1126(d), as amended. <ul style="list-style-type: none"> <li>• Country of foreign filing: _____</li> <li>• Date of foreign filing: _____</li> </ul>	
[ ]	Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services and, accompanying this application, submits a certification or certified copy of a foreign registration in accordance with 15 U.S.C. 1126(e), as amended. <ul style="list-style-type: none"> <li>• Country of registration: _____</li> <li>• Registration number: _____</li> </ul>	
<b>NOTE: Declaration, on Reverse Side, MUST be Signed</b>		

# INVOICE

ATTORNEY'S CORPORATION SERVICE, INC.

44 LANKERSHIM BLVD.  
NORTH HOLLYWOOD, CA 91602-1836  
(323) 877-6681 • (818) 505-0777

DATE: 08/02/99	TERMS: NET 15 DAYS	DB
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CUST. #: A007852	INVOICE #: 273542	
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**BILL TO:**

NORAVIAN, CARLO  
A/PAYABLE  
500 N. CENTRAL AVE #940  
GLENDALE CA 91203

**SHIP TO:**

NORAVIAN, CARLO  
500 N. CENTRAL AVE. #940  
GLENDALE CA 91203  
ATTN:

REF  
AMAZON COSMETICS & TAN PRODUCT

REQUESTS FOR BILLING ADJUSTMENTS AND MERCHANDISE CORRECTIONS MUST  
BE MADE WITHIN 30 DAYS OF RECEIPT OF MERCHANDISE.

QUANTITY	DESCRIPTION	UNIT PRICE	AMOUNT
1	Advance To Sec. Of State - ntx	18.00	18.00
1	Corp. Name Reservation-NO TAX	15.00	15.00
		C. O. D.	\$.00
		Ship/Del	\$.00
		<b>Sales Tax</b>	\$.00
		<b>TOTAL SALE</b>	<b>33.00</b>
		<b>Received</b>	\$.00
		<b>AMOUNT DUE</b>	<b>33.00</b>

\*\*ARTICLES PREPARED & FILED ON THE SAME DAY\*\*  
\*\*\*CALL FOR DETAILS\*\*\*

**PLEASE REMIT PROMPTLY**

**PLEASE INCLUDE A COPY OF THIS  
INVOICE WITH YOUR REMITTANCE**

A SERVICE CHARGE OF \$15.00 WILL BE ASSESSED ON ALL RETURNED CHECKS.  
A FEE OF \$20.00 WILL BE ADDED TO ALL ACCOUNTS SUBMITTED FOR COLLECTION.

*Thank You*

**WE HAVE PROVIDED OUR SERVICES TO YOU,  
THE "BILL TO" PARTY NAMED ABOVE, AND  
LOOK TO YOU FOR PAYMENT OF ALL CHARGES.**

# STREET ZEBRA

TRIBAL SPORTS LOCAL TURF

September 1, 1999

Mr. Eric Lerner  
President  
Amazon Tan.com  
4226 Scandia Way  
Los Angeles, CA 90065

Dear Mr. Lerner:

It was a pleasure speaking with you today. Here is the information that you have requested. Have Great day!

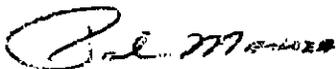
**StreetZebra** was acquired recently by Sports Celebrity Network, creators of the web site [www.athletedaily.com](http://www.athletedaily.com). This site was voted third best of all sports web sites on the Internet by Sport Magazine (March 1999). Sports Celebrity Network not only operates **StreetZebra** but in addition to this they are also currently working on launching **StreetZebra.com**. With a live date of September 1<sup>st</sup>, 1999, this site promises to be the one-stop megasource for local sports and recreation coverage, from peewee to Pros, and beyond.

**StreetZebra** was launched February 1, 1999 as the only premier local sports and recreation magazine in Los Angeles. Published monthly, **StreetZebra** delivers total city sports news, in-depth interviews, commentary, up-to-date schedules, scores, summaries and more. Our coverage runs from high school events in your own backyard to the NBA/WNBA, MLB, NFL, MLS, NHL, NASCAR, PGA/LPGA, ATP/WTA, the AVP...you name it, we cover it!

Targeted distribution is one of the keys to **StreetZebra's** success. **StreetZebra** has developed a network of retail chain locations comprised of convenience, drug, grocery, health clubs and video stores that get our magazines into the hands of prospective sports enthusiasts. **StreetZebra** not only delivers an exclusive audience, but one that attends sporting events and participates in health and sports activities.

I would like to invite you to promote **Amazon Tan** products in our premiere magazine. **StreetZebra** is the perfect vehicle to reach an exclusive audience. I look forward to meeting with you soon. If you have any questions, please feel free to call me at (310) 822-0333.

Sincerely,



Paul Mendoza  
Account Executive

streetzebra.com  
4134 Del Rey Ave.  
Marina Del Rey,  
California 90292  
Voice 310.754.4091  
Fax 310.754.4095

State of California  
SECRETARY OF STATE  
DIVISION OF CORPORATION FILING AND SERVICES  
NAME RESERVATION CERTIFICATE

CARLO MORAVIAN  
500 N CENTRAL AVE STE 940  
GLENDALE, CA 91203

RESERVATION # R0572223

ISSUED 08/02/99

EXPIRES 09/30/99

RE: AMAZON COSMETICS & TAN PRODUCTS, INC.

The name set forth above is hereby reserved for a period of sixty days, commencing on the date hereof, for the use of the addressee as specified in Section 201 of the California Corporations Code. No financial commitment regarding this proposed name should be made until documents have been filed by the Secretary of State.



*Bill Jones*

Secretary of State

*Matthew Cotten*



## Invoice

21550 Oxnard Street, Third Floor  
Woodland Hills, CA 91367-  
Phone: (800) 772-7102 Fax: (818) 592-4041

<b>Invoice Date</b>	8/3/99	<b>Contact Name</b>	Von Eric Lerner Kalaydj
<b>Order Date</b>	8/3/99	<b>Terms</b>	PAID IN FULL
<b>Ship Via</b>			

**Bill To:**

4226 Scandia Way  
Los Angeles, CA 90065-

<i>ID</i>	<i>Product Name</i>	<i>Quantity</i>	<i>Unit Price</i>	<i>Discount</i>	<i>Line Total</i>
6	Trademark Application Fee	2	\$245.00	0.00%	\$490.00
7	Trademark Attorney Fee	2	\$275.00	0.00%	\$550.00
<b>Subtotal</b>					\$1,040.00
<b>Shipping Charge</b>					\$0.00
<b>Sales Tax</b>					\$0.00
<b>Order Total</b>					\$1,040.00
<b>Total Payments</b>					\$1,040.00
<b>Total Due</b>					\$0.00

AMAZONTAN.COM, AMAZON COSMETICS AND TAN PRODUCTS

Tuesday, August 03, 1999

Page 1 of 1



August 3, 2000

Eric Kalaydjian  
dba Amazon Cosmetics  
4226 Scandia Way  
Los Angeles, CA 90065

RE: Claim #: 5620065319-001  
Insured: Eric Kalaydjian, dba Amazon Cosmetics  
Date of Loss: 09/16/99  
Claimant: Amazon.Com

Zurich U.S.

Claims

P.O. Box 92566  
Los Angeles, CA  
90009-2566

Telephone (800) 338-3160  
Fax (818) 702-6179  
<http://www.zurichus.com>

Dear Mr. Kalaydjian:

We have reviewed the material that you have submitted to us. It is clear that, to date, Amazon.com has not made a claim for monetary damages against you. They have requested that you cease and desist from using the AmazonTan name and that does not constitute a claim for monetary damages. Consequently, there is nothing to defend or indemnify and we find that there is nothing that will trigger coverage at this time.

However, please keep us advised if you receive anything further from Amazon.com. That would include correspondence and/or legal documents including a lawsuit should one be filed. Once a claim is made and/or lawsuit is filed, we can then review any allegations made by Amazon.com and determine if there is coverage for those allegations under the policy you have with

Very truly yours,  
Northern Insurance Company of New York

Patricia Horton  
CLAIM CASE MANAGER  
(818) 227-1738

PAH/lrh

**JONES, DAY, REAVIS & POGUE**

555 WEST FIFTH STREET • SUITE 4600

LOS ANGELES, CALIFORNIA 90013-1025

TELEPHONE: 213-489-3939 • FACSIMILE: 213-243-2539

DIRECT DIAL NUMBER:

(213) 243-2368

[jrawls@jonesday.com](mailto:jrawls@jonesday.com)

JP005725:jt:1067600

069310-303200

June 8, 2000

**VIA FACSIMILE AND MAIL**

Carlo Noravian, Esq.  
Law Offices of Carlo Noravian  
500 N. Central Avenue  
Suite 940  
Glendale, CA 91203

**RE: Amazon Cosmetic and Tan Products/Amazon.com**

Dear Mr. Noravian:

On April 17, 2000, I wrote to you in response to claims that your client, Amazon Tan and Cosmetic Products ("Amazon Tan") has made against my client, Amazon.com, Inc. ("Amazon.com"). Your client had claimed that Amazon.com's sale of tanning and cosmetic products infringed Amazon Tan's alleged trademark rights in the terms "Amazon" and "Amazon Tan." In my letter, I explained Amazon.com's legal position; namely, that Amazon Tan – which did not begin operations until approximately mid-1999 – is infringing and diluting the famous AMAZON.COM<sup>®</sup> mark, which has been in use since 1995. Thus, I asked your client to cease and desist from all use of the marks "Amazon" and "Amazon Tan," and to cease operating its Web site from the Internet address <[amazontan.com](http://amazontan.com)>

Despite the passage of nearly two months, you have not responded to my letter. At the same time, however, your client has directed a series of belligerent communications to me and to Amazon.com. For example, on May 15, 2000, Amazon Tan's owner, Mr. Kalydjian, sent to Amazon.com's [copyright@amazon.com](mailto:copyright@amazon.com) email address a communication that stated, among other things, the following:

**"AMAZONCOSMETICS AND AMAZONTAN ARE MY TRADEMARKS AND YOU ARE THE CRIMINALS NOT ME!!!!!!!!!!!!!!!!!!!!!!!!!!!! . . . ONE DAY THIS CASE WILL END UP IN FRONT OF A JURY AND YOU WILL THEN UNDERSTAND YOU HURT THE WRONG COMPANY . . . HOW DARE YOU CALL ME A CRIMINAL."**

Today, Amazon.com received another email from Mr. Kalydjian, making the specious threat that he would take his "evidence" to the FBI if Amazon.com continues "infringing on my trademark rights."

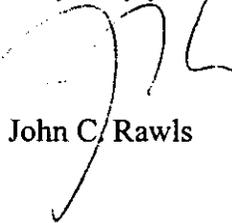
Carlo Noravian, Esq.  
June 8, 2000  
Page 2

Needless to say, this type of communication only makes it more difficult to settle this matter without litigation. If that is Amazon Tan's goal, please let us know, and we will take appropriate steps to protect Amazon.com's rights. However, if you have any interest in a reasonable, negotiated settlement, we ask for your cooperation with respect to the following:

- Please indicate whether or not you intend to respond to my April 17 letter, and whether you are interested in opening negotiations to resolve our differences in a professional and businesslike manner.
- Please indicate whether I am to communicate with you about this matter, or whether I should communicate directly with Mr. Kalydjian.
- Irrespective of your responses to the above, please instruct your client not to send any further emails or other communications to Amazon.com. Rather, all future communications regarding this matter should be directed to me, and should be in writing.

We hope that Amazon Tan will participate in civil communications aimed at a negotiated settlement. I look forward to your prompt response.

Very truly yours,



John C. Rawls

**JONES, DAY, REAVIS & POGUE**

555 WEST FIFTH STREET • SUITE 4600

LOS ANGELES, CALIFORNIA 90013-1025

TELEPHONE: 213-489-3939 • FACSIMILE: 213-243-2539

DIRECT DIAL NUMBER:

(213) 243-2368

jrawls@jonesday.com

JP005725:jt:1064646

069310-303200

April 17, 2000

**VIA FACSIMILE AND MAIL**

Carlo Noravian, Esq.  
Law Offices of Carlo Noravian  
500 N. Central Avenue  
Suite 940  
Glendale, CA 91203

**RE: Amazon Cosmetic and Tan products/Amazon.com**

Dear Mr. Noravian:

This will serve to follow up on my prior letter to you concerning the claims made by your client, Amazon Cosmetic and Tan products ("Amazon Tan"), against my client, Amazon.com, Inc. ("Amazon.com"). Please note that, although I have moved to another law firm since that time, I continue to represent Amazon.com in this matter.

Having now had an opportunity to review your client's claims in detail, we believe that there is no merit whatsoever to its contention that Amazon.com is infringing the alleged trademarks of Amazon Tan. Rather, the marks used by Amazon Tan infringe and dilute the famous AMAZON.COM<sup>®</sup> mark, which was both registered and broadly used in commerce well before your client adopted the "Amazon Tan" name. Amazon.com therefore demands that Amazon Tan immediately cease and desist from all use of the marks "Amazon," "Amazon Tan," "amazontan.com" and similar designations. In addition, Amazon.com demands that Amazon Tan immediately provide the information needed to determine the amount of compensation that will be required in connection with Amazon Tan's violations of Amazon.com's trademark and related rights to date.

You have stated that Amazon Tan offers a line of tanning and cosmetic products under the trademarks "Amazon" and "Amazon Tan," and that your client operates an Internet Web site under the name <amazontan.com.> Our investigation, however, indicates that Amazon Tan made no use of any of these marks prior to approximately mid-1999. For example, the records of Network Solutions, Inc. indicate that the <amazontan.com> domain name was not registered until July 22, 1999, and thus could not have been used as a Web site address prior to that date. Nor is there any indication, either in your letter or elsewhere, that Amazon Tan advertised or sold products under variations of the "Amazon" name prior to the establishment of the <amazontan.com> Web site. The records of the United States Patent and Trademark Office

Carlo Noravian, Esq.  
April 17, 2000  
Page 2

reveal no trademark registrations – and, indeed, no applications for trademark registrations – on behalf of Amazon Tan.

Your client's use of these marks is junior to the AMAZON.COM<sup>®</sup> mark. The AMAZON.COM<sup>®</sup> mark has been used in commerce continuously since April 1995, including as the address of Amazon.com's Internet Web site. It is well established that the first user of a mark has rights superior to those of any subsequent user of a confusingly similar designation. *Hydro-Dynamics, Inc. v. George Putnam & Co.*, 811 F.2d 1470, 1473 (Fed. Cir. 1987).

Moreover, the AMAZON.COM<sup>®</sup> mark was famous long before Amazon Tan began to use its variation on that name. By mid-1999, more than 10 million customers had purchased more than \$1 billion worth of goods through the Amazon.com Web site, the AMAZON.COM<sup>®</sup> mark had been heavily advertised, and the company, its products and its Web site had been the subject of extensive coverage in the news media. As such, the AMAZON.COM<sup>®</sup> mark is protected, pursuant to the Federal Trademark Dilution Act, against the use of similar marks – even if the junior use does not create any risk of consumer confusion and even if the junior user's products are not competitive with those of the senior user. *See* 15 U.S.C. §§ 1125(c) and 1127.

Finally, Amazon Tan is not excused from liability for trademark infringement and dilution under the theory that it began to use its marks on tanning and cosmetic products before Amazon.com used its senior mark on such products. First, because the AMAZON.COM<sup>®</sup> mark is extremely strong, it is entitled to extremely broad protection, even against junior uses on products that are not directly competitive with those sold under the AMAZON.COM<sup>®</sup> mark. *See, e.g., R.J. Reynolds Tobacco Co. v. R. Seelig & Hille*, 201 U.S.P.Q. 856 (T.T.A.B. 1978) (WINSTON cigarette mark infringed by junior use of SIR WINSTON mark in connection with tea product). Thus, your client's actions infringe the senior AMAZON.COM<sup>®</sup> mark even if its product offerings are distinguishable from those of Amazon.com. Second, because a dilution claim does not depend upon the existence of consumer confusion or competition between the senior and junior user, Amazon Tan's actions dilute the famous, senior AMAZON.COM<sup>®</sup> mark even if the products of Amazon Tan and Amazon.com are deemed to be unrelated. Third, Amazon.com was featuring health and beauty related products on its site well before your client commenced use of the name Amazon Tan.

In summary, Amazon Tan is infringing the AMAZON.COM<sup>®</sup> mark in violation of 15 U.S.C. § 1114, diluting that mark in violation of 15 U.S.C. §§ 1125(c) and 1127, and violating various state laws prohibiting unfair competition and false advertising. Moreover, your client's use of the <amazontan.com> domain name violates the recently enacted Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1051. The remedies available to Amazon.com for this illegal activity include disgorgement of any profits Amazon Tan has made on its "Amazon" products; recovery of Amazon.com's actual damages, attorneys' fees and costs; preliminary and permanent injunctive relief; and forfeiture of the <amazontan.com> domain name. Further, given the obviously willful nature of Amazon Tan's actions, Amazon.com may

Carlo Noravian, Esq.  
April 17, 2000  
Page 3

recover both punitive damages and "statutory" damages (of up to \$100,000) without proof of actual financial loss.

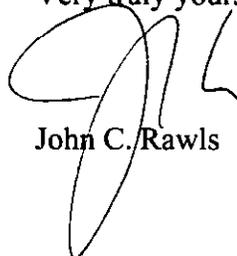
Amazon.com has instructed us to take all appropriate steps immediately to end Amazon Tan's illegal and extremely damaging conduct. By this letter, we offer Amazon Tan the chance to avoid the litigation that will be brought promptly if it does not voluntarily end these practices. Specifically, we demand that your client:

- Cease all use of the names and marks "Amazon," "Amazon Tan," "Amazon Cosmetic and Tan" and <amazontan.com,> and all other names and marks that are confusingly similar to the AMAZON.COM<sup>®</sup> mark (collectively, "Amazon Names");
- Identify all income Amazon Tan has obtained as a result of contacts with the <amazontan.com> Web site. This information must include the date and dollar volume of all revenue received or accrued and the identity of all products sold.
- Provide any information you have regarding the number of "hits," "impressions," "visits" and/or "sessions" the <amazontan.com> Web site has had, per month, since its inception.
- Confirm, in writing, that Amazon Tan will: (i) make no further use of the Amazon Names; (ii) immediately transfer registration of the <amazontan.com> domain name to Amazon.com; and (iii) not state, suggest or imply that Amazon Tan or its products, services or commercial activities originate or are affiliated with, or are sponsored or endorsed by, Amazon.com.

Upon receipt of such information and representations, Amazon.com will determine the amount of money that will be required to compensate for Amazon Tan's infringement of Amazon.com's rights. If Amazon Tan wishes to avoid litigation, all of the foregoing must be in our hands no later than fourteen days from the date of this letter.

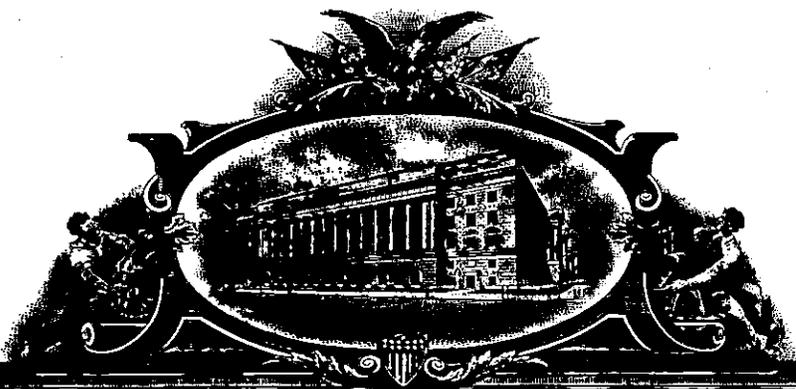
We shall expect Amazon Tan's prompt cooperation in ending the existing violations of Amazon.com's rights. Pending receipt of your response, please be advised that nothing contained in this letter is intended or should be construed as an admission or waiver of any rights that Amazon.com may have, all of which are hereby expressly reserved.

Very truly yours,



John C. Rawls

TP 215728



**THE UNITED STATES OF AMERICA**

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

March 20, 2000

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:**

**TRADEMARK APPLICATION: 75/770,523**

**FILING DATE: *September 02, 1999***



**By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS**

*L. Edelen*

**L. EDELEN  
Certifying Officer**

75770523 +

\*75770523\*

**FILING DATE**  
September 2, 1999

**ORIGINAL APPLICANT**  
Amazon.com, Inc.

**GOODS/SERVICES (CLASS 035)**  
retail store services; retail sales serv (ETC)

**FILING BASIS**  
ITU

**ORIGINAL CORRESPONDENT**  
c/o Heidi L. Sachs

ZSHOPS

ZSHOPS

PRINCIPAL

LAW OFFICE 103

*Rebecca L. Gilbert*

ATTORNEY ADVISOR: \_\_\_\_\_

75770523 +

Internet Transmission Date:

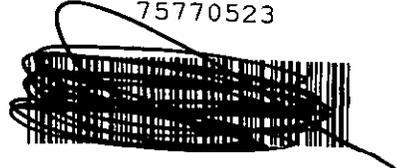
1999/09/02

Filing Date:

1999/09/02

Serial Number:

75770523



TRADEMARK APPLICATION

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

TOTAL FEES DUE: \$245

DEPOSIT ACCOUNT NUMBER: 500989

09/1999 FTAYLOR 00000043 500989 75770523  
FC:361 245.00 CH



NO OCR



09-02-1999

<SERIAL NUMBER> 75770523  
 <FILING DATE> 09/02/1999

<DOCUMENT INFORMATION>  
 <TRADEMARK/SERVICEMARK APPLICATION>  
 <VERSION 1.1>

## &lt;APPLICANT INFORMATION&gt;

<NAME> Amazon.com, Inc.  
 <STREET> Suite 1200,  
 <LN2> 1200 12th Ave. South  
 <CITY> Seattle  
 <STATE> WA  
 <COUNTRY> USA  
 <ZIP/POSTAL CODE> 98144-2734  
 <TELEPHONE NUMBER> (206) 266-1000  
 <FAX NUMBER> (206) 834-7010  
 <E MAIL ADDRESS> trademarks@amazon.com

## &lt;APPLICANT ENTITY INFORMATION&gt;

<CORPORATION: STATE/COUNTRY OF INCORPORATION> Delaware

## &lt;TRADEMARK/SERVICEMARK INFORMATION&gt;

<MARK> ZSHOPS  
 <TYPED FORM> Yes

\* Applicant requests registration of the above-identified trademark/service mark in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. §1051 et seq., as amended) for the following Class(es) and Goods and Services:  
 \*

## &lt;GOODS AND SERVICES&gt;

<INTERNATIONAL CLASS NUMBER> 035

<RECITATION OF GOODS AND/OR SERVICES> Retail store services; retail sales services provided by means of a global computer network; computerized searching, ordering and on-line retail and wholesale distributorship services featuring general merchandise and general consumer goods; providing access to on-line directories, indices and searchable databases relating to a variety of information and data available on a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing an on-line searchable database for the sale of goods and services of others; providing an on-line searchable ordering guide for locating, organizing and presenting goods and services of others; database aggregation, integration and management services; automated and computerized trading services; on-line trading services; providing classified advertising services; computer services, namely services to facilitate the sale of goods and services via the global electronic communications network; club memberships; association services, namely providing opportunities for exchange of information and conversation regarding a wide variety of topics by means of live events, mailed information, product reviews and interaction on a global computer

19990909000001

0000000 00000000 00000000

network; computer services, namely, providing multiple-user access to computer networks for the electronic transmission of various data, communication, documents and personal and professional information; searching and retrieving information, sites, and resources located on the global computer network; directory services to help locate people, places, organizations, phone numbers, network home pages, and electronic mail addresses; auction services; auctioneering; computer services, namely creating, managing and providing access to an online data base containing biographical information concerning subscribers and individuals and providing opportunities for interaction; providing information and interactive services in the fields of recruitment, employment, employment advertising, careers, lifestyle, resume creation, resume transmittals and responses thereto and resume matching services

**<FEE INFORMATION>**

**<TOTAL FEES PAID> 245**

**<NUMBER OF CLASSES> 1**

**<FILING BASIS INFORMATION>**

**<INTENT TO USE: SECTION 1(b)> Yes**

\* Applicant has a bona fide intention to use the mark in commerce on or in connection with the above identified goods/services (15 U.S.C. Section 1051(b), as amended). Applicant intends to use the mark on the goods, on labels or packaging for the goods, on displays associated with the goods, as a configuration of the goods, or in other ways customary in the trade; or for services in connection with the rendering or advertising of the services, or in other ways customary in the trade. \*

**<DEPOSIT ACCOUNT INFORMATION>**

**<DEPOSIT ACCOUNT NUMBER> 500989**

\* The U.S. Patent and Trademark Office is hereby authorized to charge any fees or credit any overpayments to the deposit account listed above. \*

**<NAME OF PERSON AUTHORIZING ACCOUNT ACTIVITY> Rebecca Watt**

**<COMPANY/FIRM NAME> Amazon.com, Inc.**

\* PTO-Application Declaration: The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. §1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true. \*

**<REQUIRED SIGNATURE AND OTHER INFORMATION>**

<SIGNATURE> /L Michelle Wilson/  
 <DATE SIGNED> 09/02/1999  
 <NAME> L. Michelle Wilson  
 <TITLE> Vice President, General Counsel

**<MAILING ADDRESS>**

<LINE> c/o Heidi L. Sachs  
 <LINE> Perkins Coie  
 <LINE> 1201 Third Ave., Suite 4800  
 <LINE> Seattle, Washington, USA  
 <LINE> 98101-3099

**<SERIAL NUMBER INFORMATION>**

<SERIAL NUMBER> 75/770523  
 <INTERNET TRANSMISSION DATE> Thursday, 09-02-1999 20:33:42 EDT  
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 487

1999090900003

**Drawing Page**

**Serial Number:**

75770523

**Applicant:**

Amazon.com, Inc.  
Suite 1200;  
1200 12th Ave. South  
Seattle WA USA 98144-2734

**Goods and Services:**

Retail store services; retail sales services provided by means of a global computer network; computerized searching, ordering and on-line retail and wholesale distributorship services featuring general merchandise and general consumer goods; providing access to on-line directories, indices and searchable databases relating to a variety of information and data available on a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing an on-line searchable database for the sale of goods and services of others; providing an on-line searchable ordering guide for locating, organizing and presenting goods and services of others; database aggregation, integration and management services; automated and computerized trading services; on-line trading services; providing classified advertising services; computer services, namely services to facilitate the sale of goods and services via the global electronic communications network; club memberships; association services, namely providing opportunities for exchange of information and conversation regarding a wide variety of topics by means of live events, mailed information, product reviews and interaction on a global computer network; computer services, namely, providing multiple-user access to computer networks for the electronic transmission of various data, communication, documents and personal and professional information; searching and retrieving information, sites, and resources located on the global computer network; directory services to help locate people, places, organizations, phone numbers, network home pages, and electronic mail addresses; auction services; auctioneering; computer services, namely creating, managing and providing access to an online data base containing biographical information concerning subscribers and individuals and providing opportunities for interaction; providing information and interactive services in the fields of recruitment, employment, employment advertising, careers, lifestyle, resume creation, resume transmittals and responses thereto and resume matching services

**Mark:**

ZSHOPS

OCR

09-02-1999

1999090900004

user: rlgilbert \*\*\*

Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
N/A	0	0	0:01	(z)[bi,ti]
N/A	0	0	0:01	(*shop*)[bi,ti]
6	7	7	0:01	1 and 2
0	1	1	0:01	z\$shop*[bi,ti]
3	6	6	0:01	*z\$shop*[bi,ti]
304	N/A	0	0:01	z[fm]
17	8	9	0:01	z[fm] and "035"[ic]
1	0	1	0:01	z[fm] and (a or b or "200")[ic]
22	10	12	0:01	z[fm] and ("042")[ic]
7	2	5	0:01	z[fm] and ("038")[ic]

started 1/18/00 4:14:54 PM  
finished 1/18/00 4:41:56 PM  
search duration 0:10 minutes  
Duration 27:02 minutes

NEAR limit= 1 ADJ limit= 1

**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

<b>SERIAL NO.</b> 57770523 Amazon.com, Inc.		<b>APPLICANT</b> 	<b>PAPER NO.</b>
<b>MARK</b> SHOPS DRESS Heidi L. Sachs Perkins Cole 201 Third Ave., Suite 4800 Seattle, Washington, USA 206-461-3099		<b>ACTION NO.</b> 01	<b>ADDRESS:</b> Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513  If no fees are enclosed, the address should include the words "Box Responses - No Fee."
		<b>MAILING DATE</b> 01/27/00	
		<b>REF. NO.</b>	
M PTO-1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE		Please provide in all correspondence: 1. Filing Date, serial number, mark and Applicant's name. 2. Mailing date of this Office action. 3. Examining Attorney's name and Law Office number. 4. Your telephone number and ZIP code.

**A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT.** For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

E: Serial Number: 75/770523

The assigned examining attorney has reviewed the referenced application and determined the following.

Likelihood of Confusion

The examining attorney refuses registration under Trademark Act Section 2(d), 15 U.S.C. Section 52(d), because the applicant's mark, when used in connection with the identified services, so resembles the marks in U.S. Registration Nos. 2,085,988; 2,137,425 and 2,257,026 as to be likely to cause confusion, to cause mistake, or to deceive. TMEP section 1207. See the enclosed registration.

The examining attorney must analyze each case in two steps to determine whether there is a likelihood of confusion. First, the examining attorney must look at the marks themselves for similarities in appearance, sound, connotation and commercial impression. *In re E. I. DuPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Second, the examining attorney must compare the goods or services to determine if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ

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823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

The services of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the services come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289 (Fed. Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

The dominant feature of each of the marks is Z. The marks are highly similar in sound, appearance and commercial impression. The applicant intends to use its mark in connection with advertising services and various other services relating to the sale of the goods of others, including computer services to facilitate the sale of goods and services via the global electronic communications network. The first cited registered mark is used in connection with the design and development of graphics arts and layouts for interactive computer communication and marketing networks for others. Such services are encompassed by the services in applicant's broad identification of advertising and computer services. The applicant also provides retail stores which are not limited in scope. The second two cited registrations are used in connection with retail stores which fall under the scope of applicant's broad identification. Therefore, the services are highly related and move in the same channels of trade. Due to the close relation between both the marks and the services, consumers are likely to be confused as to the source of the services.

#### Prior Pending Applications

The examining attorney encloses information regarding pending Application Serial Nos. 5684571; 75253248; 75613228; and 75284058. The filing dates of the referenced applications precede the applicant's filing date. There may be a likelihood of confusion between the marks under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). If either of the referenced applications matures into a registration, the examining attorney may refuse registration in this case under Section 2(d). 37 C.F.R. Section 2.83; TMEP section 1208.01.

Although the examining attorney has refused registration, the applicant may respond to the refusal to register by submitting evidence and arguments in support of registration. If the applicant chooses to respond to the refusal to register, the applicant must also respond to the following formalities.

#### Significance of Term

The applicant must indicate what significance the wording "Z" or ZSHOPS has in the relevant trade or industry or as applied to the services. 37 C.F.R. Section 2.61(b).

#### Recitation of Services

The recitation of services is unacceptable as indefinite and overly broad since the nature of the applicant's services is unclear and since the services span more than one class. The applicant may submit the following recitation if accurate:

Retail store services and on-line retail store services in the field of [indicate type of field, e.g. books, computer goods, department] (note that the applicant may not state "sales" as such is not a service for others); on-line retail store and wholesale distributorship services featuring computerized on-line search and ordering in the field of [INDICATE field or type of goods, e.g. books, computer goods]; on-line ordering services featuring [INDICATE field or type of goods]; providing an on-line computer database consisting of a searchable list of the goods and services of others, such database not being used for present retail sales; on-line retail store services featuring computerized on-line search databases, directories, indices and ordering guides of the goods of others in the field of [INDICATE field or type of goods, e.g. books, computer goods] (note this is from applicant's service relating to providing access to databases and from applicant's services relating to "providing an on-line searchable database/ordering guide...". The later services appear to be retail services rather than a mere search database); dissemination of advertising for others via an on-line electronic communications network; Providing an on-line searchable computer database featuring product and service information relating to the goods and services of others (if the applicant chooses this option, it should be clear that this is a mere database and not an ordering service); computerized database management (note that "aggregating and integration" are not appropriate since it is not clear whether such is a computer or a business service. For example, database management is in class 42); auctions provided via a global computer network; commercial information and directory agency and telephone directory information, namely, providing directory services to help locate people, places, organizations, phone numbers, network addresses, and electronic mail addresses; placing classified advertisements for others in a computerized magazine; promoting the goods and services of others by preparing and placing classified advertisements in an electronic magazine accessed through a global computer network (the last two applications are from applicant's "providing classified advertising services, computer services, namely services to facilitate the sale of goods and services via the global electronic communications network". It is not clear what the nature of such services are. The examining office assumes these are both advertising services. The applicant must specify the common commercial name of the services); buying clubs (the applicant must specify the common commercial name of "club memberships" since "membership" is ambiguous, noting that buying clubs are in class 35, however, other clubs are in differing classes depending upon the nature of the club, e.g. automobile clubs are in class 42), auctioning, in Class 35.

Trading services and computerized-trading services provided on line over a global computer network must specify the type of trading, e.g. what is traded, noting that the classification will depend upon the goods traded, e.g. commodity trading for others must be placed in class 36);

Electronic communications services, namely, providing multiple-user access to a global computer network, in Class 38. (This service comes from "providing access to". Note that this service requires physical connections. This would be a service akin to AOL. The service is considered a communications service, not a computer service. The applicant should delete all references to the type of information transmitted if the applicant chooses this physical connection service).

Electronic communications services, namely, providing multiple-user access to a global computer network, in Class 38. (This service comes from "computer services, namely, providing access to computer networks for the electronic transmission of various data, information, and professional information". Note that this refers only to the actual transmission of data. This would be a service akin to AOL. The service is considered a

6/70523

Retail store services and on-line retail store services in the field of [indicate type of field, e.g. books, computer goods, department] (note that the applicant may not state "sales" as such is not a service for others); on-line retail store and wholesale distributorship services featuring computerized on line search and ordering in the field of [INDICATE field or type of goods, e.g. books, computer goods]; on-line ordering services featuring [INDICATE field or type of goods]; providing an on-line computer database consisting of a searchable list of the goods and services of others, such database not being used for present retail sales; on-line retail store services featuring computerized on line search databases, directories, indices and ordering guides of the goods of others in the field of [INDICATE field or type of goods, e.g. books, computer goods] (note this is from applicant's service relating to providing access to databases and from applicant's services relating to "providing an on-line searchable database/ordering guide...". The later services appear to be retail services rather than a mere search database ); dissemination of advertising for others via an on-line electronic communications network; Providing an on-line searchable computer database featuring product and service information relating to the goods and services of others (if the applicant chooses this option, it should be clear that this is a mere database and not an ordering service); computerized database management (note that "aggregating and integration" are not acceptable since it is not clear whether such is a computer or a business service. For example, database development is in class 42); auctions provided via a global computer network; commercial information and directory agency and telephone directory information, namely, providing directory services to help locate people, places, organizations, phone numbers, network home pages, and electronic mail addresses; placing classified advertisements for others in a newspaper; Promoting the goods and services of others by preparing and placing classified advertisements in an electronic magazine accessed through a global computer network (the last two identifications are from applicant's "providing classified advertising services, computer services, namely services to facilitate the sale of goods and services via the global electronic communications network" It is not clear what the nature of such services are. The examining attorney assumes these are both advertising services. The applicant must specify the common commercial name of the services); buying clubs (the applicant must specify the common commercial name of "club memberships" since "membership" is ambiguous, noting that buying clubs are in class 35, however, other clubs are in differing classes depending upon the nature of the clubs, e.g. automobile clubs are in class 42), auctioning, in Class 35.

Automated and computerized trading services provided on line over a global computer network, namely, [specify the type of trading, e.g. what is traded, noting that the classification will depend upon the items traded, e.g. commodity trading for others must be placed in class 36);

Telecommunications services, namely, providing multiple-user access to a global computer information network, in Class 38. (This service comes from "providing access to". Note that this refers only to the actual physical connections. This would be a service akin to AOL. The service is considered a telecommunications service, not a computer service. The applicant should delete all references to the type of information transmitted if the applicant chooses this physical connection service.)

Telecommunications services, namely, providing multiple-user access to a global computer information network, in Class 38. (This service comes from "computer services, namely, providing multiple user access to computer networks for the electronic transmission of various data, documents and personal and professional information". Note that this refers only to the actual physical connections. This would be a service akin to AOL. The service is considered a

telecommunications service, not a computer service. The applicant should delete all references to the type of information transmitted if the applicant chooses this physical connection service.)

Providing on-line chat rooms for transmission of messages among computer users concerning [indicate field or subject of chat room, e.g. product reviews]; Providing on-line electronic bulletin boards for transmission of messages among computer users concerning [indicate field or subject of bulletin board, e.g. product reviews], in Class 38. (note that this identification stems from applicant's "association services", which appear not to be association services. Association services are class 42 services relating to promoting the interests of specified groups.)

Providing on-line chat rooms and electronic bulletin boards for transmission of messages among computer users concerning biographical information of such users, in Class 38 (note that this identification stems from applicants "computer services, namely, creating, managing and providing access to an online data base containing biographical information concerning subscribers and individuals and providing opportunities for interaction, which appears to be chat room and bulletin board services. If the service is a dating service, the applicant may state: dating services, namely providing an online database featuring biographical information of subscribers for use in selecting a date. Such service must be placed in class 42)

Computer services, namely, providing search engines for obtaining data from on-line directories, indices and searchable databases on a global computer network (note that this is from applicant's "providing access"); computer services, namely, providing search engines for obtaining data on a global computer network (note that this service stems from "searching and retrieving..."), in class 42.

Regarding "providing information and interactive services in the fields of recruitment, employment, employment advertising, careers, lifestyle, resume creation, resume transmittal and response thereto and resume matching services", the language is broad and ambiguous. The applicant must specify the common commercial name of the services, e.g. "employment agencies, employment counseling and recruiting, in class 35" or "testing to determine employment skills, resume preparation, in class 42".

Please note that, while an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09. Therefore, the applicant may not amend to include any services that are not within the scope of the services recited in the present identification.

The Trademark Acceptable Identification of Goods and Services Manual can be found on the world wide web at: <http://www.uspto.gov/web/offices/tac/doc/gsmmanual/>

Classification

If the applicant adopts the suggested amendment to the identification of services, the applicant must amend the classification to the International Classes noted. 37 C.F.R. Sections 2.33(a)(1)(vi) and 2.85; TMEP sections 805 and 1401.

Additional Classes

If the applicant prosecutes this application as a combined, or multiple-class, application, the applicant must comply with each of the following.

- (1) The applicant must list the services by international class with the classes listed in ascending numerical order. TMEP section 1113.01.
- (2) The applicant must submit a filing fee for each international class of services not covered by the fee already paid. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01. Effective January 10, 2000, the fee for filing a trademark application is \$325 for each class. This applies to classes added to pending applications as well as to new applications filed on or after that date.

Requirement for Information

The nature of the service is not clear from the present record. In order to allow proper identification of the services in connection with which the applicant intends to use the mark, the applicant must submit samples of advertisements or promotional materials for services of the same type. If such materials are not available, the applicant must describe the nature, purpose and channels of trade of the services with which the applicant has asserted a bona fide intent to use the mark. 37 C.F.R. Section 2.61(b); TMEP sections 1103.04 and 1105.02.

Fee Notice

Effective January 10, 2000, the following trademark filing fees increased:

37 C.F.R Section	Description of Paper Filed	Old Fee Amount	New Fee Amount (effective 1/10/2000)
2.6(a)(1)	Application for Registration, per class	\$245	\$325
2.6(a)(4)	Request for Extension of time for filing Statement of Use, per class	\$100	\$150
2.6(a)(5)	Application for Renewal, per class	\$300	\$400
2.6(a)(13)	Filing Section 15 Affidavit, per class	\$100	\$200
2.6(a)(16)	Petition for Cancellation, per class	\$200	\$300
2.6(a)(17)	Notice of Opposition, per class	\$200	\$300

See notices at 64 FR 67774 (Dec. 3, 1999) and 1229 TMOG 12 (Dec. 7, 1999).

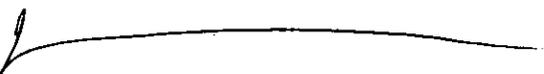
NOTE: The Trademark Office is committed to improving the quality of our service. The Assistant Commissioner for Trademarks would like to have your comments and suggestions on ways we can improve the quality of the examination process. In the event there are any areas causing you recurrent problems, please let us know of them.

COMMENTS SHOULD NOT BE INCLUDED WITH THE RESPONSE TO AN OFFICE ACTION, BUT SHOULD BE SENT IN A SEPARATE COMMUNICATION TO THE FOLLOWING ADDRESS:

Office of Trademark Quality Review  
c/o Commissioner of Patents and Trademarks  
Washington, DC 20231.

Please note that this address differs from the mailing address for the response to this Office action.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney. If the applicant has questions regarding the status of the application, the applicant should telephone the status line at 703-305-8747.

  
Rebecca L. Gilbert  
Trademark Attorney  
Law Office 113  
(703) 308-9103, ext. 119

User: rrgilbert \*\*\* Serial Number: 75165575 \*\*\* 1/18/00 4:44:50 PM \*\*\*



Z

ds and Services

IC 035. US 100 101 102. G & S: computer consultation in the field of interactive multimedia; design of interactive computer software for others; design and development of graphic arts and layouts for interactive computer communication and marketing networks for others. FIRST USE: 19960710. FIRST USE IN COMMERCE: 19960710

Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

gn Code

260901

al Number

75165575

g Date

September 13, 1996

ication for Opposition Date

May 13, 1997

tration Number

2085988

tration Date

August 5, 1997

Name and Address

(REGISTRANT) Zillion Group, Inc. CORPORATION CALIFORNIA 508 Valley Way  
Milpitas CALIFORNIA 95035

areh: 7 \*\*\* Document Number: 11 \*\*\*

(cont)

User: rgilbert

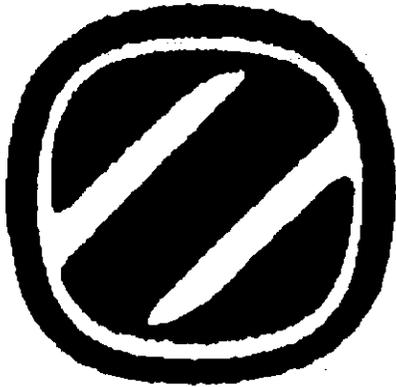
\*\*\* Serial Number: 75165575 \*\*\*

Type of Mark  
SERVICE MARK

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

User: rgilbert \*\*\* Serial Number: 75263874 \*\*\* 1/18/00 4:44:50 PM \*\*\*



Mark  
Z

Pseudo-Mark  
Z

Goods and Services

IC 035. US 100 101 102. G & S: retail stores featuring men's clothing, accessories and toiletries. FIRST USE: 19900000. FIRST USE IN COMMERCE: 19900000

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260321

Serial Number

75263874

Registration Date

March 25, 1997

Expiration Date for Opposition Date

November 25, 1997

Registration Number

2137425

Registration Date

February 17, 1998

Registrant Name and Address

(REGISTRANT) Ermenegildo Zegna Corporation CORPORATION NEW YORK 100 West Forest Avenue, Unit A Englewood NEW JERSEY 07631

Classification of Mark

SERVICE MARK

Search: 7 \*\*\* Document Number: 9 \*\*\*

(cont)

User: rgilbert

\*\*\* Serial Number: 75263874 \*\*\*

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

\*\* User: rgilbert \*\*\* Serial Number: 75474511 \*\*\* 1/18/00 4:44:50 PM \*\*\*



Mark

Z

Goods and Services

IC 035. US 100 101 102. G & S: Retail store services in the furniture and home accessories fields. FIRST USE: 19940100. FIRST USE IN COMMERCE: 19940100

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260301

Serial Number

75474511

Filing Date

April 27, 1998

Publication for Opposition Date

April 6, 1999

Registration Number

2257026

Registration Date

June 29, 1999

\*\*\* Search: 7 \*\*\* Document Number: 8 \*\*\*

(cont)

\*\* User: rgilbert \*\*\* Serial Number: 75474511 \*\*\*

Owner Name and Address

(REGISTRANT) Mark Zeff Consulting Group, Inc. CORPORATION NEW YORK 260  
West 72th Street, Suite 12B New York NEW YORK 10023

Type of Mark

SERVICE MARK

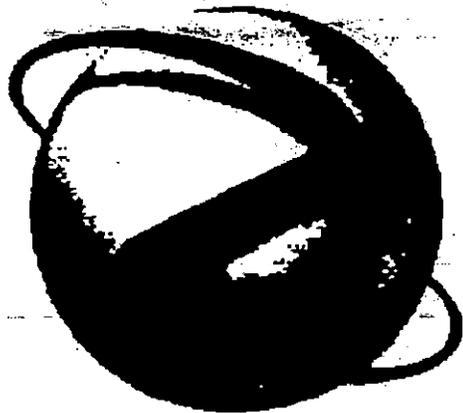
Register

PRINCIPAL

Live Dead Indicator

LIVE

\*\* User: rgilbert \*\*\* Serial Number: 75684571 \*\*\* 1/18/00 4:44:50 PM \*\*\*



Mark

Z

Goods and Services

IC 042. US 100 101. G & S: COMPUTER RELATED SERVICES, NAMELY WEB DESIGN, HOSTING WEB SITES, E-COMMERCE AND TRANSACTING BUSINESS OVER THE INTERNET, PROVIDING INTERNET SOLUTIONS, AND SEARCH ENGINE PLACEMENT. FIRST USE: 19981000. FIRST USE IN COMMERCE: 19990100

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

010725

Serial Number

75684571

Filing Date

April 15, 1999

Owner Name and Address

(APPLICANT) Z Net Solutions, LLC LIMITED LIABILITY COMPANY OREGON 700 NW Hill Street Bend OREGON 97701

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

\*\*\* Search: 9 \*\*\* Document Number: 2 \*\*\*

\*\* User: rgilbert \*\*\* Serial Number: 75253248 \*\*\* 1/18/00 4:44:50 PM \*\*\*



Mark

Z

Goods and Services

IC 035. US 100 101 102. G & S: advertising agency services. FIRST USE:  
19970101. FIRST USE IN COMMERCE: 19970101

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260102

Serial Number

75253248

Filing Date

March 7, 1997

Owner Name and Address

(APPLICANT) Zero Base Advertising, Inc. CORPORATION OHIO 6209 Riverside  
Drive Dublin OHIO 43017

Type of Mark

SERVICE MARK

Register

PRINCIPAL

Live Dead Indicator

LIVE

\*\*\* Search: 7 \*\*\* Document Number: 10 \*\*\*



Mark

Z

Pseudo Mark

Z

Goods and Services

IC 035. US 100 101 102. G & S: Business Consulting, Management Consulting, Marketing Consulting, Public Relations Consulting, Advertising Services, Design Services such as corporate identities and collateral elements. FIRST USE: 19930600. FIRST USE IN COMMERCE: 19930600

Mark Drawing Code

(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number

75613228

Filing Date

December 29, 1998

Owner Name and Address

(APPLICANT) Zeesman Communications, Inc. CORPORATION CALIFORNIA 5839 Green Valley Circle, Suite 208 Culver City CALIFORNIA 90230

Description of Mark

Company Logo; a script "Z" with and without drop shadow \* Purple "Z" with a gray drop shadow when printed 2-color \* Purple "Z" with a screened

\*\*\* User: rgilbert \*\*\* Serial Number: 75613228 \*\*\*

purple shadow when printed only 1-color Z as shown on the "label"  
specimen (enclosed with this package.) \* Purple or Black "Z" without drop  
shadow

Type of Mark  
SERVICE MARK

Register  
PRINCIPAL

Live Dead Indicator  
LIVE

\*\* User: rgilbert \*\*\* Serial Number: 75284058 \*\*\* 1/18/00 4:44:49 PM \*\*\*



Mark

Z

Goods and Services

IC 035. US 100 101 102. G & S: dissemination of advertising matter

Mark Drawing Code

(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Code

260121

Serial Number

75284058.

Filing Date

April 30, 1997

Filed ITU

FILED AS ITU

Publication for Opposition Date

January 11, 2000

Owner Name and Address

(APPLICANT) Zurich Insurance Company CORPORATION SWITZERLAND 1400  
American Lane Schaumburg ILLINOIS 60196

Assignment Recorded

ASSIGNMENT RECORDED

Section 44 Indicator

SECT44

Priority Date

February 21, 1997

\*\*\* Search: 7 \*\*\* Document Number: 1 \*\*\*

(cont)

\*\*\* User: rgilbert \*\*\* Serial Number: 75284058 \*\*\*

Prior Registration(s)  
1823174

Type of Mark  
SERVICE MARK

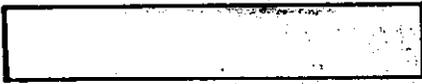
Register  
PRINCIPAL

Live Dead Indicator  
LIVE

\*\*\* Search: 7 \*\*\* Document Number: 1 \*\*\*



75770523



TRADEMARK



75770523



JAN 07 2000

LAW OFFICE 118

~~RECEIVED~~  
DEC 30 1999  
LAW OFFICE 118

**CONTENTS**

Entry	Date	Initials
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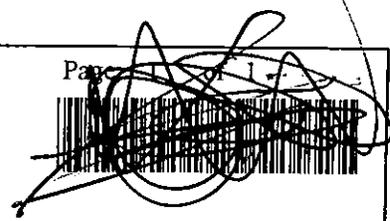
See inside of file for additional entries.

# CONTENTS CONTINUED

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ORDER NUMBER	215727
REFERENCE ORDER NUMBER	0
BIN NUMBER	910

Page 1 of 1



**DELIVERY INSTRUCTIONS**

ORDER DATE/TIME	PALM NUMBER	CUSTOMER NUMBER	CONTACT PHONE NUMBER	PAYMENT METHOD	TOTAL COST OF ORDER
2000-02-22 12:53:00		IDON337524		CREDIT CARD	\$ 50.00

**BROADCAST MESSAGE**

Our Customer Service staff is available to assist you during the hours of 8:30 a.m. to 8:00 p.m. EST, Monday through Friday. Please call (703) 308-9700 or toll free 1-800-972-6382.

**ORDER INFORMATION**

ORDER LINE	PRODUCT TYPE	DOCUMENT IDENTIFIER	U.S. COPIES	STATUS	CUSTOMER REFERENCE
1	CCI	75662416	1	RELEASED	



**E-MAIL**

**FAX NUMBER**

**CARRIER**  
FEDERAL EXPRESS

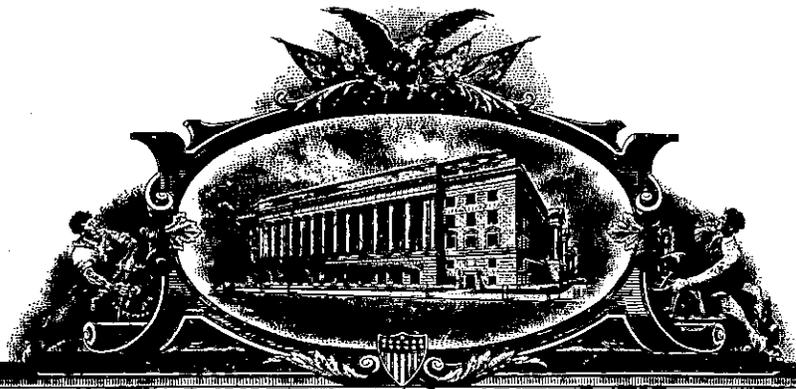
**CARRIER TRACKING NUMBER**

**CARRIER ACCOUNT NUMBER**  
2061-2373-4

**FROM:** U.S. Patent and Trademark Office  
Box 9  
Washington, DC 20231

**TO:** TRADEMARK CENTER  
ATTN: MATTHEW J. COHEN  
21550 OXNARD ST.  
SUITE 300  
WOOLAND HILLS, CA 91367  
USA

TP 215727



**THE UNITED STATES OF AMERICA**

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

March 21, 2000

THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:

TRADEMARK APPLICATION: 75/662,416

FILING DATE: *March 17, 1999*



By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS

*T. Wallace*  
T. WALLACE  
Certifying Officer

75-662416



TYPED DRAWING

AMAZON.COM

ITU

LAW OFFICE 103

PRINCIPAL

ATTORNEY ADVISOR: \_\_\_\_\_

D. LOBO

75662416

TRADEMARK APPLICATION SERIAL NO. \_\_\_\_\_

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

3/26/1999 NSHRBAZZ 00000084 75662416

FC:361

245.00 DP ✓

1999040200001

PERKINS COIE LLP

1201 THIRD AVENUE, 48<sup>TH</sup> FLOOR · SEATTLE, WASHINGTON 98101-3099

TELEPHONE: 206 583-8888 · FACSIMILE: 206 583-8500

March 17, 1999

**VIA U.S. EXPRESS MAIL**

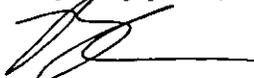
Assistant Commissioner for Trademarks  
U.S. Patent & Trademark Office  
BOX NEW APP./FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

**Re: Application for Service Mark Registration**  
**Mark: AMAZON.COM**  
**Class: 35**  
**Applicant: Amazon.com, Inc.**

Assistant Commissioner:

Enclosed for filing is an intent-to-use application to register the mark indicated above on the Principal Register, together with \$245 to cover the filing fee.

Very truly yours,



Brent D. Sanders

SDB:rfw  
Enclosures

cc: Amazon.com, Inc.  
Rebecca Watt, Paralegal

[24976-0003/SL990760.032]

M 0001\35\CO  
18E:37 10



12-03-1999

U.S. Patent & TMO/TM Mail Rept Dc #31

# PERKINS COIE LLP.

1201 THIRD AVENUE, SUITE 4800 · SEATTLE, WASHINGTON 98101-3099  
TELEPHONE: 206 583-8888 · FACSIMILE: 206 583-8500

HEIDI L. SACHS  
(206) 583-8506  
sachh@perkinscoie.com

December 2, 1999

**VIA U.S. EXPRESS MAIL**

Ms. Deborah E. Lobo  
Law Office 112  
U.S. Patent & Trademark Office  
BOX RESPONSES FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

RECEIVED  
1999 DEC 10 A 10:48  
TMO  
LAW OFFICE 112

Re: Applicant: Amazon.com, Inc.  
Serial No.: 75/662416  
Mark: AMAZON.COM  
Our Reference No. 24976-3

Dear Ms. Lobo:

Enclosed is Applicant's Response to Office Action No. 1, together with our firm check in the amount of \$980.00 for the additional filing fees for four additional classes. The Assistant Commissioner is authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-0665.

Very truly yours,  
*Heidi Sachs*  
Heidi L. Sachs

HLS:sfr  
Enclosures

cc: Amazon.com, Inc.  
Susan F. Rambin, Paralegal

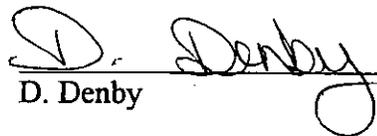
[24976-0003/SL993360.215]

1999040200002

**CERTIFICATE OF MAILING**

I CERTIFY that on March 17, 1999, I mailed (via U.S. Express Mail #EM334460273 US) the attached Intent-to-Use Application regarding the mark "AMAZON.COM" in International Class 35 to:

Assistant Commissioner for Trademarks  
U. S. Patent & Trademark Office  
BOX NEW APP / FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
D. Denby

1 999040200006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
INTENT TO USE APPLICATION FOR SERVICE MARK REGISTRATION  
ON THE PRINCIPAL REGISTER

Mark: AMAZON.COM

International  
Class No.: 35

Assistant Commissioner for Trademarks  
Arlington, Virginia 22202-3513

Amazon.com, Inc., a Delaware corporation  
P.O. Box 81226  
Seattle, Washington 98108-1226

The above-identified applicant has a bona fide intent to use the service mark shown in the accompanying drawing in connection with the following services:

Retail store services; retail sales services provided by means of a global computer network; computerized (searching) ordering and on-line retail and wholesale distributorship services featuring general merchandise and general consumer goods; providing (access) to on-line directories, indices and (searchable databases) relating to a variety of information and data available on a global computer network; dissemination of advertising for others via an on-line electronic communications network; (providing an on-line searchable database for the sale of goods and services of others); providing an on-line searchable ordering guide for locating, organizing and presenting goods and services of other on-line vendors; database aggregation, integration and management services;

Association services, namely providing opportunities for exchange of information and conversation regarding a wide variety of topics by means of live events, mailed information,

product reviews and interaction on a global computer network; (providing an interactive computer database featuring automatically updating address book, personal planner, date reminder, travel planner, and alumni and professional group links, via a global computer network) providing on-line interactive computer software for managing, viewing and editing information such as event scheduling, address books, and other personal and professional contact information; computer services, namely, providing multiple-user access to computer networks for the/electronic transmission of various data, communications, documents and personal and professional information) searching and retrieving information, sites, and resources located on computer networks for others) providing a wide range of general interest information via a computer network; )directory services to help locate people, places, organizations, phone numbers, network home pages, and electronic mail addresses)

and requests that said mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946, as amended.

The applicant has a bona fide intention to use the mark in ✓commerce in connection with the above identified goods and services (15 U.S.C. §§ 1051(b), as amended). The applicant has a bona fide intention to use the mark on labels affixed to the goods, on packaging containing the goods, on display signs at the point of sale, in connection with a Web site, brochures, advertising, letterhead, business cards and in other ways customary in the trade.

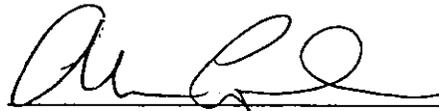
The undersigned hereby appoints the law firm of Perkins Coie LLP through Heidi L. Sachs, Robert C. Cumbow, Traci A. Sammeth, Tara L. Benson, Brent D. Sanders, Erika J. Starrs and Catherine Tran, 1201 Third Avenue, 40th Floor, Seattle, Washington 98101-3099, (206) 583-8888, to prosecute this registration application with full power of substitution and revocation, to make alterations and amendments, to transact all business in the United States Patent and Trademark Office and to receive the notice of allowance and the certificate of registration.

\*\*\*

DECLARATION

Alan Caplan, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that: he is the Vice President and General Counsel of the applicant corporation and authorized to execute this instrument; he believes applicant is entitled to use in commerce the service mark sought to be registered; to the best of his knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce in connection with the same or similar services, either in the identical form or in such near resemblance thereto as to be likely, when applied to the services of such other person, to cause confusion, or to cause mistake, or to deceive; the facts set forth in this application are true; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

EXECUTED at Seattle, Washington, this 16<sup>th</sup> day of March, 1999.



Alan Caplan  
Vice President and General Counsel  
Amazon.com, Inc.

1999040200004

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

1 999040200005

<b>SERIAL NO.</b> 75/662416 Amazon.com, Inc		<b>APPLICANT</b>	<b>PAPER NO.</b>
<b>MARK</b> AMAZON.COM			
<b>ADDRESS</b> BRENT D. SANDERS PERKINS COIE LLP 1201 THIRD AVENUE 40TH FLOOR SEATTLE, WASHINGTON 98101-3099		<b>ACTION NO.</b> 01	<b>ADDRESS:</b> Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513  If no fees are enclosed, the address should include the words "Box Responses - No Fee."
		<b>MAILING DATE</b> 09/20/99	
		<b>REF. NO.</b>	
FORM PTO-1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE		<b>Please provide in all correspondence:</b> <ol style="list-style-type: none"><li>1. Filing Date, serial number, mark and Applicant's name.</li><li>2. Mailing date of this Office action.</li><li>3. Examining Attorney's name and Law Office number.</li><li>4. Your telephone number and ZIP code.</li></ol>

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/662416 AMAZON.COM

**FIRST OFFICE ACTION**

The assigned examining attorney has reviewed the referenced application and determined the following.

**I. SEARCH RESULTS**

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

**II. INFORMALITIES**

**Recitation of Services**

The recitation of services is too broad, indefinite or requires clarification. In amending the recitation, the applicant must use the common commercial names for the services, be as complete

and specific as possible and avoid the use of indefinite words and phrases. In all cases, the applicant must specify exactly what services it is performing for others and (if accurate) the field or channel of trades.

The applicant must specify the field of goods for all the identified "retail" services. Use of the term "sale(s)" in the recitation of services is unacceptable since it does not identify a service that is provided for the benefit of others as contemplated by the Trademark Act. The activity of "selling" only benefits the seller. The applicant must amend the recitation to describe the specific service that is provided for others, for example, if the applicant is providing a retail store service, the applicant may amend the application to so indicate this.

The term "access" in the recitation is reserved for those services provided by Internet Service Providers (ISPs), such as Erol's, Mindspring, MCI, AT&T, etc. that provide the computer connection that enables a computer user to access the databases and home pages of others via the global computer network. These entities are considered "link providers" and the service is "providing multiple-user access to a global computer network" in Class 38. Entities that provide the informational or substantive content of a website and/or home page are considered "content providers." The service of providing information by means of a global computer network is classified in the class of the information subject. If an entity provides information in a wide variety of fields, the applicant must select the subject matter to be protected and classify them accordingly (e.g., banking information in Class 36, business information in Class 35, home repair information in Class 37, etc.).

The applicant must specify the field or subject matter of the "directories." The classification for the on-line directories may vary depending on the nature of the specified subject matter. Similarly, the applicant must indicate the specific field (see explanation provided above) of the on-line computer database. Classification will depend upon the specified field.

The wording "providing an on-line searchable ordering guide for locating, organizing and presenting goods and services of other on-line vendors" does not identify a specific service. The applicant must describe the specific activity underlying the service provided. If the applicant is providing a "search engine" service, the service is Class 42. If the applicant is providing an "ordering" service, the service is Class 35. If the underlying service is an "advertising" service, the service is Class 35.

The reference to "database aggregation and integration" is ambiguous. The applicant must explain the exact nature and purpose of this service or delete this reference from the recitation.

The following is an acceptable format for International Class 35 services:

International Class 35: Retail store services featuring [indicate field of goods]; computerized on-line retail services in the field of [indicate specific field]; computerized on-line ordering featuring general merchandise and general consumer goods; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing and searchable on-line database featuring goods and services of others in the field of [indicate specific field]; providing an searchable on-line

advertising guide featuring the goods and service of other on-line vendors; and database management services.

"Association services" are classified in Class 42. The applicant must indicate the specific group whose interests it is promoting. The "interactive computer software" is classified in Class 9. The applicant must indicate if the software is "downloadable." If the applicant is providing temporary use of the software, this service is classified in Class 42. The wording providing "opportunities for exchange of information and conversation regarding a wide variety of topics by means of live events, mailed information, product reviews and interaction on the global computer network" is indefinite because "opportunities" does not describe a specific service. Moreover, this wording could include services classified in other classes. The wording "wide variety of topics" is no longer accepted by the Office, the applicant must indicate the specific field(s) of information. The applicant must list specific types of "live events", e.g., live musical concerts (IC 41). The applicant must indicate the specific nature of the "mail information" service, e.g., "preparing mail lists" (IC 35). "Product reviews" is indefinite. The applicant must indicate the specific service provided in connection with the "product reviews." "Interaction" is indefinite. If the applicant is referring to providing a "chat room", the applicant must amend the recitation to so indicate. Database services are classified according to the subject of the database.

The applicant must specify the means by which the "electronic transmission of various data, communications, documents and personal and professional information" is provided and indicate the more specifically the form of the "communications." For example: electronic transmission of data and documents concerning personal and professional information via computer terminals. (IC 38). If the wording "searching and retrieving information, sites, and resources located on computer networks of others" refers to a search engine service, the applicant must amend the recitation to so indicate. Directory services for telephone numbers and addresses is a Class 35 service.

International Class 9: Downloadable computer software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information.

International Class 35: Computer services, namely, providing directories for telephone numbers, business addresses, electronic mail addresses, network home page addresses, addresses and telephone numbers of people, places and organizations.

International Class 38: Providing multiple-user access to a global computer network; providing on-line interactive chat room for transmission of messages among computer users concerning [indicate field or subject of chat room] on a global computer network; electronic transmission of data and documents concerning personal and professional information via computer terminals.

International Class 39: Providing an interactive database featuring an automatically updating travel planner.

International Class 42: Association services, namely, promoting the interests of [indicate specific group, e.g. mathematicians, skydivers, authors]; providing an interactive database featuring automatically updating address book, personal planner, date reminder and alumni and professional group links all via a global computer network; providing temporary use of on-line

non-downloadable software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information; computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network;

Please note that, while an application may be amended to clarify or limit the recitation, additions to the recitation are not permitted. 37 C.F.R. Section 2.71(b); TMEP section 804.09. Therefore, the applicant may not amend to include any goods or services that are not within the scope of the goods and services recited in the present identification.

The applicant may wish to consult the on-line identification manual on the PTO homepage for a searchable database of acceptable identifications for goods and services. The manual is available at: <http://www.uspto.gov/web/offices/tac/doc/gsmmanual>.

#### **Fees & Requirement for Adding Class(es)**

The application identifies goods and/or services that may be classified in one or more than one international class not covered by the present filing fee. Therefore, the applicant must either: (1) restrict the application to the number of classes covered by the fee already paid, or (2) comply with the requirements for adding the additional class(es). [See below] 37 C.F.R. Section 2.86(b); TMEP sections 810.01 and 1113.01.

If the applicant adds any additional classes, the applicant must comply with each of the following:

(1) The applicant must list the good/services by international class with the classes listed in ascending numerical order. TMEP section 1113.01.

(2) The applicant must submit a filing fee for each international class of goods/services not covered by the fee already paid. Effective December 3, 1993, the filing fee is \$245.00 per class. 37 C.F.R. Sections 2.6(a)(1) and 2.86(b); TMEP sections 810.01 and 1113.01.

#### **III. RESPONSE GUIDELINES**

No set form is required for response to this Office action. The applicant must respond to each point raised. The applicant should simply set forth the required changes or statements and request that the Office enter them. The applicant must sign the response. In addition to the identifying information required at the beginning of this letter, the applicant should provide a telephone number to speed up further processing.

In all correspondence to the Patent and Trademark Office, the applicant should list the name and law office of the examining attorney, the serial number of this application, the mailing date of this Office action, and the applicant's telephone number.

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.

75/662416

-5-

*Deborah E. Lobo*  
Deborah E. Lobo  
Trademark Examining Attorney  
Law Office 112

Telephone: 703-308-9112 Ext. 133

Certificate of Mailing: To avoid lateness due to mail delay, the applicant should add the following certificate to the response to the Office action, retaining a photocopy of the response with the completed certificate in case the response becomes lost.

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on \_\_\_\_\_  
(Date)

\_\_\_\_\_  
(Signature)

\_\_\_\_\_  
(Typed or printed name of the person signing the certificate)

03-17-1999

U.S. Patent & TMOte/TM Mail Rcpt Dt. #70

Applicant: Amazon.com, Inc.  
Address: P.O. Box 81226  
Seattle, Washington 98108-0387

Services: Retail store services; retail sales services provided by means of a global computer network; computerized searching, ordering and on-line retail and wholesale distributorship services featuring general merchandise and general consumer goods; providing access to on-line directories, indices and searchable databases relating to a variety of information and data available on a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing an on-line searchable database for the sale of goods and services of others; providing an on-line searchable ordering guide for locating, organizing and presenting goods and services of other on-line vendors; database aggregation, integration and management services; Association services, namely providing opportunities for exchange of information and conversation regarding a wide variety of topics by means of live events, mailed information, product reviews and interaction on a global computer network; providing an interactive computer database featuring automatically updating address book, personal planner, date reminder, travel planner, and alumni and professional group links, via a global computer network; providing on-line interactive computer software for managing, viewing and editing information such as event scheduling, address books, and other personal and professional contact information; computer services, namely, providing multiple-user access to computer networks for the electronic transmission of various data, communications, documents and personal and professional information; searching and retrieving information, sites, and resources located on computer networks for others; providing a wide range of general interest information via a computer network; directory services to help locate people, places, organizations, phone numbers, network home pages, and electronic mail addresses

INT CLASS

01	
35	38
39	42

AMAZON.COM

TRADEMARK

75662416

199904020  
12-03-1999

U.S. Patent & TMO/TM Mail Rpt Dt. #01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Amazon.com, Inc.

Serial No.: 75/662416

Filed: March 17, 1999

Mark: AMAZON.COM

112  
LA  
LAW OFFICE 112

Examiner:  
Deborah E. Lobo

RESPONSE TO OFFICE  
ACTION NO. 01

Applicant has received and reviewed Office Action No. 01, mailed September 20, 1999, and responds as follows:

I.

**IDENTIFICATION OF GOODS/RECITATION OF SERVICES**

Further to discussions with the Examining Attorney, Applicant amends its identification of goods and recitation of services to read as follows:

International Class 9: Downloadable computer software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information.

International Class 35: Retail department stores; retail on-line department stores; retail convenience stores; retail on-line convenience stores; computerized on-line ordering featuring general merchandise and general consumer goods; providing an on-line commercial information directory; providing a searchable database in the field of business information available via a global computer network; dissemination of advertising for others via an on-line electronic communications network; providing a searchable on-line database featuring goods and services of others in the field of finances, insurance, banking, real estate and vehicles ; providing a searchable on-line

12/09/1999 VBRISCD E 00000011 75662416

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980.00 00

[SL993360.206]

12/2/99

advertising guide featuring the goods and service of other on-line vendors; database management services; and computer services, namely, providing directories for telephone numbers, business addresses, electronic mail addresses, network home page addresses, addresses and telephone number of people, places, and organizations.

International Class 38: Providing multiple-user access to a global computer network; electronic transmission of data and documents concerning personal and professional information via computer terminals.

International Class 39: Providing an interactive database featuring an automatically updating travel planner.

International Class 42: Providing an interactive database featuring automatically updating address book, personal planner, date reminder and alumni and professional group links all via a global computer network; providing temporary use of on-line non-downloadable software for event scheduling and for managing, viewing and editing address books and other personal and professional contact information; computer services, namely, providing search engines for locating information, resources, and the websites of others on a global computer network; providing a wide range of general interest information via a global computer network; and providing electronic greeting cards via a global computer network.]

## II.

### ADDITIONAL FEE FOR INTERNATIONAL CLASSES

Applicant's amended description of goods and recitation of services now falls within five international classifications; therefore, Applicant is submitting herewith an

additional \$980.00 filing fee to cover the added class. The Assistant Commissioner is authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-0665.

**III.**

**CONCLUSION**

The foregoing response complies with the requirements of Office Action No. 01. Applicant believes its application is now in proper form and requests passage of the mark for publication. If any questions remain, Applicant requests that the Examining Attorney contact Applicant's attorney at the telephone number listed below.

DATED: December 2, 1999.

Amazon.com, Inc.

By Hendi L. Sachs  
Hendi L. Sachs

Attorneys for Applicant

PERKINS COIE LLP  
1201 Third Avenue, Suite 4800  
Seattle, Washington 98101-3099  
(206) 583-8888

\*\* User: dlobo \*\*\*

	Total Marks	Dead Marks	Live Viewed Docs	Live Viewed Images	Status/ Search Duration	Search
01	31	4	9	9	0:01	(amazon.com) [on]
02	161	N/A	0	0	0:01	*amazon*[bi,ti]
03	82	0	80	80	0:05	(2 not 1) not dead[ld]
04	1	1	0	0	0:01	*amason*[bi,ti]

Session started 9/9/99 5:43:41 PM  
Session finished 9/9/99 5:50:49 PM  
Total search duration 0:08 minutes  
Session Duration 7:08 minutes

Default NEAR limit= 1 ADJ limit= 1

TRADEMARK DATABASE REPORT

SN: 75/662416

DATE OF REPORT: Jan 7, 2000

PAGE: 1

EXAMINING ATTORNEY: LOBO, DEBORAH  
LAW OFFICE 112 FILED ITU: YES

FILED MAR.17,1999  
CURRENTLY ITU: YES

PUBLICATION DATE: NNN.NN,NNNN  
STATUS: RESPONSE AFTER NON-FINAL ACTION - ENTERED  
REGISTRATION NO: NNNNNNNN REGISTRATION DATE: NNN.NN,NNNN

MARK TYPE: Trademark Service Mark  
REGISTER: Principal  
MARK: AMAZON.COM

OTHER MARK DATA:

MARK DRAWING CODE: 1000 TYPESET WORD(S)/LETTER(S)/NUMBER(S)

PSEUDO MARK: -- AMAZON DOT COM

COMPOSED OF STATEMENT: PARTY TYPE 10 COMPOSED FLAG FALSE

ASSIGNMENT RECORDED: NO

OWNER: Amazon.com, Inc (DELAWARE, CORPORATION)  
P.O. Box 81226  
Seattle, WASHINGTON 981081226

FOR: DOWNLOADABLE COMPUTER SOFTWARE FOR EVENT  
SCHEDULING AND FOR MANAGING, VIEWING AND  
EDITING ADDRESS BOOKS AND OTHER PERSONAL  
AND PROFESSIONAL CONTACT INFORMATION  
INT. CLASS 009 (U.S. CLASS 021,023,026,036  
AND 038)  
FIRST USE NNN.NN,NNNN USE IN COMMERCE NNN.NN,NNNN

FOR: RETAIL DEPARTMENT STORES; RETAIL ON-LINE  
DEPARTMENT STORES; RETAIL CONVENIENCE STORES;  
RETAIL ON-LINE CONVENIENCE STORES; COMPUTERIZED  
ON-LINE ORDERING FEATURING GENERAL MERCHANDISE  
AND GENERAL CONSUMER GOODS; PROVIDING AN  
ON-LINE COMMERCIAL INFORMATION DIRECTORY;  
PROVIDING A SEARCHABLE DATABASE IN THE FIELD  
OF BUSINESS INFORMATION AVAILABLE VIA A GLOBAL  
COMPUTER NETWORK; DISSEMINATION OF ADVERTISING  
FOR OTHERS VIA AN ON-LINE ELECTRONIC COMMUNICATIONS  
NETWORK; PROVIDING A SEARCHABLE ON-LINE DATABASE  
FEATURING GOODS AND SERVICES OF OTHERS IN  
THE FIELD OF FINANCES, INSURANCE, BANKING,

TRADEMARK DATABASE REPORT

SN: 75/662416

DATE OF REPORT: Jan 7, 2000

PAGE: 2

REAL ESTATE AND VEHICLES; PROVIDING A SEARCHABLE ON-LINE ADVERTISING GUIDE FEATURING THE GOODS AND SERVICE OF OTHER ON-LINE VENDORS; DATABASE MANAGEMENT SERVICES; AND COMPUTER SERVICES, NAMELY, PROVIDING DIRECTORIES FOR TELEPHONE NUMBERS, BUSINESS ADDRESSES, ELECTRONIC MAIL ADDRESSES, NETWORK HOME PAGE ADDRESSES, ADDRESSES AND TELEPHONE NUMBER OF PEOPLE, PLACES, AND ORGANIZATIONS

INT. CLASS 035 (U.S. CLASS 100, 101 AND 102)  
FIRST USE NNN.NN, NNNN USE IN COMMERCE NNN.NN, NNNN

FOR:

PROVIDING MULTIPLE-USER ACCESS TO A GLOBAL COMPUTER NETWORK; ELECTRONIC TRANSMISSION OF DATA AND DOCUMENTS CONCERNING PERSONAL AND PROFESSIONAL INFORMATION VIA COMPUTER TERMINALS

INT. CLASS 038 (U.S. CLASS 100, 101 AND 104)  
FIRST USE NNN.NN, NNNN USE IN COMMERCE NNN.NN, NNNN

FOR:

PROVIDING AN INTERACTIVE DATABASE FEATURING AN AUTOMATICALLY UPDATING TRAVEL PLANNER

INT. CLASS 039 (U.S. CLASS 100 AND 105)  
FIRST USE NNN.NN, NNNN USE IN COMMERCE NNN.NN, NNNN

FOR:

PROVIDING AN INTERACTIVE DATABASE FEATURING AUTOMATICALLY UPDATING ADDRESS BOOK, PERSONAL PLANNER, DATE REMINDER AND ALUMNI AND PROFESSIONAL GROUP LINKS ALL VIA A GLOBAL COMPUTER NETWORK; PROVIDING TEMPORARY USE OF ON-LINE NON-DOWNLOADABLE SOFTWARE FOR EVENT SCHEDULING AND FOR MANAGING, VIEWING AND EDITING ADDRESS BOOKS AND OTHER PERSONAL AND PROFESSIONAL CONTACT INFORMATION; COMPUTER SERVICES, NAMELY, PROVIDING SEARCH ENGINES FOR LOCATING INFORMATION, RESOURCES, AND THE WEBSITES OF OTHERS ON A GLOBAL COMPUTER NETWORK; PROVIDING A WIDE RANGE OF GENERAL INTEREST INFORMATION VIA A GLOBAL COMPUTER NETWORK; AND PROVIDING ELECTRONIC GREETING CARDS VIA A GLOBAL COMPUTER NETWORK

INT. CLASS 042 (U.S. CLASS 100 AND 101)  
FIRST USE NNN.NN, NNNN USE IN COMMERCE NNN.NN, NNNN

OTHER DATA:

CORRESPONDENCE DATA:

TRADEMARK DATABASE REPORT

SN: 75/662416

DATE OF REPORT: Jan 7, 2000

PAGE: 3

ATTORNEY: Brent D. Sanders

NAME & ADDRESS: BRENT D. SANDERS  
PERKINS COIE LLP  
1201 THIRD AVENUE  
40TH FLOOR  
SEATTLE, WASHINGTON 98101-3099

LAST AUTOMATIC ADDRESS UPDATE: NOT UPDATED

DT ERROR DETECTED	DATA ELEMENT/ TEXT TYPE	ERR ED CODE STAT	DATA CONTENTS	ADDL KEY
01/07/00	CL-FLG-ANOTH-FORM	10048 E	NONE; NO VT-TEXT-TYPE WITH POSITIONS 1 AND 2 INDICATING IN ANOTHER FORM STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS	009
01/07/00	CL-FLG-ANOTH-FORM	10048 E	NONE; NO VT-TEXT-TYPE WITH POSITIONS 1 AND 2 INDICATING IN ANOTHER FORM STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS	035
01/07/00	CL-FLG-ANOTH-FORM	10048 E	NONE; NO VT-TEXT-TYPE WITH POSITIONS 1 AND 2 INDICATING IN ANOTHER FORM STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS	038
01/07/00	CL-FLG-ANOTH-FORM	10048 E	NONE; NO VT-TEXT-TYPE WITH POSITIONS 1 AND 2 INDICATING IN ANOTHER FORM STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS	039
01/07/00	CL-FLG-ANOTH-FORM	10048 E	NONE; NO VT-TEXT-TYPE WITH POSITIONS 1 AND 2 INDICATING IN ANOTHER FORM STATEMENT ['AF'] AND WITH POSITIONS 3 THROUGH 5 = THIS CL-PRIME-CLS	042
01/07/00	AM-FLG-ASGT-RCD	00350 E	T:NONE; *NO ASSIGNMENT RECORD FOUND	
01/07/00	AM-STE-CD-APPL	00343 E	WA ;NOT FOUND; NO CORRESPONDING PY-CITIZENSHIP WITH PY-PARTY-TYPE INDICATING ORI GINAL APPLICANT [10]	

## TRADEMARK EXAMINATION WORKSHEET

 AMENDMENT STAGE

 NO CHANGE

 PUBLICATION/REGISTRATION STAGE

Name: <u>THUY TA</u> L.O. <u>112</u> Date <u>1/7/08</u> Serial No. <u>751 602416</u>	
INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.	
<b>Legal Instrument Examiner (LIE)</b>	
	<b>Amended</b>
<b>Class Data</b>	<input type="checkbox"/> Prime/International Class
	<input type="checkbox"/> First Use Date
	<input type="checkbox"/> In Another Form
	<input type="checkbox"/> 1b
<b>Mark Data</b>	<input type="checkbox"/> Word Mark
	<input type="checkbox"/> Mark Drawing Code
	<input type="checkbox"/> Sizing/Lining Code
<b>Misc. Mark Data</b>	<input type="checkbox"/> Mark Description
	<input type="checkbox"/> Lining/Stippling
	<input type="checkbox"/> Translation
<b>Section 2(f)</b>	<input type="checkbox"/> Section 2(f) Entire Mark
	<input type="checkbox"/> Section 2(f) Limitation Statement
	<input type="checkbox"/> Amended Register
<b>Foreign Reg. Data</b>	<input type="checkbox"/> Foreign Country
	<input type="checkbox"/> Foreign Application Number
	<input type="checkbox"/> Foreign Registration Number
	<input type="checkbox"/> Foreign Registration Expiration Date
	<input type="checkbox"/> Foreign Reg. Renewal Expiration Date
<b>Owner Data</b>	<input type="checkbox"/> Owner Name
	<input type="checkbox"/> Address 1
	<input type="checkbox"/> City
	<input type="checkbox"/> Zip Code
	<input type="checkbox"/> Citizenship
	<input type="checkbox"/> Entity Statement
	<input type="checkbox"/> Assignment(s)/Name Change
	<input type="checkbox"/> Amendment/Renewal
	<input type="checkbox"/> Concurrent Use
	<input type="checkbox"/> Interference Statement
<b>Prior U.S. Reg.</b>	<input type="checkbox"/> Prior Registration
<b>Correspondence</b>	<input type="checkbox"/> Attorney
	<input type="checkbox"/> Attorney Docket Number
	<input type="checkbox"/> Correspondence Firm Name/Address

I certify that all corrections have been entered in accordance with text editing guidelines.

\_\_\_\_\_  
LIE

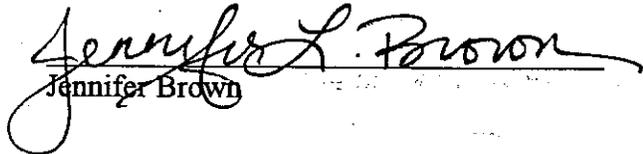
\_\_\_\_\_  
DATE

Other: \_\_\_\_\_

**CERTIFICATE OF MAILING**

I CERTIFY that on December 3, 1999, I mailed (via U.S. Express Mail #EL387664021US) the attached APPLICANT'S RESPONSE TO OFFICE ACTION NO. 1 regarding the mark "AMAZON.COM" in International Class 35 (Serial No. 75/662416) to:

Ms. Deborah E. Lobo  
Law Office 112  
U. S. Patent & Trademark Office  
BOX RESPONSES FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
Jennifer Brown

[SL982800.064]



## CONTENTS CONTINUED

Entry	Date	Initials
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75662416

NEW CASE DELIVERED

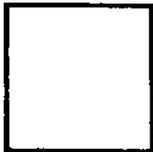
AUG 30 1999

LAW OFFICE 112

TRADEMARK



75662416



NEW CASE DELIVERED

AUG 29 1999

LAW OFFICE 113

CONTENTS

NEW CASE DELIVERED

Entry	Date	Initials
1.	SEP 20 1999	22
2. <i>AmdtA</i>	12/3/99	JAN -7 2000
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ORDER NUMBER 215725  
 REFERENCE ORDER NUMBER 0  
 BIN NUMBER 786

Page 1 of 1



**DELIVERY INSTRUCTIONS**

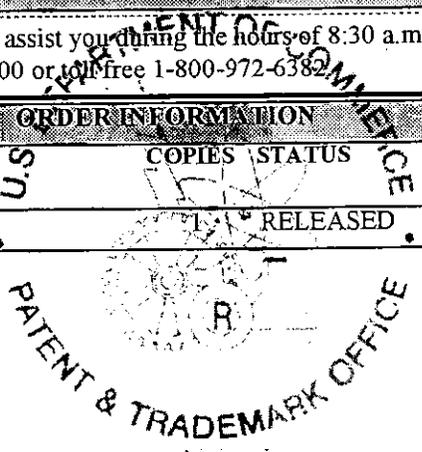
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2000-02-22 15:43:00		IDON337524		CREDIT CARD	\$ 50.00

**BROADCAST MESSAGE**

Our Customer Service staff is available to assist you during the hours of 8:30 a.m. to 8:00 p.m. EST, Monday through Friday. Please call (703) 308-9700 or toll free 1-800-972-6382.

**ORDER INFORMATION**

ORDER LINE	PRODUCT TYPE	DOCUMENT IDENTIFIER	COPIES	STATUS	CUSTOMER REFERENCE
1	CCI	75555444	1	RELEASED	



**E-MAIL**

**FAX NUMBER**

**CARRIER**  
FEDERAL EXPRESS

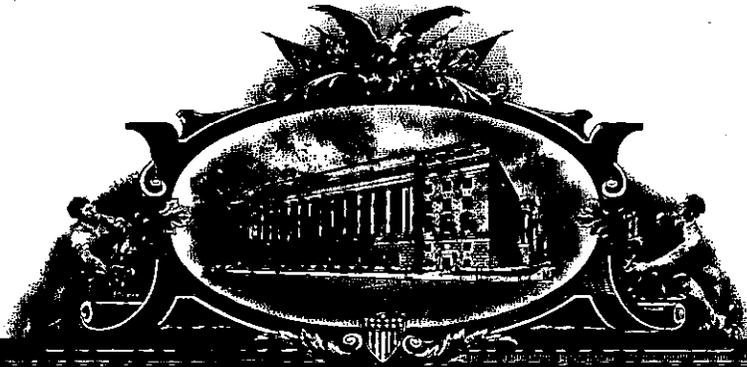
**CARRIER TRACKING NUMBER**

**CARRIER ACCOUNT NUMBER**  
2061-2373-4

FROM : U.S. Patent and Trademark Office  
 Box 9  
 Washington, DC 20231

TO: TRADEMARK CENTER  
 ATTN: MATTHEW J. COHEN  
 21550 OXNARD ST.  
 SUITE 300  
 WOOLAND HILLS, CA 91367  
 USA

TP 215725



**THE UNITED STATES OF AMERICA**

**TO ALL TO WHOM THESE PRESENTS SHALL COME:**

**UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office**

**March 21, 2000**

**THIS IS TO CERTIFY THAT ANNEXED IS A TRUE COPY FROM THE  
RECORDS OF THIS OFFICE OF THE TRADEMARK FILE WRAPPER AND  
CONTENTS OF:**

**TRADEMARK APPLICATION: 75/555,444**

**FILING DATE: *September 18, 1998***



**By Authority of the  
COMMISSIONER OF PATENTS AND TRADEMARKS**

*T. Lawrence*

**T. LAWRENCE  
Certifying Officer**

75-555444



TYPED DRAWING

MY STORE

ITU

LAW OFFICE ~~103~~ 113

PRINCIPAL

Chad T. O'Hara

Rebecca L. Gilbert

ATTORNEY ADVISOR:

Examining Attorney - (Please Print Name)  
Rebecca L. Gilbert

Approved for Publication (Principal Applicant) - (Signature)

Approved for Registration (Section 1(d)) - (Signature)

Approved for Registration (Supplemental Register) - (Signature)

PUBLISHED  
02/08/00 01

Attorney/Advisor - (Signature)

7555444

TRADEMARK APPLICATION SERIAL NO. \_\_\_\_\_

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE  
FEE RECORD SHEET

9/30/1998 6THOMAS2 00000172 7555444

FC:361

245.00 DP

PTO-1555  
(5/87)

1 398102200003

PERKINS COIE LLP

1201 THIRD AVENUE, 40<sup>TH</sup> FLOOR · SEATTLE, WASHINGTON 98101-3099  
TELEPHONE: 206 583-8888 · FACSIMILE: 206 583-8500

September 18, 1998

**VIA U.S. EXPRESS MAIL**

Assistant Commissioner for Trademarks  
U.S. Patent & Trademark Office  
BOX NEW APP FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

**Re: Application for Service Mark Registration**  
**Mark: MY STORE**  
**Class: 35**  
**Applicant: Amazon.com, Inc.**

Assistant Commissioner:

Enclosed for filing is an intent-to-use application to register the mark indicated above on the Principal Register, together with \$245 to cover the filing fee.

Very truly yours,

  
Brent D. Sanders

BDS:mhm  
Enclosures

cc: Amazon.com, Inc.  
Rebecca F. Watt, Paralegal

75555444

[24976-0003/SL982610.010]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
INTENT TO USE APPLICATION FOR SERVICE MARK REGISTRATION  
ON THE PRINCIPAL REGISTER

Mark: MY STORE

International  
Class No.: 35

Assistant Commissioner of Trademarks  
Arlington, Virginia 22202-3513

Amazon.com, Inc., a Delaware corporation  
1516 Second Avenue, 4th Floor  
Seattle, WA 98101

The above-identified applicant has a bona fide intent to use the service mark shown in the accompanying drawing in connection with the following services:

Computerized searching, ordering and on-line retail and wholesale distribution of general consumer goods, including literary works, books, music, motion pictures, multimedia products, computer software, audiocassettes, videocassettes, compact disks, floppy disks and CD-ROMs

and requests that said service mark be registered in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946, as amended.

The applicant has a bona fide intention to use the mark in commerce in connection with the above identified services (15 U.S.C. §§ 1051(b), as amended). The applicant has a bona fide intention to use the service mark in connection with a Web site, brochures, advertising, letterhead, business cards and in other ways customary in the trade.

The undersigned hereby appoints the law firm of Perkins Coie LLP through Heidi L. Sachs, Robert C. Cumbow, Tara L. Benson, Brent D. Sanders and Erika J.

75555444

1/0 2457-361

Starrs, 1201 Third Avenue, 40th Floor, Seattle, Washington 98101-3099, (206) 583-8888, to prosecute this registration application with full power of substitution and revocation, to make alterations and amendments, to transact all business in the United States Patent and Trademark Office and to receive the notice of allowance and the certificate of registration.

\* \* \*

DECLARATION

Alan Caplan, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any registration resulting therefrom, declares that: he is the Vice President, General Counsel and Assistant Secretary of the applicant corporation and authorized to execute this instrument; he believes applicant is entitled to use in commerce the service mark sought to be registered; to the best of his knowledge and belief no other person, firm, corporation or association has the right to use said mark in commerce in connection with the same or similar services, either in the identical form or in such near resemblance thereto as to be likely, when applied to the services of such other person, to cause confusion, or to cause mistake, or to deceive; the facts set forth in this application are true; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

EXECUTED at Seattle, Washington, this 17<sup>th</sup> day of September 1998.



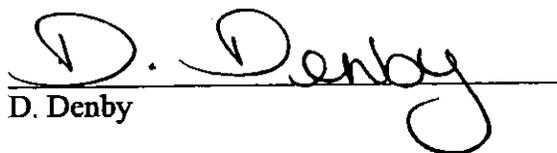
Alan Caplan  
Vice President, General Counsel and Assistant Secretary  
Amazon.com, Inc.

1398102200006

**CERTIFICATE OF MAILING**

I CERTIFY that on September 18, 1998, I mailed (via U.S. Express Mail #EM414648286US) the attached APPLICATION FOR SERVICE MARK REGISTRATON regarding the mark "MY STORE" in International Class 35 to:

Assistant Commissioner of Trademarks  
U. S. Patent & Trademark Office  
BOX NEW APP FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
D. Denby

SL982610.013

1998102200007

INT. CL.  
35  
PRIOR US CL.

**Applicant:** Amazon.com, Inc.

**Address:** 1516 Second Avenue, 4th Floor  
Seattle, WA 98101

**Services:** Computerized searching, ordering and on-line retail and wholesale distribution of general consumer goods, including literary works, books, music, motion pictures, multimedia products, computer software, audiocassettes, videocassettes, compact disks, floppy disks and CD-ROMs

Pat & TMO: PMA Mail Bmt Dc DP 102

09-18-1998

MY STORE

PUBLISHED  
02/08\00 01

TRADEMARK

7555444

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

1998102200002

<b>SERIAL NO.</b> 75/555444 Amazon.com, Inc.		<b>APPLICANT</b>		<b>PAPER NO.</b>
<b>MARK</b> MY-STORE				
<b>ADDRESS</b> BRENT D SANDERS PERKINS COIE LLP 1201 3RD AVE 40TH FL SEATTLE WA 98101-3099		<b>ACTION NO.</b> 01	<b>ADDRESS:</b> Assistant Commissioner for Trademarks 2900 Crystal Drive Arlington, VA 22202-3513  If no fees are enclosed, the address should include the words "Box Responses - No Fee."	
		<b>MAILING DATE</b> 04/12/99		
		<b>REF. NO.</b>		
FORM PTO-1525 (5-90)	U.S. DEPT. OF COMM. PAT. & TM OFFICE			<b>Please provide in all correspondence:</b> <ol style="list-style-type: none"><li>1. Filing Date, serial number, mark and Applicant's name.</li><li>2. Mailing date of this Office action.</li><li>3. Examining Attorney's name and Law Office number.</li><li>4. Your telephone number and ZIP code.</li></ol>

A PROPER RESPONSE TO THIS OFFICE ACTION MUST BE RECEIVED WITHIN 6 MONTHS FROM THE DATE OF THIS ACTION IN ORDER TO AVOID ABANDONMENT. For your convenience and to ensure proper handling of your response, a label has been enclosed. Please attach it to the upper right corner of your response. If the label is not enclosed, print or type the Trademark Law Office No., Serial No., and Mark in the upper right corner of your response.

RE: Serial Number: 75/555444

The assigned examining attorney has reviewed the referenced application and determined the following.

Search

The examining attorney has searched the Office records and has found no similar registered or pending mark which would bar registration under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). TMEP section 1105.01.

Recitation of Services

The recitation of services is unacceptable as indefinite because the nature of the applicant's services is unclear. The applicant may adopt the following recitation, if accurate:

"on line retail store services featuring computerized on line search and ordering of literary works, books, music, motion pictures, multimedia products, computer software, audiocassettes, videocassettes, compact disks, floppy disks and CD-ROMs." TMEP section 804.

**Disclaimer**

The applicant must disclaim the descriptive wording "STORE" apart from the mark as shown. Trademark Act Section 6, 15 U.S.C. Section 1056; TMEP sections 1213 and 1213.02(a). The wording is merely descriptive because it merely describes a feature or function of the applicant's services, that is, on line retail store services.

The computerized printing format for the *Trademark Official Gazette* requires a standard form for a disclaimer. TMEP section 1213.09(a)(i). A properly worded disclaimer should read as follows:

No claim is made to the exclusive right to use STORE apart from the mark as shown.

*See In re Owatonna Tool Co.*, 231 USPQ 493 (Comm'r Pats. 1983).

If the applicant has any questions or needs assistance in responding to this Office action, please telephone the assigned examining attorney.



Chad O'Hara  
Trademark Attorney  
Law Office 113  
(703) 308-9113 ext. 156

5 L 0313

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Amazon.com, Inc.

Serial No.: 75/555,444

Filed: September 18, 1998

Mark: MY STORE

LAW OFFICE 113

Examiner:  
Chad O'Hara

RESPONSE TO OFFICE  
ACTION NO 1

Applicant has received and reviewed Office Action No. 1, mailed April 12, 1999, and responds as follows:

**I.**

**RECITATION OF SERVICES**

Applicant amends its recitation of services to read as follows:

COMPUTERIZED ONLINE RETAIL DEPARTMENT STORE SERVICES; ONLINE RETAIL STORES SERVICES FEATURING COMPUTERIZED ONLINE SEARCH AND ORDERING OF LITERARY WORKS, BOOKS, MUSIC, MOTION PICTURES, MULTIMEDIA PRODUCTS, COMPUTER SOFTWARE, AUDIOCASSETTES, VIDEOCASSETTES, COMPACT DISKS, FLOPPY DISKS AND CD-ROMs.

**II.**

**DISCLAIMER**

Applicant amends its application to include the following disclaimer:

Without waiver of its common law rights, applicant disclaims the exclusive right to use the word store apart from the mark as a whole.

**III.**

**CONCLUSION**

The foregoing response complies with the requirements of Office Action No. 1. Applicant believes its application is now in proper form and requests passage of the

10-08-1999  
U.S. Patent & TMO:TM Mail Rcpt Dt. #64

*Print*

mark for publication. If any questions remain, Applicant requests that the Examining Attorney contact Applicant's attorney at the telephone number listed below.

DATED: 10/7/99

AMAZON.COM, INC.

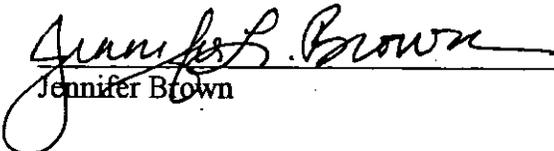
By Catherine H. Tran  
Catherine H. Tran  
Attorneys for Applicant

PERKINS COIE LLP  
1201 Third Avenue, Suite 4800  
Seattle, Washington 98101-3099  
(206) 583-8888

**CERTIFICATE OF MAILING**

I CERTIFY that on October 8, 1999, I mailed (via U.S. Express Mail #EL352567316US) the attached APPLICANT'S RESPONSE TO OFFICE ACTION NO. 1 regarding the mark "MY STORE" in International Class 35 (Serial No. 75/555444) to:

Mr. Chad O'Hara  
Law Office 113  
U. S. Patent & Trademark Office  
BOX RESPONSES NO FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
Jennifer Brown

PERKINS COIE LLP

1201 THIRD AVENUE, 48TH FLOOR · SEATTLE, WASHINGTON 98101-3099  
TELEPHONE: 206 583-8888 · FACSIMILE: 206 583-8500

CATHERINE H. TRAN  
(206) 583-8417  
tranc@perkinscoie.com  
http://www.perkinscoie.com

October 8, 1999

10-08-1999  
U.S. Patent & TMO: TM Mail Rcpt Dt. #64

#2A

VIA U.S. EXPRESS MAIL

Mr. Chad O'Hara  
Law Office 113  
U.S. Patent & Trademark Office  
BOX RESPONSES NO FEE  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: Applicant: Amazon.com, Inc.  
Serial No.: 75/555444  
Mark: MY STORE  
Our Reference No. 24976-3

RECEIVED  
1999 OCT 14 A 11: 35  
LAW OFFICE 113  
IMEO

Dear Mr. O'Hara:

Enclosed is Applicant's Response to Office Action No. 1.

Very truly yours,

*Catherine H. Tran*  
Catherine H. Tran

CHT:sfr  
Enclosures

cc: Amazon.com, Inc.  
Susan F. Ramin, Paralegal

[24976-0003/SL992800.232]



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

ASSISTANT COMMISSIONER FOR TRADEMARKS  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Jan 7, 2000

NOTICE OF PUBLICATION UNDER 12(a)

1. Serial No.:  
75/555,444
2. Mark:  
MY STORE
3. International Class(es):  
35
4. Publication Date:  
Feb 8, 2000
5. Applicant:  
Amazon.com, Inc.

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a notice of allowance pursuant to section 13(b) of the Statute.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained at \$38.00 each for domestic orders, or at \$47.50 each for foreign orders from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: (202)512-1800

By direction of the Commissioner.

**TRADEMARK EXAMINATION WORKSHEET**

AMENDMENT STAGE

NO CHANGE

PUBLICATION/REGISTRATION STAGE

Name: Symea Johnson L.O. 113

Date 10/20/99

Serial No. 555444

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

Legal Instrument Examiner (LIE)		
	Amended	Data Element
Class Data	<input type="checkbox"/>	Prime/International Class
	<input type="checkbox"/>	Goods and Services
	<input type="checkbox"/>	First Use Date
	<input type="checkbox"/>	First Use in Commerce Date
	<input type="checkbox"/>	In Another Form
	<input type="checkbox"/>	Certification
	<input type="checkbox"/>	1b
Mark Data	<input type="checkbox"/>	Word Mark
	<input type="checkbox"/>	Pseudo Mark
	<input type="checkbox"/>	Mark Drawing Code
	<input type="checkbox"/>	Design Search Code
	<input type="checkbox"/>	Sizing/Lining Code
Misc. Mark Data	<input type="checkbox"/>	Mark Description
	<input type="checkbox"/>	Disclaimer
	<input type="checkbox"/>	Lining/Stippling
	<input type="checkbox"/>	Name/Portrait/Consent
	<input type="checkbox"/>	Translation
Section 2(f)	<input type="checkbox"/>	Section 2(f) Entire Mark
	<input type="checkbox"/>	Section 2(f) Limitation Statement
	<input type="checkbox"/>	Section 2(f) in Part
	<input type="checkbox"/>	Amended Register
	<input type="checkbox"/>	Amended Register Date
Foreign Reg. Data	<input type="checkbox"/>	Foreign Country
	<input type="checkbox"/>	44(d)
	<input type="checkbox"/>	Foreign Application Number
	<input type="checkbox"/>	Foreign Application Filing Date
	<input type="checkbox"/>	Foreign Registration Number
	<input type="checkbox"/>	Foreign Registration Date
	<input type="checkbox"/>	Foreign Registration Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Number
	<input type="checkbox"/>	Foreign Reg. Renewal Expiration Date
	<input type="checkbox"/>	Foreign Renewal Reg. Date
Owner Data	<input type="checkbox"/>	Owner Name
	<input type="checkbox"/>	DBA/AKA/TA
	<input type="checkbox"/>	Address 1
	<input type="checkbox"/>	Address 2
	<input type="checkbox"/>	City
	<input type="checkbox"/>	State
	<input type="checkbox"/>	Zip Code
	<input type="checkbox"/>	Citizenship
	<input type="checkbox"/>	Entity
	<input type="checkbox"/>	Entity Statement
	<input type="checkbox"/>	Composed of
	<input type="checkbox"/>	Assignment(s)/Name Change
and/Corr. Restr.	<input type="checkbox"/>	Concurrent Use
for U.S. Reg.	<input type="checkbox"/>	Prior Registration
Correspondence	<input type="checkbox"/>	Attorney
	<input type="checkbox"/>	Domestic Representative
	<input type="checkbox"/>	Attorney Docket Number
	<input type="checkbox"/>	Correspondence Firm Name/Address

I certify that all corrections have been entered in accordance with text editing guidelines.

LIE:

*S. Johnson*

10/20/99

er:

**TRADEMARK EXAMINATION WORKSHEET**

AMENDMENT STAGE

NO CHANGE

PUBLICATION/REGISTRATION STAGE

Name: Tawana Campbell

L.O. 113

Date: December 22, 1999

Serial No. 355444

INSTRUCTIONS: Place a check mark in the appropriate column and/or box to indicate which data elements have been amended/coded.

**Legal Instrument Examiner (LIE)**

	Amended	Data Element	
<b>Class Data</b>	<input checked="" type="checkbox"/>	<input type="checkbox"/> Prime/International Class	<input checked="" type="checkbox"/> Goods and Services
		<input type="checkbox"/> First Use Date	<input type="checkbox"/> First Use in Commerce Date
		<input type="checkbox"/> In Another Form	<input type="checkbox"/> Certification
		<input type="checkbox"/> 1b	
<b>Mark Data</b>		<input type="checkbox"/> Word Mark	<input type="checkbox"/> Pseudo Mark
		<input type="checkbox"/> Mark Drawing Code	<input type="checkbox"/> Design Search Code
		<input type="checkbox"/> Sizing/Lining Code	
<b>Misc. Mark Data</b>		<input type="checkbox"/> Mark Description	<input type="checkbox"/> Disclaimer
		<input type="checkbox"/> Lining/Stippling	<input type="checkbox"/> Name/Portrait/Consent
		<input type="checkbox"/> Translation	
<b>Section 2(f)</b>		<input type="checkbox"/> Section 2(f) Entire Mark	
		<input type="checkbox"/> Section 2(f) Limitation Statement	<input type="checkbox"/> Section 2(f) in Part
		<input type="checkbox"/> Amended Register	<input type="checkbox"/> Amended Register Date
<b>Foreign Reg. Data</b>		<input type="checkbox"/> Foreign Country	<input type="checkbox"/> 44(d)
		<input type="checkbox"/> Foreign Application Number	<input type="checkbox"/> Foreign Application Filing Date
		<input type="checkbox"/> Foreign Registration Number	<input type="checkbox"/> Foreign Registration Date
		<input type="checkbox"/> Foreign Registration Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Number
		<input type="checkbox"/> Foreign Reg. Renewal Expiration Date	<input type="checkbox"/> Foreign Renewal Reg. Date
<b>Owner Data</b>		<input type="checkbox"/> Owner Name	<input type="checkbox"/> DBA/AK/TA
		<input type="checkbox"/> Address 1	<input type="checkbox"/> Address 2
		<input type="checkbox"/> City	<input type="checkbox"/> State
		<input type="checkbox"/> Zip Code	
		<input type="checkbox"/> Citizenship	<input type="checkbox"/> Entity
		<input type="checkbox"/> Entity Statement	<input type="checkbox"/> Composed of
		<input type="checkbox"/> Assignment(s)/Name Change	
<b>Amd/Corr Restr.</b>		<input type="checkbox"/> Concurrent Use	
<b>Prior U.S. Reg.</b>		<input type="checkbox"/> Prior Registration	
<b>Correspondence</b>		<input type="checkbox"/> Attorney	<input type="checkbox"/> Domestic Representative
		<input type="checkbox"/> Attorney Docket Number	
		<input type="checkbox"/> Correspondence Firm Name/Address	

certify that all corrections have been entered in accordance with text editing guidelines.

*Tec*  
LIE

DEC 22 1999  
DATE

Other: \_\_\_\_\_  
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\*\*\* User: cohara \*\*\*

#	Total Marks	Live Viewed	Dead Marks	Status	Search
01	54	29	25		amazon[ow]
02	22	1	4		amazon.com[ow]
03	4626	0	N/A		*web*[bi]
04	7	0	N/A		*web*[ti]
05	136	0	N/A		*shop*[ti]
06	5473	0	N/A		*shop*[bi]
07	10052	0	N/A		*stor*[bi]
08	258	0	N/A		*stor*[ti]
09	565	0	N/A		*my*[ti]
10	9260	0	N/A		*my*[bi]
11	102	2	48		(9 or 10) and (7 or 8)
12	31	6	10		(3 or 4) and (5 or 6)

Session started 4/9/99 3:04:12 PM  
Session finished 4/9/99 3:15:51 PM  
Duration 11 minutes

\*\* User: cohara \*\*\*

#	Total Marks	Live Viewed	Dead Marks	Status	Search
01	3143	0	N/A		my[bi]
02	355	0	N/A		my[ti]
03	1816	0	N/A		(1 or 2) not dead[ld]
04	1129829	0	N/A		016[cc]
05	872	0	N/A		3 and 4
06	116802	0	N/A		035[ic]
07	455602	0	N/A		200 or a or b[ic]
08	7958	0	N/A		(200 or a or b)[ic]
09	4991	0	N/A		200[ic]
10	2245	0	N/A		a[ic]
11	1659	0	N/A		b[ic]
12	95	2	0		3 and (6 or 9 or 10 or 11)

Session started 4/9/99 3:16:22 PM  
Session finished 4/9/99 3:25:21 PM  
Duration 9 minutes

12/29/98



## CONTENTS CONTINUED

Entry	Date	Initials
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*TCW*

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TRADEMARK  
  
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[Redacted]

NEW CASE DELIVERED  
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### CONTENTS

	Entry	Date	Initials
1.		APR 12 1999	
2.	<i>AMDTA</i>	<i>10/1/99</i>	<i>[Signature]</i> OCT 25 1999
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NOP 01  
02/08/00

CALIFORNIA STATE BOARD OF EQUALIZATION

**SELLER'S PERMIT**



ACCOUNT NUMBER

10/1/1999 SR AP 97600574

**AMAZON COSMETICS & TAN PRODUCTS  
ERIC KALAYDJIAN  
4226 SCANDIA WAY  
LOS ANGELES, CA 90065**

*THIS PERMIT DOES NOT  
AUTHORIZE THE HOLDER  
TO ENGAGE IN ANY  
BUSINESS CONTRARY TO  
LAWS REGULATING THAT  
BUSINESS OR TO  
POSSESS OR OPERATE  
ANY ILLEGAL DEVICE.*

IS HEREBY AUTHORIZED PURSUANT TO SALES AND USE TAX LAW  
TO ENGAGE IN THE BUSINESS OF SELLING TANGIBLE PERSONAL  
PROPERTY AT THE ABOVE LOCATION

*Not valid at any other address*

THIS PERMIT IS VALID UNTIL REVOKED OR CANCELED BUT IS NOT TRANSFERABLE. IF YOU SELL YOUR BUSINESS,  
OR DROP OUT OF A PARTNERSHIP, NOTIFY US OR YOU COULD BE RESPONSIBLE FOR SALES AND USE TAXES  
OWED BY THE NEW OPERATOR OF THE BUSINESS.

BOE-442-R-LZ REV. 12 (8-95)

**NOTICE TO INDIVIDUALS REGARDING  
INFORMATION FURNISHED TO THE BOARD OF EQUALIZATION**

The Information Practices Act of 1977 and the Federal Privacy Act requires this agency to provide the following notice to individuals who are asked by the State Board of Equalization (Board) to supply information, including the disclosure of the individual's social security account number.

Individuals applying for permits, certificates, or licenses, or filing tax returns, statements, or other forms prescribed by this agency, are required to include their social security numbers for proper identification. [See Title 42 United States Code Section 405(c)(2)(C)(i)]. It is mandatory to furnish all the appropriate information requested by applications for registration, applications for permits or licenses, tax returns and other related data. Failure to provide all of the required information requested by an application for a permit or license could result in your not being issued a permit or license. In addition, the law provides penalties for failure to file a return, failure to furnish specific information required, failure to supply information required by law or regulations, or for furnishing fraudulent information.

Provisions contained in the following laws require persons meeting certain requirements to file applications for registration, applications for permits or licenses, and tax returns or reports in such form as prescribed by the State Board of Equalization: Alcoholic Beverage Tax, Sections 32001-32556; Childhood Lead Poisoning Prevention Fee, Sections 43001-43651, Health & Safety Code, Sections 105275-105310; Cigarette and Tobacco Products Tax, Sections 30001-30481; Diesel Fuel Tax, Sections 60001-60709; Emergency Telephone Users Surcharge, Sections 41001-41176; Energy Resources Surcharge, Sections 40001-40216; Hazardous Substances Tax, Sections 43001-43651; Integrated Waste Management Fee, Sections 45001-45984; International Fuel Tax Agreement, Sections 9401-9433; Motor Vehicle Fuel License Tax, Sections 7301-8405; Occupational Lead Poisoning Prevention Fee, Sections 43001-43651, Health & Safety Code, Sections 105175-105197; Oil Spill Response, Prevention, and Administration Fees, Sections 46001-46751, Government Code, Sections 8670.1-8670.53; Publicly Owned Property, Sections 1840-1841; Sales and Use Tax, Sections 6001-7279.6; State Assessed Property, Sections 721-888, 4876-4880, 5011-5014; Tax on Insurers, Sections 12001-13170; Timber Yield Tax, Sections 38101-38908; Tire Recycling Fee, Sections 55001-55381, Public Resources Code, Sections 42860-42895; Underground Storage Tank Maintenance Fee, Sections 50101-50161, Health & Safety Code, Sections 25280-25299.96; Use Fuel Tax, Sections 8601-9355.

The principal purpose for which the requested information will be used is to administer the laws identified in the preceding paragraph. This includes the determination and collection of the correct amount of tax. Information you furnish to the Board may be used for the purpose of collecting any outstanding tax liability.

As authorized by law, information requested by an application for a permit or license could be disclosed to other agencies, including, but not limited to, the proper officials of the following: 1) United States governmental agencies: U.S. Attorney's Office; Bureau of Alcohol, Tobacco and Firearms; Depts. of Agriculture, Defense, Justice; Federal Bureau of Investigation; General Accounting Office; Internal Revenue Service; the Interstate Commerce Commission; 2) State of California governmental agencies and officials: Air Resources Board; Dept. of Alcoholic Beverage Control; Auctioneer Commission; Employment Development Department; Energy Commission; Exposition and Fairs; Food & Agriculture; Board of Forestry; Forest Products Commission; Franchise Tax Board; Dept. of Health Services; Highway Patrol; Dept. of Housing & Community Development; California Parent Locator Service; 3) State agencies outside of California for tax enforcement purposes; and 4) city attorneys and city prosecutors; county district attorneys, sheriff departments.

As an individual, you have the right to access personal information about you in records maintained by the State Board of Equalization. Please contact your local Board office listed in the white pages of your telephone directory for assistance. If the local Board office is unable to provide the information sought, you may also contact the Disclosure Office in Sacramento by telephone at (916) 445-2918. The Board officials responsible for maintaining this information, who can be contacted by telephone at (916) 445-6464, are: Sales and Use Tax, Deputy Director, Sales and Use Tax Department, 450 N Street, MIC:43, Sacramento, CA 95814; Excise Taxes, Fuel Taxes and Environmental Fees, Deputy Director, Special Taxes Department, 450 N Street, MIC:31, Sacramento, CA 95814; Property Taxes, Deputy Director, Property Taxes Department, 450 N Street, MIC:63, Sacramento, CA 95814.

\*All references are to the California Revenue and Taxation Code unless otherwise indicated.

Patent, Trademark Copyright  
Unfair Competition & Related  
Intellectual Property Matters

*Michael R. Diliberto*  
*Extension 3012*

*Admitted to California, Florida  
and District of Columbia Bar*

LAW OFFICES OF  
**KLEINBERG & LERNER, LLP**  
2049 CENTURY PARK EAST, SUITE 1080  
LOS ANGELES, CALIFORNIA 90067-3112  
TELEPHONE (310) 557-1511  
FACSIMILE (310) 557-1540  
[www.kleinberglerner.com](http://www.kleinberglerner.com)

WRITER'S EMAIL:  
[mdiliberto@kleinberglerner.com](mailto:mdiliberto@kleinberglerner.com)

May 21, 2002

**VIA EXPRESS MAIL AND**  
**VIA E-MAIL TO [INFO@ARB-FORUM.COM](mailto:INFO@ARB-FORUM.COM)**

NATIONAL ARBITRATION FORUM  
Post Office Box 50191  
Minneapolis, Minnesota 55405

Re: Domain Name Dispute Resolution  
COMPLAINT  
Von Eric Lerner Kalaydjian v. Simon Steinle  
Our Docket No. : 773225.13449

To the Forum:

Enclosed pursuant to the NAF Supplemental Rules are the prescribed NAF Complainant Transmittal Cover Sheet, our check in the amount of \$1,150.00, and three copies of the Complaint in the above-identified matter.

The Complainant Transmittal Cover Sheet and the Complaint are also being transmitted to the Forum as attachments via electronic mail to [info@arb-forum.com](mailto:info@arb-forum.com).

Please advise us at once via e-mail to [mdiliberto@kleinberglerner.com](mailto:mdiliberto@kleinberglerner.com) in the event that you identify any informalities that must be corrected.

Very truly yours,

KLEINBERG & LERNER, LLP



Michael R. Diliberto

MRD:cp  
Enclosures

Re: Von Eric Lerner Kalaydjian

## Complainant Transmittal Cover Sheet

**To:** Simon Steinle  
Dorfstr. 3  
Allmendingen, BW 89604  
DE  
[postmaster@sex.shop.new.net](mailto:postmaster@sex.shop.new.net); [Hallo\\_simon@hotmail.com](mailto:Hallo_simon@hotmail.com)

**From:** Michael R. Diliberto; KLEINBERG & LERNER LLP  
2049 Century Park East, Suite 1080  
Los Angeles, CA 90067  
Tel. (310) 557-1511; Fax (310) 557-1540  
[mdiliberto@kleinberglerner.com](mailto:mdiliberto@kleinberglerner.com)  
Attorneys for VON ERIC LERNER KALAYDJIAN, Complainant

**Cc:** National Arbitration Forum

**Date:** May 21, 2002

**Re:** SEX.SHOP.NEW.NET

---

The attached Complaint is being filed against you with the National Arbitration Forum (the "Forum") pursuant to the Model Domain Name Dispute Resolution Policy (the "Policy") as approved by New.net, Inc. ("New.net"), adopted by the Internet Corporation for Assigned Names and Numbers (ICANN) on October 24, 1999, and incorporated in your Registration Agreement with the Registrar of your domain name(s). By submitting this Complaint to the Forum, the Complainant agrees to abide and be bound by the provisions of the Policy, the New.net Rules, and the Forum's Supplemental Rules.

**Until you are notified by the Forum that a proceeding has commenced, you have no duty to act with regard to this Complaint.**

- The Forum will examine the Complaint to determine whether it conforms to the New.net Policy, Rules, and the Supplemental Rules.
- If the Complaint conforms to those standards, the Forum will forward an official copy of the Complaint to you.
- *Once the official Complaint is forwarded to you, you will have twenty (20) calendar days to submit a Response to both the Forum and the Complainant in accordance with the Policy, Rules, and Supplemental Rules.*
- You may seek legal assistance to represent you in this administrative proceeding.

The Policy and Rules governing this proceeding can be found at:

New.net Policy:	<a href="http://www.new.net/policiesdispute.tp">http://www.new.net/policiesdispute.tp</a>
New.net Rules:	<a href="http://www.new.net/policies_rules_old.tp">http://www.new.net/policies_rules_old.tp</a>
ICANN Policy	<a href="http://www.icann.org/udrp/udrp-policy-24oct99.htm">http://www.icann.org/udrp/udrp-policy-24oct99.htm</a>
ICANN Rules	<a href="http://www.icann.org/udrp/udrp-rules-24oct99.htm">http://www.icann.org/udrp/udrp-rules-24oct99.htm</a>
Forum Supplemental Rules	<a href="http://www.arb-forum.com/domains/domain-rules.html">http://www.arb-forum.com/domains/domain-rules.html</a>

Alternatively, you may contact the Forum to obtain any of the above documents.

Telephone: (800) 474-2371 or (651) 631-3700  
E-mail: [info@arb-forum.com](mailto:info@arb-forum.com)

***Please provide the Forum with the contact information (mailing address, e-mail address, telephone number) where the official Complaint and other communications in the administrative proceeding should be sent.***

  
**NATIONAL**  
**ARBITRATION**  
**FORUM**

VON ERIC LERNER KALAYDJIAN  
4226 Scandia Way  
Los Angeles, California 90065  
**(Complainant)**

v.

Simon Steinle  
Dorfstr. 3  
Allmendingen, BW 89604  
DE  
**(Respondent)**

**Domain Name In Dispute:**

**SEX.SHOP.NEW.NET**

**COMPLAINT IN ACCORDANCE WITH THE MODEL DOMAIN NAME DISPUTE  
RESOLUTION POLICY**

1. This Complaint is hereby submitted for decision in accordance with the Model Domain Name Dispute Resolution Policy, adopted by New.net, Inc. (New.net) on August 26, 1999 and approved by New.net on October 24, 1999 (New.net Policy), and the Rules for Model Domain Name Dispute Resolution Policy (New.net Rules), adopted by New.net on August 26, 1999 and approved by New.net on October 24, 1999, and the National Arbitration Forum (NAF) Supplemental Rules (Supp. Rules). New.net Rule 3(b)(i).
2. **COMPLAINANT INFORMATION**
  - a. Name: VON ERIC LERNER KALAYDJIAN
  - b. Address: 4226 Scandia Way  
Los Angeles, CA 90065
  - c. Telephone: 323/550-1221
  - d. Fax: 310/550-1221
  - e. E-Mail: [kamazonian@aol.com](mailto:kamazonian@aol.com)

Complainant's authorized representative in the administrative proceeding (New.net Rule 3(b)(ii)):

- a. Name: Michael R. Diliberto, c/o KLEINBERG & LERNER, LLP
- b. Address: 2049 Century Park East, Suite 1080  
Los Angeles, CA 90067-3112
- c. Telephone: 310/557-1511
- d. Fax: 310/557-1540
- e. E-Mail: mdiliberto@kleinberglerner.com

The Complainant's preferred method for communications directed to the Complainant in the administrative proceeding: New.net Rule 3(b)(iii):

Electronic-Only Material:

- a. Method: e-mail
- b. Address: mdiliberto@kleinberglerner.com
- c. Contact: Michael R. Diliberto

Material Including Hard Copy:

- a. Method: fax
- b. Address/Fax: Michael R. Diliberto  
KLEINBERG & LERNER, LLP  
2049 Century Park East, Suite 1080  
Los Angeles, CA 90067-3112  
Fax 310/557-1540
- c. Contact: Michael R. Diliberto

The Complainant chooses to have this dispute heard before a single-member administrative panel. New.net Rule 3(b)(iv).

3. RESPONDENT INFORMATION

- a. Name: Simon Steinle
- b. Address: Dorfstr. 3  
Allmendingen, BW 89604  
DE
- c. Telephone: none provided on New.net registry
- d. Fax: none provided on New.net registry
- e. E-Mail: postmaster@sex.shop.new.net; hallo\_simon@hotmail.com

4. DISPUTED DOMAIN NAME(S)

- a. The following domain name(s) is/are the subject of this Complaint (MDRP Rule 3(b)(vi)):

**SEX.SHOP.NEW.NET**

- b. Registrar Information (MDRP Rule 3(b)(vii)):

- i. Registrar's Name: New.net, Inc.
- ii. Registrar Address: 15260 Ventura Blvd., Suite 2000  
Sherman Oaks, CA 91403
- iii. Telephone Number: 818/385-2000
- iv. E-Mail Address: webmaster@new.net

- c. Trademark/Service Mark Information (MDRP Rule 3(b)(viii)): *[Specify the trademark(s) or service mark(s) on which the complaint is based and, for each mark, describe the goods or services if any, with which the mark is used (Complainant may also separately describe other goods and services with which it intends, at the time the complaint is submitted, to use the mark in the future.)]*

See attached Schedule A.

5. FACTUAL AND LEGAL GROUNDS

This Complaint is based on the following factual and legal grounds (New.net Rule 3(b)(ix)): *[The entire Complaint shall not exceed ten (10) pages. NAF Supp. Rule 4(a).]*

- a. **The domain name SEX.SHOP.NEW.NET is confusingly similar in sight, sound and meaning to the registered trademark of Kalaydjian.** *[Specify in the space below the manner in which the domain name(s) is/are identical or confusingly similar to a trademark or service mark in which the Complainant has rights. New.net Rule 3(b)(ix)(1); New.net Policy ¶ 4(a)(i).]*

The root of the domain name SEX.SHOP.NEW.NET, namely, the words SEX.SHOP, is identical in sight, sound and meaning to SEX.SHOP<sup>®</sup>, Complainant Kalaydjian's famous registered trademark and the root of Kalaydjian's registered domain names for SEX.SHOP.US, SEX-SHOP.US, SEX.SHOPS.US and SEX-SHOPS.US (see Schedule A). The mere addition of the letters "NEW.NET" to the confusingly identical domain name registered by Respondent has no relevance in this proceeding.

- b. **Simon Steidle has no right nor legitimate interest respecting the domain name SEX.SHOP.NEW.NET because Simon Steidle made no prior or current bona fide noncommercial or legitimate noncommercial use of the domain name SEX.SHOP.NEW.NET and was never commonly known by that domain name.** *[Specify in the space below why the Respondent (domain-name holder) should be considered as having no rights or legitimate interests in respect of the domain name(s) that is/are the subject of the complaint. New.net Rule 3(b)(ix)(2); New.net Policy ¶ 4(a)(ii).] [The Panel may consider any relevant aspects included in, but not limited to New.net Policy 4(c).]*

- (i.) Simon Steinle did not, before or after Kalaydjian notified him of this dispute, make use of SEX.SHOP.NEW.NET nor of any corresponding name in connection with any bona fide noncommercial offering of goods or services. Simon Steinle uses the SEX.SHOP.NEW.NET domain name for his pornographic, fee-based web site for sexually explicit materials. *[Whether, before any notice to the Respondent of the dispute, Respondent's use of, or demonstrable preparations to use, the domain name or a name corresponding to the domain name is in connection with a bona fide offering of goods or services; or]*

Complainant Kalaydjian searched the World Wide Web for evidence to determine whether Respondent Simon Steinle uses the domain name SEX.SHOP.NEW.NET for his web site on a noncommercial basis. A review of the Respondent's web site accessed by the domain name SEX.SHOP.NEW.NET shows that Respondent uses the domain name for a pornographic web site for commercial gain and profit, with no basis for a claim of fair use. Exhibit 2 attached contains pages from Respondent's web site, where Respondent's customers sign up for various fees-based accounts, such as a "Blue Account," "Gold Account," and "Platinum Account," to obtain access to Respondent's pornographic and sexually explicit materials. Respondent charges his customers a monetary fee to view and download Respondent's pornographic and sexually explicit materials through each of these accounts. Complainant is informed and believes that Respondent's confusingly similar domain name, SEX.SHOP.NEW.NET, is also used by Respondent to link to third-party pornographic websites, for commercial gain.

Complainant Kalaydjian therefore concludes that Respondent Simon Steinle has not, *at any time, let alone prior to being notified of this dispute*, made a legitimate non-commercial use of SEX.SHOP.NEW.NET, nor of any corresponding name, in connection with any bona fide offering of goods or services. Unless Respondent Simon Steinle carries his burden of bringing such evidence to light in this proceeding, the Panel must find that Respondent Simon Steinle has made no bona fide non-commercial use of the domain name SEX.SHOP.NEW.NET.

- (ii.) Simon Steinle was never commonly known by the domain name SEX.SHOP.NEW.NET *[Whether Respondent (as an individual, business, or other organization) has been commonly known by the domain name, even if Respondent has not acquired trademark or service mark rights; or]*

Complainant Kalaydjian has searched the World Wide Web and searched for U.S. trademark registrations or applications which might show that Respondent Simon Steinle is or has been commonly known by the domain name SEX.SHOP.NEW.NET, and has found none. Unless Respondent Simon Steinle carries his burden of demonstrating that he is or was commonly known by the domain name SEX.SHOP.NEW.NET, the Panel must find that Respondent Simon Steinle was never commonly known by the domain name.

- (iii.) Simon Steinle is not making any legitimate noncommercial or fair use of the domain name SEX.SHOP.NEW.NET, but rather intends for commercial gain to mislead and divert Kalaydjian's customers and tarnish Kalaydjian's registered trademark and domain names. *[Whether Respondent is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers or to tarnish the trademark or service mark at issue.]*

Having uncovered no evidence that Respondent Simon Steinle has been commonly known by the domain name SEX.SHOP.NEW.NET, Complainant Kalaydjian searched for evidence as to whether Simon Steinle is making a legitimate noncommercial or fair use of the domain name, without intent for commercial gain to misleadingly divert consumers from Complainant Kalaydjian or to tarnish Kalaydjian's trademark.

A review of the Respondent's web site accessed by the domain name SEX.SHOP.NEW.NET shows that Respondent uses the domain name for a pornographic web site for commercial gain and profit, with no basis for a claim of fair use. Exhibit 2 attached contains pages from Respondent's web site, where Respondent's customers sign up for various fee-based accounts, such as a "Blue Account," "Gold Account," and "Platinum Account," to obtain access to Respondent's pornographic and sexually explicit materials. Respondent charges his customers a monetary fees to view and download Respondent's pornographic and sexually explicit materials through each of these accounts. Complainant is informed and believes that Respondent's confusingly similar domain name, SEX.SHOP.NEW.NET, is also used by Respondent to link to third-party pornographic websites, for commercial gain.

In addition, Kalaydjian has found no information to support any conclusion as to what cause, issue, activity, or movement would be the focus of any legitimate use of the domain name SEX.SHOP.NEW.NET by Respondent Simon Steinle.

Unless Simon Steinle credibly explains his commercial use of the domain name SEX.SHOP.NEW.NET, the Panel should favor inferences that are compelled by business custom, by trademark usage and by common sense: that Respondent Simon Steinle is not making any legitimate noncommercial or fair use of the domain name SEX.SHOP.NEW.NET, but rather intends for commercial gain to mislead and divert Kalaydjian's customers and tarnish Kalaydjian's registered trademark or otherwise intends to extract a rent from Kalaydjian or Kalaydjian's competitors without giving value (see subsection c, *infra*).

**c. Simon Steinle registered the domain name SEX.SHOP.NEW.NET in bad faith.** [Specify in the space below why the domain name(s) should be considered as having been registered and being used in bad faith.] *New.net Rule 3(b)(ix)(3); New.net Policy ¶ 4(a)(iii).* [The Panel may consider any relevant aspects included in, but not limited to *New.net Policy 4(b)*]

The subparagraphs below are directed to the various acts of bad faith behavior – extorting, preempting, disrupting, misinforming, tarnishment – that are to be inferred from the registration of a domain name suspiciously identical to a famous trademark, in the apparent absence of legitimate non-commercial use or other fair use. The probable result – indeed, the probably intended result – of Respondent Simon Steinle's conduct should be determined in light of the following:

Complainant Kalaydjian has not authorized or licensed Respondent in any way to use or exploit Kalaydjian's trademark or domain names. Complainant Kalaydjian is the owner of a business, Amazon Cosmetics and Tan Products, whose business includes the design, development, manufacturing, sale and distribution of high quality skin tanning preparations throughout the United States and the world. Kalaydjian has developed a strong brand identity for the SEX.SHOP® line of skin tanning preparation products associated with Kalaydjian and the tremendous goodwill associated with Kalaydjian's trademark and domain names. From 2000 to the present, Kalaydjian has spent many thousands of dollars in marketing and advertising, all directly related to the SEX.SHOP® and SEX.SHOP.US, SEX-SHOP.US, SEX.SHOPS.US and SEX-SHOPS.US brand of skin tanning preparations and the goodwill associated with the SEX.SHOP® trademark and the SEX.SHOP.US, SEX-SHOPS, SEX.SHOPS.US and SEX-SHOPS.US .domain names.

Kalaydjian's sales have grown over the years in a manner commensurate with his marketing budget. Sales of skin tanning preparations under the SEX.SHOP® trademark and SEX.SHOP.US, SEX-SHOP.US, SEX.SHOPS.US and SEX.SHOPS.US domain names have accounted for a majority of Kalaydjian's sales on an annual basis for Kalaydjian's skin tanning preparations products in the United States.

As a result of Kalaydjian's advertising and promotion of his trademark and domain names, Kalaydjian's trademark and domain names were distinctive and famous long before the time of Respondent Simon Steinle's unauthorized registration of the domain name SEX.SHOP.NEW.NET.

Complainant Kalaydjian's famous mark creates a strong temptation for someone like Respondent Simon Steinle to associate himself in some way with Kalaydjian's trademark and thereby at no expense to himself acquire a salability for his own goods and services – or such goods or services as they or their successors may ultimately offer – which he would not otherwise have had. Such a free ride upon Kalaydjian's valuable goodwill and reputation would not only deprive Kalaydjian of control of a portion of his reputation and image and dilute his famous trademark, but would also deceive the public.

Respondent's use of the domain name, SEX.SHOP.NEW.NET, as a link to pornographic websites has tarnished and diluted Kalaydjian's registered trademark, SEX.SHOP®. These facts provide additional evidence of Respondent's bad-faith registration and use of his confusingly similar identical domain name.

- (i) **Simon Steinle registered the domain name SEX.SHOP.NEW.NET primarily for the purpose of extracting money from Kalaydjian or Kalaydjian's competitors** *[Whether there are circumstances indicating that Respondent has registered or has acquired the domain name primarily for the purpose of selling, renting, or otherwise transferring the domain name registration to the Complainant who is the owner of the trademark or service mark or to a competitor of that Complainant, for valuable consideration in excess of Respondent's documented out-of-pocket costs directly related to the domain name; or...]*

Simon Steinle registered the domain name SEX.SHOP.NEW.NET primarily for the purpose of extracting money from Kalaydjian or Kalaydjian's competitors. This is a compelling inference to be drawn from the available facts unless Simon Steinle offers the Panel some credible explanation of his registration and subsequent commercial use of the domain name SEX.SHOP.NEW.NET for a fee-based pornographic web site.

- (ii) **The Panel should request from Respondent Simon Steinle such information as the Panel deems helpful in determining whether Simon Steinle has engaged in a pattern of registering domain names in order to prevent trademark owners from reflecting their registered trademarks in a corresponding domain name.** *[Whether Respondent has registered the domain name in order to prevent the owner of the trademark or service mark from reflecting the mark in a corresponding domain name, provided that Respondent has engaged in a pattern of such conduct; or...]*

Respondent Simon Steinle's commercial use for profit of the domain name SEX.SHOP.NEW.NET leads Complainant Kalaydjian to suspect that Simon Steinle registered the domain name SEX.SHOP.NEW.NET in order to prevent Kalaydjian from reflecting Kalaydjian's registered trademarks in a corresponding "new.net" domain name. If this suspicion is borne out and is accompanied by evidence that Respondent Simon Steinle has engaged in a

pattern of such conduct, a compelling inference arises that Respondent Simon Steinle registered the domain name SEX.SHOP.NEW.NET. to prevent Kalaydjian from reflecting his registered trademark SEX.SHOP® in a corresponding “new.net” domain name.

The privacy policies of Registrars generally do not allow for Complainant Kalaydjian to query Registrars’ databases in a manner well suited to identifying the “pattern of such conduct” set forth in the second clause of New.net Policy 4(b)(ii). Moreover, such a “pattern” might well involve multiple corporations, partnerships, or individuals registering domain names with multiple Registrars in furtherance of such a pattern of conduct. Therefore, it would be burdensome to require Complainant Kalaydjian to complete the record on this point. Simon Steinle, as the Registrant, is the party better equipped to produce such evidence at a tolerable cost.

At the same time, it could easily contravene the principles of fairness underlying the New.net policies to deprive Complainant Kalaydjian of the benefit of discovering whether or not Respondent Simon Steinle is engaging in such a pattern. Rule 12 provides that “the Panel may request, in its sole discretion, further statements or documents from either of the Parties.” The Panel should request pursuant to Rule 12 that Simon Steinle provide such information as the Panel deems helpful in determining the issue of bad faith. Such information might well include:

- I. A list of all domain name registrations, with any Registrar, that have been procured by Simon Steinle, or by any other person or organization acting in concert with him;
- II. A list identifying all transactions in which Simon Steinle, or any other person or organization acting in concert with him has rented, sold, or surrendered a domain name to a third party, or sold, surrendered, or abandoned a domain name responsive to a request or demand from a third party who asserted rights in the domain name or in a similar mark.

Complainant would then request that the Panel draw the fairest possible inferences from the data produced by Respondent pursuant to that request, or, in the alternative, should the Respondent’s reply appear to be omissive or evasive, that the Panel draw inferences unfavorable to Respondent.

**(iii.) Simon Steinle registered the domain name SEX.SHOP.NEW.NET primarily for the purpose of disrupting Kalaydjian’s business.** *[Whether Respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor, or...]*

Unless Respondent Simon Steinle explains his apparent intentional registration and use of the domain name SEX.SHOP.NEW.NET, which is identical to Kalaydjian’s registered trademark SEX.SHOP®, the circumstances support an inference that Simon Steinle registered the domain name SEX.SHOP.NEW.NET primarily for the purpose of disrupting Kalaydjian’s business.

**(iv.) Simon Steinle intends for commercial gain to attract Internet users to an on-line location by creating a likelihood of confusion with Kalaydjian's registered trademark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.** *[Whether by using the domain name, Respondent has intentionally attempted to attract, for commercial gain, Internet users to Respondent's web site or other on-line location, by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of Respondent's web site or location or of a product or service on Respondent's web site or location.]*

Unless Respondent Simon Steinle explains his apparent intentional registration and use of the domain name SEX.SHOP.NEW.NET, which is identical to Kalaydjian's registered trademark SEX.SHOP®, the circumstances support an inference that Simon Steinle intends for commercial gain in the future to attract Internet users to SEX.SHOP.NEW.NET by creating a likelihood of confusion with Kalaydjian's registered trademark as to the source, sponsorship, affiliation, or endorsement of SEX.SHOP.NEW.NET, or of a product or service on Respondent Simon Steinle's pornographic web site accessed by the domain name SEX.SHOP.NEW.NET.

#### 6. REMEDY SOUGHT

The Complainant requests that the Panel issue a decision that the domain-name registration be transferred. New.net Rule 3(b)(x); New.net Policy ¶ 4(i).

#### 7. OTHER LEGAL PROCEEDINGS *[Identify any other legal proceedings that have been commenced or terminated in connection with or relating to any of the domain name(s) that are the subject of the complaint.] New.net Rule 3(b)(xi).*

There are no other legal proceedings that have been commenced or terminated in connection with or relating to Kalaydjian's domain names SEX.SHOP.US, SEX-SHOP.US, SEX.SHOPS.US and SEX-SHOPS.US.

#### 8. COMPLAINT TRANSMISSION

The Complainant asserts that a copy of this Complaint, together with the cover sheet as prescribed by NAF's Supplemental Rules, has been sent or transmitted to the Respondent (domain-name holder), in accordance with New.net Rule 2(b). New.net Rule 3(b)(xii); NAF Supp. Rule 4(c).

#### 9. MUTUAL JURISDICTION

The Complainant will submit, with respect to any challenges to a decision in the administrative proceeding canceling or transferring the domain name, to the location of the principal office of the concerned registrar in Sherman Oaks, California. New.net Rule 3(b)(xiii).

#### 10. CERTIFICATION

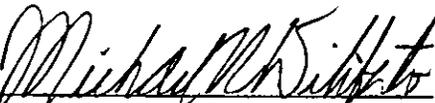
Complainant agrees that his claims and remedies concerning the registration of the domain name, the dispute, or the dispute's resolution shall be solely against the domain-name holder and waives all such claims and remedies against (a) the National Arbitration Forum and panelists,

except in the case of deliberate wrongdoing, (b) the registrar, (c) the registry administrator, and (d) New.net, as well as its directors, officers, employees, and agents.

Complainant certifies that the information contained in this Complaint is to the best of Complainant's knowledge complete and accurate, that this Complaint is not being presented for any improper purpose, such as to harass, and that the assertions in this Complaint are warranted under these Rules and under applicable law, as it now exists or as it may be extended by a good-faith and reasonable argument.

Respectfully Submitted,

KLEINBERG & LERNER, LLP

By:   
Michael R. Diliberto

Attorney for Complainant, VON  
ERIC LERNER KALAYDJIAN

May 21, 2002

[Date]

*[Annex any documentary or other evidence, including a copy of the Policy applicable to the domain name(s) in dispute and any trademark or service mark registration upon which the complaint relies, together with a schedule indexing such evidence.] New.net Rule 3(b)(xv).*

*[The Complaint, not including annexed material, shall not exceed ten (10) pages.] NAF Supp. Rule 4(a).*

*[The Complainant shall submit three (3) copies of the Complaint, including annexed material, to the National Arbitration Forum if the Complainant requested a single-member panel. If the Complainant requested a three (3) member panel, the Complainant shall submit five (5) copies of the Complaint, including annexed material, to the National Arbitration Forum. If the Respondent requests a three (3) member panel, the Complainant may be asked to submit additional copies of the Complaint.] NAF Supp. Rule 4(b).*

## SCHEDULE A

### Kalaydjian's Registered Trademark for SEX.SHOP®

1. Kalaydjian registered his mark SEX.SHOP®, U.S. Registration Number 2,461,859, with a date of first use, June 26, 2000, for skin tanning preparations, namely tanning oils in International Class 3, Exhibit 1 attached.

### Kalaydjian's SEXSHOP.US Domain Name:

2. On April 19, 2002, Kalaydjian registered his domain name SEXSHOP.US with the domain name registrar, NeuStar, Inc.

### Kalaydjian's SEX-SHOP.US Domain Name:

3. On April 20, 2002, Kalaydjian registered his domain name SEX-SHOP.US with the domain name registrar, NeuStar, Inc.

### Kalaydjian's SEXSHOPS.US Domain Name:

4. On April 19, 2002, Kalaydjian registered his domain name SEXSHOPS.US with the domain name registrar, NeuStar, Inc.

### Kalaydjian's SEX-SHOPS.US Domain Name:

5. On April 19, 2002, Kalaydjian registered his domain name SEX-SHOPS.US with the domain name registrar, NeuStar, Inc.

*Von Eric Lerner Kalaydjian v. Simon Steinle*

**Table of Contents of the Evidence in Support of  
Complainant Von Eric Lerner Kalaydjian's  
Domain Name Dispute Complaint:**

- Exhibit 1: Kalaydjian's Federal Trademark Registration for the mark, SEX.SHOP®, U.S. Registration No. 2,461,859.
- Exhibit 2: Pages from the Respondent's fee-based pornographic web site accessed by the domain name SEX.SHOP.NEW.NET.



## UNITED STATES PATENT AND TRADEMARK OFFICE

## Trademark Electronic Search System (TESS)

TESS was last updated on Sat May 18 04:10:51 EDT 2002

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP

Logout

Please logout when you are done to release system resources allocated for you.

## Record 1 out of 1

Check Status

*(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)*

### Typed Drawing

**Word Mark** SEX.SHOP  
**Goods and Services** IC 003. US 001 004 006 050 051 052. G & S: skin tanning preparations, namely tanning oils.  
 FIRST USE: 20000301. FIRST USE IN COMMERCE: 20000626  
**Mark Drawing Code** (1) TYPED DRAWING  
**Serial Number** 76092746  
**Filing Date** July 17, 2000  
**Published for Opposition** March 27, 2001  
**Registration Number** 2461859  
**Registration Date** June 19, 2001  
**Owner** (REGISTRANT) Kalaydjian, Von Eric Lerner INDIVIDUAL UNITED STATES 4226 Scandia Way Los Angeles CALIFORNIA 90065  
**Attorney of Record** ALEX D. PATEL  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL  
**Live/Dead Indicator** LIVE

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT TOP HELP

20.05.2002

User:

Pass:

[Anmelden](#) [Abmelden](#)

**HAUPTÜBERSICHT**

**BILDER**

**VIDEOS**

**XXX-FILME**

**SEX-CHAT**

**XXL-SPECIAL**

**SPANNER LOUNGE**

**WEB-CAMS**

**BORDELLFÜHRER**

**KONTAKTMARKT**

**SOFORTZUGANG**

**CASINO WELT**

**WEBMASTER WERDEN**

**SEX-CENTER**



**SEX-CENTER KONTAKTE**



Ich will gef\*\*\*  
werden! Hast  
Du Lust?

[Zum Video!](#)

**SEX-CENTER VIDEO**



Gratis Strip in  
Top Qualität.  
Von heißen  
Girls!

[Zum Video!](#)

**GIRL DES TAGES**



[Klick hier für mehr!](#)

**NEUE VIDEOS**

6 Neue Amateur  
Paar und Lesben  
Videos ...



[mehr ...](#)

**10 NEUE CAMS**

10 Ultrascharfe neue  
Web-Cams mit 4  
Brasil-Girl Cams!



[mehr ...](#)

**NEUE GGG-MOVIES**

Neue Hardcore-  
Hochglanz-Movies in  
voller Spielfilm  
Länge!



[mehr ...](#)

**NEUE GIRLY PICS**

2479 neue Girl-Pics!  
Über 180.000 Bilder  
warten auf Dich!



[mehr ...](#)

[Impressum](#)

[AGB](#)

[E-MAIL](#)

**EXHIBIT 2**





## EDEN MITGLIEDER ANMELDUNG

Hier kannst Du Dich für einen heißen **EDEN Account** anmelden.  
Du hast die Auswahl zwischen unseren **3 Mega XXL Paketen**

### BLUE ACCOUNT



1 EURO MONATLICH

### GOLD ACCOUNT



4 EURO MONATLICH

### PLATIN ACCOUNT



9 EURO MONATLICH

### VIP ZUGANG



VOICECALL - DAILER

## BLUE ACCOUNT

**Das Super Eröffnungsangebot**  
(verlängert bis zum 30.04.2002)  
für nur 1 Euro im Monat

Mit einem Blue Account hast Du uneingeschränkten Zugang auf nachfolgende EDEN Bereiche

### -1- Hardcore Pics

- 5.000 Hardcore Girl Bilder
- 1.000 Hardcore Gay Bilder
- 6.000 Hardcore Paar Bilder
- 2.000 Hardcore fetisch Bilder
- 4.000 Hardcore Lesben Bilder
- 10.000 Hardcore Amateur Bilder

### -2- Hardcore Movies

- 700 Minuten Hardcore Girl Videos
- 500 Minuten Hardcore Paar Videos
- 200 Hardcore Lesben Videos

### -3- Ausserdem

- 25.000 Amateur Webcam
- 70 Prof. Webcams
- 10 Sex Chat
- 100 Kontaktpartner
- Betätigung Club
- Hardcore Videotext
- und und und



Insgesamt erwarten Dich über 35.000  
XXX-Bilder und über 5.000 Minuten  
Videos

### TÄGLICHE AKTUALISIERUNG !

Für 3 Cent am Tag Monats-Mitglied  
werden!

**ANMELDEN**

### JAHRES-SPECIAL!

Für 2 Cent am Tag Jahres-Mitglied  
werden!

**ANMELDEN**

### VIP 100% ANONYM

Anonymer Sofortzugang zum  
superschnellen Sexserver zu allen  
Bereichen, ohne Wartezeit!

### ZUGANG VIA MODEM / ISDN



### ZUGANG VIA DSL / LAN / KABEL

EXHIBIT 2



## GOLD ACCOUNT (Nur 4 Euro im Monat)

Mit einem Gold Account hast Du uneingeschränkten Zugang auf nachfolgende EDEN Bereiche

### -1- Hardcore Pics

- 70.000 Hardcore Girl Bilder
- 10.000 Hardcore Gay Bilder
- 50.000 Hardcore Paar Bilder
- 30.000 Hardcore Fetisch Bilder
- 60.000 Hardcore Lesben Bilder
- 80.000 Hardcore Amateur Bilder

plus 280.000 USA Hardcorebilder aus allen Kategorien

### -2- Hardcore Movies

- 700 Minuten Hardcore Girl Videos
- 500 Minuten Hardcore Paar Videos
- 200 Hardcore Lesben Videos

### -3- Ausserdem

- 25.000 Amateur Webcams
- 70 Prof. Webcams
- 10 Sex-Chat
- Virtualkontaktmarkt
- Seitensprung Club
- Hardcore Videotext
- und und und



Insgesamt erwarten Dich über 500.000 XXX-Bilder und über 5.000 Minuten Videos

### TÄGLICHE AKTUALISIERUNG !

Für 13 Cent am Tag Monats-Mitglied werden!

**ANMELDEN**

### JAHRES-SPECIAL!

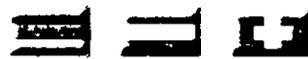
Für 10 Cent am Tag Jahres-Mitglied werden!

**ANMELDEN**

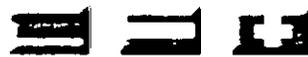
### VIP 100% ANONYM

Anonymer Sofortzugang zum superschnellen Sexserver zu allen Bereichen, ohne Wartezeit!

### ZUGANG VIA MODEM / ISDN



### ZUGANG VIA DSL / LAN / KABEL



## PLATIN ACCOUNT (Nur 9 Euro im Monat)

Mit einem Platin Account hast Du uneingeschränkten Zugang auf nachfolgende EDEN Bereiche

EXHIBIT 2

**-1- Hardcore Pics**

- 70.000 Hardcore Girl Bilder
- 10.600 Hardcore Gay Bilder
- 50.000 Hardcore Paar Bilder
- 30.000 Hardcore fetisch Bilder
- 60.000 Hardcore Lesben Bilder
- 30.000 Hardcore Amateur Bilder

plus 280.000 USA Hardcorebilder  
aus allen Kategorien

**-2- Hardcore Movies**

- 7000 Minuten Hardcore Ein Videos
- 3000 Minuten Hardcore Paar Videos
- 2000 Hardcore Lesben Videos

plus 25.000 Minuten USA Hardcore  
Live-Feeds und Videos aus allen  
Kategorien

**-3- Ausserdem**

- 20.000 Amateur Webcam
- 70 Prof. Webcams
- 10 Sex-Chat
- Kiki-Kontaktmarkt
- Satisforsprung Club
- Hardcore Videoboth
- und und und

plus 25 USA Voyeur-Cams aus allen  
Kategorien



Insgesamt erwarten Dich über 500.000  
XXX-Bilder , über 45.000 Minuten Videos  
und 25 Voyeur Cams

**TÄGLICHE AKTUALISIERUNG !**

Für 30 Cent am Tag Monats-Mitglied  
werden!

**ANMELDEN**

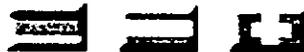
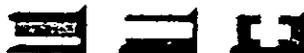
**JAHRES-SPECIAL!**

Für 24 Cent am Tag Jahres-Mitglied  
werden!

**ANMELDEN**

**VIP 100% ANONYM**

Anonymer Sofortzugang zum  
superschnellen Sexserver zu allen  
Bereichen, ohne Wartezeit!

**ZUGANG VIA MODEM / ISDN****ZUGANG VIA DSL / LAN / KABEL**

**EXHIBIT 2**



**NETWORK SOLUTIONS**

PO BOX 1656 • Herndon • VA • 20172-1656

## DEACTIVATION NOTICE

**Von Kalydjian**  
**ATTN: President/CEO**  
**4226 SCANDIA WAY**  
**LOS ANGELES, CA 90065-4329**



**Date:** MAR-30-2000  
**Domain Name:** BANKBOWL.COM  
**Invoice Number:** 18388953  
**Amount Due:** 70.00

This letter is being sent as a courtesy to advise you that our records show payment for the web address referenced above has not been received. We appreciate that there are many possible reasons for this and want to reconcile our records. Our records show that the following person has been designated as the Billing Contact for the web address in question:

**Von E Kalydjian**  
**Von Kalydjian**  
**4226 Scandia Way**  
**Los Angeles, CA 90065**  
**United States**

If you believe that the payment and this notice may have crossed paths, please verify the payment status by calling 1-888-771-3000 from the U.S., Canada, Puerto Rico, and the U.S. Virgin Islands. From other locations call 1-402-496-9798.

If payment is not received within **10 days** from the date of this notice, web address service will be discontinued.

**To Pay By Credit Card  
or Confirm Payment:**

We accept all major credit cards 24 hours per day, seven days a week. Go to <https://payments.networksolutions.com> on the World-Wide Web to use Network Solutions' Secure On-Line Payment System.

**Or:**

Call 1-888-771-3000 toll-free from the United States, Canada, Puerto Rico and the U.S. Virgin Islands. Outside of these areas, call 1-402-496-9798.

**To Pay on  
Account:**

Send e-mail to [accounts@networksolutions.com](mailto:accounts@networksolutions.com) with the web address, invoice number, and 16-digit Account Number you were assigned when you established your debit account.

For all other billing inquiries send e-mail to [billing@networksolutions.com](mailto:billing@networksolutions.com), or call 1-703-742-4777 Monday through Friday from 7:00am to 9:00pm Eastern Time.

## DEACTIVATION NOTICE

LEAD SHEET

01 1039013

RECORDED/FILED IN OFFICIAL RECORDS  
RECORDER'S OFFICE  
LOS ANGELES COUNTY  
CALIFORNIA  
2:21 PM JUN 15 2001

SPACE ABOVE THIS LINE FOR RECORDERS USE

TITLE(S)

Fictitious Name Statement

FEE

D.T.T.

FEE \$ 18.00 BG

CODE

20

CODE

19

CODE

9

Assessor's Identification Number (AIN)

To Be Completed By Examiner OR Title Company In Black Ink

Number of Parcels Shown

THIS FORM IS NOT TO BE DUPLICATED

**A** Mailing Address:

REGISTRAR - RECORDER / COUNTY CLERK's FILING STAMP

Name: VON ERIC Lerner Kalaydjian  
 Address: 4226 SCANDIA WAY  
 City: L.A. CA 90065

**01 1039013**

**1**  First Filing  Renewal Filing  
 With Changes

**FICTITIOUS BUSINESS NAME STATEMENT**

THE FOLLOWING PERSON(S) IS (ARE) DOING BUSINESS AS: (Attach additional pages if required)

**2** Fictitious Business Name(s)  
 1. SEX • INFO 3 SEX DOT INFO 5 SEX DOT WEB  
 2. SEX • SHOP 4 SEX DOT SHOP  
 Articles of Incorporation or Organization Number (if applicable)  
 AI #/ON

**3** Street Address & City of Principal Place of Business in California (P.O. Box alone not acceptable) Zip Code  
4226 SCANDIA WAY L.A. CA 90065

**4** Full name of Registrant (if corporation - incorporated in what state)  
VON ERIC Lerner Kalaydjian

Residence Street Address City State Zip Code  
4226 SCANDIA WAY L.A. CA 90065

**4A** Full name of Registrant (if corporation - incorporated in what state)

Residence Street Address City State Zip Code

**4B** Full name of Registrant (if corporation - incorporated in what state)

Residence Street Address City State Zip Code

**5** This Business is conducted by: (check one only)  
 an individual ( ) a general partnership ( ) joint venture ( ) a business trust  
 co-partners ( ) husband and wife ( ) a corporation ( ) a limited partnership  
 an unincorporated association other than a partnership ( ) a limited liability company

**6** Type of Business: ONLINE AND OFFLINE RETAIL SALES OF SUN TANNING PRODUCTS AND T-SHIRTS  
 Examples: Auto Repairing, Beauty Salon, Landscaping

**7**  The registrant commenced to transact business under the fictitious business name or names listed on (Date): MARCH 1, 2000  
 Registrant has not yet begun to transact business under the fictitious business name or names listed herein.

<p><b>8</b> If Business is not a corporation/limited liability, sign below:</p> <p><u>Von Eric Lerner Kalaydjian</u>                  SIGNATURE TYPE OR PRINT NAME</p> <p>_____                  SIGNATURE TYPE OR PRINT NAME</p> <p>_____                  SIGNATURE TYPE OR PRINT NAME</p> <p>_____                  SIGNATURE TYPE OR PRINT NAME</p>	<p><b>8A</b> If Business is a corporation/limited liability co.:</p> <p>_____                  CORPORATION/LIMITED LIABILITY CO.</p> <p>_____                  SIGNATURE</p> <p>_____                  TITLE</p> <p>_____                  TYPE OR PRINT OFFICERS NAME AND TITLE</p>
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This statement was filed with the County Clerk of LOS ANGELES County on date indicated by file stamp above.

NOTICE - THIS FICTITIOUS NAME STATEMENT EXPIRES FIVE YEARS FROM DATE IT WAS FILED IN THE OFFICE OF THE COUNTY CLERK. A NEW FICTITIOUS BUSINESS NAME STATEMENT MUST BE FILED PRIOR TO THAT DATE. The filing of this statement does not of itself authorize the use in this state of a fictitious business name in violation of the rights of another under federal, state, or common law (See Section 14400 et seq., Business and Professions Code)