

TAB

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



04-04-2003

U.S. Patent & TMOfc/TM Mail Rcpt Dt. #58

Lisa Frank, Inc.,  
Opposer

v.

Rose Art Industries, Inc.

Application Serial No. 78-133307

**NOTICE OF OPPOSITION**

Opposer, Lisa Frank, Inc., an Arizona Corporation ("Opposer"), located and doing business at 6760 S. Lisa Frank Ave., Tucson, AZ 85706, believes that it will be harmed by the registration of the mark, "RAINBOW COLOR CASE", shown in Application Serial No. 78-133307 filed June 5, 2002 by Rose Art Industries, Inc. ("Applicant") for goods classified in International Class 016 and hereby opposes the same. A description of the Applicant's application is as follows:

MARK: RAINBOW COLOR CASE

SERIAL NO.: 78-133307

FILED: June 5, 2002

CLASS: 016

GOODS: SET CONTAINING ART SUPPLIES; NAMELY, MARKERS, CRAYONS, PENCILS, SCISSORS, PAINTS, A PAINT CADDY, AND ARTISTS BRUSH AND CHALK, SOLD IN A PLASTIC CASE WITH A HANDLE.

04/18/2003 11:09:31

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01 FC:6402

300.00 OP

As grounds for the opposition, Opposer alleges that:

1. For several years and long prior to the use of Applicant, Opposer has been engaged in the manufacture and sale of stationery items, writing instruments, paint and drawing sets for children and related goods for children bearing the mark, RAINBOW CHASER (Registration Nos. 1846209 and 1901259) as well as the mark RAINBOW REEF (Registration No. 2288083).
2. Opposer is also the owner of and relies on its common law rights in the trademarks, RAINBOW CHASER and RAINBOW REEF. Opposer has continuously used RAINBOW CHASER in interstate commerce since at least as early as December 9, 1991 and has continuously used RAINBOW REEF in interstate commerce since at least as early as September 28, 1995. The use of these marks has gained a reputation and recognition among customers as being affiliated with Lisa Frank, Inc.
3. Opposer is the owner of Registration No.s 1846209 and 1901259 for RAINBOW CHASER and Registration No. 2288083 for RAINBOW REEF shown in the TARR records attached as Exhibit "A" through "C", respectively, to this Notice of Opposition.
4. Applicant is a direct competitor of Opposer in the children's market, including, but not limited to, the market in stationery, writing instruments, paint and drawing sets for children, and related goods. Applicant's goods and Opposer's goods travel in precisely the same channels of trade and are evaluated for purchase by the same buying entities in the retail distribution chain.
5. Opposer's primary customers for its RAINBOW COLOR CASE goods would be indistinguishable from those of the intended customers of Applicant's goods and their customer bases overlap.

6. Applicant's adoption of RAINBOW COLOR CASE is confusingly similar to Opposer's marks, RAINBOW CHASER and RAINBOW REEF, and its use by Applicant is likely to create confusion, deception, and mistake. Applicant's use of the mark, RAINBOW COLOR CASE, interferes with Opposer's use of the marks, RAINBOW CHASER and RAINBOW REEF for this purpose and will cause injury to Opposer.
7. In view of the similarity of the respective marks and the direct competition between Opposer and Applicant who sell the same goods to the same customers in the same channels of trade, it is alleged that Applicant's mark is confusingly similar to Opposer's pre-existing marks and that Applicant's adoption, use, and registration of the mark is likely to cause confusion, or to cause mistake, or to deceive potential buyers of Opposer's products.

Wherefore, Opposer requests that Application Serial No. 78-133307 be rejected and stricken, that no registration be issued thereon to Applicant, and that this opposition be sustained with prejudice in favor of Opposer.

Dated: April 2, 2003

Respectfully submitted,



Anne Aikman-Scalese, Esq.

Attorney for Opposer

Lisa Frank, Inc.

6760 S. Lisa Frank Ave.

Tucson, AZ 85706

Phone: (520) 547-1412

Fax: (520) 547-1413

[aaikman@lisafrank.com](mailto:aaikman@lisafrank.com)

### Certificate of First Class Mailing

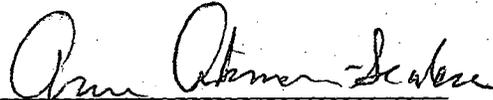
Date of Deposit: April 2, 2003. I hereby certify that the Notice of Opposition to Serial No. 78/133307, RAINBOW COLOR CASE, in Class 16 is being deposited with the United States Postal Service on the date indicated above with sufficient first class postage and is addressed to the Commissioner for Trademarks, Trademark Trial and Appeal Board, Box TTAB FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.



Anne Aikman-Scalise  
Legal Affairs Manager  
Lisa Frank, Inc.  
6760 S. Lisa Frank Ave.  
Tucson, AZ 85706  
Phone: (520) 547-1412  
Fax: (520) 547-1413

### Certificate of Service

The undersigned hereby certifies that the foregoing Notice of Opposition to Serial No. 78-133307, RAINBOW COLOR CASE, in Class 16 was served on Applicant, Rose Art Industries, Inc. by mailing a true copy, by first class mail on April 2, 2003, postage prepaid, to the Applicant at the designated correspondence address of Robert W. Smith, McCarter & English, LLP, Four Gateway Center, 100 Mulberry Street, Newark, NJ ~~07102~~ 07101 - 0652



Anne Aikman-Scalise  
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Exhibit "A"

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-03-26 14:24:22 ET

Serial Number: 74325765

Registration Number: 1846209

Mark (words only): RAINBOW CHASER

Current Status: Section 8 and 15 affidavits have been accepted and acknowledged.

Date of Status: 2000-02-07

Filing Date: 1992-10-26

Registration Date: 1994-07-19

Law Office Assigned: TMEQ Law Office #12

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

Current Location: 900 - Warehouse (Newington)

Date In Location: 2000-02-09

#### CURRENT APPLICANT(S)/OWNER(S)

T. Lisa Frank, Inc.

**Address:**

Lisa Frank, Inc.  
6760 South Lisa Frank Avenue  
Tucson, AZ 85750  
United States

**State or Country of Incorporation:** Arizona

**Legal Entity Type:** Corporation

#### GOODS AND/OR SERVICES

stickers, sticker albums and books, notebooks, folders, binders; paper party goods; namely, hats, invitations, napkins, and tablecloths; paper giftwrap, stationery; pencils and pens; erasers, paper clips, diaries; drawing rulers, rubber stamps and pads, stamp rings; word and maze puzzles on paper; coloring books, color markers, stencils, puzzle pads, playing cards, paint sets for children; and activity sets consisting variously of two or more of the preceding items.

**International Class:** 016

**First Use Date:** 1991-12-09

**First Use in Commerce Date:** 1992-04-19

**Basis:** 1(a)

### ADDITIONAL INFORMATION

**Disclaimer:** "RAINBOW"

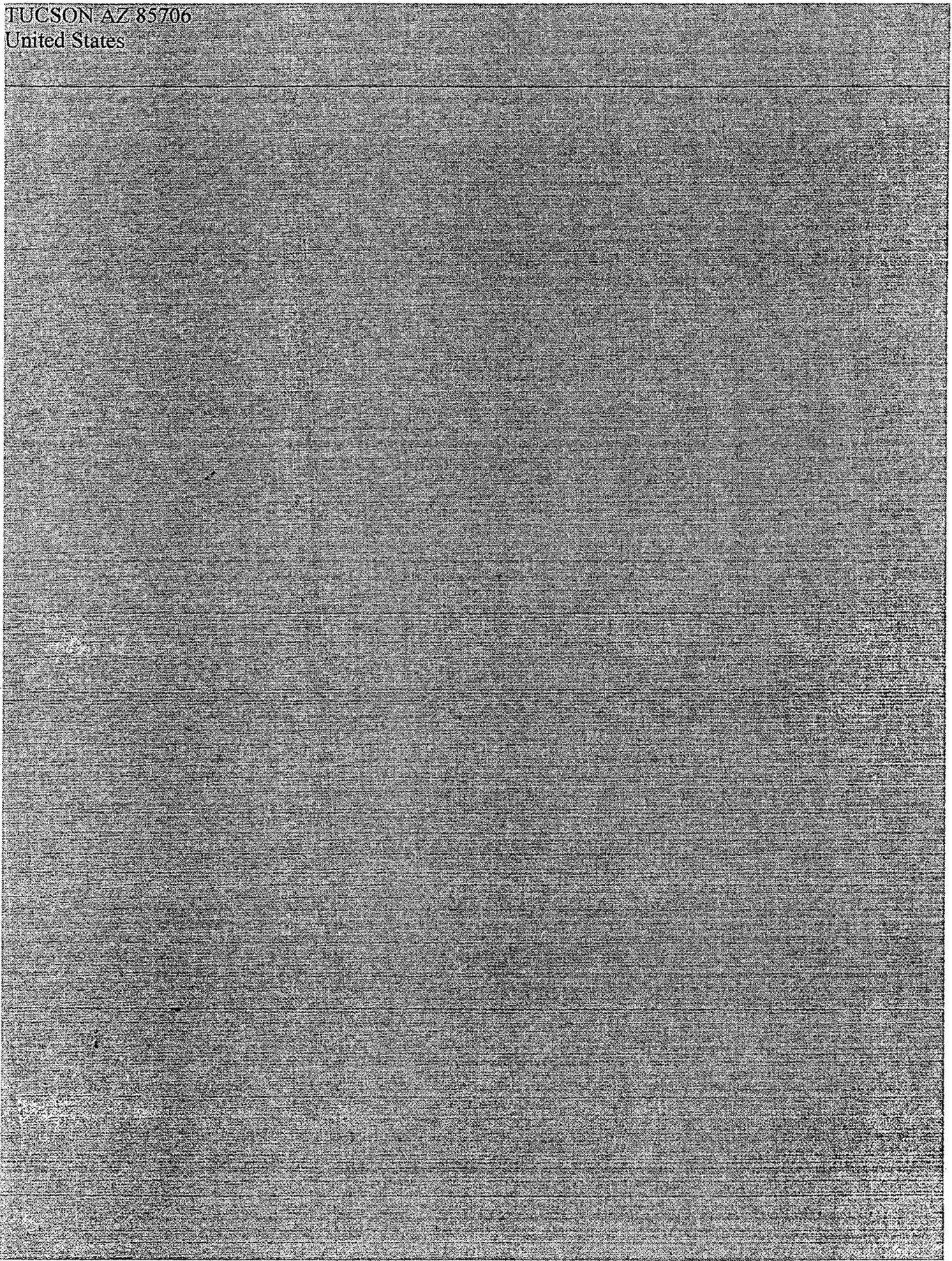
### PROSECUTION HISTORY

2002-03-08 - TEAS Change of Correspondence Received  
2000-02-07 - Section 8 (6-year) accepted & Section 15 acknowledged  
1999-10-04 - Section 8 (6-year) and Section 15 Filed  
1999-02-11 - Cancellation terminated for Proceeding  
1998-08-20 - Cancellation dismissed for Proceeding  
1994-12-06 - Cancellation instituted for Proceeding  
1994-07-19 - Registered - Principal Register  
1994-04-25 - Allowed for Registration - Principal Register (SOU accepted)  
1994-04-11 - Statement of use processing complete  
1994-03-04 - Amendment to Use filed  
1993-09-07 - Notice of allowance - mailed  
1993-04-13 - Published for opposition  
1993-03-12 - Notice of publication  
1993-01-21 - Approved for Pub - Principal Register (Initial exam)  
1993-01-14 - Examiner's amendment mailed  
1993-01-12 - Case file assigned to examining attorney  
1993-01-08 - Case file assigned to examining attorney

### CONTACT INFORMATION

**Correspondent (Owner)**  
ANNE AIKMAN SCALESE  
LISA FRANK, INC  
6760 S. LISA FRANK AVE.

TUCSON AZ 85706  
United States



**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2003-03-26 14:24:56 ET.**

**Serial Number:** 74325766

**Registration Number:** 1901259

**Mark (words only):** RAINBOW CHASER

**Current Status:** Section 8 and 15 affidavits have been accepted and acknowledged.

**Date of Status:** 2001-08-07

**Filing Date:** 1992-10-26

**Registration Date:** 1995-06-20

**Law Office Assigned:** TMEQ Law Office #12

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)**

**Current Location:** 900 Warehouse (Newington)

**Date In Location:** 2001-08-09

#### CURRENT APPLICANT(S)/OWNER(S)

I. LISA FRANK INC

**Address:**

LISA FRANK INC  
6760 S LISA FRANK AVE  
TUCSON, AZ 85706  
United States

**State or Country of Incorporation:** Arizona

**Legal Entity Type:** Corporation

#### GOODS AND/OR SERVICES

toy figures, stuffed toy animals, and plush toys

**International Class:** 028

**First Use Date:** 1993-09-00

**First Use in Commerce Date:** 1993-09-00

**Basis:** 1(a)

**ADDITIONAL INFORMATION**

**Disclaimer:** "RAINBOW"

**PROSECUTION HISTORY**

2002-03-08 - TEAS Change of Correspondence Received  
2001-08-07 - Section 8 (6-year) accepted & Section 15 acknowledged  
2001-06-14 - Section 8 (6-year) and Section 15 Filed  
1995-06-20 - Registered - Principal Register  
1995-03-23 - Allowed for Registration - Principal Register (SOU accepted)  
1995-03-16 - Statement of use processing complete  
1994-12-13 - Amendment to Use filed  
1994-07-13 - Extension 2 granted  
1994-06-01 - Extension 2 filed  
1994-02-04 - Extension 1 granted  
1993-12-14 - Extension 1 filed  
1993-06-15 - Notice of allowance - mailed  
1993-03-23 - Published for opposition  
1993-02-19 - Notice of publication  
1993-01-25 - Approved for Pub - Principal Register (Initial exam)  
1993-01-14 - Examiner's amendment mailed  
1993-01-12 - Case file assigned to examining attorney  
1993-01-08 - Case file assigned to examining attorney

**CONTACT INFORMATION**

**Correspondent (Owner)**  
ANNE AIKMAN-SCALESE  
LISA FRANK, INC.  
6760 S. LISA FRANK AVE.  
TUCSON AZ 85706

United States

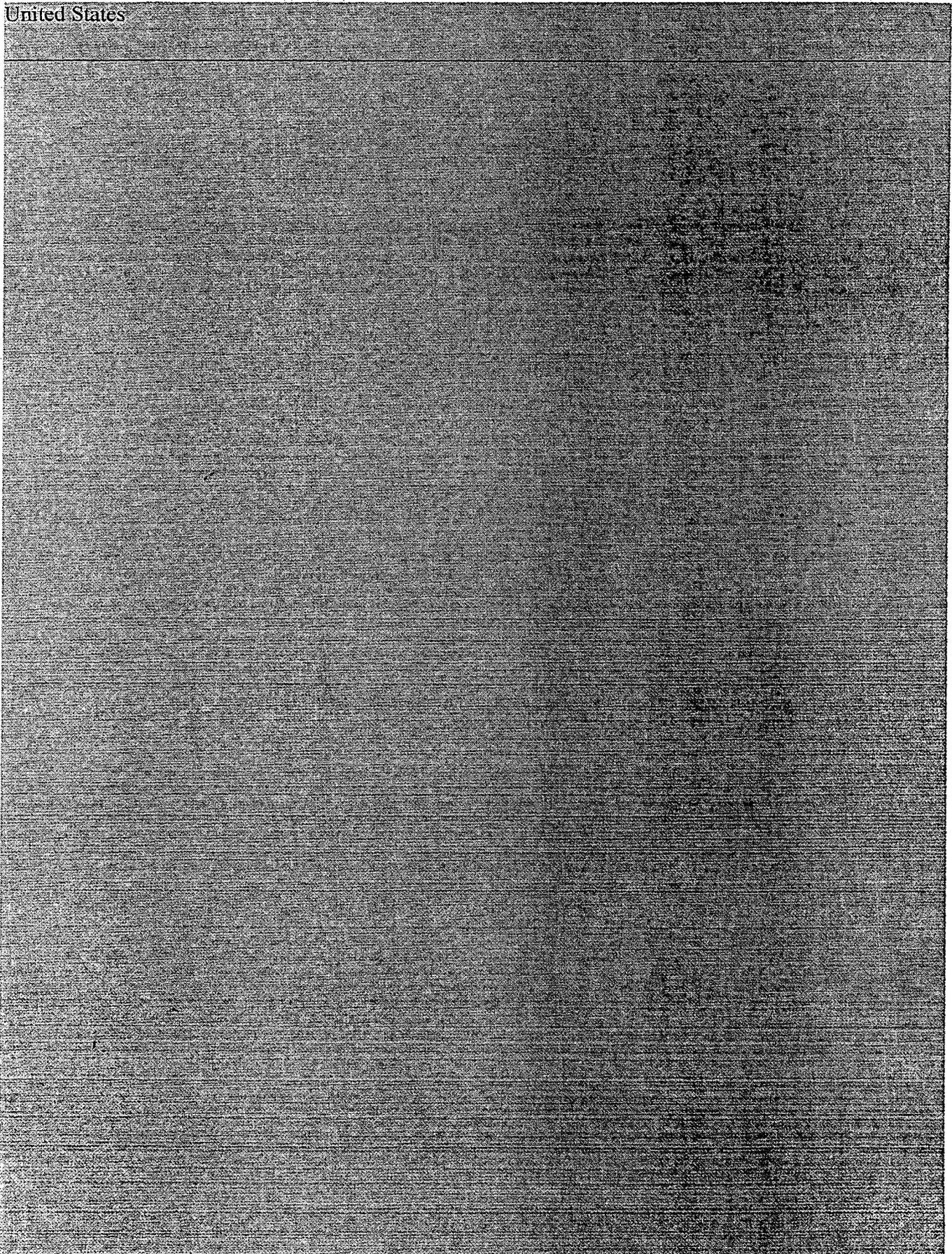


Exhibit "C"

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2003-03-26 14:25:20 ET

**Serial Number:** 74470350

**Registration Number:** 2288083

**Mark (words only):** RAINBOW REEF

**Current Status:** Registered.

**Date of Status:** 1999-10-19

**Filing Date:** 1993-12-16

**Registration Date:** 1999-10-19

**Law Office Assigned:** TMO Law Office 112

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at [TrademarkAssistanceCenter@uspto.gov](mailto:TrademarkAssistanceCenter@uspto.gov)

**Current Location:** 900 - Warehouse (Newington)

**Date In Location:** 2000-03-22

#### CURRENT APPLICANT(S)/OWNER(S)

1. LISA FRANK, INC.

**Address:**

LISA FRANK, INC.  
2801 N. Flowing Wells Rd.  
Tucson, AZ 85705  
United States

**State or Country of Incorporation:** Arizona

**Legal Entity Type:** Corporation

#### GOODS AND/OR SERVICES

stationery-type portfolios, notebooks, writing tablets, memo pads, stationery, stickers

**International Class:** 016

**First Use Date:** 1995-09-28

**First Use in Commerce Date:** 1995-09-28

**Basis:** 1(a)

**ADDITIONAL INFORMATION**

(NOT AVAILABLE)

**PROSECUTION HISTORY**

2002-03-08 - FEAS Change of Correspondence Received  
1999-10-19 - Registered - Principal Register  
1999-08-31 - Allowed for Registration - Principal Register (SOU accepted)  
1999-08-23 - Statement of use processing complete  
1999-07-30 - Amendment to Use filed  
1999-04-06 - Notice of allowance - mailed  
1999-02-11 - Opposition terminated for Proceeding  
1998-08-20 - Opposition dismissed for Proceeding  
1995-01-24 - Opposition instituted for Proceeding  
1994-10-17 - Extension of time to oppose - Filed  
1994-09-20 - Published for opposition  
1994-08-19 - Notice of publication  
1994-06-01 - Approved for Pub - Principal Register (Initial exam)  
1994-05-26 - Examiner's amendment mailed  
1994-05-23 - Case file assigned to examining attorney  
1994-05-23 - Case file assigned to examining attorney

**CONTACT INFORMATION****Correspondent (Owner)**

HARRIS J. KANE (Attorney of record)

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