

16488-0071

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

In the Matter of Trademark Application Serial No. 76/372,699

Mark: WOOD STROKES & WOODCRAFTS

Filed: February 19, 2002

Published: April 29, 2003

05-15-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

WOODCRAFT SUPPLY CORP.,)
)
Opposer)
)
v.)
)
EGW PUBLISHING/EGW.COMN.INC.)
)
Applicant)
)

Assistant Commissioner for Trademarks
Box TTAB
2900 Crystal Drive
Arlington, VA 22202-3513
May 15, 2003

05/21/2003 KGIBBONS 00000068 76372699

01 FC:6402

300.00 OP

NOTICE OF OPPOSITION

Woodcraft Supply Corp., a corporation organized and existing under the laws of the State of West Virginia, and having a principal place of business at 5300 Briscoe Road, P.O. Box 1686, Parkersburg, West Virginia, 26102-1686 (hereinafter "Opposer"), believes that it will be damaged by registration of the mark WOOD STROKES & WOODCRAFTS, for periodical published for craft enthusiasts, as set forth in application Serial No. 76/372,699, filed by EGW PUBLISHING/EGW.COMN.INC., a corporation

of the State of California, 1041 Shary Circle, Concord, California 94518, (hereinafter "Applicant"). Opposer therefore opposes such registration.

As grounds for this opposition, it is alleged that:

1. Opposer is now, and together with its predecessors in title, has continuously since at least 1928 been, engaged in the sale of hand tools, wood, wood supplies, hardware and related products and materials useful in working with, and/or making articles of, wood.

2. Opposer currently operates in commerce through a chain of retail store outlets, a mail order catalog service, and an on-line or internet order catalog service. Opposer's mail order catalog services are rendered to customers throughout the United States as well as numerous foreign countries. Opposer currently operates, either directly or through franchisees, a total of about 58 retail store outlets in 35 states across the United States. Opposer's internet order catalog services are available worldwide on-line at the web page address "www.woodcraft.com".

3. Since at least 1928, Opposer has used the term WOODCRAFT as part of its company name and as a trade name in its business.

4. Since at least 1928, Opposer has used the term WOODCRAFT, alone and in conjunction with design components, as a trademark for its hand tools, wood, wood supplies, hardware and related products. Many of Opposer's customers for such products are hobbyists and woodworking enthusiasts.

5. Since at least 1962, Opposer has used the term WOODCRAFT, alone and in conjunction with design components, in connection with catalogs, books and pamphlets dealing with tools and techniques useful in making articles of wood, and as a service

mark for its retail store services, and its mail order catalog services through which customers have purchased its hand tools, wood, wood supplies, hardware and related products. Many of Opposer's customers for these services and products are hobbyists and woodworking enthusiasts.

6. As a result of the above uses, and because of substantial amounts of time, effort and money expended in the advertising, promotion and sale of its products and the rendering of its services, Opposer has developed substantial common law rights in the term WOODCRAFT, and has built up extensive and valuable reputation, goodwill and consumer recognition in the term WOODCRAFT.

7. In addition to the above, Opposer has been issued the following registrations on the Principal Register:

<u>Reg. No.</u>	<u>Issued</u>	<u>Mark</u>	<u>Goods/Services</u>
1,127,711	12/11/79	MISC. DESIGN	CATALOG MAIL ORDER SERVICES SPECIALIZING IN TOOLS USED IN WOOD WORKING
1,335,451	5/14/85	WOODCRAFT & DES.	CATALOGS, BOOKS AND PAMPHLETS DEALING WITH TOOLS AND TECHNIQUES IN MAKING ARTICLES OF WOOD AND LEATHER
1,367,546	10/29/85	WOODCRAFT & DES.	CATALOGS, BOOKS AND PAMPHLETS DEALING WITH TOOLS AND TECHNIQUES IN MAKING ARTICLES OF WOOD AND LEATHER

2,173,162	7/16/98	HELPING YOU MAKE WOOD WORK	CATALOG MAIL ORDER SERVICES IN THE FIELD OF TOOLS, HARDWARE, WOOD AND WOOD WORKING SUPPLIES
2,225,326	2/23/99	WOODCRAFT & Des.	RETAIL TOOL AND HARDWARE STORE SERVICES
2,299,858	12/14/99	WOODCRAFT & Des.	HAND TOOLS USED PRIMARILY IN MAKING ARTICLES OF WOOD AND/OR LEATHER
2,299,859	12/14/99	WOODCRAFT & Des.	CATALOG MAIL ORDER SERVICES SPECIALIZING IN THE PROMOTION AND SALE OF WOODWORKING TOOLS, HARDWARE, SUPPLIES AND TECHNIQUES

8. The first three registrations listed in paragraph 7 above are valid, subsisting and incontestable. All listed registrations evidence Opposer's exclusive right to use the marks identified therein in interstate commerce on the goods and services specified in said registrations.

9. Applicant's application Serial No. 76/372,699 is for the mark WOOD STROKES & WOODCRAFTS for periodical published for craft enthusiasts, in International Class 16. It alleges a date of first use in October 1997.

10. On information and belief, Applicant's periodical is directed to hobbyists and woodworking enthusiasts, and Applicant advertises, offers for sale, sells and distributes

its periodical in the United States, including areas where Opposer also advertises, offers for sale, sells and distributes its products and renders its services.

11. The goods recited in application Serial No. 76/372,699, and the goods and services with which Opposer has used and continues to use the term WOODCRAFT, are the same, substantially the same, or closely related, and are made available by Applicant and Opposer to the same class of purchasers through the same or substantially the same trade channels.

12. Applicant's alleged mark, when applied to the goods recited in application Serial No. 76/372,699, so resembles Opposer's company name, trade name and marks, as applied to Opposer's goods and services, as to be likely to cause the public to believe that the goods of Applicant originate with Opposer, or vice versa, or that Applicant is owned or controlled by or in some manner associated or affiliated with Opposer, or vice versa, and is otherwise likely to cause confusion, to cause mistake or to deceive.

13. By virtue of this confusing similarity of marks, Opposer will be damaged by registration of the mark WOOD STROKES & WOODCRAFTS by Applicant for periodical published for craft enthusiasts, as set forth in application Serial No. 76/372,699.

WHEREFORE, Opposer requests that this opposition be sustained, and that application Serial No. 76/372,699 be refused registration.

Triplicate copies of this Notice of Opposition, together with the requisite fee of \$300.00 are enclosed herewith.

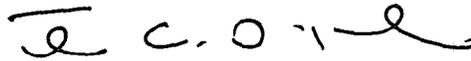
16488-0071

Please charge any other fee occasioned by this paper to our Deposit Account No.

03-1237.

Respectfully submitted,

5/15/03



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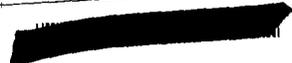
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EXPRESS-MAIL DEPOSIT

“Express Mail” Mailing-Label Number: EL768656108US

The following papers are being deposited with the United States Postal Service
“Express Mail Post Office to Addressee” service pursuant to 37 C.F.R. §1.10:

X Check No. 26489 for \$300 X Notice of Opposition (in triplicate)