



Attorney Docket No.: 800853

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

In re Application Serial No. 78/289,015
Mark: PREVENTION INSIGHTS

Rodale Inc.,

Opposer,

v.

Idea Sphere, Inc.,

Applicant.

Opposition No.: _____



Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, Virginia 22202-3513

05-26-2004
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

S I R:

NOTICE OF OPPOSITION

Rodale Inc., a Pennsylvania corporation, with a business address of 33 East Minor Street, Emmaus, Pennsylvania 18098-0099, hereby opposes the registration of the mark PREVENTION INSIGHTS, which is the subject of Application Serial No. 78/289,015, filed August 19, 2003 and published May 25, 2004. Therefore, this Notice of Opposition is timely filed.

As grounds in support of this opposition, opposer alleges as follows:

1. Opposer Rodale Inc. is a Pennsylvania corporation with a business address of 33 East Minor Street, Emmaus, Pennsylvania 18098-0099.

2. For many years, and since long prior to any date of first use upon which applicant can rely, opposer has adopted, used and registered various marks which comprise or include the term PREVENTION, either by itself, or together with another word or words, for various products and services in the health, nutrition, diet and exercise field, and related collateral products and services.

3. Opposer is the owner of the following United States Principal Register registrations which are valid, subsisting, unrevoked and uncanceled:

MARK	REG. NO.	ISSUE DATE	GOODS/SERVICES
PREVENTION	1,470,533	12/29/87	Tape measures, note pads, recipe cards and files, towels, aprons, headbands, hats, visors and shirts
PREVENTION	694,267	03/08/60	Magazine
PREVENTION	1,914,946	08/29/95	Umbrellas and golf balls
PREVENTION	2,643,325	10/29/2002	Production of radio and television programs; and entertainment services, namely, a continuing series of programs in the fields of health, fitness, diet, exercise and lifestyle distributed over radio, television, satellite, cable, audio and visual media, and via a global computer network; and information services in the fields of health, fitness, diet, exercise and lifestyle provided electronically via a web site on a multi-user global computer information network; and electronic publications via the world wide web containing on-line magazines, columns and articles in the fields of health, fitness diet, exercise and lifestyle
PREVENTION	2,550,507	03/19/2002	Pre-recorded audio and video cassettes and CDs in the field of health, fitness, diet, exercise and healthy lifestyles; and shirts, hats, running suits, sweatsuits, visors, pants, shorts and rainwear

MARK	REG. NO.	ISSUE DATE	GOODS/SERVICES
PREVENTION HEALTH BOOKS	2,222,899	02/09/99	Series of books on health, fitness, diet, exercise, and lifestyle
PREVENTION WALKING CLUB	1,464,064	11/03/87	Indicating membership in an organization which is a club directed to those whose interest in fitness relates to the exercise of walking
PREVENTION'S GUIDE	1,959,078	02/27/96	Magazine in the field of health, fitness, diet, exercise and related lifestyle issues
PREVENTION'S QUICK AND HEALTHY LOW-FAT COOKING	1,840,514	06/21/94	Series of books on recipes
THE PREVENTION PULSE	1,929,896	10/24/95	Newsletter in the field of health and fitness; conducting business surveys in the field of public opinion and market research

4. Opposer, since prior to any date of first use upon which applicant may rely, has used the mark PREVENTION in connection with providing healthcare information via its famous magazine, as well as in connection with a series of books, newsletters, guides, and via its web site on the internet. Opposer has also long used the mark PREVENTION in connection with providing healthcare information via a web site, and providing health screening and testing services.
5. Opposer, since long prior to any date of first use upon which applicant may rely, has used the mark PREVENTION in connection with collateral goods, including, without limitation, tape measures, notepads, recipe cards and files, towels, aprons, wearing apparel, umbrellas, golf balls, and pre-recorded audio cassettes and CDs.

6. Opposer is adopted and filed applications to register the mark PREVENTION, which applications are pending as follows:

MARK	APP. SERIAL NO.	FILING DATE	GOODS/SERVICES
PREVENTION	76/406,879	05/06/2002	Heart monitors and blood pressure monitors
PREVENTION	76/406,882	05/06/2002	Cologne, skin lotion, sun tan lotion, skin soap, deodorant soap, cosmetics and toiletries, namely, personal deodorants, hair gel, hair shampoo and hair cream rinse; adhesive bandages for skin wounds; air deodorant and air fresheners; appetite suppressants, dietary food supplements and food supplements; nutritional and dietary drink mix for use as a meal replacement; medicated hair care preparations and shampoo; herbal supplements and nutritional supplements; vitamins and mineral supplements; dental rinse; medicated skincare preparations and meal replacement drinks

MARK	APP. SERIAL NO.	FILING DATE	GOODS/SERVICES
PREVENTION	76/406,881	05/06/2002	Processed nuts; processed, fresh and frozen fruits and vegetables; whey based, soy based and dairy based food beverages; butter substitutes, cheese substitutes, egg substitutes and meat substitutes; dried fruit and vegetable chips and snack foods; frozen, prepared and packaged entrees consisting primarily of meat, fish, poultry and vegetables; protein for use as a food additive; herbal food beverages; breakfast cereals; chewing gum; flour and grain based chips and snack foods; ready to eat cereal derived food bars; candied fruit snacks; processed herbs; cereal based, rice based, granola based and wheat based snack foods; fruit juice and fruit juice concentrates; vegetable juice; mineral and spring water; sports drinks

These pending applications all have constructive use dates earlier than any date of first use upon which applicant may rely.

7. In addition to the foregoing, Opposer has been and is actively engaged in licensing programs with respect to its PREVENTION marks, which licensing programs relate to various other products, including products identical to or closely related to the products covered in applicant's application opposed herein.
8. As a result of opposer's long use of its PREVENTION marks and its extensive advertising and promotion of the various products and services under the PREVENTION marks, opposer's PREVENTION marks have become exclusively

associated with products and services originating with opposer, have become extremely well known to the public and have become famous.

9. Applicant, on August 19, 2003, filed an application for the mark PREVENTION INSIGHTS, which was assigned Application Serial No. 78/289,015. That application was filed alleging a bona fide intent to use and covers goods described as “dietary vitamins and supplements,” in Class 5; “scales for measuring body weight,” in Class 9; and “cholesterol test kits,” in Class 10. The application was published for opposition on May 25, 2004.
10. Applicant’s mark PREVENTION INSIGHTS for the goods described in applicant’s Application Serial No. 78/289,015, so resembles opposer’s previously used and registered PREVENTION marks as to be likely, when applied to applicant’s goods, to cause confusion, mistake or deception.
11. Applicant’s mark PREVENTION INSIGHTS, as used in connection with the goods set forth in the application, is confusingly and deceptively similar to opposer’s previously used and registered marks for PREVENTION.
12. Registration of the mark of the opposed application is barred by the provisions of Section 2(d) of the Trademark Act of 1946, as amended, for the reason that it consists of or comprises a mark which so resembles a mark previously used or registered in the United States by opposer, and not abandoned, as to be likely, when applied to the goods of applicant, to cause confusion, mistake or deception.

WHEREFORE, opposer believes it will be damaged by the registration of applicant’s mark and prays that this opposition be sustained and the registration of Application Serial No. 78/289,015 be denied.

CORRESPONDENCE ADDRESS

Please recognize the firm of SUGHRUE MION, PLLC, at 2100 Pennsylvania Avenue, N.W., Washington, D.C. 20037-3213, Telephone No. (202) 293-7060, and Kevin G. Smith, Jody H. Drake, and Gary D. Krugman of that firm, as attorneys for opposer in all matters related to the above proceeding. All correspondence should be directed to the attention of the undersigned at the above address.

PAYMENT OF FILING FEE

Attached is a check in the amount of \$900.00 in payment of the requisite filing fee for this Notice of Opposition. If the check becomes disassociated from this filing, or if the amount is insufficient, any deficiencies in the fee should be charged to Deposit Account No. 19-4880.

Respectfully submitted,

RODALE INC.

By:



Kevin G. Smith
Jody H. Drake
Gary D. Krugman
Attorneys for Opposer

SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Suite 800
Washington, D.C. 20037-3213
Telephone: (202) 293-7060
Facsimile : (202) 293-7860

Dated: May 26th, 2004.