

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

In the Matter of Trademark Application Serial
No. 78/229,875

Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark Registration No.
2,243,269

Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

ROGER ROJAS,
Respondent.

TTAB

Opposition No. 91162780 and Counterclaim
for Cancellation

**OPPOSITION TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT
IN OPPOSITION PROCEEDING [FRCP 56]**

Opposer Gold Shells, Inc., requests that the Board deny Applicant's motion for summary judgment in Opposer's opposition proceeding on the ground that there are genuine issues of material fact, including whether MESSAGE IN A BOTTLE as used on Applicant's recited goods is likely to be confused with MESSAGE IN A BOTTLE as used on Opposer's recited services.

I. BACKGROUND: UNDISPUTED FACTS

The following are the essential undisputed facts on which Applicant and Opposer appear to agree:

1. Opposer is the owner of U.S. service mark registration no. 2,243,269 for the mark



MESSAGE IN A BOTTLE in Class 38 for receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, which was registered on the Principal Register on May 4, 1999.

2. Applicant is the owner of U.S. service mark application no. 78/229,875 for the mark MESSAGE IN A BOTTLE in Class 16 for novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing, filed March 25, 2003.

3. Opposer filed the present opposition proceeding against Applicant, asking that Applicant's application be rejected on the ground that use or registration of Applicant's mark, which is identical to Opposer's mark, for Applicant's recited goods, would cause a likelihood of confusion with Opposer's mark for Opposer's recited services.

II. APPLICABLE LAW

Motions for summary judgment before the Board are governed by Rule 56 of the Federal Rules of Civil Procedure. For the Board to enter summary judgment, it must appear from the pleadings, depositions, and answers to interrogatories and admissions on file, together with any affidavits submitted concerning the motion, that there is no genuine issue as to any material fact so that one of the parties is entitled to judgment as a matter of law. Fed.R.Civ.Proc. 56(c).

In seeking a summary judgment, the moving party has the burden of showing the absence of any genuine issue as to all material facts which, under the applicable standards of substantive law, entitle such party to judgment. Old Grantian Co. v. William Grant & Sons Ltd., 361 F.2d 1018 (CCPA 1966).

Summary judgment is not usually appropriate in an action for trademark infringement since the gravamen of such an action is whether the challenged mark is likely to cause confusion, and likelihood of confusion is a question of fact. Marathon Mfg. Co. v. Enerlite Products Corp. (1985, CA5 Tex.) 767 F.2d 214, 226 USPQ 836.

Trademark infringement ordinarily involves the question of mixed law and fact which cannot appropriately be determined on affidavits or motion, and thus cannot be satisfactorily resolved on a motion for summary judgment. Marcus Breier Sons v. Marvlo Fabrics 173 F.2d 29 (2d Cir. 1949); Standard Pressed Steel Co. v. Midwest Chrome Process Co. (1976, ND Ill.) 418 F. Supp. 485, 191 USPQ 106. Consequently, such a motion is not favored in most such cases. DeVore & Sons, Inc. v. Thomas Nelson, Inc., 12 F. Supp. 2d 1157 (D. Kan. 1998); Panavision Intern., L.P. v. Toeppen, 945 F. Supp. 1296 (C.D. Cal. 1996); U.S. Jaycees v. San Francisco Jr. Chamber of Commerce, 354 F. Supp. 61 (N.D. Cal. 1972), judgment aff'd, 513 F.2d 1226 (9th Cir. 1975).

Summary judgment is inappropriate for deciding a claim of trademark infringement and related claims where a reasonable jury could decide the likelihood of confusion issue in favor of either party. Thane Int'l., Inc. v. Trek Bicycle Corp. (2002, CA9 Cal.) 305 F.3d 894.

In a suit between competitors in the marketplace, summary judgment was inappropriate for deciding trademark and trade dress infringement claims because factual questions existed as to likelihood of confusion and distinctiveness. Sally Beauty Co. v. Beautyco, Inc. (2002, CA10 Okla.) 304 F.3d 964, 64 USPQ 2d 1321.

Conflicting affidavits which raise a genuine issue of fact concerning matters relevant to the pleadings preclude summary judgment. Avon Prods., Inc. v. MarCon, Ltd., 225 USPQ 977 (TTAB

1985); Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986).

Summary judgment is usually inappropriate when the underlying issue is one of motivation, intent, or some other subjective fact. Kinley Corp. v. Ancira (1994, W.D.N.Y.) 859 F. Supp. 652 [summary judgment is generally inappropriate when state of mind is at issue].

When intent is relevant, such as when fraud on the PTO is at issue, the matter is inappropriate for resolution by summary judgment. Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991); see also Dunkin Donuts v. Metallurgical Expoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988); Volunteer Beer, Inc. v. Johnson, 45 USPQ2d 1051 (Tenn. App. 1997).

Summary judgment is usually denied in cases involving fraud, which involves issues as to litigant's state of mind. 10B Wright/Miller/Kane, Federal Practice and Procedure, Section 2730 [cases cited in footnote 21 on page 21].

The party objecting to a motion for summary judgment may prevail even without contravening affidavits or other evidentiary matter when the material presented by the moving party demonstrates the existence of a genuine issue of material fact. American International Ins. Co. v. The Vessel SS Fortaleza (1978, CA1 Puerto Rico) 585 F.2d 22.

A motion for summary judgment must focus on the issues raised by the case as set forth in the pleadings (in this case, the opposition, the counterclaim for cancellation, and the answers to each). Hawes/Dwight, Trademark Registration Practice (Thomson West 2005) Section 17:10.

Summary judgment is not intended as a procedure to decide questions in avoidance of a full trial or for weighing evidence in advance of trial. Colgate-Palmolive Co. v. S.C. Johnson & Son,

Inc., 159 USPQ 56 (TTAB 1968); Care Corp. v. Nursecare Int'l, Inc., 216 USPQ 993 (TTAB 1982).

When the consideration required to be given to a motion for summary judgment is substantially that which would be required by a full trial, or when the issue to be decided is a highly fact-driven one, the preference is to deny summary judgment. La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm. PT 1976); Nestle Co. v. Gaoyva Corp., 227 USPQ 477 (TTAB 1985).

The Board must view the evidence before it in a motion for summary judgment in a light most favorable to the non-moving party. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Since opposing factual inferences may arise from the same set of undisputed facts, the Board must draw reasonable inferences in favor of the non-moving party. United States v. Diebold, Inc., 369 U.S. 654, 655 (1962).

III. DISPUTED FACTS

The pleadings in this opposition, the interrogatory answers exchanged between the parties, and the documents produced by the parties during document production all show that there is a genuine issue of material fact as to whether the mark as used on Applicant's goods is likely to be confused with the same mark as used on Opposer's services. This is a fact-intensive issue and does not lend itself to decision as a matter of law.

Applicant's answer to the notice of opposition herein, and Applicant's counterclaim, a copy of which is attached to the Affidavit of Roger Rojas as Exhibit J, denies many of the essential allegations of the notice of opposition and raises affirmative defenses, and in itself is confirmation that there are genuine issues of material fact. The following fact assertions (without limitation) are

in dispute based on Applicant's answer to the notice of opposition and Applicant's counterclaim (referring to page numbers from said answer and counterclaim):

1. That Opposer is the owner of U.S. service mark registration number 2,243,269 for the mark and services recited therein. (Page 2)

2. That Opposer's registration is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use its mark in commerce on the services specified in the registration. (Page 2)

3. That there is a related nature of the services for which Opposer's mark was registered and the goods for which Applicant's application has been filed. (Page 2)

4. That Applicant's marks so resembles Opposer's registered mark as to be likely to cause confusion, or to cause mistake, or to deceive. (Page 2)

5. That since January 16, 1999, Opposer or its predecessor have been, and Opposer is now, actually using the mark MESSAGE IN A BOTTLE in connection with the sale of services and as a trademark in connection with the sale of goods which are identical to some of the goods set forth in Applicant's application. (Page 3)

6. That Opposer has a priority right to the mark under Section 7(c) of the Lanham Act. (Page 3)

7. That use by Opposer and its predecessor has been valid and continuous since the date of first use and has not been abandoned. (Page 3)

8. That Applicant uses the mark on services which are identical to those for which Opposer has registered its mark. (Page 3)

9. That Opposer's mark is symbolic of extensive good will and consumer recognition built up through a substantial amount of time and effort in advertising and promotion. (Page 3)
10. That the nature of the goods and services of the parties are substantially similar. (Page 3)
11. That the relevant class of the public has come to associate Opposer with the designation MESSAGE IN A BOTTLE. (Page 4)
12. That Applicant's mark consists of and comprises matter that may disparage and falsely connote a connection with Opposer. (Page 4)
13. That the mark MESSAGE IN A BOTTLE has become distinctive of Applicant's goods in commerce. (Page 4)
14. That Opposer lacks standing to bring this opposition. (Page 5)
15. That Opposer is barred by laches, acquiescence, and estoppel from contesting this opposition. (Page 5)
16. That Opposer's claims are barred due to its own fraud and fraudulent conduct and that of its alleged predecessor before the PTO. (Page 5)
17. That Opposer's claims are unconscionable and that Opposer and its predecessor have "unclean hands". (Page 5)
18. That Opposer and its predecessor have not used MESSAGE IN A BOTTLE on goods or services as an identification of origin as identified in the notice of allowance. (Page 5)
19. That Opposer and its predecessor have not used MESSAGE IN A BOTTLE on any services that may be properly characterized as within International Class 38. (Page 5)

IV. ANALYSIS

A. A COMPARISON OF THE PARTIES' GOODS AND SERVICES IN THE ABSTRACT SHOWS A LIKELIHOOD OF CONFUSION.

Look at a side-by-side comparison of Opposer's registered mark and Applicant's mark as applied for:

<u>OPPOSER'S REGISTERED MARK</u>	<u>APPLICANT'S MARK AS APPLIED FOR</u>
MESSAGE IN A BOTTLE Receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others. Class 38	MESSAGE IN A BOTTLE Novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing. Class 16

First, it is clear from the description of Opposer's services that some means must be employed by Opposer for Opposer to perform its recited communication services. Clearly, one of those means could be novelty, favor, and souvenir bottles containing messages and greetings, invitations, promotional materials of others, and advertising materials of others.

Secondly, look at Applicant's recitation of goods. It is clear that if Applicant sells bottles containing messages and greetings, it must employ communications from others, record such communication in written or printed form, and transmit such communications to others. In other words, Applicant must, in selling such goods, utilize the same services for which Opposer has previously registered the same mark, MESSAGE IN A BOTTLE.

It is not a conclusive indicator of no likelihood of confusion to recite that Applicant's mark is applied for in a different class from that in which Opposer's mark is registered. Since Applicant has chosen to focus on the goods aspect of its business with its application, of course its application is classified in a goods classification, while Opposer's predecessor, in his original application, focused on the service aspect of what he planned to sell, and therefore applied in Class 38, a service class. There can be likelihood of confusion between goods and/or services in different classes. When the descriptions of goods and services in this case are placed side by side, and analyzed as set forth above, it is clear that there indeed would be a likelihood of confusion if the same mark is applied to these goods and these services, regardless of the different classes in which the PTO categorizes the goods and services.

The interplay between Applicant's recited goods and Opposer's recited services is confirmed by the use specimens on file for each. When Opposer's predecessor filed his statement of use to obtain his registration, he filed it with a use specimen which clearly identified paper and bottles as the goods or devices used to perform Opposer's communication services; and Applicant's use specimen consists of a picture of paper in a bottle.

When other evidence is brought in from the parties, including their interrogatory answers, admissions, and documents produced, the likelihood of confusion becomes more clear. See the Affidavit of Roger Rojas.

B. REBUTTAL TO APPLICANT'S ARGUMENT.

Applicant takes the position that there is no likelihood of confusion as a matter of law, and "the dissimilarity of the goods is dispositive", yet he offers no substantive reasoning or citations to

back up these assertions. He even admits in paragraph I(A) on page 5 that, “. . . the parties’ marks apparently overlap,” and he has previously admitted to Opposer, in a document disclosed during discovery, that the parties’ businesses were offering “a similar product”. (See Exhibit K to the Affidavit of Roger Rojas.)

Applicant argues that Applicant’s recited goods are “clearly distinct” from Opposer’s recited services. In doing so, he incorrectly states that Opposer’s services are “receiving and transmitting communications, telephone, radio, TV, satellite, and other electronic methods of communication.” In fact, as noted above, and as admitted by Applicant elsewhere, Opposer’s recited services are “receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others.” These recited services say nothing about the method of receiving and transmitting communications, and do not limit that method to telephone, radio, TV, satellite, electronic, or any other specific type of communications.

Applicant argues that he sells a “tangible product” which is completely different from “electronic transmissions, a non-tangible product.” However, Opposer’s recitation of services states that it records communications “in written or printed form”, thus creating a “tangible product” (the same as the one sold by Applicant); and Applicant’s so-called “tangible product” is delivered by the same chain of services as set forth in Opposer’s recitation of services. Thus, the attempted distinction between “tangible” products and “intangible” services is a meaningless one in this context. Moreover, Applicant has mischaracterized Opposer’s services, which do not deal solely with “electronic transmissions”.

Applicant asserts that Opposer’s recited services in International Class 38 are “clearly

understood” by the PTO as a service that is sending “electronic communications, via telephone, radio, TV, computer”. However, the PTO required no such limitation in Opposer’s recitation of services, which are clearly broader than and not limited to “telecommunications”, which is noted to be the current title of International Class 38 by the PTO. Indeed, at the time Opposer’s predecessor filed the application which led to Opposer’s current registration, his attorney understood the title of International Class 38 to be merely “Communications”. (See the Affidavit of Peter H. Smith filed concurrently herewith.) Regardless of the title, Opposer’s predecessor’s services fit clearly within the then-existing PTO standards for Class 38. (See paragraph 16 of the Affidavit of Roger Rojas.)

Applicant notes that Opposer’s 1999 business license says “computer related services”, but this designation is correct in that much of Opposer’s communications are done by computer through its Internet website. (See paragraph 11 of the Affidavit of Roger Rojas for his explanation of how the phrase “computer related svcs not elsewhe” came to be on his business license.)

Applicant’s comments and exhibits about Yahoo!’s classification of Opposer’s services are inadmissible hearsay and should be disregarded. Furthermore, they are not correct. (See paragraph 12 of the Affidavit of Roger Rojas.)

The fact that Opposer’s trademark research report contains on its cover the words “message delivery service” is also inadmissible hearsay, but is consistent with Opposer’s recited services as set forth in its registration. This notation does nothing but work against Applicant’s argument, as it is clear from the recitation of goods in Applicant’s application that he also engages in “message delivery service”.

Applicant’s argument that the PTO has found similar goods as recited in trademark

application serial number 78/434,862 for MINI MESSAGE IN A BOTTLE to be dissimilar from Opposer's recited services is based solely on the examining attorney's making no reference to Opposer's registration in its office action on the application, yet no admissible evidentiary implication can be drawn from this.

Perhaps Applicant's most outrageous statement is on page 7: "The Applicant has never received communications from others, recorded such communications in written or printed form, and transmitted such communications to others." This statement is patently false. Applicant could not carry on the business of selling the goods described in its application, and as described on its website, www.bottlemeamessage.com, without receiving communications from others, recording them in written or printed form, and transmitting the resulting messages to others. That is what Opposer's business is all about, and that is what Applicant's business is all about. (See paragraph 20 of the Affidavit of Roger Rojas.)

Furthermore, Applicant has essentially admitted dealing in such communications in his answers to Opposer's interrogatories in reciting the services marketed by him under the mark and stating that these services are ancillary to sales of his products. (See his responses to Opposer's interrogatories 2 and 22 as recited in paragraph 21 of the Affidavit of Roger Rojas.)

Applicant also purports to analyze another indicator as to likelihood of confusion, namely "the nature and extent of any actual confusion". He asserts that "no actual confusion can occur", and alleges that "the parties have concurrently used their marks for over five years without any actual confusion." As Applicant knows from information given to him by Opposer during discovery, this is not true. Opposer has experienced actual confusion as noted in paragraph 17 of the Affidavit of Roger Rojas.

Finally, Applicant claims that Opposer's asserted right of priority under Section 7(c) of the Lanham Act is moot, but this assertion is based solely on the purported dissimilarity of Applicant's recited goods and Opposer's recited services, and that subject has been adequately addressed above. Once it is acknowledged that Applicant's use of Opposer's mark on Applicant's recited goods creates a likelihood of confusion with Opposer's mark on its recited services, Opposer's claim of priority is on target and indeed dispositive of this proceeding.

C. THE INDICATORS OF LIKELIHOOD OF CONFUSION.

While Applicant was at it, he should have analyzed the other indicators of likelihood of confusion as set forth in In re E. I. DuPont de Nemours, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). They are as follows, and most of them point toward a conclusion of likelihood of confusion between the identical marks used on the recited goods and services in this case:

1. The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation, and commercial impression. In this case, the marks are identical, each party's mark being MESSAGE IN A BOTTLE.

2. The similarity or dissimilarity of and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use. As mentioned above, the services as recited in Opposer's registration are services which can be used to distribute the goods as described in Applicant's application, and in fact are actually so used by Opposer. Also, the services as recited in Opposer's registration are necessary services for delivery of the goods as described in Applicant's application, and are actually so used by Applicant.

3. The similarity or dissimilarity of established, likely-to-continue trade channels. The

established, likely-to-continue trade channels for both Opposer and Applicant are the same: Internet websites, Opposer's at www.messageinabottle.com and Applicant's at www.bottlemeamessage.com; paid Internet search engines; and Internet directory listings. (See paragraphs 6, 15, and 20 of the Affidavit of Roger Rojas.)

4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. "careful, sophisticated" purchasing. Opposer submits that most buyers of gift bottle services, as sold by both Opposer and Applicant on their Internet websites, are unsophisticated impulse buyers.

5. The fame of the prior mark (sales, advertising, length of use). Opposer and its predecessor have had the mark MESSAGE IN A BOTTLE in continuous use since the first use on January 16, 1999, have advertised through an Internet website since early 1999, and since the initial use have increased sales every year since then. (See paragraphs 13 and 14 of the Affidavit of Roger Rojas.)

6. The number and nature of similar marks in use on similar goods. Opposer concedes that there have been a number of identical or similar marks in use on similar goods and services; but Opposer has taken a number of actions to police the protection of its registered mark, and has been aided in this by Yahoo!, which has blocked other uses of MESSAGE IN A BOTTLE on its areas of the Internet in deference to Opposer's registered mark. (See paragraph 15 of the Affidavit of Roger Rojas.)

7. The nature and extent of any actual confusion. Opposer has had incidents of actual confusion with Applicant's use of the mark. (See paragraph 17 of the Affidavit of Roger Rojas.)

8. The length of time during and conditions under which there has been concurrent use

without evidence of actual confusion. Opposer's mark and Applicant's mark have been in competition in the marketplace since January 16, 1999, and there has been actual confusion as noted in Item 7 above.

9. The variety of goods on which a mark is or is not used. Opposer submits that this factor is not applicable because both Opposer and Applicant use the mark only on gift bottle goods and services.

10. The market interface between applicant and the owner of a prior mark. Opposer and Applicant are direct competitors, each selling gift bottle goods and services through Internet websites. (See paragraphs 6 and 20 of the Affidavit of Roger Rojas.) They have not entered into any agreements for their concurrent use of the mark, as evidenced by the present proceeding.

11. The extent to which applicant has the right to exclude others from use of its mark on its goods. Opposer maintains that its incontestable federal registration gives it the right to exclude other users of MESSAGE IN A BOTTLE on gift bottle services and goods.

12. The extent of potential confusion, i.e., whether *de minimis* or substantial. Opposer submits that the potential confusion is substantial when the identical mark is used on essentially identical or overlapping services and goods.

D. REBUTTAL TO APPLICANT'S EVIDENCE.

The following will review each of the items of alleged supporting evidence for Applicant's motion:

1. Applicant cites the pleadings to date, including but not limited to Opposer's notice of opposition dated October 21, 2004. However, there is nothing therein that supports Applicant's

conclusion that there is no likelihood of confusion due to the differences in the Applicant's goods and the Opposer's services. On the contrary, paragraph 3 of Opposer's notice of opposition says, "Since January 16, 1999, Opposer or its predecessor have been, and Opposer is now, actually using the mark MESSAGE IN A BOTTLE in connection with the sale of services as described in the registration and as a trademark in connection with the sale of goods consisting of novelty, favor, and souvenir bottles containing messages and greetings, identical to some of the goods set forth in Applicant's application. . . . Furthermore, Applicant uses the mark on services which are identical to those for which Opposer has registered its mark, namely receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." (See paragraph 20 of the Affidavit of Roger Rojas.) Applicant's answer dated November 8, 2004, contains denials of these allegations and sets up genuine issues as to material facts. (See paragraph 18 of the Affidavit of Roger Rojas.)

2. Applicant cites his own trademark application, but there is nothing therein that supports Applicant's claim of no likelihood of confusion. On the contrary, the application shows that Applicant applied for a mark identical to Opposer's registered mark for goods which are inherently capable of being distributed by the same services which are recited in Opposer's registration (and are overlapping with Applicant's recited goods).

3. Applicant cites Opposer's registration, but it offers no support to Applicant's claim of no likelihood of confusion. On the contrary, the registration is for MESSAGE IN A BOTTLE, the identical mark applied for by Applicant, and the services for which the registration was granted are clearly services which can be used to distribute the same type of goods as those for which Applicant has applied.

4. Applicant's Exhibit A is the cover of Opposer's trademark research report dated November 18, 1996, which contains nothing in support of Applicant's position that there is no likelihood of confusion.

5. Applicant's Exhibit B is merely a copy of the PTO's receipt for Opposer's predecessor's 1997 intent-to-use service mark application. The services described therein are services which clearly can be used to distribute the same type of goods as are described in Applicant's application.

6. Applicant's Exhibit C is a copy of a PTO office action in connection with Opposer's registration. There is nothing in this office action which supports Applicant's position.

7. Applicant's Exhibit D is a series of additional documents from Opposer's registration file, none of which supports Applicant's position.

8. Applicant's Exhibit E is a print-out of the International Schedule of Goods and Services from the PTO's current Internet website, circling the words "telecommunications" in Class 38 (Opposer's registration class) as if this in itself has some significance in supporting Applicant's position, which it does not. There is no inherent reason why the same mark used on goods in Class 16 cannot create a likelihood of confusion with that mark when used on services as set forth in Class 38. (As to the consistency of Opposer's recited services with the 1997 version of Class 38, see paragraph 16 of the Affidavit of Roger Rojas.)

9. Applicant's first Exhibit H is a copy of a City of Modesto business license from 1999 for the business of Roger Rojas and Adrianna Rojas (Opposer's predecessors) for a business called "Message in a Bottle". There is a reference to "computer related services", but there is nothing in

this document which cuts either for or against Applicant's position. (See paragraph 11 of the Affidavit of Roger Rojas.)

10. Applicant's Exhibit F is allegedly a Yahoo! Local search for Internet access providers, and Applicant is apparently trying to argue that this is evidence that Opposer is an Internet access provider, and that the mark MESSAGE IN A BOTTLE on Applicant's goods is not likely to be confused with the same mark on those services. In fact, however, this document is inadmissible hearsay, and is incorrect in listing Opposer in the category of "Internet access providers - data processing and management services - computer business solutions". (See paragraph 12 of the Affidavit of Roger Rojas.)

11. Applicant's Exhibit G is another piece of inadmissible hearsay from Yahoo! Local, and even if this was admissible evidence, it does not appear to have any relevance to the issue at hand, namely whether MESSAGE IN A BOTTLE for Applicant's goods is likely to be confused with MESSAGE IN A BOTTLE for Opposer's services.

12. Applicant's second Exhibit H is a 2004 third-party application for MINI MESSAGE IN A BOTTLE, along with a PTO office action initially refusing registration on the ground of genericness. This office action, which fails to cite Opposer's prior registration as a barrier to registration of the mark MINI MESSAGE IN A BOTTLE in Class 9 for a communication device, is inadmissible hearsay and does nothing to support Applicant's position.

13. Applicant's Exhibit I consists of some telecommunications from the Internet. No foundation has been laid for their relevance in this proceeding, and they are inadmissible hearsay.

///

CONCLUSION

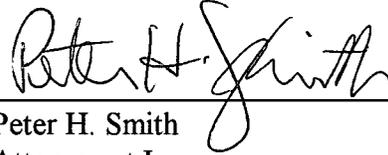
Applicant has been trading on Opposer's reputation and good will for years, despite Opposer's prior registration for the identical mark. Granting Applicant a concurrent registration makes no sense, regardless of whether he is applying to register the mark for goods such as paper and bottles, or services in which those goods are used. Either way, it is an invitation for more consumer confusion. The paper and bottle used to facilitate the communications are merely ancillary to the services. To say that Applicant is merely selling goods is like saying that Western Union is merely selling paper.

Opposer is informed and believes that Applicant is seeking a registration because of the value of a registered mark in being able to appear exclusively in Internet search engines and directory listings of Yahoo!. However, Opposer has the priority, and Opposer's incontestable registration entitles it to be the only competitor in the gift bottle service industry to identify its services – and the goods used therein – by its chosen and well-established mark.

Applicant's motion for summary judgment is based on the premise that there is no likelihood of confusion between (a) his use of a mark identical to Opposer's mark on his recited goods and (b) Opposer's mark on its recited services. However, as shown above, Applicant's recited goods fall within the scope of Opposer's recited services, and the two are inescapably related. The material presented by Applicant in his motion, taken as a whole, actually demonstrates the opposite of Applicant's conclusion – that there is a likelihood of confusion as to MESSAGE IN A BOTTLE on his recited goods and Opposer's recited services; or, at the very least, that there is a genuine issue of material fact on the subject of likelihood of confusion. Therefore Applicant's motion must fail.

Finally, Opposer notes that Applicant has furnished no verification or supporting affidavits for his motion, and therefore it does not meet the criteria for admissibility in evidence.

Dated: August 11, 2006.

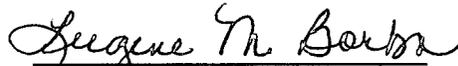


Peter H. Smith
Attorney at Law
1535 J Street, Suite A
P.O. Box 1867
Modesto, CA 95353
Telephone: (209) 579-9524
Facsimile: (209) 579-9940

Attorney for Opposer Gold Shells, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Motion for Summary Judgment in Opposition Proceeding was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on August 11, 2006.

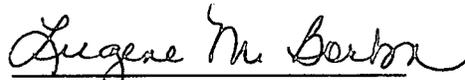

Lugene M. Borba

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR §2.198

Mark: MESSAGE IN A BOTTLE
Registration No.: 2,243,269
Opposition No.: 91162780
Mailing Date: August 11, 2006
Name of parties filing paper: Roger Rojas and Gold Shells, Inc.
Type of paper being filed: Opposition to Motion for Summary Judgment in Opposition Proceeding

Express Mail Mailing Label Number: EQ 454418768 US
Date of Deposit: August 11, 2006

I hereby certify that the above-identified opposition to motion for summary judgment in opposition proceeding, which is attached, is being deposited on August 11, 2006, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §2.198 in an envelope addressed to: U.S. Patent & Trademark Office, Trademark Trial & Appeal Board, P. O. Box 1451, Alexandria, VA 22313-1451.



Lugene M. Borba
Date: August 11, 2006

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

In the Matter of Trademark Application
Serial No. 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark Registration
No. 2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

ROGER ROJAS,
Respondent.

Opposition No. 91162780 and
Counterclaim for Cancellation

**AFFIDAVIT OF ROGER ROJAS IN SUPPORT OF OPPOSITION TO
APPLICANT'S MOTIONS FOR SUMMARY JUDGMENT**

I, Roger Rojas, being sworn, say:

1. I am the Chief Executive Officer of Gold Shells, Inc., hereinafter called "GSI", the Opposer in the above-referenced opposition proceeding, and am making this affidavit in opposition to Applicant Keith Cangiarella's motions for summary judgment in the opposition proceeding and the cancellation counterclaim.

2. GSI is a California corporation, doing business as "Message in a Bottle" at 432

Bitritto Way, Suite 5, Modesto, California 95356, and it formerly did business at 3401 Shawnee Drive, #61, Modesto, California 95356, and 725 Paradise Road, Modesto, California 95351.

3. GSI believes that it will be damaged by registration of the mark MESSAGE IN A BOTTLE as shown in Applicant's trademark application serial number 78/229,875, and therefore filed the present opposition proceeding on or about October 21, 2004.

4. GSI is the owner of U.S. service mark registration number 2,243,269 for the mark MESSAGE IN A BOTTLE in Class 38 for receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, which was registered on the Principal Register on May 4, 1999. A copy of GSI's registration is attached hereto as Exhibit A. This is a copy of a PTO-certified copy dated December 2, 2005, obtained for use herein during the testimony period, and shows the status and title of the registration. GSI's registration was based on an intent-to-use application filed by me in the U.S. Patent & Trademark Office on January 6, 1997. I timely filed a combined affidavit of continuing use under Sections 8 and 15 of the Lanham Act between the fifth and sixth anniversaries of the registration date. Thereafter, on October 5, 2004, I executed an assignment of the registration to GSI, which was mailed to the Patent & Trademark Office for recording on October 6, 2004, and was in fact recorded on October 15, 2004, as Assignment No. 102859988 on Reel No. 003061, Frame No. 0965.

5. Since January 16, 1999, and through constructive use since January 6, 1997,

the filing date of my original intent-to-use application, GSI or I have been, and GSI is now, actually using the mark MESSAGE IN A BOTTLE in connection with the sale of communication services as described in the registration and as a trademark in connection with the sale of goods consisting of novelty, favor, and souvenir bottles containing messages and greetings, some of the same goods as those recited in Applicant Keith Cangiarella's trademark application serial number 78/229,875. Use of the mark by me and GSI has been valid and continuous since the date of first use and the mark has not been abandoned.

6. In GSI's answers to interrogatories from Applicant Keith Cangiarella, GSI stated that it did business with the MESSAGE IN A BOTTLE mark at an Internet website, www.messageinabottle.com. Attached hereto as Exhibit B are three pages excerpted from the home page of GSI's website, along with six other pages. These pages display the service mark MESSAGE IN A BOTTLE and describe the goods and services that are offered by Opposer under that mark. On page 2 of Exhibit B, in the description of services offered, the website says, "Simply choose a bottle, choose a message or write your own and then tell us to whom you want it sent. We'll do the rest." The final six pages show that communications are received from others, printed on paper, enclosed in a bottle, and send to the recipient. These pages show virtually the identical services of receive/print/send as Applicant's similar pages in Exhibit P hereto (referred to in paragraph 20 below). This shows that GSI is using the mark MESSAGE IN A BOTTLE for receiving communications from others, recording such communications in written or printed form, and transmitting such communications to

others, exactly as recited in the services for which GSI's service mark registration was granted.

7. At the time I filed the intent-to-use trademark application which resulted in GSI's registration, I intended to use the mark MESSAGE IN A BOTTLE on the services as recited in the application and as later amended and recited in the registration, I in fact started using the mark for those services on January 16, 1999, in commerce, as stated in the statement of use I filed with the PTO, and all statements made in the statement of use were true of my own personal knowledge. I am attaching a copy of the statement of use as Exhibit C.

8. On or about October 13, 2004, I filed an affidavit of continuing use in connection with service mark registration no. 2,243,269. I am attaching a copy thereof as Exhibit D. All statements in the affidavit were true of my own personal knowledge.

9. I have committed no fraud on the PTO in any way, including by my original application, my statement of use, or my affidavit of continuing use.

10. I am attaching hereto as Exhibit E a copy of the specimen which I submitted with my statement of use filed herein on or about January 25, 1999, featuring the mark MESSAGE IN A BOTTLE, and evidencing my use of that mark on the services specified in my application. This specimen was accepted by the PTO for the purpose of evidencing use of the mark for the services recited. It was an actual specimen of the advertising flyers which I distributed in interstate commerce to commence marketing my services under the mark.

11. I adopted the designation MESSAGE IN A BOTTLE as a trade name as well as a service mark, and I obtained a business license in that name from the City of Modesto for the period ending June 30, 1999. A copy of that license is attached to Applicant's motion for summary judgment as his first Exhibit H. That license included the notation "computer related svcs not elsewe". In filling out the application form for the license, there were a limited number of designations to describe the type of business, and I checked the box for this because it was the closest description to my business (since in fact I did deal in the computer-related services, offering an Internet website for the sale of my services and goods).

12. Neither GSI nor I has ever used the mark MESSAGE IN A BOTTLE for or has done business as an Internet access provider, or a provider of data processing and management services or computer business solutions. The alleged designation of our business in those categories by Yahoo! Local in Exhibit F to Applicant's motion for summary judgment is incorrect. I do not know how Yahoo! came to describe the business of myself or GSI in that manner.

13. Since I began selling services and goods under the mark MESSAGE IN A BOTTLE, sales have increased each year (including GSI's sales as well as my individual sales).

14. I reserved the domain for the website www.messageinabottle.com, to feature the mark MESSAGE IN A BOTTLE, on or about January 17, 1997, and the website has been

in continuous operation since early 1999.

15. In using the Internet for advertising goods and services, GSI and Applicant have sought or obtained search engine paid listings and directory listings as well as utilizing their own websites. GSI has obtained these listings from Yahoo! (formerly Overture Services, Inc.), which has assisted GSI in policing infringing uses of MESSAGE IN A BOTTLE pursuant to its trademark policies. I am attaching hereto as Exhibit F a letter from GSI's attorney to the attorney for Overture Services, Inc. (predecessor to Yahoo!) to request such policing. (A copy of this letter has been produced in discovery to Applicant in response to his request for production of documents.) Yahoo! honored GSI's request at the time and blocked other parties from using MESSAGE IN A BOTTLE in connection with the services offered by Yahoo!.

16. I have obtained a copy of the PTO's document entitled "Acceptable Identification of Goods and Services Manual" (1997 [First] Edition) as to Class 38, which was entitled "Telecommunications", and I am attaching as Exhibit G a copy of the cover and the materials pertinent to Class 38. The explanatory note says, "This class [38] includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which: (1) allow a person to talk to another, (2) transmit messages from one person to another, and (3) place a person in oral or visual communication with another (radio and television)." (emphasis added) The services performed by me and GSI under the mark MESSAGE IN A BOTTLE are services which fall within this

description, allowing communication between persons by a “sensory means”, namely paper messages in bottles.

17. During the time that GSI and I have been doing business with the mark MESSAGE IN A BOTTLE, and I have been aware of Applicant also doing business under that mark, I have occasionally encountered actual confusion on the part of customers as between Opposer’s use of the mark and Applicant’s use of the mark. Attached hereto as Exhibits H and I are two documents evidencing actual confusion, copies of which were delivered to Applicant by Opposer in response to Applicant’s request for production of documents:

(a) Exhibit H is a copy of an e-mail from Betsy Foreman dated May 21, 2004, addressed to GSI’s website, stating that she is interested in “the bottles with confetti”. GSI has no bottles with confetti on its website, but Applicant’s website does depict such bottles.

(b) Exhibit I is a copy of an original e-mail from Lisa Kramer dated February 11, 2005 (consisting of a complaint which she had intended to direct to Applicant, but instead directed to Opposer’s website); Opposer’s response; and Lisa Kramer’s further response, evidencing that she had recommended GSI’s service, but the persons to whom she recommended it had “Googled” and got Applicant’s site instead, then had done business with him.

18. Many genuine issues of material fact have been raised by Applicant in his

answer to the notice of opposition and his counterclaim, a true and correct copy of which is attached hereto as Exhibit J.

19. Attached hereto as Exhibit K is a document which was disclosed in discovery, consisting of an e-mail from Applicant to GSI dated August 9, 2004, acknowledging his knowledge of the existence of my pending service mark application in 1997, long before he commenced using MESSAGE IN A BOTTLE, and also admitting that our businesses were offering “a similar product”.

20. In response to Opposer’s request for admissions, Applicant admitted that he does business with the website address, www.bottlemeamessage.com. (See paragraph 21 below.) I am attaching copies of the following documents excerpted from that website to illustrate and provide evidence of the fact that Applicant sells the goods which he has recited in his trademark application by offering the same services as GSI, namely receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others:

Exhibit L: Three pages consisting of Applicant’s former home page, describing the services and goods offered by Applicant under the mark.

Exhibit M: A copy of three pages entitled “FAQ” (presumably standing for “frequently asked questions”) in which Applicant makes it clear that he is in the business of receiving message design communications and orders from others, and “your MIB is created only after we receive the order”, meaning that Applicant records the communications from

his customer in written or printed form. It is also clear from the information under the heading "How Are They Shipped?" that Applicant then transmits such communications to others.

Exhibit N: One page entitled "Samples" which makes it clear from the words "Simply click on the button below . . . input message so you can see what your message will appear like . . ." that Applicant is receiving communications from others, recording them in written or printed form, and transmitting them to others.

Exhibit O: One page entitled "Message in a Bottle Prints" with the words "Choose your print and we will print your message on it", evidencing again that Applicant receives communications from others, records them in written or printed form, and transmits them to others.

Exhibit P: Twelve pages entitled "Survivor Message in a Bottle" which demonstrate that Applicant receives communications (by a "click" on the computer), records them in written as printed form ("Order a standard Survivor Message in a Bottle or have us customize it for you."), and transmits them to others (see "Mailing service").

21. The following are excerpts from Applicant's answers to Opposer's requests for admissions (copies of which are attached hereto as Exhibit Q with the cover and signature pages):

Request No. 1: You use the Trademark for novelty, favor and souvenir bottles containing messages and greetings, invitations, promotional

materials of others, and advertising materials of others; comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing.

Response No. 1: Applicant admits that he uses the Trademark for such items among others.

Request No. 14: You do business on the internet with the website addresses www.bottlemeamessage.com and www.dreamweaverstudios.com with your products and services.

Response No. 14: Applicant admits.

22. The following are excerpts from Applicant's responses to Opposer's revised first set of interrogatories (copies of which are attached hereto as Exhibit R hereto with the cover and signature pages):

Interrogatory No. 1: Identify each product marketed by you to date under the trademark.

Response to Interrogatory No. 1: Novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing. Applicant's products are further described at Applicant's website,

www.bottlemeamessage.com and include the following goods: bottles, corks, sand, shells, boxes, cords, confetti, decorative cut-outs, parchment paper, wedding invitations, party invitations, personalized greetings, notes, notecards, promotional announcements, art prints and reproductions.

Interrogatory No. 2: Identify each service marketed by you to date under the Trademark.

Response to Interrogatory 2: Retail store services; Computerized on-line retail store services featuring novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing; Providing online facilities featuring transaction order entry, order directing and order confirmation services.

Interrogatory No. 17: Identify the channels of trade for the sale of your products identified with the Trademark.

Response to Interrogatory 17: Internet sales, retail sales, catalog sales, commercial advertisements in magazines, newspapers, brochures and flyers, direct mail, telephone sales, and at trade shows and events.

Interrogatory No. 21: Identify the class of consumers to whom

your products identified with the Trademark have been sold.

Response to Interrogatory 21: All consumers, including individuals, families, commercial entities and merchants without any limitation.

Interrogatory No. 22: Identify the class of consumers to whom your services identified with the Trademark have been sold.

Response to Interrogatory No. 22: Services are not sold but are provided only ancillary to sales of products worldwide. Applicant further incorporates herein his response to Interrogatory No. 12 above.

Interrogatory No. 23: Identify all advertising media which you have advertised your products identified with the Trademark.

Response to Interrogatory No. 23: Applicant objects to this interrogatory on the grounds that it is vague and ambiguous as to “advertising media” and further objects on grounds that cumulative to other discovery requests made by opposer herein and that such interrogatory seeks information that is not relevant to the issues in this Opposition. Applicant further objects on the basis that the interrogatory seeks information and details which are of minimal, if any, evidentiary value in determining the issues in this action. Applicant further objects as the information sought under such interrogatory violates the Applicant’s rights of privacy as afforded to him

under the California Constitution and Federal law. Moreover, Applicant objects on grounds that the interrogatory seeks confidential and non-confidential materials which would require the production of commercially and competitively sensitive information which should not be produced without the protection of an Order restricting access from Opposer, a direct competitor. Applicant further objects on the grounds that as a competitor of Applicant, Opposer's interests in obtaining Applicant's advertising media used to promote his goods and services goes well beyond any matter of fact to be raised in the instant litigation. In order to protect Applicant from annoyance, oppression, undue burden and expense, and further due to the confidential and/or commercially sensitive nature of certain information requested, Applicant will not further respond to this interrogatory unless Opposer makes some preliminary explanation of relevance or showing as to need for said information and further agrees to the entry of an adequate protective Order restricting access. Notwithstanding and without waiver of said objections, Applicant further responds as follows: On the Internet at www.bottlemeamessage.com, via third party pay per click advertisers (e.g., Overture, Yahoo Search Marketing, Google Adwords etc.), via Internet search engines, via retail outlet, on banners and signage, business cards, flyers, brochures, direct mail letters, on catalogs, via commercial advertisements in

magazines, newspapers, and other printed publications, and at trade shows and events. Numerous examples have been previously provided to Opposer within Applicant's production of documents made heretofore in this action.

Interrogatory No. 24: Identify all advertising media which you have advertised your services identified with the Trademark.

Response to Interrogatory No. 24: Applicant hereby incorporates by reference his response to the preceding interrogatory No. 23.

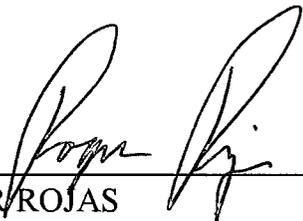
23. GSI has frequently had problems with infringers using the mark MESSAGE IN A BOTTLE. In 2003, GSI was represented by Attorney Jeffrey C. Cannon, and he recommended that GSI file a trademark application for MESSAGE IN A BOTTLE to supplement its service mark registration and aid in enforcement of its rights. GSI filed an application on November 3, 2003, serial no. 76/556,304, for the mark as a "communication device, namely, text and graphic images printed on paper and enclosed in a glass container" in Class 9. The application claimed distinctiveness under Section 2(f) of the Trademark Act, but included no evidence to support this claim. GSI then received a PTO office action dated June 7, 2004, in which the examining attorney issued an initial refusal on the ground of descriptiveness and noted that additional evidence was needed to support the claim of distinctiveness. Subsequently, however, I learned of Applicant's application and GSI filed its present opposition proceeding in October, 2004. This proceeding has taken significant time and expense since it was filed, and counsel advised that responding to the office action

in GSI's pending trademark application would also take a considerable amount of time and expense. Therefore, GSI and I filed a voluntary withdrawal of application serial number 76/556,304 without prejudice, which was accepted by the PTO on December 6, 2004. GSI still claims trademark rights, however, for the mark MESSAGE IN A BOTTLE as applied to the goods stated in that application.

* * * *

The foregoing facts are known to be true, of my own knowledge. I am competent to testify to such facts, and would so testify if I appeared before the Board as a witness at the trial of this matter.

Dated: August 11, 2006.



ROGER ROJAS

STATE OF CALIFORNIA)
) ss
COUNTY OF STANISLAUS)

On August 11, 2006, before me LUGENE M. BORBA, notary public (here insert name and title of the officer), personally appeared ROGER ROJAS, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person(s) whose name(s) is/are subscribed to the within instrument and acknowledged to me that he/she/they executed the same in his/her/their authorized capacity(ies), and that by his/her/their signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.



LUGENE M. BORBA
My commission expires: Dec. 9, 2009

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Affidavit of Roger Rojas in Support of Opposition to Applicant's Motions for Summary Judgment was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on August 11, 2006.


Lugene M. Borba

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR §2.198

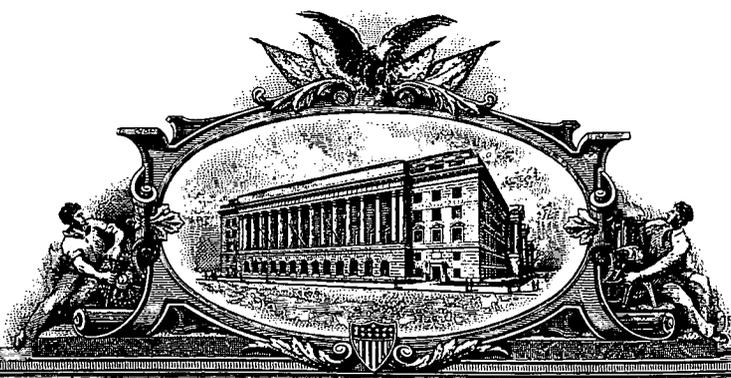
Mark: MESSAGE IN A BOTTLE
Registration No.: 2,243,269
Opposition No.: 91162780
Mailing Date: August 11, 2006
Name of parties filing paper: Roger Rojas and Gold Shells, Inc.
Type of paper being filed: Affidavit of Roger Rojas in Support of Opposition to Applicant's Motions for Summary Judgment

Express Mail Mailing Label Number: EQ 454418768 US
Date of Deposit: August 11, 2006

I hereby certify that the above-identified affidavit of Roger Rojas in support of opposition to applicant's motions for summary judgment, which is attached, is being deposited on August 11, 2006, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §2.198 in an envelope addressed to: U.S. Patent & Trademark Office, Trademark Trial & Appeal Board, P. O. Box 1451, Alexandria, VA 22313-1451.


Lugene M. Borba
Date: August 11, 2006

1399424



THE UNITED STATES OF AMERICA

TO ALL TO WHOM THESE PRESENTS SHALL COME:

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

December 02, 2005

THE ATTACHED U.S. TRADEMARK REGISTRATION 2,243,269 IS CERTIFIED TO BE A TRUE COPY WHICH IS IN FULL FORCE AND EFFECT WITH NOTATIONS OF ALL STATUTORY ACTIONS TAKEN THEREON AS DISCLOSED BY THE RECORDS OF THE UNITED STATES PATENT AND TRADEMARK OFFICE.

REGISTERED FOR A TERM OF 10 YEARS FROM *May 04, 1999*

SECTION 8 & 15

SAID RECORDS SHOW TITLE TO BE IN:

GOLD SHELLS, INC.

A CA CORP

**By Authority of the
Under Secretary of Commerce for Intellectual Property
and Director of the United States Patent and Trademark Office**

T. LAWRENCE

Certifying Officer



EXHIBIT A

Opposition No. 91162780

Gold Shells, Inc. v Keith Cangiarella

Submitting Party: Gold Shells, Inc.

Int. Cl.: 38

Prior U.S. Cls.: 100, 101, and 104

Reg. No. 2,243,269

United States Patent and Trademark Office

Registered May 4, 1999

**SERVICE MARK
PRINCIPAL REGISTER**

MESSAGE IN A BOTTLE

**ROJAS, ROGER (UNITED STATES CITIZEN)
725 PARADISE ROAD
MODESTO, CA 95351**

**FOR: RECEIVING COMMUNICATIONS
FROM OTHERS, RECORDING SUCH COMMU-
NICATIONS IN WRITTEN OR PRINTED
FORM, AND TRANSMITTING SUCH COMMU-
NICATIONS TO OTHERS, IN CLASS 38 (U.S.
CLS. 100, 101 AND 104).**

**FIRST USE 1-16-1999; IN COMMERCE
1-16-1999.**

**NO CLAIM IS MADE TO THE EXCLUSIVE
RIGHT TO USE "MESSAGE", APART FROM
THE MARK AS SHOWN.**

SN 75-226,521, FILED 1-6-1997.

RUSS HERMAN, EXAMINING ATTORNEY



Home All Message in a Bottle® Specials Accessories Shipping About Guarantee Contact FAQs Feedback Message Sample

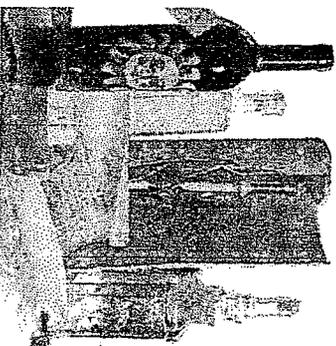
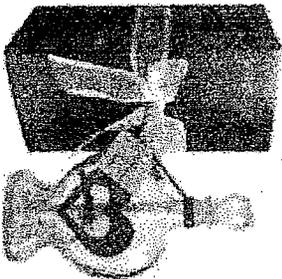
MessageInABottle.com is the Official Site of Message in a Bottle®

- Love
- Anniversary Gift
- Traditional Friendship
- Birthday Special Occasion
- Celestial Flowers For Mom For Dad Zodiac Gift Baby Nautical Christmas Valentines Day

*Make a lasting impression on someone today!
Send them a genuine Message in a Bottle®*

Over 70 Beautiful Glass Bottles To Choose From!

Call Us 1-800-959-2069
Mon-Fri, 9am-4pm PST



Message In A Bottle®

Desire \$39.99

What is a Message in a Bottle®?

In simple terms a Message in a Bottle® is the combination of your personalized sentiment which is printed, rolled and placed inside one of our beautiful bottles. A variety of presentation gift boxes, one of which is free, can then be added. We then send your gift to the recipient of your choice.

"It is beautiful! you guys did a wonderful job, thank you. I've been telling

everyone about you. I am very pleased to give this to my daughter!" - Joy H.

We are proud to offer you the **largest selection** of quality gift bottles in the **gift bottle industry** with a **100% money back guarantee**. We are proud to offer you a huge selection of pre-written messages and a **free gift box** with every order. You'll be proud you gave your loved one the **original Message in a Bottle ®** and not a mere imitation by another name. Remember to insist on the genuine Message in a Bottle ® because anything less simply won't do. It's easy. **Simply choose a bottle, choose a message or write your own and then tell us to whom you want it sent. We'll do the rest.**

Imagine...

- the surprise they'll feel as they open the gift box and a beautiful bottle is revealed.
- the wonder they'll experience as they discover the message inside. Who could it be from?
- the anticipation that grips them as they remove the message.
- the joy they'll feel when they realize it's from you. The look in their eyes says it all!

Message in a Bottle®

offers a Free **Gold Gift Box**

or Upgrade to a Sweetheart Red

Box \$3.99

Wood

Presentation Box \$16.99



Now just imagine how great it will feel knowing you made someone so very happy.

"I just want to thank you .. you guys have by far the best customer service .. i have never dealt with a company as thorough as yours in their customer service dept. i will definitely be ordering from you guys again .. keep up the excellent work!" -Mike M.

Say I Love You in a Message in a Bottle ®



Hand-Crafted In the USA

We are excited to bring you a personalized gift in a class of its own. Our beautiful glass bottles are simply the perfect complement to your message, love poem, love letter or if you prefer, select one of our wonderful pre-written messages. Either way, it makes for a **great gift idea** as a **Valentine's Day gift, Mother's Day gift, Wedding gift, Anniversary Gift**, or as a unique gift for any **Special Occasion**.

Home | All Message in a Bottle ® | Specials | Accessories | Shipping | About | Guarantee | Contact | FAQs | Feedback | Message Sample |

www.MessageInABottle.com Official Site of Message In A Bottle®



Call Us Toll Free 1 800 959-2069 Mon.-Fri. 9am-4pm PST

Look for our signature "Gold Shells from Carmel" logo to ensure it's a real Message in a Bottle®.

Message in a Bottle® 432 Britto Way Ste. 5 Modesto, CA 95356 Email: customerservice@messageinabottle.com

Message in a Bottle® is a registered mark. All rights reserved 1997-2006. ©





Message in a Bottle[®]
www.MessageInABottle.com

"the art of expression"[™]
Serving our Online Customers
Since 1997

www.

Home All Message in a Bottle 90 For Mom Love Anniversary Birthday Friendship Specials Invitations Mess

Cupid

Price: \$34.99

Glass Bottle
12 inches tall
Text: "I Love You"

Details:

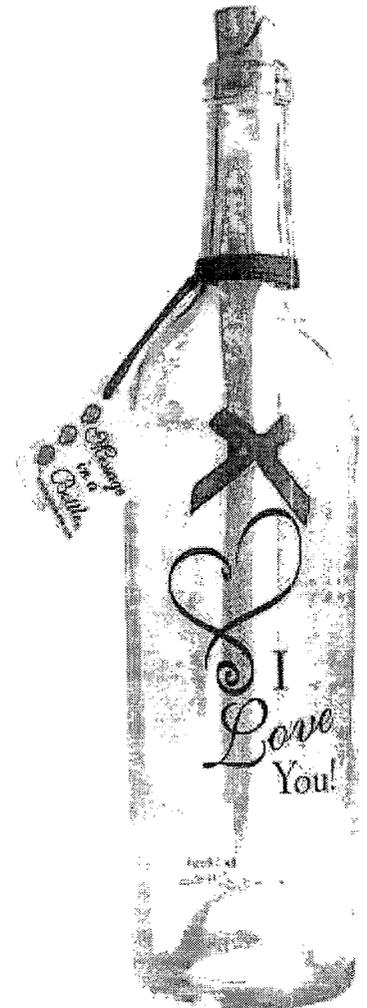
Cupid's arrow has struck again! This time he's decided that it's your turn to be in love. Let the love of your life know exactly how you feel with this great bottle that showcases a bright red heart above the simple declaration "I Love You!". The perfect Valentine's Day Gift!

Enter the text of your message that is to go rolled inside the bottle in the following field. Select Gift Box and Add to Cart at the bottom of the page.

WRITE YOUR
OWN:

GREETING:

- PREWRITTEN: My desire for you is a flame that won't subside, it burns within me deep inside.
- You live in my heart as you do in my soul. You are the one that makes me whole.
- Your friendship means the world to me, the things you do especially. You are a friend I can rely on, one whose shoulder I can cry on. There's a few things I know to be true and one is the friendship between me and you.
- Of all the special things in life, you are the one that brings me the greatest joy. I love when you're around.



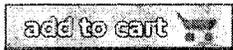
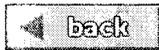
People come and go through life, but you have always been there for me. Constantly supporting and teaching me, your presence I feel everywhere. I love you more than you know and I guess that I always will, and with so many years gone by some thought the feeling would pass, but no, I feel it still.

CLOSING :

SELECT BOX: Gold Toned Box (add \$0.00) ▾

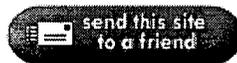
BURNT EDGES: No Thanks (add \$0.00) ▾

ADD SILK PETALS: No Thanks (add \$0.00) ▾



[Home](#) | [All Message in a Bottle ®](#) | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Message Sample](#) | [For Dad](#) |

www.MessageInABottle.com Official Site of Message In A Bottle®



Call Us Toll Free 1 800 959-2069 Mon.-Fri. 9am-4pm PST

Look for our signature "Gold Shells from Carmel" logo to ensure it's a real Message in a Bottle
Message in a Bottle® 432 Bitritto Way Ste. 5 Modesto, CA 95356 Email customerservice@messageinabottle.com
Message in a Bottle® is a registered mark. All rights reserved 1992006.©





Message in a Bottle[®]
www.MessageInABottle.com

"the art of expression"[™]
Serving our Online Customers
Since 1997

www.

- [Home](#)
- [All Message in a Bottle®](#)
- [For Mom](#)
- [Love](#)
- [Anniversary](#)
- [Birthday](#)
- [Friendship](#)
- [Specials](#)
- [Invitations](#)
- [Mess](#)

Product



Cupid
WRITE YOUR OWN:I want you to know that I love you.
GREETING:Dear Mary,
CLOSING :Love, Sam
SELECT BOX:Gold Toned Box
BURNT EDGES:No Thanks
ADD SILK PETALS:No Thanks

Qty.	Price	Total
<input type="text" value="1"/>	\$34.99	\$ 34.99

Sub Total \$ 34.99

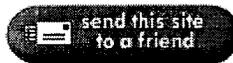
Zip Code: [estimate shipping](#) [update totals](#)

[more shopping](#) [secure checkout](#)

To remove an item from your cart, check the "x" button next to that item.
To change the quantity of an item, enter the new quantity in the box next to that item, and select update totals.

[Home](#) | [All Message in a Bottle®](#) | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Message Sample](#) | [For Dad](#) |

www.MessageInABottle.com Official Site of Message In A Bottle®



Call Us Toll Free 1 800 959-2069 Mon.-Fri. 9am-4pm PST

Look for our signature "Gold Shells from Carmel" logo to ensure it's a real Message in a Bottle
Message in a Bottle® 432 Bitritto Way Ste. 5 Modesto, CA 95356 Email customerservice@messageinabottle.com
Message in a Bottle® is a registered mark. All rights reserved 1992006.©





Message in a Bottle[®]
www.MessageInABottle.com

"the art of expression"[™]
Serving our Online Customers
Since 1997

www.

[Home](#) [All Message in a Bottle](#) [For Mom](#) [Love](#) [Anniversary](#) [Birthday](#) [Friendship](#) [Specials](#) [Invitations](#) [Mess](#)

Checkout Progress: [Account Information](#) [Shipping & Payment](#) [Place Order](#)



Account Information

Your Email:

Signup for our mailing list

Billing Information

First Name:

Last Name:

Company:

Your Phone:

Address:

City:

State/Province:

Zip/Postal Code:

Country:

- Shipping: Ship to billing address.
 Ship to another mailing address.

Please enter your billing address as it appears on your credit card statement. Rest assured your personal information and email address will NOT be shared or sold to a third party.

[← back](#) [continue →](#)

[Home](#) | [All Message in a Bottle](#) [®] | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Messag](#)
[Sample](#) | [For Dad](#) |

www.MessageInABottle.com Official Site of Message In A Bottle[®]





Message in a Bottle[®]
www.MessageInABottle.com

"the art of expression"[™]
Serving our Online Customers
Since 1997

www.

[Home](#) | [All Message in a Bottle](#) | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Mess](#)

Checkout Progress: [Account Information](#) | [Shipping & Payment](#) | [Place Order](#)



Enter your shipping address:

Enter your shipping address in the form below and click continue.

Name:

Address:

City:

State/Province:

Zip/Postal Code:

Phone:

Country: ▾

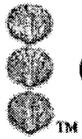
[Home](#) | [All Message in a Bottle](#) | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Messag](#)
[Sample](#) | [For Dad](#) |

www.MessageInABottle.com Official Site of Message In A Bottle[®]



Call Us Toll Free 1 800 959-2069 Mon.-Fri. 9am-4pm PST

Look for our signature "Gold Shells from Carmel" logo to ensure it's a real Message in a Bot[®]
Message in a Bottle[®] 432 Bitritto Way Ste. 5 Modesto, CA 95356 Email customerservice@messageinabottle.com
Message in a Bottle[®] is a registered mark. All rights reserved 199-2006.©



Message in a Bottle[®]
www.MessageInABottle.com

"the art of expression"[™]
Serving our Online Customers
Since 1997

www

[Home](#) [All Message in a Bottle®](#) [For Mom](#) [Love](#) [Anniversary](#) [Birthday](#) [Friendship](#) [Specials](#) [Invitations](#) [Mess](#)

Checkout Progress: [Account Information](#) [Shipping & Payment](#) [Place Order](#)



Select your preferred method of shipping:

- Express - \$22.20
- Priority - \$5.00

*Important- Make sure you have selected your preferred shipping method above.

DOMESTIC SHIPPING

USPS Priority Mail - Select this for standard delivery which usually takes 3-5 business days from date of order within the continental U.S..

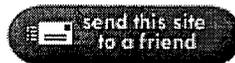
USPS Express Mail - Select this for expedited delivery which usually takes 2 business days from date of order within the continental U.S. If you place your order by 3:00 p.m. Pacific Standard Time on a regular business day, Mon-Fri. excluding holidays. Express Mail orders placed outside the above guidelines will require additional business day for travel.

Select your payment method:

[back](#) [continue](#)

[Home](#) | [All Message in a Bottle®](#) | [For Mom](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Specials](#) | [Invitations](#) | [Message Sample](#) | [For Dad](#) |

www.MessageInABottle.com Official Site of Message In A Bottle®



Call Us Toll Free 1 800 959-2069 Mon.-Fri. 9am-4pm PST

Look for our signature "Gold Shells from Carmel" logo to ensure it's a real Message in a Bottle
Message in a Bottle® 432 Bitritto Way Ste. 5 Modesto, CA 95356 Emailcustomerservice@messageinabottle.com
Message in a Bottle® is a registered mark. All rights reserved 1992-2006.©

STATEMENT OF USE UNDER 37 C.F.R. §2.88, WITH DECLARATION

TO THE ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS:

APPLICANT NAME: ROGER ROJAS

NOTICE OF ALLOWANCE ISSUE DATE: August 25, 1998

Applicant requests registration of the above-identified 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). Three (3) specimens showing the mark as used in commerce are submitted with this statement.

Applicant is using the mark in commerce on or in connection with the services identified in the Notice of Allowance in this application as receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others.

The date of first use of the mark anywhere was January 16, 1999.

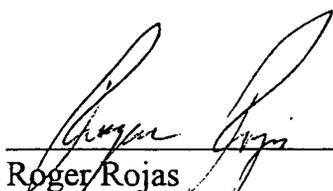
The date of first use of the mark in commerce which the U.S. Congress may regulate was January 16, 1999.

The type of commerce is interstate commerce.

The manner or mode of use of the mark in connection with the services is on advertising flyers, letterheads, business cards, computer screen displays in electronic commerce, and labels and containers used in carrying out the services.

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 is executing this statement as the applicant; he believes that he is the owner of the service mark sought to be registered; the service mark is now in use in commerce; and all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

DATE: January 19, 1999.



Roger Rojas

EXHIBIT C

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangarella
Submitting Party: Gold Shells, Inc.

Telephone: (209) 521-3653

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

Registrant:) Roger Rojas
Mark:) MESSAGE IN A BOTTLE
Registration No.) 2,243,269
Class No.) 38

The Commissioner of Patents and Trademarks
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Combined Affidavit of Use and Incontestability

Roger Rojas, doing business as Message in a Bottle, 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 this document, declares that he owns the above-identified registration, issued May 4, 1999, as shown by records in the Patent and Trademark Office; that the mark shown therein has been in continuous use in interstate commerce for five consecutive years from the date of the registration or the date of publication under Section 12(c)(6) to the present, on or in connection with receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, which services are stated in the registration; that such mark is still in use in interstate commerce; that such mark is still in use as evidenced by the specimen attached hereto as Exhibit A; that there has been no final decision adverse to registrant's claim of ownership of such mark for such services, or to registrant's right to register the same or to keep the same on the register; that there is no proceeding involving said rights pending and not disposed of either in the Patent and Trademark Office or in the courts; and that all statements made of his own knowledge are true and all statements made on information and belief are believed to be true.

Dated: October 1, 2004.



Roger Rojas, doing business as
Message in a Bottle

EXHIBIT D
Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

Message in a Bottle®

the art of expression™

Messageinabottle.com Official Site of Message in a Bottle® Serving our online customers since 1997

Home
Message in a Bottle®
Gifts
Free
Shipping
Gift Certificates
Specialty
Gift Occasions
Accessories
Message Samples
FAQ
Contact
Privacy
Terms



Free Gold Toned Box or Upgrade to a Wood Presentation Box For Only \$12.99



Don't Forget!

Sweetest Day Oct. 16th
Boss's Day Oct. 16th

Christmas Collection
Coming Soon!



Make a lasting impression on someone today.
Send them a genuine Message in a Bottle®

We offer you:

- o the largest selection of decorative bottles in the gift bottle industry so that you'll always have the appropriate bottle for any occasion.
- o a 100% unconditional money back guarantee so that you'll feel confident with your purchase.
- o a huge selection of prewritten messages and poems so that you will always have the words to say it right.
- o a FREE Gold Toned Gift Box with every purchase or upgrade to one of our Wood Presentation Boxes.
- o the security of knowing that you are sending your loved one the original Message in a Bottle® that we have been offering to our online customers since 1997 and not a mere imitation by another name.



Message in a Bottle®
Be Romantic!



Free Gold Toned Box
or Upgrade to a
Wood Presentation Box For Only
\$12.99

"she loved it! I can't tell you how happy it made her. thank you! thank you! thank you!" -Patrick R.

We are proud to offer a personalized gift in a class of its own. Our beautiful bottles are simply the perfect complement to your message, love poem, love letter or if you prefer, select one of our wonderful prewritten messages. Either way, our bottles make for a great gift idea as a Valentine's Day gift, Mother's Day gift, Wedding gift, Anniversary gift, or as a unique gift for any special occasion.

"It is beautiful! you guys did a wonderful job, thank you. I've been telling everyone about you. I am very pleased to give this to my daughter!" - Joy H.

Ordering couldn't be simpler!

- A. Select category and bottle
- B. Choose your message or write your own
- C. Proceed to our secure checkout

It's that simple!

Click [HERE](#) view bottles

[Home](#) | [All Message in a Bottle®](#) | [Specials](#) | [Love](#) | [Anniversary](#) | [Birthday](#) | [Friendship](#) | [Traditional](#) | [Any Occasion](#) | [Accessories](#) | [Message Sample](#) | [Shipping](#) | [About](#) | [Guarantee](#) | [Contact](#) | [Privacy](#) | [FAQ'S](#) | [Feedback](#) |



Look for our signature "Gold Shells from Carmel" to ensure it's a real Message in a Bottle®.

Message in a Bottle® P. O. Box 1625 Carmel by the Sea, CA 93921 Email: sales@messageinabottle.com
Message in a Bottle® is a registered mark. All rights reserved 1997-2004. ©

MESSAGE IN A BOTTLE_{SM}

Roger Rojas, Proprietor ~ P.O. Box 581113 ~ Modesto, CA 95358 ~ U.S.A.
Email miab@ainet.com
Visit our website at www.messageinabottle.com

Valued customer,

Our service is sending art quality greetings in unique and distinctive bottles to that someone special. You let us

know the communication you want to send, and who you want it sent to, and we will record your communication in

beautifully hand-written form, insert it in a bottle, and transmit it for you. To receive our service visit our website at

www.messageinabottle.com and fill out the order form.

Sincerely,

Roger Rojas

EXHIBIT E

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

PETER H. SMITH

ATTORNEY AT LAW

1535 J STREET, SUITE A

POST OFFICE BOX 1867

MODESTO, CALIFORNIA 95353

MEMBER OF CALIFORNIA
& OREGON STATE BARS

TELEPHONE (209) 579-9524
FACSIMILE (209) 579-9940

May 31, 2005

VIA FAX TO (312) 321-4299

Howard S. Michael, Esq.
Brinks, Hofer, Gilson & Lione
NBC Tower - Suite 3600
455 N. Cityfront Plaza Drive
Chicago, IL 60611-5599

Re: Trademark/Service Mark Infringement Issue – MESSAGE IN A BOTTLE

Dear Mr. Michael:

I am writing to you as counsel for Overture Services, Inc., having previously contacted you in that capacity regarding infringements of the registered service mark MESSAGE IN A BOTTLE, which is owned by my client, Gold Shells, Inc. My client's initial contact to you was by letter from its prior counsel, Jeffrey Cannon, dated January 27, 2004, and you sent a brief response to Mr. Cannon dated February 6, 2004. Thereafter, Mr. Cannon received a positive substantive response from Debra Carrete of the Trademark Department at Overture Services, Inc., dated April 1, 2004.

I subsequently alerted you by telephone to on-going problems with infringements of MESSAGE IN A BOTTLE on December 14, 2004, and February 8, 2005.

It has now come to my client's attention that a repeat infringer, Keith Cangiarella at bottlemeamessage.com, has started bidding on the key word "Message in a Bottle", which is identical to my client's registered mark. Please recall that my client's service mark registration no. 2,243,269 was issued on May 4, 1999, and has a priority date of January 6, 1997. A continuing use affidavit has been filed and accepted by the U.S. Patent & Trademark Office, and the registration is now incontestable.

After my client's concerns were originally communicated to Overture, Overture properly removed Mr. Cangiarella and some other infringers over a year ago, and they have not since returned except for Cangiarella. Since his website continues to contain infringing material, I am not sure how his site has again appeared, and I ask that it again be removed.

EXHIBIT F

Opposition No. 91162780

Gold Shells, Inc. v Keith Cangiarella

Submitting Party: Gold Shells, Inc.

My client has also learned that, because of a technical issue cited by Overture Customer Service, infringers are occasionally popping up on the Yahoo Sponsored Search under the "Sponsored Results" area on the right side of the page. This is a mistake because these companies are not bidding for the term; they are simply appearing without paying, apparently because of this "technical issue". Overture Customer Service advised that this could be easily corrected by manually removing these results, and I ask that this be done.

Upon further investigation, my client has determined that many of the previous infringers who were removed from Yahoo Sponsored Search have now migrated to many of the new Yahoo products that have become available. These companies are all repeat infringers and have violated the Yahoo Trademark Policy, the Yahoo Terms of Service, the Yahoo Content Guidelines, and the Yahoo Merchant Guidelines, as well as federal trademark law.

The following is a list of infringing websites which have appeared on the various Yahoo products:

(1) **Yahoo Sponsored Search**: bottlemeamessage.com, timelessmessage.com, authenticmessages.com, and personalcreations.com. (All have been previously removed, but are occasionally popping up due to the "technical issue" noted above).

(2) **Yahoo Product Submit**:

timelessmessage.com	bottlemeamessage.com
epersonalized-gifts.com/pickNpersonalize.com	
walmart.com	allbirthdaygifts.com
shop.store.yahoo.com/myweddingfavours/index.html	
personalizedbirthdaygifts.com	dogwoodsquare.com
momentsofelegance.com	yourweddingpartyfavours.com
weddingfavorsetc.com	paradiseisntlost.com
giftlet.com	babyshowerspecialists.com
textstyledesigns.com	capeimages.com
mypersonalartist.com	granny1.com
giftideasformom.com	tradewindproducts.com
writingpapers.com	weddinggifts.net
babygifts1.com	giftsfourgolfers.com
wtv-zone.com	weddinggifts1.com

Howard S. Michael, Esq.
May 31, 2005
Page 3

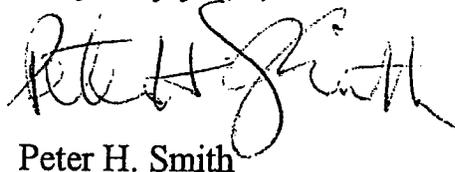
nopassportrequired.com	fraternity-sorority.com
hqweddingfavors.com	thinkingofyoutwo.com
washnweartoo.com	allmothersdaygifts.com
shop.store.yahoo.com/theobsessionboxco/trgiset.html	
easterncorner.com	wherebridgesgo.com
foreverwedstore.com	cottongin.com
name-origins.com	weddingsbydeign.com
romanticgiftstudio.com	lighthousewarehouse.com
bocaresort.com	moodweddings.com
cassandra-greatest.com	kidboxes.com
giftideasfordad.com	sale4all.com
shoppingbrains.com	presentpicker.com
jilcompanies.com	islandweddingshop.com
tradingstories.com	myweddingfavors.com
yourpartyweddingfavors.com	crownstationers.com
sandartsupplies.com	

(3) **Directory Submit:** bottlemeamessage.com, timelessmessage.com, and marketinginabottle.com.

(4) **Search Submit:** thegreetingstore.com, authenticmessages.com, timelessmessage.com, and marketinginabottle.com,

Please take the action requested above and also take whatever other action may be required to remove these infringers' infringing materials from all Yahoo products, including Yahoo Store. I will appreciate your confirming your action on this subject by return communication to me by June 17, 2005.

Very truly yours,



Peter H. Smith

PHS/lmb

cc: Mr. Roger Rojas, Gold Shells, Inc.

**ACCEPTABLE
IDENTIFICATION OF
GOODS AND SERVICES
MANUAL**

1997 (First) Edition



Issued by:
Patent and Trademark Office
U.S. Department of Commerce

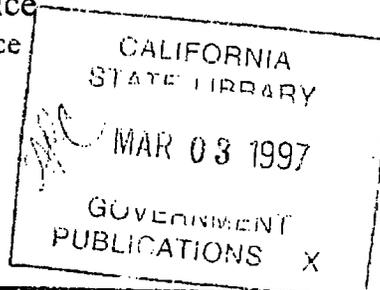


EXHIBIT G

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

CLASS 38
(Telecommunications)

Explanatory Note

This class includes mainly services allowing at least one person to communicate with another by a sensory means. Such services include those which:

- (1) allow a person to talk to another,
- (2) transmit messages from one person to another, and
- (3) place a person in oral or visual communication with another (radio and television).

Includes, in particular:

- ° services which consist essentially of the diffusion of radio or television programmes.

Does not include, in particular:

- ° radio advertising services (Cl. 35).

CLASS 39
(Transportation and storage)

Transport; packaging and storage of goods; travel arrangement.

Explanatory Note

This class includes mainly services rendered in transporting people or goods from one place to another (by rail, road, water, air or pipeline) and services necessarily connected with such transport, as well as services relating to the storing of goods in a warehouse or other building for their preservation or guarding.

Includes, in particular:

- ° services rendered by companies exploiting stations, bridges, rail-road ferries, etc., used by the transporter;
- ° services connected with the hiring of transport vehicles;
- ° services connected with maritime tugs, unloading, the functioning of ports and docks and the salvaging of wrecked ships and their cargoes;
- ° services connected with the functioning of airports;
- ° services connected with the packaging and parcelling of goods before dispatch;
- ° services consisting of information about journeys or the transport of goods by brokers and tourist agencies, information relating to tariffs, timetables and methods of transport;
- ° services relating to the inspection of vehicles or goods before transport.

Doe

Tre

This
proc
For
tran
whe

Incl

Doe

Edu

This
facu

T	IC	Services	Date	S
S	038	Audio broadcasting	4/2/91	A
S	038	Audio teleconferencing	4/2/91	A
S	038	Broadcasting (Audio)	4/2/91	A
S	038	Broadcasting (Cable radio)	4/2/91	A
S	038	Broadcasting (Cable television)	4/2/91	A
S	038	Broadcasting (Radio)	4/2/91	A
S	038	Broadcasting (Subscription television)	4/2/91	A
S	038	Broadcasting (Television)	4/2/91	A
S	038	Broadcasting (Video)	4/2/91	A
S	038	Broadcasting programs via a global computer network	1/2/97	A
S	038	Cable casting services	2/20/96	A
S	038	Cable radio broadcasting	4/2/91	A
S	038	Cable radio transmission	4/2/91	A
S	038	Cable television broadcasting	4/2/91	A
S	038	Cable television transmission	4/2/91	A
S	038	Cellular telephone services	4/2/91	A
S	038	Communication (Mobile radio)	4/2/91	A
S	038	Communication (Radio)	4/2/91	A
S	038	Communication (Telegram transmission and)	4/2/91	A
S	038	Communication (Telephone)	4/2/91	A
S	038	Communication by telegram	4/2/91	A
S	038	Computer terminals (Electronic transmission of data and documents via)	4/2/91	A
S	038	Data and voice telecommunications	3/15/93	D
S	038	Delivery of messages by electronic transmission	4/2/91	A
S	038	Electronic mail services	4/2/91	A
S	038	Electronic order transmission for florists	4/2/91	A
S	038	Electronic store-and-forward messaging	4/2/91	A
S	038	Electronic transmission (Delivery of messages by)	4/2/91	A
S	038	Electronic transmission of data and documents via computer terminals	4/2/91	A
S	038	Electronic transmission of messages and data	4/2/91	A
S	038	Electronic voice messaging, namely, the recording, storage and subsequent transmission of voice messages by telephone	4/2/91	A
S	038	Facsimile transmission	4/2/91	A
S	038	Florists (Electronic order transmission for)	4/2/91	A
S	038	Mail services (Electronic)	4/2/91	A
S	038	Messaging (Electronic store-and-forward)	4/2/91	A
S	038	Messaging, namely, the recording storage and subsequent transmission of voice messages by telephone (Electronic voice)	4/2/91	A
S	038	Mobile radio communication	4/2/91	A

S	038	Network conferencing services	9/
S	038	Outcall notification services	1/
S	038	PBX dialing services	19/
S	038	Paging services	14/2
S	038	Pay-per-view television transmission services	9/
S	038	Providing frame relay connectivity services for data transfer	13/2
S	038	Providing telecommunications connections to a global computer network	17/
S	038	Radio broadcasting (Cable)	1/
S	038	Radio broadcasting	12/2
S	038	Radio communication (Mobile)	14/
S	038	Radio communication	17/
S	038	Radio transmission (Cable)	17/
S	038	Rental of telecommunication equipment [in general or indicate specific items of equipment, e.g. telephones, facsimile machines]	17/
S	038	Satellite transmission services	21/2
S	038	Singing telegram services	17/
S	038	Subscription television broadcasting	17/
S	038	Telecommunication (data and voice)	18/
S	038	Telecommunication equipment (in general or indicate specific items of equipment, e.g. telephones, facsimile machines) (Rental of)	17/
S	038	Telecommunication services	17/
S	038	Telecommunications gateway services, namely [INDICATE SPECIFIC purpose of the gateway link]	17/
S	038	Telecommunications gateway services	9/
S	038	Telecommunications services, namely [MUST INDICATE SPECIFIC purpose of gateway link]	17/
S	038	Telecommunications services, namely, ISDN services	9/
S	038	Telecommunications services, namely, personal communication services	9/
S	038	Teleconferencing (Audio)	17/
S	038	Teleconferencing (Video)	17/
S	038	Telegram (Communication by)	17/
S	038	Telegram services (Singing)	17/
S	038	Telegram transmission and communication	17/
S	038	Telegram transmission	17/
S	038	Telegraph services	17/
S	038	Telematic services	17/
S	038	Telephone communication services	17/
S	038	Telephone services (Cellular)	17/
S	038	Telephone voice messaging services	17/
S	038	Teleprinting	17/

038	Teletext services	4/2/91 A
038	Teletype services	3/15/93 D
038	Television broadcasting (Cable)	4/2/91 A
038	Television broadcasting (Subscription)	4/2/91 A
038	Television broadcasting	4/2/91 A
038	Television transmission (Cable)	4/2/91 A
038	Ticker tape services	4/2/91 A
038	Transmission (Cable radio)	4/2/91 A
038	Transmission (Cable television)	4/2/91 A
038	Transmission (Delivery of messages by electronic)	4/2/91 A
038	Transmission (Facsimile)	4/2/91 A
038	Transmission (Telegram)	4/2/91 A
038	Transmission and communication (Telegram)	4/2/91 A
038	Transmission for florists (Electronic order)	4/2/91 A
038	Transmission of data and documents via computer terminals (Electronic)	4/2/91 A
038	Transmission of messages and data (Electronic)	4/2/91 A
038	Transmission of voice messages by telephone (Electronic voice messaging, namely, the recording and subsequent)	4/2/91 A
038	Video broadcasting	4/2/91 A
038	Video narrowcasting services	9/1/95 A
038	Video conferencing	4/2/91 A
038	Video-on-demand transmission services	9/1/95 A
038	Vidiotext services	4/2/91 A
038	Voice mail services	1/2/97 A
038	Voice messaging, namely, the recording storage and subsequent transmission of voice messages by telephone (Electronic)	4/2/91 A
038	Voice telecommunication (Data and)	3/15/93 D
038	Voice-activated dialing services	9/1/95 A
038	Wireless PBX services	9/1/95 A
038	Wireless digital messaging services	9/1/95 A
038	Wireless facsimile mail services	9/1/95 A
038	Wireless voice mail services	2/20/96 D

gsinc@sbcglobal.net

From: "Foreman, Betsy" <Foreman_B@ccesc.org>
To: <sales@messageinabottle.com>
Sent: Friday, May 21, 2004 7:15 AM
Subject: Website

I am interested in ordering from your company. I saw the "Message in a Bottle" invitations on your website. For some reason, I am having trouble getting to them today. Are you having difficulties with your website? I am interested in the bottles with confetti. What is the total cost for these—if you assemble, with invitation, but we send them out? Please let me know ASAP. Also, let me know the best way to order if I cannot get through on the website. Could you e-mail me the list of all prices?

Thank you,
Betsy Foreman
Foreman_B@ccesc.org

gsinc@sbcglobal.net

From: "Kramer, Lisa MS" <lisa.kramer@us.army.mil>
To: <customerservice@messageinabottle.com>
Sent: Friday, February 11, 2005 1:29 PM
Subject: RE: Feedback

You are correct. I recommended your site specifically. However, the guys I recommended it to "googled" it or something and got bottlemeamessage.com [1mib@dreamweaverstudios.com] I apologize for my misdirected email. I have not posted any negative messages yet. I will be very specific in my reference to the appropriate website. They bill themselves as the "original message in a bottle shop."

Again, I am sorry. I will continue to recommend your site, I'll just be sure to provide the link to those I make the recommendations to.

-----Original Message-----

From: customerservice@messageinabottle.com
[mailto:customerservice@messageinabottle.com]
Sent: Friday, February 11, 2005 2:21 PM
To: KramerL@wood.army.mil
Subject: Re: Feedback

Dear Ms. Kramer,

We do not offer free shipping so this cannot be our company. Please let us say that we don't take advantage of any of our customers, especially those serving in our military. Our shipping policy is clearly posted on our website and it applies to all of our customers.

We have heard of some other companies selling imitation products with sound alike names which do promote free shipping. Again this is NOT us! Please have your friends examine any email receipts or the actual imitation product to see who is the source of this fraudulent practice. Please confirm who is actually doing this before posting to any bulletin boards. Our company is messageinabottle.com and we sell the only genuine Message in a Bottle®. Please respond to this email because we cannot stress how

EXHIBIT I

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

9/15/2005

upsetting this revelation is.

Thank you for your concern and for looking out for our men and women in uniform.

messageinabottle.com

----- Original Message -----

From: <KramerL@wood.army.mil>

To: <customerservice@messageinabottle.com>

Sent: Friday, February 11, 2005 11:33 AM

Subject: Feedback

First_Name: Lisa

Last_Name: Kramer

Email_Address: KramerL@wood.army.mil

Comments: After receiving one of your products, I recommended your website

to several of my coworkers as a great place to get a Valentine's Day gift.

I work with soldiers who don't have great incomes. Now, three days before Valentine's day, I have heard from several who have fallen victim to what appears to be your very deceptive bait & switch shipping policy.

Advertising free shipping as a part of your service and then charging (at the last minute) more than \$25 shipping for an item that is less than \$25 itself is bad business. I'm embarassed to have recommended your site to my friends serving your country. I will no longer do so. I will instead post my complaint on every consumer electronic bulletin board I can find.

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

In the Matter of Trademark Application
Serial No.: 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark
Registration No.: 2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,
v.

ROGER ROJAS,
Registrant

Opposition No. 91162780

Cancellation No. _____

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION AND COUNTERCLAIM

Applicant, Keith Cangiarella ("Applicant"), for his answer to the Notice of Opposition against his application for registration of his trademark: MESSAGE IN A BOTTLE, Serial No. 78/229,875, filed on March 25, 2003 and published in the Official Gazette on June 29, 2004, filed by Opposer Gold Shells, Inc. (as the alleged assignee, and/or successor-in-interest of Registrant Roger Rojas), hereby generally and specifically denies each and every allegation contained in the Opposition hereinafter not specifically admitted, modified, or qualified, and strict proof is demanded thereof. Applicant further responds to Opposition with the answers as follows:

1. Applicant admits that the filing date of his application, Serial No. 78/229,875 was March 25, 2003. Applicant also admits that his date of first use of the trademark applied for as

EXHIBIT J

Opposition No. 91162780

Gold Shells, Inc. v Keith Cangiarella

Submitting Party: Gold Shells, Inc.

claimed was at least as early as March 10, 1998. Otherwise, to the extent that the allegations are understood, Applicant denies the allegations of Paragraph 1 for the reason that they are untrue or on the grounds that Applicant is without knowledge or information sufficient to form a belief as to the allegations and therefore denies same. Applicant more specifically denies that Opposer, Gold Shells, Inc. "is the owner of U.S. service mark registration no. 2,243,269 for the mark MESSAGE IN A BOTTLE in Class 38 for receiving communications from others, recording such communication in written or printed form, and transmitting such communication to others, which was registered on the Principal Register on May 4, 1999."

Applicant further denies the allegation that "[s]aid registration is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use said mark in commerce on the services specified in said registration, Opposer's predecessor having timely filed a combined affidavit of continuing use under Sections 8 and 15 of the Lanham Act between the fifth and sixth anniversaries of Opposer's registration date."

Applicant further denies that the allegation that there is a "related nature of the services for which Opposer's mark was registered and the goods for which Applicant's application has been filed."

Applicant further denies that "Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion, or to cause mistake, or to deceive."

2. Applicant is without knowledge or information sufficient to form a belief as to the allegations of Paragraph 2 and therefore denies the same.

3. Applicant admits that the filing date of his application, Serial No. 78/229,875 was March 25, 2003. Applicant also admits that his claimed first use in commerce was at least as early as June 10, 1998. Otherwise, to the extent that the allegations are understood, Applicant

denies the allegations of Paragraph 3 for the reason that they are untrue, or otherwise that Applicant is without knowledge or information sufficient to form a belief as to the allegations and therefore denies the same. To the extent that a legal conclusion is therein stated, no response is required. Applicant further specifically denies the allegation that “[s]ince January 16, 1999, Opposer or its predecessor have been, and Opposer is now, actually using the mark MESSAGE IN A BOTTLE in connection with the sale of services as described in the registration and as a trademark in connection with the sale of goods consisting of novelty, favor, and souvenir bottles containing messages and greetings, identical to some of the goods set forth in Applicant’s application.”

Applicant further denies the allegation that “[u]nder section 7(c) of the Lanham Act, Opposer has a priority right to the mark through constructive use based on the filing date of its predecessor’s original intent-to-use service mark application...”

Applicant further denies the allegation that “[u]se by Opposer and its predecessor has been valid and continuous since the date of first use and has not been abandoned.”

Applicant further denies the allegation that “Applicant uses the the mark on services which are identical to those for which Opposer has registered its mark, namely receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others.”

Applicant further denies the allegation that [s]aid mark of Opposer is symbolic of extensive good will and consumer recognition built up by Opposer and its (alleged) predecessor through a substantial amount of time and effort in advertising and promotion.”

Applicant further denies the allegation that “the nature of the goods and services of the parties are substantially similar”, and also for purposes of this proceeding, only, denies that

“Applicant’s mark so resembles Opposer’s mark as to be likely to cause confusion, or to cause mistake, or to deceive.”

4. Applicant admits that he is not a person who has used the mark MESSAGE IN A BOTTLE prior to the application filing date of Opposer's alleged predecessor. Applicant denies that Opposer has any “right of priority under Section 7(c) of the Lanham Act” or otherwise. To the extent that a legal conclusion is therein stated, no further response is required.

5. Applicant denies the allegations of Paragraph 5 for the reason that they are untrue. Applicant is without knowledge or information sufficient to form a belief as to the allegations with respect to Opposer’s alleged predecessor and therefore denies same. Applicant specifically denies that “the relevant class of the public has come to associate Opposer with (any) said designation.” Applicant denies that his “mark consists of and comprises matter that may disparage and falsely suggest a connection with Opposer.” To the extent that a legal conclusion is therein stated, no response is required.

6. Applicant denies the allegations of Paragraph 6 for the reason that they are untrue. Defendant denies Opposer’s Prayer and all allegations therein contained and further submits the following separate and alternative affirmative defenses as to this matter:

AFFIRMATIVE DEFENSES

1. As a result of his long term, continuous and substantial usage of his mark MESSAGE IN A BOTTLE since adoption, such mark has become distinctive of the Applicant’s goods in commerce and such mark is a valuable asset of Applicant which has become and carries considerable goodwill and consumer acceptance of Applicant's products sold under the mark. Such goodwill and widespread usage has made the mark distinctive to the Applicant.

2. Opposer lacks any standing to bring this opposition.
3. Opposer is barred by laches, acquiescence and estoppel from contesting this opposition.
4. Opposer's claims are barred due to its own fraud and fraudulent conduct and that of its alleged predecessor as engaged in before the United States Patent & Trademark Office.
5. Opposer's claims are barred as unconscionable and due to Opposer's (and its alleged predecessor, Roger Rojas') unclean hands.
6. Opposer (and its alleged predecessor, Roger Rojas) has not used the mark MESSAGE IN A BOTTLE on goods or services as an identification of origin of those goods or services identified in the Notice of Allowance. As such, Opposer has no trademark rights to the term for the goods or services, regardless of when and if it allegedly first used the term in commerce.
7. Opposer and its alleged predecessor has not used the MESSAGE IN A BOTTLE mark on any services that may be properly characterized as within International Class 38.
8. There is a myriad of adoptions and uses of the mark MESSAGE IN A BOTTLE. As such, any service mark rights that Opposer (and/or its alleged predecessor) may allegedly have are narrowly circumscribed to the specific services identified by the Notice of Allowance of the Registration No. 2,243,269 and any other use would not lead to a likelihood of confusion.
9. Notice of Opposition fails to state a claim upon which relief can be granted, and in particular, fails to state legally sufficient grounds for sustaining the opposition.

In view of the foregoing, Applicant contends that this opposition is groundless and baseless in fact; that Opposer has not shown wherein it will be, or is likely to be, damaged by the registration of Applicant's trademark; that Applicant's trademark is manifestly distinct from any

alleged mark of the Opposer or any designation of the Opposer and Applicant prays that this Opposition be dismissed and that Applicant be granted registration of his trademark.

APPLICANT'S COUNTERCLAIM FOR CANCELLATION
[37 C.F.R. § 2.106(b)(2)(i); 37 C.F.R. §2.114(b)(2)(i)]

Petitioner Keith Cangiarella, an individual, and doing business as DreamWeaver Studios, having a place of business at 331 N. Harrington Drive, Fullerton, CA 92831 ("Applicant") believes that he has been and will be damaged by Registration No. 2,243,269, owned in the name of Roger Rojas, ("Registrant") and pursuant to 15 U.S.C. §1064 et. seq. and 37 C.F.R. §2.111 et. seq. hereby petitions to cancel the same.

As grounds therefore it is alleged that:

1. Applicant is an individual engaged in the business producing and selling favor, and novelty souvenir bottles containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing.
2. Applicant uses and has continuously used the trademark MESSAGE IN A BOTTLE in connection with his goods and services in connection with his business for well over six (6) years with a first use date of March 10, 1998 and a first use in commerce date of June 10, 1998.
3. That on March 03, 1999, Applicant filed with the United States Patent & Trademark documents pertaining to his MESSAGE IN A BOTTLE branded novelty gift souvenir bottles under the Disclosure Document No. 452308.

4. That on March 08, 1999, Applicant filed with the United States Patent & Trademark a nonprovisional Patent Application No. 09/265,237 as pertaining to his MESSAGE IN A BOTTLE branded novelty souvenir gift bottles.

5. Applicant obtained a Federal copyright registration, namely Registration No. VAU 483-244 for his work consisting of a photograph of his distinctive MESSAGE IN A BOTTLE novelty souvenir gift bottle on January 28, 2000, which was based on a creation date of January 1998.

4. Since adopting his MESSAGE IN A BOTTLE trademark in 1998, Applicant has spent substantial sums in the advertising and promotion of Applicant's business and professional quality of the goods and services under the MESSAGE IN A BOTTLE trademark throughout the United States, and is continuing to spend substantial amounts of time and money in promotion the same.

5. As a result of the expenditure of considerable sums for promotional activities, advertising, and by virtue of the excellence of his products and services, Applicant has garnered for his MESSAGE IN A BOTTLE trademark a most valuable reputation and has developed extensive goodwill throughout the United States. His products have further been the subject of reports, advertisements and features in newspapers and magazines of general circulation, including, without limitation, the Orange County Register (April 4, 1999) and Modern Bride magazine (Fall, 2001).

6. On March 25, 2003, Applicant filed a trademark application on the Principal Register for MESSAGE IN A BOTTLE in Class 16 for "favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising

messages, greetings, messages and invitations and packaging and boxes for mailing." This application was assigned Serial No. 78/229875.

7. Applicant is the owner of State of California Service mark Registration No. 059960 for the mark MESSAGE IN A BOTTLE as registered for "manufacturing and shipping a novelty, favor, souvenir bottle, containing messages and greetings, invitations, promotional materials of others and advertising materials of others.

8. On October 21, 2004, a California corporation, GOLD SHELLS, INC., as the alleged successor-in-interest to Registrant Roger Rojas, relying on his trademark MESSAGE IN A BOTTLE, filed the above- answered opposition to Applicant's application. The trademark relied on by the Opposer has been registered and remains in the name of an individual, Roger Rojas ("Registrant"). On January 6, 1997, Registrant Roger Rojas filed application Serial No. 75226521 for registration on the Principal Register for the mark MESSAGE IN A BOTTLE in International Class 38 for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." This application matured into Reg. No. 2,243,269 on May 4, 1999 and is the subject of this petition.

9. Applicant is informed and believes that on or about January 28, 1999, under notice of Section 1001 of Title 18 of the United States Code, Registrant submitted a sworn declaration to the U.S. Patent & Trademark Office in which he stated that "Applicant is using the mark in commerce on or in connection with the services identified in the Notice of Allowance in this application as receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others."

10. On information and belief, Registrant fraudulently obtained the registration by purposefully providing a false and misleading description of the goods and/or services covered by his application. The specification in the formal application papers filed by Registrant under oath stated that the goods and/or services were being used in International Class 38 as "telecommunication services" and was further described as "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." Notwithstanding such representations, Applicant is informed and believes that the goods and/or services actually used by Registrant, if any, were actually more properly described as within International Class 16, as related to, similar, or identical to the goods that were then in use, and remain in use by the Applicant herein.

11. Applicant on information and belief further alleges that the Registrant, Roger Rojas intentionally mischaracterized his goods as "telecommunication services" with the intent to avoid a potential descriptiveness refusal, (with respect to the sale and offering of "messages in a bottle,") and/or with the intent to mislead potential third party opposers, including Applicant, as to the nature of the goods and services used in connection with his purported MESSAGE IN A BOTTLE mark to the extent that his goods and services were not similar in nature to those of the Applicant herein, but instead were "telecommunications services." In fact, Applicant is informed and believes that the goods and services used in connection with Registrant's alleged MESSAGE IN A BOTTLE trademark application filed under Serial No. 75226521 and subsequently registered under Registration No. 2,243,269 were not properly classified as "telecommunications services" but rather actually consisted of the sale of novelty and souvenir gift bottles containing personalized messages of others.

12. Upon information and belief, when Registrant submitted his Statement of Use under 37 C.F.R. § 2.88 to the U.S. Patent & Trademark Office ("PTO") on or about January 28, 1999, which indicated under oath and with knowledge that "willful false statements may jeopardize the validity of the application or any resulting registration" and which further alleged that that he had first used the mark MESSAGE IN A BOTTLE in connection with "receiving communications from others, recording such communications in written or printed form from others, and transmitting such communications to others" with a first use date of January 16, 1999. In further support of his Statement of Use filed on or about January 28, 1999, Registrant alleged that "the manner and mode of use of the mark in connection with the services is on advertising flyers, letterheads, (sic) business cards, computer screen displays in electronic commerce, and labels and containers used in carrying out the services." Upon information and belief, such representations concerning the date of first use and the manner and mode of use was intentionally false and misleading and was done with the specific intent of misleading the Patent & Trademark Office and/or depriving potential third parties, including Applicant of their opportunity to oppose such application.

13. On further information and belief, the sole purpose for Registrant's fraudulent description and misleading representations was to avoid a conflict based on Applicant's prior use of the term MESSAGE IN A BOTTLE on novelty, favor and souvenir gift bottles containing messages of others and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing, which Registrant knew or should have known that Applicant had used since at least as early as March 10, 1998.

14. Upon information and belief, Registrant Rojas knowingly submitted his false description of goods and services as being properly classified as "telecommunications services" in International Class No. 038, while he was aware that the actual goods and/or services allegedly used in connection with the MESSAGE IN A BOTTLE mark was more closely related to and more properly classified within International Class 016 as involving "the sale of goods consisting of novelty, favor and souvenir bottles containing messages and greetings, identical to some of the goods set forth in Applicant's application" herein. Indeed, in its Opposition herein, Opposer has alleged at paragraph 3, that it is now, and heretofore, its alleged predecessor since January 16, 1999 has been "actually using the mark MESSAGE IN A BOTTLE in connection with the sale of services as described in the registration and as a trademark in connection with the sale of goods consisting of novelty, favor and souvenir bottles containing messages and greetings, identical to some of the goods set forth in Applicant's application."

15. Upon information and belief Applicant alleges that the representations made within Registrant's Statement of Use as submitted to the Trademark Office on or about January 28, 1999 was made by the owner of the application, Roger Rojas with the knowledge and belief that said statement was false. Said false statement was made with the intent to induce authorized agents of the U.S. Patent and Trademark Office to grant said registration, and, reasonably relying upon the truth of said false statements, the U.S. Patent and Trademark Office did, in fact, grant said registration to Registrant. Applicant was damaged by said false statements and the registration issued in reliance thereon in that Applicant, since March 10, 1998, has continuously used the mark MESSAGE IN A BOTTLE, and Applicant's continued and legal use of said mark has been impaired and will be further impaired by the continued registration of said mark of Registrant.

16. On information and belief, Registrant did not use the mark MESSAGE IN A BOTTLE *in commerce* at the time when he filed the Statement of Use. Further, Applicant alleges that the specimen attached to Registrant Rojas' Statement of Use filed on January 28, 1999, could not sufficiently support the allegation of use in commerce. As a specimen, the mark was allegedly placed on letterhead only, and such letterhead constituted only of an generalized and unparticularized announcement which did not and does not sufficiently demonstrate any actual use in commerce by the Registrant. It was not placed on the goods themselves, their containers or the tags, labels affixed, nor was displayed in connection with the bona fide offering or sale of services. Such "token" usage is not a proper use in commerce upon which a registration may properly issue.

17. On information and belief, when Registrant submitted its Statement of Use to the PTO indicating that he first used the mark MESSAGE IN A BOTTLE in commerce beginning on January 16, 1999, such information was false.

18. Upon information and belief, as stated above, Registrant misrepresented the nature of his alleged use in commerce of the MESSAGE IN A BOTTLE trademark at the time he submitted his Statement of Use which finally led to the registration that is the subject of this petition. On information and belief, Registrant procured the aforesaid registration by false means and/or by knowingly and willfully making false and/or fraudulent declarations or representations to the PTO, including, *inter alia*, false alleging in a Declaration under 37 CFR §1(a) that

- (a) Registrant used the mark *in commerce*, and
- (b) the first use of the mark was on January 16, 1999 for receiving, recording and transmitting communications, when, on information and belief, Registrant did not use and still does not use the mark for receiving, recording and transmission communications of others in

International Class 038. Upon information and belief, said false statements were made with the intent to induce authorized agents of the PTO to grant said registration, and reasonably relying upon the truth of said false statements, the PTO did, in fact, grant said registration to Registrant.

19. Upon information and belief, Registrant knew at the time he filed his statement of use made as related to the application that ultimately matured into Reg. No. 2243269 that the statements contained therein were false.

20. Upon information and belief, Registration No. 2243269 was fraudulently obtained by the Registrant since Registrant's mark MESSAGE IN A BOTTLE and design and the services performed under the mark—namely, souvenir bottles containing messages and greetings—upon information and belief are not and at the time of filing of the application which resulted in Registration No. 2243269 were not rendered in interstate commerce as alleged in the application, but to the contrary were wholly rendered, within the state of California. As such, the Registrant did not qualify the mark for Federal Registration, and Registration No. 2243269 is invalid.

21. Upon information and belief, after the filing of the application which matured into Registration No. 2243269, Registrant abandoned the registered mark as he failed to use the mark in connection with his products and services for at least two years, with no intention to resume such use.

22. On information and belief, Registration No. 2243269 is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. Applicant specifically alleges that without proper licensing or any assignment, Registrant has knowingly required or consented to a third party GOLD SHELLS, Inc. to describe itself in its advertising, marketing and sales promotion materials as MESSAGE IN A BOTTLE owner since at least 2003, long before the date of

October 5, 2004, when the assignment was allegedly made from Registrant to GOLD SHELLS, Inc. GOLD SHELLS, Inc. never was, in fact, the owner of the mark MESSAGE IN A BOTTLE at that time.

23. Upon information and belief, Registrant failed to disclose to the United States Patent & Trademark Office known uses of the MESSAGE IN A BOTTLE mark, or an allegedly confusingly similar marks by others, including the Applicant, whose legal rights are superior to Registrant's. Registrant knew that the other third parties had rights in the mark superior to Registrant's and either believed that a likelihood of confusion would result from Registrant's use of his mark or had no reasonable basis for believing otherwise and Registrant, in failing to disclose these facts to the Patent & Trademark Office, intended to procure a registration to which Registrant was not entitled.

24. Applicant has used the mark MESSAGE IN A BOTTLE long prior to any use, if at all, by the Registrant. As alleged by the Opposer in its opposition herein, Registrant's mark caused consumers to make a false connection with Applicant. Registrant's mark falsely suggests a connection with Applicant's mark as barred by Lanham Act §2(a).

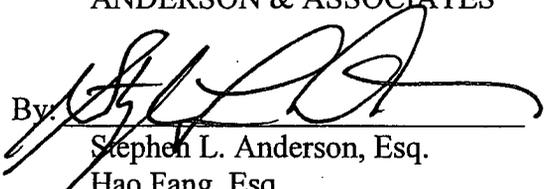
25. Applicant has been, and will continue to be damaged by the issuance and existence of Registration No. 2243269 issued to the Registrant, in that since 1998, Applicant has continuously used the mark MESSAGE IN A BOTTLE in the United States in connection with his business producing and selling souvenir bottles containing messages. Using Registration No. 2243269 as the basis of its claim, the third party GOLD SHELLS, Inc. has opposed the registration of Applicant's trademark MESSAGE IN A BOTTLE herein.

26. A duplicated copy of this Answer to Notice of Opposition and Counterclaim and the fee required in §2.6(a)(16) is enclosed herewith.

WHEREFORE, in view of the above allegations, Registrant is not entitled to continue registration of his alleged mark since Registrant, upon information and belief, committed fraud in the procurement of the subject registration, and/or in the alternative has abandoned use of said mark, and/or that the registration is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. As such, the Applicant prays that Registration No. 2243269 issued May 4, 1999 be cancelled and that his Counterclaim for Cancellation be sustained in favor of Applicant.

ANDERSON & ASSOCIATES

Dated: December 10, 2004

By: 

Stephen L. Anderson, Esq.

Hao Fang, Esq.

27349 Jefferson Avenue, Ste. 211

Temecula, CA 92590

(951) 719-1371

Attorneys for Applicant/Petitioner

KEITH CANGIARELLA

Certificate of Service

I hereby certify that a copy of the foregoing APPLICANT'S ANSWER TO NOTICE OF OPPOSITION; COUNTERCLAIM FOR CANCELLATION was mailed first-class mail, postage prepaid, to Peter H. Smith, Attorney at law, 1535 J Street, Suite A, Post Office Box 1867, Modesto, California, 95353, attorney for Opposer, December 10, 2004


DOLLY J. SMITH

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

<p>In the Matter of Trademark Application Serial No.: 78/229,875 Mark: MESSAGE IN A BOTTLE</p> <p>GOLD SHELLS, INC., a California corporation, Opposer, v. KEITH CANGIARELLA, Applicant.</p>	<p>Opposition No. 91162780</p> <p>Cancellation No. _____</p> <p>POWER OF ATTORNEY</p>
<p>In the In the Matter of Trademark Registration No.: 2,243,269 Mark: MESSAGE IN A BOTTLE</p> <p>KEITH CANGIARELLA, Petitioner, v. ROGER ROJAS, Registrant</p>	

The undersigned Applicant/Petitioner KEITH CANGIARELLA hereby appoints Stephen L. Anderson, (CBN 150860) and Hao Fang (CBN 231174) of the law firm of Anderson & Associates, 27349 Jefferson Ave. Suite 211, Temecula, CA, 92590, its duly authorized agents and attorneys in the matter of this opposition/cancellation matter, and to transact all business in the Patent and Trademark Office and in the United States courts connected therewith, to sign all papers which may hereinafter be filed in connection therewith, and to receive all communication relating to the same.

Dated: December 8, 2004



KEITH CANGIARELLA

gsinc@sbcglobal.net

From: "bottlemessage.com" <1mib@dreamweaverstudios.com>
To: <customerservice@messageinabottle.com>; <sales@messageinabottle.com>
Sent: Monday, August 09, 2004 9:11 AM
Subject: Message in a Bottle TM

Dear Golden Shells, Inc.

I recently received a letter from the Trademark Trial and Appeal Board with a copy of your extension to file an opposition to our trademark.

Yes, we both offer a similar product a bottle housing a message...but anyone looking at the two products can see the multiple distinct differences in the products.

The style bottles used, the accent pieces, internal decorative materials utilized by us.

I created this product in 1997 and new of your pending trademark at the time, but felt we were and have developed two different products.

I began selling my MIBs officially on the net in late 97, our two products are more different than similar.

I wish to receive my registered trademark, so I may cease and desist companies like ebottles.com, marketinginabottle.com and others who have for the past two years infringe on my intellectual property rights.

These companies are not message in a bottle companies like ours, they are simply capitalizing on my creativity, we both fill completely different niches, I had hoped of forming a Message in a Bottle Association for us and possibly other Message in a Bottle companies, whom offer similar but distinctly different products.

There are 200 Million Americans if we each can get 1 million sales from those 200 Million life would be very good for the both of us.

Like I have said before, we both have similar but very different products...

EXHIBIT K

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

9/15/2005

I would appreciate a reply..

Respectfully,

Keith Cangiarella

DreamWeaver Studios

<http://www.bottlemeamessage.com>

originally in the early days <http://www.dreamweaverstudios.com>

Message in a Bottle Promotional Product

How will you announce your next event?

How will you invite your guests?

How will you make your company stand out from the rest?

By sending a MIB.

Larry's Quotes
a dose of inspiration

FAQ

Company Info

Email Us

Fundraising with MIB

Home Page

Promotional Messages

MIB Collections

Choose a MIB

Love MIBs

Invitations

Message Harbors

Hours

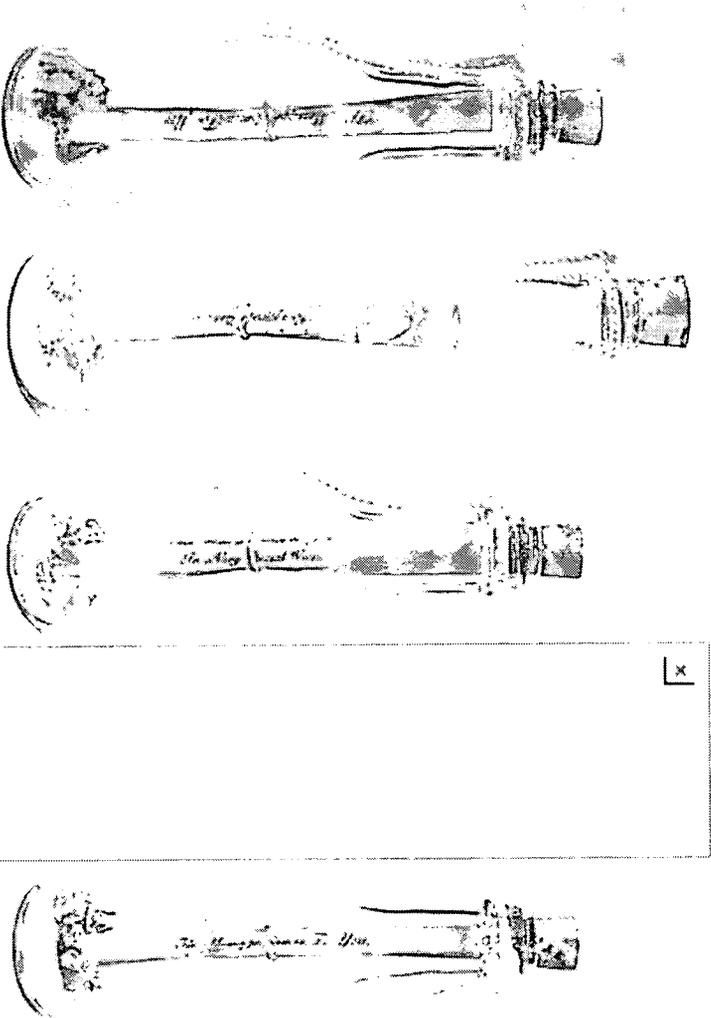
Monday - Friday

8:30am - 5:30 pm

Pacific Time

We want to help you create the most unique invitation/promotional product that will generate leads, sales, and/or bring the right people to your event. We want to take hectic out of your hectic schedule -because you have more important things to do.

Review the images and information below, ultimately you decide what goes in your MIBs. We look forward and are privileged to be part of your event.



We have hundreds of confettis that can be ordered. we will update this page.

714-441-3442

Email Us

Bottles Only

Dream Weaver Studios

weekly.

When you go to the order form, you can input what your looking for, and we will scan an image of it and send it to you. Get creative we are here to help you create the ultimate

Party invitation. truly unique. like no other.



Pricing is as follows -

24 - 200 plastic MIBs(7 inches tall by 2 inches wide) \$4.00 per MIB.

24 - 200 glass MIBs(7 inches tall by 2 inches wide) \$5.00 per MIB each of these MIBs is packed individually in a white box resting on a sea of blue packing material.

250 and up plastic MIBs \$3.75

250 and up glass MIBs \$4.75

Above pricing is for any standard MIB on the website, except the Original MIB, which contains five confettis and seashells. Customizing is available at additional cost

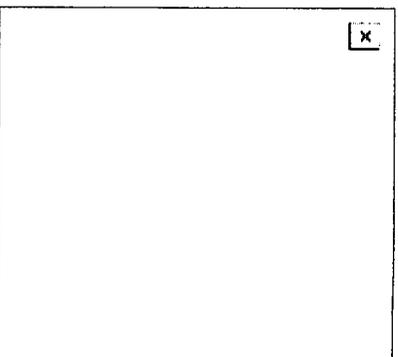
Invitations are printed in black ink, color ink is available at additional cost.

Graphics and scanned background images on invitation available at additional cost.

Postage cost Plastic - \$.60(without RSVP) \$.83 with RSVP postcard.

Glass - \$2.21 first class mail

New RSVP Postcards now available - images appear to the right. Post cards will be printed on postcard parchment paper, same color your Party invitations are printed on. You might be wondering where is the wording, you get to write your own. Each postcard measures 4x5 they come with postage, your address printed on the opposite side. Prices start at \$1.23 per MIB(includes \$.23 postage stamp) pricing depends on quantity and whether you are sending a glass or plastic MIB. Glass - inserted into box. Plastic - attached to the outside of the bottle, an image will be sent to you when place your order. (patent pending)



New mailing service - for only \$.50 more plus the necessary postage per MIB, we will print your labels attach them to the box, or plastic bottle. Affix the necessary postage and bring them to the post office for you. All you have to do is send us an email with your addresses or a MS Word document with your addresses and we will take it from here. When considering this service, remember the cost of shipping and handling of the MIBs to you.



Current lead time is 5-20 working days

SAMPLES - If you would like a sample, click below tour the Party order form, fill it out, and we will send you a sample MIB for only \$15.99, we will expedite your order and send it out priority mail. When you order we will apply a \$10 credit to your order.

To order click below or questions email for fastest response, or call 714-441-3442

Email

Order Promotional MIBs

Website - Copyright2000Dream WeaverStudios

Message in a Bottle Collecton -

Copyright1997Dream WeaverStudios

All Rights Reserved -

No part of this site may be duplicated for any reason.



Message in a Bottle™ Shop

FAQ

- Wedding Invitations
Message in a Bottle
- Party Invitation
Message in a Bottle
- Promotional
Message in a Bottle
- Survivor
Message in a Bottle
- Lost
Message in a Bottle
- Treasure Island
Message in a Bottle
- Christmas
Message in a Bottle
- Message Harbor
Message in a Bottle
- Seashore
Message in a Bottle
- Coastal
Message in a Bottle
- Love
Message in a Bottle
- Inspirational
Message in a Bottle

How long does it take to process my order?
When ordering a single MIB it is shipped in one-three days.
Wedding and Party orders take between 3-7 business days, after you give us a go to print.

How are they shipped?
Each MIB is uniquely gift wrapped(included in the price)then placed in a white box resting in a sea of white foam, the MIB appears to arrive on the white surf of the tide. All MIBs are mailed via US priority Mail, which is included in the price as well
Remember - the \$21.99 and \$24.99 price includes free priority mail shipping(US Only)and gift wrapping

I am ordering wedding invitation what is the cost of mailing them on my end?
The cost of mailing a single MIB(glass) in a box is \$2.31 per unit first class mail.
The cost of mailing a plastic MIB \$.63.

I want to write my own wedding or party invitation is that okay?
The beauty of this product is that we can customize it for your specific needs, you can write your own message or even incorporate some of ours with your own ideas. You can pick any writing style (font) you like we have a CD-ROM of 3000.

Will I get to see a proof of my wedding or party invitation?
This is what happens when we take your order by phone, you will email us, your invitation line for line, we then cut and paste it into our program, print it up, scan it and then email it to you for confirmation., or we can fax it to you which ever you prefer.

We will make changes if necessary and we never go to print until you say so, remember We are the Experts.

I don't really like any of the MIBs I see on your web store, can I design my own???
Yes click on **Design your own Message in a Bottle** and you can pick and choose

- Bottles Only & More
- Design Your Own Message in a Bottle
- New - MIB Prints
- MIB - Samples
- Shopping Cart

- Sitemap
- Email Us

- FAQ
- Legal Info

- Comments
- Message in a Bottle Fundraiser

- Company Info

- Message in a Bottle Links

- Message in a Bottle Articles Library

- Home Page

Call us 714-441-3442
DreamWeaver Studios

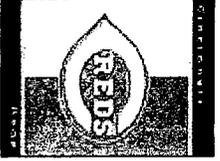
everything, one interesting thing about our product is no two are ever exactly alike and your MIB is created only after we receive the order.

I need to talk to someone, I am still confused, can I give you a call?
Yes, 714-441-3442, you may get one of us or leave us a message and we will get back to you as fast as humanly possible, or email us your concerns, we can sometimes get back to you even faster.

Still got questions - call us or [E-mail Us](#)

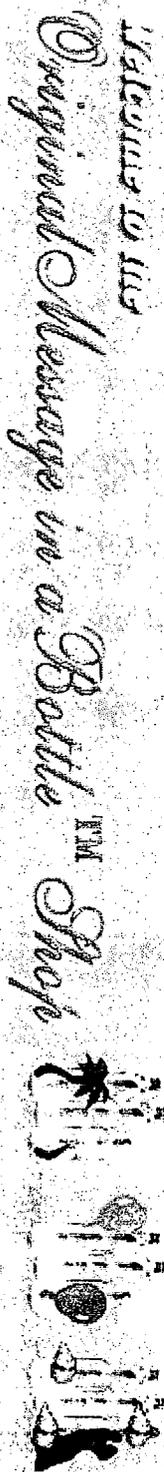
Website copyright2004DreamWeaver Studios





Official Invite to the ESPN
Super Bowl VIPS, House
of Blues, Cincinnati Red,
and more...

Message in a Bottle™ Shop



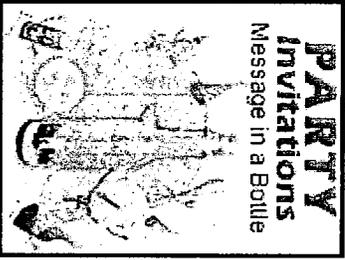
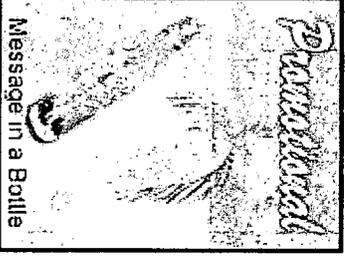
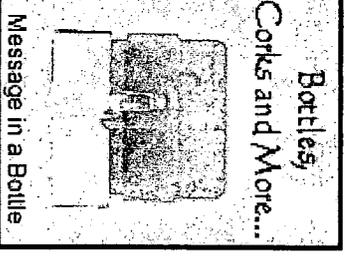
Message in a Bottle™ Shop

Samples

We would gladly send you a sample, they cost \$9.99 this includes priority mail (a \$3.85 value) and we will prioritize your order, most samples mailed the following day.

Simply click on the button below for the sample you would like, input 1 into the how many form field, pick and choose what you wish to have in the MIB, input message so you can see what your message will appear like.

- Wedding Invitations
Message in a Bottle
- Party Invitation
Message in a Bottle
- Promotional
Message in a Bottle
- Survivor
Message in a Bottle
- Lost
Message in a Bottle
- Treasure Island
Message in a Bottle
- Christmas
Message in a Bottle
- Message Harbor
- Seashore
Message in a Bottle
- Coastal
Message in a Bottle
- Love
Message in a Bottle
- Inspirational
Message in a Bottle

 <p>Wedding Invitations Message in a Bottle</p>	 <p>PARTY Invitations Message in a Bottle</p>	 <p>Promotional Message in a Bottle</p>	 <p>Bottles, Corks and More... Message in a Bottle Kit - DIY</p>
--	---	--	---

Welcome to the Original Message in a Bottle™ Shop

Message in a Bottle™ Shop

• Wedding Invitations Message in a Bottle

• Party Invitation Message in a Bottle

• Promotional Message in a Bottle

• Survivor Message in a Bottle

• Lost Message in a Bottle

• Treasure Island Message in a Bottle

• Christmas Message in a Bottle

• Message Harbor

• Seashore Message in a Bottle

• Coastal Message in a Bottle

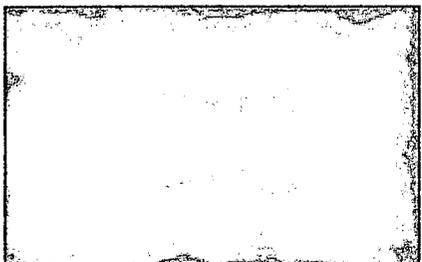
• Love Message in a Bottle

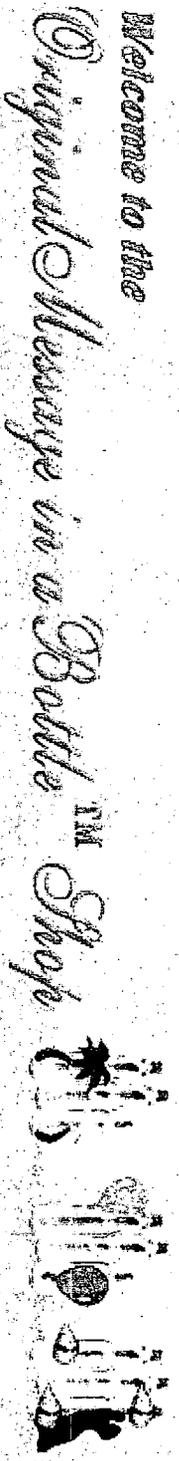
• Inspirational Message in a Bottle

Message in a Bottle Prints

Choose your print and we will print your message on it.

[view more prints](#)

			
Island Sunset	Magic Hour Sunset	Sea Horses	Glory Sunset



Message in a Bottle™ Shop

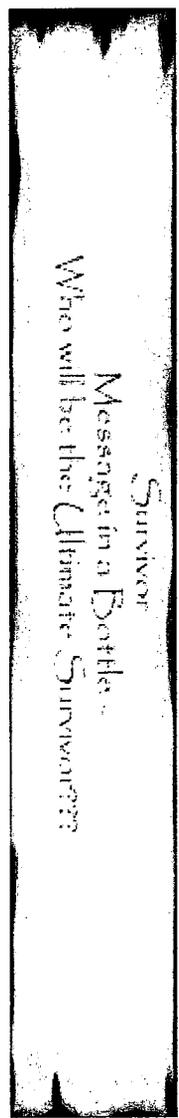
Tell a friend : friend's email?



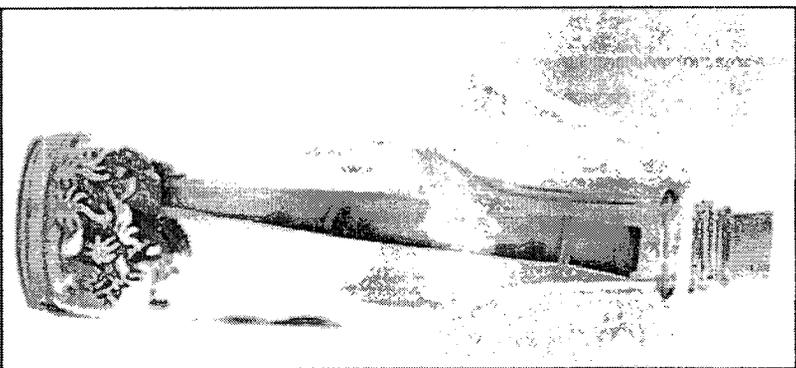
Survivor Message in a Bottle

Gift, Invitation, Promotional product or business gift

- Wedding Invitations
Message in a Bottle
- Party Invitation
Message in a Bottle
- Promotional
Message in a Bottle
- Survivor
Message in a Bottle
- Survivor Messages
Message in a Bottle
- Lost
Message in a Bottle
- Treasure Island
Message in a Bottle
- Christmas
Message in a Bottle
- Message Harbor
- Seashore
Message in a Bottle
- Coastal
Message in a Bottle
- Love
Message in a Bottle

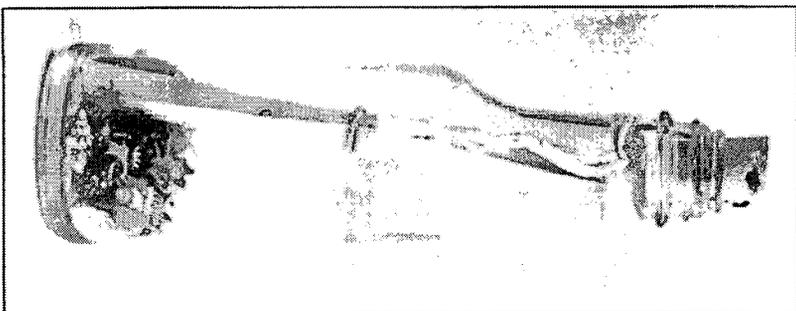


- International Message in a Bottle
 - Seashore Only & More
 - Design Your Own Message in a Bottle
 - New - MIB Prints
 - MIB - Stickers
 - Shopping Cart
 - Shipping
 - Email Us
 - FAQ
 - Contact Us
 - Payments
 - Message in a Bottle Fundraising
 - Company Info
 - Message in a Bottle Links
 - Message in a Bottle Activities Library
 - Home Page
- Call us 714-441-3442
 The Bottle Case Studios



Click on image for larger view a popup will appear.

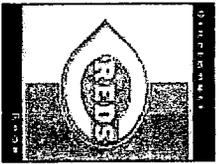
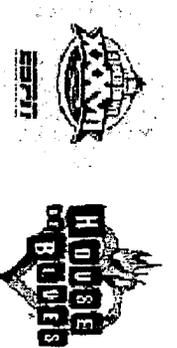
This is a background you can choose to use or we can create a unique background for you. MIB decals can be created and adhere to outside of bottle, pricing is based on volume.



Single Survivor Message in a bottle

Want to share the Survivor spirit with a friend or family member, then this the Message in a Bottle for you, comes with palm trees, tropical fish, and real seashells. You choose the sand color, parchment paper color when you order. You can even choose the burnt edges print or opt for a custom print created by our team just for you.

Single Survivor MIBs cost \$21.99 little guy or \$24.99 wine size, they come with free shipping(US mail only) and gift wrapping.



Official Invite to the ESPN Super Bowl VIPs, House of Blues, Cincinnati Red, and more...



Click here to ORDER NOW!

[Click above to order single Survivor Message in a Bottle]

Multiple Survivor Message in a bottle

Throwing a Survivor Party, then this is the way to announce your Survivor Day, we can custom create a special message for you, and custom background as well. Order today do not delay. Pricing below.

Impress your clients and customers with a unique message in a Survivor Message in a Bottle.

Order a standard Survivor Message in a Bottle or have us customize it for you. Pricing Below...

<p>Pricing is as follows</p> <p>24 - 200 plastic MIBs (7 inches tall by 2 inches wide) \$3.25 per MIB - mail as is no box needed, post office approved.</p> <p>24 - 200 glass MIBs (7 inches tall by 2 inches wide) \$4.25 per MIB each of these MIBs is packed individually in a white box resting on a sea of blue packing material.</p> <p>250 and up plastic MIBs \$2.95 250 and up glass MIBs \$3.95</p> <p>Invitations are printed in black ink, color ink is available at additional cost.</p>	<p>Postage</p> <p>Postage cost Plastic - \$.60 Glass - \$2.23 first class mail</p> <p>Mailing service</p> <p>For only \$.40 extra per MIB plus the necessary postage per MIB, we will print your labels attach them to the box, or plastic bottle. Affix the necessary postage and bring them to the post office for you. All you have to do is send us an email with your addresses to us in an Excel file, which we will email to you. When considering this service, remember the cost of shipping and handling of the MIBs to you.</p>
---	--

Graphics and scanned background images on invitation available at additional cost.

Above pricing is for any standard MIB on the website.

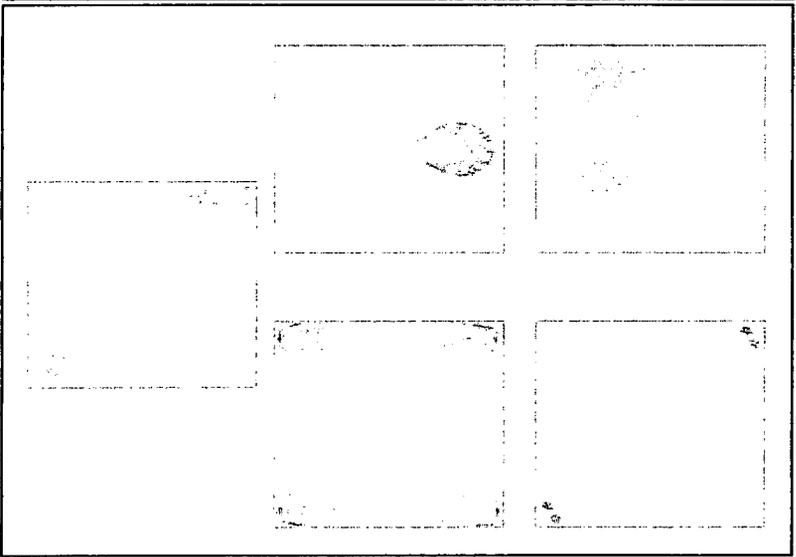
Click here to ORDER NOW!

[Click above to order Multiple Survivor Message in a Bottle]

RSVP Postcards - (Images on right side)
Post cards will be printed on postcard parchment paper, same color your wedding invitations are printed on. You might be wondering where is the wording, you get to write your own. Each postcard measures 4.25 x 5.5 they come with postage, your address printed on the opposite side. Prices start at \$.75 per MIB (includes \$.23 postage stamp) pricing depends on quantity.

If ordering glass we will insert them into the box with the MIB, if ordering a plastic MIB after you place your order and have confirmed we will tell you the method of mailing RSVPs.

SAMPLES - If you would like a sample, click the Order Now button below, fill out the order form input 1 for number of MIBs, and we will send you a sample MIB for only \$9.99 we will prioritize your order and mail it out via priority mail - a \$3.85 value!



Click here to
ORDER NOW!

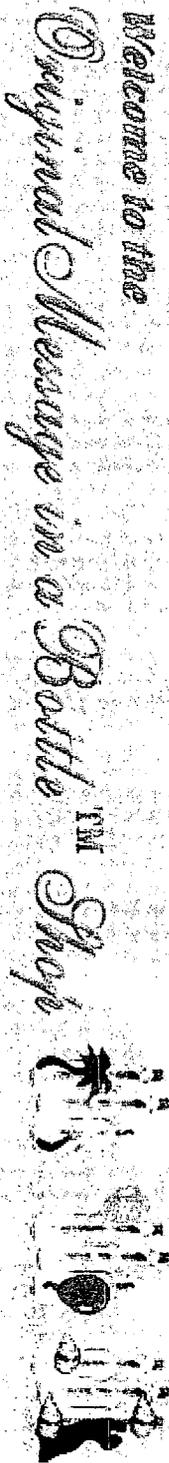
[Click above to order Multiple Survivor Message in a Bottle]

Tell a friend : friend's email?



Website copyright2004DreamWeaver Studios

Message in a Bottle™ Shop



Message in a Bottle™ Shop

• Wedding Invitations
Message in a Bottle

• Party Invitation
Message in a Bottle

• Promotional
Message in a Bottle

• Survivor
Message in a Bottle

• Lost
Message in a Bottle

• Treasure Island
Message in a Bottle

• Christmas
Message in a Bottle

• Message Harbor

• Seashore
Message in a Bottle

• Coastal
Message in a Bottle

• Love
Message in a Bottle

• Inspirational
Message in a Bottle

Write Your Message

Write Your Own Message

Type your Message :

Save Your Message



Message in a Bottle™ Shop

• Wedding Invitations
Message in a Bottle

• Party Invitation
Message in a Bottle

• Promotional
Message in a Bottle

• Survivor
Message in a Bottle

• Lost
Message in a Bottle

• Treasure Island
Message in a Bottle

• Christmas
Message in a Bottle

• Message Harbor

• Seashore
Message in a Bottle

• Coastal
Message in a Bottle

• Love
Message in a Bottle

MIB Shopping Cart

You can not select more than one MIB

Please remove the selected MIB from your shopping cart and then choose another MIB.

Order Identification No : 27991

MIB Information

Your MIB : [click to remove MIB]
Single Survivor Message in a Bottle

Please choose an opening for the message, i.e. Dear Sara, Sara, Hello Sara...



Your Message :
You have not added a message. Please write a message or select message from Message Harbor.
May we suggest messages from - ' Survivor Messages '

Please choose a closing for the message, i.e. Love Tom, Tom, Your Friend Tom...

- Inspirational Message in a Bottle
 - Bottles Only & more
 - Design Your Own Message in a Bottle
 - MIB Samples
 - New - MIB Prints
 - Shopping Cart
 - Sitemap
 - Email Us
 - FAQ
 - Legal Info
 - Comments
 - Message in a Bottle Fundraiser
 - Company Info
 - Message in a Bottle Links
 - Message in a Bottle Articles Library
 - Home Page
- Call us 714-441-3442
DreamWeaver Studios

Choose your type of bottle :

- Wine 10.5 inches x 2.35 inches for only \$ 24.99
- Glass 7 inches x 2 inches for only \$ 21.99
- Plastic 7 inches x 2 inches for only \$ 19.99

Your MIB Prints : [Click here to choose MIB Prints]
None

Choose your Confettis :



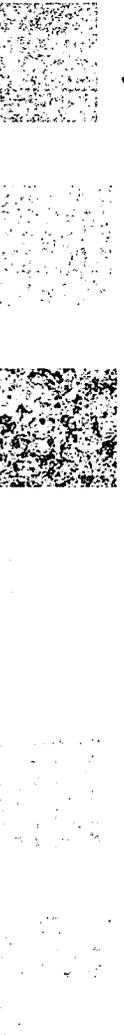
Burnt Edges Print :

Burnt edges print - Yes No [\$ 1.50 extra per MIB]

Select Cord :

- White Cord
- Raffia Tie

Choose your Sand Color :



Our Deals

Cincinnati Reds and Reds Commun Fund

Official Invite to the ESPN Super Bowl VIPs, House of Blues, Cincinnati Red, and more...

- Dark Blue Sand
- Crystal and Blue
- Crystal and Black
- Sparkly white sand
- Sparkly Pink Sand
- Natural Beach Sand

Choose your Parchment Paper :

- Golden tan parchment
- White parchment
- Light blue parchment

Custom Background :

Want a custom color background, input your request below, be very descriptive, for example, tropical island background with setting sun, spring flowers background, hearts, rubber ducks swimming in the ocean, coastal shot with palm trees, ocean waves breaking on a cliff, setting sun on a tropical island, treasure map, small dog walking on the beach or a big palm tree. We will create a background for you from our 1000s of images, compress and send it to you for your approval, you will email us a go to print. Price is based on how much work is involved and volume of MLBs ordered. We will email you a price quote.

Insert comments or special instructions above, if you would like something different than the above confettis and seashells we have hundreds of confettis we can order, from brides and grooms, wedding bells, to hearts, x and o's, input your request and we will see what we can come up with, we will email you scanned images of the confetti for your review.

Recipients Country :

Recipients Email address :

When would you like your Message in a bottle delivered?

Ship my Message in a bottle via Priority 2-3 day USPS mail (FREE)

Ship my Message in a bottle FEDEX* Overnight Delivery(**this is not FREE**, the price of the MIB will be on the email sent to you, we will charge you exactly what Fedex charges us at the time we ship it. Fedex charges are an additional charge on the top of the price of the MIB) (order must be received by 12 noon PST, otherwise order will be sent following day)

I want my Message in a bottle to arrive on a special date/special instructions please enter the date you would like the message in a bottle delivered below. (**this is not FREE**, it is sent via FEDEX overnight, the price of the MIB will be on the email sent to you, we will charge you exactly what Fedex charges us at the time we ship it. Fedex charges are an additional charge on the top of the price of the MIB)

THIS OPTION NOT AVAILABLE FOR VALENTINE'S DAY

Valentine Day options:

This Option no longer available - Check here to have it arrive on Valentine's Day via Fedex Overnight(**this is not FREE**, the price of the MIB will be on the email sent to you, we will charge you exactly what Fedex charges us at the time we ship it. Fedex charges are an additional charge on the top of the price of the MIB) **Latest possible order date Feb 10 by 12 pm Noon PST**

This option no longer available - Check here if you wish to have your MIB mailed the week before V-Day, this included in the price of the MIB, with a decal on the box that says "DO NOT OPEN TILL VALENTINE'S DAY" (orders must be received no later than February 4th) **these will be mailed Feb 7th via US Priority Mail(2-3 days but not guaranteed)**

Total Order Amount : \$ 21.99

* Card Number :

* Card Type : MasterCard

* Expiration Date : Month 1 Year 2006 (Range: 1997-2020)

* CVV2 :

Please turn over your card and look in the signature strip we need the last three or four numbers found at the end of the signature strip. This is very important.

[Submit Your Shopping Cart >>](#)

Website copyright2004DreamWeaver Studios

Message in a Bottle™ Shop

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

In the Matter of Trademark Application
Serial No.: 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark
Registration No.: 2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

Gold Shells, Inc,
Assignee

Opposition No. 91162780

Cancellation No. _____

**APPLICANT'S ANSWER TO
TO OPPOSER'S REQUEST FOR ADMISSIONS FROM APPLICANT**

Applicant, Keith Cangiarella ('Applicant'), for his answer to Opposer's Request for Admissions from Applicant regarding his application for registration of his trademark: MESSAGE IN A BOTTLE, Serial No. 78/229,875, filed on March 25, 2003 and published in the Official Gazette on June 29, 2004, filed by Opposer Gold Shells, Inc. (as the alleged assignee, and/or successor-in-interest of Registrant Roger Rojas).

PREFATORY STATEMENT

Applicant has not fully completed its investigation of facts relating to this case, has not fully completed its discovery in this action, and has not completed preparation for trial. All of the answers contained herein are based only upon such information and documents which are

EXHIBIT Q

Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

REQUEST NO. 1.: You use the Trademark for novelty, favor and souvenir bottles containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing.

RESPONSE NO. 1: Applicant admits that he uses the Trademark for such items among others.

REQUEST NO. 2: You use the Trademark for receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others.

RESPONSE NO. 2: Denied.

REQUEST NO 3: Your pending application for registration of the Trademark with the U.S. Patent & Trademark Office, serial number 78/229875, has a filing date of March 25, 2003.

RESPONSE NO. 3: Applicant admits.

REQUEST NO. 4: On or before March 25, 2003, you had information that products and/or services featuring the Trademark had been sold in commerce by someone other than yourself.

RESPONSE NO. 4: Applicant admits.

REQUEST NO. 10: An application for registration of the Trademark was filed with the U.S. Patent & Trademark Office under the name Roger Rojas with a filing date of January 6, 1997, which was the basis for issuance of registration number 2,243,269 with an issue date of May 4, 1999.

RESPONSE NO. 10: Applicant denies on the basis that he has no independent knowledge or belief aside from the publicly available records, which speak for themselves.

REQUEST NO. 11: You claim use of the Trademark at least as early as March 10, 1998, anywhere and at least as early as June 10, 1998 in commerce.

RESPONSE NO. 11: Applicant admits.

REQUEST NO. 12: You do not claim use of Trademark prior to January 6, 1997.

RESPONSE NO. 12: Applicant denies.

REQUEST NO. 13: Your counterclaim for cancellation of Opposer's registration number 2,243,269 has a filing date of December 10, 2004 with the Trademark Trial & Appeal Board.

RESPONSE NO. 13: Applicant admits.

REQUEST NO. 14: You do business on the internet with the website addresses www.bottlemeamessage.com and www.dreamweaverstudios.com with your products and services.

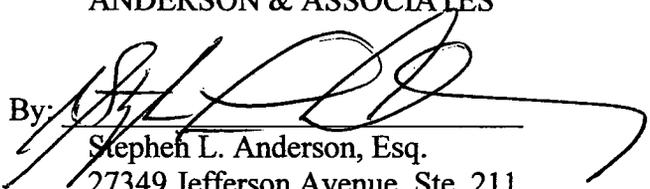
RESPONSE NO. 14: Applicant admits

REQUEST NO. 15: You do business under the fictitious business name "Dream Weaver Studios?"

RESPONSE NO. 15: Applicant admits.

ANDERSON & ASSOCIATES

Dated: August 12, 2005

By: 

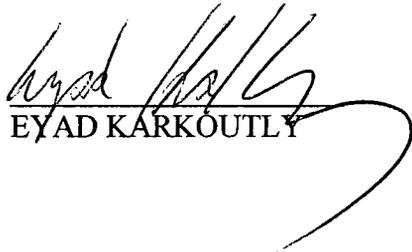
Stephen L. Anderson, Esq.
27349 Jefferson Avenue, Ste. 211
Temecula, CA 92590
(951) 719-1371

Attorneys for Applicant/Petitioner
KEITH CANGIARELLA

Certificate of Service

I hereby certify that a copy of the foregoing APPLICANT'S ANSWERS TO OPPOSER'S FIRST SET OF REQUESTS FOR ADMISSIONS was mailed first-class mail, postage prepaid, to Peter H. Smith, Attorney at law, 1535 J Street, Suite A, Post Office Box 1867, Modesto, California, 95353, attorney for Opposer,

August 12, 2005


EYAD KARKOUTLY

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

In the Matter of Trademark Application
Serial No.: 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark
Registration No.: 2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,
v.

Gold Shells, Inc,
Assignee

Opposition No. 91162780

Cancellation No. _____

**APPLICANT'S RESPONSES TO OPPOSER'S REVISED FIRST SET OF
INTERROGATORIES**

Pursuant to Rules 26 and 33 of the Federal Rules of Civil Procedure, and Rules 2.116 and 2.120 of the Trademark Rules of Practice, Applicant, Keith Cangiarella ("Applicant"), hereby responds to Opposer's Revised First Set of Interrogatories as follows:

PREFATORY STATEMENT

The following objections are given without prejudice to Applicant's right to later provide a substantive response to the interrogatories and/or to produce evidence of any subsequently discovered fact or facts which may later be developed. These objections are required in lieu of a response to the excessive number of interrogatories and should in no way be considered prejudicial in relation to further discovery, research, analysis or production of evidence.

EXHIBIT R
Opposition No. 91162780
Gold Shells, Inc. v Keith Cangiarella
Submitting Party: Gold Shells, Inc.

RESPONSES

Interrogatory No. 1: Identify each product marketed by you to date under the trademark.

Response to Interrogatory No. 1: Novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing. Applicant's products are further described at Applicant's website, www.bottlemeamessage.com and include the following goods: bottles, corks, sand, shells, boxes, cords, confetti, decorative cut-outs, parchment paper, wedding invitations, party invitations, personalized greetings, notes, notecards, promotional announcements, art prints and reproductions.

Interrogatory No. 2: Identify each service marketed by you to date under the Trademark.

Response to Interrogatory 2: Retail store services; Computerized on-line retail store services featuring novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; Kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing; Providing online facilities featuring transaction order entry, order directing and order confirmation services.

Interrogatory No. 3: Identify all discontinued goods that applicant previously identified with the Trademark.

Response to Interrogatory 3: None

Interrogatory No. 17: Identify the channels of trade for the sale of your products identified with the Trademark

Response to Interrogatory 17: Internet sales, retail sales, catalog sales, commercial advertisements in magazines, newspapers, brochures and flyers, direct mail, telephone sales, and at trade shows and events.

Interrogatory No. 18: Identify the channels of trade for the sale of your services identified with the Trademark

Response to Interrogatory 18: Please refer to the response to Interrogatory No. 12 above.

Interrogatory No. 19: State the geographic area in which your products identified with the Trademark have been sold

Response to Interrogatory 19: Worldwide, without limitation.

Interrogatory No. 20: State the geographic area in which your services identified with the Trademark have been sold.

Response to Interrogatory No. 20: Services are not sold but are provided only ancillary to sales of products worldwide. Applicant further incorporates herein his response to Interrogatory No. 12 above.

Interrogatory No. 21: Identify the class of consumers to whom your products identified with the Trademark have been sold.

Response to Interrogatory No. 21: All consumers, including individuals, families, commercial entities and merchants without any limitation.

Interrogatory No. 22: Identify the class of consumers to whom your services identified with the Trademark have been sold.

Response to Interrogatory No. 22: Services are not sold but are provided only ancillary to sales of products worldwide. Applicant further incorporates herein his response to Interrogatory No. 12 above.

Interrogatory No. 23: Identify all advertising media which you have advertised your products identified with the Trademark

Response to Interrogatory No. 23: Applicant objects to this interrogatory on the grounds that it is vague and ambiguous as to “advertising media” and further objects on grounds that cumulative to other discovery requests made by opposer herein and that such interrogatory seeks information that is not relevant to the issues in this Opposition. Applicant further objects on the basis that the interrogatory seeks information and details which are of minimal, if any, evidentiary value in determining the issues in this action. Applicant further objects as the information sought under such interrogatory violates the Applicant’s rights of privacy as afforded to him under the California Constitution and Federal law. Moreover, Applicant objects on grounds that the interrogatory seeks confidential and non-confidential materials which would require the production of commercially and competitively sensitive information which should not be produced without the protection of an Order restricting access from Opposer, a direct competitor. Applicant further objects on the grounds that as a competitor of Applicant,

Opposer's interests in obtaining Applicant's advertising media used to promote his goods and services goes well beyond any matter of fact to be raised in the instant litigation. In order to protect Applicant from annoyance, oppression, undue burden and expense, and further due to the confidential and/or commercially sensitive nature of certain information requested, Applicant will not further respond to this interrogatory unless Opposer makes some preliminary explanation of relevance or showing as to need for said information and further agrees to the entry of an adequate protective Order restricting access. Notwithstanding and without waiver of said objections, Applicant further responds as follows:

On the Internet at www.bottlemeamessage.com, via third party pay per click advertisers (e.g., Overture, Yahoo Search Marketing, Google Adwords etc.), via Internet search engines, via retail outlet, on banners and signage, business cards, flyers, brochures, direct mail letters, on catalogs, via commercial advertisements in magazines, newspapers, and other printed publications, and at trade shows and events. Numerous examples have been previously provided to Opposer within Applicant's production of documents made heretofore in this action.

Interrogatory No. 24: Identify all advertising media which you have advertised your services identified with the Trademark

Response to Interrogatory No. 24: Applicant hereby incorporates by reference his response to the preceding interrogatory No. 23.

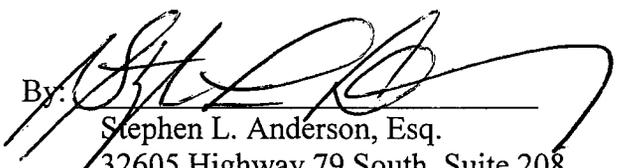
Interrogatory No. 25: Have you received an opinion concerning possible trademark conflicts arising out of the use of the Trademark by Opposer?

Interrogatory No. 64: What evidence do you have to support your allegation that Opposer failed to disclose to the U.S. Patent & Trademark known uses of the Trademark by others?

Response : Applicant objects to the extent that this interrogatory calls for a legal conclusion and/or that it seeks information and communications protected by the attorney/client privilege. Applicant further objects inasmuch as a response would call for privileged attorney work product. Applicant further objects inasmuch as the interrogatory is vague and suggests contentions or assertions which were not clearly made by the Applicant herein. Notwithstanding and without waiver of said objections: Opposer's response to interrogatory No. 12 as propounded by Applicant; Opposer's document production No. 3: Thomson & Thomson Report dated November 18, 1996.

Dated: April 5, 2006

ANDERSON & ASSOCIATES

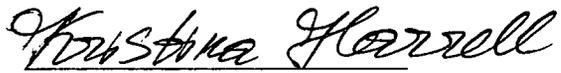
By: 

Stephen L. Anderson, Esq.
32605 Highway 79 South, Suite 208
Temecula, CA 92592
(951) 694-1877
Attorneys for Applicant/Petitioner
KEITH CANGIARELLA

Certificate of Service

I hereby certify that on the date set forth below, a true copy of the foregoing **APPLICANT'S RESPONSES TO OPPOSER'S REVISED FIRST SET OF INTERROGATORIES** was mailed first-class mail, postage prepaid, as addressed to: Peter H. Smith, Attorney at law, 1535 J Street, Suite A, Post Office Box 1867, Modesto, California, 95353, attorney for Opposer.

Dated: 4/7/06, 2006


Kristina Harrell

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

In the Matter of Trademark Application
Serial No. 78/229,875
Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark Registration
No. 2,243,269
Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

ROGER ROJAS,
Respondent.

Opposition No. 91162780 and
Counterclaim for Cancellation

AFFIDAVIT OF PETER H. SMITH IN SUPPORT OF
OPPOSITION TO APPLICANT'S MOTIONS FOR
SUMMARY JUDGMENT

I, Peter H. Smith, being sworn, say:

1. I am an attorney at law, duly licensed to practice law in the State of California, and am attorney for Gold Shells, Inc., the Opposer in Opposition Proceeding No. 91162780 herein, and for Roger Rojas, Respondent in Applicant's counterclaim for cancellation.

2. I represented Roger Rojas in connection with his filing of an intent-to-use application in the U.S. Patent & Trademark Office on January 6, 1997, serial number

75/226,521, for MESSAGE IN A BOTTLE for certain described services in Class 38. Prior to this filing, I assisted him with adopting an appropriate description of the services for which he wanted to register the mark and an appropriate classification for those services within the International Schedule of Trademark Classification.

3. In assisting Roger Rojas in adopting a classification, I used the version of the International Schedule of Trademark Classification which was published in Appendix A of Hawes, James E., Trademark Registration Practice, which listed Class 38 as a service class entitled "Communication". A true and correct copy of the page on which I relied in so classifying the services is attached hereto as Exhibit A.

4. I did not consult any other text or publications in regard to classifying Roger Rojas' intended services in connection with his intent-to-use application.

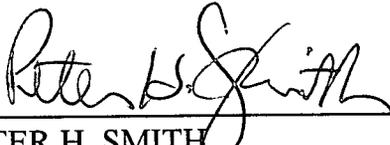
5. Roger Rojas represented to me that he intended to use the mark MESSAGE IN A BOTTLE for his commercial service of receiving wording for selected messages from people, putting those messages onto a piece of paper, inserting the paper in a bottle, and delivering the finished item to a designated recipient. In working with Roger Rojas on his initial service mark application, I drafted the application with the following description of services: "Written communication services, namely the telephonic, electronic, or mail receiving of text, the recording of text utilizing print media, and arrangements for delivery of the recorded text to others."

6. In response to the service mark application, I received a PTO office action from

Russ Hermann, trademark attorney, dated September 15, 1997, which said, "The recitation of services is unacceptable as indefinite", and offered an alternative recitation which could be adopted if accurate, namely "electronic mail services, namely, the recording, storage and subsequent transmission of written messages by telephone". I discussed this office action with the applicant and then with the examining attorney. I explained to the examining attorney that his proposed recitation of services was not accurate, and I explained to him the services on which the applicant intended to use the mark. After discussion, the examining attorney and I agreed that the application would be amended with the recitation of services to read as follows: "Receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, in Int. Class 38." The examining attorney issued an examiner's amendment dated March 16, 1998, confirming the revised recitation of services, and this recitation of services was eventually included in the applicant's service mark registration following issuance of a notice of allowance and a filing of a statement of use.

The foregoing facts are known to be true of my own knowledge. I am competent to testify to such facts, and would so testify if I appeared before the Board as a witness at the trial of this matter.

Dated: August 10, 2006.



PETER H. SMITH

STATE OF CALIFORNIA)
) ss
COUNTY OF STANISLAUS)

On August 10, 2006, before me LUGENE M. BORBA, notary public (here insert name and title of the officer), personally appeared PETER H. SMITH, personally known to me ~~(or proved to me on the basis of satisfactory evidence)~~ to be the person(s) whose name(s) is/~~are~~ subscribed to the within instrument and acknowledged to me that he/~~she/they~~ executed the same in his/~~her/their~~ authorized capacity(ies), and that by his/~~her/their~~ signature(s) on the instrument the person(s), or the entity upon behalf of which the person(s) acted, executed the instrument.

WITNESS my hand and official seal.


LUGENE M. BORBA
My commission expires: Dec. 9, 2009



CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Affidavit of Peter H. Smith in Support of Opposition to Applicant's Motions for Summary Judgment was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on August 11, 2006.


Lugene M. Borba

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR §2.198

Mark: MESSAGE IN A BOTTLE
Registration No.: 2,243,269
Opposition No.: 91162780
Mailing Date: August 11, 2006
Name of parties filing paper: Roger Rojas and Gold Shells, Inc.
Type of paper being filed: Affidavit of Peter H. Smith in Support of Opposition to Applicant's Motions for Summary Judgment

Express Mail Mailing Label Number: EQ 454418768 US
Date of Deposit: August 11, 2006

I hereby certify that the above-identified affidavit of Peter H. Smith, which is attached, is being deposited on August 11, 2006, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §2.198 in an envelope addressed to: U.S. Patent & Trademark Office, Trademark Trial & Appeal Board, P. O. Box 1451, Alexandria, VA 22313-1451.


Lugene M. Borba
Date: August 11, 2006

TRADEMARK REGISTRATION PRACTICE

27. Carpets, rugs, mats and matting; linoleums and other materials for covering existing floors; wall hangings (nontextile).

28. Games and playthings; gymnastic and sporting articles (except clothing); ornaments and decorations for Christmas trees.

29. Meats, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams; eggs, milk and other dairy products; edible oils and fats; preserves, pickles.

30. Coffee, tea, cocoa, sugar, rice, tapioca, sago, coffee substitutes; flour, and preparations made from cereals; bread, biscuits, cakes, pastry and confectionary, ices; honey, treacle; yeast, baking powder; salt, mustard, pepper, vinegar, sauces, spices; ice.

31. Agricultural, horticultural and forestry products and grains not included in other classes; living animals; fresh fruits and vegetables; seeds; live plants and flowers; food-stuffs for animals, malt.

32. Beer, ale and porter; mineral and aerated waters and other nonalcoholic drinks; syrups and other preparations for making beverages.

33. Wines, spirits and liqueurs.

34. Tobacco, raw or manufactured; smokers' articles; matches.

Services

35. Advertising and business.

36. Insurance and financial.

37. Construction and repair.

38. Communication.

39. Transportation and storage.

40. Material treatment.

41. Education and entertainment.

42. Miscellaneous.

In the case of certification marks, all goods and services are classified in two classes as follows: A. Goods. B. Services.

All collective membership marks are classified as follows: 200. Collective Membership.

(8) Prior U.S. Schedule of Trademark Classification

The following schedule of classes for goods and services is still used by many state trademark registrars:

App.A-12

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

In the Matter of Trademark Application Serial
No. 78/229,875

Mark: MESSAGE IN A BOTTLE

GOLD SHELLS, INC.,
a California corporation,
Opposer,

v.

KEITH CANGIARELLA,
Applicant.

In the Matter of Trademark Registration No.
2,243,269

Mark: MESSAGE IN A BOTTLE

KEITH CANGIARELLA,
Petitioner,

v.

ROGER ROJAS,
Respondent.

Opposition No. 91162780 and Counterclaim
for Cancellation

**OPPOSITION TO PETITIONER'S MOTION FOR SUMMARY
JUDGMENT IN CANCELLATION PROCEEDING [FRCP 56]**

Respondent Roger Rojas, and his assignee, Gold Shells, Inc., hereinafter called "GSI", request that the Board deny Petitioner Keith Cangiarella's motion for summary judgment in Petitioner's cancellation proceeding on the ground that there are genuine issues of material fact, including whether Respondent or GSI have actually used the mark MESSAGE IN A BOTTLE on or in connection with the services identified in the notice of allowance for and in U.S. service mark registration number 2,243,269, or whether Respondent or GSI committed fraud on the PTO as alleged by Petitioner.

I. BACKGROUND: UNDISPUTED FACTS.

The following are the essential undisputed facts on which Petitioner and Respondent appear to agree:

1. Respondent's assignee, GSI, is the owner of U.S. service mark registration no. 2,243,269 for the mark MESSAGE IN A BOTTLE in Class 38 for receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others, which was registered on the Principal Register on May 4, 1999.

2. Petitioner is the owner of U.S. service mark application no. 78/229,875 for the mark MESSAGE IN A BOTTLE in Class 16 for novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotional materials of others, and advertising materials of others; kits comprised of bottles, paper for creating promotional messages, advertising messages, greetings, messages and invitations and packaging and boxes for mailing, filed March 25, 2003.

3. GSI filed the present opposition proceeding against Petitioner, asking that Petitioner's application be rejected on the ground that use or registration of Petitioner's mark, which is identical to GSI's mark, for Petitioner's recited goods, would cause a likelihood of confusion with GSI's mark for GSI's recited services, and Petitioner filed a counterclaim for cancellation of GSI's registration on the ground of fraud.

II. APPLICABLE LAW.

Motions for summary judgment before the Board are governed by Rule 56 of the Federal Rules of Civil Procedure. For the Board to enter summary judgment, it must appear from the pleadings, depositions, and answers to interrogatories and admissions on file, together with any affidavits submitted concerning the motion, that there is no genuine issue as to any material fact so

that one of the parties is entitled to judgment as a matter of law. Fed.R.Civ.Proc. 56(c).

In seeking a summary judgment, the moving party has the burden of showing the absence of any genuine issue as to all material facts which, under the applicable standards of substantive law, entitle such party to judgment. Old Grantian Co. v. William Grant & Sons Ltd., 361 F.2d 1018 (CCPA 1966).

Summary judgment is not usually appropriate in an action for trademark infringement since the gravamen of such an action is whether the challenged mark is likely to cause confusion, and likelihood of confusion is a question of fact. Marathon Mfg. Co. v. Enerlite Products Corp. (1985, CA5 Tex.) 767 F.2d 214, 226 USPQ 836.

Trademark infringement ordinarily involves the question of mixed law and fact which cannot appropriately be determined on affidavits or motion, and thus cannot be satisfactorily resolved on a motion for summary judgment. Marcus Breier Sons v. Marvlo Fabrics 173 F.2d 29 (2d Cir. 1949); Standard Pressed Steel Co. v. Midwest Chrome Process Co. (1976, ND Ill.) 418 F. Supp. 485, 191 USPQ 106. Consequently, such a motion is not favored in most such cases. DeVore & Sons, Inc. v. Thomas Nelson, Inc., 12 F. Supp. 2d 1157 (D. Kan. 1998); Panavision Intern., L.P. v. Toeppen, 945 F. Supp. 1296 (C.D. Cal. 1996); U.S. Jaycees v. San Francisco Jr. Chamber of Commerce, 354 F. Supp. 61 (N.D. Cal. 1972), judgment aff'd, 513 F.2d 1226 (9th Cir. 1975).

Summary judgment is inappropriate for deciding a claim of trademark infringement and related claims where a reasonable jury could decide the likelihood of confusion issue in favor of either party. Thane Int'l, Inc. v. Trek Bicycle Corp. (2002, CA9 Cal.) 305 F.3d 894.

In a suit between competitors in the marketplace, summary judgment was inappropriate for deciding trademark and trade dress infringement claims because factual questions existed as to

likelihood of confusion and distinctiveness. Sally Beauty Co. v. Beautyco, Inc. (2002, CA10 Okla.) 304 F.3d 964, 64 USPQ 2d 1321.

Conflicting affidavits which raise a genuine issue of fact concerning matters relevant to the pleadings preclude summary judgment. Avon Prods., Inc. v. MarCon, Ltd., 225 USPQ 977 (TTAB 1985); Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986).

Summary judgment is usually inappropriate when the underlying issue is one of motivation, intent, or some other subjective fact. Kinley Corp. v. Ancira (1994, WDNY) 859 F. Supp. 652 [summary judgment is generally inappropriate when state of mind is at issue].

When intent is relevant, such as when fraud on the PTO is at issue, the matter is inappropriate for resolution by summary judgment. Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Circ. 1991); see also Dunkin Donuts v. Metallurgical Expoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988); Volunteer Beer, Inc. v. Johnson, 45 USPQ2d 1051 (Tenn. App. 1997).

Summary judgment is usually denied in cases involving fraud, which involves issues as to litigant's state of mind. 10B Wright/Miller/Kane, Federal Practice and Procedure, Section 2730 [cases cited in footnote 21 on page 21].

The party objecting to a motion for summary judgment may prevail even without contravening affidavits or other evidentiary matter when the material presented by the moving party demonstrates the existence of a genuine issue of material fact. American International Ins. Co. v. The Vessel SS Fortaleza (1978, CA1 Puerto Rico) 585 F.2d 22.

A motion for summary judgment must focus on the issues raised by the case as set forth in the pleadings (in this case, the opposition, the counterclaim for cancellation, and the answers to

each). Hawes/Dwight, Trademark Registration Practice (Thomson West 2005) Section 17:10.

Summary judgment is not intended as a procedure to decide questions in avoidance of a full trial or for weighing evidence in advance of trial. Colgate-Palmolive Co. v. S.C. Johnson & Son, Inc., 159 USPQ 56 (TTAB 1968); Care Corp. v. Nursecare Int'l, Inc., 216 USPQ 993 (TTAB 1982).

When the consideration required to be given to a motion for summary judgment is substantially that which would be required by a full trial, or when the issue to be decided is a highly fact-driven one, the preference is to deny summary judgment. La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm. PT 1976); Nestle Co. v. Gaoyva Corp., 227 USPQ 477 (TTAB 1985).

The Board must view the evidence before it in a motion for summary judgment in a light most favorable to the non-moving party. Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

Since opposing factual inferences may arise from the same set of undisputed facts, the Board must draw reasonable inferences in favor of the non-moving party. United States v. Diebold, Inc., 369 U.S. 654, 655 (1962).

III. DISPUTED FACTS.

The pleadings in the opposition and the cancellation proceeding, the interrogatory answers exchanged between the parties, and the documents produced by the parties during document production all show that there is a genuine issue of material fact as to whether GSI or its predecessor committed fraud in the process of obtaining and maintaining the registration for MESSAGE IN A BOTTLE with the PTO. This is a fact-intensive issue involving the intent and state of mind of Roger Rojas and does not lend itself to a cancellation decision as a matter of law, particularly as to an

incontestable registration.

Applicant's answer to the notice of opposition herein and Applicant's counterclaim, a copy of which is attached to the Affidavit of Roger Rojas as Exhibit J, makes many allegations in the counterclaim which raise genuine issues of material fact.

IV. ANALYSIS AND REBUTTAL TO PETITIONER'S ARGUMENT.

Petitioner has set forth a long list of alleged undisputed facts, along with much of the same supporting evidence as in his concurrently filed motion for summary judgment in the opposition proceeding herein, and argues that these facts and documents somehow show that Respondent committed fraud on the PTO by knowingly filing a false statement of use in order to obtain his registration. Nothing could be further from the truth, and Respondent submits that there is nothing in Petitioner's unverified motion, including his list of facts and documents, which would justify finding as a matter of law that Respondent or his assignee committed fraud and that there is no genuine issue of material fact on this subject.

Indeed, Respondent has great difficulty following Petitioner's argument.

On page 6, Petitioner says, "There is no question that the Application would not have provided a basis for registration with the very fact that the Application makes no mention of communication devices, namely text and graphic images printed on paper and enclosed in a glass container, as well as being misclassified in International Class 38." However, the Affidavit of Roger Rojas, filed concurrently herewith, contains evidence in paragraphs 4, 5, 6, 7, 8, and 9 that he indeed intended to use and did use the services in commerce which were recited in his application, the statement of use, and the resulting registration. Furthermore, Respondent did make mention of

communication devices in his recitation of services, namely “recording such communications in written or printed form”. See paragraph 16 of the Affidavit of Roger Rojas, which offers evidence as to the 1997 version of the International Schedule of Trademark Classification, and explains Respondent’s consistency with that classification in his description of services.

On his page 6, Petitioner cites various prior trademark applications which had been rejected by the PTO, but offers no foundation as to their relevance or even whether Respondent had any knowledge about such prior applications. These citations of Petitioner should be disregarded as inadmissible and irrelevant to the present case.

Petitioner argues that Respondent’s recitation of services fail to identify the goods involved with the services, and that this somehow undermines the registration, which was in fact properly granted after the usual process by the PTO. However, the use of goods is implicit from Respondent’s recitation of services, specifically the services of “recording such communications in written or printed form”, clearly indicating the use of tangible goods in carrying out the specified services. Furthermore, Respondent’s specimen, filed with his statement of use, refers specifically to “sending art quality greetings in unique and distinctive bottles”, a specific statement of the goods and devices involved in the rendering of Respondent’s services. (See paragraph 10 and Exhibit E to the Affidavit of Roger Rojas.)

It is absurd for Petitioner to suggest that the statement of use constituted fraud in that it did not specifically mention a bottle in the recitation of services. Should it also have mentioned the paper on which the communications were recorded? The ink and the printers used in recording the communication? The programs used to format the communications? The packaging used for shipping? The computers, telephones, and mailboxes through which the communications were

rendered? Of course not. In any event, the specimen submitted with the statement of use specifically mentioned bottles as a means of communication.

Additionally, the combined affidavit of use and incontestably filed in the PTO by Respondent on October 13, 2004, included a specimen from GSI's website featuring the mark and referring to "decorative bottles in the gift bottle industry" as the goods and devices involved in the rendering of services. (See Exhibit D to the Affidavit of Roger Rojas.)

Petitioner's argument appears to assume that Respondent filed his service mark application in the wrong class, and was in bad faith in doing so. However, there is no evidence to support this contention. On the contrary, see the Affidavit of Peter H. Smith filed concurrently herewith, as well as paragraph 16 and Exhibit G of the Affidavit of Roger Rojas, as evidence of his good faith.

There is one obvious error in Petitioner's statement of undisputed facts, namely his item 7, that Respondent filed his statement of use on January 25, 2006. It was actually filed on January 25, 1999.

Petitioner's citation of Medinol Ltd. v. Neuro Vasx Inc., 67 USPQ2d 1205 (TTAB 2003), allegedly in support of finding fraud on the part of Respondent, is misleading, misplaced, and irrelevant to this case. In that case, a recitation of goods was included in the statement of use as to goods which had actually not been in use until a year later. There is no evidence of any such facts in the present case.

When other evidence is brought in from the parties, including their interrogatory answers, admissions, and documents produced, there is still a profound lack of any evidence of fraud or bad faith. See generally the Affidavit of Roger Rojas.

V. REBUTTAL TO APPLICANT'S EVIDENCE.

The only documents in Petitioner's list of "supporting evidence" which contain any statements or assertions by Respondent are Petitioner's item numbers 1, 3, 4, 6, 8, 11, and 12. However, scrutiny of all those documents discloses no evidence whatsoever of any fraud on the part of Respondent or his successor. Respondent is at a loss to understand why these documents are listed as Petitioner's supporting evidence, including Petitioner's Exhibit I, which consists solely of an action of the Board of Directors of GSI, along with a licensing agreement between GSI and Roger Rojas, both of which are entirely consistent with their other dealings with the mark MESSAGE IN A BOTTLE.

Petitioner has included as Exhibit J GSI's own trademark application which was later voluntarily withdrawn, but there is nothing therein that supports Petitioner's claim of fraud. See paragraph 23 of the Affidavit of Roger Rojas for further information as to this withdrawn application.

Petitioner's Exhibit H is a 2004 third-party application for MINI MESSAGE IN A BOTTLE, along with a PTO office action initially refusing registration on the ground of genericness. This office action, which fails to cite GSI's prior registration as a barrier to registration of the mark MINI MESSAGE IN A BOTTLE in Class 9 for a communication device, is inadmissible hearsay and does nothing to support Petitioner's position of fraud.

Petitioner has enclosed as Exhibit K documents relating to various third-party trademark applications. No foundation has been laid for their relevance in this proceeding, and they are inadmissible hearsay.

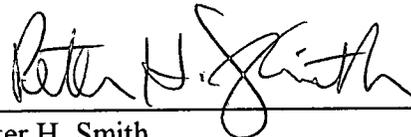
The other items of Petitioner's "supporting documents", items 2, 5, 7, 9, 10, and 13, are all documents which have nothing to do with the issue of whether or not Opposer or its predecessor had a particular intent or state of mind.

VI. CONCLUSION.

It is inconceivable that Petitioner could think that he has produced any arguments or evidence on which the Board could base a finding that GSI's service mark registration has been undermined by fraud and is subject to cancellation as a matter of law. The Affidavit of Roger Rojas provides ample evidence, uncontested by Petitioner's arguments and so-called supporting evidence, that no such fraud existed. To the extent that there is no genuine issue of material fact, it is that there was no fraud which would undermine Opposer's registration. Petitioner has presented no material which supports his conclusion, and therefore, Petitioner's motion must fail.

Finally, Respondent notes that Petitioner has furnished no verification or supporting affidavits for his motion, and therefore it does not meet the criteria for admissibility in evidence.

Dated: August 11, 2006.

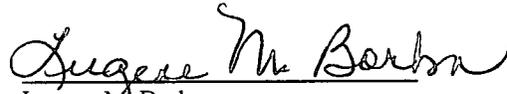


Peter H. Smith
Attorney at Law
1535 J Street, Suite A
P.O. Box 1867
Modesto, CA 95353
Telephone: (209) 579-9524
Facsimile: (209) 579-9940

Attorney for Respondent Roger Rojas and
Opposer/Assignee Gold Shells, Inc.

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposition to Petitioner's Motion for Summary Judgment in Cancellation Proceeding was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on August 11, 2006.


Lugene M. Borba

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR §2.198

Mark: MESSAGE IN A BOTTLE

Registration No.: 2,243,269

Opposition No.: 91162780

Mailing Date: August 11, 2006

Name of parties filing paper: Roger Rojas and Gold Shells, Inc.

Type of paper being filed: Opposition to Petitioner's Motion for Summary Judgment in Cancellation Proceeding

Express Mail Mailing Label Number: EQ 454418768 US

Date of Deposit: August 11, 2006

I hereby certify that the above-identified opposition to petitioner's motion for summary judgment in cancellation proceeding, which is attached, is being deposited on August 11, 2006, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §2.198 in an envelope addressed to: U.S. Patent & Trademark Office, Trademark Trial & Appeal Board, P. O. Box 1451, Alexandria, VA 22313-1451.


Lugene M. Borba
Date: August 11, 2006