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TTAB

September 26, 2007

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

78229875

Re: Opposition No. 91162780 and Counterclaim for Cancellation
Applicant/Petitioner: Keith Cangiarella
Opposer/Respondent: Gold Shells, Inc.

Ladies/Gentlemen:

I am enclosing the original of (1) Opposition to Applicant's Motion for Summary Judgment and (2) Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion for Summary Judgment, each for filing in the above-referenced proceeding.

I am also enclosing a copy of the first page of each of these documents. Please endorse these pages with your file stamp and return them to me in the enclosed self-addressed, stamped envelope to acknowledge your receipt and filing of these documents.

Thank you.

Very truly yours,


Peter H. Smith

PHS/clf
Enclosures

cc: Gold Shells, Inc.
Mr. Roger Rojas



09-28-2007

U.S. Patent & Trademark Trial Repl. Dt. #34

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,</p> <p>v. KEITH CANGIARELLA, Applicant.</p> <p>-----</p> <p>In the Matter of Trademark Registration No. 2,243,269 Mark: MESSAGE IN A BOTTLE</p> <p>KEITH CANGIARELLA, Petitioner,</p> <p>v. GOLD SHELLS, INC., Respondent.</p>	<p>Opposition No. 91162780 and Counterclaim for Cancellation</p>
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OPPOSITION TO MOTION FOR SUMMARY JUDGMENT

Keith Cangiarella has filed a document herein dated August 17, 2007, entitled "Petitioner's Motion for Summary Judgment 'In Pro Per'". Keith Cangiarella is the Petitioner in his cancellation counterclaim, but is the Applicant in the Opposition filed by Opposer Gold Shells, Inc. Curiously, though Gold Shells, Inc., is in the capacity of Opposer in the opposition proceeding, Cangiarella has referred to it as the "Assignee" in the cancellation counterclaim, which is confusing. In fact, Roger Rojas, who assigned the registration for MESSAGE IN A BOTTLE to Gold Shells, Inc., was the original Respondent in the counterclaim, but Opposer filed a motion with the Board on April 27, 2005, to substitute Gold Shells, Inc., as Respondent, and thereafter the Board referred to it as such in its order of March 30, 2005, so Opposer and Respondent are actually one and the same, but will be referred to herein as "Opposer" only.

Also, it is unclear from Cangiarella's document whether he is moving for summary judgment in the opposition proceeding, the counterclaim, or both.

In any event, Opposer requests that the Board deny Applicant's motion for summary judgment on the ground that there are genuine issues of material fact as to whether (1) Opposer's mark is generic, and (2) Opposer filed a fraudulent statement of use.

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. Opposer's registration resulted from its predecessor's application serial number 75/226,521, which was based on intent to use, and a statement of use subsequently filed on January 26, 1999, alleging use in commerce since January 16, 1999.

3. Opposer's predecessor submitted a combined affidavit of use and incontestability which was filed on October 13, 2004, and accepted by the Patent & Trademark Office on December 9, 2004.

4. Applicant is the owner of U.S. trademark 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.

5. 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.

6. Applicant previously filed another motion for summary judgment herein on July 5 and 6, 2006, alleging that there was no genuine issue of material fact as to likelihood of confusion and Opposer's fraud on the Patent & Trademark Office, but that motion was rejected by the Trademark Trial & Appeal Board in a decision dated June 18, 2007, finding ". . . that Applicant has failed to meet his burden of establishing that there are no genuine issues of material fact and that he is entitled to judgment as a matter of law. At a minimum, genuine issues of material fact exist as to . . . Opposer's intent to commit fraud in the procurement of its pleaded registration."

II. APPLICABLE LAW

A. NO SUMMARY JUDGMENT ON NON-PLEADED ISSUES.

A party may not obtain summary judgment on an issue that has not been pleaded. TBMP §528.07(a); Fed.R.Civ.P. 56(a) and 56(b); S. Industries, Inc., v. Lamb-Weston, Inc., 45 USPQ2d 1293, 1297 (TTAB 1997); Commodore Electronics Limited, Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503, 1505 (TTAB 1993); Estate of Biro v. Bic Corp., 18 USPQ2d 1382, 1386 n.8

(TTAB 1991); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626, 628 (TTAB 1986); and Consolidated Foods Corp. v. Berkshire Handkerchief Co. Inc., 229 USPQ 619, 621 (TTAB 1986).

B. INCONTESTABILITY.

If the Patent & Trademark Office accepts an affidavit of continuing use of a registered mark after five consecutive years of use and the satisfaction of certain formalities, then the registration shall be conclusive evidence of the validity of the registered mark and its registration of the registrant's ownership of the mark and of the registrant's exclusive right to use the registered mark on the specified goods or services. Lanham Act, §33(b), 15 U.S.C.S. §1115(b).

Once such an affidavit has been accepted, there are only limited bases (including genericness and fraud) for cancellation of any otherwise incontestable registration; and the primary significance of the registered mark to the relevant public rather than purchaser motivation is the test for determining whether the registered mark has become the generic name of the services on or in connection with which it has been used. Lanham Act Section 14 (15 U.S.C.S. Section 1064).

C. EVIDENCE ALLOWABLE IN SUMMARY JUDGMENT MOTION.

The types of evidence that may be submitted in support of, or in opposition to, a motion for summary judgment include the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any. TBMP Manual of Procedure §528.05(a). Also, see Fed. R. Civ. P. 56(c).

The element of self-authentication cannot be presumed to be capable of being satisfied by information obtained and printed out from the Internet. TBMP §528.05(e).

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.

D. WHEN SUMMARY JUDGMENT IS INAPPROPRIATE.

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 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. 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].

When considering charges of fraud, the Trademark Trial & Appeal Board has repeatedly stated that fraud must be "proved to the hilt" by clear and convincing evidence. Fraud will not lie if the allegedly fraudulent statement was made with a reasonable and honest belief that it was true, or if the statement was not material. Woodstock's Enterprises, Inc. (California) v. Woodstock's Enterprises, Inc. (Oregon), 43 USPQ2d 1440 (TTAB 1997).

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.

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).

E. GENERICNESS.

A distinction must be made between “generic” names and “apt or common descriptive” names. TMEP §1209.01(c)(ii).

A proper genericness inquiry focuses on the description of services set forth in the application, rather than on what the applicant's actual goods or services may be. Magic Wand, Inc. v. RDB, Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991).

Generic terms are terms that the relevant purchasing public understands primarily as the common or class name for the goods or services. In re Dial-A-Mattress Operating Corp., 240 F.

3d 1341, 57 USPQ 2d 1807, 1811 (Fed. Cir. 2001); In re American Fertility Society 188 F.3d 1341, 1346, 51 USPQ 2d 1983, 1836 (Fed. Cir. 1999).

There is a two-part test used to determine whether a designation is generic: (1) What is the class of goods or services at issue?; and (2) Does the relevant public understand the designation primarily to refer to that class of goods or services? H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 990, 228 USPQ 528, 530 (Fed. Cir. 1986). The test turns upon the primary significance that the term would have to the relevant public. TMEP §1209.1(c)(i).

A party alleging that a term is generic has the burden of proving genericness by clear evidence. In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987).

Where the mark at issue is a phrase, the proponent of genericness cannot simply cite definitions and generic uses of the individual components of the mark, but must provide evidence of the generic meaning of the composite mark as a whole. TMEP §1209.1(c)(i).

In In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), the court held that evidence that the components “society” and “reproductive medicine” were generic was not enough to establish that the composite phrase SOCIETY FOR REPRODUCTIVE MEDICINE was generic for association services in the field of reproductive medicine. The court held that the examining attorney must show: (1) the genus of services that the applicant provides; and (2) that the relevant public understands the proposed composite mark to primarily refer to that

genus of services. 51 USPQ2d at 1836-37. In In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), the court found that 1-888-M-A-T-T-R-E-S-S was not generic as applied to “telephone shop-at-home retail services in the field of mattresses” because there was no evidence of record that the public understood the term to refer to shop-at-home telephone mattress retailers. Therefore, the court held that the examining attorney must show that the relevant public would understand the mark as a whole to have generic significance.

In the following cases, the matters sought to be registered was found not to be generic: In re Dial-A-Mattress Operating Corp., 240 F.3d 1341, 57 USPQ2d 1807 (Fed. Cir. 2001), (1-888-M-A-T-T-R-E-S-S not generic for “telephone shop-at-home retail services in the field of mattresses”); In re American Fertility Society, 188 F.3d 1341, 51 USPQ2d 1832 (Fed. Cir. 1999), (SOCIETY FOR REPRODUCTIVE MEDICINE not generic for association services in the field of reproductive medicine); In re Merrill Lynch, Pierce, Fenner & Smith, Inc., 828 F.2d 1567, 4 USPQ2d 1141 (Fed. Cir. 1987) (CASH MANAGEMENT ACCOUNT for “stock brokerage services, administration of money market fund services, and providing loans against security services” held merely descriptive, rather than generic); H. Marvin Ginn Corp, v. International Association of Fire Chiefs, Inc., 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986) (FIRE CHIEF not generic for publication); In re Federated Depart. Stores, Inc., 3 USPQ2d 1541 (TTAB 1987). (THE CHILDREN’S OUTLET [“Outlet”disclaimed], while merely descriptive of applicant’s “retail children’s clothing store services,” held capable of functioning as a mark, with evidence submitted by applicant sufficient to establish acquired distinctiveness); Hunter Publishing Co. v.

Causfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986) (SYSTEMS USER for periodic trade journal held merely descriptive, rather than generic, and applicant's evidence held sufficient to establish acquired distinctiveness); In re Failure Analysis Associates, 1 USPQ2d 1144 (TTAB 1986) (FAILURE ANALYSIS ASSOCIATES, for "consulting services in the field of mechanical, structural, metallurgical, and metal failures, fires and explosions; engineering services in the field of mechanical design and risk analysis" and "consulting engineering services in the metallurgical field," found to be merely descriptive of applicant's services rather than incapable of distinguishing them from those of others).

An examining attorney in the Patent & Trademark Office must consider the evidence of record to determine whether a mark is merely descriptive or whether it is suggestive or arbitrary. The examining attorney may request that the applicant submit additional explanations or materials to clarify the nature of the goods or services. The examining attorney should also do any necessary research to determine the nature of the use of the designation in the marketplace. If the examining attorney refuses registration, he or she should support the refusal with appropriate evidence. TMEP §1209.02.

A mark comprising a combination of merely descriptive components is registerable if the combination of terms creates a unitary mark with a unique, nondescriptive meaning. See In Re Colonial Stores, Inc., 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (SUGAR & SPICE held not merely descriptive of bakery products).

It is possible for a word to be generic as to some goods and services and not others, and in

such case, the word or words may receive trademark protection for their nongeneric use. Soweco Inc. v. Shell Oil Co. 617 F.2d 1178, 1183.

It is appropriate for the TTAB to review various categories of evidence in a cancellation proceeding based on genericness, namely, (1) uncontested generic use by competitors, (2) generic use by the mark owner, (3) dictionary definitions, (4) generic use in the media, (5) testimony of persons in the trade, and (6) consumer surveys. Zimmerman v. National Association of Realtors, TTAB Cancellation Proceeding Nos. 92032360 and 92040141 (decided March 31, 2004).

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 Opposer had the intent to commit fraud in the procurement of its registration. This is a fact-intensive issue and does not lend itself to decision as a matter of law. These documents also contain significant bases for disputing Applicant's new allegation of genericness, but Opposer deems it unnecessary to enumerate those since genericness has not been pleaded by Applicant.

Applicant's answer to the notice of opposition herein and Applicant's counterclaim 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 Opposer has a priority right to the mark under Section 7(c) of the Lanham Act. (Page 3)
4. 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)
5. That the relevant class of the public has come to associate Opposer with the designation MESSAGE IN A BOTTLE. (Page 4)
6. That the mark MESSAGE IN A BOTTLE has become distinctive of Applicant's goods in commerce. (Page 4)
7. 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)
8. That Opposer's claims are unconscionable and that Opposer and its predecessor have "unclean hands". (Page 5)
9. 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)

IV. ANALYSIS AND ARGUMENT

- A. THE ISSUE OF SUMMARY JUDGMENT AS TO FRAUD HAS ALREADY BEEN ARGUED IN APPLICANT'S PRIOR MOTION AND HAS BEEN DECIDED AGAINST APPLICANT.

The Board must note that this is Applicant's second motion for summary judgment in this proceeding. In his first motion, Applicant attempted to obtain summary judgment on the issues of likelihood of confusion and Opposer's alleged fraud in the prosecution of its service mark registration. On both counts, Applicant failed. See the Board's ruling herein dated June 18, 2007, by Administrative Trademark Judges Hohein, Drost, and Walsh. While Applicant attempts in his current motion to focus on Opposer's predecessor's alleged fraud in the filing of his statement of use, this is merely one aspect of the prosecution of the registration, and there are clearly genuine issues of material fact in regard to this allegation. Therefore, Applicant's current motion for summary judgment on the ground of fraud should be denied for the same reason as its previous motion.

- B. APPLICANT'S MOTION FOR SUMMARY JUDGMENT BASED ON GENERICNESS IS PROCEDURALLY DEFECTIVE IN THAT APPLICANT HAS NOT PLEADED GENERICNESS IN HIS PLEADINGS HEREIN.

As noted above, summary judgment is not proper when based on an issue not previously pleaded. In his answer to the opposition herein, and in his counterclaim, Applicant has raised many issues, but not genericness. Therefore, his current motion is fatally defective to the extent that it is based on genericness, and must be denied. Also, in light of the fact that the discovery period has already been completed in this proceeding, it is too late for Applicant to amend his

pleadings to allege genericness.

C. "MESSAGE IN A BOTTLE" IS NOT GENERIC AS APPLIED TO THE SERVICES SPECIFIED IN OPPOSER'S SERVICE MARK REGISTRATION.

Opposer's incontestable service mark registration in Class 38 is for "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others". As noted above, the inquiry for genericness must focus on the services specified in the application (or in this case, in the registration). In that context, using the two-step inquiry for genericness, the first question is what is the genus of the services at issue. Opposer submits that the genus is communication services. The second inquiry is whether the term at issue is understood by the relevant public primarily to refer to that genus, namely communication services. Opposer submits that no admissible or relevant evidence has been submitted that the relevant public has any such understanding as to the mark MESSAGE IN A BOTTLE.

Even if the Board were to be able to go beyond the description of services in Opposer's registration, and consider the evidence of Opposer's receiving Internet communications from customers requesting that certain messages be recorded and sent to other people using bottles, Opposer submits that the mark is not generic. In Applicant's application serial no. 78/229,875, which is the focus of the opposition herein, Applicant seeks to register MESSAGE IN A BOTTLE as a trademark for "novelty, favor, and souvenir bottle containing messages and greetings, invitations, promotion 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” in Class 16. The whole reason for the existence of the present proceeding is that the examining attorney in Applicant’s application passed the application to publication without citing genericness, or even descriptiveness, as a ground for refusal (and without citing Opposer’s registration as a basis for likelihood of confusion).

In Opposer’s predecessor’s trademark application serial no. 76/556,304 for the same mark in Class 9 (which was later voluntarily withdrawn), the examining attorney issued an initial refusal based on descriptiveness, but it is important to note that the refusal was not based on genericness.

Furthermore, Applicant submits that if the Board was inclined to view the registered mark MESSAGE IN A BOTTLE as initially having been descriptive of the services specified, the issue of descriptiveness is now moot due to the lapse of time and the current incontestability of Opposer’s registration; and Opposer’s predecessor obtained the existing registration without the examining attorney having raised any issue of either descriptiveness or genericness. An incontestable registration is conclusive evidence that a mark is nondescriptive or has acquired secondary meaning.

Applicant argues that MESSAGE IN A BOTTLE is generic because there have been lots of references to messages in bottles in literature and the media going back into history. This does not mean, however, that the relevant public in the communication service industry or the gift bottle industry thinks of “message in a bottle” as the genus for the goods or services involved; and

if evidence can be put forward that this is the case, evidence can also be put forward to the contrary, creating a genuine issue of material fact. As noted above, there can be genuine issues of material fact on genericness relating to uncontested generic use by competitors, generic use by the mark owner, dictionary definitions, generic use in the media, testimony of persons in the trade, and consumer surveys.

In the alleged evidence cited by Applicant for his proposition that the mark is generic, the public perception of the words "message in a bottle" involves castaways on desert islands who scrawl messages, destined for no one in particular, insert the messages into bottles, and cast them arbitrarily into the ocean. This is a far cry from the modern commercial communication services on which Opposer uses the registered mark MESSAGE IN A BOTTLE with the Internet as its primary commercial facilitator.

With a generic mark, there is nothing left to a potential customer's imagination as to the goods or services. However, due to the historical public perception of the words "message in a bottle", as noted above, there is imagination required on the part of the consumer as to what services may be offered under that mark. The mark therefore functions as an indication of source, and certainly not as the genus of the services described in Opposer's registration. Customers of Opposer's services are not thinking of the service as a found bottle which has washed up on a foreign shore, or a bottle which already contains a message scrawled by a distant stranger. Opposer uses the mark for a service that allows its customers to dictate a message to be sent, have it printed, and have it sent to someone specific, just as with a telegram.

A Google search of the words “message in a bottle” will yield a myriad of references, but these references show a mixed bag of understandings by the general public as to the term. The term has been used for a book, a movie, and a song, among other things. This myriad of understandings bolsters Opposer’s assertion that its mark MESSAGE IN A BOTTLE is not understood by the relevant public primarily to refer to the genus of the services described in Opposer’s registration.

Though there are obviously dictionary definitions of “message” and “bottle”, there is no dictionary definition of “message in a bottle”.

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 conclusions that there was fraud on Opposer’s part or that the mark is generic.
2. Applicant cites his own trademark application, but there is nothing therein that supports Applicant’s claims.
3. Applicant cites Opposer’s registration, but it offers no support to Applicant’s claims.
4. Applicant’s Exhibit A is an 1903 article from the Los Angeles Times talking about a message from shipwrecked men found in a bottle in the ocean, but this only shows that the public perception of the words “message in a bottle” has nothing to do with the services for which

Opposer uses its registered mark. Also, it was not disclosed in discovery.

5. Applicant's Exhibit B is a web page printout from NewsBank, Inc., which was not disclosed in discovery and is irrelevant to the issues herein.

6. Applicant's Exhibit C is a series of articles from NewsBank, Inc., which are similar in effect to Exhibit A and were not disclosed in discovery.

7. Applicant's Exhibit D is a printout of a Google search for the words "message in a bottle". This was not disclosed in discovery and merely serves to show the myriad of public uses and perceptions of these words, and thus fails to support Applicant's arguments.

8. Applicant's Exhibit E consists of copies of documents relating to Opposer's predecessor's withdrawn trademark application in Class 9, which is irrelevant to the arguments herein.

9. Applicant's Exhibit G is a copy Opposer's response to Applicant's interrogatories in this proceeding, but none of the responses therein support Applicant's arguments on fraud and genericness.

10. Applicant's Exhibit H is the examiner's initial refusal of Opposer's predecessor's trademark application in Class 9, but that was based on descriptiveness, not genericness, and fails to support Applicant's arguments.

11. Applicant's Exhibit I consists of documents relating to Opposer's predecessor's statement of use in the proceeding by which Opposer obtained its current registration, but nothing therein supports Applicant's allegations of fraud and genericness.

12. Applicant's Exhibit J consists of documents relating to Opposer's predecessor's combined affidavit of use and incontestability in connection with Opposer's current registration, but nothing therein supports Applicant's allegations of fraud and genericness.

13. Applicant's Exhibit K is a printout of the home page from Opposer's website, but nothing therein supports Applicant's claim of fraud or genericness.

14. Applicant's Exhibit L consists of a printout of portions of Opposer's website, but nothing therein supports Applicant's allegations of fraud or genericness.

15. Applicant's Exhibit M is a printout from the website of a company called "Alexa" which says that Opposer has been on-line since January 17, 1997. Applicant uses this to argue that Opposer's predecessor was fraudulent in stating a first use date in 1999 for his mark. However, as set forth in the accompanying affidavit of Roger Rojas, while the domain name was set up on or about January 17, 1997, there was no commerce with the mark until January 16, 1999. In any event, it is novel of Applicant to allege fraud in claiming a use date which is actually later than what Applicant perceived to be the actual use date.

16. Applicant's Exhibit N is a reference to a book (which was not disclosed in discovery) which purports to contain "strange but true tails of messages found in seagoing bottles". See Opposer's comments in regard to Applicant's Exhibit A.

17. Applicant's Exhibit O is a copy of another publication which was not disclosed in discovery and includes a story about messages being placed in bottles and dropped in the ocean. See Opposer's comments on Applicant's Exhibit A.

V. CONCLUSION

Applicant's present motion for summary judgment is based on the dual premises that Opposer committed fraud on the Patent & Trademark Office in obtaining its current registration, and that in any event, the mark MESSAGE IN A BOTTLE is generic as applied to Opposer's recited services. However, as noted above, Applicant has previously been rejected on a motion for summary judgment claiming that there was no genuine issue of material fact as to Opposer's fraud, and this motion should be rejected on the same ground.

As to Applicant's argument of genericness, the materials presented by him in his motion, taken as a whole, while largely inadmissible hearsay, actually demonstrate the opposite of his conclusion – that the mark MESSAGE IN A BOTTLE is not generic as to Opposer's recited services, or, at the very least, that there is a genuine issue of material fact regarding the evidence in connection with genericness. Also, in pleading genericness in this motion, Applicant has gone beyond his own pleadings since he has never previously raised the issue of genericness, thereby rendering this motion procedurally defective. For these reasons, Applicant's motion must fail.

It is particularly ironic to note that, by raising the issue of genericness, which has not been raised by any of three different examining attorneys who have reviewed applications for MESSAGE IN A BOTTLE at the Patent & Trademark Office, Applicant is pursuing a kamikaze motion, as its ultimate effect, if successful, would be to defeat Applicant's own trademark application for the same mark.

Getting back to the core of the present proceeding, Opposer has priority over Applicant in

regard to the identical mark, MESSAGE IN A BOTTLE, and Opposer's incontestable registration entitles it to be the only competitor in the communication service industry and the related gift bottle industry to identify its services – and the goods used therein – by its chosen and well established mark.

Finally, Opposer notes that Applicant has furnished no independent verification evidentiary foundation for his Exhibits A, B, C, D, E, N or O, therefore those exhibits do not meet the criteria for admissibility in evidence.

Dated: September 26, 2007



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Telephone: (209) 579-9524
Facsimile: (209) 579-9940

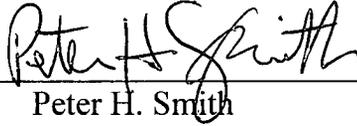
Attorney for Opposer and Respondent
Gold Shells, Inc.

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR §2.197

MARK: MESSAGE IN A BOTTLE
REGISTRATION NO.: 2,243,269
OPPOSITION NO.: 91162780
MAILING DATE: September 26, 2007
NAME OF PARTY FILING PAPER: Gold Shells, Inc.
TYPE OF PAPER BEING FILED: Opposition to Motion for Summary Judgment

I hereby certify that the above-identified Opposition to Motion for Summary Judgment, dated September 26, 2007, which is attached, is being deposited on September 26, 2007, with the United States Postal Service by first-class mail, postage prepaid under 37 C.F.R. §2.197 in an envelope addressed to:

Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

A handwritten signature in black ink, appearing to read "Peter H. Smith", written over a horizontal line.

Peter H. Smith

Date: September 26, 2007

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,</p> <p>v.</p> <p>KEITH CANGIARELLA, Applicant.</p> <p>-----</p> <p>In the Matter of Trademark Registration No. 2,243,269 Mark: MESSAGE IN A BOTTLE</p> <p>KEITH CANGIARELLA, Petitioner,</p> <p>v.</p> <p>GOLD SHEELS, INC., Respondent.</p>	<p>Opposition No. 91162780 and Counterclaim for Cancellation</p>
---	--

**AFFIDAVIT OF ROGER ROJAS IN SUPPORT OF OPPOSITION TO APPLICANT'S
MOTION 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 and Respondent in the above-referenced opposition proceeding, and am making this affidavit in opposition to Applicant Keith Cangiarella's second motion for summary judgment in the present proceeding.

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. 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 sent to the recipient.

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. Though the specimen submitted with said statement states in part, "Serving our on-line customers since 1997", that is a

reference to the year my domain name and the accompanying business information came on-line, but communication services using my service mark were not sold from the website in commerce until January 16, 1999. Thus, 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 communication services using the mark have been sold on the website continuously since early 1999.

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. 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!.

12. Attached hereto as Exhibit G 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".

13. 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.

* * * *

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: September 26, 2007

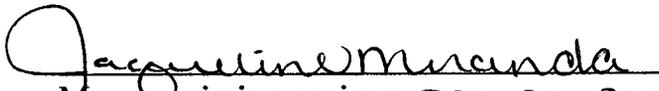


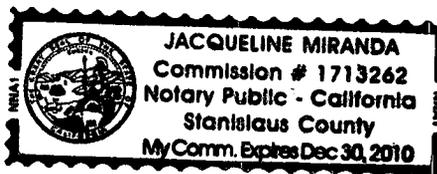
ROGER ROJAS

STATE OF CALIFORNIA)
) ss
COUNTY OF STANISLAUS)

On September 20, 2007, before me Jacqueline Miranda, notary public personally ~~known to me to be~~ ^{to be} personally proven the person whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

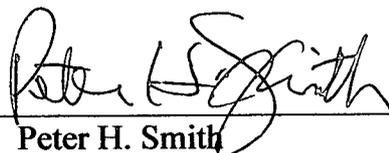

My commission expires: DEC. 30, 2010



CERTIFICATE OF SERVICE

Opposition to Applicant's Motion for Summary Judgment and

I hereby certify that a copy of the foregoing Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion for Summary Judgment was mailed first class mail, postage pre-paid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on September 26, 2007.



Peter H. Smith

CERTIFICATE OF FIRST CLASS MAILING UNDER 37 CFR §2.197

MARK: MESSAGE IN A BOTTLE

REGISTRATION NO.: 2,243,269

OPPOSITION NO.: 91162780

MAILING DATE: September 26, 2007

NAME OF PARTY FILING PAPER: Gold Shells, Inc.

TYPE OF PAPER BEING FILED: Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion for Summary Judgment

I hereby certify that the above-identified Affidavit of Roger Rojas in Support of Opposition to Applicant's Motion for Summary Judgment dated September 26, 2007, which is attached, is being deposited on September 26, 2007, with the United States Postal Service by first-class mail, postage prepaid under 37 C.F.R. §2.197 in an envelope addressed to:

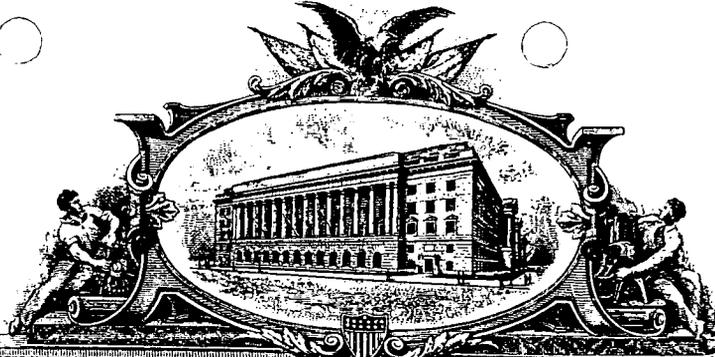
Commissioner of Trademarks
Trademark Trial & Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451



Peter H. Smith

Date: September 26, 2007

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

United States Patent and Trademark Office

Reg. No. 2,243,269

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


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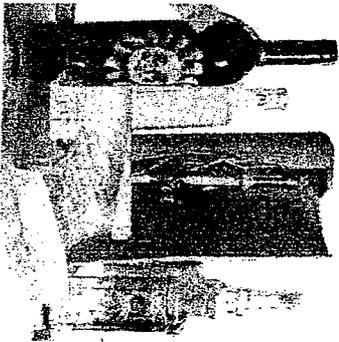
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- Baby
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- Christmas
- Valentine's
Day



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!

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

"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®

Message in a Bottle® offers a Free **Gold Gift Box** or Upgrade to a Sweetheart Red Box \$3.99
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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.**

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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) ▾

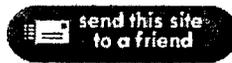
BURNT EDGES: No Thanks (add \$0.00) ▾

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



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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

\$34.99

Total

\$ 34.99

Sub Total \$ 34.99

Zip Code:

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To remove an item from your cart, check the "x" button next to that item.

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Billing Information

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Your Phone:

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Zip/Postal Code:

Country:

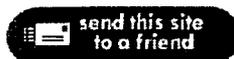
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USPS Express Mail - Select this for expedited delivery which usually takes **2 business days** from date of order within the continental U.S. If you place your order by 3:00 p.m. Pacific Standard Time on a regular business day, Mon-Fri. excluding holidays.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

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Credit Card



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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.

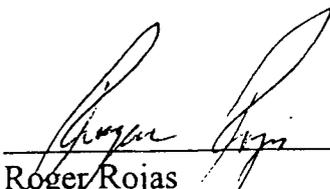
The date of first use of the mark in commerce which the U.S. Congress may regulate was January 16, 1999.

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 Cangiarella
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
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Message in a Bottle®

the art of expression™

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

- Home
- All Message in a Bottle®
- Specials
- Love
- Anniversary
- Birthday
- Friendship
- Traditional
- Any Occasion
- Accessories
- Message Sample
- Shipping
- About
- Customers
- Contact
- Privacy
- FAQ'S



Christmas Collection
Coming Soon!



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

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

We offer you:

- the largest selection of decorative bottles in the gift bottle industry so that you'll always have the appropriate bottle for any occasion.
- a 100% unconditional money back guarantee so that you'll feel confident with your purchase.
- a huge selection of prewritten messages and poems so that you will always have the words to say it right.
- a FREE Gold Toned Gift Box with every purchase or upgrade to one of our Wood Presentation Boxes.
- 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

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MEMBER OF CALIFORNIA
& OREGON STATE BARS

TELEPHONE (209) 579-9524
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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.

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Howard S. Michael, Esq.

May 31, 2005

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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
personalized-gifts.com/pickNpersonalize.com	
walmart.com	allbirthdaygifts.com
shop.store.yahoo.com/myweddingfavors/index.html	
personalizedbirthdaygifts.com	dogwoodsquare.com
momentsofelegance.com	yourweddingpartyfavors.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

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 G

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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>

9/15/2005