

Member of California
and Oregon State Bars

PETER H. SMITH
ATTORNEY AT LAW
3436 BECKWITH ROAD
MODESTO, CALIFORNIA 95358

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

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TTAB

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

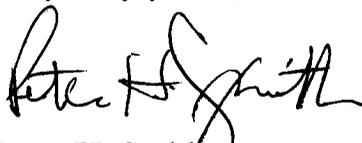
Re: Opposition No. 91162780 and Counterclaim for Cancellation
Applicant/Petitioner: Keith Cangiarella
Opposer/Respondent: Message In A Bottle, Inc.

Ladies/Gentlemen:

I am enclosing the original of Opposer Message In A Bottle, Inc.'s Brief as Plaintiff in the Opposition for filing in the above-referenced proceeding. Please file this document.

Thank you.

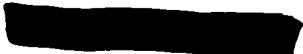
Very truly yours,



Peter H. Smith

PHS/lmb
Enclosure

cc: Message In A Bottle, Inc.


10-26-2009

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

<p>MESSAGE IN A BOTTLE, INC., Opposer, v. KEITH CANGIARELLA, Applicant.</p>	<p>Opposition No.: 91162780 Application Serial No.: 78/229,875 Mark: MESSAGE IN A BOTTLE</p>
<p>KEITH CANGIARELLA, Petitioner, v. MESSAGE IN A BOTTLE, INC., Registrant.</p>	<p>Counterclaim for cancellation Registration No.: 2,243,269 Mark: MESSAGE IN A BOTTLE</p>
<p>OPPOSER MESSAGE IN A BOTTLE, INC.'S BRIEF AS PLAINTIFF IN THE OPPOSITION</p>	

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OPPOSER MESSAGE IN A BOTTLE, INC. ("Opposer") hereby submits its brief as plaintiff in the above-referenced opposition proceeding, Opposition No. 91162780, by which Opposer seeks rejection of Application Serial No. 78/229,875 for the mark MESSAGE IN A BOTTLE by Applicant Keith Cangiarella ("Applicant").

I. INTRODUCTION

This opposition proceeding is one of two proceedings which have been consolidated into a single proceeding arising from a dispute between Opposer and Applicant over the mark MESSAGE IN A BOTTLE ("the Trademark"). In this proceeding, Opposer opposes Applicant's application to register the Trademark in Class 16 on the grounds that Opposer is the owner of an existing and incontestable registration for the Trademark in Class 38, that Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion, to cause mistake, or to deceive, and that Applicant's mark may disparage Opposer's registered mark and falsely imply a connection with Opposer. Applicant has filed a counterclaim against Opposer to request cancellation of Opposer's existing registration, but Opposer's defense to that counterclaim will be covered in a separate brief in the appropriate time period designated by the Trademark Trial & Appeal Board ("TTAB").

II. DESCRIPTION OF THE RECORD

The portion of the record pertinent to this opposition includes all items listed in Opposer's Notice of Reliance filed herein on March 31, 2008, and the transcript filed herein on April 16, 2008, of the deposition of Roger Rojas taken on March 24, 2008.

Pursuant to said Notice of Reliance, the record includes a certified copy of Opposer's registration of the Trademark, Registration No. 2, 243,269 dated May 4, 1999; a fictitious business name statement filed in Stanislaus County, California, on January 27, 1999, by Roger and Adriana Rojas for the fictitious business name "Message in a Bottle"; a fictitious business name statement filed in Stanislaus County, California, on October 23, 2003, by Gold Shells, Inc., for the fictitious business name "Message in a Bottle"; the articles of incorporation of Gold Shells, Inc., filed with the California Secretary of State on July 7, 2003; an amendment to the articles of incorporation of Gold Shells, Inc., changing its corporate name to Message In A Bottle, Inc., filed with the California Secretary of State on July 19, 2007; Applicant's Answers to Opposer's Requests for Admission; and Applicant's Responses to Opposer's revised First Set of Interrogatories.

Applicant has also filed a Notice of Reliance herein on May 14, 2009, attempting to introduce certain other documents to the record. Opposer's objections thereto are set forth below. Said Notice of Reliance includes the complete file at the Patent & Trademark Office ("PTO") for Opposer's registration, to which Opposer has no objection, but Opposer objects to inclusion in the record of all other documents listed by Applicant.

Applicant's PTO application file is also deemed to be part of the record.

Opposer notes that Applicant has not filed any deposition transcript as part of the record herein.

III. ISSUES

The issues to be decided in connection with this opposition proceeding are as follows:

1. Whether Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion or cause mistake or to deceive.
2. Whether the goods identified in Applicant's application are or may be related to the services identified in Opposer's registration of the identical mark so as to support a finding of likelihood of confusion.
3. Whether Applicant's mark may disparage Opposer's mark and falsely imply a connection with Opposer.
4. Whether Opposer has a priority right to the Trademark under Section 7(c) of the Trademark Act through constructive use based on the filing date of its predecessor's original intent-to-use service mark application.
5. Whether Applicant's application should be rejected due to Applicant's fraud through untrue statements in the application.

IV. EVIDENTIARY OBJECTIONS

Opposer objects to the following testimony and/or evidence offered by Applicant:

A. Evidence Requested by Opposer to be Excluded: Applicant's Exhibits W, Y, Business Wire press release, November 11, 1996; Exhibit V, Computer Networks and ISDN Systems Volume 29, Copyright 1997; Exhibit U, Orange County Register, Section Accent, April 4, 1999; Exhibit O, Primedia Business Magazine &

Media Inc., Telephony, Section Intelligence & Software; ISSN: 0040-2656; and Exhibit X, Dunn & Bradstreet Inc., Message in a Bottle/Gold Shell Inc., business reports, all cited in Applicant's May 14, 2009 Notice of Reliance, Sections II (A) – (E).

B. Grounds for Objection: Opposer objects to the introduction of the above exhibits and moves to strike them as evidence on the grounds that they are not printed publications or official records within the meaning of 37 C.F.R. § 1.122.(e) and TBMP § 704.08, they are inadmissible hearsay under Federal Rule of Evidence 801, and they are not relevant evidence under Federal Rule of Evidence 402.

Applicant seeks to introduce these excerpts from technical publications, a newspaper advertisement, and business reports. However, there is no indication that they are available to the general public in libraries or of general circulation among members of the public. Because conference papers, dissertations, and journal papers are not usually in general circulation, they are not admissible via a notice of reliance under 37 C.F.R. § 1.122.(e). See, e.g., Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 U.S.P.Q. 2d 1996, 1999 n.2 (TTAB 1986). Likewise, press releases, press clippings, and business reports are inadmissible. Harjo v. Pro-Football Inc., 1999 WL 375907 *17 (TTAB 1999).

Applicant additionally seeks to introduce these documents for the truth of statements made in the documents. Applicant's Notice of Reliance Sections II (A)-(E).

All of these documents are, therefore, hearsay, and are presumptively inadmissible. Federal Rule of Evidence 802.

Finally, these documents do not constitute relevant evidence under Federal Rule of Evidence 402. For example, Applicant contends that Exhibits V, W, and Y will be used to show that “the concept of Message in a Bottle is not a novel concept”. Applicant’s Notice of Reliance Sections II (A) and (B). Whether a concept is novel or not is irrelevant to the issue of likelihood of confusion between two trademarks. Accordingly, these exhibits should additionally be excluded for irrelevancy.

V. FACTS

A. The Products and Services of Opposer Message In A Bottle, Inc.

Opposer is an internet-based business. Testimony deposition of Roger Rojas (“Rojas Depo”) 8:1-4. Opposer’s registration is in Class 38 for “receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others”. Rojas Depo 10:13-18; Opposer’s registration file. The Trademark has been and is used for those services. Rojas Depo 11:25-12:2. The business is to accommodate people who want communications sent to others, who can place orders with Opposer, which will record their communications in written or printed form and transmit those communications to their intended recipients in bottles. Rojas Depo 13:7-18. Opposer’s products and services are further described on Opposer’s internet website, www.messageinabottle.com, the 2006 version of which is attached to the Rojas Depo as Exhibit V. Rojas Depo 44:18-25.

B. The Products and Services of Applicant Keith Cangiarella.

Applicant has said that he markets the following products: “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.” He says that his business includes the following goods: “bottles, corks, sand, shells, boxes, cords, confetti, decorative cut-outs, parchment paper, wedding invitations, party invitations, personalized greetings, notes, note cards, promotional announcements, art prints and reproductions.” Applicant’s Responses to Interrogatories, Response No. 1 on page 4.

Applicant has also said that he markets the following services under the Trademark: “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.” Applicant’s Responses to Interrogatories, Response No. 2 on page 4.

Applicant’s products and services are further described on Applicant’s internet website, www.bottlemeessage.com, the 2006 version of which is attached to the Rojas Depo as Exhibit W. Rojas Depo 45:16-25.

C. The Parties' Relationship to One Another in Trade.

Opposer and Applicant are in direct competition with one another. Rojas Depo 53:24-54:3. This has been admitted by Applicant. Applicant's Responses to Interrogatories, Response Nos. 11, 12, 13, 14, and 39.

D. The Parties' Channels of Trade.

Applicant has said that his channels of trade are internet sales, retail sales, catalog sales, commercial advertisements in magazines, newspapers, brochures, and flyers, direct mail, telephone sales, and at trade shows and events. Applicant's Responses to Interrogatories, Response No. 17, page 11. Opposer has said that its primary channel of trade is the internet, and specifically its website. Rojas Depo. 56:15-18.

E. Consumer Classes of the Parties.

Applicant has identified the class of consumers to whom its products identified with the Trademark have been sold as "all consumers, including individuals, families, commercial entities and merchants without any limitation." Applicant's Responses to Interrogatories, Response No. 21, page 12. The class of consumers to whom Opposer's services and goods have been sold with the Trademark has been stated by Opposer's principal as follows: "They have been sold to everyone; individuals, families, commercial entities, merchants without limitation." Rojas Depo 56:19-24.

F. Opposer's Registration of the Trademark.

Opposer holds U.S. registration 2,243,269 from the PTO for the mark MESSAGE IN A BOTTLE dated May 4, 1999, for which Section 8 and 15 affidavits have been filed

and accepted by the PTO. A certified copy of the registration showing the Section 8 and 15 filings and the title in Opposer is attached to Opposer's Notice of Reliance herein. See also Rojas Depo 9:9-11:1, and Opposer's registration file. This registration resulted from the filing of an intent-based application with the PTO on January 6, 1997, by Roger Rojas, Opposer's predecessor. Rojas Depo 16:7-16, and Exhibit D thereto. Rojas thereafter filed a statement of use claiming first use anywhere and in commerce as January 16, 1999. See Rojas Depo, Exhibit K. The registration was for recited services in Class 38, which was entitled "Communications" at the time Rojas' application for registration was filed. Rojas Depo. 10:4-9. The recited services are, "receiving communications from others, recording such communications in written or printed form, and transmitting such communications to others." Rojas Depo 10:13-18. This description of services was specifically agreed upon as between Rojas and the PTO examining attorney after the examining attorney rejected the definition of services originally set forth in the application. Rojas Depo 16:22-17:18. See also the Examiner's Amendment set forth as Exhibit E thereto. Rojas filed Section 8 and 15 affidavits between the fifth and sixth anniversaries of the registration. See Exhibit P to Rojas Depo. The PTO accepted these affidavits. See Exhibit Q to Rojas Depo. Rojas subsequently assigned the registration to Gold Shells, Inc., a California corporation, on October 5, 2004, and this assignment was recorded with the PTO on October 15, 2004. Rojas Depo 40:8-19. However, Rojas was allowed by a license agreement to continue to use the Trademark concurrently with the corporation. Rojas Depo 35:15-25, and Exhibit

N thereto. The name of Gold Shells, Inc., was subsequently changed to Message In A Bottle, Inc., and this change of name was recorded with the PTO on January 30, 2008. Rojas Depo 41:5-18, and Exhibit T thereto. Opposer then filed an application for renewal of the registration on March 25, 2009, and renewal was granted by the PTO on March 31, 2009, continuing the registration in effect for an additional ten years from May 4, 2009. See Opposer's registration file. Opposer or its predecessor have continuously used the Trademark in commerce since January 16, 1999. Rojas Depo 25:9-20 and 36:1-15.

F. Applicant's Application Serial No. 78/229,875 for MESSAGE IN A BOTTLE.

Applicant's application was filed on March 25, 2003, and was published for opposition in the Official Gazette on June 29, 2004. Opposer timely filed with the TTAB a request for an extension for filing a notice of opposition, and on August 24, 2004, the TTAB granted to Opposer an extension of time until October 27, 2004. Opposer subsequently filed its notice of opposition on October 21, 2004.

The mark applied for is 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, claiming first use on March 10, 1998, and first use in commerce on June 10, 1998. See Applicant's application file. The filing date of the application was March 25, 2003. See Applicant's Answers to Requests for Admission, Answer No. 3.

V. ARGUMENT

A. Opposer has the Exclusive Right to Use the Trademark in Commerce.

Section 7(b) of the Trademark Act states as follows:

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

B. The Evidence Shows a Likelihood of Confusion Under Section 2(d) of the Trademark Act between Opposer's Registered Mark MESSAGE IN A BOTTLE and Applicant's Application to Register MESSAGE IN A BOTTLE for the Classes of Goods Recited in the Application.

1. A PTO Application Must be Refused if There is a Likelihood of Confusion.

Section 2(d) of the Trademark Act states as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it - . . .

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent & Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause a mistake, or to deceive . . .

The factors for analyzing likelihood of confusion under Section 2(d) of the Trademark Act are set forth in In Re E.I. duPont de Nemours & Co., 177 USPQ 563

(CCPA 1973). According to the duPont case, “. . . in testing for likelihood of confusion under Section 2(d). . . the following, when of record, must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sounds, connotation, and commercial impression.
- (2) The similarity or dissimilarity 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.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.
- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use. “

The TTAB must consider each duPont factor for which it has evidence of record. Hewlett-Packard Co. v. Packard Press, Inc., 281 F.3d 1261, 1267 *Fed. Cir. 2002). The relevant factors in the present case are: 1) the identical nature of the parties' marks; 2) the similarity of the parties' respective goods and services; 3) the parties' similar trade channels; 4) the virtual identity of the parties' customer base and its lack of sophistication; 5) the evidence of actual confusion, and the substantial nature of the confusion; and 6) the direct market interface between the parties.

2. Applicant's Mark is Identical to Opposer's Mark.

Not all of the duPont factors may be relevant or of equal weight in a given case, and "any one of the factors may control a particular case." In Re Majestic Distilling Co., 315 F.3d 1311, 1315 (Fed.Cir. 2003). The two key factors are the similarity of the marks and the similarity of the services. Federated Foods, Inc. v. Fort Howard Paper Co., 192 USPQ 24, 29 (CCPA 1976). There is no issue in the present case as to similarity of the marks, as the marks as used by the parties, and as registered by Opposer and applied for by Applicant, are identical:

MESSAGE IN A BOTTLE.

3. There is a Potential and Actual Interplay between the Services Recited in Opposer's Registration and the Goods Recited in Applicant's Application.

One of the key duPont factors is the similarity or dissimilarity of services.

Federated Foods, 192 USPQ at 20. Under this duPont factor, similarity of services is examined by comparing the registrations and/or use of the senior user's mark at the time the junior user began use of its mark. Electronic Data Systems Corporation v. EDSA Micro Corp., 1992 WL 184671 *3 (TTAB 1992).

Applicant has admitted using the Trademark for the goods recited in his application "among others". Applicant's Answers to Requests for Admission, Answer No. 1. Furthermore, Applicant admits to utilizing services in selling its recited products. Applicant's Responses to Interrogatories, Response Nos. 1 and 2. He admits that services are provided "ancillary to sales of products worldwide". Applicant's Responses to Interrogatories, Response Nos. 20 and 22. Opposer uses its service mark for services in connection with the sale of the goods (excluding kits) described in Applicant's application. Opposer's service involves receiving communication from others, and those communications can include messages, greetings, invitations, and promotional materials of others. Opposer then records those communications in written or printed form, and transmits or passes on those communications in bottles, namely novelty, favor and souvenir bottles. Rojas Depo 51:4-52:4. Applicant's sale of the recited goods involves the same services. See Applicant's internet website, Exhibit W to Rojas Depo.

In reviewing the websites of each of the parties (see Exhibits V and W to Rojas Depo.), it should be noted that both use the Trademark prominently throughout the site, both use decorative bottles, both have a text input box where communications can be received, both have statements to the effect that the message will be printed, both have

text input boxes that indicate the sender, and both have text input boxes that allow for the address of the intended recipient to be entered so that the communication can be transmitted. Rojas Depo 53:3-12. Opposer's principal has testified that Opposer carries out the services described in its registration by using novelty, favor and souvenir bottles containing messages and greetings, invitations, and promotional materials. Rojas Depo 53:13-23. Thus, the services recited in Opposer's registration and the goods recited in Applicant's application are totally intermeshed.

The use of goods is implicit from Opposer's recitation of services in its registration, 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, the specimen which Rojas 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 in the rendering of Opposer's services. Rojas Depo. 24:19-25, and Exhibit K thereto. Additionally, the combined affidavit of use and incontestability filed in the PTO by Opposer on October 13, 2004, included a specimen from Opposer's website featuring the Trademark and referring to "decorative bottles in the gift bottle industry" as the goods and devices involved in the rendering of Opposer's services. See Rojas Depo, Exhibit P.

All of these things support the fact statement in paragraph V(C) above that the parties are in direct competition with one another, each utilizing the Trademark, which Applicant has admitted. With such direct competition, and the intermeshing of the Class

38 service description in Opposer's registration and the Class 16 goods description in Applicant's application, it is clear that there will be a likelihood of confusion if Applicant is allowed to register Opposer's mark for the recited goods in Class 16.

Actually, competition is not required for a likelihood of confusion finding. It is sufficient if the respective goods/services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See In Re Albert Trostel & Sons Co., 29 USPQ 2d 1783 (TTAB 1993).

Moreover, the greater the degree of similarity between the marks in question, the lesser the degree to similarity required as to the goods/services to support a likelihood of confusion determination. If the marks are the same, or almost the same, there need only be a "viable relationship" between the goods/services. In Re SCR Computers, Inc., S.N. 75/519, 930, et al (January 25, 2001). In SCR, the Board affirmed a Section 2(d) refusal to register the mark SCR COMPUTERS and two SCR and design marks for "custom manufacturing of computers for others" and "design of computers for others" finding the marks confusingly similar to SCR DIRECT, registered for "supplies volume purchasing services, namely, telephone and mail order services in the field of office and business equipment, machines, computers, printers, accessories and supplies used therewith." In In Re Norcom, Inc., S.N. 75/543,910 (January 24, 2001), the TTAB affirmed a Section 2(d) refusal to register the mark DOCUWORKS for various office supplies, including

copier paper, in view of the identical mark registered for photocopying and document reproduction services.

In In Re Lancome Parfums et Beaute & Cie, S.N. 75/348,649 (September 8, 2000), the TTAB affirmed a Section 2(d) refusal to register the mark VITABOLIC for cosmetics, finding the mark confusingly similar to the marks VITABOLIC AM and VITABOLIC PM for vitamins and minerals supplements.

In Niblick Pty. Ltd., vs. Kriton Golf Corp., Opposition No. 110,763 (March 2, 2001), the TTAB sustained a Section 2(d) opposition to registration of the mark NIBLOCK & design for “golfing accessories, namely gold golf locks and golf bag locks”, on the ground of confusing similarity to the registered mark NIBLICK for sports clothing including golf shoes. The TTAB found that golf shoes and clothing are related to golf accessories since they travel in the same channels of trade and are purchased by the same classes of purchasers.

In Professional Product Research, Inc. vs. Body Balancing Ltd., Opposition No. 113,363 (January 30, 2001), the TTAB sustained an opposition to registration of the mark BODY BALANCER for “health care devices, namely, boards for the back for use in therapy and pain relief”, finding the mark confusingly similar to the registered mark BODY BALANCERS for heel insert pads. Citing In Re Shell Oil Co., 26 USPQ 2d 1687 (Fed. Cir. 1993), the TTAB observed that, because the marks are virtually identical, their contemporaneous use can lead to the assumption that there is a common source even though the goods are not competitive or intrinsically related. The record demonstrated

that the goods were clearly related because they are advertised in the same publications, travel in the same trade channel, are sold to the same customers, and serve the same purpose.

In In Re N.A.D. Inc., 57 USPQ 2d 1872 (TTAB 2001), the TTAB affirmed a Section 2(d) refusal to register the mark SATURN INFORMATION SYSTEM for “computer software that assists anesthesiology in the recording and reporting of anesthesia related data”, finding it confusingly similar to the mark SATURN registered for computer programs and related products, following In Re Linkvest S.A., 24 USPQ 2d 1716 (TTAB 1992) in viewing the prior registrant’s goods as encompassing all computer programs, including those intended for the medical field. Similarly, in the present case, the TTAB should view Opposer’s service description, including the word “communications”, as encompassing all communications, including those intended to be made by messages in bottles.

4. The Parties’ Trade Channels are Substantially Similar.

The parties are both internet-based businesses, and their channels of trade are substantially similar as noted in paragraphs V(A), (B), and (D) above.

5. The Parties are Going After the Same Types of Customers, and They Are Unsophisticated Consumers.

The classes of consumers to which each of the parties sell are virtually the same, as indicated in paragraph V(E) above. An examination of the parties’ websites, as set forth in Exhibits V and W to Rojas Depo, reveals that the prices for the parties’ products and services are low, designed to attract a broad base of consumers, the bulk of whom

would be unsophisticated and easily confused by the use of the same trademark by two different businesses.

6. There Has Been Actual Confusion Between Applicant's Use of the Trademark on His Recited Goods and Opposer's Use of the Trademark on Its Recited Services, and the Confusion has been Significant.

“Convincing evidence of significant actual confusion occurring under actual marketplace conditions is the best evidence of a likelihood of confusion.” 3 McCarthy on Trademarks and Unfair Competition, Section 23.13 (4th Ed. 2005). The record contains significant evidence of actual confusion between the parties' use of the Trademark. See Rojas Depo 46:9-50:20, and Exhibits X, Y and Z. This evidence includes three e-mails from persons who were confused by Applicant's use of the Trademark, and Opposer's principal has testified that he has received phone calls in which a person has indicated that he or she had previously talked to Keith Cangiarella, and they wanted to talk to him in connection with an order they had placed. Rojas Depo 50:14-20. Misdirected e-mail communications were accepted as evidence of actual confusion in SOHO Internetwork, Inc., vs. Advanced Intelligent Networks Corp., Opposition No. 110,081 (July 31, 2000), in which the TTAB sustained an opposition to the registration of the mark SOHONET for computer software for solving multimedia communication problems, finding the mark confusing similar to Opposer's SOHONET, previously used for hosting and designing websites, designing and licensing software for internet applications, and goods and services relating to electronic mail and internet connectivity.

7. There is Direct Market Interface between the Parties.

The parties' websites, Exhibits V and W to Rojas Depo, show that they are in direct competition with one another. Furthermore, this direct competition has been noted by Opposer's principal, Rojas Depo 53:24-54:3, and has been admitted by Applicant in Applicant's Responses to Interrogatories, Response Nos. 11, 12, 13, 14 and 39. See also Applicant's e-mail to Opposer, Exhibit U to Rojas Depo. Under these circumstances, confusion is not only likely when the parties use the same mark, confusion is inevitable, so it is no surprise that there has been substantial actual confusion.

C. Applicant's Use and Registration of the Trademark May Disparage Opposer's Mark and Falsely Imply a Connection with Opposer.

In the evidence of actual confusion noted in paragraph V(B)(5) above, there is evidence of consumer hostility having been visited on Opposer when intended for Applicant. If Applicant is allowed to register Opposer's mark for Applicant's, recited goods, more such disparagement of Opposer's mark can be expected. Opposer's principal has testified to persons having called him and asking for Applicant, and this is evidence of there being a false implication of a connection between the parties, which again would seem to be inevitable when the same mark is used. See Rojas Depo 46:9-50:20, and Exhibits X, Y, and Z thereto.

D. Opposer Has a Priority of Rights to the Trademark Based on Its Predecessor's Having Filed an Intent-Based Application for the Trademark with the PTO on a Date Prior to Applicant's Filing Date or Claimed Date of First Use.

The filing date of Opposer's predecessor's original intent-to-use service mark application was January 6, 1997. This date is prior to either Applicant's filing date,

which was March 25, 2003, or Applicant's claimed first use, which was March 10, 1998.

Section 7(c) of the Trademark Act states as follows as to intent-based applications:

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing -

- (1) has used the mark;
- (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
- (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) to register the mark which is pending or has resulted in registration of the mark.

Applying this statute to the present case, the filing of Opposer's predecessor's application for Trademark on January 6, 1997, constituted constructive use of the mark once registration had been achieved on the principal register, and this constructive use conferred a right of priority to Opposer's predecessor (and subsequently to Opposer) on or in connection with the services specified in Opposer's registration. Applicant is not a person who claims to have used the mark prior to Opposer's filing date, had not filed an application prior to Opposer's filing date, and had not filed a foreign application to register the mark, and therefore Applicant does not fit any of the statutory exemptions to Opposer's right of priority.

In Brookfield Communications, Inc. vs. West Coast Entertainment Corp., 174 F.3d 1036, fn 13 (9th Cir. 1999), there was an issue over when the registrant started actually using the disputed trademark, but even though it failed to produce evidence to support its claim of first use, the court held that it was entitled to a presumptive first use date equivalent to the filing date of its trademark application, citing Rolley, Inc. vs. Youngblood, 204 F.2d, 209, 210 (9th Cir. 1953).

E. Applicant's Application is Defective in that it Contains an Untrue Statement and is Therefore Fraudulent.

In connection with and as part of his application to register the Trademark, Applicant signed a statement on March 19, 2004, including the following language:

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. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares . . . he/she believes the Applicant to be the owner of the trademark/service mark sought to be registered, . . . ; to the best of his/her knowledge and belief, no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods and/or services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true as set forth within the original application and/or the submitted amendment/response.

Applicant has admitted that his application filing date was March 25, 2003. Applicant's Answers to Requests for Admission, Answer No. 3. Applicant has also admitted having information on or before March 25, 2003, his application filing date, that

products and/or services featuring the Trademark had been sold in commerce by someone else. Applicant's Answers to Requests for Admission, Answer No. 4. In addition, Applicant has admitted that he noticed on or before March 25, 2003, that Roger Rojas had filed an application with the PTO for registration of the Trademark, and that Rojas had had a registration issued to him. Applicant's Answers to Requests for Admission, Answer Nos. 6 and 8. Therefore, Applicant's sworn statement as set forth above was untrue and Applicant's application should be rejected for that reason alone as a fraud on the PTO, apart from whether or not that there is likelihood of confusion with Opposer's registered mark.

On August 9, 2004, Applicant sent an e-mail to Opposer in which he said, referring to the Trademark, "I created this product in 1997 and new[sic] of your pending trademark at the time . . .". Rojas Depo 43:11-22, Exhibit U. This constitutes an admission by Applicant that he knew of Opposer's claim of rights to the Trademark at the time of filing his application and at the time of signing the sworn statement noted above. Furthermore, Applicant acknowledged in that e-mail knowing of other companies which had used the Trademark. Furthermore, he acknowledged in that e-mail direct competition with Opposer by saying ". . . we both offer a similar product, a bottle housing a message . . ." and referring to other companies as "not message in a bottle companies like ours". . . . He further admits that the products of his and Opposer's are similar. See Rojas Depo, Exhibit U.

Averments of fraud must include an explicit expression of the factual circumstances alleged to constitute fraud. See Fed. R Civ. P. 9(b): and King Automotive, Inc. v. Speedy Muffler King, Inc., 667 F.2d 1008, 212 USPQ 801 (CCPA 1981). When a party claims that the declaration in another's application for registration was executed fraudulently in that there was another use of the same or confusingly similar mark at the time the declaration was signed, the party must allege particular facts which, if proven, would establish that : (1) there was in fact another use of the same or a confusingly similar mark at the time the oath was signed; (2) the other user had legal rights superior to applicant's rights; (3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and (4) applicant, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which applicant was not entitled. See Intellimedia Sport Inc. v. Intellimedia Corp., 43 USPQ 2d 1203, 1206 (TTAB 1997) and cases cited therein. In the present proceeding priority of constructive use and likelihood of confusion, coupled with the evidence of Applicant's knowledge and failure to disclose, supply the necessary factual basis for Opposer's claim of fraud.

VII. CONCLUSION

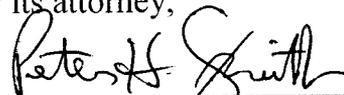
Applicant's application for registration of the mark MESSAGE IN A BOTTLE in Class 16 should be refused because Opposer has established by the evidence of a likelihood of confusion that exists of Applicant's use of this mark for his recited goods

and Opposer's identical registered mark for its recited services, precluding Applicant's registration of the same mark; Applicant's registration of the Trademark may disparage Opposer's registered mark and falsely imply a connection with Opposer; Opposer has established a clear priority to the mark based on its prior constructive use based on its early filing date; and the validity of Applicant's application in Class 16 is undermined by his signing a sworn statement of entitlement when he knew at the time that Opposer, a direct competitor, had already registered the same mark for the recited services in Class 38. Accordingly, Opposer respectfully requests that Applicant's application for registration of the mark be rejected.

Respectfully submitted,

MESSAGE IN A BOTTLE, INC.

By its attorney,



PETER H. SMITH

3436 Beckwith Road

Modesto, CA 95358

Phone: (209) 579-9524

Fax: (209) 579-9940

Date: October 26, 2009

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Opposer Message In A Bottle, Inc.'s Brief as Plaintiff in the Opposition was mailed first-class mail, postage prepaid, to Keith Cangiarella, 331 N. Harrington Drive, Fullerton, California 92831, on October 26, 2009.

Dated: October 26, 2009



PETER H. SMITH

CERTIFICATE OF EXPRESS MAILING UNDER 37 CFR SECTION 2.198

Mark: MESSAGE IN A BOTTLE
Registration No.: 2,243,269
Opposition No.: 91162780
Mailing Date: October 26, 2009
Name of party filing paper: Message In A Bottle, Inc.
Type of paper being filed: OPPOSER MESSAGE IN A BOTTLE, INC.'S BRIEF
AS PLAINTIFF IN THE OPPOSITION

Express Mail Mailing Label Number: *EH 817870728 US*
Date of Deposit: October 26, 2009

I hereby certify that the above-identified Opposer Message In A Bottle, Inc.'s Brief as Plaintiff in the Opposition dated October 26, 2009, which is attached, is being deposited on October 26, 2009, with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR Section 2.198 in an envelope addressed to:

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



Peter H. Smith
Date: October 26, 2009