

ESTTA Tracking number: **ESTTA318935**

Filing date: **11/25/2009**

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

Proceeding	91162780
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Date	11/25/2009
Attachments	anwer to opposition.pdf ( 28 pages )(75037 bytes )

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

MESSAGE IN A BOTTLE. INC.  Opposer  v.  KEITH CANGIARELLA.  Applicant.	Opposition No. : 91162780  Application Serial No. : 78/229.875  Mark : MESSAGE IN A BOTTLE
KEITH CANGIARELLA.  Petitioner.  v.  MESSAGE IN A BOTTLE. INC.  Registrant.	Counterclaim for cancellation  Registration No. : 2,243,269  Mark : MESSAGE IN A BOTTLE

**REPLY BRIEF BY KEITH CANGIARELLA AS DEFENDANT IN THE**  
**OPPOSITION**

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## I. INTRODUCTION

This is a very special and peculiar case of its own kind and hence the applicant request the kind attention of the Board even to the minutest fact, which if overlooked may lead to a miscarriage of justice. Opposer MESSAGE IN A BOTTLE INC. has filed this opposition alleging that the Applicant's mark so resembles Opposer's registered mark as to be likely to cause confusion or cause mistake or to deceive and that Applicant's mark may disparage Opposer's registered mark and falsely imply a connection with the Opposer. The applicant, on grounds to be stated in the forthcoming arguments allege that the registration of the mark of the Opposer was itself the result of fraud committed on the Board and that the opposer is guilty of continuing fraud till this date. The Opposer has approached the Board with the opposition proceedings with utmost unclean hands. Hence the applicant prays the Hon'ble Board apply utmost care and caution in deciding this case.

## II. ARGUEMENTS

### A. Opposer's evidentiary objections as is raised in its brief should be overruled.

Documents that constitute printed publications or official record enjoy a special status because Trademark Rule 2.122 (e) and not 1.122 (e) as stated by the Opposer, specifically permits them to be introduced under a notice of reliance.

"Printed publications" are defined in the Trademark as materials "such as books and periodicals, available to the general public or that segment of the public which is relevant under an issue in a proceeding."

Orange County Register is a daily newspaper based in Santa Ana, Calif., is a three-time, Pulitzer Prize-winning newspaper and the area's most trusted source of news

and information since 1905, it is available to the general public in the area which comes within the business sphere of both the Opposer and Applicant. Hence it satisfies the requirement in Rule 2.122 (e). When the newspaper itself satisfies the necessary requirements of this rule, an advertisement published in the same paper, being a part of it, also come within the purview of this rule. Hence the objection raised by the Opposer with respect to Exhibit U must be overruled.

The relevancy of the other evidences (Exhibit V, W, Y and O) to which objection is raised by the Opposer in his brief lies in the fact that it shows how the communication of messages can be carried out strictly adhering to telecommunications medium. It is not relied for asserting the truth of any material facts. Hence the objection raised as to its admissibility must be overruled.

**B. Applicant's Evidentiary Objection.**

The Applicant raise objection to Exhibit (N) introduced by the Opposer together with the Testimony Deposition of Rojas Roger filed on 16/04/2008. This is based on the following facts:

Under 15 USC 1060 (1) 'A registered mark or a mark for which an application to register has been filed shall be assignable with the good will of the business in which the mark is used, or with that part of the good will of the business connected with the use of and symbolized by the mark.' ..... and,

Under 15 USC 1060 (3): 'Assignments shall be by instruments in writing duly executed. Acknowledgment shall be prima facie evidence of the execution of an assignment, and when the prescribed information reporting the assignment is recorded in the United States Patent and Trademark Office, the record shall be prima facie evidence of execution.'

It is humbly submitted that this document is not ‘duly executed’ or ‘acknowledged’ as is required by the above rule.

Moreover, Exhibit N is nothing but a type written or print out form signed by Roger Rojas and Adriana Rojas. There is nothing in this document to show the authenticity of the date of the document. Even today, it is possible to produce a similar document provided the parties affix their signature to it. Moreover it should also be considered that the signing parties bear marital relationship with each other. There is neither a company seal affixed nor is it registered. When this document is relied as crucial to the fate of this application, there must be strong evidence to prove the authenticity of the date of execution.

Also, the licensing agreement claims that Roger Rojas is the owner of the service mark and trademark ‘MESSAGE IN A BOTTLE’, whereas he has the ownership only of the servicemark MESSAGE IN A BOTTLE. The mark assigned by this agreement is the trademark and not the servicemark as can be understood from the wordings of the agreement. Hence it could be concluded that only the trademark (and that too without any ownership) is assigned while the ownership of the servicemark is with Rojas Roger. The words of the licensing agreement clearly state that Rojas Roger is the owner of the service mark and trademark ‘MESSAGE IN A BOTTLE’ and that only the trademark, to which Rojas Rojer has no exclusive right, is assigned. For a valid assignment it is important that the assigner should have the ownership of the ‘assigned’. How can the trademark ‘Message in a Bottle’ be assigned when Rojas Roger is not the owner of it.

This applicant also doubts the veracity of evidence marked U, X, Y and Z (all electronic mails) produced by the Opposer along with the testimony deposition of Rojas Roger as they are not assertive by themselves.

C. **Preliminary Issues**

The Opposer's brief concentrates entirely on its priority rights and alleged resemblance of this applicants mark with the Opposer's so as to be likely to cause confusion or cause mistakes or to deceive.

The Opposer most tactfully tried to lift the concentration of this Hon'ble board from certain important preliminary facts which could be crucial informing a decision with respect to this case. This Applicant has tried its best to bring these facts to the light of the board in the forth coming brief together with framing a reply to this brief.

There are certain preliminary issues highlighted by this Applicant for the kind consideration of this board. They are enumerated as below.

1. **Role of Rojas Roger in this application.**

Rojas Roger is highlighted as a prominent person through out the course of this opposition proceeding. He is the CEO of the Opposer Gold Shells Inc. (now renamed as Message in a Bottle Inc.). Together with his wife Adriana Rogers, Rojas Roger holds ownership of this incorporation and is the controlling interest of the Opposer Corporation. As far as this opposition is concerned, no evidence has been provided to prove the existence of any third persons other than these two who has substantial controlling interest over the Opposer Corporation.

This applicant like to use the name Gold Shells Inc. to designate the Opposer, since at the time of filing the proceedings it was designated so and only subsequently pending the proceeding it acquired the present name 'Message in a Bottle Inc.' The mark 'Message in a Bottle' it self being in question, this Applicant looks upon the change of name by the Opposer to a name which itself is the name of the mark in dispute as quite ambiguous and suggestive of intrinsic irregularity.

2. **The origin of registration of the service mark 'Message in a Bottle'.**

The impugned mark is service mark 'Message in a Bottle' which is granted registration under international class 038 to Rojas Roger, a US citizen, based on an intent to use application filed by him on January 6, 1997. This intent to use application matured into registration on May 4, 1999 subsequent to the first use of it in commerce by him on January 16, 1999. This mark is granted under the category 'telecommunication', which is one of the constituents of the domain 'communication'.

### **3. Role of the Opposer.**

The Opposer corporation is constituted by Rojas Roger and came into existence on July 3, 2003 with the name 'Gold Shells Inc.' This corporation was purported to be assigned the right to concurrent use of the mark by Rojas Roger by an agreement dated July 7, 2003, to which this Applicant has raised evidentiary objection and which eventually developed into a full-fledged assignment which is supported by the agreement dated October 5, 2004. It is based on this assignment the Opposer has filed this opposition.

### **4. Status of the Opposer when the cause of action arose.**

The cause of action for filing the opposition arose when the application of this Applicant for the registration of his trade mark 'Message in a Bottle' was put for opposition in the official gazette. The Opposer has stated in its notice of opposition filed on 10/21/2004 on page 1 that 'Opposer timely filed with the Trademark Trial & Appeal Board a request for extension of the time for filing a notice of opposition, and on August 27, 2004 the Trademark Trial & Appeal Board granted to Opposer an extension of time until October 27, 2004.' And on October 21, 2004 the opposition was filed.

The latest of the date on which knowledge of the pending application for the mark 'Message in a Bottle' by this Applicant that could be attributed to the Opposer is August 24, 2004 when it approached the Board for an extension of time to file the opposition, the earliest being the filing date of the application by this Applicant.

Hence it is submitted that at the time the cause of action arose, the Opposer did not have any right under which he could challenge this application. The right to challenge this application was obtained by the Opposer only on October 5, 2004 when the assignment of Servicemark was executed by Rojas Roger in its favor which is a date subsequent to the date of cause of action.

Moreover, Gold Shells Inc. was not incorporated at the time of filing of the application by this Applicant which was on March 25, 2003. Hence it is humbly submitted that the Opposer who has its existence derived from the Articles of Incorporation which bears a date subsequent to the filing date of this application and whose right to question this application accrued only on a date subsequent to that on which the cause of action arose, do not have a legal competency to question this application.

It is also submitted that the appropriate person who could have questioned this application at the time when the cause of action arose is Rojas Roger. The Opposer did not have any right to question this application even at the time it approached this Board for an extension of time to file the opposition. It is only on October 5, 2004 that the opposer was granted ownership over the servicemark 'Message In a Bottle'.

Hence based on the above mentioned arguments the applicant submits that the Opposer has no right to challenge this application.

**5. Fraud committed by the Opposer's predecessor with respect to the registration of his mark and evidence of continuing fraud by the Opposer.**

It was held in **Western Farmers Association v. Loblaw Inc., 180 USPQ 345, 347 (TTAB 1973)** that:

‘Proof of specific intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material representation that the applicant or registrant knew or should have known was false.’

And, in **Torres v. Cantine Torresella S.r.l., 808 F. 2d 46, 1 USPO 2d 1483, 1484 – 85 (Fed. Cir. 1986)** it was held that:

‘A trademark applicant commits fraud in procuring a registration when it makes material representations of fact in its declaration which it knows or should know to be false or misleading.’

It was held in **General Car and Truck Leasing Systems Inc. v. General Rent-a-car Inc. 17 USPO 2d 1398, 1401 (S.D. Fla. 1990) aff’g General Rent-a-car Inc. v. General Leaseways Inc., Canc. No. 14,870 (TTAB May 2, 1998)** which was subsequently reiterated in **Medinol Ltd. V. Neuro Vasx Inc., 67 USPO 2d 1205 (TTAB 2003)** that :

‘If fraud can be shown in the procurement of a registration, the entire resulting registration is void.’

The mark as obtained by the Opposer’s predecessor Rojas Roger is a servicemark ‘Message In a Bottle’ registered under International class 038 that reads ‘telecommunications’

Under **15 USC 1127**, ‘Service mark’, means any word, name, symbol or device or any combination thereof – (1) used by a person (2) which a person has a bonafide intention to use in commerce and applies to the register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if the source is unknown’ and

‘Trademark’ includes any word, name, symbol or device or any combination thereof – (1) used by a person (2) which a person has a bonafide intention to use in

commerce and applies to the register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, form those manufactured or sold by others and to indicate the source of the goods, even if the source is unknown.’

Hence both of these marks are inherently different. While a trademark is used to distinguish the goods and products of different persons, a servicemark is used to distinguish the services rendered by different persons. Trade mark is associated with tangible goods whereas service mark is used to refer to intangible services.

Now this Applicant would like to draw the attention of the Board to the wide categories to which the word ‘communication can be applied. In olden days, birds were used as a means of communication, messages being attached to their body. Messengers were used by kings to send and receive messages. These all instances can be covered under the wide connotation of the word ‘communication’. But ‘telecommunication’, which is one of the modes of communication, has a narrow meaning. Mathematically speaking it has the relationship of a ‘set’ and ‘subset’, ‘communication’ being the set and ‘telecommunication’ the subset. When we come to reasoning principles, it is like: All ‘telecommunications’ are ‘communication’ but not vice versa. The expansion of business by the Opposer to the wide area of ‘communication’ with adequate knowledge cannot in anyway be justified.

Also, **47 USC 153 (43)** defines ‘telecommunication’ as the transmission between or among points specified by the user, of information of the user’s choosing, without the change in form or content of the information sent and received.

Hence, according to this definition of telecommunication, the message or information is transmitted without any change in the form or content of the information sent and received. However, in the case of the Opposer’s business there is a definite change in the form of information. The information (messages) received through various means are consolidated into printed or written form and is sent to the intended recipients

in bottles. The under mentioned arguments would enlighten the Board as to how the Opposer achieved this by defrauding the PTO.

Oxford dictionary defines telecommunication as ‘communication over a distance by cable, telegraph, telephone or broadcasting’.

West’s encyclopedia of American law defines telecommunication as ‘the science and technology of communication at a distance by electronic transmission of impulses, as by telegraph, cable, telephone, radio or television’.

It is submitted that no use of any tangible goods is made in the transmission of messages throughout these definitions. However, the use of tangible goods as advertising materials of the service could have been excusable. But the Opposer has made use of tangible goods as the main component of his business which is highly unacceptable and thus not at all to be overlooked. Since the use of tangible goods is the main and dominating component of the Opposer’s business, the Applicant would rather call the mark as purportedly possessed by the Opposer as a Trademark rather than a Servicemark. The remnants of this service mark still alive, the mark has transformed itself into a Trademark with the use of it in tangible items that is the main component of the business and which are used in conveying messages.

May it also be noted that the initial recital of services was as follows:, namely the telephonic, electronic, or mail receiving of text, the recording of text utilizing print media, and arrangement for delivery of the recorded text to others. Exhibit C & D Rojas Depo. How this delivery could be achieved, is not stated by this Opposer.

The applicant humbly submits the fact which contributed to the development of the service mark of the Opposer to his trademark in the words of the Opposer itself as stated in the brief.

On page 11 para F, “Opposer holds 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 registration showing the Section 8 and 15 filings and the tilte in Opposer is attached to Opposer’s Notice of Reliance herein. See also Rojas Depo 9:9 – 11:1. 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. This 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 service are, “receiving communications from others, recording such communication in written and 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 in Exhibit E thereto. Rojas filed Section 8 and 15 afffidavits 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.”

As contrary to what is stated in the brief, Class 38 always had read as ‘telecommunication’ and never has it read as ‘communication’ also what the Opposer must have used in commerce is the Service mark and not the Trademark.

Again, on Page 17 Para 1 of the Brief, the Opposer has stated thus: “Opposer user its service mark for services in connection with the sale of goods (excluding kits) described in Applicant’s application. Opposer’s services involve 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.”

On Page 18 of the brief it is stated thus: “Opposer’s principal has testified that Opposer carries out the services described in its registration by using novelty, favor and souvenir bottles containing greetings, invitations, and promotional materials. Rojas Depo. 53:13 – 23. This, the services recited in the 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 goods and devices in the rendering of Opposer’s services. Rojas Depo. 24: 19 – 25, 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. ”

The abovementioned is the most crucial statement in the brief which clearly manifest the intention, malice and action to constitute fraud. Hence this Applicant allege that the Opposer has committed fraud with utmost knowledge of it.

In Opposer’s response to applicant’s request for admissions, Exhibit J, attached to Applicant’s notice of reliance filed on 05/27/2008, the Opposer is found to admit to Request No. 12 which is as follows: ‘Registrant did not disclose to United States Patent & Trademark Office in application serial No. 75226521, that goods and/or services offered there under would also include ‘novelty, favor and souvenir bottles containing messages and greetings.’

The Applicant humbly submit the fact that a written application must specify the particular goods or services on or in connection with which the applicant uses, or has a bonafide intention to use, the mark in commerce. **15 USC 1051 (a) (2) & 15 USC 1051 (b) (2), 27 CFR 2.32 (a) (6).**

Moreover, **In re Societe Generale des Ruax Minerales de Vittel S.A., 1 USPO 2d 1296 (TTAB 1986)**, it was held thus:

‘The identification of goods or services must be specific, definite, clear, accurate and concise.’

Further it is also submitted that ‘The accuracy of identification language in the original application is important because the identification cannot later be expanded.’ **37 CFR 2.71 (a) 1402.06 & 1402.07 et seq; In re M.V. Et Associes 21 USPO 2d 1628 (Commr. Pats. 1991)**

Further, the Opposer has also admitted in Request No. 5 in the above Exhibit that ‘the Opposer is currently making use in commerce of the Message In a Bottle Trademark.’ Also, the Opposer has admitted to Request No. 11 which is thus, ‘Opposer is an exclusive assignee of the Trademark registration.’

Please note the fact that the Opposer is not an assignee of the trademark as stated but only of the servicemark registration of mark ‘Message In a bottle’.

Also, kindly note the fact that both of the parties are not using their Trademarks as stated in the brief. While the Opposer is purported and should be using his Servicemark in business, the Applicant is rightfully using the mark as a Trademark in his business for which application for registration is filed under International Class 16.

Right from the inception, the business of the opposer was extraneous to telecommunication. Exhibit K which is a specimen enclosed under statement of use filed under 37 CFR 2.88 as submitted by Rojas Roger together with his testimony deposition dated April 18, 2008 which reads as follows speaks for itself.

‘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 handwritten form, insert it in a bottle, and transmit it for you. To receive our service visit our website at [www.messageinabottle.com](http://www.messageinabottle.com) and fill out the order form.’

It is humbly submitted before the Board that transmission of messages in bottles in beautifully handwritten form cannot in anyway be termed as telecommunication business as is claimed by the opposer and hence this sort of business cannot claim the protection of constructive use related priority rights based on the intent to use service mark application under International class 038.

The service mark granted under International class 038 granted to Rojas Roger which is subsequently assigned to the Opposer is yet to be used in commerce in its true

sense. The business of the Opposer cannot be said to confine itself to the boundaries of a service mark registration which include intangible services rendered but has right from inception encroached upon the field of trademarks which include goods and materials that are tangible. The medium through which messages are conveyed are tangible things which is extraneous to the acceptable definitions of the word 'telecommunication' and this business is the subject of the opposition. Moreover, in the case of the Opposer, the earning of revenue, which is the core of every business, is achieved through the conveyance of tangible goods, hence making the delivery of tangible goods the main component of business, and that is highly unacceptable when the registration is granted under Class 038.

Applicant is thoroughly convinced of the fraudulent intention on part of the Opposer and its predecessor to deceive PTO based on the explicit submission of the abovementioned facts in the brief by the Opposer and ancillary evidence produced by the Applicant and thus most humbly pray to the Board not to overlook these facts in coming to a conclusion with regard to fraud committed by the Opposer on the PTO.

**D. Applicants reply to the brief filed by the Opposer: Priority rights and likelihood of confusion discussed:**

The Opposer in his brief has challenged this application under Section **2 (d), 7 (b) and 7 (c)** of the Lanham Act. Section 2(d) protection envisages that the mark is not abandoned by the registrant.

The first point to be argued in this behalf is that the servicemark of 'Message In a Bottle' granted to the Opposer under class 38 which read 'telecommunication' has not been, at any point of time, used in business which could properly be classified as been covered under class 38. All the abovementioned arguments support the view how the servicemark has been unlawfully used to market tangible goods and thus earn revenue from the delivery of these goods. Hence the inference the applicant draw is that the service mark 'Message In a Bottle' is abandoned by the Opposer. whereas the Opposer

and its predecessor has succeeded in making the PTO believe that they do business in service sector, they have most fraudulently encroached the tangible sector with goods and devices serving as the modes of communication. Hence in the eyes of PTO, and hence theoretically the service mark has survived whereas practically and factually the Opposer has literally abandoned the use of his registered mark as a service mark. The mark which it now purports to use is a Trademark 'Message In a Bottle' to which the Opposer has no title. Here the Opposer comes into direct conflict with the Applicant who claims the use of the mark in commerce ever since its first use on March 10, 1998. The earliest of the date to which the Opposer could relate his claim to this mark as a Trademark is January 16, 1999, the date on which this mark was introduced by the Opposer for the first time in commerce.

**In Barbara Bakery Inc. V. Lendesman 82 USPO 2d 1283 (TTAB 2007)** held:

'We first turn to opposer's Sec 2 (d) opposition. To prevail on such ground opposer must prove ownership of a registration and/or priority of use, and likelihood of confusion.'

Taking this case of opposition what the Opposer has tried to prove is the ownership of the servicemark registration and not the trademark registration. However, the business of the Opposer could very well be contained within the domain of the trademark rather than going in search of pitfalls and unsolicited explanations to fill up lacunas created by the quantum of deviation of the business of the Opposer from the field of servicemark sector. The natural outcome being that the Opposer has so miserably failed to prove the ownership of a trademark registration with respect to the mark 'Message In a Bottle' but has most successfully proved the registration and ownership of the servicemark 'Message In a Bottle'. Moreover, the earliest of the date to which the Opposer could relate his claim to this trademark is January 16, 1999, the day it was introduced in commerce for the first time which is alas, more or less an year after the claimed first use of it in commerce by this Applicant. Hence the Opposer has pathetically failed to state his priority claims to the Trademark. Hence both the Applicant and the Opposer are placed in the same position with respect to the Trademark 'Message In a Bottle', the Applicant being in a better position that he has filed an application for getting

this Trademark registered to which the Opposer has filed this Opposition. Going by the common law rights that the first user in commerce gets priority to the mark, this Applicant has got undisputed priority rights to the trademark 'Message In a bottle'.

Coming to the next component, that is likelihood of confusion, the Opposer, in its brief, has relied upon six of the Dupont factors as relevant in the present case which are as follows :

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, the original dupont factor being the conditions under which the buyers to whom sales are made.
5. The evidence of actual confusion, the original dupont factor being the nature and extent of actual confusion.
6. The direct market interface between parties, the original dupont factor being the market interface between applicant and owner of the prior mark.

This Applicant would like to examine the dupont factors in its entirety. Likelihood of confusion, is determined on the basis of a thirteen point factor which was established in **In re E. I. Du Pont De Nemours & Co., 476 F. 2d, 177 USPQ 563 (CCPA 1973)**. The Applicant enumerates his argument on these factors for the kind consideration of this Board.

1. **Comparison of the Marks**: The first Du pont factor requires to determine the similarity or dissimilarity of the marks when viewed in their entirety in terms of appearances, sound, connotation and commercial impression.

This applicant most penitently succumb to the concrete fact that the servicemark of the Opposer and the Trademark of the Applicant are not only confusingly similar but exactly similar as is constituted by the same set of words 'Message In a Bottle'. The confession of this Applicant is only in relation to this similarity and nothing more. Knowledge of this

similarity could be very well attributed to this Applicant but not any fraudulent intention or intent to deceive or confuse as is alleged in Pages 26 – 27 with the support of Exhibit U attached to Rojas Depo. 43:11 – 22, which is an email this Applicant sent to the Opposer.

2. **Comparison of goods and trade channels**: The second du pont factor requires to determine the similarity or dissimilarity of goods and third du pont factor requires to consider the similarity or dissimilarity of the trade channels for the goods.

**In re Continental Graphics Corp., 52 USPO 2d 1374, 1377 (TTAB 1999)** it was held that : ‘ The determination of relationship between the goods and services must be made on the basis of identification in the application and registration.’

The Opposer’s services were registered under International Class 038 which included only telecommunication services without the mention of any goods. This Applicant has filed the application for registration of the mark under International Class 16 which comprises a set of goods. It is humbly submitted that the Opposer’s goods as is alleged by the Opposer to be in use in the Opposer’s business is neither identified in the application which the Opposer made to PTO nor in the registration that resulted from the application. Hence going by the lawful circumstances it is not possible for a comparison to be initiated between the Applicant’s and the Opposer’s goods/ services. But the factual circumstances which are the result of fraud of the Opposer easily do facilitate a comparison between the goods of the Opposer and this Applicant.

In **Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaish 77 USPO 2d 1917 ( TTAB 2006)** it was held:

‘We turn to the question of whether the applicant’s goods and Opposer’s goods are sufficiently related and/or whether the circumstances surrounding the marketing of the goods are such that the purchasers encountering them could, in view of similarity of the mark, mistakenly believe that the goods emanate from the same source. Even if the marks are identical, if these conditions do not exist, confusion is not likely to occur.’

It is submitted that the first and only advertisement that is produced with respect to this mark is Exhibit U filed along with Applicant's Notice of Reliance dated 05/14/2009. This advertisement is published in a daily newspaper, the Orange County Register( Accent on April4, 1999 which has a wide circulation in the area where the Opposer and the Applicant carry on their businesses. Hence it is probable that the general public would associate Dreamweaver Studios which is owned by this Applicant to the business of conveying messages in bottles rather than to the Opposer. The Opposer has not produced any evidence of advertisement of his business to the general public which would create a general vision of associating this kind of business to the Opposer in the minds of the public.

While effort of comparison of goods has to be initiated, the tedious task this Applicant encounter is the proven factual shift of the servicemark to the trademarked area. The unexplainably exaggerated usage of this servicemark by the Opposer has camouflaged this servicemark again into a trademark with lots of tangible goods, mainly bottles containing messages, the inevitable result being the numerous similarities of the goods and trade channels of the Applicant and the Opposer. Had the Opposer limited his business within the lawful limits of class 38, this dilemma could very well have been avoided. Since Applicant has priority rights on the Trademark 'Message In a Bottle' as is argued in the aforementioned arguments, it must be assumed that it is the goods of the Opposer that is confusingly similar to that of the Applicant's and also, there is the overlapping of trade channels of the Applicant and the Opposer.

Moreover, it is also stated by this Applicant that internet is only one of the channels through which business is acquired by the Applicant. He has other means to acquire business. i.e. the Applicant is not solely dependant on internet for the acquisition of business to call it primarily internet based. The main part of his business is sending messages enclosed in bottles to the intended recipients. This is the process which earns revenue for the applicant. The same factor could be asserted as the revenue earner of the

Opposer also. His business being under class 38, the earning of revenue which is the core of every business through the conveyance of tangible goods is totally unacceptable.

Hence it is submitted that the opposer, had it been conducting its business under class 38 lawfully, would never have encroached into the channels of the applicant as has happened here. The result would have been that both the parties would have been operating in entirely different channels. The Opposer would have been associated with the sale of telecommunication services while the Applicant, with those of tangible goods.

3. **Condition of purchase**: the fourth du pont factor requires to consider evidence pertaining to the buyer to whom and the conditions under which the goods are marketed: The narration as to the classes of consumers to whom products are sold is not disputed by this applicant. However this Applicant would like to add that the mode of intended reception of messages would depend upon the customer's mental concept. Those who want to use telecommunication mode can get their messages delivered through this mode by contacting the Opposer and those who prefer conveyance of messages through tangible modes could approach the applicant for that. The mode of delivery of the messages could have been entirely different had the Opposer adhered to the lawfully allotted sphere.

4. **Evidence of the fame of the mark**: The Opposer has not submitted any authoritative evidence to prove that its mark was famous.

A famous mark is defined as in **Bose Corp v. OSC Audio Products Inc., 293 F. 3d 1367, 63 USPO 2d 1303 (Fed. Cir. 2002)**

‘A famous mark is one “with extensive public recognition and renown.” ’

Nowhere in the brief it is claimed by the Opposer that its mark is one with extensive public recognition and renown.

5. **Third Party marks**: This du pont factor pertains to the relevancy of evidence submitted as to the number and nature of similar marks in use on similar goods or

services. Answer to Interrogatory No. 11 and Exhibit A attached to the Opposer's response to Applicant's first set of interrogatories produced by the Applicant by way of Notice of Reliance filed on 05/27/2008 clearly depicts the presence of a number of internet websites conducting the same business as that conducted by the Opposer other than this Applicant.

**Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772, 73 USPQ 2d at 1694 (Fed. Cir. 2005)**, it was held that: 'The purpose of a defendant introducing third party uses is to show customers has become so conditioned by a plethora of such similar marks that customers have been educated to distinguish between different such marks on the basis of minute distinctions.'

Exhibit V, filed with Rojas Deposition, which is the 2006 version of the Opposer's website has the following message added to it: 'Look for our signature "Gold Shells from Carmel" logo to ensure it is a real Message In a Bottle ®'

Hence it should be presumed that at least the Opposer has taken precaution to educate its customers as to distinguish between similar marks.

6. **Actual confusion**: The seventh du pont factor considers evidence pertaining to the nature and extent of actual confusion which has resulted from the parties use of their marks and the eighth du pont factor requires to consider evidence pertaining to the length of the time during and the conditions under which there has been actual contemporaneous use without actual confusion.

It is humbly stated that actual confusion, if any, would have arisen only after January 16, 1999, which is the date when the Opposer used his purported service mark in commerce. The Applicant would rather call it a Trademark as the medium of usage of the mark (i.e., the use of goods) fit well into the definition of Trademark rather than a Servicemark. Until then, after his first use of the Trademark in commerce on March 10, 1998, the Applicant was dealing in his goods without any element of actual confusion

involved. After the entry of the Opposer in the same sphere with similar goods, it is this Applicant who may have actually faced the confusion factor which is disputed till now. During the period ranging from March 10, 1998 to January 16, 1999 there was no confusion factor in existence as the Opposer had not launched his business in the area dominated by the Applicant.

In **Gillette Canada Inc. v. Ranir, 23 USPQ 2d 1768 (TTAB 1992)** it was held: ‘The absence of evidence of significant actual confusion largely might be explained by the fact that there has not been any significant opportunity for actual confusion to have occurred.’

7. **Market Interface between the parties:** The entry of the Opposer into the Applicant’s area of business has brought both the parties into direct competition with each other. Had the Opposer confined his business to ‘telecommunication’ services, the situation could have been different. The Opposer would not have faced any competition from this Applicant.

8. **The extent to which Applicant has a right to exclude others from use of its mark on its goods and the extent of potential confusion:** This could be argued in the light of the above mentioned arguments. This Applicant has already stated that it is the servicemark ‘Message In a Bottle’ which is camouflaged as a Trademark. This servicemark has not been used in commerce in its true sense by the Opposer ever since the application was filed for it in January 6, 1997 which subsequently developed into registration on May 4, 1999. Hence this Applicant argues that this servicemark which could have been darned with telecommunication services bears a status as close to an abandoned mark in as much as it is dead for its substance and purpose of registration but the skeleton of the mark which is a set of words ‘Message in a Bottle’ even now exist within the sphere of Trademarks with numerous tangible goods and devices as medium of communication. Hence this Applicant has an explicit right to exclude this Opposer from entering the arena of similar goods as those that are marketed by this Applicant which cannot be overlooked. The extent of potential confusion arising from the encroachment of

the Opposer into the business field of the Applicant with a set of similar goods is highly substantial.

9. **Any other established fact probative of the effect of use:** The Applicant has stated fraud of the Opposer in the aforementioned arguments which would have a probative value in coming to a decision in this case. It is stated in Para C at page 23 of the brief, that applicants use and registration of the trademark may disparage Opposer's mark and falsely imply a connection with Opposer. May the Board note the following facts for its kind consideration. The Opposer's predecessor Rojas Roger is a person who has used its mark in association with the goods as aforementioned commercially only from Jan 16, 1999 where as the applicant is a person who has continuously used the mark with respect to his goods falling under Class 16 since its first use in commerce on Mar 10, 1998. Hence the chance is in favor of this applicant that the general public would have associated the proposed mark and the goods delivered with the applicant rather than the Roger who joined the bandwagon a year after.

Moreover the services of Rojas Rojer was registered under the class 38 which would have nothing to do with the business of the applicant. However knowledge can be imparted to Roger that seeing the scope of this flourishing business of the applicant, Roger deliberately entered into this field with similar goods. Hence it could be aptly concluded that, Roger most fraudulently entered into the sphere of business which was started on a small scale by this applicant and which was in the incumbent stage with slowly gaining popularity, invested in it and gradually snatched it in its entirety from this Applicant. Hence the origin of the business was crushed most treacherously. And hence this Applicant is now before this Board for the protection of his business which is entirely a creation of his own. Roger never did question the use of the mark by the Applicant even if he had knowledge of it. This situation continued until the applicant approached the Board for the protection of his business through a Trademark application. Even at this juncture, Roger waited, got permission of the Board for a time extension to file the opposition, assigned his mark entirely to the Opposer and the Opposer is now questioning this application. The inference that this applicant draws in his mind is that since a

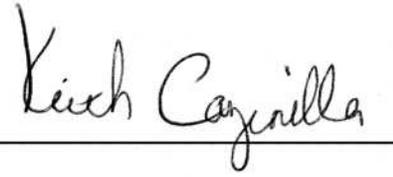
corporation is more powerful than an individual it could very well stand this proceedings while Roger as a person would have easily succumbed to it. Hence Roger as a person is taking recourse under the veil of the incorporation for his own fraudulent, mean and most treacherous purposes. Rojas has adequate knowledge that the applicant is a small scale businessman and cannot stand the aura of an incorporation.

Hence the applicant humbly pray that the Hon'ble Board come to its rescue. The truth is that Opposers business has so flourished within the period of pendency of these proceedings, with the Opposer most recently changing its name to MESSEAGE IN A BOTTLE INC. Hence this applicant is before the consideration of this Hon'ble Board for the grave injustice done to it.

### III. CONCLUSION

The Opposer has most fraudulently encroached on the business sphere of the applicant without any back up licence (as this is the area of trademarks and the opposer is the owner of only a service mark). Based on the above arguments the Applicant humbly conclude that the condition of the Opposer is no better than the Applicant. However the Applicant stands in a better position that he has applied for the trademark for the protection of his business but the Opposer has failed to do so and has fraudulently used his service mark to illegally encroach the areas that only a trademark could do with profit motives. This Applicant is before the consideration of this Hon'ble Board for the grave injustice done to it by the Opposer. This Applicant is also harmed by the fraudulent conduct of the Opposer in the business field. The intent to defraud the PTO and the Board by the Opposer is also manifest. Hence it is humbly prayed that the application of this Applicant for the trademark 'Message In a Bottle' be allowed. The petition to cancel the registration of the Opposer will be filed during the assigned time.

Respectfully submitted,

A handwritten signature in cursive script that reads "Keith Cangiarella". The signature is written in black ink and is positioned above a solid horizontal line.

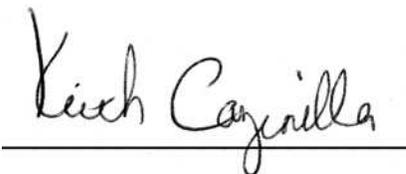
Keith Cangiarella

Date : November 25, 2009

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing applicant Keith Cangiarella as defendant in the opposition was mailed first – class mail, postage prepaid, to Peter H Smith, Attorney for the Opposer, MESSAGE IN A BOTTLE INC., 3436 Beckwith Road, Modesto, CA 65358, on November 25, 2009.

Dated : November 25, 2009.

A handwritten signature in cursive script that reads "Keith Cangiarella". The signature is written in black ink and is positioned above a solid horizontal line.

Keith Cangiarella