

ESTTA Tracking number: **ESTTA50843**

Filing date: **10/27/2005**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Ms. Anita Dhaliwal		
<b>Entity</b>	Individual	<b>Citizenship</b>	UNITED STATES
<b>Address</b>	8502 E Chapman#306 Orange, CA 92869 UNITED STATES		

<b>Attorney information</b>	R. Joseph Trojan Trojan Law Offices 9250 Wilshire Blvd Suite 325 Beverly Hills, CA 90212 UNITED STATES trojan@trojanlawoffices.com Phone: 310-777-8399		
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#### Applicant Information

<b>Application No</b>	78495856	<b>Publication date</b>	09/27/2005
<b>Opposition Filing Date</b>	10/27/2005	<b>Opposition Period Ends</b>	10/27/2005
<b>Applicant</b>	DVD WORLD Pictures Corp. 63 McGaw Ave. Lake Grove, NY 11755 UNITED STATES		

#### Goods/Services Affected by Opposition

Class 035. First Use: 19970514First Use In Commerce: 19981119  
All goods and services in the class are opposed, namely: Online Retail store services and distributorships of DVD movies

Class 041. First Use: 19970514First Use In Commerce: 19981119  
All goods and services in the class are opposed, namely: Motion Picture Production and Distribution

<b>Attachments</b>	Opposition.pdf ( 6 pages )
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<b>Signature</b>	/yewon min/
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<b>Name</b>	YeWon Min
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<b>Date</b>	10/27/2005
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On information and belief, Application Serial No. 78495856 for DVD WORLD for Online Retail store services and distributorships of DVD movies in International Class 35 and Motion Picture Production and Distribution in International Class 41 was filed on October 6, 2004 by DVD WORLD Pictures Corp., a New York corporation with a place of business at 63 McGaw Ave. Lake Grove, New York 11755.

As grounds for opposition, Opposer alleges that:

1. Since at least as early as November 29, 2004, Opposer has owned the domain name DVD WORLD in connection with the sale of DVDs.

2. As Opposer is the owner of the domain name [www.dvdworld.com](http://www.dvdworld.com), Opposer will be damaged by the issuance of a registration for DVD WORLD to Applicant as sought in Application Serial No. 78495856. Opposer opposes the registration of the mark based on the following grounds:

**I. First Cause for Opposition: The Mark Is Not Distinctive and Applicant Does Not Have Exclusive Rights to the Mark**

3. There are at least 114 other persons who are using the alleged mark DVD WORLD in conjunction with the sale of DVDS.

4. Given the widespread use of the mark in conjunction with the sale of DVDs, the alleged mark DVD WORLD is not distinctive and does not serve any single source identification function in any manner whatsoever in light of the widespread use of the term in connection with the sale of DVDs. Accordingly, Applicant does not have exclusive rights to DVD WORLD.

5. Accordingly, Opposer states that Applicant is not entitled to Federal registration of its alleged mark in that the alleged mark is not distinctive and cannot serve as a source identifier.

**II. Second Cause for Opposition:**

**Fraud—Non-Use of Mark in Connection with Claimed Scope of Services**

6. Opposer re-alleges paragraphs 1-5 as if they were stated in full herein.

7. Upon information and belief, Applicant is not using the mark DVD WORLD in connection with Motion Picture Production and Distribution in International Class 41, as stated in Applicant's Amendment to Allege Use filed with the Patent and Trademark Office.

8. Applicant's knowledge of the falsity in its Application and Declaration submitted to the Patent and Trademark Office regarding the scope of services constitutes fraud.

9. Accordingly, Applicant is not entitled to Federal registration of its alleged mark in International Class 41.

**III. Third Cause for Opposition:**

**Lack of Use as a Mark Prior to Registration**

10. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 9, inclusive, as if they had been fully restated herewith.

11. Applicant is not using the alleged mark DVD WORLD as a trademark.

12. Even in the Amendment to Allege Use filed by Applicant with the Patent and Trademark Office, Applicant admits that its name is THE DVD WORLD COMPANY.

13. The specimen submitted by Applicant fails to show use of DVD WORLD as a trademark.

14. Applicant uses the marks DVD DESTINATION, DVD WORLD ONLINE, DVD WORLD PICTURES CORP. and/or THE DVD WORLD COMPANY as source identifier(s), not DVD WORLD.

15. In view of the above, Applicant is not entitled to Federal registration of its alleged mark in that Applicant's proposed use is likely to cause confusion, or to cause mistake, or to deceive.

#### **IV. Fourth Cause of Opposition:**

##### **Misuse of the ® Notice**

16. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 14, inclusive, as if they had been fully restated herewith.

17. Applicant has misused the ® Notice by using it in conjunction with the alleged mark DVD WORLD prior to registration by unlawfully attaching the ® mark to all mention of the words "DVD world" on Applicant's website.

18. Accordingly, Applicant is not entitled to Federal registration of the alleged mark in that Applicant has misused the ® notice in violation of 15 U.S.C. § 1111.

**V. Fifth Cause of Opposition:**

**Failure to Disclaim**

19. Opposer hereby incorporates by reference the allegations contained in paragraphs 1 through 18, inclusive, as if they had been fully restated herewith.

20. Applicant seeks to register the alleged mark DVD WORLD in connection with Online Retail store services and distributorships of DVD movies in International Class 35 and Motion Picture Production and Distribution in International Class 41.

21. The word "DVD" is merely descriptive of Applicant's services and must be disclaimed.

22. Applicant has failed to disclaim "DVD" from its application for registration of the alleged mark.

23. Accordingly, Applicant is not entitled to Federal registration of the alleged mark.

**VI. Conclusion**

For the foregoing reasons, Opposer respectfully requests that Application Serial No. 78495856 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

This Notice of Opposition is being submitted pursuant to 37 C.F.R. §§2.101-12.107. The appropriate fee under 37 C.F.R. §2.6 is also submitted herewith. Please direct all future correspondence to the undersigned.

Respectfully submitted,

Opposer Anita Dhaliwal

By:

Date: October 27, 2005

A handwritten signature in cursive script, appearing to read "YeWon Min", is written over a horizontal line.

B. Joseph Trojan

YeWon Min

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