

ESTTA Tracking number: **ESTTA56452**

Filing date: **12/07/2005**

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

Name	Eckerd Corporation
Granted to Date of previous extension	12/07/2005
Address	50 Service Avenue Warwick, RI 02866 UNITED STATES

Attorney information	Helen Hill Minsker Banner & Witcoff, Ltd 1001 G Street, NW Washington, DC 20001 UNITED STATES BWPTOTM@bannerwitcoff.com Phone:202-824-3000
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### Applicant Information

Application No	78483094	Publication date	08/09/2005
Opposition Filing Date	12/07/2005	Opposition Period Ends	12/07/2005
Applicant	Dan-Dee International, Ltd. 106 Harbor Drive Jersey City, NJ 07065 UNITED STATES		

### Goods/Services Affected by Opposition

Class 028. First Use: 1988/06/01 First Use In Commerce: 1988/06/01  
All goods and services in the class are opposed, namely: STUFFED TOYS

Attachments	HUMFREY Opp.pdf ( 4 pages )
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Signature	/helen hill minsker/
Name	Helen Hill Minsker
Date	12/07/2005

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

In the Matter of Trademark Applicant )  
Dan-Dee International, Ltd. )  
Mark: HUMFREY )  
Serial No.: 78/483094 )  
Filed: September 14, 2004 )  
Published in the Official Gazette dated August 9, 2005 )

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ECKERD CORPORATION, )  
Opposer, )  
vs. )  
DAN-DEE INTERNATIONAL, LTD., )  
Applicant. )

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Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Sir:

Opposer, Eckerd Corporation (“Eckerd”), whose address is 50 Service Road, Warwick, Rhode Island 02866, believes it will be damaged by registration of the above-identified mark and hereby opposes the same.

The grounds for the opposition are as follows:

1. Eckerd owns and operates a large, well-known chain of retail drugstores in a number of states in the United States under the mark ECKERD. In connection with its retail drug store operations, Eckerd contracts with various manufacturers to produce merchandise exclusively for sale in Eckerd stores.

2. At least as early as 1987, Eckerd contracted with Applicant (“Dan-Dee”) to produce a holiday bear on Eckerd’s behalf for sale exclusively in Eckerd’s retail drug stores.

3. Dan-Dee manufactured the bear to Eckerd’s specifications and the mark HUMFREY was selected as the trademark for the bear.

4. The Eckerd HUMFREY bear is a collectable bear, and for each year since 1987, Eckerd has contracted with Dan-Dee to produce a new version of the HUMFREY bear to Eckerd’s specifications.

5. Since 1987, the Eckerd HUMFREY bear has been manufactured exclusively for Eckerd and sold exclusively through Eckerd stores, or via websites with links to Eckerd.

6. Since 1987, Eckerd’s sales of the HUMFREY bear have been substantial, and Eckerd has expended significant sums in advertising the HUMFREY bear.

7. As a result of Eckerd’s long, continuous and exclusive use of the HUMFREY trademark, as well as its substantial sales and promotion efforts, Eckerd has developed substantial goodwill in its HUMFREY mark, and the public has come to associate the mark HUMFREY with the annual holiday bear offered by Eckerd.

8. Further, as a result of Eckerd’s efforts, the HUMFREY mark has become well known and famous among purchasers as a distinctive indicator of origin.

**DAN-DEE IS NOT THE OWNER OF THE HUMFREY TRADEMARK**

9. Dan-Dee was and is the manufacturer of the HUMFREY bear, but it does not own the HUMFREY trademark. The HUMFREY trademark is owned by Eckerd. Dan-Dee’s application to register HUMFREY is void *ab initio* because Dan-Dee is not the owner of the mark and applied for registration of the mark in contravention of Section 1 of the Trademark Act, 15 U.S.C. §1051.

**DAN-DEE HAS MADE NO USE OF THE MARK HUMFREY**

10. Dan-Dee manufactures the HUMFREY bear exclusively for Eckerd, and all sales of the product to consumers have been made by Eckerd, through its Eckerd drug stores and website. Dan-Dee's application to register HUMFREY therefore is void *ab initio* because Dan-Dee has made no use of the mark HUMFREY in commerce, in contravention of its claim for registration pursuant to section 1(a) of the Trademark Act, 15 U.S.C. §1051(a).

**LIKELIHOOD OF CONFUSION – SECTION 2(D)**

11. Dan-Dee seeks to register the identical mark, HUMFREY, for the identical goods, stuffed toys, which is likely to cause confusion, mistake, or deception of purchasers within the meaning of Section 2(d) of the Trademark Act of 1946, as amended, all to Eckerd's grave and irreparable damage.

**DILUTION - SECTION 43(D)**

12. As a result of Eckerd's substantial sales and promotion efforts, the HUMFREY trademark has become well known and famous as a distinctive symbol of Eckerd.

13. The Eckerd HUMFREY mark became well known and famous well before Dan-Dee used or filed its application to register the mark HUMFREY.

14. Use or registration of the mark HUMFREY by Dan-Dee will cause dilution of the Eckerd HUMFREY mark, and will lessen the capacity of Eckerd's HUMFREY mark to identify and distinguish Eckerd's goods.

**ECKERD WILL BE DAMAGED BY REGISTRATION OF THE HUMFREY MARK BY DAN-DEE**

15. Registration of the mark HUMFREY by Dan-Dee will damage the goodwill Eckerd has in the HUMFREY mark, and will deprive Eckerd of its ability to protect the reputation and

goodwill associated with the mark.

16. If Dan-Dee is permitted to register the mark HUMFREY, the registration would give Dan-Dee a prima facie exclusive right to the use of the mark HUMFREY for stuffed animals. Such registration would damage and injure Eckerd.

17. For reasons set forth in this Notice of Opposition, Dan-Dee's registration of the mark HUMFREY will cause injury and damage to Eckerd's rights to the mark HUMFREY and to its use thereof described above.

WHEREFORE, Eckerd respectfully prays that the present opposition be sustained and that the registration sought by the Dan-Dee be refused.

Please charge the statutory fee of \$300 to our firm's deposit account, No. 19-0733. Please also charge any additional fees, or credit any overpayments, to our firm's deposit account, No. 19-0733.

Respectfully submitted,

BANNER & WITCOFF, LTD.  
Attorneys for Opposer

Date: December 7, 2005

By: \_\_\_\_\_



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