

ESTTA Tracking number: **ESTTA126060**

Filing date: **02/21/2007**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Barnes & Noble, Inc.
Granted to Date of previous extension	02/28/2007
Address	122 Fifth Avenue New York, NY 10011 UNITED STATES

Name	Barnes & Noble College Booksellers, Inc.		
Entity	Corporation	Citizenship	New York
Address	33 East 17th Street New York, NY 10003 UNITED STATES		

Name	barnesandnoble.com llc		
Entity	limited liability company	Citizenship	Delaware
Address	76 Ninth Avenue New York, NY 10011 UNITED STATES		

Attorney information	Todd Braverman, Esq. Bryan Cave LLP 1290 Avenue of the Americas New York, NY 10104 UNITED STATES nyuspto@bryancave.com Phone:212-541-2064
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Applicant Information

Application No	78742478	Publication date	10/31/2006
Opposition Filing Date	02/21/2007	Opposition Period Ends	02/28/2007
Applicant	The Madjo Company, LLC 2669 Einstein Drive Virginia Beach, VA 23456 UNITED STATES		

Goods/Services Affected by Opposition

Class 035.

All goods and services in the class are opposed, namely: Computerized on-line retail store services in the field of clothing and apparel; Electronic retailing services via computer featuring clothing and apparel; On-line retail store services featuring clothing and apparel

Attachments	me bn me opp.pdf (11 pages)(874519 bytes)
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Signature	/tjbraverman/
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Name	Todd Braverman, Esq.
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Date	02/21/2007
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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BARNES & NOBLE, INC.,	:	
BARNES & NOBLE COLLEGE BOOKSELLERS,	:	
INC. and barnesandnoble.com llc	:	Opposition No.
	:	Application Serial No. 78/742,478
	:	Mark: ME BN ME
	:	
Opposers,	:	
	:	
v.	:	
	:	
THE MADJO COMPANY, LLC,	:	
	:	
	:	
Applicant.	:	
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NOTICE OF OPPOSITION

Barnes & Noble, Inc., a Delaware corporation, having its principal place of business at 122 Fifth Avenue, New York, NY 10011 and its parents, licensors and affiliates, namely, Barnes & Noble College Booksellers, Inc., a New York corporation, located at 33 East 17th Street, New York, NY 10003 and barnesandnoble.com llc, a Delaware limited liability company, located at 76 Ninth Avenue, 11th Floor, New York, NY 10011 (jointly referred to as "the Opposer"), believes that it will be damaged by registration of the mark ME BN ME shown in Application Serial No. 78/742,478, which was filed on October 28, 2005, by The Madjo Company, LLC, a Virginia limited liability company, located at 2669 Einstein Drive, Virginia Beach, VA 23456 (the "Applicant"), and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946 (15 U.S.C. §1063).

As grounds of opposition, it is alleged that:

1. The Applicant seeks to register the mark "ME BN ME" for "computerized on-line retail store services in the field of clothing and apparel; electronic retailing services via computer featuring clothing and apparel; on-line retail store services featuring clothing and apparel," in International Class 35, as evidenced by the publication of said mark in the *Official Gazette* in the October 31, 2006 issue.

2. The Applicant, The Madjo Company, LLC, a Virginia limited liability company, located at 2669 Einstein Drive, Virginia Beach, VA 23456, filed the application for the mark "ME BN ME", on October 28, 2005, pursuant to Section 1(b) of the Lanham Act, 15 U.S.C. 1051.

3. The U.S. Patent and Trademark Office ("USPTO") assigned the application for the mark "ME BN ME" U.S. Trademark Application Serial No. 78/742,478.

4. Upon information and belief, on August 8, 2006, the Applicant filed an Amendment to Allege Use in connection with the mark "ME BN ME," U.S. Trademark Application Serial No. 78/742,478, claiming a date of first use of February 1, 2006 and a date of first use in commerce of March 15, 2006.

5. Opposer, through its predecessors and related companies has been and continues to be engaged in the sale of various goods and services, including but not limited to, retail store and online retail store services featuring books, DVDs, CDs, magazines, calendars, bags, stationery and clothing items in interstate commerce under the marks BARNES & NOBLE, B&N, BN.COM and BN, alone and with other terms, prior to October 28, 2005.

6. Long prior to October 28, 2005, Opposer, through its predecessors and/or related companies, has been, and continues to be, engaged in the marketing and sale of a variety

of goods and services under the marks BARNES & NOBLE, B&N, BN.COM and BN, alone and with other terms, including the retail sale of clothing and apparel products.

7. As a result of Opposer's long and extensive promotion, marketing and use of various BARNES & NOBLE, B&N, BN.COM and BN marks, including the retail sale of clothing and apparel products, Opposer has established and owns a family of "BN" marks (hereinafter, the "Family of BN Marks").

8. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,797,319 for the mark B&N for retail and online retail bookstore services, featuring, among other things, books, magazines, compact discs, audio and video cassettes, digital video discs, posters, food, beverages and general giftware items. The USPTO issued a registration for the mark on December 23, 2003 and the mark has been in continuous and exclusive use since March 1975. Said Federal Registration is valid and subsisting.

9. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 1,138,704 for the mark BARNES & NOBLE for book distributorship services and retail bookstore services. The USPTO issued a registration for the mark on August 12, 1980 and the mark has been in continuous and exclusive use since March 1975. Said Federal Registration is valid and subsisting and is now incontestable in accordance with Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b).

10. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,360,295 for the mark BN.COM BARNES & NOBLE DESIGN for online retail bookstore services, featuring, among other things, books, magazines, software and general giftware items; entertainment in the nature of providing online book reviews, interviews with authors, personal recommendations, gift ideas, and bestseller lists, all related to books,

magazines, and general giftware items; and computer services, namely providing a web site of information about software. The USPTO issued a registration for the mark on June 20, 2000 and the mark has been in continuous and exclusive use since April 26, 1999. Said Federal Registration is valid, subsisting and is now incontestable in accordance with Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b).

11. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,360,296 for the mark BN.COM for online retail bookstore services, featuring, among other things, books, magazines, software and general giftware items; entertainment in the nature of providing online book reviews, interviews with authors, personal recommendations, gift ideas, and bestseller lists, all related to books, magazines, and general giftware items; and computer services, namely providing a web site of information about software. The USPTO issued a registration for the mark on June 20, 2000 and the mark has been in continuous and exclusive use since April 26, 1999. Said Federal Registration is valid, subsisting and is now incontestable in accordance with Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b)..

12. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,290,269 for the mark BARNESANDNOBLE.COM for online retail bookstore services, featuring, among other things, books, magazines, software and general giftware items; entertainment in the nature of providing online book reviews, interviews with authors, personal recommendations, gift ideas, and bestseller lists, all related to books, magazines, and general giftware items; and computer services, namely providing a web site of information about software. The USPTO issued a registration for the mark on November 2, 1999 and the mark has been in continuous and exclusive use since May 13, 1997. Said Federal Registration is valid and

subsisting and is now incontestable in accordance with Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b).

13. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,463,172 for the mark BARNESANDNOBLE.COM & DESIGN for online retail bookstore services, featuring, among other things, books, magazines, software and general giftware items; entertainment in the nature of providing online book reviews, interviews with authors, personal recommendations, gift ideas, and bestseller lists, all related to books, magazines, and general giftware items; and computer services, namely providing a web site of information about software. The USPTO issued a registration for the mark on June 26, 2001 and the mark has been in continuous and exclusive use since May 13, 1997. Said Federal Registration, dated November 2, 1982, is valid and subsisting and is now incontestable in accordance with Section 33(b) of the Trademark Act, 15 U.S.C. § 1115(b).

14. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,832,365 for the mark BNTV for telecommunication services, namely, television broadcasting and webcasting via a global computer network and entertainment services, namely, television production, television programs, television show schedule programming, internet production, internet programs, internet show programming and audio/visual programs in the fields of books, book reviews, author interviews and entertainment, namely, music, videos, sports, comedy and variety via a global computer network; computer services, namely, providing a web site of information about books and related topics. The USPTO issued a registration for the mark on April 13, 2004 and the mark has been in continuous and exclusive use since June 27, 2000. Said Federal Registration is valid and subsisting..

15. Opposer is the owner, licensor or licensee of United States Service Mark Registration No. 2,632,807 for the mark B&N UNIVERSITY for educational services, namely, providing interactive educational classes, seminars, conferences, lectures and workshops in the fields of k-12, post-secondary, post-graduate, professional, vocational, workplace and continuing education and distributing course materials in connection therewith, via a global computer information network. The USPTO issued a registration for the mark on October 8, 2002 and the mark has been in continuous and exclusive use since June 27, 2000. Said Federal Registration is valid and subsisting.

16. In addition to the aforesaid registered marks, Opposer owns common law rights to numerous marks, the dominant portion of which are the designations "BN", "B&N" and/or "BARNES & NOBLE" including the following: B&N, B&N University, Barnes & Noble, Barnes & Noble Books, Barnes & Noble Books Better Books Better Prices, Barnes & Noble Booksellers, Barnes & Noble Classics, Barnes & Noble Hotspot, Barnes & Noble In Print, Barnes & Noble Jr., Barnes & Noble Membership, Barnes & Noble Television, Barnes & Noble University, Barnes & Noble Wireless Hotspot, Barnes & Noble World Digital Library, Barnes & Noble.com, Barnesandnoble.com, Barnsie, Barnsie The Noble Bear, bn.com , bn.com On The Go, BNTV, and The BN Top 100. These marks have been used in connection with the sale of products and the rendering of services, including the sale of clothing items.

17. Opposer frequently abbreviates the designation for BARNES & NOBLE as either B&N or BN in connection with the sale of products and the rendering of services.

18. Opposer owns numerous domain names incorporating the terms "BARNES & NOBLE, B&N and BN, including <bn.com>; <barnesandnoble.com>;

<barnesnoble.com>; and numerous variations that incorporate the "BN" designation, including domains names that incorporate typographical mistakes.

19. Opposer also uses BN.COM and BARNESANDNOBLE.COM as marks and domain names in connection with the operation of web sites that provide on-line shopping and information services. All of the domain names listed immediately above link directly to the BN.COM web site. Opposer actively promotes the <bn.com> web site to encourage potential Internet customers to visit the site and take advantage of its product and information offerings.

20. The wide variety of products and services promoted, sold, or offered for sale under Opposer's Family of "BN" marks have been commercially promoted, sold, and rendered throughout the United States by Opposer with skill and care. Opposer has expended large sums of money to maintain the quality of the products and services through the careful selection and careful methods used in the commercial promotion and sale of its goods and services under Opposer's Family of "BN" marks. As a result, the sales of goods and services under Opposer's family of "BN" marks have grown tremendously.

21. Opposer's family of "BN" marks have been, and are continuously being, applied to numerous and various products and services. Opposer uses these marks on labeling and/or packaging for products, as well as used in extensive nationwide advertising and promotional campaigns of Opposer's products, services, and businesses.

22. By reason of the extensive advertising, promotion and sale of Opposer's Family of "BN" products and services, the family of "BN" marks have acquired, and now enjoy, fame, distinctiveness, and substantial secondary meaning signifying Opposer's products and services. Opposer now owns valuable goodwill that is symbolized by the family of "BN" marks.

23. The Opposer and its predecessors in title have used the mark BN in various forms and iterations in commerce on or in connection with retail store services, since at least as early as _____.

24. Opposer has used and is now using its Family of "BN" marks in commerce on or in connection with the goods and services listed above. This use has been valid and continuous and has not been abandoned.

25. Applicant seeks to register the mark "ME BN ME" for use in connection with "computerized on-line retail store services in the field of clothing and apparel; electronic retailing services via computer featuring clothing and apparel; on-line retail store services featuring clothing and apparel," in International Class 35. There is no issue as to priority. Upon information and belief, Applicant has not made any use in interstate commerce or commerce with the United States of the mark "ME BN ME" in connection with the services identified in U.S. Application Serial No. 78/742,478 prior to February 1, 2006, which date is long after Opposer's date of first use in commerce of the mark BARNES & NOBLE, B&N and Family of "BN" marks.

26. Opposer, by virtue of its efforts, and the expenditure of considerable sums for advertising, marketing and promotional activities, and by virtue of the excellence of its products and services, has developed an exceedingly valuable goodwill and reputation with respect to its Family of "BN" marks.

27. Opposer's Family of "BN" marks, by virtue of Opposer's efforts in selling and distributing goods and services bearing such marks, and through Opposer's substantially exclusive and continuous use of such marks in commerce since March 1975, has become distinctive of the goods and services listed above.

28. Applicant's mark "ME BN ME" is confusingly similar in sound, appearance and/or meaning to Opposer's Family of "BN" marks because the dominant portion of the mark is "BN."

29. The "BN" within Applicant's mark is the phonetic equivalent to the "BN" and "B&N" in Opposer's Family of "BN" marks.

30. Opposer uses the "BN" designation in connection with various goods and services, including the sale of clothing and apparel.

31. Upon information and belief, Applicant uses the mark "ME BN ME" on and in connection with goods and services that are similar and related to those offered by Opposer under Opposer's Family of "BN" marks.

32. Upon information and belief, Applicant intends to offer and offers goods and services in whole or in part within the same channels of trade and to the same class of purchasers as Opposer.

33. Opposer believes and alleges that when Applicant uses "ME BN ME" in connection with the services listed in Application Serial No. 78/742,478, consumers are likely to believe that the services originate with, are sponsored by or affiliated with, Opposer.

34. Applicant's use and registration of the mark "ME BN ME" for the services identified in Application Serial No. 78/742,478 will enable Applicant to trade upon and utilize the goodwill established by Opposer in its Family of "BN" marks.

35. Opposer believes and alleges that Applicant's mark when used on or in connection with the services identified in Application Serial No. 78/742,478 is likely to cause confusion or mistake or to deceive and will deceive and mislead the public and/or potential

clients into believing that Applicant is licensed or controlled by Opposer or that Applicant is in some way related to Opposer.

36. If the Applicant is permitted to use and register its mark for its services, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of the similarity between the Applicant's mark and the Opposer's mark. Persons familiar with Opposer's marks would be likely to purchase or make use of Applicant's services thinking such services are related to Opposer's goods and services. Any such confusion in trade inevitably would result in loss of sales and business opportunities under the mistaken belief that such goods and services are offered by or connected with Opposer. Furthermore, any defect, objection or fault found with Applicant's goods marketed and performed under its mark "ME BN ME" would necessarily reflect upon and seriously injure the reputation that the Opposer has established for its products and services merchandised, sold and distributed under its Family of "BN" marks.

37. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer, as well as confusion in the relevant marketplace.

38. In view of the similarity in overall commercial impression of the respective marks, the related nature of the goods and services of the respective parties, and Opposer's priority as to use of the mark, Opposer alleges that Applicant's mark "ME BN ME" so resembles Opposer's Family of "BN" marks as to be likely to cause confusion, or mistake, or to deceive under Trademark Act Sections 2(d) and 43(a), 15 U.S.C. Sections 1052(d) and 1125(a), and will cause damage to Opposer and its goodwill represented by its prior-used marks.

39. In addition, Opposer's rights and fame in its Family of "BN" marks, including those based on its extensive use, registrations and public recognition, were established long before Applicant filed the application for "ME BN ME" or commenced use of the mark in commerce. Thus, granting registration to Applicant would diminish and dilute the distinctive quality of Opposer's rights in its family of famous "BN" marks in violation of Trademark Act Section 43(c), 15 U.S.C. Section 1125(c), and could also, in the event of any mishaps involving, or poor quality of, the services offered by Applicant, tarnish such distinctiveness.

WHEREFORE, the Opposer prays that the application Serial No. 78/742,478 be rejected, that the mark therein sought for the services therein specified in International Class 35 be denied and refused and that this opposition be sustained in favor of Opposer.

Opposer has enclosed the required filing fee of \$300 herewith.

Respectfully submitted,

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