

ESTTA Tracking number: **ESTTA142696**

Filing date: **05/25/2007**

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	In Touch Ministries, Inc.		
Entity	Corporation	Citizenship	Georgia
Address	3836 Dekalb Technology Parkway Atlanta, GA 30340 UNITED STATES		

Name	In Touch Foundation, Inc.		
Entity	Corporation	Citizenship	Georgia
Address	3836 Dekalb Technology Parkway Atlanta, GA 30340 UNITED STATES		

Attorney information	Courtney D. Jones Bird, Loechl, Brittain & McCants, LLC 3414 Peachtree Road NE 1150 Monarch Plaza Atlanta, GA 30326 UNITED STATES cjones@birdlawfirm.com Phone:404-264-9400		
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Applicant Information

Application No	78954926	Publication date	05/01/2007
Opposition Filing Date	05/25/2007	Opposition Period Ends	05/31/2007
Applicant	Brazile, Courtney R. 6832 Trailcrest Dr. Dallas, TX 75232 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Conducting workshops and seminars in personal awareness; Conducting workshops and seminars in biblical studies; Entertainment, namely live music concerts; Religious instruction services; Summer camps
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Grounds for Opposition

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1751621	Application Date	02/05/1992
Registration Date	02/09/1993	Foreign Priority Date	NONE
Word Mark	IN TOUCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1977/01/02 First Use In Commerce: 1977/01/02 production and distribution of religious radio and television programs		

U.S. Registration No.	1752942	Application Date	02/05/1992
Registration Date	02/16/1993	Foreign Priority Date	NONE
Word Mark	IN TOUCH MINISTRIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1980/04/00 First Use In Commerce: 1980/04/00 production and distribution of religious radio and television programs		

U.S. Registration No.	1332925	Application Date	01/11/1982
Registration Date	04/30/1985	Foreign Priority Date	NONE
Word Mark	IN TOUCH		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1977/01/00 First Use In Commerce: 1977/01/00 Pre-Recorded Audio and Video Cassettes Dealing with Religion Class 016. First use: First Use: 1973/06/25 First Use In Commerce: 1973/06/25 [BOOKS, PAMPHLETS AND] MAGAZINES DEALING WITH RELIGION Class 041. First use: First Use: 1977/01/02 First Use In Commerce: 1977/01/02 Series of Religious Radio and Television Programs		

U.S. Registration No.	2397345	Application Date	05/26/1999
Registration Date	10/24/2000	Foreign Priority Date	NONE
Word Mark	IN TOUCH FOUNDATION		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1993/05/26 First Use In Commerce: 1993/12/06 educational services, namely, conducting seminars in the field of biblical stewardship of financial resources, estate planning, and charitable giving, and distributing course materials in connection therewith		

Attachments	75714525#TMSN.gif (1 page)(bytes) InTouch.27.Opposition.ToTouchOneMinistries.pdf (8 pages)(115049 bytes)
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Signature	/CDJ/
Name	Courtney D. Jones
Date	05/25/2007

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

IN TOUCH MINISTRIES, INC. (F/K/A ITM, INC. DBA IN TOUCH MINISTRIES CORPORATION), and)	Opposition No. _____
)	
)	Application Serial No.
)	78/954926
IN TOUCH FOUNDATION, INC.)	
)	Mark: "TO TOUCH ONE MINISTRIES"
Opposers,)	
)	Published in the Official Gazette
V.)	on May 1, 2007
)	
COURTNEY R. BRAZILE,)	
)	
Applicant.)	
)	

**NOTICE OF OPPOSITION OF IN TOUCH MINISTRIES, INC. AND
IN TOUCH FOUNDATION, INC.**

Opposer In Touch Ministries, Inc., formerly known as ITM, Inc. dba In Touch Ministries Corporation ("ITM"), is a Georgia nonprofit corporation, tax exempt as a 501(c)(3) public charity, with its business address at 3836 Dekalb Technology Parkway, Atlanta, Georgia 30340-3604.

Opposer In Touch Foundation, Inc. ("ITF"), is also a Georgia nonprofit corporation, tax exempt as a 501(c)(3) public charity, with its business address at 3836 Dekalb Technology Parkway, Atlanta, Georgia 30340-3604.

ITM and ITF (collectively, "In Touch" or "Opposers") having similar interests in this matter, jointly oppose the application in Serial No. 78/954926.

In Touch will be damaged by registration of the mark proposed in Application Serial No. 78/954926, and hereby opposes the same because there will likely be substantial and irreparable confusion between In Touch's long used and properly

registered marks and Applicant's proposed mark. In addition, in the event Applicant begins national use of the proposed mark, In Touch's marks are likely to be diluted as a result. In further support of its opposition, In Touch states that the grounds for opposition include all of the following:

1. ITM is a 501(c)(3) nonprofit corporation headquartered in Georgia, and began as a ministry outgrowth of First Baptist Church of Atlanta (the "Church"), with broadcasts beginning in 1972. ITM was separately incorporated in 1982.

2. ITF is a 501(c)(3) nonprofit corporation headquartered in Georgia. ITF is organized and operated as a supporting organization of ITM.

I. ITM Has Established Use Of Its Registered Marks Since 1977

3. ITM began use in January 1977 of the mark, "IN TOUCH", in connection with religious goods and services within International Class 41, and has used it continuously since that date, in a "series of religious radio and television programs". These programs include biblical instruction on topics including but not limited to, spirituality, ethics, social issues, relationships, and lifestyle.

4. The "IN TOUCH" mark was registered by ITM on April 30, 1985 as United States Registration No. 1,332,925 and was registered by ITM under the Madrid Protocol on August 30, 2005 as International Registration No. 0867479.

5. In addition, radio and television broadcasts began from the Church in 1972, and the Church began using the mark "IN TOUCH" in connection with these broadcasts in 1977. The In Touch broadcast is currently on 400 television stations and 800 radio stations, broadcasting in English in at least one of these media in every U.S.

state and in every nation of the world, as well as broadcasting in over 50 other languages in other specific regions of the world, potentially reaching over 3 billion people.

6. ITM began use in January 1977 of the mark, “IN TOUCH”, in connection with religious goods and services within International Class 41, and has used it continuously since that date, in “production and distribution of religious radio and television programs.” This second “IN TOUCH” registration was completed by ITM on February 9, 1993 as United States Registration Number 1,751,621 and was registered by ITM under the Madrid Protocol on August 30, 2005 as International Registration Number 0867479.

7. ITM began use in 1984 of the mark, “IN TOUCH MINISTRIES”, in connection with religious goods and services in International Class 41, and has used it continuously since that date, in “production and distribution of religious radio and television” programs. The “IN TOUCH MINISTRIES” mark was registered by ITM on February 16, 1993 as United States Registration Number 1,752,942. Just as with the “IN TOUCH” mark, the “IN TOUCH MINISTRIES” mark is used extensively in radio and television broadcasts throughout the United States and around the world. In addition, the “IN TOUCH MINISTRIES” mark is used extensively in audio, video, and print media, at conferences and rallies held by In Touch, on the Internet, and in other media distributed under the auspices of In Touch.

II. ITF’s Use of Its Marks Has Been Continuous Since At Least 1993.

8. ITF began use in May 1993 of the mark, “IN TOUCH FOUNDATION”, in connection with religious goods and services in International Class 41, and has used it continuously since that date, in “educational services, namely, conducting seminars in the

field of biblical stewardship of financial resources, estate planning, and charitable giving, and distributing course materials in connection therewith.” In addition, the “IN TOUCH FOUNDATION” mark is used extensively in print media and on the Internet.

The “IN TOUCH FOUNDATION” mark was registered by ITF on October 24, 2000 as United States Registration Number 2,397,345.

III. In Touch’s Investment In Its Marks Requires USPTO Protection.

9. In Touch has invested tremendous expenses and effort in the promotion of its marks in the field of religious goods and services through radio, television, the Internet, printed materials, conferences, workshops, seminars, and rallies, thereby establishing its marks as a leader in religious programming and materials, with the result that the public has come to know, rely upon, and recognize the goods and services of In Touch by such marks. In Touch’s marks are well known and respected and In Touch has exceedingly valuable goodwill established in its marks. Indeed, the National Religious Broadcasters awarded ITM the Television Program of the Year Award in 1993, and also named ITM’s program as the 1999 Radio Program of the Year.

10. In Touch’s marks “IN TOUCH”, “IN TOUCH MINISTRIES”, and “IN TOUCH FOUNDATION” are symbolic of the extensive goodwill and recognition built up by In Touch through continuous use of said marks over a substantial period of time.

11. Due, in part, to In Touch’s zealous efforts to protect its marks, a search of the USPTO website reveals no other mark in use in International Class 41, or any other class, featuring religious goods and services which include “Touch” other than those of In Touch or its affiliates.

12. Application Serial No. 78/954926 for registration on the Principal Register, of the mark “TO TOUCH ONE MINISTRIES”, was filed on August 17, 2006, based upon Applicant’s alleged intention to use said mark. The word mark was published in the Official Gazette on May 1, 2007. Thus, Opposer ITM has been using its “IN TOUCH” mark more than 30 years prior to the filing date of Applicant’s application.

IV. Courtney R. Brazile’s Application Should Be Denied Under 15 U.S.C. §§ 1052(a), 1052(d), and 1063(a).

13. In the matter of its intent-to-use application, Applicant Courtney R. Brazile, an individual, requests the proprietary right to use the word mark, “TO TOUCH ONE MINISTRIES”. Applicant states that this mark will be used in “conducting workshops and seminars in personal awareness; conducting workshops and seminars in biblical studies; religious instruction services” pursuant to International Class 41.

14. In Touch’s registered marks, “IN TOUCH”, “IN TOUCH MINISTRIES”, and “IN TOUCH FOUNDATION”, are substantially similar in appearance, sound, connotation, and impression to Applicant’s proposed mark, “TO TOUCH ONE MINISTRIES”. In Touch has priority of use for their marks over Applicant’s proposed mark.

15. In Touch’s registered mark, “IN TOUCH”, is used in a “series of religious radio and television programs” pursuant to International Class 41, which is substantially similar to Applicant’s intended use of its proposed mark in “religious instruction services”, “conducting workshops and seminars in biblical studies”, and “conducting workshops and seminars in personal awareness”, pursuant to International Class 41.

16. In Touch's registered mark, "IN TOUCH MINISTRIES", is used in "production and distribution of religious radio and television programs" pursuant to International Class 41, which is substantially similar to Applicant's intended use of its proposed mark in "religious instruction services", "conducting workshops and seminars in biblical studies", and "conducting workshops and seminars in personal awareness", pursuant to International Class 41.

17. In Touch's registered mark, "IN TOUCH FOUNDATION", is used in "educational services, namely, conducting seminars in the field of biblical stewardship of financial resources, estate planning, and charitable giving, and distributing course materials in connection therewith" pursuant to International Class 41, which is substantially similar to Applicant's intended use of its proposed mark in "conducting workshops and seminars in personal awareness; conducting workshops and seminars in biblical studies; religious instruction services", pursuant to International Class 41.

18. In Touch's marks are used in all 50 states (and around the world). On information and belief, Applicant intends to use the proposed mark nationwide.

19. By reason of In Touch's extensive use of the "IN TOUCH", "IN TOUCH MINISTRIES", and "IN TOUCH FOUNDATION" marks, the public will believe that Applicant's use of its proposed mark "TO TOUCH ONE MINISTRIES" is sponsored or approved by In Touch and that the quality of the goods and/or services bearing the Applicant's mark has been approved and/or maintained by In Touch.

20. In view of these similarities, Applicant's intended use of the mark "TO TOUCH ONE MINISTRIES" is likely to cause confusion, mistake, or deception with respect to In Touch's marks "IN TOUCH", "IN TOUCH MINISTRIES", and "IN

TOUCH FOUNDATION”, and to damage the goodwill represented and symbolized by the marks, especially given Applicant’s intentions to use the proposed mark in the same or related fields in which In Touch’s marks are used.

21. By reason of the foregoing, In Touch will be irreparably damaged by the registration and use of Applicant’s proposed mark.

22. Pursuant to 15 U.S.C. § 1052(d), In Touch opposes the registration of Applicant’s proposed mark because Applicant’s proposed mark “so resembles...[In Touch’s continually used and registered marks]...as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive.”

23. Pursuant to 15 U.S.C. § 1063(a), In Touch also opposes the registration of Applicant’s proposed mark because, if Applicant begins to use the proposed mark on a nationwide basis, such use is likely to dilute the distinctive quality of In Touch’s famous marks.

24. In Touch’s long prior use and prior registration of its marks have so distinctively linked the marks to In Touch that Applicant’s proposed use would substantially and irreparably damage In Touch.

25. Pursuant to 15 U.S.C. § 1052(a), In Touch also opposes the registration of Applicant’s proposed mark because, if used by Applicant, the proposed mark would falsely suggest a connection to In Touch.

WHEREFORE, In Touch prays that this Opposition be sustained, that the application for the registration of the word mark, “TO TOUCH ONE MINISTRIES”,

Application Serial No. 78/954926, be denied, and that In Touch have such other and further relief as deemed appropriate.

The filing fee for this opposition in the amount of \$300 is herewith submitted.

This is the 25th day of May, 2007.

Respectfully submitted,

Bird, Loechl, Brittain & McCants, LLC

/CDJ/

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