

ESTTA Tracking number: **ESTTA146892**

Filing date: **06/20/2007**

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 party opposes registration of the indicated application.

Opposer Information

Name	Hearst Communications, Inc.
Granted to Date of previous extension	06/20/2007
Address	959 Eighth Avenue New York, NY 10019 UNITED STATES

Attorney information	Theodore H. Davis Jr. Kilpatrick Stockton LLP 1100 Peachtree Street Suite 2800 Atlanta, GA 30309 UNITED STATES tdavis@kilpatrickstockton.com, mbaratta@kilpatrickstockton.com, lestrin@kilpatrickstockton.com, bagdern@hearst.com, bfitzpatrick@hearst.com Phone:404-815-6500
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Applicant Information

Application No	78911551	Publication date	02/20/2007
Opposition Filing Date	06/20/2007	Opposition Period Ends	06/20/2007
Applicant	Products & Ventures International, Inc. PO Box 1527 Santa Barbara, CA 931021527 UNITED STATES		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Cosmetic pencils

Grounds for Opposition

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.	630028	Application Date	08/10/1955
Registration Date	07/03/1956	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		

Design Mark	
Description of Mark	NONE
Goods/Services	Class U038 (International Class 016). First use: First Use: 1886/03/00 First Use In Commerce: 1886/03/00 MAGAZINE OR PERIODICAL PUBLISHED MONTHLY OR AT OTHER INTERVALS

U.S. Registration No.	2527954	Application Date	01/20/1999
Registration Date	01/08/2002	Foreign Priority Date	NONE
Word Mark	COSMO GIRL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1999/06/29 First Use In Commerce: 1999/06/29 general interest magazine for girls and young women		

U.S. Registration No.	2518660	Application Date	01/20/1999
Registration Date	12/11/2001	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1997/11/00 First Use In Commerce: 1997/11/00 COMPUTER SERVICES, NAMELY PROVIDING AN INTERACTIVE ON-LINE COMPUTER DATABASE FEATURING PORTIONS OF VARIOUS MAGAZINES AND ARTICLES AND ILLUSTRATIVE MATERIALS IN THE FIELDS OF PERSONAL RELATIONSHIPS, BEAUTY AND FASHION, HEALTH AND FITNESS, PERSONAL HYGIENE, STARS AND ENTERTAINMENT NEWS, AND LIFE AND WORK, RENDERED BY MEANS OF A GLOBAL COMPUTER NETWORK		

U.S. Registration No.	2407134	Application Date	01/20/1999
Registration Date	11/21/2000	Foreign Priority Date	NONE
Word Mark	COSMO GIRL!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1999/06/29 First Use In Commerce: 1999/06/29 Providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news and life and work, rendered by means of a global computer network		

U.S. Application No.	76521257	Application Date	05/29/2003
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN.COM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2007/02/14 First Use In Commerce: 2007/02/14 On-line retail store services featuring general merchandise in the fields of beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network		

U.S. Registration No.	1685161	Application Date	07/03/1991
Registration Date	05/05/1992	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1988/10/15 First Use In Commerce: 1988/10/15 pre-recorded video tapes and video cassettes on the subjects of exercise and beauty		

U.S. Registration No.	1911389	Application Date	08/31/1994
Registration Date	08/15/1995	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1994/07/01 First Use In Commerce: 1994/07/01 books of general interest		

U.S. Registration No.	1855579	Application Date	08/16/1993
Registration Date	09/27/1994	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1988/11/01 First Use In Commerce: 1988/11/01 eye glasses and eye glass frames		

U.S. Registration No.	2178873	Application Date	10/10/1995
Registration Date	08/04/1998	Foreign Priority	NONE

		Date	
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 026. First use: First Use: 1998/02/09 First Use In Commerce: 1998/02/09 hair ornaments, namely, barrettes, ribbons, bands and bows		

U.S. Registration No.	3011715	Application Date	12/26/2001
Registration Date	11/01/2005	Foreign Priority Date	NONE
Word Mark	COSMOGIRL!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 2005/04/01 First Use In Commerce: 2005/04/01 mirrors		

U.S. Registration No.	2963497	Application Date	06/15/2001
Registration Date	06/21/2005	Foreign Priority Date	NONE
Word Mark	COSMOGIRL!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 2002/11/30 First Use In Commerce: 2002/11/30 Bed throws, beach towels		

U.S. Registration No.	2976367	Application Date	07/27/1999
Registration Date	07/26/2005	Foreign Priority Date	NONE
Word Mark	COSMO GIRL!		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/10/31 First Use In Commerce: 2003/10/31 t-shirts		

U.S. Application No.	78892923	Application Date	05/25/2006
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COSMOGIRL!		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 009. First use: PRE-RECORDED VIDEO TAPES AND DVDS FEATURING INFORMATION ON HEALTH AND FITNESS
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U.S. Application No.	76572404	Application Date	01/23/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: pre-recorded compact discs and audio cassettes featuring music Class 014. First use: jewelry, namely, cuff links, tie pins and rings Class 021. First use: cosmetic brushes		

U.S. Application No.	78487899	Application Date	09/22/2004
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	COSMOPOLITAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 014. First use: Watches		

Attachments	75623902#TMSN.gif (1 page)(bytes) 76521257#TMSN.gif (1 page)(bytes) 76353658#TMSN.gif (1 page)(bytes) 76271863#TMSN.gif (1 page)(bytes) 75761609#TMSN.jpeg (1 page)(bytes) 78892923#TMSN.jpeg (1 page)(bytes) 76572404#TMSN.gif (1 page)(bytes) 78487899#TMSN.jpeg (1 page)(bytes) Hearst - Notice of Opposition (COSMONOVA).pdf (8 pages)(22668 bytes)
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Signature	/Theodore H. Davis Jr./
Name	Theodore H. Davis Jr.
Date	06/20/2007

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

HEARST COMMUNICATIONS, INC.)	
)	In re Serial No. 78911551
Opposer,)	
)	Mark: COSMONOVA
)	
v.)	
)	
)	Opposition No. _____
PRODUCTS & VENTURES)	
INTERNATIONAL, INC.,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer Hearst Communications, Inc. will be damaged by the registration of the COSMONOVA mark underlying Application Serial No. 78/911,551 and states the following for its Notice of Opposition to that application:

1. Opposer Hearst Communications, Inc. (“HCI”) is a Delaware corporation with a principal place of business at 300 West 57th Street, New York, New York 10019. HCI is a subsidiary of The Hearst Corporation, one of the world’s largest communications companies. Among its other activities, HCI is a publisher of magazines and other printed materials and a provider of online content.

2. Beginning in 1886, more than a century prior to the June 19, 2006 filing date of Applicant’s application, HCI’s predecessors-in-interest began using the

COSMOPOLITAN mark in connection with a magazine. Each issue of COSMOPOLITAN magazine contains candid discussions of a variety of “lifestyle” issues, including discussions of beauty and cosmetic-related topics. COSMOPOLITAN magazine currently is produced by HCI.

3. For the last 100 years, HCI and its predecessors have invested a substantial amount of time, effort, and money in promoting the internationally famous and well-known COSMOPOLITAN magazine. It is published in over 30 languages and sold in more than 100 countries, making it the largest monthly magazine franchise in the world. HCI’s COSMOPOLITAN mark is the subject of Registration No. 630,028, issued on July 3, 1956, for a “magazine or periodical published monthly or at other intervals” in International Class 16. This registration is incontestable.

4. References to HCI’s registered COSMOPOLITAN mark often are abbreviated by HCI and by the public to COSMO. In 1999, HCI began use of the COSMO GIRL mark in connection with a magazine for teens and younger women that also features articles on “lifestyle” subjects. Like its sister magazine, COSMOPOLITAN, COSMO GIRL magazine has become famous and well-known. In 2000, it was named “Startup of the Year” by ADWEEK magazine and was named to ADVERTISING AGE’s “A List,” which designated it among the top three magazines of 2003. HCI’s COSMO GIRL mark is the subject of Registration No. 2,527,954, issued January 8, 2002, for a “general interest magazine for girls and young women.”

5. Well prior to the filing date of Applicant's application, HCI began using the COSMO GIRL! and COSMOPOLITAN.COM marks in connection with the online provision of information related to that found in HCI's magazines. HCI is the owner of two registrations for computer services: (1) Reg. No. 2,518,660 of COSMOPOLITAN.COM, issued on December 11, 2001 for "computer services, namely providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network;" and (2) Reg. No. 2,407,134 of COSMO GIRL!, issued on November 21, 2000, for "providing an interactive on-line computer database featuring portions of various magazines and articles and illustrative materials in the fields of personal relationships, beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network."

6. On May 29, 2003, well prior to the filing date of Applicant's applications, HCI filed application Serial No. 76/521,257 to register the mark COSMOPOLITAN.COM in connection with "on-line retail store services featuring general merchandise in the fields of beauty and fashion, health and fitness, personal hygiene, stars and entertainment news, and life and work, rendered by means of a global computer network." On February 15, 2007, HCI filed a statement to allege use of the mark underlying this application that recited a date of first use of February 14, 2007. As of June 11, 2007, the USPTO's TARR web server

recited for this application that “[t]he final review before registration has been completed for this Intent to Use application and it will register in due course.”

7. In addition to the COSMOPOLITAN.COM and COSMO GIRL! marks for computer services, HCI also is the owner of the following marks:

Mark	Goods & Services	Registration/ Filing Date
COSMOPOLITAN Reg. No. 1,685,161	Pre-recorded video tapes and video cassettes on the subjects of exercise and beauty in International Class 9	May 5, 1992
COSMOPOLITAN Reg. No. 1,911,389	Books of general interest in International Class 16	Aug. 15, 1995
COSMOPOLITAN Reg. No. 1,855,579	Eye glasses and eye glass frames in International Class 9	Sept. 27, 1994
COSMOPOLITAN Reg. No. 2,178,873	Hair ornaments, namely, barrettes, ribbons, bands and bows in International Class 26	Aug. 4, 1998
COSMOGIRL! (Reg. No. 3,011,715)	Mirrors in International Class 20	Nov. 1, 2005
COSMOGIRL! (Reg. No. 2,976,367)	T-shirts in International Class 25	July 26, 2005
COSMOGIRL! (Reg. No. 2,963,497)	Bed throws, beach towels in International Class 24	June 21, 2005
COSMOGIRL! (Serial No. 78/892,923)	Pre-recorded video tapes and dvds featuring information on health and fitness in International Class 9	May 25, 2006
COSMOPOLITAN (Serial No. 76/572,404)	Cosmetic brushes in International Class 21	Jan. 23, 2004
COSMOPOLITAN (Serial No. 78/487,899)	Watches in International Class 14	Sept. 22, 2004

8. Since 1997, HCI has used the mark COSMO QUIZ for a regular section of its magazines. Consistent with the widespread circulation of HCI’s magazines, use and public

recognition of the COSMO QUIZ mark as a brand of HCI extended throughout the United States prior to the filing date of Applicant's application.

9. Since prior to the filing date of Applicant's application, HCI also has used such titles and section headlines as COSMO FAQs, COSMO KAMA SUTRA, COSMO FASHION, CONNECT WITH COSMO, BE IN COSMO, FREE STUFF FROM COSMO, COSMO EXCLUSIVES, COSMO FOR YOUR GUY, GET COSMO HEADLINES, MAKE COSMO YOUR HOMEPAGE, TELL COSMO ABOUT YOUR HAIR!, HELP COSMO CHOOSE ITS COVERLINES, MAKE A GREAT RECIPE FROM COSMO RADIO, SPORTING A STYLE YOU FOUND IN COSMO?, ADD COSMO TO YOUR MYSPACE, GET COSMO UPDATES, COSMO MOBILE, COSMO RADIO, FREE STUFF FROM COSMO, COSMO PROMO HOT SPOT, COSMO MEDIA KIT, and EVERYTHING COSMO in connection with its publications.

10. Taken together, HCI's marks based on the elements COSMOPOLITAN and COSMO constitute a family of marks. Beginning over a hundred years ago, HCI and its predecessors have expended considerable sums of money into developing consumer brand recognition for its family of COSMO and COSMOPOLITAN marks.

11. As a result of widespread advertising and promotion by HCI and its predecessors, the marks making up HCI's family of COSMOPOLITAN and COSMO marks acquired a high degree of recognition, fame, and distinctiveness as symbols of the high quality products and services offered by HCI prior to the filing date of Applicant's

application. The public and trade are familiar with and identify HCI's marks with HCI and, by reason of this identification, goods and services associated with the marks are understood by the public and trade to be produced, marketed, and supplied under HCI's authority or otherwise derived from HCI.

12. The marks making up HCI's family of COSMOPOLITAN and COSMO marks are important factors employed by the public in identifying the source of HCI's products and services and are distinctive of those products and services. As a result of their fame and notoriety, HCI's marks are entitled to a broad scope of protection.

13. On June 19, 2006, Applicant filed an intent-to-use application to register the COSMONOVA mark on the Principal Register for use in connection with "cosmetic pencils" in International Class 3.

14. The first element of the COSMONOVA mark Applicant seeks to register is identical in sound, meaning, and commercial impression to the salient elements of the marks making up HCI's family of COSMOPOLITAN and COSMO marks and will be used for goods related to the goods and services for which HCI uses its family of COSMOPOLITAN and COSMO marks.

15. Because of the prominence of its COSMO-element, Applicant's mark is substantially similar in sound, meaning, and commercial impression to the salient elements of the marks making up HCI's family of COSMOPOLITAN and COSMO marks and will be

used for goods that are either directly competitive with, or related to, the goods and services for which HCI uses its family of COSMOPOLITAN and COSMO marks.

16. Based on the similarities of the marks and the goods and services, the relevant public is likely to be confused into believing that Applicant's goods, as offered under the COSMONOVA mark, emanate from HCI, or are authorized, licensed, endorsed, or sponsored by HCI. Registration of Applicant's mark on the Principal Register would thus be inconsistent with HCI's prior rights in its family of well-known COSMOPOLITAN and COSMO marks.

17. HCI will be damaged by the registration of Applicant's COSMONOVA mark because it so resembles HCI's previously used and well-known marks as to be likely, when used on or in connection with the goods and services identified in the subject application, to cause confusion, or to cause mistake, or to deceive in violation of section 2(d) of the Lanham Act, 15 U.S.C. § 1052.

18. HCI will be damaged by registration of Applicant's COSMONOVA mark because the mark is likely to dilute the distinctiveness of the famous marks making up HCI's family of COSMOPOLITAN and COSMO marks by eroding consumers' exclusive identification of these marks with HCI, and/or by tarnishing and degrading the positive associations and prestigious connotations of these famous marks, and/or by otherwise lessening the capacity of the marks to identify and distinguish HCI's goods and services in violation of section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

19. The opposition fee in the amount of \$300.00 accompanying this Notice of Opposition is filed herewith. The Director is authorized to debit Deposit Account No. 11-0860 if there is any deficiency in the required fee.

HCI therefore requests that registration of the mark underlying Application Serial No. 78/911,551 be refused, and this Notice of Opposition be sustained in HCI's favor.

This 20th day of June, 2007.

Respectfully submitted,

/Theodore H. Davis Jr./

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