

ESTTA Tracking number: **ESTTA198448**

Filing date: **03/14/2008**

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	CBS Studios Inc.
Granted to Date of previous extension	03/16/2008
Address	51 West 52nd Street New York, NY 10019 UNITED STATES

Correspondence information	CBS Studios Inc. 51 West 52nd Street New York, NY 10019 UNITED STATES mallory.levitt@cbs.com Phone:212-975-4321
----------------------------	---

Applicant Information

Application No	78925934	Publication date	09/18/2007
Opposition Filing Date	03/14/2008	Opposition Period Ends	03/16/2008
Applicant	Sarakalo, Layla 9502 Via Salerno Burbank, CA 91504 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, anoraks, beachwear, belts, blazers, blouses, blousons, bodysuits, boleros, bottoms, camisoles, cardigans, chemises, coats, coveralls, dresses, footwear, infant wear, jackets, jeans, jogging suits, kimonos, leggings, lingerie, neckwear, neckties, leather coats, leather jackets, overalls, pajamas, panties, pants, polo shirts, pullovers, robes, sarongs, scarves, shirts, shorts, skirts, sleepwear, sun sleeves, slips, stockings, surf wear, sweaters, sweatpants, sweatshirts, swimwear, tank tops, tennis wear, tights, tops, t-shirts, trousers, underclothes, undergarments, underwear, vests, gloves, shawls, wraps, and headgear, namely, bandanas, caps, beanies, hats, headbands, hoods, visors and sweat bands
--

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Application/Registration No.	NONE	Application Date	NONE
-----------------------------------	------	------------------	------

Registration Date	NONE
Word Mark	BEAM ME UP SCOTTY
Goods/Services	variety of goods including but not limited to clothing, printed matters and key chains

Attachments	LAYLA001.PDF (7 pages)(258831 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/ml/
Name	CBS Studios Inc.
Date	03/14/2008

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

In the Matter of Application Serial No. 78/925,934
Published in the Official Gazette of September 18, 2007

CBS STUDIOS INC.,	:	Opposition No.
Opposer,	:	
-against-	:	NOTICE OF OPPOSITION
LAYLA SARAKEYLO,	:	Opposition No.
Applicant.	:	
-----	X	

CBS Studios Inc., successor in interest to the intellectual property rights in STAR TREK (“Opposer”), a Delaware corporation, with its principal offices at 4024 Radford Avenue, Studio City, CA 90036, hereby opposes the application of Layla Sarakaylo (“Applicant”) for registration of the trademark BEAM ME UP SCOTTY bearing serial number 78/925,934, published in the Official Gazette of September 18, 2007 (“Application”).

Opposer believes that it will be damaged by registration of the mark shown in the Application and opposes on the following grounds:

1. Opposer is, and has been for many years, engaged in the business of producing audiovisual entertainment programs, and exploiting the rights in those properties worldwide. Among the audiovisual entertainment programs produced and distributed by Opposer, and its predecessor, Paramount Pictures Corporation, are the well-known television programs “STAR TREK”, “STAR TREK: The Next Generation”, “STAR TREK: Deep Space Nine” and “STAR TREK: Voyager”, “STAR TREK: Enterprise,” “STAR TREK The Animated Series” as well as ten “STAR TREK” motion pictures and an eleventh production to be released in 2009 (collectively, the “STAR TREK Productions”).

2. Since the introduction of the original series in 1966, the STAR TREK Productions have achieved enormous popularity. The Productions have been viewed by millions of people on television in more than 100 domestic markets and seventy-five countries worldwide, as well as in movie houses and on video cassettes (and related technology). Similarly, printed matter (including novels and fan publications), audiotapes and videotapes and DVDs based on the STAR TREK

Productions have achieved widespread circulation and popularity. Furthermore, sales of merchandise tied to the STAR TREK Productions have exceeded forty billion dollars over the decades.

3. Indeed, many of the STAR TREK Productions are currently broadcast throughout the United States on a variety of networks including but not limited to Spike TV, TV Land and G4 and various pay cable networks. The STAR TREK Productions continue to be licensed for broadcast in hundreds of countries worldwide.

4. The STAR TREK Productions are available in a variety of formats including but not limited to VHS, DVD, Blue Ray discs and downloadable streaming content on numerous licensed websites. Millions of units have been sold worldwide to date.

5. The fame of the STAR TREK Productions has led to a “STAR TREK culture”: there are STAR TREK fan clubs throughout the United States and in countries worldwide; there are STAR TREK conventions held regularly worldwide; there are many fans-sponsored websites, blogs and bulletin boards online, as well as Opposer’s official website at www.startrek.com; millions of people visited the official STAR TREK exhibit at the Smithsonian Institute Air and Space Museum in Washington, D.C., and many more continue to attend the traveling exhibit “STAR TREK The Tour” which has journeyed throughout Europe and more recently re-located to Long Beach, California and features interactive sets and attractions, costumes and props; “STAR TREK: The Experience”, in its 10th year at the Hilton Hotel in Las Vegas is an interactive adventure which includes rides, a museum, restaurant and store all tied to the STAR TREK Productions; and in October 2006, Opposer and Christie’s New York hosted an official auction of more than 1000 never- before-released archives of Opposer celebrating 40 years of STAR TREK and encompassing costumes, props, weapons, set designs, detailed models of the ships, among many other items.

The Origin of the STAR TREK Family of Marks

6. Opposer is the owner of rights in and to the STAR TREK Productions, including numerous trademarks in the elements of the STAR TREK Productions such as the characters, sets, slogans and paraphernalia appearing therein.

7. Opposer owns trademark registrations and applications worldwide for the STAR TREK mark and a "family" of marks related thereto and derived therefrom (the "STAR TREK Marks").

The "BEAM ME UP SCOTTY" Mark

8. Among the "family" of STAR TREK Marks is the unique and distinctive phrase "BEAM ME UP SCOTTY" (the "Mark"). The Mark derives from the earliest episodes of the original series in 1966. In connection with their duties, the crew of the U.S.S. Enterprise would visit distant planets via a device called a "transporter"--a chamber on the ship which disassembled the molecules of a person (or other entity), transported them to the desired location and then reassembled the molecules in their original arrangement to "transpose" the person from the ship to a planet (or other place). The "transporter" also allowed people in other locations to board the Enterprise.

9. When an individual used the transporter to leave the Enterprise, the process was described in the series as "beaming down", and similarly, use of the transporter to board the Enterprise was termed "beaming up". Crew members desiring to re-board the Enterprise could alert the chief engineer, Scotty, by stating a variation of "Beam me up Scotty". The order to be transported onto the Enterprise was frequently given by the ship's captain, James T. Kirk, and quickly became one of the most instantly recognizable phrases associated with the STAR TREK Productions.

10. Since its introduction in the original series, the phrase "Beam Me Up Scotty" has been widely associated by the public with the STAR TREK Productions as well as the several "STAR TREK" motion pictures featuring the original cast, including Chief Engineer Scotty, played by Montgomery Scott. The Mark has become irrevocably associated with the STAR TREK Productions.

11. Opposer has used the Mark extensively in interstate commerce since at least as early as 1966 in connection with the STAR TREK Productions and since as early as 1991 in connection with its merchandising program and advertising, marketing and promotion thereof.

Licensing and Merchandising

12. Opposer is and has been for many years engaged in the business of using and licensing to others the right to use of titles and other elements of its audio visual entertainment programs as trademarks in connection with various products and services. The BEAM ME UP SCOTTY Mark has been used and will continue to be used by Opposer in this licensing program. This practice of licensing elements from a famous television and film property is commonplace

and well known to the general public and throughout the industry in general. In the words of the T.T.A.B. in a case related to Opposer's trademarks, In re Paramount Pictures Corp., 213 U.S.P.Q. 1111 (TTAB1982): "It is a common merchandising technique in this country to license the use of the character names and images as trademarks for a variety of products collateral to the product or services in respect of which the name or images are primarily known."

13. Opposer has developed widespread public recognition of the series of publications and the merchandising of related goods featuring the STAR TREK Marks, specifically including the BEAM ME UP SCOTTY Mark. As a result of Opposer's extensive licensing and marketing efforts, Opposer and its numerous licensees have sold over \$1 billion of STAR TREK related merchandise over the past forty years. Accordingly, Opposer has built up goodwill of great value in the STAR TREK Marks.

14. Since at least as early as July, 1991, Opposer has licensed, marketed and sold in interstate commerce numerous products bearing the BEAM ME UP Mark, including such goods as bumper stickers, t-shirts, key chains, posters and baseball caps. Additionally, Opposer has licensed the use of the Mark in connection with the rendering of services by third-parties. It is the nature of licensing programs that certain of the specific properties may not be the subject of licenses at all times. Given the extraordinary popularity and longevity of the STAR TREK Productions, and enduring public interest in the television series and motion pictures, and the effort to deliver to the public new products over time, the categories of goods and specific properties Opposer licenses has changed over time. At no time has Opposer abandoned or intended to abandon its rights in and to the Mark.

15. Opposer continues to license its rights in and to the STAR TREK Marks including but not limited to the BEAM ME UP SCOTTY Mark for goods and services tied to the STAR TREK Productions. Opposer's exploitation includes the use of the Mark on clothing and related goods.

16. Opposer considers its STAR TREK properties extremely valuable and protects those rights from unauthorized third party use.

Applicant's Intent to Use an Identical, Confusingly Similar Mark

17. On or about July 10, 2006, Applicant filed the instant Application in the Patent and Trademark Office bearing Serial No. 78/925, 934 on an intent-to-use basis for the registration on the Principal Register of the trademark BEAM ME UP SCOTTY for “clothing and apparel” in International Class 25.

18. Said Application is based on Applicant's stated intent to use the Mark on or in connection with such goods in commerce, and upon information and belief, Applicant has not made use of this Mark in the United States.

19. Applicant's proposed mark BEAM ME UP SCOTTY is identical to Opposer's Mark, both aurally and visually.

20. Given the renown of the STAR TREK Productions, the extensive and continuous use of the BEAM ME UP SCOTTY Mark by Opposer and its licensees in connection with a variety of goods including but not limited to on clothing, and the widespread public identification of the BEAM ME UP SCOTTY Mark with Opposer, its services and related merchandising, it is extremely likely that a prospective purchaser faced with Applicant's products utilizing the mark BEAM ME UP SCOTTY would be confused and would be otherwise likely to assume, erroneously, that Applicant's product was manufactured, sold, approved, licensed, sponsored or in some other way connected with or authorized by Opposer.

21. Applicant is known to have appeared in an extra for a brief scene in one of the STAR TREK Productions. It is clear that Applicant selected BEAM ME UP SCOTTY specifically with the intent to trade on the tremendous goodwill associated with Opposer's STAR TREK Marks, specifically including the Mark.

22. Opposer would thus be seriously injured by the granting of a certificate of registration to Applicant for the Mark BEAM ME UP SCOTTY in Class 25 because Applicant's mark is identical to Opposer's BEAM ME UP SCOTTY Mark and, when used in connection with Applicant's goods, such mark:

- (a) would be likely to cause confusion, or to cause mistake, or to deceive in violation of Sections 2(d) and 13(a) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1063(a);
- (b) would falsely and erroneously suggest a connection with Opposer; and

c) would tend to damage and interfere with and dilute Opposer's valuable goodwill in its Star Trek Marks, including its BEAM ME UP SCOTTY mark in violation of Sections 2(f), 13(a), and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(f), 1063(a), and 1125(c).

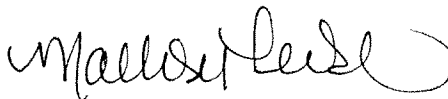
WHEREFORE, Opposer believes that it will be seriously damaged by said registration and, therefore Opposer, by its undersigned attorneys, respectfully requests that its opposition be sustained and that the application for registration be denied.

Dated: New York, New York

March 14, 2008

Respectfully submitted,

By:

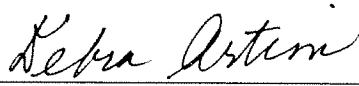


**Mallory Levitt/s
Mallory Levitt
Attorneys for Opposer
CBS Studios Inc.
c/o CBS Corporation Law
51 West 52nd Street
New York, NY 10019
Mallory.levitt@cbs.com
P: 212-975-4321
F: 212-975-0114**

CERTIFICATE OF EXPRESS MAIL
EXPRESS LABEL MAIL NO. EB 307942829US

I hereby certify that this document is being deposited with the United States Postal Service by Express Mail, postage pre-paid, addressed to John J Santalone, Levin Santalone, 2 East Avenue, Suite 201, Lachmont, NY 10538-2419 on this 14th day of March, 2008.

Debra Artim
(Typed name of person mailing paper)


(Signature of person mailing paper)