

ESTTA Tracking number: **ESTTA235516**

Filing date: **09/09/2008**

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 parties oppose registration of the indicated application.

Opposers Information

Name	Intellectual Reserve, Inc.
Granted to Date of previous extension	09/10/2008
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES

Name	Corporation of the President of The Church of Jesus Christ of Latter-day Saints		
Entity	Corporation sole	Citizenship	Utah
Address	50 East North Temple Salt Lake City, UT 84150 UNITED STATES		

Attorney information	Dale E. Hulse Kirton & McConkie 60 East South Temple, Suite 1800 Salt Lake City, UT 84111 UNITED STATES dhulse@kmclaw.com Phone:(801) 321-4815
----------------------	---

Applicant Information

Application No	77203424	Publication date	05/13/2008
Opposition Filing Date	09/09/2008	Opposition Period Ends	09/10/2008
Applicant	Hartnett, Pam L. 13366 W Annabrook Drive Boise, ID 83713 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: T-shirts

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.	3239919	Application Date	09/05/2002
Registration Date	05/08/2007	Foreign Priority Date	NONE
Word Mark	MORMON		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 041. First use: First Use: 1920/00/00 First Use In Commerce: 1920/00/00 Educational services, namely, providing classes, conferences, and institutes in the fields of history and religion</p> <p>Class 042. First use: First Use: 1833/06/01 First Use In Commerce: 1833/06/01 genealogy services</p>		

U.S. Registration No.	2883572	Application Date	05/10/2002
Registration Date	09/14/2004	Foreign Priority Date	NONE
Word Mark	BOOK OF MORMON		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1977/00/00 First Use In Commerce: 1977/00/00 pre-recorded audio and video cassette tapes and compact discs featuring religious content</p> <p>Class 016. First use: First Use: 1830/00/00 First Use In Commerce: 1830/00/00 Printed matter; namely religious books, religious instructional pamphlets, and brochures; photographs, artist materials, instructional and teaching material, posters, engravings, prints of paintings, books</p>		

U.S. Registration No.	2766231	Application Date	11/20/2001
Registration Date	09/23/2003	Foreign Priority Date	NONE
Word Mark	MORMON TABERNACLE CHOIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 009. First use: First Use: 1973/11/00 First Use In Commerce: 1973/11/00 Pre-recorded audio and audio-video cassette tapes and compact discs featuring musical entertainment incorporating religious, family, and educational themes</p> <p>Class 041. First use: First Use: 1893/08/00 First Use In Commerce: 1893/08/00 entertainment services, namely, live performances by a musical performance group</p>		

U.S. Registration No.	2913694	Application Date	04/10/2003
Registration Date	12/21/2004	Foreign Priority Date	NONE
Word Mark	MORMON TABERNACLE CHOIR		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 prerecorded audiotapes, videotapes, compact discs, and digital video discs featuring musical entertainment incorporating religious, family, and educational themes Class 016. First use: First Use: 2003/06/00 First Use In Commerce: 2003/06/00 publications, namely, books featuring musical performances and featuring religious, family, and educational themes Class 041. First use: First Use: 2003/03/00 First Use In Commerce: 2003/03/00 entertainment services, namely, live performances by a musical performance group

U.S. Registration No.	1524555	Application Date	04/07/1986
Registration Date	02/14/1989	Foreign Priority Date	NONE
Word Mark	MORMON HANDICRAFT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 1974/05/00 First Use In Commerce: 1974/05/00 FABRICS, LINENS, BATS, TOWELS, DISH CLOTHS, PILLOWCASES, AFGHANS, LAP ROBES, QUILTS, QUILT KITS, AND WALL HANGINGS, TABLE COVERS, SOFT GIFTS, AND HEM-STITCHED ITEMS OF TEXTILE MATERIAL		

U.S. Registration No.	1527447	Application Date	04/07/1986
Registration Date	02/28/1989	Foreign Priority Date	NONE
Word Mark	MORMON HANDICRAFT		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1937/10/00 First Use In Commerce: 1937/10/00 RETAIL CATALOG MAIL ORDER AND TELEPHONE ORDER SERVICES FOR CRAFT ITEMS AND MATERIALS, DOLLS, BABY CLOTHES, TOYS, YOUNG GIRLS' CLOTHING, QUILTS, PERSONAL GIFTS, NEEDLEWORK, PORCELAIN STATUES AND THE LIKE		

U.S. Application No.	77179068	Application Date	05/11/2007
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	MORMON.ORG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use:		

	Providing information and instruction in the fields of religion, ethics, moral and religious values, parenting, marital and family relations
--	--

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MORMON		
Goods/Services	A variety of goods and services		

Attachments	76405608#TMSN.gif (1 page)(bytes) 76340212#TMSN.gif (1 page)(bytes) 76505493#TMSN.gif (1 page)(bytes) 77179068#TMSN.jpeg (1 page)(bytes) Opposition_16265-105.pdf (2 pages)(91389 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 First Class Mail on this date.

Signature	/Dale E. Hulse/
Name	Dale E. Hulse
Date	09/09/2008

1. Intellectual Reserve, Inc. ("IRI") is a nonprofit corporation of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City, Utah 84150, and Corporation of the President of The Church of Jesus Christ of Latter-day Saints ("COP"), is a corporation sole of the state of Utah having a principal place of business at 50 East North Temple, Salt Lake City Utah 84150, IRI and COP being collectively referred to herein as "Opposer".

2. Since at least as early as 1833, Opposer and its predecessors have used the mark and trade name "MORMON" in connection with a variety of goods and services, and Opposer has continually used such mark up through the present time.

3. In this regard, Opposer owns all right, title, and interest in and to the mark "MORMON", as well as to the following marks and federal registrations: U.S. Registration No. 3,239,919 for the mark "MORMON", U.S. Registration No. 2,883,572 for the mark "BOOK OF MORMON", U.S. Registration No. 2,766,231 for the mark "MORMON TABERNACLE CHOIR", U.S. Registration No. 2,913,694 for the mark "MORMON TABERNACLE CHOIR (and Design)", U.S. Registration No. 1,524,555 for the mark "MORMON HANDICRAFT", and U.S. Registration No. 1,527,447 for the mark "MORMON HANDICRAFT". Opposer is also the owner of all right, title, and interest in and to the mark "MORMON.ORG" and federal application Serial No. 77/179,068 for the mark "MORMON.ORG". All of the foregoing marks, registrations, and applications are collectively referred to herein as the "MORMON marks".

4. The use of the MORMON marks by Opposer has been valid and continuous since the respective dates of first use of those marks and such use has not been abandoned.

5. Opposer has so used the MORMON marks in connection with Opposer's goods and services such that the public has come to associate "MORMON" and the MORMON marks with Opposer and as indicating that the goods and services marketed and/or associated with the MORMON marks originate with Opposer.

6. The MORMON marks are symbolic of extensive goodwill and consumer recognition built up by Opposer through the substantial expenditure of time and resources in promotion and advertising.

7. On information and belief, Applicant, Pam L. Hartnett, is an individual residing at 13366 West Annabrook Drive, Boise Idaho, 83713.

8. On June 11, 2007, Applicant filed application Serial No. 77/203,424 for registration of the alleged mark "MORMON CHICKS RULE.", and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on May 13, 2008 in International Class 25 (U.S. Classes 22 and 39) for "T-shirts". On June 11, 2008, Opposer was granted a 90 day Extension of Time to Oppose, extending the opposition deadline to September 10, 2008.

9. Applicant's aforesaid application is based upon Applicant's alleged bona fide intent to use the proposed "MORMON CHICKS RULE." mark in connection with the above-stated goods.

10. The goods recited in Applicant's application and the goods and services with which Opposer has used, and now uses, the MORMON marks are of the same general class and type as goods and services offered by Opposer.

11. The goods of Applicant bearing the alleged mark "MORMON CHICKS RULE." would pass through the same or similar channels of commerce to the same or similar classes of

purchasers as the goods and services offered by Opposer in association with its MORMON marks.

12. The alleged "MORMON CHICKS RULE." mark of Applicant, as applied to the goods of Applicant set forth in Applicant's application, so resembles the MORMON marks of Opposer, previously used in the United States by Opposer, as applied to the goods and services of Opposer, so as to be likely to cause confusion, or to cause mistake, or to deceive, so as to falsely suggest a connection with Opposer, and so as to dilute the distinctive quality of Opposer's MORMON marks which are believed to be famous.

13. Based upon the foregoing, registration of the "MORMON CHICKS RULE." mark depicted in application Serial No. 77/203,424 on the Principal Register of the United States Patent and Trademark Office will cause injury and damage to Opposer.

14. Wherefore, Opposer prays that this opposition be sustained in its favor, and that registration of Applicant's alleged mark "MORMON CHICKS RULE.", application Serial No. 77/203,424, be denied.