

ESTTA Tracking number: **ESTTA294983**

Filing date: **07/13/2009**

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	Intellectual Reserve, Inc.		
Entity	Corporation	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 P.O. Box 45120 Salt Lake City, UT 84145-0120 UNITED STATES dhulse@kmclaw.com Phone:(801) 321-4815
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**Applicant Information**

Application No	77337325	Publication date	06/30/2009
Opposition Filing Date	07/13/2009	Opposition Period Ends	07/30/2009
Applicant	Sheets, Kendal M. 1855 MacArthur Drive McLean, VA 22101 UNITED STATES		

**Goods/Services Affected by Opposition**

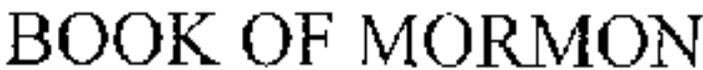
<p>Class 009. All goods and services in the class are opposed, namely: CD-ROMs, DVDs, magnetic tape cassettes, high definition digital disks featuring non-fictional content of history and religious doctrine; computer software for database management and interactive reading and research of electronically formatted books of history and religion; downloadable electronic publications and publications on recordable media, namely, books, magazines, newsletters, manuals, pamphlets, multimedia files, and magazine columns featuring non-fictional content of history and religious doctrine; audio and video recordings provided in analog and digital format featuring non-fictional content of history and religious doctrine; audio and video recordings that are downloadable to recordable media featuring books, seminars, movies, documentaries, and interviews of non-fictional content of history and religious doctrine; computer game software and DVDs, CD-ROMs, and downloadable digital media files containing such software featuring non-fictional content of history and religious doctrine</p>
<p>Class 016. All goods and services in the class are opposed, namely: Publications, namely, books, magazines, newsletters, pamphlets, guides, manuals, and syndicated newspaper columns featuring non-fictional content of history and religious doctrine; screenplays, books, guides, and manuals featuring fictional and non-fictional content of historical and religious events, persons, and activities; posters, calendars, note cards, greeting cards, stationery items, namely, pens, pencils, notebooks, notepads, stickers, binders, folders, writing paper and envelopes</p>

## 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)
Other	Tarnishment

## 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
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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	<p>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</p> <p>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</p> <p>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</p>		

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, and moral and religious values; providing on-line religious instruction promoting family values; providing information in the field of parenting concerning education and entertainment of children; and providing courses of instruction in the field of marital relations		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	MORMON		

Goods/Services	A wide variety of goods and services
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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 ) SECRET MORMON Opposition Brief.PDF ( 2 pages )(127356 bytes )
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### **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	07/13/2009

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, IRI and its affiliates and predecessors being collectively referred to herein as "Opposer".

2. Since at least as early as 1833, Opposer has 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, Kendal M. Sheets, is an individual with a business address at Sheets Law Office, LLC, 1855 MacArthur Drive, McLean, Virginia 22101.

8. On November 27, 2007, Applicant filed application Serial No. 77/337,325 for registration of the alleged mark "SECRET MORMON", and said application was published for opposition in the Official Gazette of the United States Patent and Trademark Office on June 30, 2009 in International Class 9 (U.S. Classes 21, 23, 26, 36, and 38) for "CD-ROMs, DVDs, magnetic tape cassettes, high definition digital disks featuring non-fictional content of history and religious doctrine; computer software for database management and interactive reading and research of electronically formatted books of history and religion; downloadable electronic publications and publications on recordable media, namely, books, magazines, newsletters, manuals, pamphlets, multimedia files, and magazine columns featuring non-fictional content of history and religious doctrine; audio and video recordings provided in analog and digital format featuring non-fictional content of history and religious doctrine; audio and video recordings that are downloadable to recordable media featuring books, seminars, movies, documentaries, and interviews of non-fictional content of history and religious doctrine; computer game software and DVDs, CD-ROMs, and downloadable digital media files containing such software featuring non-fictional content of history and religious doctrine", and International Class 16 (U.S. Classes 2, 5, 22, 23, 29, 37, 38, and 50) for "Publications, namely, books, magazines, newsletters, pamphlets, guides, manuals, and syndicated newspaper columns featuring non-fictional content of history and religious doctrine; screenplays, books, guides, and manuals featuring fictional and non-fictional content of

historical and religious events, persons, and activities; posters, calendars, note cards, greeting cards, stationery items, namely, pens, pencils, notebooks, notepads, stickers, binders, folders, writing paper and envelopes". The opposition deadline has been set for July 30, 2009.

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

10. The goods recited in Applicant's application are identical with or very similar to goods and services presently offered by Opposer, or offered in the past by Opposer, bearing the MORMON marks of Opposer.

11. The goods of Applicant bearing the alleged mark "SECRET MORMON" 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 connection with its MORMON marks.

12. The alleged "SECRET MORMON" 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, so as to dilute the distinctive quality of Opposer's MORMON marks which are believed to be famous, and so as to tarnish Opposer's MORMON marks.

13. Based upon the foregoing, registration of the "SECRET MORMON" mark depicted in application Serial No. 77/337,325 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 "SECRET MORMON", application Serial No. 77/337,325, be denied.