

ESTTA Tracking number: **ESTTA431659**

Filing date: **09/21/2011**

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                                  | 3M Company   |
| Granted to Date of previous extension | 09/21/2011   |
| Address                               | 3M Center, 2501 Hudson Road<br>St. Paul, MN 55114<br>UNITED STATES |

|                      |   |
|----------------------|---|
| Attorney information | William G. Barber<br>Pirkey Barber LLP<br>600 Congress Ave., Suite 2120<br>Austin, TX 78701<br>UNITED STATES<br>bbarber@pirkeybarber.com, shightower@pirkeybarber.com,<br>eolson@pirkeybarber.com, tmcentral@pirkeybarber.com,<br>trademarks@mmm.com Phone:512.322.5200 |
|----------------------|---|

**Applicant Information**

|                                |   |                                 |            |
|--------------------------------|---|---------------------------------|------------|
| Application No                 | 77405947  | Publication date                | 05/24/2011 |
| Opposition Filing Date         | 09/21/2011  | Opposition Period Ends          | 09/21/2011 |
| International Registration No. | NONE  | International Registration Date | NONE       |
| Applicant                      | Bi-Silque-Artigos Para Casa e Escritorio, S.A.<br>Av. Da Praia, Esmoriz<br>3880 Ovar,<br>PORTUGAL |                                 |            |

**Goods/Services Affected by Opposition**

|  |
|--|
| Class 016.<br>All goods and services in the class are opposed, namely: office articles, in particular presentation boards, dry erase writing boards and writing surfaces, dry erase boards for use with magnetic products, office combination boards comprised in part of dry erase boards and in part of bulletin boards, daily planners, desktop planners, markers, white board erasers, corkboard pushpins, presentation easels and flip chart pads |
| Class 020.<br>All goods and services in the class are opposed, namely: office furniture; bulletin boards   |

**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. | 1046353   | Application Date      | 12/29/1975 |
| Registration Date     | 08/17/1976  | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 PAPER AND CARDBOARD SHEET MATERIAL HAVING ADHESIVE COATING ON BOTH SIDES THEREOF FOR ATTACHMENT TO WALLS OR OTHER VERTICAL SURFACES TO HOLD DISPLAYS OR OTHER MESSAGES IN PLACE |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1198694   | Application Date      | 03/12/1981 |
| Registration Date     | 06/22/1982  | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery Notes Containing Adhesive on One Side for Attachment to Surfaces |                       |            |

|                       |  |                       |            |
|-----------------------|--|-----------------------|------------|
| U.S. Registration No. | 1208297  | Application Date      | 11/19/1981 |
| Registration Date     | 09/14/1982   | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT  |                       |            |
| Design Mark           |  |                       |            |
| Description of Mark   | NONE   |                       |            |
| Goods/Services        | Class 016. First use: First Use: 1981/10/01 First Use In Commerce: 1981/10/01 Trays for Holding Stationery Notes |                       |            |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 1284295   | Application Date      | 06/30/1983 |
| Registration Date     | 07/03/1984  | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 016. First use: First Use: 1983/01/01 First Use In Commerce: 1983/01/01 Adhesive Tape for Home and Office Use |                       |            |

|                   |         |                  |            |
|-------------------|---------|------------------|------------|
| U.S. Registration | 1935381 | Application Date | 11/14/1994 |
|-------------------|---------|------------------|------------|

|                     |  |                       |      |
|---------------------|--|-----------------------|------|
| No.                 |  |                       |      |
| Registration Date   | 11/14/1995   | Foreign Priority Date | NONE |
| Word Mark           | POST-IT  |                       |      |
| Design Mark         |  |                       |      |
| Description of Mark | NONE   |                       |      |
| Goods/Services      | Class 016. First use: First Use: 1994/05/24 First Use In Commerce: 1994/05/24 adhesive backed easel paper and easel pads |                       |      |

|                       |   |                       |            |
|-----------------------|---|-----------------------|------------|
| U.S. Registration No. | 2736421   | Application Date      | 09/04/2002 |
| Registration Date     | 07/15/2003  | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT   |                       |            |
| Design Mark           |   |                       |            |
| Description of Mark   | NONE  |                       |            |
| Goods/Services        | Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; [ glue sticks for stationery or office use;] and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place |                       |            |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3168105    | Application Date      | 11/11/2005 |
| Registration Date     | 11/07/2006 | Foreign Priority Date | NONE       |
| Word Mark             | POST-IT    |                       |            |

|                     |  |  |  |
|---------------------|--|--|--|
| Design Mark         | <h1>POST-IT</h1>   |  |  |
| Description of Mark | NONE   |  |  |
| Goods/Services      | Class 016. First use: First Use: 1974/09/25 First Use In Commerce: 1974/09/25 Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper |  |  |

|                       |            |                       |            |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3861083    | Application Date      | 04/16/2010 |
| Registration Date     | 10/12/2010 | Foreign Priority Date | NONE       |

|           |         |
|-----------|---------|
| Word Mark | POST-IT |
|-----------|---------|

|                     |   |  |  |
|---------------------|---|--|--|
| Design Mark         | <h1>POST-IT</h1>  |  |  |
| Description of Mark | NONE  |  |  |
| Goods/Services      | Class 016. First use: First Use: 2008/04/30 First Use In Commerce: 2008/04/30 Adhesive-backed paper pockets for attachment to surfaces; adhesive labels; adhesive-backed paper name badges; adhesive-backed craft paper |  |  |

|             |   |
|-------------|---|
| Attachments | 76446169#TMSN.gif ( 1 page )( bytes )<br>78751997#TMSN.jpeg ( 1 page )( bytes )<br>85015676#TMSN.jpeg ( 1 page )( bytes ) |
|-------------|---|

|  |
|--|
| 3MTM034 - NOO.pdf ( 6 pages )(552430 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 | /WGB/             |
| Name      | William G. Barber |
| Date      | 09/21/2011        |

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

|                               |   |                      |
|-------------------------------|---|----------------------|
| In Re Serial No. 77/405,947   | § |                      |
| Filed: February 26, 2008      | § |                      |
| Mark: <b>EARTH-IT</b>         | § |                      |
| Published: May 24, 2011       | § |                      |
|                               | § |                      |
| 3M Company,                   | § |                      |
|                               | § | Opposition No. _____ |
| Opposer,                      | § |                      |
|                               | § |                      |
| v.                            | § |                      |
|                               | § |                      |
| BI-SILQUE-ARTIGOS PARA CASA E | § |                      |
| ESCRITORIO, S.A.              | § |                      |
|                               | § |                      |
|                               | § |                      |
| Applicant.                    | § |                      |

**NOTICE OF OPPOSITION**

Opposer 3M Company, a Delaware corporation located at 3M Center, 2501 Hudson Road, St. Paul, Minnesota 55114, believes that it will be damaged by registration of the mark identified above, and hereby opposes same under the provisions of 15 U.S.C. § 1063. As grounds for opposition, Opposer asserts that:

1. Opposer develops and markets innovative products and solutions, including many consumer and office products, that serve a diverse field of customers. Opposer introduced the now-famous POST-IT brand of adhesive-based paper and stationery notes approximately thirty years ago. Since that time, Opposer has used the POST-IT mark extensively in connection with a variety of highly successful consumer and office-related products, including, without limitation, repositionable notes, adhesive-backed easel pads and paper, bulletin boards, dry-erase boards, and combination boards comprising in part dry-erase boards and in part bulletin boards.

Opposer's POST-IT mark is among the most famous marks in the United States, with very high brand awareness levels.

2. Opposer's POST-IT mark is famous within the meaning of 15 U.S.C. § 1125(c)(2)(A). *See Minnesota Min. & Mfg. Co. v. Taylor*, 21 F. Supp. 2d 1003, 1005, 48 USPQ2d 1701, 1702 (D. Minn. 1998) (finding POST-IT mark famous).

3. In addition to its extensive common-law rights, Opposer is the owner of numerous United States Trademark Registrations for its POST-IT mark. Opposer's registrations include, but are not limited to, those shown in the following chart:

| Registration Number | Date Issued | Goods (Class 16)   |
|---------------------|-------------|--|
| 1046353             | 8/17/76     | Paper and cardboard sheet material having adhesive coating on both sides thereof for attachment to walls or other vertical surfaces to hold displays or other messages in place  |
| 1198694             | 6/22/82     | Stationery notes containing adhesive on one side for attachment to surfaces  |
| 1208297             | 9/14/82     | Trays for holding stationery notes   |
| 1284295             | 7/3/84      | Adhesive tape for home and office use  |
| 1935381             | 11/14/95    | Adhesive backed easel paper and easel pads   |
| 2736421             | 7/15/03     | Stationery notes and note pads containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; cover-up tape for paper; tape flags; printed note forms; printed notes featuring messages, pictures or ornamental designs; adhesive-backed easel paper and easel pads; bulletin boards; and paper and cardboard sheet material having adhesive coatings on both sides for attachment to walls or other surfaces to hold displays or other messages in place   |
| 3168105             | 11/7/06     | Stationery notes containing adhesive on one side for attachment to surfaces; printed notes featuring messages, pictures or ornamental designs; note pads, business forms, index cards, index tabs, easel paper, easel pads, sketch pads, art pads, banners of paper, page markers, bookmarks and recipe cards containing adhesive on one side of the sheets for attachment to surfaces; adhesive tape for stationery or office use; labeling tape; cover-up tape for paper; correcting tape for type; tape flags; easels; display and message boards, adhesive backed strips and geometrical shapes made from cardboard for attachment to surfaces; dry erase writing boards and |

|         |          |   |
|---------|----------|---|
|         |          | writing surfaces; holders for stationery notes, notepads and tape flags; dispensers for tape flags and stationery notes for stationery use; ball point pens and highlighter pens containing tape flags; photo paper |
| 3861083 | 10/12/10 | Adhesive-backed paper pockets for attachment to surfaces; adhesive labels; adhesive-backed paper name badges; adhesive-backed craft paper   |

Each of the registrations listed in the preceding chart is valid and subsisting, and all but the last two are incontestable pursuant to 15 U.S.C. § 1065.

4. Applicant Bi-Silque-Artigos Para Casa e Escritorio, S.A. is a Portuguese corporation with a principal place of business at Avenida Da Praia, Esmoriz, 3880 Ovar, Portugal.

5. Applicant filed application Serial No. 77/405,947 (“the Application”) pursuant to 15 U.S.C. § 1126(d) on February 26, 2008, claiming a foreign filing date of January 30, 2008, for the mark EARTH-IT (“Applicant’s Mark”) for the following goods in Class 16: “office articles, in particular presentation boards, interactive presentation boards, dry erase writing boards and writing surfaces, dry erase boards for use with magnetic products, office combination boards comprised in part of dry erase boards and in part of bulletin boards, daily planners, desktop planners, markers, white board erasers, corkboard pushpins, presentation easels and flip chart pads,” and for the following goods in Class 20: “office furniture; bulletin boards.” The filing basis of the Application was later amended to 15 U.S.C. § 1126(e).

6. The Application was published in the *Official Gazette* on May 24, 2011. Opposer timely requested and received extensions of time until September 21, 2011 to file a Notice of Opposition.

7. Opposer has priority based on its prior use and registration of its mark POST-IT in the United States.

8. Opposer's mark POST-IT became famous long prior to Applicant's filing date or any priority date that Applicant may claim for Applicant's Mark.

9. Applicant's Mark is confusingly similar to Opposer's mark POST-IT. Applicant's mark is very similar to the mark POST-IT in sight, sound, meaning, and overall commercial impression. In particular, Applicant's Mark EARTH-IT and Opposer's mark POST-IT are comprised of a one-syllable terms followed by -IT. Moreover, 3M is committed to sustainable practices in connection with its formulation of POST-IT products, including but not limited to the use of recycled paper in many of 3M's POST-IT products. 3M's packaging and marketing of its POST-IT products have called attention to these and other sustainability efforts by 3M.

10. The goods in the Application are directly competitive with, or similar or related to, the goods for which Opposer uses and has registered its mark POST-IT.

11. Because the Application is unrestricted to any particular trade channel, Applicant's goods travel or will travel in the same channels of trade as Opposer's goods, and are or will be purchased and used by the same types of consumers who purchase and use Opposer's goods.

12. Opposer has not given Applicant permission or approval to use or register Applicant's Mark.

13. Applicant's Mark so resembles Opposer's mark POST-IT as to be likely, when used on or in connection with the identified goods of Applicant, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the products Applicant intends to offer under Applicant's Mark are produced, sponsored, endorsed, or approved by Opposer, or are in some way affiliated, connected, or associated with Opposer or its POST-IT brand products.

14. Opposer would be damaged by registration of Applicant's Mark, which should be refused under 15 U.S.C. §§ 1052(d) and 1063.

15. Applicant's Mark is likely to cause dilution by blurring of Opposer's famous mark POST-IT, and registration should therefore be refused under 15 U.S.C. § 1125(c).

16. Registration of Applicant's Mark would be inconsistent with Opposer's rights in the mark POST-IT and would be damaging to Opposer.

WHEREFORE, Opposer prays that Application Serial No. 77/405,947 be rejected, and that registration of Applicant's Mark be refused.

This Notice of Opposition is being filed electronically, along with the filing fee required by 37 C.F.R. § 2.6(a)(17). The Commissioner is authorized to draw on the Deposit Account of Pirkey Barber LLP, Account No. 50-3924/3MTM:034/SJH, if there is any problem with the processing of the electronically submitted fee.

Respectfully submitted,



---

William G. Barber  
Susan J. Hightower  
PIRKEY BARBER LLP  
600 Congress Avenue, Suite 2120  
Austin, Texas 78701  
(512) 322-5200  
ATTORNEYS FOR OPPOSER

Date: September 21, 2011

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing NOTICE OF OPPOSITION was served by first class mail on September 21, 2011 on counsel for the Applicant at the Correspondent address listed below:

David Ehrlich  
Fross Zelnick Lehrman & Zissu, P.C.  
866 United Nations Plaza  
New York, NY 10017-1822

  
\_\_\_\_\_