

ESTTA Tracking number: **ESTTA568840**

Filing date: **11/04/2013**

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	City of Baltimore
Granted to Date of previous extension	11/03/2013
Address	c/o Suzanne Sangree, Esq. 100 N. Holliday Street Baltimore, MD 21202 UNITED STATES

Correspondence information	City of Baltimore c/o Suzanne Sangree, Esq. 100 N. Holliday Street, Rm 109 Baltimore, MD 21202 UNITED STATES suzanne.sangree@baltimorecity.gov Phone:410 396-3249
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**Applicant Information**

Application No	85794867	Publication date	05/07/2013
Opposition Filing Date	11/04/2013	Opposition Period Ends	11/03/2013
Applicant	Riesett, Sandra L. 10122 Falls Road Lutherville, MD 21093 USX		

**Goods/Services Affected by Opposition**

Class 035. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: public advocacy to prevent animal cruelty and promote awareness of the importance of stopping animal abuse; promoting public awareness of cruelty, abuse and neglect shown to animals; and promoting public awareness of humane treatment of animals
Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: charitable fundraising services, namely raising money for animal welfare and public advocacy to prevent animal cruelty and promote the health, welfare and humane treatment of animals

**Grounds for Opposition**

False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Other	Opposed Mark was created by the City's agency, Outlaw Advertising, LLC, which is wholly owned by Applicant.

## Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	SHOW YOUR SOFT SIDE		
Goods/Services	"public advocacy to prevent animal cruelty and promote awareness of the importance of stopping animal abuse; promoting public awareness of cruelty, abuse and neglect shown to animals; and promoting public awareness of humane treatment of animals# in International Class 035; as well as #charitable fundraising services, namely raising money for animal welfare and public advocacy to prevent animal cruelty and promote the health, welfare and humane treatment of animals# in International Class 036.		

Related Proceedings	Sande Riesett v. Mayor and City Council of Baltimore, No. 1:13-cv-01860-GLR (U.S. District Court, District of Maryland)
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Attachments	Draft Notice of Opposition3.pdf(93294 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	/Suzanne Sangree/
Name	City of Baltimore
Date	11/04/2013

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

In the Matter of Applications:

Serial No. 85/794867  
SHOW YOUR SOFT SIDE  
Official Gazette : May 7, 2013

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Mayor and City Council  
of Baltimore,  
Opposer,

v.

Sandra L. Riesett,  
Applicant.

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TRADEMARK TRIAL AND APPEAL BOARD  
Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

The Mayor and City Council of Baltimore (“the City” or “the City of Baltimore”), a municipal corporation, with an address of c/o City Solicitor, City Hall, 100 N. Holliday Street, Baltimore, MD 21202, believes that it will be damaged by registration of the mark SHOW YOUR SOFT SIDE (hereinafter the "Opposed Mark") for: "public advocacy to prevent animal cruelty and promote awareness of the importance of stopping animal abuse; promoting public awareness of cruelty, abuse and neglect shown to animals; and promoting public awareness of humane treatment of animals" in International Class 035; as well as “charitable fundraising services, namely raising money for animal welfare and public advocacy to prevent animal cruelty and promote the health, welfare and humane treatment of animals” in International Class 036.

The mark SHOW YOUR SOFT SIDE is set forth in Application Serial No. 85/794867, filed on December 5, 2012, and published on May 7, 2013 (hereinafter the "SOFT SIDE Application"), filed by Sandra L. Riesett, Individual, with an address at 10122 Falls Road Lutherville, Maryland 21093 (hereinafter the "Applicant"). An initial Extension of Time was granted to September 4, 2013. A second Extension of Time to Oppose was granted to November 3, 2013, a Sunday.

The City opposes the Application, and as grounds for this opposition, alleges that:

1. Applicant's solely owned advertising agency, Outlaw Advertising LLC ("Outlaw"), created the Opposed Mark while working as the advertising agency of the City. The Opposed Mark has since its inception been the property of, and it has always been associated with, the City of Baltimore's Mayor's Anti-Animal Abuse Advisory Commission ("the Commission").
2. On October 8, 2010, the City enacted Baltimore City Ordinance 10-369 to create the Commission. The purpose of the Commission is to provide the services of promoting best practices for eradicating animal abuse in the City of Baltimore, raising awareness of animal cruelty laws, improving training for law enforcement officials on how to handle animal cruelty cases, and fostering improved responses to animal cruelty.
3. Shortly after, events in February 2011 in Baltimore regarding animal abuse, Applicant, the president and sole owner of Outlaw, approached Caroline Griffin, then Chair of the Commission, to ask if Outlaw could do anything to help the Commission with its work. At that time, neither Applicant nor Outlaw had created or even

- considered any materials or taglines that might have been used in the Commission's efforts.
4. At a subsequent meeting, Applicant professed to know very little about animal abuse and asked the Commission members to educate her about the incidence of animal abuse and the demographics of its perpetrators in the City of Baltimore, which the Commission members proceeded to do.
  5. Applicant next attended a meeting of the Commission, asking about the mission of the Commission and hearing ideas for a campaign.
  6. After a few months of work, Outlaw developed the Campaign on behalf of the City as Outlaw had promised. The Commission approved the advertisements and, in September 2011, issued a press release announcing its Campaign. The purpose of the Campaign was to further the Commission's services of promoting best practices for eradicating animal abuse in the City of Baltimore, raising awareness of animal cruelty laws, and fostering improved responses to animal cruelty.
  7. Unbeknownst to the City, on December 5, 2012, Applicant filed Application Serial Number 85/794867 in her own name to register the trademark SHOW YOUR SOFT SIDE.
  8. The City is the owner and user (by assignment or otherwise) of the common law trademark SHOW YOUR SOFT SIDE for goods and services in, inter alia, International Class 035 and 036, and has been continuously using SHOW YOUR SOFT SIDE since its first publication in September 2011 in U.S. commerce.
  9. Applicant does not have a priority date earlier than December 5, 2012 for the SHOW Opposed Mark.

10. In creating the Opposed Mark, Applicant was working as the agent of her solely owned advertising agency Outlaw, which in turn was the City's advertising agency. When an advertising agency creates a mark for a client, the client owns the mark. Thus, the City, as Outlaw's client owns the Opposed Mark.
11. The Opposed Mark so closely resemble the mark owned and previously used by the City that its use, in connection with the services aforementioned, is likely to cause confusion, or to cause mistake or deceive, in violation Section 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d). Purchasers likely will assume that the City is somehow affiliated with, licenses, or endorses, Applicant's use of the Opposed Mark when the City is not connected in any way with Applicant or the Opposed Mark.
12. The Opposed Mark so closely resemble the mark owned and previously used by the City that its use, in connection with the services aforementioned, is likely to cause confusion, or to cause mistake or deceive, in violation Section 43(a) of the Trademark Act of 1946, 15 U.S.C. § 1125(a). Consumers likely will assume that the City is somehow affiliated with, licenses, or endorses, Applicant's use of the Opposed Mark when the City is not connected in any way with Applicant or the use of the Opposed Mark.
13. The registration of the Opposed Mark will be inconsistent with the City of Baltimore's rights at common law and will be damaging to the City.



