

ESTTA Tracking number: **ESTTA623702**

Filing date: **08/27/2014**

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	08/27/2014
Address	2501 Hudson Road 3M Center St. Paul, MN 55144 UNITED STATES

Attorney information	Laura J. Borst Fulbright & Jaworski LLP 2100 IDS CENTER, 80 SOUTH EIGHTH STREET MINNEAPOLIS, MN 55402 UNITED STATES aoipdocket@nortonrosefulbright.com, laura.borst@nortonrosefulbright.com, kelle.pfertner@nortonrosefulbright.com Phone:612.321.2206
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**Applicant Information**

Application No	86066994	Publication date	04/29/2014
Opposition Filing Date	08/27/2014	Opposition Period Ends	08/27/2014
Applicant	TAIWAN HOPAX CHEMICALS MFG. CO., LTD. No. 28, Hua Dong Road, Daliao Dist. Kaohsiung City, 831 TAIWAN		

**Goods/Services Affected by Opposition**

Class 016. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Memo pads; writing paper pads; notepapers; note pads; bookmarkers; index cards;self-adhesive note pads; adhesive tapesfor stationery and household purposes; paper labels; marking tabs; self-adhesive paper labels
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Application No	86066998	Publication date	04/29/2014
Opposition Filing Date	08/27/2014	Opposition Period Ends	
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## 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. Registration No.	1447458	Application Date	12/09/1986
Registration Date	07/14/1987	Foreign Priority Date	NONE
Word Mark	MAGIC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1957/07/17 First Use In Commerce: 1957/07/17 ADHESIVE TAPE FOR STATIONERY OR HOUSEHOLD USE		

Attachments	Consolidated Notice of Opposition re MAGIC CUBE and MAGIC NOTES.pdf(141132 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	/Laura J. Borst/
Name	Laura J. Borst
Date	08/27/2014

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

In the matter of Application Serial Nos.: 86/066,994 and 86/066,998

By Taiwan Hopax Chemicals Mfg. Co., Ltd.

For the Marks: MAGIC CUBE & Design and MAGIC NOTES & Design

Filed: September 17, 2013

Published in the *Official Gazette* on April 29, 2014

3M Company,

Opposer,

v.

Taiwan Hopax Chemicals Mfg. Co., Ltd.

Applicant.

Opposition No. \_\_\_\_\_

**CONSOLIDATED NOTICE OF OPPOSITION**

3M Company (“3M Company” or “3M”), a Delaware corporation having a principal place of business at 3M Center, 2501 Hudson Road, St. Paul, Minnesota, 55144-1000, believes that it will be damaged by registration of the marks in Application Serial Nos. 86/066,994 and 86/066,998, and hereby opposes same under the provisions of 15 U.S.C. § 1063.

As grounds for opposition, 3M Company asserts that:

1. 3M is the owner of the MAGIC name and mark (collectively, the “MAGIC mark”). 3M adopted and commenced use of the MAGIC mark at least as early as 1957 in connection with adhesive tape for stationery and household use and has continuously used its MAGIC mark since that time. The packaging and advertising for 3M’s MAGIC products also bears the 3M house mark.
2. For many years, 3M has also sold under the 3M mark and other marks a wide variety of other stationery and office products, including self-adhesive paper notepads, memo pads, labels, and marking flags.

3. Over the years, 3M has also used its MAGIC mark and variations for a number of other products, including the mark MAGIC for lint and hair removal adhesive rollers and the marks BOW MAGIC and SASHEEN MAGIC for decorative ribbon products.

4. 3M's MAGIC mark is inherently distinctive as applied to 3M's products.

5. As a result of 3M's long use and extensive promotion of the MAGIC mark, the MAGIC mark has become distinctive to designate 3M, to distinguish 3M and its products from the products of others, and to distinguish the source or origin of 3M's products. As a result of 3M's efforts, the consuming public throughout the United States widely recognizes and associates the MAGIC mark with 3M and its products.

6. As a result of 3M's long use and extensive promotion of its MAGIC mark, 3M has acquired valuable common law rights in the MAGIC mark throughout the United States.

7. As a result of 3M's long use and extensive promotion of its MAGIC mark and the success of 3M's products sold under the MAGIC mark, the MAGIC mark has become famous.

8. In accordance with federal law, 3M has registered its MAGIC mark on the Principal Register of the United States Patent and Trademark Office and obtained U.S. Registration No. 1,447,458 covering "adhesive tape for stationery or household use" in International Class 16. This registration is valid and enforceable and is incontestable pursuant to 15 U.S.C. § 1065. A copy of this registration and printout of the TSDR record are attached hereto as **Exhibit A**.

9. Applicant Taiwan Hopax Chemicals Mfg. Co., Ltd. ("Applicant") seeks to register the marks MAGIC CUBE & Design (Serial No. 86/066,994); and MAGIC NOTES & Design (Serial No. 86/066,998) (together, "Applicant's marks") for "memo pads; writing paper pads; notepapers; note pads; bookmarkers; index cards; self-adhesive note pads; adhesive tapes for stationery and household purposes; paper labels; marking tabs; self-adhesive paper labels" in International Class 16 (collectively, "Applicant's goods").

10. 3M's MAGIC mark became famous prior to the priority date for Applicant's applications to register Applicant's marks and Applicant's use of Applicant's marks.

11. The marks that Applicant seeks to register so resemble 3M's MAGIC mark as to be likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive. Purchasers and prospective purchasers are likely to mistakenly believe that the goods of Applicant offered under Applicant's marks are sponsored, endorsed, or approved by 3M Company, or are in some way affiliated, connected, or associated with 3M.

12. The marks that Applicant seeks to register so resemble 3M's MAGIC mark as to be likely, when used on or in connection with Applicant's goods, to dilute the distinctive quality of the MAGIC mark, in violation of 15 U.S.C. § 1125(c).

13. Registration of Applicant's marks would be a source of damage to 3M because consumers are likely to attribute the source or sponsorship of Applicant's goods to 3M.

14. Registration of Applicant's marks would be a source of damage to 3M because these marks are likely to dilute the distinctive quality of 3M's MAGIC mark.

15. Registration of Applicant's marks would be a source of damage to 3M, as it would confer upon Applicant various statutory presumptions to which it is not entitled in view of 3M's long prior use of its MAGIC mark.

WHEREFORE, 3M prays that Application Serial Nos. 86/066,994 and 86/066,998 be rejected, and that registration of the marks therein be refused under 15 U.S.C. §§ 1052(d), 1063, and 1125(c).

The filing fee in the amount of \$600 as required by 37 C.F.R. § 2.6(a)(17) is being paid electronically via credit card with this Notice of Opposition. The Commissioner of Trademarks is authorized to draw on the deposit account of Fulbright & Jaworski, L.L.P., Account No. 50-

1212/THRT.T2106US.DS/MSM, in the event that anything prevents the successful completion of electronic payment of the filing fee.

Date: August 27, 2014

Respectfully submitted,

/s/Laura J. Borst

Laura J. Borst

Brandon M. Ress

FULBRIGHT & JAWORSKI LLP

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ATTORNEYS FOR OPPOSER  
3M COMPANY

## CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the Notice of Opposition has been served via First Class Mail to Applicant's Domestic Representative at the address below on this the 27<sup>th</sup> day of August, 2014:

BRENT E. ROUTMAN  
MERCHANT & GOULD P.C.  
PO BOX 2910  
MINNEAPOLIS, MINNESOTA 55402-0910  
UNITED STATES

/s/Kellie Voss Pfertner

# **EXHIBIT A**

Int. Cl.: 16

Prior U.S. Cl.: 5

**United States Patent and Trademark Office** **Reg. No. 1,447,458**  
Registered July 14, 1987

**TRADEMARK  
PRINCIPAL REGISTER**

**MAGIC**

MINNESOTA MINING AND MANUFACTUR-  
ING COMPANY (DELAWARE CORPORA-  
TION), AKA 3M  
3M CENTER  
SAINT PAUL, MN 55144

FIRST USE 7-17-1957; IN COMMERCE  
7-17-1957.

OWNER OF U.S. REG. NOS. 875,439, 1,322,118  
AND OTHERS.

FOR: ADHESIVE TAPE FOR STATIONERY  
OR HOUSEHOLD USE, IN CLASS 16 (U.S. CL.  
5).

SER. NO. 634,449, FILED 12-9-1986.

HENRY S. ZAK, EXAMINING ATTORNEY

**ADVISORY:** If you experience any trouble when clicking on the direct links to published records in Notices of Publication received via email and/or that appear in TSDR (Trademark Status and Document Retrieval), you can access the individual record by either 1) copying the link from the email or Notice of Publication in TSDR and pasting it into the url address of a supported browser (IE 10.0 or later and the latest versions of FireFox, Chrome or Safari); or 2) visiting the TMOG main page at <https://tmog.uspto.gov/>, selecting the Official Gazette issue date from the list of Issues in the upper left corner and then entering the 8 digit serial number in the box labeled "Search By" and clicking on the magnifying glass icon to execute the search.

STATUS

DOCUMENTS

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**Mark:** MAGIC

No Image exists for this case.

**US Serial Number:** 73634449

**Application Filing Date:** Dec. 09, 1987

**US Registration Number:** 1447458

**Registration Date:** Jul. 14, 1987

**Register:** Principal

**Mark Type:** Trademark

**Status:** The registration has been renewed.

**Status Date:** Jul. 27, 2007

**Publication Date:** Apr. 21, 1987

## Mark Information

**Mark Literal Elements:** MAGIC

**Standard Character Claim:** No

**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## Related Properties Information

**Claimed Ownership of US** [0875439](#), [1322118](#) and others  
**Registrations:**

## Goods and Services

### Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*.\* identify additional (new) wording in the goods/services.

For: ADHESIVE TAPE FOR STATIONERY OR HOUSEHOLD USE

International Class(es): 016 - Primary Class

U.S Class(es): 005

Class Status: ACTIVE

Basis: 1(a)

First Use: Jul. 17, 1957

Use in Commerce: Jul. 17, 1957

**Basis Information (Case Level)**

Filed Use: Yes

Currently Use: Yes

Filed ITU: No

Currently ITU: No

Filed 44D: No

Currently 44D: No

Filed 44E: No

Currently 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

**Current Owner(s) Information**

Owner Name: 3M Company

Owner Address: 2501 Hudson Road  
3M Center  
St. Paul, MINNESOTA 55144  
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

**Attorney/Correspondence Information****Attorney of Record**

Attorney Name: Michael L. Gannon

Docket Number: 04999

Attorney Primary Email [trademarks@mmm.com](mailto:trademarks@mmm.com)

Attorney Email Authorized: Yes

Address:

**Correspondent**

Correspondent Name/Address: Michael L. Gannon

3M Innovative Properties Company  
3M Center, 2501 Hudson Road  
220-9E-01  
St. Paul, MINNESOTA 55144  
UNITED STATES

Phone: 651 733 2099

Fax: 651 736 378

Correspondent e-mail: [trademarks@mmm.com](mailto:trademarks@mmm.com)

Correspondent e-mail Authorized: Yes

**Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Jul. 27, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	76533
Jul. 27, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Jul. 23, 2007	ASSIGNED TO PARALEGAL	76533
Jun. 26, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Jun. 26, 2007	TEAS SECTION 8 & 9 RECEIVED	
Mar. 22, 2007	CASE FILE IN TICRS	
Oct. 21, 1992	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Aug. 10, 1992	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Jul. 14, 1987	REGISTERED-PRINCIPAL REGISTER	
Apr. 21, 1987	PUBLISHED FOR OPPOSITION	
Mar. 21, 1987	NOTICE OF PUBLICATION	
Feb. 20, 1987	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 18, 1987	EXAMINER'S AMENDMENT MAILED	

**Maintenance Filings or Post Registration Information**

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

**Renewal Date:** Jul. 14, 2007

**TM Staff and Location Information**

**TM Staff Information - None**

**File Location**

**Current Location:** POST REGISTRATION

**Date in Location:** Jul. 27, 2007

**Assignment Abstract Of Title Information****Summary**

**Total Assignments:** 1

**Registrant:** MINNESOTA COMPANY

**Assignment 1 of 1**

**Conveyance:** MERGER AND CHANGE OF NAME

Reel/Frame: [2502/0547](#)

Pages: 40

Date Recorded: Apr. 30, 2002

Supporting Documents: [assignment-tm-2502-0547.pdf](#)**Assignor**Name: [MINNESOTA MINING AND MANUFACTURING  
COMPANY](#)

Execution Date: Apr. 08, 2002

Legal Entity Type: CORPORATION

State or Country Where  
Organized: DELAWARE**Assignee**Name: [3M COMPANY](#)

Legal Entity Type: CORPORATION

State or Country Where  
Organized: DELAWAREAddress: 3M CENTER  
2501 HUDSON ROAD  
ST. PAUL, MINNESOTA 55144**Correspondent**

Correspondent Name: JAMES F. VOEGELI

Correspondent Address: 3M CENTER, BLDG. 220-11W-01  
P.O. BOX 33427  
ST. PAUL, MINNESOTA 55133-3427**Domestic Representative - Not Found**[Proceedings - Click to Load](#)