

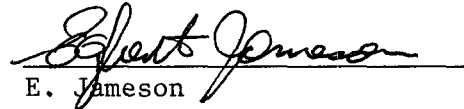
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Date of Deposit: March 19, 2003

I hereby certify that the attached Notice of Opposition, fee and transmittal letter, are being deposited with the United States Postal Service "Express Mail Post Office To Addressee" service under 37 C.F.R. Section 1.10 on the date indicated above and are addressed to BOX TTAB, FEE, Commissioner for Trademarks, United States Patent & Trademark Office, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

March 19, 2003


E. Jameson

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

In The Matter of Application Serial No. 76/285,382
Published In The Official Gazette of August 27, 2002



03-19-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #11

-----X
ESSENCE COMMUNICATIONS PARTNERS, :

Opposer, :

vs. :

OPPOSITION No.

UNIVERSAL COMMUNICATIONS OF
MIAMI, INC.,

Applicant. :

-----X

BOX TTAB
FEE

Commissioner For Trademarks
United States Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513

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NOTICE OF OPPOSITION

Essence Communications Partners (“Opposer”), a general partnership organized and existing under and by virtue of the laws of the State of Delaware, the general partners of which are ECI Holdings, Inc., a corporation organized and existing under and by virtue of the laws of the state of Delaware and TIE Holdings, Inc., a corporation organized and existing under and by virtue of the laws of the state of Delaware, having its office and principal place of business at 1500 Broadway, New York, New York 10036, believes that it will be damaged by the registration of the mark “ELITE TRAVELER THE ESSENCE OF LUXURY”, shown in Application Serial No. 76/286,560, in International Class 16 (Paper Goods and Printed Matter), filed on the 10th day of July, 2001, by Universal Communications of Miami, Inc. (“Applicant”), and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Applicant has requested registration, upon the Principal Register, under the provisions of the United States Trademark Act of 1946, as amended, of the mark “ELITE TRAVELER THE ESSENCE OF LUXURY” (“Applicant’s Mark”) for, “Periodical Magazines in the Field of Travel, Leisure, Life Styles, Entertainment, Dining and Tourism,” in International Class 16, based upon alleged use in commerce on August 27, 2001, all as is evidenced by the publication of said mark in the August 27, 2002 issue of the *OFFICIAL GAZETTE* of the United States Patent and Trademark Office.

2. The mark “ESSENCE” (Registration Number 1,131,774) (“Opposer’s Mark”) was registered, on the Principal Register of the United States Patent and Trademark Office, as the title of a magazine, in International Class 16, on March 11, 1980. It was registered on behalf of Opposer’s predecessor in interest and general partner, ECI Holdings, Inc., then

known as Essence Communications Inc. By nunc pro tunc assignment, as of October 19, 2000, Opposer's Mark was assigned to Opposer by its predecessor in interest.

3. The Opposer and its predecessor in interest have, since 1970, used Opposer's Mark as the title of a magazine. ESSENCE is a lifestyle magazine, targeted to black women and includes interviews, departments, articles, stories, commentary and advertisements concerning matters of particular interest to women. Many of the articles, stories and advertisements that appear in Opposer's magazine concern topics relating to travel, leisure, life styles, entertainment, dining and tourism.

4. ESSENCE is distributed on a nationwide basis and presently has a circulation of approximately 1 million and a total readership of approximately 7 million.

5. Prior to and since the first publication of ESSENCE, Opposer and its predecessor in interest have spent substantial sums in, and devoted substantial time to, advertising the periodical, marketing the publication to advertisers and advertising agencies and in establishing readership through newsstand sales and subscriptions. As a result of their efforts, Opposer and its predecessor in interest have established substantial goodwill in the title ESSENCE and ESSENCE has come to be widely recognized by readers and advertisers and by potential readers and potential advertisers as the title of perhaps the leading magazine published in the United States for black women.

6. Applicant seeks to register its mark "ELITE TRAVELER THE ESSENCE OF LUXURY" for a periodical magazine, an item identical to that sold under Opposer's Mark.

7. There is no issue as to priority. Applicant's application for registration alleges use in commerce on August 27, 2001. The registration of Opposer's Mark is based upon use in commerce in 1970, well prior to the date Applicant alleges its mark was first used. Opposer and its predecessor in interest sold goods in commerce under Opposer's Mark prior to the use in commerce, by Applicant, of the mark of the Application.

8. The word "ESSENCE" is a major component of Applicant's Mark. The word is identical to Opposer's Mark.

9. Applicant's Mark, when used in connection with its magazine, is likely to be confused with, and mistaken for Opposer's Mark. The Applicant's Mark is so similar to Opposer's Mark so as to cause confusion and to lead to confusion as to the origin of Applicant's magazine.

10. Accordingly, if the Applicant is permitted to use and register its mark for a magazine, confusion in trade, resulting in damages and injury to the Opposer, would be caused as a result of the similarity between the Applicant's Mark and the Opposer's Mark and the similarity between the goods of the Applicant and those of the Opposer. Any such confusion could result in financial loss to the Opposer. Furthermore, to the extent that the magazine sold under Applicant's mark does not meet the standards of quality and value provided by Opposer under Opposer's Mark, such would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its magazine sold and provided under Opposer's Mark.

11. If the Applicant is granted the registration herein opposed, it would thereby obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

WHEREFORE, Opposer prays that the Application Serial No. 76/286,560 be rejected for registration.

A duplicate copy of this Notice of Opposition and the fee required by Section 2.6(a)(17) are enclosed herewith.

New York, New York
March 16, 2003

Respectfully submitted,

ESSENCE COMMUNICATIONS PARTNERS
Opposer

By: 

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TRADEMARK TRIAL AND
APPEAL BOARD

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March 18, 2003

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VIA EXPRESS MAIL

Honorable Commissioner for Trademarks
Trademark Trial and Appeal Board
U.S. Patent and Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202-3513
BOX TTAB
FEE



03-19-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #11

Re: Mark: "ELITE TRAVELER THE ESSENCE
OF LUXURY"
Applicant: Universal Communications of Miami, Inc.
Serial No.: 76/286,560
Class: International Class 16
Opposer: Essence Communications Partners
Notice of Opposition with Consent

Dear Commissioner:

Enclosed, on behalf of Opposer, Essence Communications Partners, are duplicate originals of a Notice of Opposition, opposing registration, in International Class 16, of the Trademark "ELITE TRAVELER THE ESSENCE OF LUXURY".

Also enclosed is our check in the sum of \$300 representing the fee for filing the Notice of Opposition.

A Certificate of Mailing by "Express Mail" is endorsed on the Notice of Opposition.

Kindly confirm receipt of the foregoing on the enclosed self-addressed, stamped postcard and return the postcard to me.

Very truly yours,


Michael J. Saltser

Enclosures

cc: Harry Dedyo
Charles Hamilton, Esq.
Stephen J. Quigley, Esq.

LM