

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

National Institute on Media and the Family,)

Opposer,)

v.)

MediaWise, Inc., f/k/a Kansas City Alliance for)
Nonviolent Programming,)

Applicant.)

Opposition No. 125,296

Serial No. 75/595,360

Mark: **MEDIAWISE**



04-15-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #39

AMENDED NOTICE OF OPPOSITION

TO: Assistant Commissioner for Trademarks, Box TTAB-FEE, 2900 Crystal Drive,
Arlington, Virginia 22202-3513

Applicant MediaWise, Inc., through its attorneys, J. David Wharton and Constance M.
Jordan, Stinson Morrison Hecker LLP, 1201 Walnut, Suite 2800, Kansas City, MO
64106-2150.

Sir:

In the matter of Trademark Application Serial No. 75/595,360, filed November 25, 1998,
and published in the April 4, 2000 issue of the Trademark Official Gazette. The period of time
in which to file a Notice of Opposition was originally set to expire on May 4, 2000. On April 28,
2000, Opposer filed a Request for Extension of Time to File a Notice of Opposition until August
2, 2000. This Request was granted by the Board on May 12, 2000. On August 1, 2000, Opposer
filed a Consented Request for Extension of Time to File a Notice of Opposition until October 1,
2000. This Request was granted by the Board on August 8, 2000. On October 2, 2000,¹
Opposer filed a Consented Request for Extension of Time to File a Notice of Opposition until
October 31, 2000. This Request was granted by the Board on October 6, 2000.

¹ Because October 1, 2000 was a Sunday, the deadline for filing a Notice of Opposition or Extension Request was extended to Monday, October 2, 2000.

Opposer, National Institute on Media and the Family (“National Institute”), a Minnesota nonprofit corporation with its offices at 2450 Riverside Avenue, Minneapolis, Minnesota 559454, believes that it will be damaged by registration by the applicant of the mark **MEDIAWISE** for “workshops and seminars in the field of media literacy and anti-violence training” in International Class 41, and hereby opposes Application Serial No. 75/595,360 under the provisions of Title 15 of the U.S. Code, including, but not limited to, Sections 1052 and 1063. As grounds for opposing the registration, it is alleged as follows:

1. Opposer is the owner of common law rights in the United States for the mark **MEDIAWISE**, used to identify newsletters and printed educational materials relating to media literacy and advertising. Opposer first began use of the **MEDIAWISE** mark to identify its goods at least as early as February 20, 1998, and first began use of the mark in interstate commerce at least as early as February 25, 1998. The mark has been in such use continuously since that date.
2. Applicant filed its **MEDIAWISE** application on November 25, 1998, claiming first use of the mark on April 6, 1998, and first use of the mark in commerce on April 13, 1998.
3. Opposer has an application to register its **MEDIAWISE** mark pending in the U.S. Patent and Trademark Office, Serial No. 75/762,983. Registration of this mark has been refused under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), based on Applicant’s mark. Thus Opposer is and will be damaged by the registration of Applicant’s mark.
4. Opposer has superior and paramount rights as compared to Applicant, and Opposer has used the trademark and service mark **MEDIAWISE** in commerce continuously since prior to Applicant’s filing date.
5. Use by Applicant of the trademark **MEDIAWISE** for which registration is sought in the application opposed herein is without Opposer’s consent or permission.

6. Applicant's services and Opposer's goods are closely related and appeal to the same class of consumers.

7. Opposer's **MEDIAWISE** mark and Applicant's **MEDIAWISE** mark are identical in appearance, sound, and in connotation as provided under Section 2(d) of the Lanham Act, and are likely to cause confusion, or to cause mistake, or to deceive a substantial number of people to believe, mistakenly, that Applicant's services originate from, or are approved by, or are in some way associated with Opposer. Accordingly, Opposer's goodwill and reputation have been and will be damaged and jeopardized by Applicant's use and registration of its **MEDIAWISE** mark.

8. Applicant is no longer an active corporation.

9. Applicant has abandoned all use of the **MEDIAWISE** name and mark, and upon information and belief, does not intend to resume such use.

WHEREFORE, Opposer National Institute prays that Application Serial No. 75/595,360 be rejected, that the registration of the mark therein shown for the goods therein specified be refused, and that the present opposition be sustained.

Dated: April 15, 2003

DORSEY & WHITNEY LLP

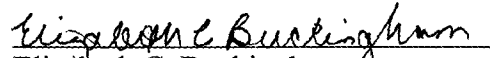
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Attorneys for Opposer National
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CERTIFICATE OF SERVICE

I hereby certify that the foregoing documents have been served via first-class mail, postage pre-paid to J. David Wharton and Constance M. Jordan, Stinson Morrison Hecker LLP, 1201 Walnut, Suite 2800, Kansas City, MO 64106-2150, this 7th day of April, 2003.


Elizabeth C. Buckingham

Good Cause

In or around the summer of 2002, Opposer National Institute first had reason to believe that Applicant MediaWise, Inc. ("MediaWise") was no longer an active corporation and was no longer using the MEDIAWISE name or mark in commerce. Over the next several months, National Institute and its counsel attempted unsuccessfully to confirm these facts on their own and with counsel for Applicant. In January 2003, National Institute hired an investigator to research the corporate status and current use of the MEDIAWISE mark by Applicant. The investigator hired by National Institute reported that MediaWise no longer had an active business location and that there is no current telephone listing for MediaWise. The investigator also confirmed that the MediaWise corporation had been dissolved in Missouri and Kansas in 2002 for failure to file an annual report.

Applicant attempted to further confirm these facts by serving discovery on counsel for MediaWise on March 10, 2003. As of the date of this motion, Applicant has received no response to its requests.

Therefore, Opposer believes it has good cause at this time to plead abandonment of the MEDIAWISE mark and application by Applicant. Opposer respectfully requests that the Board grant its motion to amend its Notice of Opposition as shown in Exhibit A to this motion.

Dated: April 15, 2003

DORSEY & WHITNEY LLP

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April 15, 2003

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04-15-2003

U.S. Patent & TMOfr/TM Mail Rcpt Dt. #39

Re: Opposer's Motion to Amend Notice of Opposition
Serial No. 75/595,360
Mark: **MEDIAWISE**

Dear Commissioner:

Enclosed herewith please find Opposer's Motion to Amend Notice of Opposition, attached Exhibit A, and a postcard acknowledging receipt of the above.

Please return the postcard with the stamped date of receipt.

Very truly yours,

Elizabeth C. Buckingham
Elizabeth C. Buckingham