

M&G 7320.71USTA

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

In the Matter of Trademark Application:



Serial No. 75/936,115
Trademark: MARKETPLACE TELEVISION and Design
Filed: March 6, 2000

06-10-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

For: Preparation and dissemination of video and audio point-of-purchase advertising;
installation and maintenance of electronic advertising systems for point-of-purchase
advertising

International Classes: 35 & 37
First Use: March 12, 1999
First Use in Commerce: March 12, 1999
Published in the Official Gazette of May 6, 2003

MINNESOTA PUBLIC RADIO)
)
)
vs.) Opposer,)
)
)
MARKETPLACE TELEVISION, INC.)
)
)
)
)
Applicant.)

Opposition No. _____

NOTICE OF OPPOSITION

Minnesota Public Radio, a corporation organized under and existing under the laws of Minnesota, having its principal place of business at 45 East Seventh Street, St. Paul, MN 55101 (hereinafter referred to as "Opposer"), believes that it may be damaged by the registration of the mark MARKETPLACE TELEVISION and Design, shown in trademark application Serial No. 75/936,115, and hereby opposes the same.

The grounds for oppositions are as follows:

1. By the application herein opposed, Applicant is seeking to obtain under the provisions of the Trademark Act of 1946, as amended, registration upon the Principal Register of the mark MARKETPLACE TELEVISION and Design as a trademark for "preparation and dissemination of video and audio point-of-purchase advertising; and installation and maintenance

of electronic advertising systems for point-of-purchase advertising" in International Classes 35 and 37.

2. Opposer produces and broadcasts a continuing radio program series called MARKETPLACE and has done so since at least as early as 1995. Attached as Exhibit A is a website page that discusses Opposer's MARKETPLACE program.

3. Opposer owns U.S. Registration No. 2,581,025 for MARKETPLACE for "providing information in the field of business news and information by means of a global computer information network; and entertainment services, namely, a continuing program series in the field of business news and information, provided through radio." This registration is valid, subsisting, unrevoked and uncanceled, and is prima facie evidence of the validity of Opposer's ownership of the marks shown therein, and is conclusive evidence of Opposer's exclusive right to use the mark therein in commerce in connection with the services described therein without condition or ill imitation. This registration is constructive notice of Opposer's claim of ownership of the mark, all as provided by Sections 7 (b), 22, 33 (a) of the Trademark Act of 1946, as amended.

4. Opposer owns U.S. Registration No. 2,638,200 for MARKETPLACE and Design for "providing information in the field of business news and information by means of a global computer information network; and entertainment services, namely, a continuing program series in the field of business news and information, provided through radio." This registration is valid, subsisting, unrevoked and uncanceled, and is prima facie evidence of the validity of Opposer's ownership of the marks shown therein, and is conclusive evidence of Opposer's exclusive right to use the mark therein in commerce in connection with the services described therein without condition or ill imitation. This registration is constructive notice of Opposer's

claim of ownership of the mark, all as provided by Sections 7 (b), 22, 33 (a) of the Trademark Act of 1946, as amended.

5. Opposer owns U.S. Registration No. 2,546,462 for MARKETPLACE MORNING REPORT in association with "education and entertainment services, namely, a continuing program series in the field of business news and information, provided through radio; and providing radio programming and information in the field of business news via a global computer network." This registration is valid, subsisting, unrevoked and uncancelled, and is prima facie evidence of the validity of Opposer's ownership of the marks shown therein, and is conclusive evidence of Opposer's exclusive right to use the mark therein in commerce in connection with the services described therein without condition or ill imitation. This registration is constructive notice of Opposer's claim of ownership of the mark, all as provided by Sections 7 (b), 22, 33 (a) of the Trademark Act of 1946, as amended.

6. Opposer owns Serial No. 76/349,347, filed December 13, 2001, which is a published U.S. application for MARKETPLACE MINUTES, in association with "providing information in the field of business news and information by means of a global computer network; and educational and entertainment services, namely, a continuing radio program series in the field of business news and information.

7. Opposer owns Serial No. 78-208, 906 for MINNESOTA PUBLIC RADIO & Design, and Opposer has been using this design mark since at least as early as January 2, 2003 for radio broadcasting services; the production and distribution of radio programs; and entertainment services. The design depicted in this application shall be referred to as the "Sound Wave Design" herein.

8. Prior to Applicant's application for MARKETPLACE TELEVISION and Design, Opposer adopted and used, and is still using, the marks MARKETPLACE, MARKETPLACE and Design, MARKETPLACE MINUTES, and MARKETPLACE MORNING REPORT (the MARKETPLACE Family of Marks") in connection with the services described in the above paragraphs.

9. Opposer has continuously used the marks MARKETPLACE, MARKETPLACE and Design, MARKET MORNING REPORT as noted above and has not abandoned its use of the MARKETPLACE Family of Marks.

10. Opposer has continuously used the Sound Wave Design as noted in paragraph 7 and has not abandoned its use of the Sound Wave Design.

11. Consumers and potential consumers are likely to be confused, or to be mistaken, or to be deceived into the belief, contrary to fact, that the services of Applicant emanate from, or are sponsored by Opposer, all to Opposer's irreparable damage.

12. The mark MARKETPLACE TELEVISION and Design for which Applicant seeks registration is so similar in meaning, sound, appearance and significance to Opposer's previously used and registered MARKETPLACE Family of Marks to be likely to cause confusion, mistake or to deceive within the meaning of Section 2 (d) of the Trademark Act of 1946, all to Opposer's irreparable damage and loss.

13. Because Opposer's use of its MARKETPLACE Family of Marks has been continuous for a significant period of time prior to the date Applicant filed for registration of the mark MARKETPLACE TELEVISION and Design, there is no issue as to the priority of Opposer's use of its Family of MARKETPLACE Marks with respect to Applicant's application for the mark MARKETPLACE TELEVISION and Design.

14. Upon information of belief, the services to be provided by Applicant under the mark MARKETPLACE TELEVISION, and the services provided by Opposer under its MARKETPLACE Family of Marks, are closely related.

15. Opposer alleges, upon information and belief that the services of Applicant and those of Opposer are or are likely to be distributed and provided in coincident geographical areas through the same or commercially related channels of trade to the same type of consumers.

16. Recipients of Applicant's services under the designation MARKETPLACE TELEVISION are likely to be confused, mistaken, or deceived into the belief, contrary to fact, that Applicant's services originate with and/or are in some way sponsored or approved by Opposer, all to Opposer's irreparable damage.

17. Upon information and belief, Applicant has abandoned its use of MARKETPLACE TELEVISION and Design.

18. Applicant is not entitled to the registration sought in the opposed application for the reasons that Applicant is not the owner of the mark sought to be registered within the meaning of Section 1 of the Trademark Act of 1946 and, further, is not entitled to the exclusive use of the designation MARKETPLACE TELEVISION and Design in commerce which may lawfully be regulated by Congress among the several states because of the prior use of a confusingly similar Family of Marks by Opposer.

19. If Applicant is granted registration of its claimed mark MARKETPLACE TELEVISION and Design, herein opposed, it would thereby obtain the prima facie exclusive right to use such mark, and such registration would be a source of damage and injury to Opposer.

20. The use by Applicant of the designation MARKETPLACE TELEVISION and Design in connection with the services described in the opposed application is without Opposer's consent or permission.

Please direct all correspondence to the attention of Linda M. Byrne, 3200 IDS Center, 80 South Eighth Street, Minneapolis, Minnesota 55402-2215, telephone: 612.336.4615.

The Opposer hereby appoints Linda M. Byrne, and the attorneys of Merchant & Gould, Minneapolis, Minnesota to be its attorneys in this matter, with full power of substitution and revocation, to represent it in this proceeding and to transact all business in the U.S. Patent and Trademark Office connected therewith.

The required fee of \$300 is enclosed. Please charge any excess fees to the deposit account of Opposer's counsel: Deposit Account No. 13-2725. This Notice of Opposition is being submitted in duplicate.

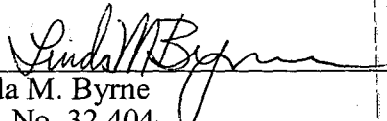
WHEREFORE, Opposer prays that the present opposition be sustained and the registration by Applicant be refused.

Respectfully submitted,

MINNESOTA PUBLIC RADIO

By Its Attorneys,

Date: 6/5/03


Linda M. Byrne
Reg. No. 32,404
MERCHANT & GOULD, P.C.
P.O. Box 2910
Minneapolis, Minnesota 55402-2215
612.336.4615

Attorneys for Opposer

Enclosures: Exhibit A
Check for \$300



Thursday, June 5, 2003

- Stations
- Features
- Cast & Crew
- About
- Bookshelf
- Comments
- Jobs
- Underwriters
- Archives
- Discussions

MARKETPLACE

Host:



David Brancaccio

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Source: Associated Press on Newsday.com, New York

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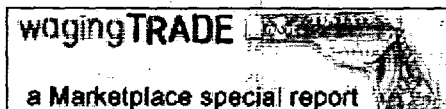
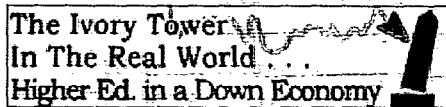
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Thursday, June 5, 2003

MARKETPLACE

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- Discussions

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David Brancaccio

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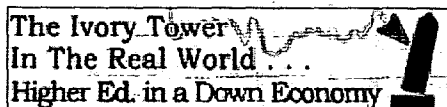
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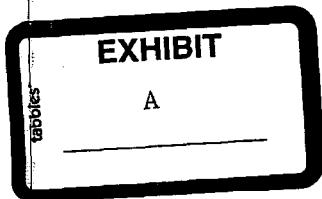
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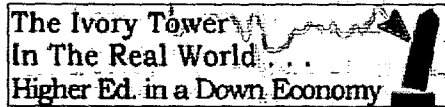
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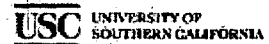
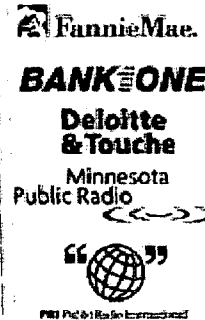
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v.)
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Opposer)

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Mark: MARKETPLACE TELEVISION
Serial No.: 75/936,115
Docket Number: 7320.71USTA
Official Gazette: May 6, 2003

Due Date: June 6, 2003
Filing Date:

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Commissioner for Trademarks, Box TTAB, 2900 Crystal Drive, Arlington, VA 22202-3513, on June 5, 2003.

By: *Jamie Holden*
Name: Jamie Holden

Commissioner for Trademarks
Box FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Commissioner:

We are transmitting herewith the attached:

- Return postcard.
- Transmittal Sheet in duplicate containing Certificate Under 37 C.F.R. 1.8
- Notice of Opposition (1 Original and 1 Copy)
- Check in the amount of \$300 to cover Filing Fee.

Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate copy of this sheet is enclosed.

By: *Linda M. Byrne*
Name: Linda M. Byrne
Reg. No.: 32,404
LMB:jrh

(CONTESTED MATTER)