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



In the matter of Application Serial No. 76/415,147  
Published in the *Official Gazette* on April 15, 2003

06-12-2003

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

BOOK PASSAGE, INC.  
a California Corporation

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

Opposer,

v.

BORDERS PROPERTIES, INC. a  
Delaware Corporation

Applicant.

06 Jun 20 03 10:30 AM

NOTICE OF OPPOSITION

This opposition is filed by Book Passage, Inc. a California corporation with a business address of 51 Tamal Vista Boulevard Corte Madera, CA 94925/ (the "Opposer" or "Book Passage"). Books Passage believes it will be damaged by the registration of the mark GREAT COOKS & THEIR BOOKS as shown in United States Application Serial No. 76/415,147 (the "Application") and hereby opposes the same.

A description of the Application is as follows:

Mark: GREAT COOKS & THEIR BOOKS

Serial No.: 76/415,147 ; 06/18/2003 SEDWARDS 00000176 76415147

Filed: May 31, 2002 ; 01 FC:6402 300.00 OP

Published: April 15, 2003

Basis: 1(a)

Class: 41

Services: Conducting entertainment exhibitions in the nature of food and wine tasting.

1 Opposer hereby opposes the Application and alleges the following:

2 1. On May 31, 2002, Borders Properties, Inc. ("Borders" or "Applicant"), a Delaware  
3 corporation having a business address of 100 Phoenix Drive, Ann Arbor, Michigan, filed a  
4 service mark application seeking registration of the mark GREAT COOKS & THEIR BOOKS for  
5 "conducting entertainment exhibitions in the nature of food and wine tasting and educational  
6 services, namely, conducting seminars and workshops in the field of food and wine tasting." The  
7 Application was published in the *Official Gazette* on April 15, 2003.

8 2. Book Passage, since at least as early June 1995, has been using continuously and  
9 pervasively its service mark COOKS WITH BOOKS in connection with a series of dining with  
10 cookbook writers events in which customers sign up for a COOKS WITH BOOKS event, receive  
11 an autographed copy of a book by a noted chef and share a meal with that chef prepared from the  
12 cookbook they received. Along with the food, customers are treated to compatible wines to  
13 enjoy.

14 3. Book Passage was founded in 1982 by Bill and Elaine Petrocelli. In addition to  
15 providing an unrivaled selection of books on all subjects including travel, history, public affairs,  
16 fiction mysteries and children's books, since its inception Book Passage has created an  
17 environment in which authors, writers, and book lovers could participate in educational and  
18 entertaining events such as writers' classes and workshops, children's story time, conferences of  
19 travel and mystery writers, author's readings and book groups. The activities of Book Passage  
20 are chronicled in its bimonthly newsletter Book Passage News and Reviews and its website  
21 [www.bookpassage.com](http://www.bookpassage.com)

22 4. Book Passage's use of the mark COOKS WITH BOOKS has been valid and  
23 continuous since June, 1995, and has not been abandoned. The COOKS WITH BOOKS mark is  
24 symbolic of extensive good will and consumer recognition built by Book Passage through  
25 substantial advertising and promotion, including displays in the bookstore, on the company  
26 website and through its electronic newsletter the *B.P. Fortnightly*. The mark is also promoted  
27 through regular press releases and the Books Passage News & Reviews newsletter which is  
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1 distributed every two months to over 40,000 readers. The COOKS WITH BOOKS events are  
2 prominently featured on either the front or back cover of the newsletter.

3 5. Book Passage started COOKS WITH BOOKS events with a restaurant called the  
4 Island Café near its Corte Madera location and then switched to another restaurant called  
5 Savannah Grill. Since at least 1997, the events have been held at the Left Bank restaurant in  
6 Larkspur, California. Yearly, Book Passage presents one or more extremely well-attended  
7 COOKS WITH BOOKS events each month on the average. The events feature such well-known  
8 cookbook authors as Nigella Lawson, Jacques Pepin, Victoria Wise, Carol Field, Bruce Aidell  
9 and Hubert Keller, to name a few. Book Passage has plans not only to continue and expand its  
10 COOKS WITH BOOKS offerings, but to add additional locations. For example, Book Passage is  
11 opening a new retail location in San's Francisco's newly refurbished Ferry Building. The great  
12 hall of the building will house some of the best food purveyors in California, making the Book  
13 Passage San Francisco location ideal for COOKS WITH BOOKS events.

14 6. Book Passage is informed and believes and on that basis alleges that in or about  
15 2001, there was an attempt to stage a dining/cookbook writer event sponsored by Borders at the  
16 Pleasant Hill branch of the Left Bank restaurant. Book Passage is informed and believes that the  
17 event was planned to be exactly like those conducted by Book Passage in the Larkspur restaurant,  
18 including use of the COOKS WITH BOOKS name and mark. Book Passage is informed and  
19 believes and on that basis alleges that Borders attempted to obtain information on how the Book  
20 Passage program was set up, managed and promoted in order to duplicate Books Passage's  
21 COOKS WITH BOOKS events. When Book Passage indicated to the Left Bank restaurant its  
22 opposition to the use of its service mark by Borders, the event was dropped. The Left Bank  
23 restaurant later collaborated with a bookstore other than Borders to sponsor a cookbook writer's  
24 event at the restaurant's Menlo Park location, using the mark: AUTHORS A LA CARTE. This  
25 mark does not pose a likelihood of confusion with the COOKS WITH BOOKS mark, as does  
26 GREAT COOKS & THEIR BOOKS.

27 7. Because of the attempted use of the Book Passage mark in 2001, notice of  
28 Borders' current trademark application for GREAT COOKS & THEIR BOOKS (a mark

1 allegedly used by Borders since 1997) raises concerns that the maturation of the Application  
2 would result in confusion, deception and mistake. The similarity of the marks COOKS WITH  
3 BOOKS and GREAT COOKS & THEIR BOOKS in appearance, sound and connotation,  
4 combined with the description of use in the Application, suggests that Borders will use the  
5 GREAT COOKS & THEIR BOOKS service mark with exactly the same kind of restaurant events  
6 as the COOKS WITH BOOKS events, featuring the author, the book and the sampling of food  
7 and wines described in the author's book.

8           8.       The maturation of the Application into a registration would cause likelihood of  
9 confusion, mistake or deception with respect to the source or affiliation of the events. Customers  
10 will erroneously believe that Borders events are produced or sponsored by, or associated with  
11 Book Passage in light of the similar words and the apparently identical nature of the services.

12           9.       Book Passage, through its newsletter and website, reaches a national and  
13 international audience and intends to use its COOKS WITH BOOKS mark for events in  
14 restaurants in other areas.

15           10.      Book Passage would be damaged by the registration of Applicant's mark, which  
16 would give Applicant a *prima facie* exclusive right to use the mark GREAT COOKS & THEIR  
17 BOOKS, despite Book Passage's priority over the Applicant and the likelihood of confusion and  
18 injury to Books Passage's goodwill.

19           11.      The similarity of the respective marks and the related nature of the goods and  
20 services of the respective parties mean that Applicant's mark so closely resembles Opposer's  
21 mark, previously used in the United States and not abandoned, as to be likely to cause confusion,  
22 mistake and deception.

23           WHEREFORE, Book Passage prays that the Application be rejected , and that the mark  
24 therein sought for the goods identified in International Class 41 be denied and refused.

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1 A duplicate copy of this Notice of Opposition and a check in the amount of \$300.00 covering the  
2 filing fee are enclosed herewith.

3 Dated: June 12, 2003

Respectfully submitted,

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**CERTIFICATE OF EXPRESS MAILING**

Express Mail Label Number: EG210191702US  
Date of Deposit: June 12, 2003

I hereby certify that the original and one copy of this Notice of Opposition are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" on the date indicated above and is addressed to the Commissioner for Trademarks, Box TTAB – Fee, 2900 Crystal Drive, Arlington, VA 22202-3513.

Signature:   
Name: Katharine Livingston, Esq.