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Attorney Docket No.: 237151US33

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

_____))
 VERBATIM CORPORATION,))
))
 Opposer,))
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 v.))
))
 VANENBURG GROUP B.V.,))
))
 Applicant.))
 _____)


 05-23-2003
 U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #40

Opposition No.: _____
 Appln. Serial No. 76/409,002

Honorable Commissioner of Trademarks
 2900 Crystal Drive
 Arlington, VA 22202-3514


 05-23-2003
 U.S. Patent & TMOfc/TM Mail Rcpt Dt. #39

NOTICE OF OPPOSITION

VERBATIM CORPORATION, a corporation duly organized and existing under the laws of the State of California, located and doing business at 1200 W. T. Harris Boulevard, Charlotte, North Carolina 28262 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 76/409,002, filed May 16, 2002, under the Trademark Act of 1946, in the name of Vanenburg Group B.V., published for opposition in the *Official Gazette* of March 25, 2003, Vol. 1268, No. 4, at Page TM 85, for the mark V & DESIGN.

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The grounds of Opposition are as follows:

1. The Opposer, VERBATIM CORPORATION, is a corporation duly organized and existing under the laws of the State of California, having its principal offices at 1200 W. T. Harris Boulevard, Charlotte, North Carolina 28262.

2. Commencing long prior to Applicant's filing date, Opposer has engaged, and is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of computer media and supplies.

3. Commencing long prior to Applicant's filing date, Opposer has used, and is now using Opposer's V & DESIGN trademark (hereinafter sometimes referred to as Opposer's Mark) in connection with blank magnetic recording tape, cassettes containing magnetic recording tape, cartridges containing magnetic recording tape; blank and preformatted magnetic recording disks; blank and preformatted optical disks; and optical head cleaning kits, comprised of cleaning diskette and solution distributed and sold by Opposer in commerce.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registration:

MARK
V & DESIGN

REGISTRATION NO.
1,717,603

ISSUED
September 22, 1992

Opposer's Registration No. 1,717,603 identifies the goods as "blank magnetic recording tape, cassettes containing magnetic recording tape, cartridges containing magnetic recording tape; blank and preformatted magnetic recording disks; blank and preformatted optical disks; and computer head cleaning kits, comprised of cleaning diskette and solution". Opposer's Registration No. 1,717,603 is incontestable by virtue of Opposer's Section 15 Affidavit having been acknowledged on June 30, 1998. A copy of the registration is attached hereto, as Opposer's

Exhibit 1. Said registration of Opposer's Mark is valid and subsisting and is conclusive evidence of Opposer's exclusive right to use Opposer's Mark in commerce on the goods specified in said registration.

5. Since its initial use of the V & DESIGN mark, Opposer has made a substantial investment in advertising and promoting its goods under its trademark. Opposer has extensively used, advertised, promoted and offered Opposer's goods bearing the mark to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's Mark and associate same with Opposer and/or goods sold by Opposer. Opposer has built extensive goodwill in connection with the sales of products under its mark.

6. Upon information and belief, notwithstanding Opposer's rights in and to its mark, on May 16, 2002, Applicant filed an application for registration of the alleged V & DESIGN trademark in Classes 9, 16, 35, 37, 41 and 42, later amended to the following goods and services: "Computer programs for use in business management, namely, enterprise resource planning in the field of sales, manufacturing, human resources, logistics, and accounting; printed instruction manuals for computers and for general purpose work processing software; computer data entry and data retrieval services; data processing; consultation in the field of electronic data processing; providing information via a global computer network in the field of enterprise resource planning; maintenance, installation and repair of computers, computer peripherals, computer networks and computer equipment; educational services, conducting classes and seminars in the field of computer education; computer education training for in-house developed software, for third party software sold to customers". Said application was assigned Serial No.

76/409,002, and was published for Opposition in the *Official Gazette* of March 25, 2003, Vol. 1268, No. 4, at Page TM 85.

7. Applicant's V & DESIGN mark is a simulation and colorable imitation of, and so resembles Opposer's trademark as to be likely, when applied to the proposed goods of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

8. Upon information and belief, Opposer's and Applicant's goods will be sold in close proximity and purchased and consumed by the same general class of purchasers.

9. Upon information and belief, the *bona fides* of Applicant's intent-to-use is not apparent from materials of record in the subject application, and Opposer therefore challenges same and leaves the Applicant to its proofs with regard to the nature and sufficiency of its intent to use at the time of filing Application Serial No. 76/409,002.

10. Opposer, upon information and belief, avers that its customers, and the public in general, are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's proposed goods to be marketed under Applicant's alleged V & DESIGN trademark and misled into believing that such goods are produced by, emanate from, or are in some way directly or indirectly associated with Opposer, to the damage and detriment of Opposer and its reputation.

11. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged V & DESIGN trademark, as set forth in Applicant's Trademark Application Serial No. 76/409,002, in that the mark is substantially similar to Opposer's trademark and common law rights and will be used in connection with goods closely related to the goods offered to the public by Opposer.

WHEREFORE, this Opposer, VERBATIM CORPORATION, believes and avers that it is being and will continue to be damaged by registration of the V & DESIGN trademark as aforesaid, and prays that said Application Serial No. 76/409,002 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed Jeffrey H. Kaufman and P. Jay Hines, a member of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith. Please address all correspondence to:

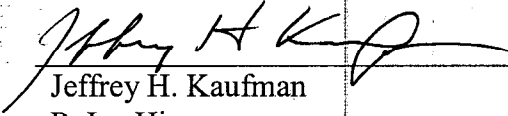
Jeffrey H. Kaufman
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314

The filing fee for this opposition in the amount of \$300.00 is enclosed herewith. The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment, to Account No. 50-2014.

Respectfully submitted,

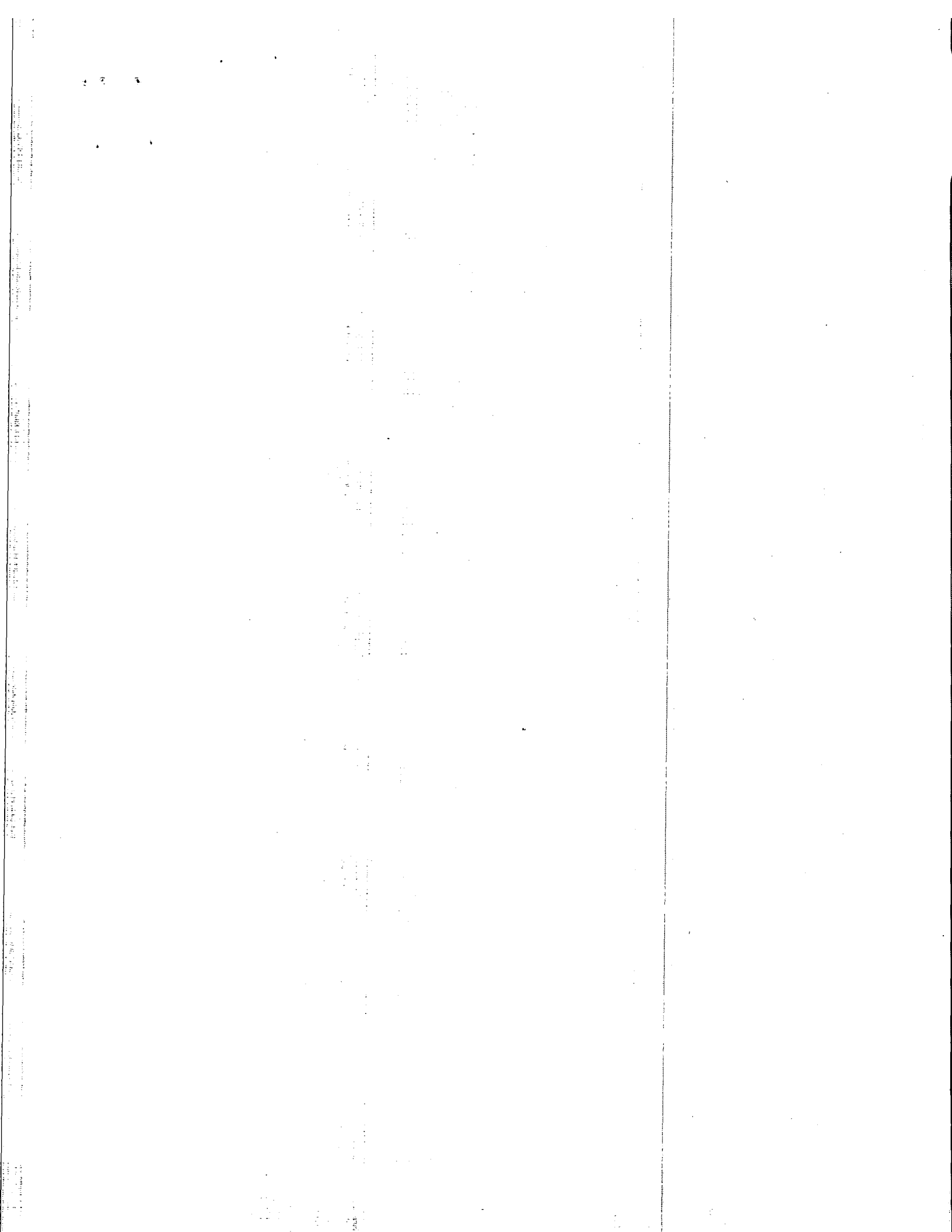
VERBATIM CORPORATION

By:


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Int. Cl.: 9

Prior U.S. Cl.: 26

United States Patent and Trademark Office

Reg. No. 1,717,603

Registered Sep. 22, 1992

**TRADEMARK
PRINCIPAL REGISTER**



VERBATIM CORPORATION (CALIFORNIA CORPORATION)
1200 W.T. HARRIS BOULEVARD
CHARLOTTE, NC 28262

FOR: BLANK MAGNETIC RECORDING TAPE, CASSETTES CONTAINING MAGNETIC RECORDING TAPE, CARTRIDGES CONTAINING MAGNETIC RECORDING TAPE, BLANK AND PREFORMATTED MAGNETIC RECORDING DISKS; BLANK AND PREFORMATTED

OPTICAL DISKS; AND COMPUTER HEAD CLEANING KITS, COMPRISED OF CLEANING DISKETTE AND SOLUTION, IN CLASS 9 (U.S. CL. 26).

FIRST USE 6-30-1982; IN COMMERCE 6-30-1982.

SER. NO. 74-113,865, FILED 11-9-1990.

ANNA W. MANVILLE, EXAMINING ATTORNEY

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Reviewed
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