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

In re Application of : AMERICAN PUBLISHING, LLC
Serial No. : 76/083,594
Filed : July 6, 2000
For : "EVERYDAY LIVING"



09-22-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #79

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MARTHA STEWART LIVING OMNIMEDIA, INC. :
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: Opposer, :
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: Opposition No.
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: v. :
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: AMERICAN PUBLISHING, LLC :
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: Post Application Owner. :
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NOTICE OF OPPOSITION

Martha Stewart Living Omnimedia, Inc. ("Opposer"), a corporation organized under the laws of Delaware with a place of business at 20 West 43rd Street, New York, N.Y. 10036, believes that it will be damaged by registration of the above-identified mark, and hereby opposes registration thereof. As grounds for opposition, it is alleged that:

1. Opposer is a leading provider of original "how to" content and products for the home. Opposer, through publications such as general interest magazines, provides consumers with "how to" ideas, products, and other resources to help raise the quality of the home. Home, cooking and entertaining, gardening, crafts, holidays, weddings, babies

and children are some examples of the many fields of interest that Opposer targets in its publications. Women are the primary target audience for Opposer's publications and products.

2. Opposer has adopted and used continuously in commerce since November 12, 1990, the trademarks MARTHA STEWART LIVING and MARTHA STEWART LIVING (& Design) in connection with general interest magazines.

3. Opposer is the owner of:

(a) U.S. Registration No. 1,709,962, registered on August 25, 1992 on the Principal Register for the trademark MARTHA STEWART LIVING in International Class 16 covering "general interest magazines"; and

(b) U.S. Registration No. 2,208,568, registered on December 8, 1998 on the Principal Register for the trademark MARTHA STEWART LIVING (& Design) in International Class 16 covering "general interest magazines."

4. Opposer also owns at least nine United States Trademark registrations (No. 2,186,450, No. 2,182,768, No. 2,184,653, No. 2,186,451, No. 2,502,391, No. 2,586,068, No. 2,593,353, No. 2,663,547, and No. 2,729,596) for the trademark MARTHA STEWART EVERYDAY in International Classes 4, 11, 20, 21, 24, 27, 31.

5. MARTHA STEWART EVERYDAY, MARTHA STEWART LIVING, MARTHA STEWART LIVING (& Design) are extensively used and advertised.

Opposer has sold many millions of dollars worth of products under these marks, which have become famous.

6. All the registrations cited above are valid and subsisting and Opposer hereby gives notice, in accordance with Trademark Rule 2.122(d)(2), that it will rely thereon as

evidence on its behalf in this proceeding, and a status copy thereof showing present title will be introduced into evidence during Opposer's testimony period.

7. By the application herein opposed, American Publishing, LLC ("Post Application Owner") is seeking to obtain, under the provisions of the Trademark Act of 1946 (15 U.S.C. § 1051), registration for the mark EVERYDAY LIVING in International Class 16 for "magazines in the field of woman's interests, family interests, women's health and family health" (hereinafter referred to as the "Owner's mark").

8. Upon information and belief, the application for Owner's mark was initially filed on July 6, 2000 (Serial Number 76/083,594) by third party Mars Advertising Company ("Applicant"), based on Applicant's intention to use the mark for the goods specified in the application, and was purportedly assigned to Post Application Owner on April 23, 2001.

9. Owner's mark was published for opposition on April 22, 2003. Opposer has been granted extensions of time to file an opposition until and including September 19, 2003.

10. Registration should be refused on the grounds that Applicant, upon information and belief, had no *bona fide* intention to use the mark in commerce under 15 U.S.C. § 1051(b) for the products specified in the application at the time the application was initially filed.

11. Registration should also be refused on the grounds that, upon information and belief, the purported assignment from Applicant to Post Application Owner, which occurred prior to the filing of any amendment under U.S.C. § 1051(c) or any verified

statement of use under 15 U.S.C. § 1051(d) is invalid because it violated 15 U.S.C. § 1060(a)(1).

12. In addition, registration should be refused pursuant to 15 U.S.C. § 1052(d) on the grounds that Post Application Owner's use of the Owner's mark for the aforementioned goods, without the consent or authorization of the Opposer, is likely to cause confusion, mistake or deception as to the source or origin or sponsorship of the goods and/or services for which such mark is used, or intended to be used.

13. Owner's mark consists entirely of two words which are identical to words that prominently appear in Opposer's famous marks set forth above.

14. Opposer's priority dates for all of its marks set forth above predate the filing date of Applicant's intent-to-use trademark application, as well as any use of Owner's mark.

15. Use and registration of Owner's mark is likely to cause injury to Opposer's rights in and to its trademarks set forth above, and said use and registration is also likely to cause confusion, mistake and/or falsely suggest a connection with Opposer.

16. If Post Application Owner is granted a registration for EVERYDAY LIVING, it would obtain thereby at least the prima facie exclusive right to use such mark. Such registration would be a source of damage and injury to Opposer.

17. If Post Application Owner is permitted to use the term EVERYDAY LIVING or to register it so as to claim exclusive rights therein, it would cause confusion among the public, resulting in damage and injury to Opposer. In view of Post Application Owner's claim to such exclusive rights, members of the public familiar with Opposer's marks would be likely to believe (and would be justified in so believing) that Post

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Application Owner's goods originated with Opposer, or an entity in some way associated with Opposer, or were licensed or authorized by Opposer or with Opposer's approval. Furthermore, any objection or fault found with Post Application Owner's goods would necessarily reflect upon and seriously injure the reputation which Opposer has established in connection with the goods sold by Opposer which feature Opposer's famous trademark set forth above.

18. By reason of the foregoing, Post Application Owner's registration of the mark herein opposed would cause significant damage and injury to Opposer, to Opposer's rights in its famous and valuable MARTHA STEWART LIVING, MARTHA STEWART LIVING (& Design) and MARTHA STEWART EVERYDAY marks, and to the use thereof. Thus, registration should be denied under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)).

19. A duplicate copy of this Notice of Opposition is enclosed herewith. The statutory fee of \$300, and any additional required fees, should be charged to the undersigned's Deposit Account No. 11-0600.

WHEREFORE, Opposer prays that Application Serial No. 76/083,594 be rejected, and that registration of the mark therein sought for the product therein specified be denied and refused, and that this Opposition be sustained.

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Respectfully submitted,

KENYON & KENYON

Dated: September 19, 2003

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Martha Stewart Living Omnimedia,
Inc.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class/express mail in an envelope addressed to: Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, on

Date September 19, 2003 Box T.T.A.B. - FEE

Signature Harlee Fair
KENYON & KENYON