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

IN THE MATTER OF APPLICATION SERIAL NO. 76/448,315
PUBLISHED IN THE OFFICIAL GAZETTE ON JULY 15, 2003

INTERNATIONAL STAR REGISTRY)
OF ILLINOIS, LTD.,)
)
Opposer,)
)
v.)
)
TONYA S. VAUGHAN,)
)
Applicant.)

Opposition No.:

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail addressed to the Assistant Commissioner for Trademarks, U.S. Trademark Office, 2900 Crystal Drive, Arlington VA 22202-3513 on October 15, 2003.

Jessica L. McCollam
JESSICA L. MCCOLLAM



NOTICE OF OPPOSITION WITH NOTIFICATION
OF NEW ADDRESS FOR OPPOSER'S COUNSEL

10-20-2003
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

In the matter of the trademark application of Tonya S. Vaughan for the registration of the alleged mark "Name A Star" and Design for the services in Class 35 and the goods in Class 16 as described in said **Application Serial No. 76/448,315** filed on September 10, 2002, published in the Official Gazette of July 15, 2003. This opposition is against the Applicant's application in both Classes 16 and 35 which are the only two classes identified in the application.

Opposer, International Star Registry of Illinois, Ltd., an Illinois corporation with a principal place of business at 34523 N. Wilson Road, Ingleside, Illinois 60041, believes that it will be damaged by the registration of the alleged mark shown in

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the application and hereby opposes the application with this opposition against both classes of the application.

The grounds for the opposition are:

1. Continuously since long prior to September 10, 2002, the Applicant's filing date for the trademark application at issue, the Opposer has marketed, advertised and sold and continues to sell throughout the United States and in foreign commerce star naming services and products. Specifically the Opposer offers to name a star or name stars with the names requested by members of the public.

2. The Opposer offers services and products to customers to name a star or for naming stars.

3. The services of Opposer include offering novelty gift services, namely designating celestial stars with names selected by customers and providing certificates and listings in recognition thereof. The name a star or star naming related products include providing printed publications namely brochures, charts (showing the location of the star named in response to the name a star request), certificates (printed with the name requested by the customer in response to the name a star request), and sheets in the field of astronomy identifying celestial bodies.

4. The Applicant's services and products offered under the alleged designation "Name A Star" are in competition with those of the Opposer.

5. The Applicant's services and products offered under the alleged designation "Name A Star" are comparable in description to those services and goods of the Opposer as identified in Paragraph No. 3 of this Opposition Petition.

6. The Trademark Attorney Examiner assigned to reviewing the Applicant's trademark application in a prior unsuccessful application by the same Applicant, Serial No. 75/852,239 in Office Action No. 1 in that prior application objected to registrability because the Applicant's proposed mark was considered as merely descriptive for the goods. 15 U.S.C. Section 1052 (e)(1). In that Office Action, the Examiner referred to standard dictionary definitions for the words "named, nam-ing, names" and "star". In objecting to registrability the Examiner asserted that:

"Applicant proposes the mark NAME A STAR for use in connection with printed publications, namely brochures, charts, certificates, and sheets identifying celestial bodies pertaining to astronomy and for persons having an interest in astronomy and topics related thereto and for novelty gift services, namely designating celestial stars with names selected by customers, providing personalized certificates, and maintaining a registry in recognition thereof. Applicant's mark merely identifies the goods and services. Specifically applicant's services allows customers to NAME A STAR. Please see definitions below as further proof of the descriptive nature of this mark:"

7. The Applicant in response to the Office Action in the referenced prior unsuccessful application sought to register the alleged mark based upon acquired distinctiveness or secondary meaning, Section 2(f). Reliance by the Applicant upon Section

2(f) assumes that the mark is not inherently distinctive and requires proof of secondary meaning. The Applicant's alleged mark is not inherently distinctive and was considered as merely descriptive. The Applicant's mark would therefore require a showing of secondary meaning or acquired distinctiveness for registrability under Section 2(f). The Applicant has again in the present application sought reliance upon acquired distinctiveness under Section 2(f).

8. The sole evidence in support of the argument of acquired distinctiveness submitted by Applicant in the prior referenced unsuccessful application Serial No. 75/852,829 was a 2 page, 7 numbered paragraph Declaration signed by Applicant, a single advertisement from Applicant, and duplicate specimens showing alleged use of the mark at least as early as November 18, 1999 which specimens were submitted based upon a request by the Examiner for substitute specimens. The Applicant in that Declaration in Paragraph No. 3 described her services and goods as:

"... to identify star registration goods and services, including printed publications, brochures, charts, certificates, and sheets in the field of astronomy identifying celestial bodies, and novelty gift services including designating celestial stars with names selected by customers and providing certificates and a registry in recognition thereof."

The Applicant's services and goods in the identified prior application as published under the phrase or asserted designation "name a star" were described as:

"Novelty gift services, namely, designating celestial stars with names selected by customers and providing certificates and a registry in recognition thereof", in International Class 42, and "printed publications, namely brochures, charts, certificates, and sheets in the field of astronomy identifying celestial bodies", in International Class 16.

9. The Applicant's advertisement identified in the Declaration submitted by Applicant (as described in Paragraph No. 8) for urging secondary meaning in the top right hand corner of the advertisement used the phrase "NAME A STAR!" followed by the phrase "FOR YOURSELF...FOR A LOVED ONE!" Such wording merely described or generically identified the services and products offered by the Applicant. Such wording does not represent trademark use of the phrases.

10. The Opposer has for many years circulated the brochure which is entitled "To Name a Star" shown by the photocopy of the cover attached as Exhibit A. The Applicant or its representatives were aware of this brochure prior to the filing of the Applicant's application at issue in these proceedings, which of course, precedes Applicant's filing of the Declaration urging registrability based upon acquired distinctiveness, Section 2(f). The Applicant or its representatives prior to filing the application herein being opposed were made aware of

Opposer's use of the words "Name A Star" and that Opposer considered the words as being merely descriptive or generic.

11. The Applicant or its representatives were aware of other uses by Opposer of the phrase "Name A Star" or of the use by Opposer of similar such phrases prior to filing the application under opposition in these proceedings.

12. The Applicant or its representatives were also aware of third party uses of the phrase "Name a Star" or of the use of similar such phrases prior to filing the application under opposition.

13. The Applicant has referred to her own services or products as being the "star naming business" or as offering star naming services and products. In the star naming business or in offering star naming services or products the Applicant will name a star to a designation requested by a customer, provided that the customer complies with certain requirements, such as providing proper payment of a fee.

14. To show acquired distinctiveness or secondary meaning under Section 2(f) the Applicant in the present application relied upon the assertion of the substantially exclusive and continuous use of the phrase or alleged mark sought to be registered. Based upon information and belief the Applicant and its representatives were aware of significant descriptive or

generic uses of the words by the Opposer and/or other descriptive or generic uses of the phrase or alleged mark.

15. The Applicant's use of the phrase or alleged mark sought to be registered has not been substantially exclusive for the time period identified in Applicant's Declaration which was submitted for asserting secondary meaning.

16. Applicant's alleged mark includes a phrase which, when applied to the services and goods of Applicant, is merely descriptive in that said alleged mark is an apt and common term used to describe services and goods of the nature involved herein. Opposer, has for many years offered services and goods which are of a related nature to applicant's services and goods, and which Opposer has a valid and legal right to describe by use of the phrase sought to be registered by the Applicant. Opposer is likely to be damaged by registration of said term in that the prima facie effect of such registration will tend to impair Opposer's right to the descriptive or generic use of said phrase.

In view of the above allegations, Applicant is not entitled to federal registration of the alleged phrase in that Applicant is not entitled to exclusive use of said term in commerce on the services and goods specified and further that Applicant's alleged mark does not function to identify Applicant's services and goods and distinguish them from those offered by others.

17. Applicant's alleged mark which includes the asserted phrase has not become distinctive of the Applicant's services and goods in commerce and no customer recognition of said phrase as a valid mark identifying only Applicant has been achieved.

18. In the alternative, the Opposer also asserts that Applicant's alleged mark, includes a phrase which is the common descriptive name of the articles and items included in applicant's description of services and goods and is the generic name of the services and goods offered and sold in such business.

Therefore, Opposer alleges that Applicant's term does not function to identify Applicant's services and goods and distinguish them from services and goods offered by others.

19. In the Office Action objecting to the registrability of the alleged mark shown in the prior application of Applicant, Serial No. 75/852,829, the Examiner asserted that:

"Applicant's mark merely identifies the goods and service

Assuming that the Examiner was correct in this objection the Applicant's asserted mark would be considered as including a generic phrase and no amount of evidence could show acquired distinctiveness for registrability to overcome a genericness objection.

20. Specimens submitted by Applicant in the application file for the prior application of the Applicant filed in 1999,

Serial No. 75/852,829 included phrases such as: "Naming a star after a loved one is very romantic and memorable" and "The Star Name you choose". Written materials provided by Applicant to customers included an article written by Applicant described by Applicant as "relating to how stars have been named since the beginning of time". The order form of Applicant included the statement above "Ordered by" that "I wish to Name A Star" and the current order form submitted by Applicant in the present application refers to the phrases "To Name a Star" and "Name for the Star". In brochures or advertising materials the Applicant has also used phrases such as "Name a Star to Honor Someone Special"; "we've brought names to stars"; "Having a Star named after oneself or a loved one is very memorable" and the Applicant refers to itself as a "Star Naming Service". The phrases identified herein are merely descriptive or generic phrases and do not represent trademarks or source identifying uses of such phrases. Such phrases are not used in a trademark sense, but as merely descriptive or generic phrases.

21. The use of the alleged mark at issue by Applicant on information or belief would represent too small of a use to have under the circumstances achieved acquired distinctiveness, even assuming arguendo that the use by the Applicant was continuous and substantially exclusive. In fact, the Opposer spends far greater sums in advertising which includes the phrase "Name A

Star" than the Applicant. While the Applicant admitted in the application at issue that she is aware of other uses of "Name A Star", she failed to identify the nature or extent of that use of the phrase, including that the Applicant's awareness of the use of the phrase by others extends over many years.

22. The Applicant has not only acquiesced in third party use of "Name A Star", but during the year prior to the filing of the Applicant's application at issue, which relied upon acquired distinctiveness, the Applicant orchestrated a bidding plan where others in the industry would bid upon the use of the term upon the internet in pay per click advertising.

23. Examples of Opposer's longstanding use of the phrase "Name A Star" are shown by Exhibits A through F which include by way of example the Time Magazine advertisement from May 4, 1987, radio advertising and other widespread uses in advertising or in promotional brochures. Similarly, the trade has also used the phrase generically or descriptively.

24. At the time of the filing of the Applicant's application under opposition which has relied upon acquired distinctiveness under Section 2(f), the Applicant, on information and belief, would have been familiar with Opposer's longstanding radio advertising which uses "Name A Star", and which reached over 90% of U.S. radio listening market, including playing on an assortment of radio stations in the region of the Applicant's

business location in Bend, Oregon.

25. Opposer is likely to be damaged by Applicant's registration of said phrase "Name A Star" in that the prima facie effect of such registration will tend to impair Opposer's right to sell potentially competing products or use appropriate terms in describing or offering services and products. In view of the above allegations, Applicant is not entitled to Federal registration of her alleged mark in that Applicant is not entitled to exclusive use of said phrase as a trademark on the services and goods and further, that Applicant's alleged mark does not function to identify Applicant's services and goods and distinguish them from those offered by others. Furthermore, the Applicant's design features in its asserted mark are confusingly similar to a design mark in prior use by the Opposer.

26. This Notice of Opposition is being filed in duplicate and the required fee is enclosed. Please charge any additional costs to our Deposit Account No. 05-0630.

WHEREFORE, Opposer believes it will be damaged by the registration of the claimed trademark in Application Serial No. 76/448,315 in both International Classes 16 and 35 and prays that this Opposition be sustained and that the Applicant's registration be denied.

Please address all correspondence to:

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Chicago, IL 60604

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Facsimile: (312) 427-6663
E-Mail: burte@ladas.net

Please note that this represents a change of address from the address of Opposer's counsel at the time of the filing of the earlier extension of the opposition period.

Respectfully submitted,

By: 
One of Opposer's attorneys

Burton S. Ehrlich
Ladas & Parry
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(312) 427-1300

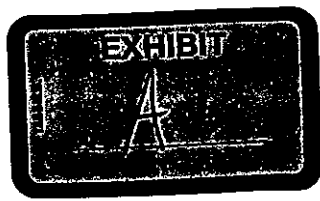
CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited (in duplicate) with the United States Postal Service as First Class Mail addressed to: BOX TTAB FEE, Commissioner for Trademarks, U.S. Trademark Office, 2900 Crystal Drive, Arlington, VA 22202-3513, on October 15, 2003.


Burton S. Ehrlich, Esq.

To
Name
a Star

International
Star Registry



fierce, quickly passing Rickey's previous salary of \$55. Given the finite pool of \$120, the large number of top players in this year's draft would seem to make each one less valuable. But Rickey is immune to the iron laws of economics, and he boldly goes where no man has gone before: \$60, then \$65 and finally \$69. The auctioneer intones his ritual "Going once, going twice..." Everyone looks at the Amaros.

Without hesitation, they pass. "It would ruin our salary structure," they explain. The high bid belongs to Hugh Sweetley, whose attention now focuses on the Moose Factory, Rickey's employer the past two seasons and the holder of topping rights to his salary. For \$1 more, Mooser Alex Patton, the league's winningest owner, can have his star player back for two more years at \$70. But Patton passes too. The league breathes a double sigh of relief.

And out comes the cash: Cleveland's potent Joe Carter, who hit 302 with 29 home runs, 121 RBIs and had 29 steals in 1986, fetches \$46; Detroit's injury-prone slugger speedster and amateur airplane pilot Kirk Gibson goes for \$41. More than five hours later, the auction closes with the march of the scrubbeensies, the cheap players who fill out everyone's roster. There are still some good buys for those who have husbanded their money, either by design or dumb luck. The Moosers grab Milwaukee's Cecil Cooper for \$3, the same price that Nova pays for Catcher Ron Hassey. Pitiably, the once mighty Reggie Jackson commands merely a single buck as the Hackers' designated hitter.

As the meeting breaks up—it is the only time during the season the owners ever see one another face to face in a group—the postmortems are immediately held. The Amaros are still the favorites, but they didn't put it away with Rickey; the Nova, the Hackers and the BB Guns are going to be tough; the pesky Moose Factory will probably be there at the end, as usual. Prices for the best players were surprisingly high, everyone agrees, and there were amazing bargains at the end. "I feel we've created a misshapen monster," says Patton, who contributed two chapters on intelligent pricing to Golenbock's book, then saw them contradicted by frenetic, trading-floor reality.

As the season progresses, a new phase of the game will begin—trading. Phones will ring at all hours. Wives will issue ultimatums. Owners traveling in Europe, Asia or northern Canada will search desperately for box scores. The circulation of *USA Today*, the best day-to-day source of baseball intelligence, will soar. Thousands of man-hours will be expended thinking about baseball, talking about baseball and contemplating baseball. But until tomorrow, when the major leagues start play, things will be quiet. "You've read the book," quips the Tooners' Larry Fine, traded by Reuters from New York to London during the off-season. "Now play the game."
—By Michael Walsh

TIME, MAY 4, 1987

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Notify us of an address
change.

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nience of TIME's Cus-
tomer Service Renewal
Hotline to keep TIME
coming at your low sub-
scriber rate.

For Mother On Her Day

Name a Star

For only \$35 you'll get a beautiful color parchment star with your name and the star's celestial coordinates inscribed in hand calligraphy. You'll also receive two sky charts to help you locate your Mom's star exactly in the sky. There's a booklet about the stars by Dr. T. Harry Heath, Professor of Natural Sciences at York University in Toronto, Canada.

The new star's name will be registered in a hard cover astronomy book which will be copyrighted in Washington, DC.

CALL AND ORDER NOW
(800) 282-3333

or send to
Star Registry

1821 Willow Rd.
Northfield, IL 60090

The star to be named _____

My name _____

Address _____

City _____

State _____ Zip _____

Special occasion date ____/____/____

Charge to: Mastercard Visa

Account # _____

Ex. date _____

Or I enclose a check or money order for \$35.00 (\$7.45 for a single star or \$70.00 (\$14.90) for a binary two star) that revolve around each other, payable to International Star Registry, 1821 Willow Rd., Northfield, IL 60093 / Phone: (800) 282-3333.

Illinois sales tax applied to Illinois residents.



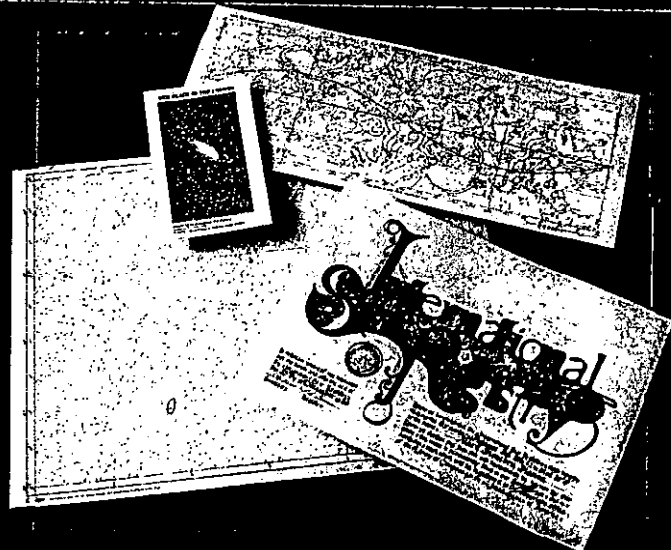
Name A Star For That Special Someone.



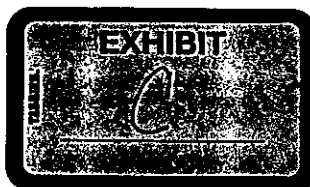
It's the gift of immortality, the most unique gift idea to come along in years. For just \$35, the International Star Registry will name a star — that's right, a real star — after anyone on your gift list.

The star name you select will be permanently recorded in book form in the copyright office of the Library of Congress. And the lucky person will also receive the Registry's special Star Package, which includes:

- A 12" x 16", 4-color parchment Certificate of Record, suitable for framing, personalized in hand calligraphy.
- Two sky charts showing the star's precise location in the heavens.
- An informative booklet, "Our Place in the Cosmos", prepared for the International Star Registry by Dr. T. Harry Leith, Professor of Natural Science at York University, Toronto, Canada.



Order yours today from —
International Star Registry
1821 Willow Road
Northfield, IL 60093
or call Toll Free 1-800-282-3333



For
*Valentine's
Day*
♥



Name A Star For Someone You Love

You'll Receive:

- A beautiful 12" x 16" four color, gold sealed parchment certificate personalized in hand calligraphy officially recording the name change.
- A sky chart showing the star's constellation and another close-up sky chart with the star's telescopic coordinates to help you locate the star exactly in the sky.
- An informative booklet about the stars prepared especially for International Star Registry by Dr. T. Harry Leith, Professor of Natural Sciences at York University, Toronto, Canada.
- The new star name will be published in the book, *Your Place In The Cosmos*, volume II, copyrighted in Washington D.C. and permanently recorded in International Star Registry's vaults in Geneva, Switzerland.

Call:
1-800-282-3333

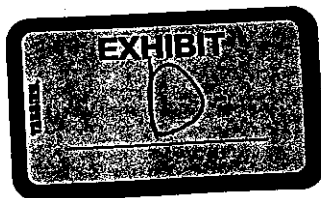
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Star Registry

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MEDIA FINANCE COMPANY

1821 Willow Road

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312-446-4422

Radio Copy for International Star Registry

1985 Christmas

#2

Written by Harrison

Rotate Copy

Want to really impress somebody this Christmas . . . but without going broke doing it? Well, here's a novel gift idea that's so far out of this world, it'll keep'em talking for years to come. It's the chance to name a star - that's right, a REAL STAR - after anyone you choose. And all it takes is \$35 and one toll-free call to the International Star Registry at 800/282 33 33. For that \$35, the person you choose will receive the ultimate conversation piece - the Registry's beautiful 12" x 16" certificate of record, printed in full color on real parchment and absolutely ideal for framing. They'll also receive a booklet about the stars, plus sky charts showing the star's exact location. Also their name will be permanently recorded in a book available later for future generations to share in and enjoy. That's right - the International Star Registry is for real, and really a lot of fun for everyone who gives, or receives, a star for any special occasion. Call the International Star Registry today at 800/282 33 33, and get the \$35 gift of a lifetime for someone this Christmas. That's the International Star Registry at 800/282 33 33. Call Now.



BROADCAST COPY

CLIENT: INTERNATIONAL STAR REGISTRY

DAY:

MEDIUM: OUTSIDE CHICAGO
800-282-3333

DATE:

COPY NO: ISR 83 #2

REMARKS:

Is there someone on your Christmas, holiday or birthday gift list that has you stumped? Where nothing short of the ultimate gift will do? Why not name a star after them? That's right -- a real star. Just call the International Star Registry at 800-282-3333.....and for \$35 they'll name a star after anyone on your list. The star name for the person that you choose will be permanently recorded in book form in the copyright office of the Library of Congress and registered in our private Swiss vaults. We'll send you a beautiful parchment certificate of record, perfect for framing, a booklet on the stars, plus sky charts showing your star's exact location. It's the perfect gift for the person who already has everything, or for that wealthy relative whose fortune you'd like to share, someday. There's certainly no more unique or lasting gift on the market today...for Christmas, birthdays or special occasions. It's yours for just \$35. To order your star, just call the International Star Registry at 800-282-3333. That's 800-282-3333. Buy a bit of heaven for that special angel in your life. That's the International Star Registry...800-282-3333.

