Attorney Docket No.: 241030US56 **BOX TTAB FEE**

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

J&J TECHNOLOGY, LLC, Opposer, v. BIG PLANET, INC., Applicant.	Opposition No.: _____ Appln. Serial No. 78/180,241

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

NOTICE OF OPPOSITION

J&J Technology, LLC, a limited liability company duly organized and existing under the laws of the State of Nevada, located and doing business at 621 Old Hickory Boulevard, Suite 9, Jackson, Tennessee 38305 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No. 78/180,241, filed October 30, 2002, under the Trademark Act of 1946, in the name of Big Planet, Inc. (hereinafter "Applicant"), published for opposition in the *Official Gazette* of July 22, 2003, Vol. 1272, No. 4, at Page TM 125, for the mark ECOSPHERE.

Opposer filed a Request for Extension of Time to File Notice of Opposition until September 20, 2003 in connection with the above-captioned application. Attached as Exhibit 1

is a copy of the official notice from the Trademark Trial and Appeal Board mailed August 21, 2003, approving the extension request. By clerical error, Opposer's name in the extension request was listed as "J&J **Technologies**, LLC," instead of "J&J **Technology**, LLC." A clerical error in the Opposer's name listed in an extension request will not preclude the Opposer from bringing an opposition that relies on the extension request. 37 CFR §2.102(b), TBMP §206.03.

The grounds of Opposition are as follows:

1. The Opposer, J&J Technology, LLC, is a corporation duly organized and existing under the laws of the State of Nevada, having its principal place of business at 621 Old Hickory Boulevard, Suite 9, Jackson, Tennessee 38305.

2. Commencing prior to Applicant's claimed date of first use, Opposer, through its predecessor-in-interest, was and is now engaged in the manufacture, distribution, sale, licensing, advertising and promotion in interstate commerce of proprietary, environmentally safe cleaning products.

3. Applicant entered into a contract dated July 10, 2001 with Opposer's predecessor-in-interest.

4. In the contract of July 10, 2001, Applicant acknowledges that Opposer's predecessor-in-interest is the owner of the ECOSPHERE mark. Also in the contract, Applicant accepts and Opposer's predecessor-in-interest grants a license to use the ECOSPHERE mark.

5. Provision 5.2.1 of the July 10, 2001 contract precluded Applicant from filing an application to register ECOSPHERE without the consent of Opposer's predecessor-in-interest.

6. The July 10, 2001 contract remained in force until December 23, 2002, when it was terminated by Applicant.

7. Upon information and belief, notwithstanding Opposer's rights in and to its mark, and notwithstanding the contractual obligation prohibiting Applicant from doing so, Applicant

filed an application on October 30, 2002, to register the trademark ECOSPHERE for all purpose cleaning preparations, carpet cleaning preparations, and glass cleaning preparations, in International Class 3. Said application was assigned Serial No. 78/180,241, and was published for Opposition in the Official Gazette of July 22, 2003 at Page TM 125.

8. On the date that Application Serial No. 78/180,241 was filed, Applicant was still contractually bound by Provision 5.2.1 of the July 10, 2001 contract not to file an application to register ECOSPHERE without the consent of Opposer's predecessor-in-interest.

9. Applicant was not the owner of the mark of Serial No. 78/180,241 at the time the application was filed, and therefore the application is void pursuant to Trademark Act Section 1(a)(1), 15 U.S.C. §1051(a)(1).

10. Applicant was legally estopped by contract from asserting ownership of the ECOSPHERE mark shown in Serial No. 78/180,241 at the time the application was filed.

11. Applicant acknowledged in the July 10, 2001 contract that it was not the owner of the ECOSPHERE mark, and that another party, Opposer's predecessor-in-interest, was the owner of the mark.

12. Applicant has committed fraud on the Patent and Trademark Office by willfully and intentionally making material false statements that induced the Patent and Trademark Office to approve the application for publication, namely, (a) by declaring under oath that no other person, firm, corporation or association has the right to use the mark in commerce, and (b) by declaring under oath that Applicant is the owner of the mark.

13. Any use of the ECOSPHERE mark claimed by Applicant prior to December 23, 2002, the termination date of the trademark license between Applicant and Opposer's predecessor-in-interest, is use that inures to the benefit of Opposer, by reason of the aforesaid license and the resulting licensor-licensee relationship.

14. Opposer has priority of use of the ECOSPHERE mark by virtue of Applicant's use of the ECOSPHERE mark prior to December 23, 2002, which inures to Opposer.

15. The mark shown in Serial No. 78/180,241 is a simulation and colorable imitation of, and so resembles Opposer's aforesaid ECOSPHERE trademark as to be likely, when applied to the goods of Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

16. Upon information and belief, Opposer and Applicant are both engaged in the sale and promotion of their respective goods through the same channels of trade, and to the same general class of purchasers.

17. 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 goods marketed under Applicant's alleged ECOSPHERE 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.

18. Opposer, upon information and belief, avers that it will be damaged by the continued use and registration by Applicant of the mark set forth in Applicant's Trademark Application Serial No. 78/180,241, in that the mark is confusingly similar to Opposer's trademark and is used in connection with goods similar to the goods offered to the public by Opposer.

19. Opposer, upon information and belief, avers that it will be also be damaged by the continued use and registration of the mark by Applicant, because Applicant will gain thereby a claim of right to the mark which rightfully belongs to Opposer.

WHEREFORE, Opposer believes and avers that it is being and will continue to be damaged by registration of the mark in Application Serial No. 78/180,241, and requests that the

application be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

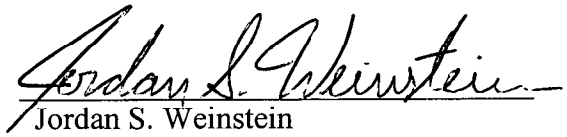
Opposer has appointed Jordan S. Weinstein, a member of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., a member of the Bar of the Commonwealth of Virginia, to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office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

JORDAN S. WEINSTEIN
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,

J&J TECHNOLOGY, LLC

By: 

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Date: September 22, 2003

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UNITED STATES PATENT AND TRADEMARK OFFICE
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Roberta S. Bren
OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT
1940 Duke Street
Alexandria, VA 22314

Mailed: August 21, 2003

Serial No.: 78180241

Helen Johnson, Legal Assistant

The request to extend time to oppose is granted until **9/20/03** on behalf of potential opposer **J&J Technologies, LLC.**

Please do not hesitate to contact the Trademark Trial and Appeal Board for any questions relating to this extension.

TTAB

OBLON
SPIVAK
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&
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ATTORNEYS AT LAW

JORDAN S. WEINSTEIN
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September 22, 2003

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

Re: *J&J Technology, LLC v. Big Planet, Inc.*
Mark: ECOSPHERE
Opposition No.:
Class(es): 3
Atty Dkt. No.: 241030US56

Dear Commissioner:

We enclose the following for filing in the U.S. Patent and Trademark Office:

☑ Notice of Opposition to Serial No. 78/180,241

Also enclosed is our check for the required filing fee in the amount of $300.00.

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,

OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, P.C.

Jordan S. Weinstein

JSW/dlb

09-22-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #77