

ESTTA Tracking number: **ESTTA8989**

Filing date: **05/19/2004**

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

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Costco Wholesale Corporation
<b>Granted to Date of previous extension</b>	05/22/2004
<b>Address</b>	Costco Wholesale Corporation 999 Lake Drive Issaquah, WA 98027 UNITED STATES

<b>Attorney information</b>	James W. Dabney, Pauline L. Wen, Thomas M. Rowland Fried, Frank, Harris, Shriver & Jacobson LLP One New York Plaza New York, NY 10004 UNITED STATES thomas.rowland@friedfrank.com Phone:212-859-8000
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#### Applicant Information

<b>Application No</b>	76514253	<b>Publication date</b>	03/23/2004
<b>Opposition Filing Date</b>	05/19/2004	<b>Opposition Period Ends</b>	05/22/2004
<b>Applicant</b>	Metrokane, Inc.		

**Goods/Services Affected by Opposition**

Class 021. First Use: 20000100 First Use In Commerce: 20000500  
All goods and services in the class are opposed, namely: corkscrews

Metrokane, Inc. v. Costco Wholesale Corp., No. 04 Civ. 00402 (WHP)

<b>Attachments</b>	Costco.pdf ( 13 pages )
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<b>Signature</b>	/tom rowland/
<b>Name</b>	Thomas M. Rowland
<b>Date</b>	05/19/2004

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

NOTICE OF OPPOSITION

In the matter of Application Serial No.  
76514253 Published in the Official Gazette  
on March 23, 2004 at page TM 439.

\_\_\_\_\_  
COSTCO WHOLESALE CORPORATION :

Opposer, :

v. :

METROKANE, INC. :

Applicant. :

Opp. No. \_\_\_\_\_

Assistant Commissioner of Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

SIR:

COSTCO WHOLESALE CORPORATION (“Costco”), a company organized and existing under the laws of Washington with its principal place of business located at 999 Lake Drive, Issaquah, Washington 98077, believes that it would be damaged by registration of the product design shown in Application Serial No. 76/514253 for “corkscrews” in International Class 21 (the “Proposed Mark”) and hereby opposes same.

As grounds of opposition, Costco alleges:

CERTIFICATION OF TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically to the United States Patent and Trademark Office on May 19, 2004.

Thomas M. Rowland Thomas M. Rowland 5/19/04  
(Name) (Signature) (Date of Signature)

## COUNT 1

1. Opposer owns and operates a chain of COSTCO retail stores in the United States, through which Opposer distributes a broad range of branded consumer household products. A description of Opposer's business appears at the web site associated with the domain name www.costco.com.

2. Opposer markets and sells certain lever action corkscrew products in the United States (the "Costco Products") that embody the design disclosed in U.S. Patent No. D464,241 (the "'241 Patent"). A copy of the '241 Patent is annexed hereto as Exhibit 1.

3. On or about January 14, 2004, the Applicant commenced a civil action against Opposer entitled Metrokane, Inc. v. Costco Wholesale Corp., No. 04 Civ. 00402 (WHP), in the United States District Court for the Southern District of New York (the "New York Action").

4. In its complaint in the New York Action, the Applicant alleges that the Proposed Mark purportedly constitutes "non-functional" "trade dress" whose "primary significance" purportedly is to indicate the origin of goods, and that by selling the Costco Products, Opposer purportedly is making unauthorized use of this so-called "trade dress" and therefore is purportedly liable to Applicant for monetary and injunctive relief.

5. The Proposed Mark is not a "trademark" within the meaning of 15 U.S.C. § 1127 and is not registrable on the principal register provided for by 15 U.S.C. §§ 1051-1072. The Proposed Mark is neither physically nor conceptually separable from any "goods" on which it purportedly is "placed".

6. Registration of the Proposed Mark to Applicant would damage Opposer, in that such registration would conflict with Opposer's legal right to sell the Costco Products and

would give false color to Applicant's claim that the Proposed Mark constitutes "non-functional" "trade dress" entitled to protection under 15 U.S.C. § 1125(a)(1).

### COUNT 2

7. Paragraphs 1 through 6, above, are realleged and incorporated by reference as if set forth in full.

8. The Proposed Mark comprises a product design that is merely descriptive of goods on which it purportedly is "placed". Assuming, for purposes of argument, that the Proposed Mark could be constituted a "trademark", it is unregistrable under 15 U.S.C. § 1052(e)(1).

9. Registration of the Proposed Mark to Applicant would damage Opposer, in that such registration would conflict with Opposer's legal right to sell the Costco Products and would give false color to Applicant's claim that the Proposed Mark is primarily perceived as a designation of origin, as distinguished from being perceived as constituting a utilitarian, functional, attractive, or aesthetically pleasing design valued for its appearance or utility.

### COUNT 3

10. Paragraphs 1 through 9, above, are realleged and incorporated by reference as if set forth in full.

11. The Proposed Mark comprises a design that affects the cost or quality of corkscrew products and accordingly is "functional" and unregistrable under 15 U.S.C. § 1052(e)(5).

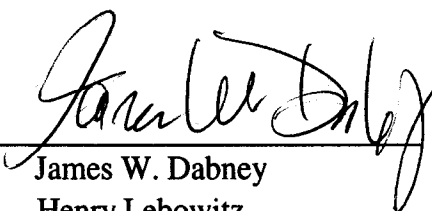
12. Registration of the Proposed Mark to Applicant would damage Opposer, in that such registration would conflict with Opposer's legal right to sell the Costco Products and would give false color to Applicant's claim that the Proposed Mark purportedly has no utilitarian

function and does not affect the cost or quality of goods embodying the design.

WHEREFORE, Opposer prays that this opposition be sustained, and that registration of the Proposed Mark to Applicant be refused. Please recognize as attorneys for Opposer in this proceeding, James W. Dabney, Henry Lebowitz, Pauline L. Wen, Thomas M. Rowland (members of the Bar of the State of New York), and Darcy Goddard (member of the Bar of the State of Colorado), and the law firm of Fried, Frank, Harris, Shriver, & Jacobson LLP, One New York Plaza, New York, New York 10004.

Please address all comments to James W. Dabney at the address below.

FRIED, FRANK, HARRIS, SHRIVER & JACOBSON LLP

By 

James W. Dabney  
Henry Lebowitz  
Pauline L. Wen  
Thomas M. Rowland  
Darcy Goddard

Date: May 19, 2004

One New York Plaza  
New York, New York 10004  
(212) 859-8000

Attorneys for Opposer  
Costco Wholesale Corporation

# **EXHIBIT 1**

(12) **United States Design Patent** (10) Patent No.: **US D464,241 S**  
 Sun (45) Date of Patent: **\*\* Oct. 15, 2002**

- (54) **CORK EXTRACTOR**
- (75) Inventor: **Lim Chan Sun, Hong Kong (HK)**
- (73) Assignee: **Technical Development (HK) Limited (HK)**
- (\*\*) Term: **14 Years**
- (21) Appl. No.: **29/158,349**
- (22) Filed: **Apr. 3, 2002**
- (51) LOC (7) CL ..... **07-99**
- (52) U.S. CL ..... **D8/39; D8/42**
- (58) Field of Search ..... **D8/33-43, 308, D8/4, 5, 107, 52, 48; 30/400-443; 81/3.07-3.49; 7/151-156; D7/665, 666; D23/250, 252; D12/179, 180; 74/523, 480 R, 489, 502.2**

6,357,322 B1 • 3/2002 Dolan et al. .... 81/3.37  
 D455,058 S • 4/2002 Stirling ..... D8/39

**OTHER PUBLICATIONS**

www.winetimegiftstore.com, 2pgs., Jan. 9, 2002, lever model lx and lever model 2000.\*  
 Summer 1997 Chef's Catalog, dated May 5, 1997, p. 76, Leverpull LX professional model.\*

\* cited by examiner

Primary Examiner—Jeffrey Asch  
 (74) Attorney, Agent, or Firm—Jackson Walker L.L.P.

(57) **CLAIM**

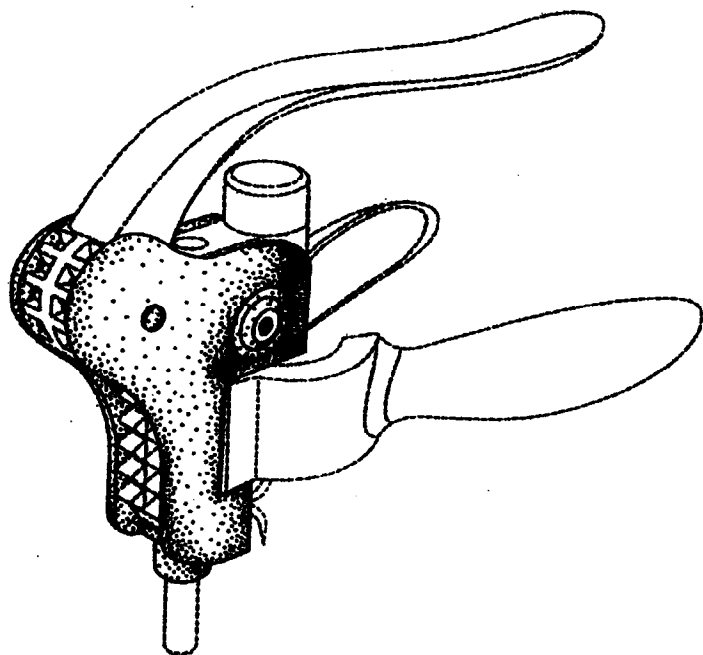
The ornamental design of a cork extractor, as shown and described.

**DESCRIPTION**

FIG. 1 is a front perspective view of the present invention. FIG. 2 is a front view thereof. FIG. 3 is a rear view thereof. FIG. 4 is a right side view thereof. FIG. 5 is a left side view thereof. FIG. 6 is a top plan view thereof. FIG. 7 is a bottom plan view thereof; and, FIG. 8 is an additional front perspective view showing the present invention in an alternate environment for use. The broken line showings throughout the views are for illustrative purposes only and form no part of the claimed design.

- (56) **References Cited**
- U.S. PATENT DOCUMENTS**
- 4,253,351 A • 3/1981 Allen ..... 81/3.29
  - D408,697 S • 4/1999 Bergen ..... D8/42
  - D415,667 S • 10/1999 de Bergen ..... D8/42
  - D420,558 S • 2/2000 Lee ..... D8/39
  - D430,994 S • 9/2000 Kilduff ..... D8/39
  - D441,265 S • 5/2001 Kilduff ..... D8/39
  - D442,043 S • 5/2001 Kao ..... D8/39
  - D442,045 S • 5/2001 Kilduff ..... D8/39
  - D444,045 S • 6/2001 Kay ..... D8/39
  - D445,008 S • 7/2001 Andina et al. .... D8/42
  - D446,098 S • 8/2001 Kilduff ..... D8/39
  - D446,702 S • 8/2001 Kilduff ..... D8/39

1 Claim, 7 Drawing Sheets





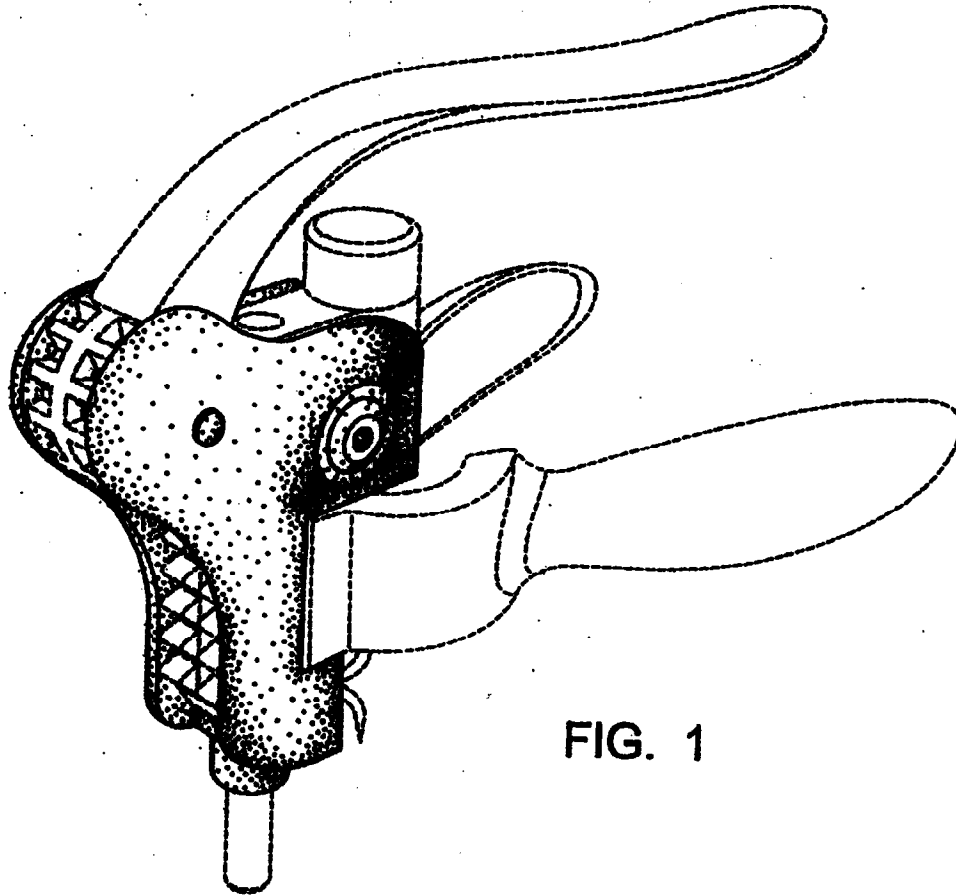


FIG. 1

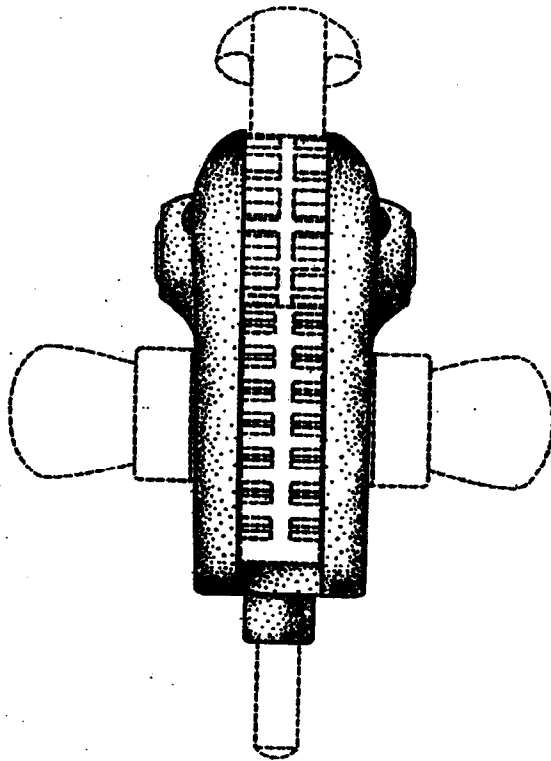


FIG. 2

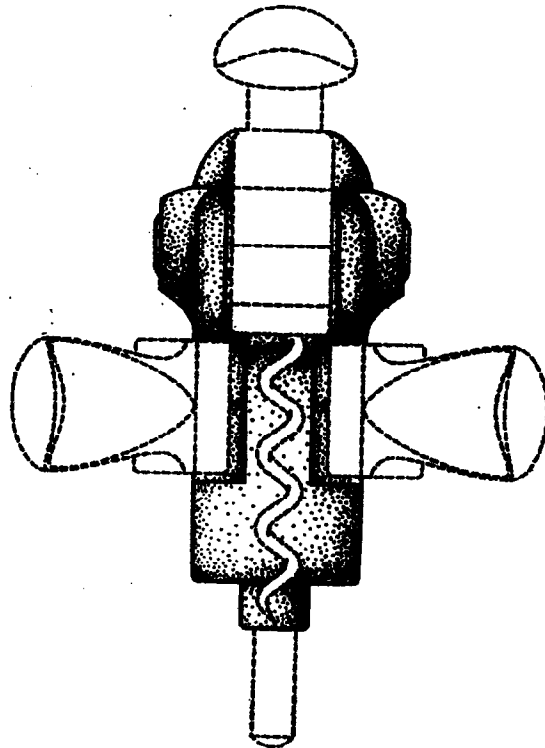


FIG. 3

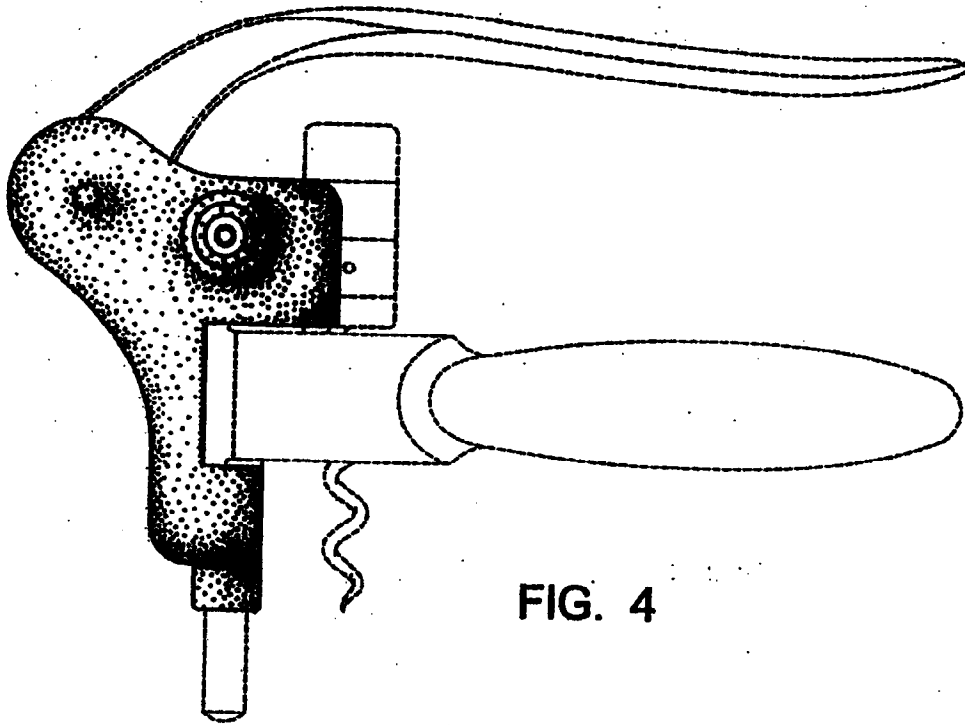


FIG. 4

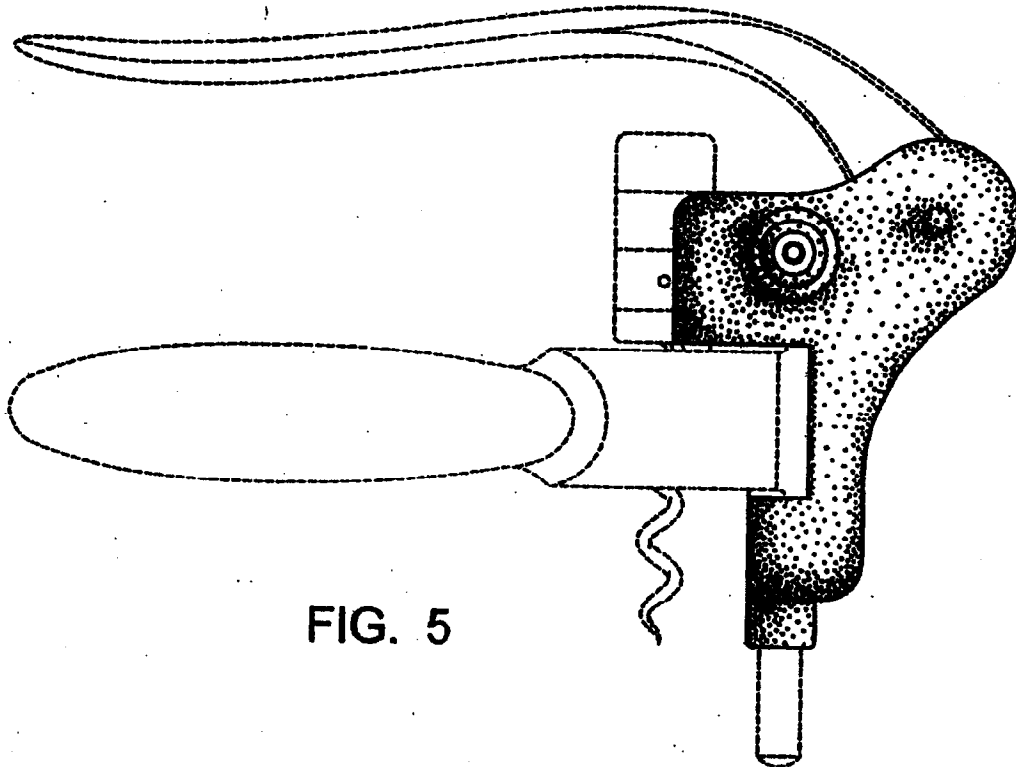


FIG. 5

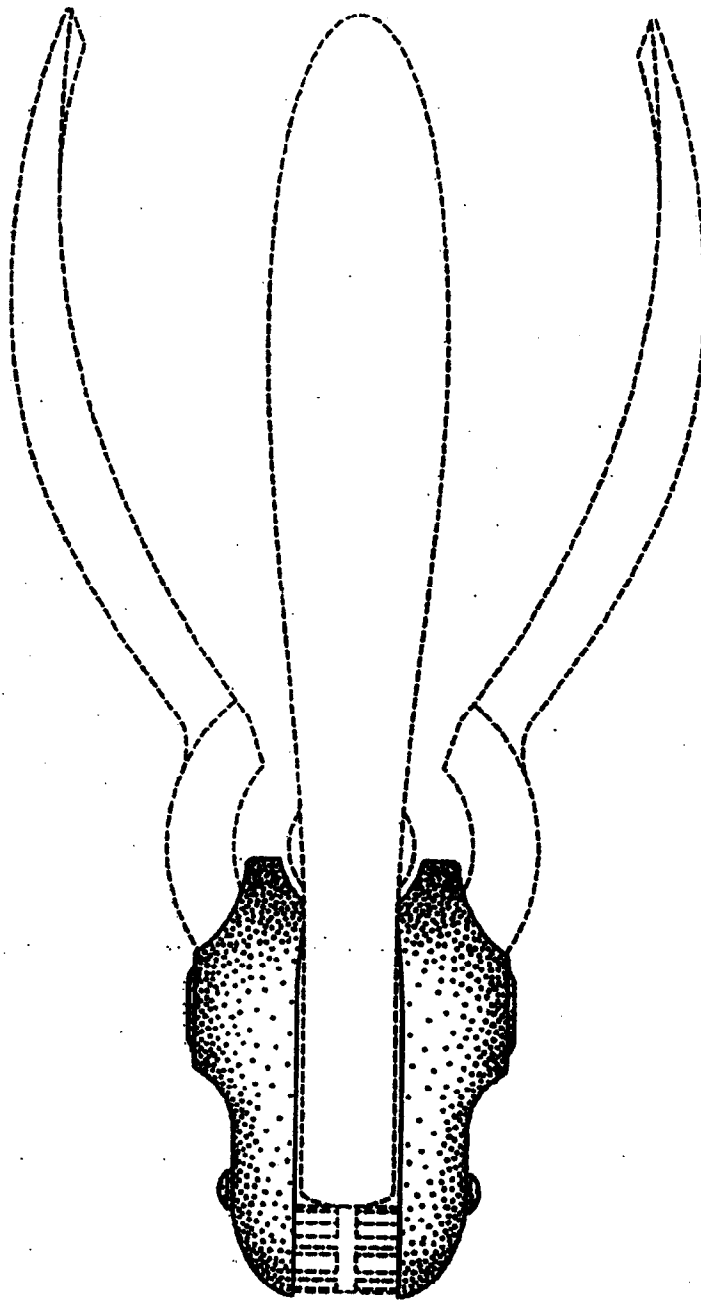


FIG. 6

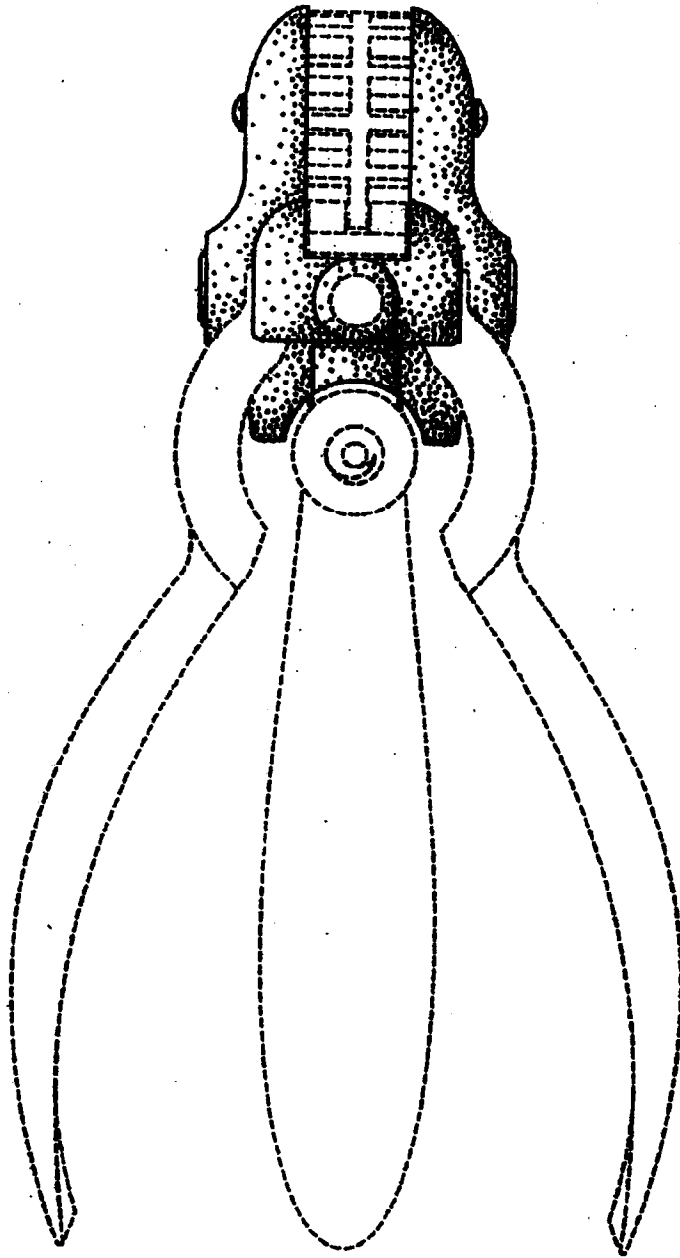


FIG. 7

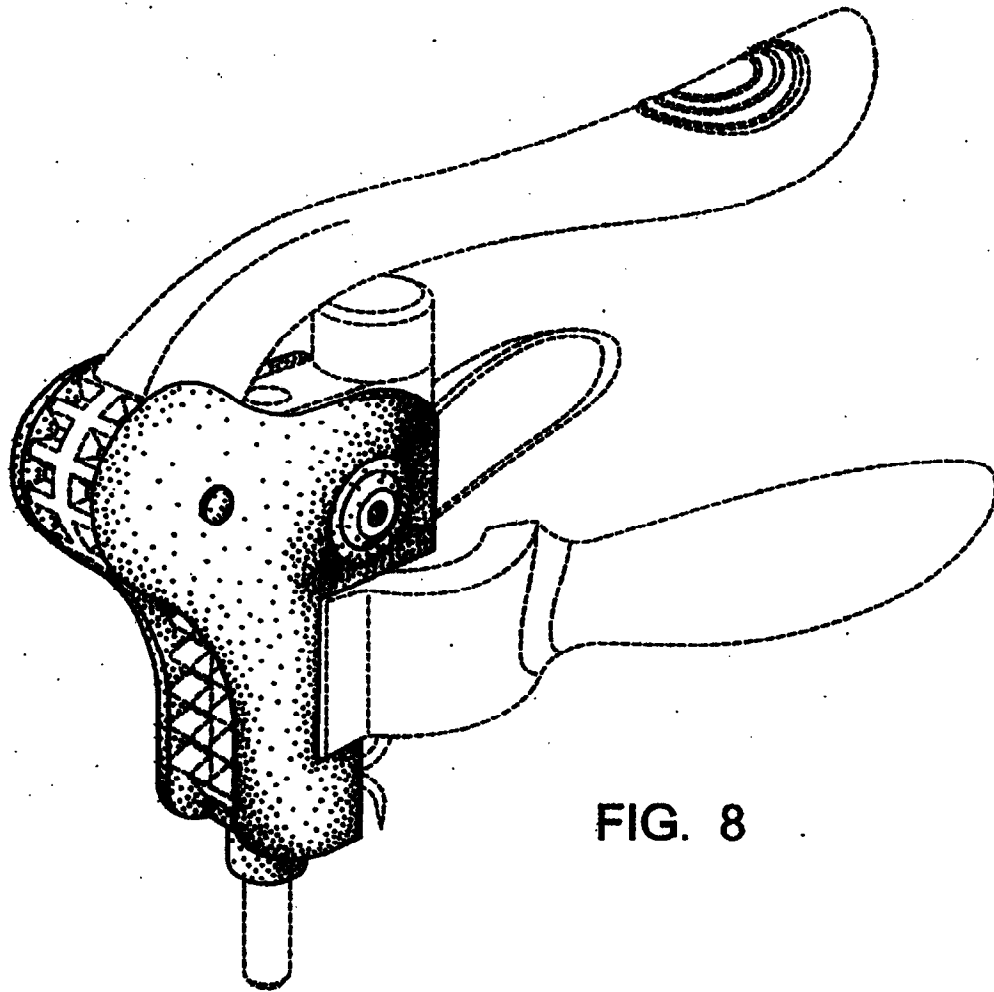


FIG. 8