

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

In the Matter of Trademark Application Serial No. 78165318

For the Mark "THE PLACE TO BEAD"

Published in the Official Gazette on August 31, 2004.

JULIE FROINES,

Opposer,

v.

The Place To Bead LLC, a
Utah Limited Liability Company,

Applicant.

NOTICE OF OPPOSITION

Julie Froines, the Opposer identified above (hereinafter referred to as "Ms. Froines"), believes that she will be damaged by the Applicant's registration of the mark "THE PLACE TO BEAD" and hereby opposes the same.

The grounds for opposition are as follows:

1.

The Applicant's proposed mark, "THE PLACE TO BEAD", was published for Opposition in the Official Gazette on August 31, 2004. This Opposition is timely filed as it is being sent by Certified Mail, Return Receipt Requested, to the Trademark Trial and Appeal Board on September 2, 2004, within 30 days after the date of publication.

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U.S. Patent & TMO/TM Mail Rcpt Dt. #22

2.

Ms. Froines is the owner of a business located in San Ramon, California known as “The Place To Bead”, which is engaged in the sale of beads and beading supplies, and which also holds classes for persons interested in making their own personalized beaded jewelry. Ms. Froines has been in business under the name “The Place To Bead” since at least October 1, 1991. Additionally, Ms. Froines has used that name in interstate commerce since at least October 1, 1997, when she began advertising her business in trade magazines distributed throughout the United States. In 1999, Ms. Froines established an internet website, www.placetobead.com, and has conducted online sales and advertising since that time. Accordingly, not only does Ms. Froines advertise extensively in nationally distributed trade and hobby magazines, she sells her goods to customers throughout the United States through her internet site. As such, Ms. Froines claims common law trademark rights in the name “The Place To Bead” within the State of California dating back to October 1, 1991 and throughout the United States dating back to October 1, 1997.

3.

On January 26, 2004, Ms. Froines submitted an application for a federal trademark registration for the mark “THE PLACE TO BEAD”, including an accompanying design. That application was submitted after the Trademark Office had issued an Office Action making final a refusal to register the Applicant’s mark for “THE PLACE TO BEAD”. Ms. Froines’ application was assigned serial number 76573097. A copy of the information concerning Ms. Froines’ application, taken from the USPTO TARR system, is attached hereto as Exhibit 1 and by this reference incorporated herein.

4.

Recently, Ms. Froines received correspondence from the Trademark Office stating that although there were no registered marks which would bar her registration, if the Applicant's mark matures into a registration then the Trademark Office would refuse registration of Ms. Froines' mark.

5.

As recognized on Ms. Froines' application and as stated above, she first began to use the mark in interstate commerce on October 1, 1997. Ms. Froines has continued to use the mark in commerce throughout the United States since that time, and such use continues today.

6.

As a result of Ms. Froines' extensive advertising and promotion of her business, her "The Place To Bead" mark, through widespread public acceptance and recognition, has become a unique, distinctive and readily recognizable mark among customers and members of the trade and public. The name "The Place To Bead" has become a distinctive designation of the source of origin of goods and services offered by Ms. Froines and is an asset of incalculable value as a symbol of her business, the quality of her business and her goodwill.

7.

Because Ms. Froines employs the name "The Place To Bead" throughout the United States and has spent significant sums in promoting that mark, developing name recognition and goodwill, there is a high risk that the use of marks which are confusingly similar to that mark will damage and/or dilute her rights to that name and mark. The damaging effects are

multiplied where competitors such as the Applicant offer goods identical to those offered by Ms. Froines under a name which is identical to the name claimed by Ms. Froines.

8.

The goods and services to be covered under the Applicant's proposed mark are "Hobby craft sets for beading". In addition, the Applicant has apparently submitted another application for the name "The Place To Bead" for "retail craft stores", which application has been assigned serial number 78427266. The goods provided by the Applicant under both of the Applicant's applications are identical to the goods provided by Ms. Froines under the name "The Place To Bead".

9.

The customers and suppliers that would be likely to do business with the Applicant are the same as the ones likely to do business with Ms. Froines. That is especially true considering the fact that Ms. Froines has maintained an internet website, www.placetobead.com, and has conducted online sales since at least 1999. Accordingly, not only does Ms. Froines advertise extensively in nationally distributed trade and hobby magazines, she sells her goods to customers throughout the United States through her internet site.

10.

The appearance and sound of Ms. Froines' mark and the Applicant's mark are identical and likely to confuse consumers and suppliers, especially considering that Ms. Froines and the Applicant are engaged in the same type of business.


11.

As stated above, Ms. Froines has used the name "The Place To Bead" throughout the United States continuously since at least October, 1997. The Applicant has alleged she first used the name "THE PLACE TO BEAD" on August 1, 2002, long after Ms. Froines began use of that name. There is no evidence to show that the Applicant's use of that name, within the State of Utah or elsewhere, predates Ms. Froines' use of that name so as to entitle the Applicant to any common law trademark or other rights in that name.

12.

Because the mark proposed by the Applicant is confusingly similar to the mark used by Ms. Froines, which use is prior in time to the Applicant's, especially considering the close relation between the goods and services provided and the customer and supplier overlap, registration of the Applicant's proposed mark would seriously damage Ms. Froines and her business and do irreparable harm to Ms. Froines' prior rights in the name "The Place To Bead". Accordingly, Ms. Froines respectfully requests that registration of the Applicant's mark be denied.

DATED this 2nd day of September, 2004.



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Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-09-02 15:55:32 ET

Serial Number: 76573097

Registration Number: (NOT AVAILABLE)

Mark



The Place to Bead

(words only): THE PLACE TO BEAD

Standard Character claim: No

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2004-08-18

Filing Date: 2004-01-26

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 106

Attorney Assigned:
FOSTER STEVEN R Employee Location

Current Location: L60 -TMEG Law Office 106

Date In Location: 2004-08-17

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Julie Froines

Address:

Exhibit 1
Page 1/2

Julie Froines
2551 San Ramon Valley Blvd., Ste. 103
San Ramon, CA 94583
United States
Legal Entity Type: Unknown
State or Country Where Organized: Not Provided
Phone Number: 925-837-5544

GOODS AND/OR SERVICES

International Class: 014
Beads, beading kits, beading supplies, tools and accessories for the creation of personalized jewelry
First Use Date: 1991-10-01
First Use in Commerce Date: 1997-10-01

Basis: 1(a)

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-08-18 - Non-final action mailed
2004-08-17 - Case file assigned to examining attorney
2004-02-17 - New Application Entered In Tram

CONTACT INFORMATION

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September 2, 2004

SENT VIA CERTIFIED MAIL, RETURN RECEIPT REQUESTED

TTAB

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, VA 22202

RE: Opposition to Registration of Serial Number 78165318
"THE PLACE TO BEAD" mark

Dear Sir or Madam:


This office represents Julie Froines, the proprietor of a business known as "The Place To Bead", whose principal office is located in California. Ms. Froines has done business under the name "The Place To Bead" since October 1, 1991. Ms. Froines also has pending a trademark application for that name, which application has been assigned Serial No. 76573097.

Enclosed are two (2) original Oppositions submitted on behalf of Ms. Froines opposing the registration by a third party (known as The Place To Bead, LLC) of the mark "THE PLACE TO BEAD", Serial No. 78165318, which was published for opposition in the Official Gazette on August 31, 2004. This Opposition is timely as it is being submitted within 30 days after publication. We are also enclosing a check for the required filing fee in the amount of \$300.00.

Please advise as to when you receive this Opposition and whether there is any additional information which we can provide for you.

Very truly yours,

BROPHY, MILLS, SCHMOR
GERKING & BROPHY, LLP


Thaddeus G. Pauck

Enclosures

cc: Julie Froines



09-07-2004

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