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

Mark: BABY SHAKESPEARE

Attorney Docket No.: KSHAK62650

Application Serial No: 76/452,605

International Class: 20

Filed: September 25, 2002

Applicant: The Baby Einstein Company, LLC

Published for Opposition: July 20, 2004

Official Gazette: Page TM 325

Goods: sleeping bags, plastic cake decorations; drinking straws; figurines of wood, wax, plaster, or plastic; picture frames; jewelry boxes not of precious metal; decorative mobiles; pillows; decorative wall plaques; statues of wood, wax, plaster or plastic; mirrors; plastic ornamental badges; toy chests; beds; infant walkers; seats; bassinets; infant cradles; playpens; non-metal nesting boxes; high chairs for babies

SHAKESPEARE COMPANY, LLC, a  
Delaware limited liability company,

Opposer,

v.

THE BABY EINSTEIN COMPANY, LLC, a  
Colorado limited liability company,

Applicant.

Opposition No. \_\_\_\_\_

NOTICE OF OPPOSITION

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NOTICE OF OPPOSITION

Seattle, Washington 98101

January 11, 2005

TO THE COMMISSIONER FOR TRADEMARKS

TRADEMARK TRIAL AND APPEAL BOARD

Shakespeare Company, LLC, a limited liability company, organized and existing under the laws of the State of Delaware, and having a place of business at 3801 Westmore Drive, Columbia, South Carolina 29223 (hereinafter "Opposer"), believes that it will be damaged by registration of the



mark BABY SHAKESPEARE for all of the goods claimed by U.S. Application Serial No. 76/452,605, filed September 25, 2002, and hereby opposes the same.

As grounds for the Opposition, Opposer alleges as follows:

1. On information and belief, The Baby Einstein Company, LLC is a limited liability company organized and existing under the laws of the State of Colorado, and having a place of business at 500 South Buena Vista Street, Burbank, California 91521 (hereinafter "Applicant").

2. Continuously, since long prior to any date upon which Applicant can rely, Opposer has used the trademark SHAKESPEARE in association with the sale of fishing poles, fishing line, fishing reels, fishing tackle, camping products, clothing, sunglasses, and a wide variety of recreational and sporting equipment.

3. Opposer is the owner of U.S. Registration No. 359,879 for the mark SHAKESPEARE for fishing reels, fishing lines, fishing rods, and artificial fishing baits and lures in International Class 28. Said registration issued August 30, 1938, and is currently valid, subsisting, and incontestable.

4. Opposer is the owner of U.S. Registration No. 2,183,050 for the mark SHAKESPEARE for camping furniture, namely, picnic tables, folding chairs, canvas chairs, and sleeping pads, and stadium seats in International Class 20. Said registration issued August 18, 1998, and is currently valid, subsisting, and incontestable.

5. Opposer is the owner of U.S. Registration No. 2,211,805 for the mark SHAKESPEARE for portable food and beverage coolers in International Class 21. Said registration issued December 15, 1998, and is currently valid, subsisting, and incontestable.

6. Opposer is the owner of U.S. Registration No. 2,213,444 for the mark SHAKESPEARE for backpacks in International Class 18. Said registration issued December 22, 1998, and is currently valid, subsisting, and incontestable.

7. Opposer is the owner of U.S. Registration No. 2,241,287 for the mark SHAKESPEARE for camping gloves and fishing tackle boxes in International Class 28. Said registration issued April 20, 1999, and is currently valid, subsisting, and incontestable.

8. Opposer is the owner of U.S. Registration No. 2,241,288 for the mark SHAKESPEARE for sunglasses and sunglass cases in International Class 9. Said registration issued April 20, 1999, and is currently valid, subsisting, and incontestable.

9. Opposer is the owner of U.S. Registration No. 2,241,290 for the mark SHAKESPEARE for duffel bags, fanny packs, mesh toiletry bags sold empty, all purpose sport and camping bags, bags for carrying bottles, and shoulder straps for the same in International Class 18. Said registration issued April 20, 1999, and is currently valid, subsisting, and incontestable.

10. Opposer is the owner of U.S. Registration No. 2,242,083 for the mark SHAKESPEARE for stools in International Class 20. Said registration issued April 27, 1999, and is currently valid, subsisting, and incontestable.

11. Opposer is the owner of U.S. Registration No. 2,281,649 for the mark SHAKESPEARE for cots in International Class 20. Said registration issued September 28, 1999, and is currently valid, subsisting, and incontestable.

12. Opposer is the owner of U.S. Registration No. 2,473,865 for the mark SHAKESPEARE for tents in International Class 22. Said registration issued July 31, 2001, and is currently valid and subsisting.

13. Opposer is the owner of U.S. Registration No. 2,490,605 for the mark SHAKESPEARE for fishing accessories, namely, floats, sinkers, swivels and hand held nets in International Class 28. Said registration issued September 18, 2001, and is currently valid and subsisting.

14. Opposer will be damaged by the registration sought by Applicant insofar as the

registration will be *prima facie* evidence of the validity of the registration, Applicant's ownership of the mark BABY SHAKESPEARE, and Applicant's exclusive right to use the mark BABY SHAKESPEARE in association with all of the goods claimed by Application Serial No. 76/452,605 when, in fact, Applicant is not entitled to such rights by virtue of Opposer's prior and continuous use of the mark SHAKESPEARE in association with the sale of fishing poles, fishing line, fishing reels, fishing tackle, camping products, clothing, sunglasses, sleeping bags, and a wide variety of recreational equipment in the same channels of trade in which the goods claimed by Application Serial No. 76/452,605 would be sold.

15. Opposer and Applicant entered a Co-Existence Agreement effective April 21, 2003. The terms of that Co-Existence Agreement prohibit Applicant's use or registration of any mark including SHAKESPEARE for "recreational equipment, fishing poles, fishing line, fishing reels, fishing tackle, camping products, and sporting goods." The terms of that Co-Existence Agreement also include Opposer's agreement not to challenge use or registration of the mark BABY SHAKESPEARE for goods designed to "stimulate the learning capabilities of infants and children." Application Serial No. 76/452,605 includes goods that are not designed to "stimulate the learning capabilities of infants and children" and some goods that are recreational equipment or sporting goods. Application Serial No. 76/452,605 claims goods that are outside of the scope of registration or use permitted by the Co-Existence Agreement entered by the Parties effective April 21, 2003.

16. The mark BABY SHAKESPEARE shown by Application Serial No. 76/452,605, when used in association with some of the goods claimed by said application, so resembles Opposer's mark SHAKESPEARE as to be likely to cause confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

17. As a result of Opposer's long-term, substantial, and widespread use of the mark SHAKESPEARE shown by the registrations identified by Paragraph Nos. 3-13 herein, the mark

SHAKESPEARE has become famous and is thus a valuable symbol that serves to identify Opposer as the source of all goods and services identified by or promoted with the mark.

18. The mark SHAKESPEARE previously used by Opposer and shown by the registrations identified by Paragraph Nos. 3-13 herein became famous prior to any date upon which Applicant can show use of the mark BABY SHAKESPEARE.

19. Applicant's mark BABY SHAKESPEARE shown by Application Serial No. 76/452,605 includes the entirety of Opposer's famous mark SHAKESPEARE.

20. The mark shown by Application Serial No. 76/452,605 when used in association with some of the goods claimed by Application Serial No. 76/452,605 so resembles Opposer's famous mark SHAKESPEARE previously used and registered by Opposer and shown by the registrations identified by Paragraph Nos. 3-13 herein as to be likely to falsely suggest a connection between Opposer and Applicant in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

21. The mark shown by Application Serial No. 76/452,605 so resembles Opposer's famous mark SHAKESPEARE when used in association with some of the goods claimed by Application Serial No. 76/452,605 as to cause dilution of the distinctive quality of Opposer's mark SHAKESPEARE in violation of 15 U.S.C. § 1125(c).

22. Based upon the foregoing, registration of the mark BABY SHAKESPEARE shown by Application Serial No. 76/452,605 for all of the goods claimed by said application, filed September 25, 2002, is likely to cause injury and damage to Opposer.

WHEREFORE, Opposer respectfully requests that the registration of the mark BABY SHAKESPEARE shown by Application Serial No. 76/452,605 be denied pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and Section 43 of the Lanham Act, 15 U.S.C. § 1125(c), and that this opposition be sustained.

Accompanying the duplicate signed copies of this Notice of Opposition is our Check

No. 159468 for the required filing fee in the amount of \$300.00 (\$300.00 per class). Please charge any excess fees to Deposit Account No. 03-1740 of Opposer's counsel noted below.

Please direct all correspondence to Cindy L. Caditz of Christensen O'Connor Johnson Kindness<sup>PLLC</sup> at the following address:

Cindy L. Caditz  
Christensen O'Connor Johnson Kindness<sup>PLLC</sup>  
1420 Fifth Avenue, Suite 2800  
Seattle, WA 98101-2347

Please direct all telephone calls to Cindy L. Caditz at 206-682-8100.

DATED this 11th day of January, 2005.

Respectfully submitted,

CHRISTENSEN O'CONNOR  
JOHNSON KINDNESS<sup>PLLC</sup>



Cindy L. Caditz  
Attorneys for Opposer

#### CERTIFICATE OF MAILING

I hereby certify that this NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 76/452,605 for the mark BABY SHAKESPEARE is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Trademarks, Trademark Trial and Appeal Board, 2900 Crystal Drive, Arlington, VA 22202-3513, on the below date.

Date: January 11, 2005



CLC:jh