

ESTTA Tracking number: **ESTTA34249**

Filing date: **05/27/2005**

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

Proceeding	91163994
Party	Defendant The Baby Einstein Company, LLC The Baby Einstein Company, LLC 500 South Buena Vista Street Burbank, CA 91521
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Submission	Answer
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Signature	/Julia Anne Matheson/
Date	05/27/2005
Attachments	Answer-91163994.pdf (9 pages)

6. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 6 of the Notice of Opposition, and therefore denies them

7. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 7 of the Notice of Opposition, and therefore denies them.

8. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 8 of the Notice of Opposition, and therefore denies them.

9. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 9 of the Notice of Opposition, and therefore denies them.

10. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 10 of the Notice of Opposition, and therefore denies them.

11. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 11 of the Notice of Opposition, and therefore denies them.

12. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 12 of the Notice of Opposition, and therefore denies them.

13. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 13 of the Notice of Opposition, and therefore denies them.

14. The statements in Paragraph 14 concerning the benefits and presumptions afforded by a U.S. registration are mere recitations of law that do not require an answer. Applicant denies the general allegation of damages set forth in Paragraph 14. Applicant denies the allegations in Paragraph 14 to the effect that Applicant is not entitled to the rights afforded by federal registration. With respect to the allegations in paragraph 14 concerning Opposer's asserted prior and continuous use of the mark SHAKESPEARE, Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations and therefore denies them.

Applicant denies the allegation that Opposer's pleaded goods and Applicant's goods in Application Serial No. 76/452,605 travel in the same channels of trade.

15. With respect to Paragraph 15 of the Notice of Opposition, Applicant admits that Opposer and Applicant entered a Co-Existence Agreement effective April 21, 2003; admits that the terms of the Co-Existence Agreement prohibit Applicant's use or registration of any name or mark comprised of or including SHAKESPEARE for "recreational equipment, fishing poles, fishing line, fishing reels, fishing tackle, and camping products and sporting goods;" and admits that the terms of the Co-Existence Agreement prohibit Opposer from challenging Applicant's use or registration of the mark BABY SHAKESPEARE for goods designed to "stimulate the learning capabilities of infants and children." Applicant denies all of the remaining allegations in Paragraph 15 of the Notice of Opposition. Applicant specifically denies the allegation in Paragraph 15 that Application Serial No. 76/452,605 includes goods that are not designed to "stimulate the learning capabilities of infants and children." Applicant specifically denies the allegation in Paragraph 15 that some of the goods in Application Serial No. 76/452,605 are recreational equipment or sporting goods. Applicant specifically denies the allegation in Paragraph 15 that 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. Applicant denies the allegations set forth in Paragraph 16 of the Notice of Opposition.

17. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 17 of the Notice of Opposition, and therefore denies them.

18. Applicant lacks sufficient information to form a belief as to the truth or falsity of the allegations set forth in Paragraph 18 of the Notice of Opposition, and therefore denies them.

19. With respect to the allegations in Paragraph 19 of the Notice of Opposition, Applicant admits only that its mark BABY SHAKESPEARE contains within it the word SHAKESPEARE. With respect to the remaining allegations in Paragraph 19 concerning Opposer's alleged ownership of the mark SHAKESPEARE and the purported fame of Opposer's alleged mark, Applicant lacks sufficient information to form a belief as to the truth or falsity of these remaining allegations set forth in Paragraph 19 of the Notice of Opposition and therefore denies them.

20. Applicant denies the allegations set forth in Paragraph 20 of the Notice of Opposition.

21. Applicant denies the allegations set forth in Paragraph 21 of the Notice of Opposition.

22. Applicant denies the allegations set forth in Paragraph 22 of the Notice of Opposition.

23. Applicant denies any implied allegations of damage contained in the request for relief in the unnumbered paragraph that follows numbered Paragraph 22 in the Notice of Opposition.

AFFIRMATIVE DEFENSES

24. Opposer lacks standing to bring this opposition.

25. The Notice of Opposition fails to state a claim upon which relief may be granted.

26. The opposition is barred by the doctrines of estoppel by laches and waiver.

27. The opposition is barred by the doctrine of acquiescence.

28. Opposer is contractually estopped from opposing the subject Application by virtue of the April 21, 2003 Co-Existence Agreement between the parties that prohibits Opposer from challenging Applicant's use or registration of the marks **BABY SHAKESPEARE** and/or **LITTLE SHAKESPEARE** for goods designed to "stimulate the learning capabilities of infants and children."

29. Opposer's claims are barred by the doctrine of unclean hands. Opposer and Applicant entered into a Co-Existence Agreement, effective April 21, 2003, in which Opposer agreed that it would not challenge Applicant's use or registration of the marks **BABY SHAKESPEARE** and/or **LITTLE SHAKESPEARE** for goods designed to "stimulate the learning capabilities of infants and children." Opposer now seeks to modify the Co-Existence Agreement and to this end has presented Applicant with an "Amendment to Coexistence Agreement." The present opposition as such represents nothing more than an illegitimate attempt by Opposer to harass Applicant for the purpose of attempting to force Applicant to cede back to Opposer rights that were conferred to Applicant in the April 21, 2003 Co-Existence Agreement between the parties.

30. Opposer cannot be damaged by registration of Applicant's subject Application Serial No. 76/452,605 because Applicant is also the owner of the following U.S. Registrations for the mark **BABY SHAKESPEARE**:

- Reg. No. 2,489,954 for **BABY SHAKESPEARE & Design** for audiovisual programming for children stored for playback on videotape, videodisc, CD-ROM, DVD.
- Reg. No. 2,460,824 for **BABY SHAKESPEARE & Design** for "books for children that incorporate photographic images, poetry and prose."

31. There is no likelihood of confusion between Applicant's mark for the goods listed in its Application Serial No. 76/452,605 because Applicant's subject mark **BABY SHAKESPEARE** is part of the well-known family of "BABY" formative marks and names that combine the term "BABY" with the name of renowned persons in the fields of art, music, letters and science. Consequently, consumers will immediately recognize Applicant's **BABY SHAKESPEARE** mark as another mark in Applicant's "BABY" formative family of marks and will readily associate goods bearing the mark **BABY SHAKESPEARE** with Applicant, The Baby Einstein Company, LLC, and with Applicant's series of "BABY" brand product offerings. Among Applicant's "BABY" family of marks and names are the following U.S. Trademark Registrations:

- Reg. No. 2,531,261 for **BABY VAN GOGH & Design** for "books for babies, infants and toddlers; flashcards.
- Reg. No. 2,533,408 for **BABY VAN GOGH & Design** for "audiovisual and audio programming designed to stimulate the learning capabilities of infants and toddlers, namely, pre-recorded videotapes, videodiscs, DVDs, CD-ROMs, audio cassettes, and audio CDs, all featuring music, natural sounds, spoken words, photographic images and graphic images."
- Reg. No. 2,535,468 for **BABY WEBSTER & Design** for "audiovisual and audio programming designed to stimulate the learning capabilities of infants and toddlers, namely, pre-recorded videotapes, videodiscs, DVDs, CD-ROMs, audio cassettes, and audio CDs, all featuring music, natural sounds, spoken words, photographic images and graphic images."

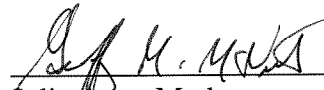
- Reg. No. 2,463,268 for **BABY BEETHOVEN & Design** for “pre-recorded videotapes, videodiscs, compact discs, audio cassettes, and DVDs featuring children’s music.”
- Reg. No. 2,648,992 for **BABY BACH** for “games, playthings and toys for children, namely puppets, plush toys, pull toys, crib toys, electronic action toys, board games, hand-held electronic games, role-playing games, and music, art, language, poetry, math and science multiple-activity toys.”
- Reg. No. 2,607,780 for **BABY BACH & Design** for “pre-recorded video tapes, videodiscs, CD-ROMs, CDs, audio cassettes and DVDs featuring children's music.”
- Reg. No. 2,380,650 for **BABY EINSTEIN & Design** for “audiovisual and audio programming designed to stimulate the learning capabilities of infants and young children, namely, pre-recorded video tapes, videodiscs, DVDs, CD-ROMs, audio cassettes and audio CDs, all featuring music, natural sounds, spoken words, photographic images and graphic images.”
- Reg. No. 2,528,127 for **BABY EINSTEIN & Design** for “games, playthings and toys for children, namely puppets, plush toys, pull toys, crib toys, electronic action toys, board games, hand-held electronic games, electronic board games, role-playing games, and music, art, language, poetry, math and science multiple-activity toys.”
- Reg. No. 2,598,640 for **BABY EINSTEIN & Design** for “books for babies, infants and toddlers; flashcards.”
- Reg. No. 2,791,739 for **BABY EINSTEIN** for “Online retail store services featuring games and playthings for children and audiovisual programming for children stored for playback on video tape, video disc, CD-ROM, DVD.”

32. There is no likelihood of confusion between Applicant's mark for the goods listed in its Application Serial No. 76/452,605 and Opposer's pleaded marks and goods.

WHEREFORE, The Baby Einstein Company, LLC, prays that this opposition be dismissed with prejudice and on the merits, and that Applicant's mark be granted registration.

Respectfully Submitted,

Dated: May 27, 2005

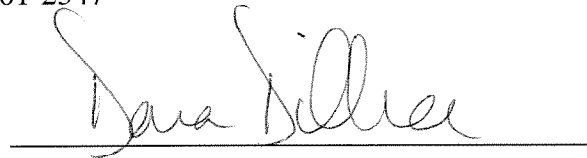


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CERTIFICATE OF SERVICE

I hereby certify that on May 27, 2005 a true and correct copy of the foregoing Answer was served by United States first class mail, postage prepaid, on counsel for Opposer:

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A handwritten signature in cursive script, appearing to read "Dana Silberman", is written above a solid horizontal line.