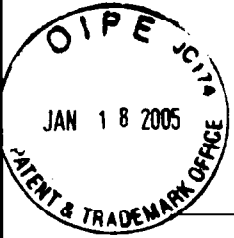


Attorney Docket No.: 257867US33

BOX TTAB FEE



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

VERBATIM CORPORATION, )

Opposer, )

v. )

WILEY PUBLISHING, INC., )

Applicant. )

Opposition No.: \_\_\_\_\_  
Appln. Serial No. 75/938,020

The Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

VERBATIM CORPORATION, a corporation duly organized and existing under the laws of the State of California, located and doing business at 1200 W. T. Harris Boulevard, Charlotte, North Carolina 28262 (hereinafter "Opposer"), believing that it will be damaged by registration, hereby opposes Application Serial No.75/938,020, filed March 8, 2000, under the Trademark Act of 1946, in the name of Wiley Publishing, Inc., published for opposition in the *Official Gazette* of July 20, 2004, Vol. 1284, No. 3, at Page TM 8, for the mark V AND DESIGN.

01/25/2005 KGIBBONS 00000044 75938020

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300.00 DP



01-18-2005

The grounds of Opposition are as follows:

1. The Opposer, VERBATIM CORPORATION, is a corporation duly organized and existing under the laws of the State of California, having its principal offices at 1200 W. T. Harris Boulevard, Charlotte, North Carolina 28262.

2. Commencing long prior to Applicant's filing date, Opposer has engaged, and is now engaged in the manufacture, distribution, sale, advertising and promotion in interstate commerce of computer products, including but not limited to, magnetic and optical data storage devices, and supplies and equipment for computers and printers (hereinafter sometimes referred to as "Opposer's goods").

3. Commencing long prior to Applicant's filing date, Opposer has used, and is now using Opposer's V AND DESIGN trademark (hereinafter sometimes referred to as Opposer's Mark) in connection with Opposer's goods distributed and sold by Opposer in commerce.

4. Opposer is the owner of, and will rely herein, upon the following Federal trademark registration:

MARK  
V AND DESIGN

REGISTRATION NO.  
1,717,603

ISSUED  
September 22, 1992

Opposer's Registration No. 1,717,603 identifies the goods as "blank magnetic recording tape, cassettes containing magnetic recording tape, cartridges containing magnetic recording tape; blank and preformatted magnetic recording disks; blank and preformatted optical disks; and computer head cleaning kits, comprised of cleaning diskette and solution". Opposer's Registration No. 1,717,603 is incontestible by virtue of Opposer's Section 15 Affidavit being accepted on June 30, 1998. A copy of the registration is attached hereto, as Opposer's Exhibit 1. Said registration of Opposer's Mark is valid and subsisting and is conclusive evidence of

Opposer's exclusive right to use Opposer's Mark in commerce on the goods specified in said registration.

5. Opposer will also rely on its common law trademark rights resulting from its use of the V AND DESIGN mark on a variety of other goods, including supplies and equipment for computers and printers.

6. Since its initial use of the V AND DESIGN mark, Opposer has made a substantial investment in advertising and promoting its goods under its trademark. Opposer has extensively used, advertised, promoted and offered Opposer's goods bearing the mark to the public through various channels of trade in commerce, with the result that Opposer's customers and the public in general have come to know and recognize Opposer's Mark and associate same with Opposer and/or goods sold by Opposer. Opposer has built extensive goodwill in connection with the sales of products under its mark.

7. Upon information and belief, notwithstanding Opposer's rights in and to its mark, on March 8, 2000, Applicant filed an application for registration of the alleged V AND DESIGN trademark for "Prerecorded compact discs in the fields of computer-related information and computer information technology," in International Class 9; "books, pamphlets and printed guides in the fields of computer information technology," in International Class 16; and "for providing a web site via the Internet featuring information in the field of computers", in International Class 42. Said application was assigned Serial No. 75/938,020, and was published for Opposition in the *Official Gazette* of July 20, 2004, Vol. 1284, No. 3, at Page TM 8.

8. Applicant's V AND DESIGN mark is a simulation and colorable imitation of, and so resembles Opposer's trademark as to be likely, when applied to the proposed goods of

Applicant, to cause confusion or mistake or to deceive purchasers resulting in damage and detriment to Opposer and its reputation.

9. Upon information and belief, Opposer's and Applicant's goods will be sold in close proximity and purchased and consumed by the same general class of purchasers.

10. 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 proposed goods to be marketed under Applicant's alleged V AND DESIGN 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.

11. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the alleged V AND DESIGN trademark, as set forth in Applicant's Trademark Application Serial No. 75/938,020, in that the mark is substantially similar to Opposer's trademark and common law rights and will be used in connection with goods identical to the goods offered to the public by Opposer.

WHEREFORE, this Opposer, VERBATIM CORPORATION, believes and avers that it is being and will continue to be damaged by registration of the V AND DESIGN trademark as aforesaid, and prays that said Application Serial No. 75/938,020 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

Opposer has appointed Jeffrey H. Kaufman and P. Jay Hines, members of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., and members 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:

**Jeffrey H. Kaufman**  
OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, Virginia 22314

We enclose our credit card payment form or check for the required filing fee for this Opposition. 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,

VERBATIM CORPORATION

By:



Jeffrey H. Kaufman  
P. Jay Hines  
Oblon, Spivak, McClelland,  
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Date: 1/18/05

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# **EXHIBIT 1**



Int. Cl.: 9

Prior U.S. Cl.: 26

**United States Patent and Trademark Office**

**Reg. No. 1,717,603**

Registered Sep. 22, 1992

**TRADEMARK  
PRINCIPAL REGISTER**



VERBATIM CORPORATION (CALIFORNIA CORPORATION)  
1200 W.T. HARRIS BOULEVARD  
CHARLOTTE, NC 28262

FOR: BLANK MAGNETIC RECORDING TAPE, CASSETTES CONTAINING MAGNETIC RECORDING TAPE, CARTRIDGES CONTAINING MAGNETIC RECORDING TAPE; BLANK AND PREFORMATTED MAGNETIC RECORDING DISKS; BLANK AND PREFORMATTED

OPTICAL DISKS; AND COMPUTER HEAD CLEANING KITS, COMPRISED OF CLEANING DISKETTE AND SOLUTION, IN CLASS 9 (U.S. CL. 26).

FIRST USE 6-30-1982; IN COMMERCE 6-30-1982.

SER. NO. 74-113,865, FILED 11-9-1990.

ANNA W. MANVILLE, EXAMINING ATTORNEY