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

Mark: THE UGLY STICK

Attorney Docket No.: KSHAK62710

Application Serial No: 76/583,243

International Class: 28

Filed: March 25, 2004

Applicant: Ugly Tree, Inc.

Mark: THE UGLY STICK

Published for Opposition: January 11, 2005

Official Gazette: Page TM 433

Goods: plush and inflatable toys

SHAKESPEARE COMPANY, LLC, a  
Delaware limited liability company,

Opposer,

v.

UGLY TREE, INC., a New York corporation,

Applicant.

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

NOTICE OF OPPOSITION

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Seattle, Washington 98101

February 9, 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 THE UGLY STICK for the goods claimed by U.S. Application Serial No. 76/583,243, filed March 25, 2004, and hereby opposes the same.

As grounds for the Opposition, Opposer alleges as follows:

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1. On information and belief, Ugly Tree, Inc. is a corporation of the State of New York having a place of business at 210 West 90th Street, #3L, New York, New York 10024 (hereinafter "Applicant").
2. Continuously, since long prior to any date upon which Applicant can rely, Opposer has used the trademark UGLY STIK as a mark and as a distinctive portion of composite marks in association with the sale of fishing rods, fishing tackle, fishing reels, fishing line, and related promotional goods including, but not limited to clothing and collateral promotional items.
3. Opposer is the owner of U.S. Registration No. 1,064,566 for the mark UGLY STIK for fishing rods in International Class 28. Said registration issued April 26, 1977, and is currently valid, subsisting, and incontestable.
4. Opposer is the owner of U.S. Registration No. 2,546,533 for the mark UGLY STIK for clothing, namely, shirts, t-shirts, and hats in International Class 25. Said registration issued March 12, 2002, and is currently valid and subsisting.
5. Opposer is the owner of U.S. Registration No. 2,180,823 for the mark UGLY STIK TIGER for fishing rods in International Class 28. Said registration issued August 11, 1998, and is currently valid, subsisting, and incontestable.
6. Opposer is the owner of U.S. Registration No. 2,202,156 for the mark UGLY STIK INTERCOASTAL for fishing tackle in International Class 28. Said registration issued November 3, 1998, and is currently valid, subsisting, and incontestable.
7. Opposer is the owner of U.S. Registration No. 2,294,742 for the mark UGLY STIK TIGER for fishing tackle, namely, rods, reels, and line in International Class 28. Said registration issued November 23, 1999, and is currently valid and subsisting.
8. Opposer is the owner of U.S. Registration No. 1,389,220 for the mark UGLY STIK LITE for fishing rods in International Class 28. Said registration issued April 8, 1986, and is

currently valid, subsisting, and incontestable.

9. 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 THE UGLY STICK, and Applicant's exclusive right to use the mark THE UGLY STICK in association with the goods claimed by Application Serial No. 76/583,243 when, in fact, Applicant is not entitled to such rights by virtue of Opposer's prior and continuous use of the mark UGLY STIK in association with the sale of fishing rods, fishing tackle, fishing reels, fishing line, and related promotional goods including, but not limited to clothing and collateral promotional items in the same channels of trade in which the goods claimed by Application Serial No. 76/583,243 would be sold.

10. The mark THE UGLY STICK shown by Application Serial No. 76/583,243, when used in association with the goods claimed by said application, so resembles Opposer's mark UGLY STIK 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).

11. As a result of Opposer's long-term, substantial, and widespread use of the mark UGLY STIK which comprises the mark or a portion of the marks shown by the registrations identified by Paragraphs Nos. 3-8 herein, the mark UGLY STIK has become famous and thus is a valuable symbol that serves to identify Opposer as the source of all goods and services identified by or promoted with the mark.

12. The mark UGLY STIK previously used by Opposer and shown to comprise the mark or a portion of the marks shown by the registrations identified by Paragraphs Nos. 3-8 herein became famous prior to any date upon which Applicant can show use of the mark THE UGLY STICK.

13. Applicant's mark THE UGLY STICK shown by Application Serial No. 76/583,243 includes the entirety of Opposer's famous mark UGLY STIK.

14. The mark shown by Application Serial No. 76/583,243 when used in association with

the goods claimed by Application Serial No. 76/583,243 so resembles Opposer's famous mark UGLY STIK previously used and registered by Opposer and shown to comprise the mark or a portion of the marks shown by the registrations identified by Paragraphs Nos. 3-8 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).

15. The mark shown by Application Serial No. 76/583,243 so resembles Opposer's famous mark UGLY STIK when used in association with the goods claimed by Application Serial No. 76/583,243 as to cause dilution of the distinctive quality of Opposer's mark UGLY STIK in violation of 15 U.S.C. § 1125(c).

16. Based upon the foregoing, registration of the mark THE UGLY STICK shown by Application Serial No. 76/583,243 for the goods claimed by said application, filed March 25, 2004, is likely to cause injury and damage to Opposer.

WHEREFORE, Opposer respectfully requests that the registration of the mark THE UGLY STICK shown by Application Serial No. 76/583,243 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. 161360 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 9th day of February, 2005.

Respectfully submitted,

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

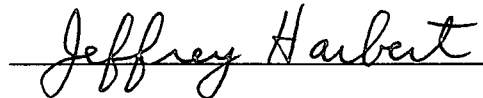


Cindy L. Caditz  
Attorneys for Opposer

### **CERTIFICATE OF MAILING**

I hereby certify that this NOTICE OF OPPOSITION to U.S. Trademark Application Serial No. 76/583,243 for the mark THE UGLY STICK 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: February 9, 2005



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