

STROOCK

TTAB

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Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Re: Client/Matter No. : 385284.0900
Applicant : Valerie Rickel
Serial No. : 78/403,780
Filed : April 19, 2004
MARK : MANDALA

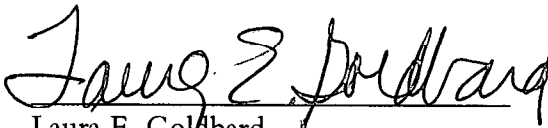
Sir:

Kindly file the annexed papers indicated below, charging the fee (including any deficiency in the fee as estimated below) to the undersigned attorney's Deposit Account No. 19-4709:

(X) Notice of Opposition (in duplicate) on behalf
of Majestic Drug Co., Inc.

Respectfully submitted,

STROOCK & STROOCK & LAVAN LLP

By: 

Laura E. Goldbard
Attorney for Opposer

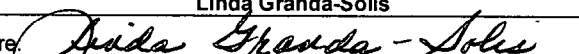
Estimated Fee \$300.00
Dated : July 19, 2005

Certificate of Mailing by "Express Mail" (37 C.F.R. 1.10)

Number: EV 611869757 US
Date of Deposit: July 19, 2005

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service on the date indicated above and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451.

Name: Linda Granda-Solis

Signature: 



07-19-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

SSL-DOCS1 1593672v1

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

In the Matter of Application:

Mark: MANDALA
Applicant: Valerie Rickel
Serial No.: 78-403,780
Published: April 19, 2004

-----X
MAJESTIC DRUG CO., INC., :
 :
Opposer, :
 :
vs. : Opposition No. _____
 :
VALERIE RICKEL, :
 :
Applicant. :
-----X

07/22/2005 SWILSON1 00000035 194709 78403780
01 FC:6402 300.00 DA

NOTICE OF OPPOSITION

Opposer, Majestic Drug Co., Inc. ("Majestic"), a New York corporation, located and doing business at 4996 Main Street (Route 42), South Fallsburg, New York 12779, believes that it will be damaged by the registration of the above-referenced trademark and hereby opposes the application for registration. Its grounds for the opposition are as follows:

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Name: Linda Granda-Solis

Signature: 

1. For more than 40 years, Majestic has used the marks MANDELAY and/or MANDELAYS in the field of sexual enhancements (collectively referred to as the "MANDELAY Mark"). The mark has been used on a nationwide basis in major drug chains. Majestic is the owner of two registrations with the United States Patent and Trademark Office, one for the mark MANDELAY for climax control gel, U.S. Trademark Registration No. 2,113,358, and one for the mark MANDELAYS for a medicated prophylactic device, U.S. Trademark Registration No. 787,631 (goods covered by both registrations are collectively referred to as "MANDELAY Products"). Copies of these registrations are annexed as Exhibit 1.

2. The MANDELAY Mark is distinctive and, by reason of extensive sales, distribution, advertising and marketing throughout the United States on or in connection with the MANDELAY Products, the MANDELAY Mark has acquired substantial goodwill, secondary meaning and fame. By virtue of the distinctiveness, goodwill and fame that Majestic has established in the MANDELAY Mark, the public understands and believes that products bearing the MANDELAY Mark originate exclusively from Majestic.

3. By reason of extensive sales, distribution, advertising and marketing throughout the United States, the MANDELAY Mark has become famous among American consumers. By virtue of Majestic's extensive and continuous use of the MANDELAY Mark in interstate commerce, the mark has become and continues to be famous and distinctive.

4. Applicant, Valerie Rickel, an individual, whose address is P.O. Box 64460, Los Angeles, California 90064, seeks to register MANDALA for an extensive list of goods in Class 3

including, but not limited to, sexual enhancement aids, namely, balms, gels and lotions (collectively referred to as “sexual enhancement aids”).

5. The mark that Applicant seeks to register is similar in appearance and pronunciation to Majestic’s registered marks. Applicant has merely removed the “Y” and changed the “E” and “A”, resulting in a mark which is confusingly similar in pronunciation, appearance and commercial impression to Majestic’s registered MANDELAY Mark.

6. Applicant’s goods are sexual enhancement aids which are closely related to the MANDELAY Products. Upon information and belief, the respective goods of Opposer and Applicant may be sold in the same stores and, possibly, side-by-side on the same shelves. Accordingly, the respective goods of Opposer and Applicant are related and because such related goods are sold under confusingly similar trademarks, a likelihood of confusion exists.

COUNT I
LIKELIHOOD OF CONFUSION

7. Majestic repeats and re-alleges the allegations in paragraphs 1-6 as if fully set forth herein.

8. In view of the facts set forth above, Applicant's use and registration of the mark MANDALA for sexual enhancement aids is likely to create confusion, mistake and deceive the trade and public into believing that Applicant's goods originate with or are otherwise licensed, sponsored or authorized by Majestic.

9. The use and registration of the mark MANDALA for sexual enhancement aids by Applicant is likely to damage and destroy the distinctiveness, goodwill, reputation and secondary meaning created and established by Majestic in its MANDELAY Mark as used on the MANDELAY Products, by virtue of the confusion, mistake and deception likely to occur between the respective marks in derogation of Majestic's exclusive right to continue to use its registered mark for its present goods.

10. By reason of all the foregoing, Majestic will be gravely damaged by Applicant's registration of the mark MANDALA for sexual enhancement aids.

COUNT II
DILUTION

11. Majestic repeats and re-alleges the allegations contained in paragraphs 1-6 and 8-10 as if fully set forth therein.

12. Majestic's MANDELAY Mark is famous and the use and registration of Applicant's mark MANDALA for sexual enhancement aids is likely to dilute the distinctive quality of Majestic's famous mark pursuant to 15 U.S.C. § 1125(c), which is applicable in an opposition proceeding.

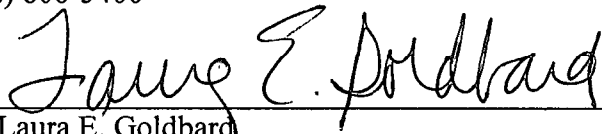
13. By reason of all the foregoing, Majestic will be greatly damaged by Applicant's registration of the MANDALA mark for sexual enhancement aids.

WHEREFORE, by reason of the confusing similarity of Applicant's and Majestic's marks and the likelihood that Applicant's mark for sexual enhancement aids, namely, balms, gels

and lotions, will dilute Majestic's mark, Majestic respectfully requests that the opposition be sustained and that registration of Applicant's MANDALA mark be refused.

Respectfully submitted,

STROOCK & STROOCK & LAVAN LLP
Attorneys for Majestic Drug Co., Inc.
180 Maiden Lane
New York, New York 10038-4982
(212) 806-5400

BY 
Laura E. Goldbard

Dated: New York, New York
July 1, 2005



PRINCIPAL REGISTER
Trademark

Ser. No. 198,463, filed July 24, 1964

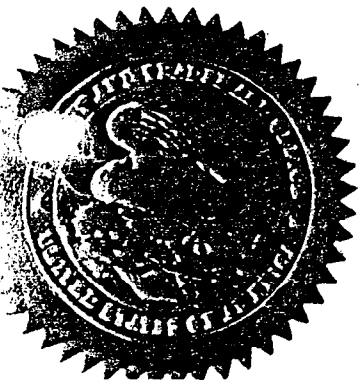
MANDELAYS

Delancey Chemical Co. Inc. (New York corporation)
797 E. 135th St.
Bronx, N.Y.

For: MEDICATED PROPHYLACTIC DEVICE, in
CLASS 44.
First use July 6, 1964; in commerce July 6, 1964.

REGISTERED FOR A TERM OF 20 YEARS FROM Mar. 30, 1965

COMB. AEE. SEC 8 & 15



CERTIFIED TO BE A TRUE COPY OF THE REGISTRATION
WHICH IS IN FULL FORCE AND EFFECT, WITH NOTATION
OF ALL STATUTORY ACTIONS TAKEN THEREON, AS DIS-
CLOSED BY THE RECORDS OF THE UNITED STATES PATENT
AND TRADEMARK OFFICE. SAID RECORDS SHOW TITLE
TO BE IN: Majestic Drug Co., Inc., a
N. Y. corp.

Attest:

SEP 2 1977

S. P. Delancey
Attesting Officer

Lucille I. Parker

Int. Cl.: 5

Prior U.S. Cls.: 6, 18, 44, 46, 51 and 52

Reg. No. 2,113,358

United States Patent and Trademark Office

Registered Nov. 18, 1997

**TRADEMARK
PRINCIPAL REGISTER**

MANDELAY

MAJESTIC DRUG CO., INC. (NEW YORK COR-
PORATION)
711-717 134TH STREET
BRONX, NY 10454

FOR: CLIMAX CONTROL GEL, IN CLASS 5
(U.S. CLS. 6, 18, 44, 46, 51 AND 52).

FIRST USE 12-7-1984; IN COMMERCE
12-7-1984.

OWNER OF U.S. REG. NO. 787,631.

SER. NO. 75-001,284, FILED 10-3-1995.

JOHN MICHOS, EXAMINING ATTORNEY