

TTAB



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September 16, 2005

OUR FILE NO. 341176-900703

Via Express Mail

Trademark Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**Re: frog design, Inc. v. Nikki D. May**  
**Attorney Ref. No.: 341176-900703**

Dear Sirs:

Enclosed for filing is a Notice of Opposition in regard to the matter of *frog design, Inc. v. Nikki D. May*.

Please date stamp and return the enclosed postcard indicating receipt of this document.

Very truly yours,

**DLA Piper Rudnick Gray Cary US LLP**

Allyn Taylor  
Attorney  
allyn.taylor@dlapiper.com

Admitted to practice in Washington DC and California

PA10426841.1  
341176-900703

09-16-2005

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

In Re Application Serial No. 78/471450  
Filed on August 21, 2004  
Published in the Official Gazette September 13, 2005

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

<b>frog design, Inc.</b>	)	Opposition No.
	)	
Opposer,	)	
	)	
v.	)	
	)	
<b>Nikki D. May</b>	)	
	)	
Applicant.	)	
	)	
	)	
	)	

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Commissioner of Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

**frog design, Inc.** ("Opposer"), a California corporation having its principal business address at 3460 Hillview Avenue, Palo Alto, California 94304, believes that it will be damaged by the registration of the mark shown in Serial No. 78/471450 and hereby opposes same.

As grounds for the opposition, Opposer alleges as follows:

1. Opposer is a widely recognized leader in the product design field. It has long developed and marketed design concepts of all types to various companies engaged in selling products and services.

2. Opposer owns and uses, both in interstate and foreign commerce, the mark FROG DESIGN and /or FROG in connection with its consulting and design services. Opposer, or its predecessor in interest, has conducted its business under the company name and mark FROG DESIGN since the mid 1980's, a date well before Applicant filed the subject application.

3. Opposer owns valid, subsisting, uncancelled and unrevoked federal trademark registrations that are comprised of, or include, the word FROG for its products and services.

These registrations include the following:

(a) FROGDESIGN (Stylized), Registration No. 1312760 for "engineering and design services" in International Class 42 registered on January 1, 1985 and renewed December 27, 2004;

(b) FROG, Registration No. 2554673 for "computer software design for others, namely, design of computer software stored on digital media; design services, namely, industrial design services; digital media design, namely, website design and analysis for others; graphic art design; and design for others in the field of engineering" in International Class 42, registered on April 2, 2002, and

(c) FROG (Stylized), Registration No. 2781008 for "business consultation, namely, corporate identity and branding strategies consultation; online directory services, namely, providing indexes and website links to other content providers featuring editorials and articles in the fields of marketing and electronic commerce" in International Class 35, registered on November 11, 2003.

True and correct copies of these registrations owned by Opposer from the TARR database are attached hereto as Exhibit A.

4. By way of the opposed intent-to-use application, Nikki D. May ("Applicant") seeks to register the confusingly similar designation BLUE FROG DESIGNS, Application Serial No. 78/471450, in International Class 42 covering "graphic design and illustration services for others, design of homepages and web-sites". The opposed application was filed August 21, 2004, well after Opposer obtained United States trademark registrations for FROG DESIGN (Stylized), FROG and FROG (Stylized)

5. Applicant's services for which it claims the right to use the BLUE FROG DESIGN mark include services which are likely to be offered through the same or overlapping markets and trade channels and to the same or overlapping customers to whom Opposer markets, promotes and sells its consulting and design services.

6. Applicant's BLUE FROG DESIGN mark is confusingly similar in sight, sound and meaning and overall commercial impression to Opposer's federally registered FROG DESIGN (Stylized), FROG and FROG (Stylized) marks in that each contain the distinctive term FROG. This similarity is likely to lead to confusion with Opposer and its services.

7. Applicant's registration of BLUE FROG DESIGN is likely to cause confusion, mistake and deception in the marketplace and damage Opposer. Therefore, Applicant is not entitled to a registration under the Lanham Act, 15. U.S.C. §1052(d).

WHEREFORE, for each of the above separate and independent reasons, Opposer prays that Application Serial No. 78/461450 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Opposer.

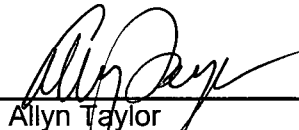
The Assistant Commissioner is hereby authorized to charge the \$300.00, and any other required fees for this Opposition to Deposit Account 07-1907.

Please recognize as attorneys for Opposer, Allyn Taylor, member of the Bar of the State of California, and the law firm of DLA Piper Rudnick Gray Cary Ware US LLP, 2000 University Avenue, East Palo Alto, CA 94303-2248. All communications regarding this petition should be addressed to said attorney at the foregoing address.

Dated:

DLA PIPER RUDNICK GRAY CARY US LLP

By: \_\_\_\_\_



Allyn Taylor

**DLA PIPER RUDNICK GRAY CARY US LLP**  
2000 University Avenue  
East Palo Alto, CA 94303-2248  
Telephone: (650) 833-2170  
Attorneys for Opposer

CERTIFICATE OF EXPRESS MAILING

I, Tricia Dresel, do hereby certify that the foregoing document(s) is/are being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451, on this date of 9/16/05.

Tricia Dresel

Express Mail No.: 561137831

Date of Deposit: 9/16/05

# EXHIBIT A

EXHIBIT A, page 1

**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2005-09-15 14:15:53 ET**

**Serial Number: 73458033 Assignment Information**

**Registration Number: 1312760 Assignment Information**

**Mark**

**frogdesign**

**(words only): FROGDESIGN**

**Standard Character claim: No**

**Current Status: This registration has been renewed.**

**Date of Status: 2005-01-19**

**Filing Date: 1983-12-21**

**Transformed into a National Application: No**

**Registration Date: 1985-01-01**

**Register: Principal**

**Law Office Assigned: (NOT AVAILABLE)**

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location: 834 -Post Registration**

**Date In Location: 2005-02-04**

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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**1. FROG DESIGN, INC.**

**Address:**  
FROG DESIGN, INC.  
3460 Hillview Avenue

Palo Alto, CA 94304

United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** California

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### GOODS AND/OR SERVICES

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**International Class:** 042

Engineering and Design Services

**First Use Date:** 1982-05-01

**First Use in Commerce Date:** 1982-05-01

**Basis:** 1(a), 44(e)

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### ADDITIONAL INFORMATION

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**Foreign Registration Number:** 1,046,212

**Foreign Registration Date:** 1983-03-16

**Country:** Fed Rep Germany

**Foreign Expiration Date:** 1992-08-13

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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2005-08-31 - TEAS Change Of Owner Address Received

2004-12-27 - Combined Section 8 (10-year)/Section 9 filed

2005-01-19 - First renewal 10 year

2005-01-19 - Section 8 (10-year) accepted/ Section 9 granted

2004-12-27 - Combined Section 8 (10-year)/Section 9 filed

2005-01-04 - PAPER RECEIVED

2004-12-27 - TEAS Section 8 & 9 Received

1991-01-23 - Section 8 (6-year) accepted & Section 15 acknowledged

1990-09-04 - Response received for Post Registration action

1990-09-04 - Section 8 (6-year) and Section 15 Filed

1990-08-29 - Post Registration action mailed Section 8 & 15



1990-04-25 - Section 8 (6-year) and Section 15 Filed  
1985-01-01 - Registered - Principal Register  
1984-10-23 - Published for opposition  
1984-08-27 - Notice of publication  
1984-07-09 - Approved for Pub - Principal Register (Initial exam)  
1984-06-18 - Communication received from applicant  
1984-05-10 - Non-final action mailed

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**CORRESPONDENCE INFORMATION**

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**Correspondent**

ALLYN TAYOR, (Attorney of record)

Allyn Taylor  
DLA Piper Rudnick Gray Cary US LLP  
2000 University Avenue  
East Palo Alto CA 94303-2248

**Phone Number:** 650-833-2170

**Fax Number:** 650-833-2001

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**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2005-09-15 14:17:28 ET**

**Serial Number:** 75812729 Assignment Information

**Registration Number:** 2554673 Assignment Information

**Mark (words only):** FROG

**Standard Character claim:** No

**Current Status:** Registered.

**Date of Status:** 2002-04-02

**Filing Date:** 1999-10-01

**Transformed into a National Application:** No

**Registration Date:** 2002-04-02

**Register:** Principal

**Law Office Assigned:** LAW OFFICE 102

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location:** 900 -File Repository (Franconia)

**Date In Location:** 2002-04-12

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

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1. FROG DESIGN, INC.

**Address:**

FROG DESIGN, INC.  
3460 Hillview Avenue  
Palo Alto, CA 94304  
United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** California

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**GOODS AND/OR SERVICES**

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**International Class:** 042

Computer software design for others, namely, design of computer software stored on digital media;

design services, namely, industrial design services; digital media design, namely, website design and analysis for others; graphic art design; and design for others in the field of engineering

**First Use Date:** 1984-06-22

**First Use in Commerce Date:** 1984-06-22

**Basis:** 1(a)

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**ADDITIONAL INFORMATION**

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(NOT AVAILABLE)

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**MADRID PROTOCOL INFORMATION**

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(NOT AVAILABLE)

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**PROSECUTION HISTORY**

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2005-08-31 - TEAS Change Of Owner Address Received  
2005-02-18 - TEAS Change of Correspondence Received  
2004-07-05 - TEAS Change of Correspondence Received  
2002-04-02 - Registered - Principal Register  
2002-01-08 - Published for opposition  
2001-12-19 - Notice of publication  
2001-09-06 - Approved for Pub - Principal Register (Initial exam)  
2001-07-31 - Communication received from applicant  
2001-02-02 - Final refusal mailed  
2000-08-01 - Communication received from applicant  
2000-02-08 - Non-final action mailed  
2000-01-19 - Case file assigned to examining attorney  
2000-01-13 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

---

**Correspondent**

Eliane Setton (Attorney of record)

Allyn Taylor  
DLA Piper Rudnick Gray Cary US LLP  
2000 University Avenue  
East Palo Alto CA 94303-2248

**Phone Number:** 650-833-2170

**Fax Number:** 650-833-2001

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**Thank you for your request. Here are the latest results from the TARR web server.**

**This page was generated by the TARR system on 2005-09-15 14:17:47 ET**

**Serial Number: 75908778 Assignment Information**

**Registration Number: 2781008 Assignment Information**

**Mark**

**frog**

**(words only): FROG**

**Standard Character claim: No**

**Current Status: Registered.**

**Date of Status: 2003-11-11**

**Filing Date: 2000-02-02**

**Transformed into a National Application: No**

**Registration Date: 2003-11-11**

**Register: Principal**

**Law Office Assigned: LAW OFFICE 116**

**If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov**

**Current Location: 900 -File Repository (Franconia)**

**Date In Location: 2003-11-17**

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**LAST APPLICANT(S)/OWNER(S) OF RECORD**

---

**1. FROG DESIGN, INC.**

**Address:**  
FROG DESIGN, INC.  
3460 Hillview Avenue

Palo Alto, CA 94304

United States

**Legal Entity Type:** Corporation

**State or Country of Incorporation:** California

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### GOODS AND/OR SERVICES

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**International Class:** 035

BUSINESS CONSULTATION, NAMELY, CORPORATE IDENTITY AND BRANDING STRATEGIES CONSULTATION; ONLINE DIRECTORY SERVICES, NAMELY, PROVIDING INDEXES AND WEBSITE LINKS TO OTHER CONTENT PROVIDERS FEATURING EDITORIALS AND ARTICLES IN THE FIELDS OF MARKETING AND ELECTRONIC COMMERCE

**First Use Date:** 1984-06-22

**First Use in Commerce Date:** 1984-06-22

**Basis:** 1(a)

**International Class:** 042

COMPUTER SOFTWARE DESIGN FOR OTHERS, NAMELY, DESIGN OF COMPUTER SOFTWARE STORED ON DIGITAL MEDIA; INDUSTRIAL DESIGN; GRAPHIC ART DESIGN; AND DESIGN FOR OTHERS IN THE FIELD OF ENGINEERING; COMPUTER SERVICES, NAMELY, DESIGNING AND IMPLEMENTING WEB SITES FOR OTHERS; COMPUTER SOFTWARE DESIGN FOR OTHERS FOR USE IN E-COMMERCE BUSINESS APPLICATIONS; COMPUTER SERVICES, NAMELY, PROVIDING CUSTOMIZED ONLINE WEB PAGES FEATURING USER-DEFINED INFORMATION, WHICH INCLUDE SEARCH ENGINES AND ONLINE WEB LINKS TO NEWS, WEATHER, SPORTS, CURRENT EVENTS AND REFERENCE MATERIALS, ALL IN A WIDE RANGE OF USER DEFINED FIELDS

**First Use Date:** 1984-06-22

**First Use in Commerce Date:** 1984-06-22

**Basis:** 1(a)

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### ADDITIONAL INFORMATION

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**Description of Mark:** The mark consists of a stylized version of the word "FROG" where the letter "F" is green, the letter "R" is red, the letter "O" is gold and the letter "G" is light blue.

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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2005-08-31 - TEAS Change Of Owner Address Received

2005-02-18 - TEAS Change of Correspondence Received

2004-07-05 - TEAS Change of Correspondence Received  
2003-11-11 - Registered - Principal Register  
2003-07-21 - Extension Of Time To Oppose Received  
2002-07-23 - Extension Of Time To Oppose Received  
2002-06-18 - Published for opposition  
2002-05-29 - Notice of publication  
2002-02-06 - Approved for Pub - Principal Register (Initial exam)  
2001-10-22 - Communication received from applicant  
2001-06-18 - Final refusal mailed  
2001-02-01 - Communication received from applicant  
2000-08-01 - Non-final action mailed  
2000-07-28 - Case file assigned to examining attorney  
2000-07-05 - Case file assigned to examining attorney  
2000-06-28 - Case file assigned to examining attorney

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**CORRESPONDENCE INFORMATION**

---

**Correspondent**

Eliane Setton (Attorney of record)

Allyn Taylor  
DLA Piper Rudnick Gray Cary US LLP  
2000 University Avenue  
East Palo Alto CA 94303-2248

**Phone Number:** 650-833-2170

**Fax Number:** 650-833-2001

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