

ESTTA Tracking number: **ESTTA50267**

Filing date: **10/25/2005**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|--|---|
| Name | Spencer Gifts LLC |
| Granted to Date of previous extension | 11/09/2005 |
| Address | 6826 Black Horse Pike Egg Harbor Township, NJ 08234 UNITED STATES |

| | |
|-----------------------------|--|
| Attorney information | Roberta Jacobs-Meadway, Esq. Ballard Spahr Andrews & Ingersoll, L.L.P. 1735 Market Street, 51st Floor Philadelphia, PA 19103 UNITED STATES jacobsmeadwayr@ballardspahr.com Phone:215-864-8201 |
|-----------------------------|--|

Applicant Information

| | | | |
|-------------------------------|---|-------------------------------|------------|
| Application No | 78472424 | Publication date | 07/12/2005 |
| Opposition Filing Date | 10/25/2005 | Opposition Period Ends | 11/09/2005 |
| Applicant | Brown, Don PO Box 22459 Knoxville, TN 379330459 | | |

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|---------------|
| UNITED STATES |
|---------------|

Goods/Services Affected by Opposition

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|---|
| Class 035. First Use: 20040731 First Use In Commerce: 20040731 All goods and services in the class are opposed, namely: Online retail store services featuring novelty items such as bumper stickers and shirts bearing political and other novelty commentary |
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|--------------------|--|
| Attachments | NOO - Spencer v Don Brown.pdf (12 pages) |
|--------------------|--|

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|------------------|--------------------------|
| Signature | /Roberta Jacobs-Meadway/ |
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|-------------|------------------------------|
| Name | Roberta Jacobs-Meadway, Esq. |
|-------------|------------------------------|

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|-------------|------------|
| Date | 10/25/2005 |
|-------------|------------|

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED ELECTRONICALLY TO THE COMMISSIONER FOR TRADEMARKS P.O. BOX 1451, ALEXANDRIA, VA 22313-1451, ON THE DATE INDICATED BELOW

By: Vallie K. Moenan
DATE: 10/25/05

BOX TTAB – FEE

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

| | |
|-------------------|------------------|
| SPENCER GIFTS LLC | : |
| | : |
| Opposer, | : |
| | : |
| v. | : |
| | : Opposition No. |
| | : |
| DON BROWN | : |
| | : |
| Applicant. | : |

NOTICE OF OPPOSITION

Honorable Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Dear Sir/Madam:

In the matter of Trademark Application Serial No. 78/472,424 for the mark SPENCIEBOY, filed August 24, 2004 and published for opposition in the Official Gazette on July 12, 2005:

Spencer Gifts, LLC, a Delaware limited liability company having a place of business at 6826 Black Horse Pike, Egg Harbor Township, NJ 08234-4197 (Spencer), believes that it will be damaged by the registration of the mark shown in the above-identified application and hereby opposes the same. The grounds for opposition are as follows:

1. Don Brown (Applicant), seeks to register SPENCIEBOY as a mark for use in connection with retail store services featuring novelty items such as bumper stickers and shirts

bearing political and other novelty commentary, as evidenced by the publication of said mark in the Official Gazette on July 12, 2005.

2. The application herein opposed was filed August 24, 2004 with a claim of use in commerce since July 31, 2004.

3. Spencer is and has been engaged in the sale through its retail stores of a wide range of novelty items, including bumper stickers and shirts bearing political and other “novelty” commentary. Spencer has built a successful business in connection with such sales.

4. Spencer has since at least as early as 1950 used the mark SPENCER GIFTS for retail gift store services. Spencer has since at least as early as October 16, 1964 used such mark in commerce for such services.

5. Use of the SPENCER GIFTS mark by Spencer for retail gift store services has been continuous and commercially significant for more than fifty (50) years.

6. Spencer has taken steps to protect the SPENCER GIFTS mark and has secured U.S. Trademark Registration No. 0857651, *inter alia* for such mark for such services. Registration No. 0857651 is valid and subsisting, incontestable and renewed. A copy of the pertinent information about such registration from the PTO database is attached as Exhibit A.

7. Spencer has used Spencer Gifts and Spencer’s as trade names in connection with its retail gift store services.

8. Spencer’s use of Spencer Gifts and Spencer’s as trade names for its business long predates Applicant’s claimed date of first use of the mark of the application herein opposed.

9. Spencer has since at least as early as April 1, 2004 used SPENCER’S as a mark for retail novelty and gift store services.

10. Spencer has taken steps to protect the SPENCER'S mark and has secured U.S. Trademark Registration No. 3,002,385 for such mark for such services. Registration No. 3,002,385 is valid and subsisting. A copy of the pertinent information about such registration from the PTO database is attached as Exhibit B.

11. By virtue of Spencer's continuous use in commerce of its registered SPENCER GIFTS and SPENCER'S marks and its names in connection with its services, such services have become favorably known to the relevant trade and public under such marks and names. Both the SPENCER GIFTS and SPENCER'S names have been well known and associated with Spencer in connection with retail sales of novelty and gift items since long prior to July 31, 2004.

12. As Spencer is the owner of U.S. trademark registrations for the SPENCER GIFTS and SPENCER'S marks, priority is not in issue.

13. Applicant's mark is confusingly similar to Spencer's registered marks and its trade names.

14. Applicant's "SPENCIEBOY" mark would be recognized as a play on the SPENCER'S name and mark and would be taken to be a boys' division of the SPENCER GIFTS stores.

15. The services of Applicant are essentially the same as Spencer's services: retail novelty and gift store services.

16. The products sold by Applicant through its retail stores are the same as products sold by Spencer through its retail stores, including bumper stickers and shirts with various types of slogans and designs.

17. The retail store services of Applicant and Spencer are such as appeal to and attract the same and overlapping classes of customers, including young men and boys.

18. Applicant's SPENCIEBOY mark as applied to the retail store services identified in the application herein opposed so resembles Spencer's registered SPENCER GIFTS and SPENCER'S marks for retail store services and its trade names that it is likely to cause confusion, mistake, and/or deception.

19. If Applicant is permitted to register SPENCIEBOY for retail store services as set forth in the application herein opposed, confusion of the relevant trade and public is likely to result, which will damage and injure Spencer.

20. On seeing Applicant's SPENCIEBOY mark used in connection with Applicant's services, purchasers and potential purchasers are likely to believe in error that such services are offered by or in association with or under license from Spencer, that Spencer and Applicant are affiliated, or that Spencer's goods are sold through Applicant's stores, or that Spencer endorses the Applicant's stores and the goods sold from such stores.

21. Any defect, objection to or fault found with Applicant's services or any objection to the goods sold through such stores under the mark SPENCIEBOY would necessarily reflect on and seriously injure the reputation that Spencer has established for its retail novelty and gift store services.

22. If Applicant is granted a registration for the mark herein opposed, it would obtain thereby at least a *prima facie* exclusive right to use the mark. Such registration would be a source of damage and injury to Spencer.

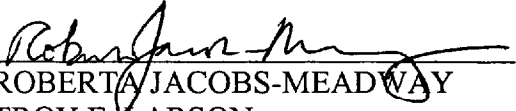
WHEREFORE, Spencer Gifts, LLC prays that registration of the mark of Application Serial No. 78/472,424 be refused and that this opposition be sustained.

A duplicate copy of this Notice of Opposition is enclosed herewith.

The required fee of \$300.00 may be charged to Deposit Account No. 02-0755 and any overpayment may be credited to this account.

Respectfully submitted,

Date: October 25, 2015

By: 
ROBERTA JACOBS-MEADWAY
TROY E. LARSON
Ballard Spahr Andrews & Ingersoll, LLP
1735 Market Street – 51st Floor
Philadelphia, PA 19103-7599
(215) 864-8201
(215) 864-9950 (fax)

ATTORNEYS FOR SPENCER

EXHIBIT A

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

This page was generated by the TARR system on 2005-10-24 16:03:32 ET

Serial Number: 72276293 Assignment Information

Registration Number: 857651 Assignment Information

Mark (words only): SPENCER GIFTS

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1988-11-08

Filing Date: 1967-07-19

Transformed into a National Application: No

Registration Date: 1968-09-24

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: 900 -File Repository (Franconia)

Date In Location: 2001-11-07

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

1. SPENCER GIFTS, INC.

Address:

SPENCER GIFTS, INC.
1050 BLACK HORSE PIKE
PLEASANTVILLE, NJ 08232
United States

Legal Entity Type: Corporation

State or Country of Incorporation: Delaware

GOODS AND/OR SERVICES

U.S. Class: 101 (International Class 035)

RETAIL GIFT SHOP SERVICES

First Use Date: 1950-00-00

First Use in Commerce Date: 1964-10-16

Basis: 1(a)

ADDITIONAL INFORMATION

Disclaimer: THE WORD "GIFTS" IS DISCLAIMED APART FROM THE MARK AS SHOWN.

Prior Registration Number(s):
832689

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

1988-09-24 - First renewal

1988-07-22 - Section 9 filed/check record for Section 8

CORRESPONDENCE INFORMATION

Correspondent
RONALD L. PANITCH
PANITCH SCHWARZE JACOBS & NADEL
36TH FLOOR, FIVE PENN CENTER PLAZA
1601 MARKET STREET
PHILADELPHIA, PA. 19103

EXHIBIT B

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

This page was generated by the TARR system on 2005-10-24 16:04:01 ET

Serial Number: 76564494

Registration Number: 3002385

Mark

SPENCER'S

(words only): SPENCER'S

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2005-09-27

Filing Date: 2003-12-10

Transformed into a National Application: No

Registration Date: 2005-09-27

Register: Principal

Law Office Assigned: LAW OFFICE 106

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: 650 -Publication And Issue Section

Date In Location: 2005-08-19

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

1. Spencer Gifts LLC

Address:

Spencer Gifts LLC
6826 Black Horse Pike
Egg Harbor Township, NJ 082344197
United States

Legal Entity Type: Ltd Liab Co

State or Country Where Organized: Delaware

GOODS AND/OR SERVICES

International Class: 035
retail novelty and gift store services
First Use Date: 2004-04-01
First Use in Commerce Date: 2004-04-01

Basis: 1(a)

ADDITIONAL INFORMATION

Section 2(f)

Prior Registration Number(s):

832689
857651
2138736
2178191

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2005-09-27 - Registered - Principal Register
2005-08-17 - Law Office Registration Review Completed
2005-08-05 - Assigned To LIE
2005-08-04 - Allowed for Registration - Principal Register (SOU accepted)
2005-08-03 - Statement of use processing complete
2005-07-13 - Amendment to Use filed
2005-07-13 - TEAS Statement of Use Received
2005-04-19 - Notice of allowance - mailed
2005-01-25 - Published for opposition
2005-01-05 - Notice of publication
2004-11-29 - Law Office Publication Review Completed
2004-11-08 - Assigned To LIE
2004-10-27 - Approved for Pub - Principal Register (Initial exam)
2004-10-27 - Case file assigned to examining attorney

2004-10-27 - Amendment From Applicant Entered
2004-10-12 - Communication received from applicant
2004-10-12 - PAPER RECEIVED
2004-07-01 - Non-final action mailed
2004-06-24 - Case file assigned to examining attorney
2004-01-26 - Applicant amendment prior to exam entered
2004-01-26 - Communication received from applicant
2004-01-26 - PAPER RECEIVED
2003-12-26 - New Application Entered In Tram

CORRESPONDENCE INFORMATION

Correspondent

ROBERTA JACOBS-MEADWAY (Attorney of record)

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