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

Mark: BABY SHAKESPEARE

Attorney Docket No.: SHAK62558

Application Serial No: 76/452,603

International Class: 28

Filed: September 25, 2002

Applicant: The Baby Einstein Company, LLC

Published for Opposition: December 23, 2003

Official Gazette: Page TM 431

Goods: rubber balls; action skill games; bean bag dolls; plush toys; balloons; bath toys; Christmas tree ornaments; board games; building blocks; equipment sold as a unit for playing card games; playing cards; dolls and dolls clothing; doll playsets; crib toys; electric action toys; manipulative games; jigsaw puzzles; kites; mobiles; music box toys; party favors in the nature of small toys; inflatable pool toys; multiple activity toys; wind-up toys; target games; toy vehicles; toy cars; toy trucks; toy bucket and shovel sets; roller skates; toy model kits; musical toys; bubble making wands and solution sets; toy figurines; toy banks; puppets; skateboards; scooters; face masks; hand-held unit for playing electronic games

SHAKESPEARE COMPANY, LLC, a  
Delaware limited liability company,

Opposer,

v.

THE BABY EINSTEIN COMPANY, LLC, a  
Colorado limited liability company,

Applicant.

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

NOTICE OF OPPOSITION

NOTICE OF OPPOSITION

Seattle, Washington 98101

April 22, 2004

TO THE COMMISSIONER FOR TRADEMARKS

TRADEMARK TRIAL AND APPEAL BOARD

Shakespeare Company, LLC, a limited liability company, organized and existing under the

1 laws of the State of Delaware, and having a place of business at 3801 Westmore Drive, Columbia,  
2 South Carolina 29223 (hereinafter "Opposer"), believes that it will be damaged by registration of the  
3 mark **BABY SHAKESPEARE** for all of the goods claimed by U.S. Application Serial  
4 No. 76/452,603, filed September 25, 2002, and hereby opposes the same.

5 As grounds for the Opposition, Opposer alleges as follows:

6 1. On information and belief, The Baby Einstein Company, LLC is a limited liability  
7 company organized and existing under the laws of the State of Colorado, and having a place of  
8 business at 500 South Buena Vista Street, Burbank, California 91521 (hereinafter "Applicant").

9 2. Continuously, since long prior to any date upon which Applicant can rely, Opposer  
10 has used the trademark **SHAKESPEARE** in association with the sale of fishing poles, fishing line,  
11 fishing reels, fishing tackle, camping products, clothing, sunglasses, and a wide variety of  
12 recreational and sporting equipment.

13 3. Opposer is the owner of U.S. Registration No. 359,879 for the mark **SHAKESPEARE**  
14 for fishing reels, fishing lines, fishing rods, and artificial fishing baits and lures in International  
15 Class 28. Said registration issued August 30, 1938, and is currently valid, subsisting, and  
16 incontestable.

17 4. Opposer is the owner of U.S. Registration No. 2,183,050 for the mark  
18 **SHAKESPEARE** for camping furniture, namely, picnic tables, folding chairs, canvas chairs, and  
19 sleeping pads, and stadium seats in International Class 20. Said registration issued August 18, 1998,  
20 and is currently valid and subsisting.

21 5. Opposer is the owner of U.S. Registration No. 2,211,805 for the mark  
22 **SHAKESPEARE** for portable food and beverage coolers in International Class 21. Said registration  
23 issued December 15, 1998, and is currently valid and subsisting.

24 6. Opposer is the owner of U.S. Registration No. 2,213,444 for the mark  
25

1 SHAKESPEARE for backpacks in International Class 18. Said registration issued December 22,  
2 1998, and is currently valid and subsisting.

3 7. Opposer is the owner of U.S. Registration No. 2,241,287 for the mark  
4 SHAKESPEARE for camping gloves and fishing tackle boxes in International Class 28. Said  
5 registration issued April 20, 1999, and is currently valid and subsisting.

6 8. Opposer is the owner of U.S. Registration No. 2,241,288 for the mark  
7 SHAKESPEARE for sunglasses and sunglass cases in International Class 9. Said registration issued  
8 April 20, 1999, and is currently valid and subsisting.

9 9. Opposer is the owner of U.S. Registration No. 2,241,290 for the mark  
10 SHAKESPEARE for duffel bags, fanny packs, mesh toiletry bags sold empty, all purpose sport and  
11 camping bags, bags for carrying bottles, and shoulder straps for the same in International Class 18.  
12 Said registration issued April 20, 1999, and is currently valid and subsisting.

13 10. Opposer is the owner of U.S. Registration No. 2,242,083 for the mark  
14 SHAKESPEARE for stools in International Class 20. Said registration issued April 27, 1999, and is  
15 currently valid and subsisting.  
16

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2 1998, and is currently valid and subsisting.

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4 SHAKESPEARE for camping gloves and fishing tackle boxes in International Class 28. Said  
5 registration issued April 20, 1999, and is currently valid and subsisting.

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11 camping bags, bags for carrying bottles, and shoulder straps for the same in International Class 18.  
12 Said registration issued April 20, 1999, and is currently valid and subsisting.

13 10. Opposer is the owner of U.S. Registration No. 2,242,083 for the mark  
14 SHAKESPEARE for stools in International Class 20. Said registration issued April 27, 1999, and is  
15 currently valid and subsisting.

16 11. Opposer is the owner of U.S. Registration No. 2,281,649 for the mark  
17 SHAKESPEARE for cots in International Class 20. Said registration issued September 28, 1999,  
18 and is currently valid and subsisting.

19 12. Opposer is the owner of U.S. Registration No. 2,473,865 for the mark  
20 SHAKESPEARE for tents in International Class 22. Said registration issued July 31, 2001, and is  
21 currently valid and subsisting.

22 13. Opposer is the owner of U.S. Registration No. 2,490,605 for the mark  
23 SHAKESPEARE for fishing accessories, namely, floats, sinkers, swivels and hand held nets in  
24 International Class 28. Said registration issued September 18, 2001, and is currently valid and  
25

1 subsisting.

2 14. Opposer will be damaged by the registration sought by Applicant insofar as the  
3 registration will be *prima facie* evidence of the validity of the registration, Applicant's ownership of  
4 the mark EABY SHAKESPEARE, and Applicant's exclusive right to use the mark BABY  
5 SHAKESPEARE in association with all of the goods claimed by Application Serial No. 76/452,603  
6 when, in fact, Applicant is not entitled to such rights by virtue of Opposer's prior and continuous use  
7 of the mark SHAKESPEARE in association with the sale of fishing poles, fishing line, fishing reels,  
8 fishing tackle, camping products, clothing, sunglasses, and a wide variety of recreational equipment  
9 in the same channels of trade in which the goods claimed by Application Serial No. 76/452,603  
10 would be sold.

11 15. Opposer and Applicant entered a Co-Existence Agreement effective April 21, 2003.  
12 The terms of that Co-Existence Agreement prohibit Applicant's use or registration of any mark  
13 including SHAKESPEARE for "recreational equipment, fishing poles, fishing line, fishing reels,  
14 fishing tackle, camping products, and sporting goods." The terms of that Co-Existence Agreement  
15 also include Opposer's agreement not to challenge use or registration of the mark BABY  
16 SHAKESPEARE for goods designed to "stimulate the learning capabilities of infants and children."  
17 Application Serial No. 76/452,603 includes goods that are not designed to "stimulate the learning  
18 capabilities of infants and children" and some goods that are recreational equipment or sporting  
19 goods. Application Serial No. 76/452,603 claims goods that are outside of the scope of registration  
20 or use permitted by the Co-Existence Agreement entered by the Parties effective April 21, 2003.

21 16. The mark BABY SHAKESPEARE shown by Application Serial No. 76/452,603,  
22 when used in association with some of the goods claimed by said application, so resembles  
23 Opposer's mark SHAKESPEARE as to be likely to cause confusion, or to cause mistake, or to  
24 deceive within the meaning of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).  
25

1           17. As a result of Opposer's long-term, substantial, and widespread use of the mark  
2 SHAKESPEARE shown by the registrations identified by Paragraph Nos. 3-13 herein, the mark  
3 SHAKESPEARE has become famous and is thus a valuable symbol that serves to identify Opposer  
4 as the source of all goods and services identified by or promoted with the mark.

5           18. The mark SHAKESPEARE previously used by Opposer and shown by the  
6 registrations identified by Paragraph Nos. 3-13 herein became famous prior to any date upon which  
7 Applicant can show use of the mark BABY SHAKESPEARE.

8           19. Applicant's mark BABY SHAKESPEARE shown by Application Serial  
9 No. 76/452,603 includes the entirety of Opposer's famous mark SHAKESPEARE.

10           20. The mark shown by Application Serial No. 76/452,603 when used in association with  
11 some of the goods claimed by Application Serial No. 76/452,603 so resembles Opposer's famous  
12 mark SHAKESPEARE previously used and registered by Opposer and shown by the registrations  
13 identified by Paragraph Nos. 3-13 herein as to be likely to falsely suggest a connection between  
14 Opposer and Applicant in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

15           21. The mark shown by Application Serial No. 76/452,603 so resembles Opposer's  
16 famous mark SHAKESPEARE when used in association with some of the goods claimed by  
17 Application Serial No. 76/452,603 as to cause dilution of the distinctive quality of Opposer's mark  
18 SHAKESPEARE in violation of 15 U.S.C. § 1125(c).

19           22. Based upon the foregoing, registration of the mark BABY SHAKESPEARE shown  
20 by Application Serial No. 76/452,603 for all of the goods claimed by said application, filed  
21 September 25, 2002, is likely to cause injury and damage to Opposer.

22           WHEREFORE, Opposer respectfully requests that the registration of the mark BABY  
23 SHAKESPEARE shown by Application Serial No. 76/452,603 be denied pursuant to Section 2(d) of  
24 the Lanham Act, 15 U.S.C. § 1052(d), Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), and  
25

1 Section 43 of the Lanham Act, 15 U.S.C. § 1125(c), and that this opposition be sustained.

2 Accompanying the duplicate signed copies of this Notice of Opposition is our Check  
3 No. 155055 for the required filing fee in the amount of \$300.00 (\$300.00 per class). Please charge  
4 any excess fees to Deposit Account No. 03-1740 of Opposer's counsel noted below.

5 Please direct all correspondence to Cindy L. Caditz of Christensen O'Connor Johnson  
6 Kindness<sup>PLLC</sup> at the following address:

7 Cindy L. Caditz  
8 Christensen O'Connor Johnson Kindness<sup>PLLC</sup>  
9 1420 Fifth Avenue, Suite 2800  
Seattle, WA 98101-2347

10 Please direct all telephone calls to Cindy L. Caditz at 206-682-8100.

11 DATED this 22nd day of April, 2004.

12 Respectfully submitted,

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

15 *Cindy Caditz*

16 Cindy L. Caditz  
17 Attorneys for Opposer

18 **CERTIFICATE OF MAILING**

19  
20 I hereby certify that this NOTICE OF OPPOSITION to U.S. Trademark Application Serial  
21 No. 76/452,603 for the mark BABY SHAKESPEARE is being deposited with the U.S. Postal  
22 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.

23 Date: April 22, 2004

24 *Jeffrey Harbert*

25 CLC:jh

File No.: SHAK-6-2558

Date: 4/22/04

Atty/Secy: CLC:jh

Serial No.: 76/452,603

Parties: Shakespeare Company, LLC v. The Baby Einstein Company, LLC

Mark: BABY SHAKESPEARE

Int'l Class(es): 28

**The following documents have been received in the U.S. Patent and Trademark Office, ATTN: TTAB, on the date stamped hereon via first-class mail, with a signed Certificate of Mailing:**

Notice of Opposition (6 pages, in duplicate)

Check for \$300 for filing fee #155055

**RECEIVED**

MAY 10 2004

Christensen O'Connor  
Johnson Kindness, PLLC



04-26-2004  
U.S. Patent & TMO/TM Mail Rcpt Dt. #78