

ESTTA Tracking number: **ESTTA95700**

Filing date: **08/22/2006**

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	Perry & Wilson, Inc.		
Entity	Corporation	Citizenship	Maryland
Address	4101 Howard Avenue Kensington, MD 20895 UNITED STATES		

Attorney information	Brian J. Hundertmark Garson Claxton LLC 7910 Woodmont Avenue Suite 650 Bethesda, MD 20814 UNITED STATES lmackell@garsonlaw.com Phone:(301) 280-2700		
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### Applicant Information

Application No	78756796	Publication date	07/25/2006
Opposition Filing Date	08/22/2006	Opposition Period Ends	08/24/2006
Applicant	Marvin J. Perry, Inc. 10563 Metropolitan Avenue Kensington, MD 20895 UNITED STATES		

### Goods/Services Affected by Opposition

Class 035. First Use: 1955/12/31 First Use In Commerce: 1955/12/31 All goods and services in the class are opposed, namely: Procurement, namely, purchasing furniture for others
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Related Proceedings	Perry & Wilson, Inc. v. Marvin J. Perry, et al., United States District Court for the District of Maryland, No. 05-CV-3126(MJG)
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Attachments	Notice of Opposition.pdf ( 5 pages )(198574 bytes )
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Signature	/s/
Name	Brian J. Hundertmark
Date	08/22/2006

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

In the Matter of Trademark Application No. 78,756,796  
For the Mark MARVIN J. PERRY  
Published July 25, 2006

Perry & Wilson, Inc.	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. _____
	)	
Marvin J. Perry, Inc.	)	
	)	
Applicant	)	
_____	)	

**NOTICE OF OPPOSITION**

Opposer, Perry & Wilson, Inc., d/b/a Marvin J. Perry & Associates, a Maryland corporation located at 4101 Howard Avenue, Kensington, Maryland 20895, by and through its undersigned attorneys, hereby opposes the application for registration of the mark MARVIN J. PERRY, Serial Number 78/756,796, filed by Marvin J. Perry, Inc., on or about November 18, 2005. Opposer owns rights to the “Marvin J. Perry & Associates” mark and any variations of that mark, and would be damaged by another party’s registration of “Marvin J. Perry.”

As grounds for opposition, Perry & Wilson alleges the following:

1. Beginning in the 1950s, Marvin J. Perry began selling furniture to the United States government. Mr. Perry’s interaction with the federal government came to involve both sales as a dealer directly to the government and representation of manufacturers who sold to the government in their own names.

2. In 1973, Mr. Perry incorporated Marvin J. Perry, Inc. (Applicant). Shortly thereafter, Mr. Perry hired Malcolm Wilson to work in the business. Mr. Perry continued doing business under a variety of trade names or marks, including “Marvin J. Perry,” “Marvin J. Perry, Inc.,” and “Marvin J. Perry & Associates.” Mr. Perry, however, conducted most of his business as a furniture manufacturer’s representative in the manufacturer’s name, while conducting most of his business as a furniture dealer, which included a furniture showroom, under the “Marvin J. Perry & Associates” mark.

3. In 1993, Mr. Perry closed his furniture showroom and transferred the remainder of his business conducted as Marvin J. Perry & Associates to a new company, Perry & Wilson, Inc. (Opposer), which continued conducting business under the “Marvin J. Perry & Associates” mark. As part of this transaction, Mr. Perry assigned to Opposer the rights to 13 contracts comprising Mr. Perry’s entire furniture dealer business and some of his manufacturer’s representative business. In addition, Mr. Perry transferred to Opposer all of his business’s tangible assets, such as vehicles, office equipment, and showroom samples, and turned over to Opposer responsibility for the business’s lease, utilities, and employees. Mr. Perry initially took a 51% ownership interest in Opposer, and Mr. Wilson a 49% ownership interest, though Mr. Wilson ran the company. Mr. Wilson acquired Mr. Perry’s 51% interest in Opposer in 1995, thereby becoming the sole owner.

4. Following the transaction in 1993, neither Applicant nor Mr. Perry worked on the 13 contracts transferred to Opposer. Mr. Perry had retained at the time of the transaction three manufacturer’s representative contracts, consisting of a contract with the U.S. State Department, which required minimal work to maintain, and two much smaller contracts. All three of these contracts were manufacturer’s representative contracts under the names of the respective

manufacturer, with Mr. Perry as the representative. None of these contracts depended on use of any mark that included the words “Marvin J. Perry.”

5. As the successor-in-interest to, and the transferee of the assets of, Mr. Perry’s business, Opposer continued to service all federal government contracts previously serviced by Mr. Perry and associated with the “Marvin J. Perry & Associates” mark. In the decade following the 1993 transaction, Opposer did in excess of \$50 million in business under the “Marvin J. Perry & Associates” mark, steadily increasing profits over the years. Opposer sold furniture under the “Marvin J. Perry & Associates” mark to every branch of the federal government, particularly the military, as well as to non-governmental entities.

6. In addition to renewing existing contracts associated with the “Marvin J. Perry & Associates” mark, Opposer solicited and won new contracts under this mark. Since 1993, Opposer has spent an average of \$35,000 annually advertising under the “Marvin J. Perry & Associates” mark in industry and trade publications. Likewise, Opposer has spent approximately \$15,000 annually promoting its business under the “Marvin J. Perry & Associates” mark through travel to client sites, and another \$10,000 annually under the “Marvin J. Perry & Associates” mark at trade and industry shows.

7. In 1997, Mr. Perry, who was Applicant’s sole shareholder and officer, acknowledged Opposer’s proper use of the “Marvin J. Perry & Associates” mark by consenting in writing to Opposer registering that mark as a trade name with the Maryland State Department of Assessments and Taxation. Subsequently, with Applicant’s knowledge, Opposer incorporated the “Marvin J. Perry & Associates” mark into a revised logo that Opposer used in marketing materials. In 2004, Opposer registered this trademark with the State of Maryland. In December of 1999, Opposer registered the internet domain name “marvinjperry.com” to create a website for marketing purposes which prominently featured the “Marvin J. Perry & Associates” mark.

8. In addition, in 2005, Opposer, Mr. Perry, and the federal government executed a Novation Agreement that formally recognized the 1993 transfer of Mr. Perry's business assets to "Perry & Wilson trading as Marvin J. Perry & Associates." Also at this time, Opposer and Mr. Perry executed a Restated Agreement that encompassed the terms of the 1993 transaction. Among other things, the Novation Agreement and Restated Agreement confirmed that in 1993, Mr. Perry sold to Opposer the assets sufficient for Opposer to continue Mr. Perry's furniture dealer and non-State Department representative business under the "Marvin J. Perry & Associates" mark.

9. Despite Opposer's purchasing the business associated with the "Marvin J. Perry & Associates" mark in 1993 and significantly building that business under the mark since then, Applicant began using the "Marvin J. Perry & Associates" mark in direct competition with Opposer around 2004, infringing on Opposer's rights to the mark. Because Applicant has refused to cease this infringing activity, Opposer filed suit against Applicant in U.S. District Court on November 18, 2005. The suit seeks, among other things, injunctive relief against Applicant to restrain Applicant from using the "Marvin J. Perry & Associates" mark or any mark using "Marvin J. Perry" in a manner likely to cause confusion or mistake or to deceive. In addition, the suit seeks cancellation of any registration of "Marvin J. Perry" resulting from the instant application.

10. Employees of federal government agencies, who evaluate and procure furniture for their agencies, represent Opposer's primary customer. These representatives of the federal government recognize the "Marvin J. Perry & Associates" mark as indicating the source of services that Opposer provides. These government representatives do not recognize this mark as indicating any other source of services.

11. In view of the similarity of the “Marvin J. Perry & Associates” and “Marvin J. Perry” marks and the related nature of the services of the respective parties, Applicant’s mark so resembles Opposer’s marks as to be likely to cause confusion, to cause mistake, or to deceive.

12. Opposer has expended considerable effort and expense in promoting its marks and the services provided under the marks. As a result, the purchasing public has come to know, rely upon, and recognize Opposer’s services by the marks.

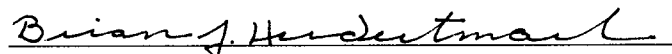
13. Opposer has an exceedingly valuable goodwill established in its marks.

14. If Applicant obtains registration of its mark, and thereby the prima facie exclusive right to use the mark in commerce, a cloud will be placed on Opposer’s title in its marks and on Opposer’s right to enjoy the free and exclusive use thereof in connection with the provision of its services, all to the injury of Opposer.

15. Pursuant to 15 U.S.C. § 1052(d), Applicant’s mark should not be registered because the mark so resembles a mark or trade name previously used in the United States by another and not abandoned as to be likely to cause confusion, to cause mistake, or to deceive.

Wherefore, Opposer prays that this Notice of Opposition be granted, that Serial Number 78/756,796 be rejected, and that Applicant be denied registration.

Respectfully submitted,



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Attorneys for Petitioner

August 22, 2006