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Filing date: **01/11/2008**

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

Proceeding	91181044
Party	Defendant Hachette Book Group USA, Inc.
Correspondence Address	Mary A. Donovan Donovan & Yee LLP 110 Greene Street, Suite 700 New York, NY 10012 UNITED STATES
Submission	Answer
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Date	01/11/2008
Attachments	Answer.pdf ( 10 pages )(575097 bytes )

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

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**MASTERCARD INTERNATIONAL  
INCORPORATED,**

**Opposer,**

**v.**

**Opposition No. 91181044**

**HACHETTE BOOK GROUP USA, INC.**

**Applicant.**

**Mark: Miscellaneous  
Design**

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**ANSWER**

Applicant Hachette Book Group USA, Inc. (“HACHETTE”), by its attorneys Donovan & Yee LLP, hereby answers the Notice of Opposition (“Notice”) of MasterCard International Incorporated (“MASTERCARD”) as follows:

1. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 1 of the Notice.
2. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 2 of the Notice.
3. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 3 of the Notice.
4. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 4 of the Notice.

5. HACHETTE admits that MASTERCARD is the record owner of the Registrations set forth in paragraph 5 but denies knowledge or information sufficient to form a belief as to the truth of the remaining allegations of paragraph 5 of the Notice.

6. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 6 of the Notice.

7. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 7 of the Notice.

8. HACHETTE denies knowledge or information sufficient to form a belief as to the truth of the allegations of paragraph 8 of the Notice.

9. HACHETTE admits the allegations of paragraph 9 of the Notice.

10. HACHETTE denies the allegations of paragraph 10 of the Notice.

11. HACHETTE denies the allegations of paragraph 11 of the Notice.

12. HACHETTE denies the allegations of paragraph 12 of the Notice.

13. HACHETTE denies the allegations of paragraph 13 of the Notice.

**FACTUAL BACKGROUND FOR AFFIRMATIVE DEFENSES**

14. Applicant is a major book publisher. The books sold in connection with the mark at issue herein are fiction, specifically romance novels, and are identified as such in Applicant's specification of goods.

15. The mark at issue herein consists of two elliptical rings, suggestive of wedding bands ("Applicant's Mark"). This mark has been used by Applicant through its predecessor in interest since at least January 31, 2003.

16. Applicant's Mark and Opposer's marks are not remotely similar in appearance. Attached hereto as Exhibit A is a printout showing Applicant's mark and Opposer's marks alleged herein ("Opposer's Marks").

17. Opposer's business is in the banking and financial field, specifically offering of credit cards and other banking and financial services. On information and belief, Opposer is not a publisher of fictional works.

18. The marks of Applicant and Opposer have co-existed for approximately five years. Applicant is not aware of any incidences of confusion between the use of its mark and Opposer's Marks.

#### **AFFIRMATIVE DEFENSES**

19. Based on the differences of the respective marks and goods of each party there is no likelihood of confusion between the source of Applicant's products and Opposer's products.

20. Opposer has failed to state a claim upon which relief can be granted.

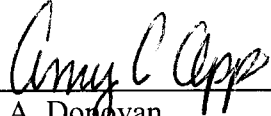
21. Opposer's claims are barred by the doctrine of laches, acquiescence and/or equitable estoppel.

WHEREFORE, Applicant respectfully requests that this Opposition be dismissed and Applicant's mark be permitted to proceed to registration.

Dated: New York, New York  
January 11, 2008

Respectfully submitted,

DONOVAN & YEE LLP

By:   
Mary A. Donovan  
Amy C. Opp  
*Attorneys for Applicant*  
The Soho Building  
110 Greene Street, Suite 700  
New York, New York 10012  
(212) 226-7700  
(212) 226-1995 (fax)

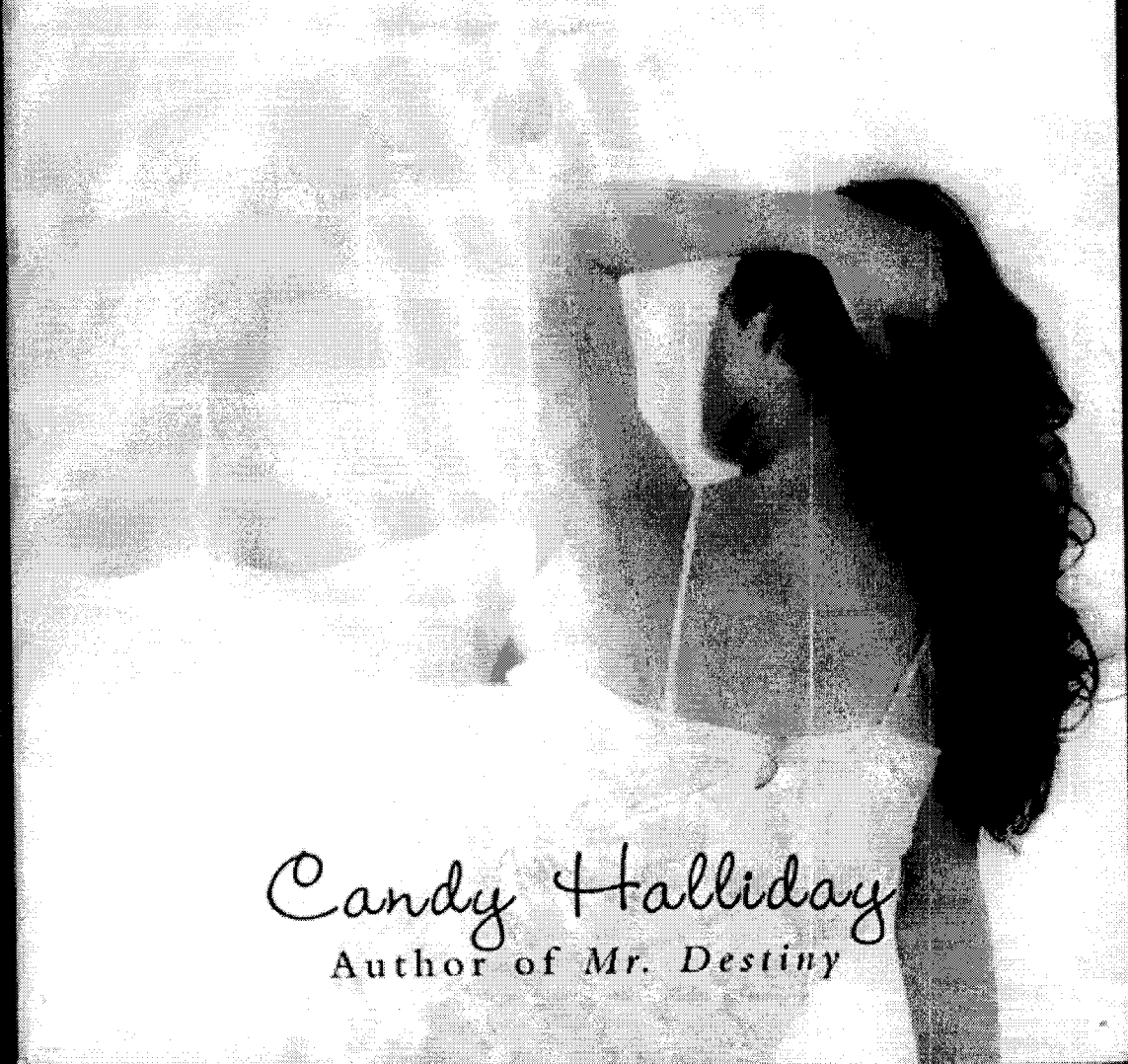
Of Counsel: Carol F. Ross, Esq.  
EVP Business Affairs and  
General Counsel  
Hachette Book Group USA, INC.

**EXHIBIT A**


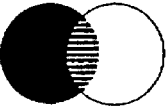
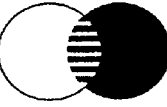

WARNER  FOREVER

# Your Bed or Mine?



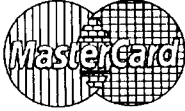

A Housewives  Fantasy Club Novel



*Candy Halliday*  
Author of *Mr. Destiny*

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
<p>MISCELLANEOUS DESIGN</p>  <p>SN:78-841757</p>	<p>Published - Opposed December 4, 2007</p> <p>Int'l Class: 16 First Use: January 31, 2003 Filed: March 20, 2006 Published: June 5, 2007</p>	<p>(Int'l Class: 16) Printed matter including publications in the nature of fiction books, namely, romance novels</p>	<p>Hachette Book Group Usa, Inc. (Delaware Corp.) 1271 Avenue of the Americas New York New York, 10020</p>
<p>MISCELLANEOUS DESIGN</p>  <p>RN:1,723,718</p>	<p>Renewed 8 &amp; 15 October 13, 2002</p> <p>Int'l Class: 16, 36 First Use: February, 1990 Filed: October 25, 1991 Published: July 21, 1992 Registered: October 13, 1992</p>	<p>(Int'l Class: 16) Printed matter and publications; namely, credit, debit and charge cards, travellers cheques, pamphlets, brochures, newsletters and magazines of a financial nature (Int'l Class: 36) Financial services; namely, providing credit, debit and charge card, travellers cheque, cash disbursement, and transaction authorization and settlement services</p>	<p>Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509</p>
<p>MISCELLANEOUS DESIGN</p>  <p>RN:2,038,134</p>	<p>Renewed 8 &amp; 15 February 18, 2007</p> <p>Int'l Class: 9, 16, 36 First Use: August 19, 1992 Filed: March 9, 1995 Published: November 26, 1996 Registered: February 18, 1997</p>	<p>(Int'l Class: 9) Electronic data carriers in the form of magnetically encoded cards (Int'l Class: 16) Printed matter and publications, namely, pamphlets, brochures, newsletters and magazines of a financial nature (Int'l Class: 36) Financial services, namely, providing debit card services</p>	<p>Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509</p>
<p>MASTERCARD and Design</p>  <p>RN:1,257,853</p>	<p>Renewed 8 &amp; 15 November 15, 2003</p> <p>Int'l Class: 36 First Use: February 11, 1980 Filed: April 2, 1980 Published: August 23, 1983 Registered: November 15, 1983</p>	<p>(Int'l Class: 36) Financial services-namely, providing bank card services</p>	<p>Mastercard International Incorporated (Delaware Corp.) 2000 Purchase St Purchase New York, 105772509</p>
<p>MASTERCARD and Design</p>	<p>Renewed 8 &amp; 15 December 8, 2002</p> <p>Int'l Class: 16, 36 First Use: February, 1990 Filed: February 19, 1991 Published:</p>	<p>(Int'l Class: 16) Printed matter and publications; namely, credit cards and debit cards, pamphlets, brochures, newsletters and magazines of a financial nature (Int'l Class: 36) Financial services; namely, providing credit card, debit card, cash disbursement, and transaction authorization and settlement services</p>	<p>Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509</p>



TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
 RN:1,738,276	November 5, 1991 Registered: December 8, 1992		
MASTERCARD and Design  RN:1,814,279	Renewed 8 & 15 December 28, 2003  Int'l Class: 16, 36 First Use: February, 1990 Filed: February 1, 1990 Published: May 19, 1992 Registered: December 28, 1993	(Int'l Class: 16) Printed matter and publications; namely, credit cards, travellers cheques, and debit cards, pamphlets, brochures, newsletters and magazines of a financial nature (Int'l Class: 36) Financial services; namely, providing credit card, debit card, travelers cheque, travel financial assistance, cash disbursement, and transaction authorization and settlement services	Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509
MASTERCARD and Design  RN:1,890,786	Renewed 8 & 15 April 25, 2005  Int'l Class: 6, 9, 14, 16, 18, 20, 21, 24, 25, 28 First Use: April, 1991 Filed: January 21, 1993 Published: January 31, 1995 Registered: April 25, 1995	(Int'l Class: 6) Metal key chains (Int'l Class: 9) Calculators (Int'l Class: 14) Watches, clocks, metal tie pins (Int'l Class: 16) Pens, pencils, pen stands, paper weights, letter openers, notebooks, metal book marks (Int'l Class: 18) Umbrellas, luggage, garment bags for travel, toiletry cases sold empty, duffel bags, attache cases, carry-on bags, tote bags, wallets, business card cases, credit card cases (Int'l Class: 20) Non-metal key rings, luggage tags (Int'l Class: 21) Mugs (Int'l Class: 24) Towels (Int'l Class: 25) Shirts, jackets, sweaters, sweat shirts, visors, caps (Int'l Class: 28) Christmas tree decorations, tennis balls, golf balls, soccer balls, golf tees	Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509
MASTERCARD and Design  RN:2,168,736	Registered June 30, 1998  Int'l Class: 9, 16, 36, 39 First Use: February, 1990 Filed: January 29, 1993 Published: April 7, 1998	(Int'l Class: 9) Electronic data carriers in the form of magnetically encoded cards (Int'l Class: 16) Printed matter and publications, namely, credit, debit and charge cards, travelers cheques, and pamphlets, brochures, newsletters and magazines of a financial nature (Int'l Class: 36) Financial services, namely, providing credit, debit and charge card services, administration of the issuance, redemption and processing of travelers cheques, travel financial assistance, cash disbursement and transaction authorization and settlement services	Mastercard International Incorporated (Delaware Corp.) 2000 Purchase Street Purchase New York, 105772509

TM/SN/RN/Disclaimer	Status/Key Dates	Full Goods/Services	Owner
		(Int'l Class: 39) Travel assistance services, namely, arranging travel tours, making replacement and emergency reservations and booking for transportation	

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing Answer was served on the attorneys of  
Opposer, on January 11, 2008, via First Class mail, postage prepaid to:

Robert M. Wasnofski, Esq.  
Dorsey & Whitney LLP  
250 Park Avenue  
New York, NY 10177

  
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Amy C. Opp