

ESTTA Tracking number: **ESTTA223177**

Filing date: **07/09/2008**

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 parties oppose registration of the indicated application.

**Opposers Information**

Name	Mignon Fogarty, Inc.
Granted to Date of previous extension	07/09/2008
Address	1450 Idlewild Drive, #734 Reno, NV 89509 UNITED STATES

Name	Macmillan Holdings, LLC
Granted to Date of previous extension	07/09/2008
Address	175 Fifth Avenue New York, NY 10010 UNITED STATES

Attorney information	Mark Lerner Satterlee Stephens Burke & Burke LLP 230 Park Avenue Suite 1130 New York, NY 10169 UNITED STATES mlerner@ssbb.com, diana.frost@macmillan.com, mignon@qdnw.com, dgerard@ssbb.com Phone:(212) 818-9200
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**Applicant Information**

Application No	77277106	Publication date	03/11/2008
Opposition Filing Date	07/09/2008	Opposition Period Ends	07/09/2008
Applicant	Joel Avery 3750 Main Street Philadelphia, PA 19127 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 041. All goods and services in the class are opposed, namely: Educational services, namely, conducting programs in the field of grammar
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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## Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	GRAMMAR GIRL		
Goods/Services	Downloadable podcasts in the field of grammar and writing; Entertainment services, namely, providing podcasts in the field of grammar and writing; audio books in the field of grammar and writing provided for download and on CD-ROM; books in the field of grammar and writing; educational services in the nature of seminars on grammar; providing a website with educational information on grammar and writing		

Attachments	Notice of Opposition to The Grammar Girls.pdf ( 6 pages )(18612 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by USPS Express Mail Post Office to Addressee on this date.

Signature	/mark lerner/
Name	Mark Lerner
Date	07/09/2008

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

In the Matter of Trademark Application  
Serial No. 77277106 Filed September 11, 2007  
for the Trademark THE GRAMMAR GIRLS  
Published on March 11, 2008

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Mignon Fogarty, Inc. and Macmillan Holdings, LLC,	:	
Opposers,	:	NOTICE OF OPPOSITION
	:	
v.	:	Opposition No.
	:	
Joel Avery,	:	
	:	
Applicant.	:	
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In the matter of the application of Joel Avery (hereinafter “Avery” or “Applicant”) for registration of the trademark THE GRAMMAR GIRLS, intent-to-use application Serial No. 77277106, Mignon Fogarty, Inc. (“MFI”) a Nevada corporation with a place of business at 100 N. Arlington Avenue, #22K, Reno, Nevada 89501 and Macmillan Holdings, LLC (“Macmillan”) (collectively MFI and Macmillan will be referred to as “Opposers”), a New York limited liability company, with a place of business at 175 Fifth Avenue, New York, New York 10010, believe that they will be damaged by registration of the mark and hereby oppose the same. As grounds for opposition, it is alleged, upon information and belief, as follows:

**Preliminary Statement**

1. Since July 2006, MFI has offered podcasts for download under the name GRAMMAR GIRL. The podcasts, which offer short, friendly tips to improve your

writing, have become immensely popular. Since their introduction, over fourteen million podcasts have been downloaded.

2. On September 7, 2007, MFI, together with its licensee Macmillan, launched an online network of downloadable audio snippets dubbed Quick and Dirty Tips, featuring GRAMMAR GIRL brand downloads and information.

3. Together, Opposers continue to expand the use of the brand, building on the popular podcast series launched in 2006.

4. In a short time, MFI and the GRAMMAR GIRL brand products and services have garnered substantial public recognition and good will.

5. In this opposition, Opposers seek to prevent registration of the confusingly similar mark THE GRAMMAR GIRLS in connection with “Educational services, namely, conducting programs in the field of grammar” in Class 41.

#### **The GRAMMAR GIRL mark**

6. MFI is the owner of rights in the trademark GRAMMAR GIRL based on its continuous use in commerce since July 2006.

7. Since July 2006, MFI has offered educational podcasts in the field of grammar and writing, for download under the mark GRAMMAR GIRL through the iTunes store, on the Internet at qdnow.com and at numerous other websites. The podcasts, which offer short, friendly tips to improve your writing, have become immensely popular. Since their introduction, over fourteen million podcasts have been downloaded. The GRAMMAR GIRL podcasts have been as high as number 1 on the list of most downloaded podcasts at the iTunes store. Currently, approximately 800,000 of the podcasts are downloaded per month.

8. Due to the near instant popularity of the GRAMMAR GIRL podcast series, in March, 2007, the use of the GRAMMAR GIRL mark was expanded to downloadable audio books.

9. The first book, "Grammar Girl's Quick and Dirty Tips to Clean Up Your Writing," was subsequently offered, beginning July 2007, in a CD-ROM version as well.

10. On July 8, 2008 a new paperback book, entitled "Grammar Girl's Quick and Dirty Tips for Better Writing" was published. An audiobook and e-book version of the print book were also released on July 8, 2008. The printed book is scheduled to be featured in retail promotions including back to school promos at all the major book retailers in the U.S.

11. The GRAMMAR GIRL audiobook was named one of the top five non-fiction audiobooks at iTunes for 2007.

12. On September 7, 2007, Opposers launched an online network of downloadable audio snippets dubbed Quick and Dirty Tips, featuring GRAMMAR GIRL brand downloads and information. The GRAMMAR GIRL branded section of the Quick and Dirty Tips website receives over 125,000 unique visitors each month and has had more than 1.1 million unique visitors since the September 2007 launch.

13. MFI has also provided educational programs under the GRAMMAR GIRL mark at the annual meeting of the American Library Association, and at Book Expo America in 2007.

14. MFI, both by itself and through its licensee, Macmillan, has expended great effort and expense in promoting its GRAMMAR GIRL brand and prominently uses

the mark GRAMMAR GIRL in the distribution, promotion, and advertising of the products and services sold under the mark.

15. As a result of its advertising and sales, MFI has valuable goodwill established in the GRAMMAR GIRL mark.

16. Indeed, the podcasts and related goods and services have received favorable unsolicited media coverage including articles in *The New York Times*, *The Wall Street Journal*, *BusinessWeek*, *Reader's Digest*, the *Washington Post*, and CNN.com, as well as in numerous other publications and websites.

17. In addition, MFI's founder, Mignon Fogarty, has appeared on *The Oprah Winfrey Show*.

18. As a result of word of mouth and the unsolicited media coverage, the GRAMMAR GIRL mark has become well-known in association with podcasts, audiobooks, printed books and information on writing and the subject of grammar.

19. Opposers' goods and services offered under the GRAMMAR GIRL mark have achieved a reputation for excellence because of the high quality of the goods and services offered.

20. The GRAMMAR GIRL podcasts have won several awards, including the Best Education Podcast – 2007 Podcast Awards, the Favorite Audio Program – 2007 Podcast Peer Awards and the Best Education Podcast – 2006 Podcast Peer Awards. Grammar Girl is currently a nominee for Best How-To Podcast in the 2008 Podcast Peer Awards.

### **Avery's Proposed Trademark and Usage**

21. On September 11, 2007, long after MFI's GRAMMAR GIRL mark had become well-known, Avery filed an application to register the mark THE GRAMMAR

GIRLS in connection with the following goods: “Educational services, namely, conducting programs in the field of grammar” in Class 41.

22. Avery filed his application on the basis of intent to use.

23. Despite receipt of several letters from counsel for Opposers to Avery requesting that he withdraw his application due to potential confusion with the GRAMMAR GIRL mark, Avery has failed or refused to do so.

### **Likelihood of Confusion**

24. Opposers’ use of the GRAMMAR GIRL mark pre-dates the Applicant’s filing date.

25. Due to the strength of MFI’s mark, the similarity between the marks, the similarity between the goods, as well as the similarity between channels of trade applicant’s use and registration of THE GRAMMAR GIRLS is likely to cause confusion in the marketplace.

26. As set forth above, the GRAMMAR GIRL mark is strong.

27. The marks are practically identical. Avery’s mark merely adds the article “the” and an “s” at the end of MFI’s mark.

28. As noted above, applicant proposes to use the mark in connection with education services in Class 41. These same services have been provided by MFI under the mark GRAMMAR GIRL, and the Opposers, together, have offered educational materials in the form of books and online information under the GRAMMAR GIRL mark.

29. The parties’ services are thus similar and competing.

30. Moreover, because applicant has not specifically limited his channels of trade in his application, the services must be assumed to be sold (or intended to be sold)

through all available channels. Thus, the channels of trade for services bearing applicant's proposed mark overlap with the channels of trade for Opposer's GRAMMAR GIRL goods and services.

31. In view of the foregoing, Applicant's mark is likely to cause confusion and mistake as to the origin of his services and Opposers will be damaged by the registration of the mark.

WHEREFORE, Opposers pray that the application Serial No. 77277106 be rejected and that the mark therein sought for the services therein specified in International Class 41 be denied and refused.

Respectfully submitted,

Satterlee Stephens Burke & Burke LLP

By:           /mark lerner/            
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Attorneys for Opposers

To:  
Mr. Joel Avery  
1726 North 51st Street  
Philadelphia, Pennsylvania 19127

CERTIFICATE OF MAIL BY EXPRESS MAIL

"Express Mail" Label No.: EV 654028961  
Date of Deposit: July 9, 2008

I, Mark Lerner, hereby certify that the forgoing Notice of Opposition was served on Applicant by depositing a true and correct copy with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to Mr. Joel Avery, 1726 North 51st Street, Philadelphia, Pennsylvania 19127 on the above date of deposit.

          /mark lerner/            
Mark Lerner