

ESTTA Tracking number: **ESTTA1071490**

Filing date: **07/29/2020**

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	FarWorks, Inc.
Granted to Date of previous extension	07/29/2020
Address	4616 25TH AVENUE NE, #33 SEATTLE, WA 98105 UNITED STATES
Attorney information	SETH H. REAGAN PERKINS COIE, LLP 1201 THIRD AVENUE SUITE 4900 SEATTLE, WA 98101 UNITED STATES Primary Email: pctrademarks@perkinscoie.com Secondary Email(s): sreagan@perkinscoie.com, gstanton@perkinscoie.com 2063598000
Docket Number	074321-7009

Applicant Information

Application No.	88699692	Publication date	03/31/2020
Opposition Filing Date	07/29/2020	Opposition Period Ends	07/29/2020
Applicant	Strong, Jason D. 4424 VINCENT AVE S MINNEAPOLIS, MN 55410 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2019/11/19 First Use In Commerce: 2019/11/19 All goods and services in the class are opposed, namely: On-line retail store services featuring clothing and apparel

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	3017858	Application Date	09/22/2004
Registration Date	11/22/2005	Foreign Priority Date	NONE
Word Mark	THE FAR SIDE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1980/01/01 First Use In Commerce: 1980/01/01 Cartoon prints, books containing cartoon drawings [, greeting cards, and calendars] Class 041. First use: First Use: 1989/10/27 First Use In Commerce: 1989/10/27 [Production of] [television shows,] [motion pictures,] [videotapes] [and DVDs]		

Attachments	2020.07.29 Notice of Opposition - FARSIDER.pdf(81724 bytes)
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Signature	/Seth H. Reagan/
Name	SETH H. REAGAN
Date	07/29/2020

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

FarWorks, Inc.

Opposer,

v.

Jason D. Strong,

Applicant.

Opposition No.: _____

Mark: FARSIDER

App. Ser. No.: 88/699,692

NOTICE OF OPPOSITION

FarWorks, Inc. (“Opposer”) believes that it will be damaged by registration of the mark FARSIDER (“Applicant’s Mark”), Application Serial No. 88/699,692 (“Application”), filed by Jason D. Strong (“Applicant”) on November 20, 2019, and hereby opposes the Application. As grounds for this opposition, Opposer alleges as follows:

I. PARTIES

1. Opposer is a corporation organized under the laws of the State of Washington with a place of business at 4616 25th Avenue NE #33, Seattle, Washington 98105. Opposer owns and manages the intellectual property rights associated with Gary Larson’s famous The Far Side® cartoons, merchandising, animated films, and digital content.

2. Upon information and belief, Applicant is an individual with an address at 4424 Vincent Avenue S, Minneapolis, Minnesota 55410.

II. OPPOSER’S MARK

3. Opposer’s *The Far Side* cartoons are well-known and beloved around the world, having been carried by more than 1,900 daily newspapers in over 40 countries, and translated into seventeen different languages.

4. Since at least as early as January 1, 1980, Opposer has used the mark THE FAR SIDE (“Opposer’s Mark”), which is the subject of Opposer’s incontestable U.S. Registration No. 3017858, in

connection with cartoon prints and books containing cartoon drawings. (A printout from the USPTO's Trademark Status and Document Retrieval system showing the current status of this registration is attached hereto as **Exhibit A**.) In addition, Opposer has attained expansive common law rights in Opposer's Mark by using and/or licensing Opposer's Mark in connection with apparel, mugs, calendars, posters, greeting cards, museum exhibits, wine, and numerous other goods and services.

5. Opposer has sold more than 77 million calendars bearing Opposer's Mark. Opposer's "The Far Side Off-the-Wall" calendars were identified as the world's bestselling calendar for eighteen years.

6. Opposer has also sold nearly 41 million books bearing Opposer's Mark. To date, 23 of Opposer's books were identified as *New York Times* bestsellers.

7. Opposer currently owns the website www.thefarside.com which provides a daily distribution of *The Far Side* cartoons in addition to a deep dive into *The Far Side* comics letting visitors see exclusive, never-before-seen extras from *The Far Side* series, as well as new works by Gary Larson. The website also operates an online shop that sells and distributes various products bearing Opposer's Mark.

8. Opposer's Mark is recognized by consumers in the United States and around the world as a designation of source of Opposer's goods and services.

9. Opposer's Mark is valid and subsisting, unrevoked and uncancelled, and Opposer is the owner of the aforementioned filings for Opposer's Mark and all of the goodwill represented thereby.

10. Opposer's Mark has achieved widespread and substantial recognition in association with Opposer's goods and services as a result of Opposer's longstanding and continuous use of Opposer's Mark in association with its goods and services.

11. At no time has Opposer granted permission, written or otherwise, to Applicant to use or register any form or derivation of Opposer's Mark, including but not limited to Applicant's Mark.

III. APPLICANT'S MARK AND APPLICATION

12. Applicant is the record owner of the Application, which covers "On-line retail store services featuring clothing and apparel" in Class 35.

13. Applicant filed the Application on November 20, 2019, under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), claiming a date of first use anywhere and first use in commerce of November 19, 2019.

14. The Application was published for opposition on March 31, 2020. Extensions of time to oppose were granted until July 29, 2020. This Opposition is therefore timely filed pursuant to TBMP § 209.02 and 37 CFR § 2.196.

IV. PRIORITY

15. There is no issue regarding priority. Opposer has continuously used Opposer's Mark, and Opposer's Mark has been distinctive, since well-prior to the filing date of the Application, and upon information and belief, any other priority date upon which Applicant may rely.

16. Moreover, the application for Opposer's Mark was filed, and the registration for Opposer's Mark was granted, well-prior to the filing date of the Application, and upon information and belief, any other priority date upon which Applicant may rely.

V. FIRST CLAIM - LIKELIHOOD OF CONFUSION

17. Opposer realleges and incorporates by reference each of the preceding allegations of this Notice of Opposition.

18. Applicant's Mark, FARSIDER, is substantially similar to Opposer's Mark, THE FAR SIDE.

19. Applicant's services, as described in the Application, are related to and/or overlapping with Opposer's goods and services.

20. Applicant's services and Opposer's goods and services are likely to be advertised and/or travel in similar trade channels and be used by and marketed to overlapping consumers.

21. Applicant's Mark so resembles Opposer's Mark as to be likely, when applied to Applicant's services, to cause confusion, to cause mistake, and to deceive the public with consequent injury to Opposer, the trade, and the public.

22. Opposer will be damaged if the Application is allowed to proceed to registration because consumers and prospective consumers are likely to be confused, misled, or deceived into believing that Applicant or Applicant's services, offered under Applicant's Mark, are connected with, sponsored by, or approved by Opposer.

23. Any defect, objection or fault with Applicant's services marketed or sold under Applicant's Mark will reflect upon and seriously injure the valuable reputation and goodwill that Opposer has established for Opposer's Mark.

24. Registration of Applicant's Mark would also damage Opposer because such registration would grant a statutory exclusive right to Applicant in violation of the prior and superior rights of Opposer, and would unduly narrow the scope of protection afforded of Opposer's Mark, in contravention of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

VI. SECOND CLAIM - LIKELIHOOD OF DILUTION

25. Opposer realleges and incorporates by reference each of the preceding allegations of this Notice of Opposition.

26. As a result of Opposer's exclusive and extensive advertising of its marks, the long duration and extent of Opposer's use of its mark, and the tremendous commercial success Opposer has experienced in connection with the use of its marks, Opposer's Mark has become widely recognized by the general consuming public of the United States as a designation of source of Opposer's goods and services. Accordingly, Opposer's Mark is "famous" as defined under 15 U.S.C. § 1125(c).

27. Opposer's Mark achieved fame well prior to the filing date of the Application, and upon information and belief, any other priority date upon which Applicant may rely.

28. Opposer will be damaged by the registration of Applicant's Mark because such registration is likely to cause dilution of the distinctive quality of Opposer's famous mark by blurring or by tarnishment in contravention of Section 43(c) of the Lanham Act, 15 U.S. C. § 1125(c).

VII. THIRD CLAIM - FALSE ASSOCIATION

29. Opposer realleges and incorporates by reference each of the preceding allegations of this Notice of Opposition.

30. As a result of the similarity between Applicant's Mark and Opposer's Mark and the related nature of services covered by the Application, consumers may falsely believe that Applicant's services are provided by, sponsored by, or otherwise affiliated with or connected to Opposer.

31. Opposer will be damaged by the registration of Applicant's Mark because such registration is likely to create a false association with Opposer in contravention of 15 U.S.C. § 1052(a).

VIII. FOURTH CLAIM - ABANDONMENT AND LACK OF USE

32. Opposer realleges and incorporates by reference each of the preceding allegations of this Notice of Opposition.

33. Upon information and belief, Applicant owns and operates an online website, <https://www.farsider.co/> ("FARSIDER Website").

34. The FARSIDER Website identifies Applicant's company as an "adventure watch start up" company, and defines an adventure watch as "a classic, analog time piece inspired by military field watches blended with today's outdoor gear aesthetic."

35. Upon information and belief, the FARSIDER Website does not offer clothing or apparel items for sale or distribution.

36. Upon information and belief, to date, Applicant has never sold or distributed any T-shirts, clothing, or apparel on the FARSIDER Website, and still has not offered any "on-line retail store services featuring clothing and apparel" under Applicant's Mark.

37. Upon information and belief, despite never having actually used Applicant's Mark in connection with "on-line retail store services featuring clothing and apparel," or otherwise using Applicant's Mark in interstate commerce, Applicant filed the Application under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a), falsely claiming a date of first use anywhere and first use in commerce of November 19, 2019.

38. Contrary to the foregoing facts, the Application falsely states that “the mark was first used by the applicant or the applicant's related company or licensee predecessor in interest at least as early as 11/19/2019, and first used in commerce at least as early as 11/19/2019, and is now in use in such commerce.”

39. Accordingly, the Application should be refused on the basis of abandonment and/or lack of use pursuant to TBMP § 309.03(c)(1).

IX. REQUEST FOR RELIEF

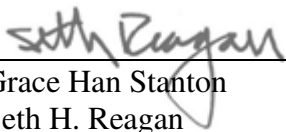
WHEREFORE, Opposer believes that it will be damaged by registration of the mark shown in Application Serial No. 88/699,692 and respectfully requests that the opposition be sustained and that registration to Applicant be refused.

This Notice of Opposition is filed according to the rules governing electronic submissions to the Trademark Trial and Appeal Board, including payment of the requisite filing fee.

DATED: July 29, 2020

Respectfully submitted,

PERKINS COIE LLP



Grace Han Stanton
Seth H. Reagan
Attorneys for Opposer
1201 Third Avenue, Suite 4900
Seattle, Washington 98101-3099
(206) 359-8000

Exhibit A

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Mark: THE FAR SIDE

THE FAR SIDE

US Serial Number: 78488052

Application Filing Date: Sep. 22, 2004

US Registration Number: 3017858

Registration Date: Nov. 22, 2005

Register: Principal

Mark Type: Trademark, Service Mark

TM5 Common Status Descriptor:



LIVE/REGISTRATION/Issued and Active

The trademark application has been registered with the Office.

Status: The registration has been renewed.

Status Date: Nov. 13, 2015

Publication Date: Aug. 30, 2005

Mark Information

Mark Literal Elements: THE FAR SIDE

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Related Properties Information

Claimed Ownership of US Registrations: 1292219

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *..* identify additional (new) wording in the goods/services.

For: Cartoon prints, books containing cartoon drawings [, greeting cards, and calendars]

International Class(es): 016 - Primary Class

U.S Class(es): 002, 005, 022, 023, 029, 037, 038, 050

Class Status: ACTIVE

Basis: 1(a)

First Use: Jan. 01, 1980

Use in Commerce: Jan. 01, 1980

For: [Production of] [television shows,] [motion pictures,] [videotapes] [and DVDs]

International Class(es): 041 - Primary Class

U.S Class(es): 100, 101, 107

Class Status: SECTION 8 - CANCELLED

Basis: 1(a)

First Use: Oct. 27, 1989

Use in Commerce: Oct. 27, 1989

Basis Information (Case Level)

Filed Use: Yes
Filed ITU: No
Filed 44D: No
Filed 44E: No
Filed 66A: No
Filed No Basis: No

Currently Use: Yes
Currently ITU: No
Currently 44E: No
Currently 66A: No
Currently No Basis: No

Current Owner(s) Information

Owner Name: FarWorks, Inc.
Owner Address: 4616 25th Ave. NE #33
Seattle, WASHINGTON UNITED STATES 98105
Legal Entity Type: CORPORATION
State or Country Where Organized: WASHINGTON

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Grace Han Stanton
Attorney Primary Email Address: pctrademarks@perkinscoie.com
Docket Number: 74321-4000.2
Attorney Email Authorized: Yes

Correspondent

Correspondent Name/Address: Grace Han Stanton
Perkins Coie LLP
1201 Third Avenue, Suite 4900
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Correspondent e-mail: pctrademarks@perkinscoie.com
Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Apr. 18, 2017	NOTICE OF SUIT	
Apr. 18, 2017	NOTICE OF SUIT	
Nov. 13, 2015	NOTICE OF ACCEPTANCE OF SEC. 8 - E-MAILED	
Nov. 13, 2015	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	68502
Nov. 13, 2015	REGISTERED - SEC. 9 GRANTED/CHECK RECORD FOR SEC. 8	68502
Nov. 13, 2015	REGISTERED - PARTIAL SEC. 8 (10-YR) ACCEPTED	68502
Nov. 12, 2015	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68502
Sep. 29, 2015	TEAS SECTION 8 & 9 RECEIVED	
Mar. 23, 2012	ATTORNEY/DOM.REP.REVOKED AND/OR APPOINTED	
Mar. 23, 2012	TEAS REVOKE/APP/CHANGE ADDR OF ATTY/DOM REP RECEIVED	
May 25, 2011	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70619
May 25, 2011	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70619
Apr. 29, 2011	TEAS SECTION 8 & 15 RECEIVED	
Jan. 16, 2009	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Nov. 22, 2005	REGISTERED-PRINCIPAL REGISTER	
Aug. 30, 2005	PUBLISHED FOR OPPOSITION	
Aug. 10, 2005	NOTICE OF PUBLICATION	
May 06, 2005	LAW OFFICE PUBLICATION REVIEW COMPLETED	77978
Apr. 29, 2005	ASSIGNED TO LIE	77978
Apr. 28, 2005	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 26, 2005	EXAMINER'S AMENDMENT ENTERED	77976
Apr. 22, 2005	EXAMINER'S AMENDMENT MAILED	

Apr. 22, 2005 EXAMINERS AMENDMENT -WRITTEN
Apr. 22, 2005 ASSIGNED TO EXAMINER
Sep. 29, 2004 NEW APPLICATION ENTERED IN TRAM

76487
76487

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMEG LAW OFFICE 103

Date in Location: Nov. 13, 2015

Proceedings

Summary

Number of Proceedings: 2

Type of Proceeding: Opposition

Proceeding Number: [91254691](#)

Filing Date: Mar 16, 2020

Status: Terminated

Status Date: Apr 27, 2020

Interlocutory Attorney: JENNIFER KRISP

Defendant

Name: Marvel Food Corp.

Correspondent Address: KEVIN G SMITH
SUGHRUE MION PLLC
2000 PENNSYLVANIA AVENUE NW, SUITE 900
WASHINGTON DC UNITED STATES , 20006

Correspondent e-mail: tm@sughrue.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
FARSIDE	Abandoned - After Inter-Partes Decision	86961376	

Plaintiff(s)

Name: FarWorks, Inc.

Correspondent Address: SETH H REAGAN
PERKINS COIE LLP
1201 THIRD AVENUE , SUITE 4900
SEATTLE WA UNITED STATES , 98101

Correspondent e-mail: SReagan@perkinscoie.com , CMarcelo@perkinscoie.com , TBrandon@perkinscoie.com , PCTrademarks@perkinscoie.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THE FAR SIDE	REGISTERED AND RENEWED	78488052	3017858

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 16, 2020	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 16, 2020	Apr 25, 2020
3	INSTITUTED	Mar 16, 2020	
4	W/DRAW OF APPLICATION	Apr 23, 2020	
5	BD DECISION: OPP DISMISSED W/O PREJ	Apr 27, 2020	
6	TERMINATED	Apr 27, 2020	

Type of Proceeding: Opposition

Proceeding Number: [91234487](#)

Filing Date: May 10, 2017

Status: Terminated

Status Date: Aug 07, 2017

Interlocutory Attorney: MARY B MYLES

Defendant

Name: Shawn Bainbridge

Correspondent Address: CHASE E SCOTT
TAYLOR FEIL HARPER LUMSDEN & HESS PC
3340 PEACHTREE ROAD NE SUITE 250
ATLANTA GA UNITED STATES , 30326-1148

Correspondent e-mail: cscott@tfhlegal.com , tharper@tfhlegal.com , trademarks@tfhlegal.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
FAR SIDE	Abandoned - After Inter-Partes Decision	87150167	

Plaintiff(s)

Name: FarWorks, Inc.

Correspondent Address: SETH H REAGAN
PERKINS COIE LLP
1201 THIRD AVENUE SUITE 4900
SEATTLE WA UNITED STATES , 98101-3099

Correspondent e-mail: pctrademarks@perkinscoie.com

Associated marks

Mark	Application Status	Serial Number	Registration Number
THE FAR SIDE	REGISTERED AND RENEWED	78488052	3017858

Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	May 10, 2017	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	May 11, 2017	Jun 20, 2017
3	PENDING, INSTITUTED	May 11, 2017	
4	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jun 13, 2017	
5	SUSPENDED	Jun 13, 2017	
6	W/DRAW OF APPLICATION W/O CONSENT	Jul 28, 2017	
7	BD DECISION: SUSTAINED	Aug 07, 2017	
8	TERMINATED	Aug 07, 2017	