

ESTTA Tracking number: **ESTTA1402964**
Filing date: **12/18/2024**

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	Penguin Random House LLC
Granted to date of previous extension	12/18/2024
Address	1745 BROADWAY NEW YORK, NY 10019 UNITED STATES

Attorney information	COURTNEY B. SHIER FROSS ZELNICK LEHRMAN & ZISSU, P.C. 151 WEST 42ND STREET 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary email: cshier@fzlj.com Secondary email(s): cshier@fzlj.com, cmende@fzlj.com, ttbfiling@fzlj.com, gharris@fzlj.com 212-813-5924
Docket no.	

Applicant information

Application no.	98242543	Publication date	08/20/2024
Opposition filing date	12/18/2024	Opposition period ends	12/18/2024
Applicant	Jake, Jessika 6012 RANCHO MISSION RD, UNIT 312 SAN DIEGO, CA 92108 UNITED STATES		

Goods/services affected by opposition

<p>Class 009. First Use: Jan 1, 2004 First Use In Commerce: Dec 1, 2004 All goods and services in the class are opposed, namely: Downloadable educational course materials in the field of mathematics for children; Downloadable educational course materials in the field of mathematics for students from elementary through junior high; Downloadable educational course materials in the field of mathematics for students in grades 0-8; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for children; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for students from elementary through junior high; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for grades 0-8; Downloadable children's educational computer applications; Downloadable children's educational mobile applications; Downloadable children's educational software; Downloadable children's educational tablet applications; Downloadable printable educational materials in the field of mathematics for children; Downloadable printable educational materi-</p>

als in the field of mathematics for students from elementary through junior high; Downloadable printable educational materials in the field of mathematics for students in grades 0-8


Class 016. First Use: Jan 1, 2004 First Use In Commerce: Dec 1, 2004


All goods and services in the class are opposed, namely: Printed educational materials in the field of mathematics; Printed instructional and teaching materials in the field of mathematics; Printed instructional, educational, and teaching materials in the field of mathematics; Printed publications, namely, brochures, booklets, and teaching materials in the field of mathematics; Printed teaching materials in the field of mathematics; Educational kits sold as a unit in the field of mathematics for children consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for students from elementary through junior high consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for students in grades 0-8 consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for children consisting primarily of printed instructional materials and also including DVDs; Educational kits sold as a unit in the field of mathematics for students from elementary through junior high consisting primarily of printed instructional materials and also including DVDs; Educational kits sold as a unit in the field of mathematics for students in grades 0-8 consisting primarily of printed instructional materials and also including DVDs


Grounds for opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)


Marks cited by opposer as basis for opposition

U.S. registration no.	1018812	Application date	02/03/1974
Register	Principal		
Registration date	08/26/1975	Foreign priority date	NONE
Word mark	MAD LIBS		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Sep 1958 First Use In Commerce: Sep 1958 BOOK OF GAMES		


U.S. registration no.	2586559	Application date	01/12/2001
Register	Principal		
Registration date	06/25/2002	Foreign priority date	NONE
Word mark	MAD LIBS		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Jul 2001 First Use In Commerce: Jul 2001 BOOKS FEATURING WORD GAMES		


U.S. registration no.	3398843	Application date	10/03/2001
Register	Principal		
Registration date	03/18/2008	Foreign priority date	NONE
Word mark	MAD LIBS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 016. First use: First Use: Jun 24, 2005 First Use In Commerce: Jun 24, 2005 GREETING CARDS, PAPER PARTY FAVORS</p> <p>Class 025. First use: First Use: Dec 2005 First Use In Commerce: Dec 2005 [T-SHIRTS]</p> <p>Class 028. First use: First Use: May 2002 First Use In Commerce: May 2002 CARD GAMES [; HAND HELD UNIT FOR PLAYING ELECTRONIC GAMES]</p>		

U.S. registration no.	3471746	Application date	12/10/2007
Register	Principal		
Registration date	07/22/2008	Foreign priority date	NONE
Word mark	MAD LIBS		
Design mark			
Description of mark	The mark consists of the designation "MAD LIBS" with the fanciful representation of a face between the words "MAD" and "LIBS".		
Goods/services	<p>Class 041. First use: First Use: May 15, 2007 First Use In Commerce: May 15, 2007 Entertainment services, namely, providing on-line computer games</p>		

U.S. registration no.	3770903	Application date	08/19/2009
Register	Principal		
Registration date	04/06/2010	Foreign priority date	NONE
Word mark	MAD LIBS		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: Aug 19, 2009 First Use In Commerce: Aug 19, 2009 Electronic game software for wireless devices</p>		

U.S. registration no.	4704113	Application date	05/23/2012
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Register	Principal		
Registration date	03/17/2015	Foreign priority date	NONE
Word mark	ADULT MAD LIBS		
Design mark			
Description of mark	NONE		
Goods/services	Class 035. First use: First Use: Nov 2012 First Use In Commerce: Nov 2012 the bringing together for the benefit of others of a variety of goods, electronic and multimedia [equipment and] software, electronic books and downloadable software and [jewelry and metal gift items, paper and cardboard articles,] books, [stationery, cards, gift wrap, pens, bags, purses and leather goods, umbrellas, furniture and home accessories, household and kitchen items, textile goods, bed linen, clothing, footwear and headgear, games and toys, and food and drink,] enabling customers conveniently to view and purchase those goods in a product retail establishment or in an online store or by mail order or from a catalogue		

U.S. registration no.	5227075	Application date	11/07/2016
Register	Principal		
Registration date	06/20/2017	Foreign priority date	NONE
Word mark	MAD LIBS JUNIOR		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Feb 2, 2004 First Use In Commerce: Feb 2, 2004 children's books, books featuring word games, and children's activity books		

Attachments	73012582#TMSN.png(bytes) 76193316#TMSN.png(bytes) 76320692#TMSN.png(bytes) 77348226#TMSN.png(bytes) 77808193#TMSN.png(bytes) 85633187#TMSN.png(bytes) 87228269#TMSN.png(bytes) NOP MATHLIBS.pdf(411670 bytes)
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Signature	/Courtney B. Shier/
Name	Courtney B. Shier
Date	12/18/2024

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

Marks Opposed: MATHLIBS
Applications Opposed: App. S.N. 98242543

Penguin Random House LLC,	-	X
	:	
Opposer,	:	
	:	
- against -	:	NOTICE OF OPPOSITION
	:	
Jessika Jake,	:	
	:	
Applicant.	:	
	-	X

Opposer, Penguin Random House LLC, a limited liability company organized under the laws of Delaware with an address at 1745 Broadway, 14-1, Legal Department, New York, New York 10019, believes that it would be damaged by the issuance of a registration for the mark MATHLIBS for goods in Classes 9 and 16 as sought by Applicant, Jessika Jake, in Application Serial No. 98242543 (the “Application”), and therefore Opposer opposes the same.

As grounds for this opposition, Opposer, by its counsel, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

FACTS COMMON TO ALL CLAIMS


- A. Opposer and its Famous MAD LIBS Mark
 - 1. Opposer, one of the nation’s leading publishers, produces and markets the iconic, humorous MAD LIBS fill-in-the-blanks game books and related offerings. Since publication of the first MAD LIBS book more than 65 years ago, hundreds of different books have been published under the MAD LIBS mark by Opposer and its predecessors, and more than one hundred million units have been sold, making it one of the most successful book series in history.

2. In addition to entertaining multiple generations of readers, MAD LIBS books are used extensively in children’s education. Opposer publishes guides for educators using MAD LIBS books in classrooms. In addition, Opposer publishes MAD LIBS workbooks specifically designed for elementary school students – including a series “For Growing Readers” (ages 6-7) and a series “For Tweens” (ages 8-12) – and corresponding curriculum guides for educators. The MAD LIBS books provide an entertaining and engaging way to teach children about nouns, verbs, adjectives, and adverbs, and to reinforce essential grammar, reading comprehension, and vocabulary skills.¹

3. MAD LIBS games and related offerings are sold in various formats and media including via online websites, via downloads, and on mobile apps, in addition to printed books.

4. Through extensive promotion and use and tremendous sales success, dating back decades and long before any date upon which Applicant can rely, Opposer’s MAD LIBS mark has become famous among U.S. consumers and has come to represent an enormous goodwill that is exclusively associated with Opposer and its MAD LIBS fill-in-the-blanks books and related offerings.

5. In addition to its strong common law rights built up in the inherently distinctive MAD LIBS mark through decades of use and promotion, Opposer owns the following registrations, among others, for the MAD LIBS mark and other MAD LIBS-inclusive marks:

Mark	Reg. No.	Reg. Date	Goods/Services
MAD LIBS	1018812	8/26/1975	IC 16: book of games
	2586559	6/25/2002	IC 16: books featuring word games

¹ Opposer also publishes children’s word game and activity books under the MAD LIBS JUNIOR mark.

Mark	Reg. No.	Reg. Date	Goods/Services
MAD LIBS	3398843	3/18/2008	IC 16: greeting cards, paper party favors IC 28: card games
MAD LIBS	3471746	7/22/2008	IC 41: entertainment services, namely, providing on-line computer games
MAD LIBS	3770903	4/6/2010	IC 9: electronic game software for wireless devices
ADULT MAD LIBS	4704113	3/17/2015	IC 35: the bringing together for the benefit of others of a variety of goods, electronic and multimedia software, electronic books and downloadable software and books, enabling customers conveniently to view and purchase those goods in a product retail establishment or in an online store or by mail order or from a catalogue
MAD LIBS JUNIOR	5227075	6/20/2017	IC 16: children's books, books featuring word games, and children's activity books

6. The foregoing registrations are all valid, subsisting, and in full force and effect and constitute evidence of the validity of the registered marks and of the registration thereof, and of Opposer's ownership of the marks and exclusive right to use the marks in commerce in connection with the identified goods and services.

B. Applicant and its Application for the MATHLIBS Mark.

7. Upon information and belief, Applicant is an individual residing at 6012 Rancho Mission Road, Unit 312, San Diego, California 92108.

8. On October 26, 2023, Applicant filed the Application to register the mark MATHLIBS for "Downloadable educational course materials in the field of mathematics for students from elementary through junior high" in Class 9, "Printed instructional and teaching materials in the field of mathematics" in Class 16, and the other Class 9 and 16 goods listed at Exhibit A (Applicant's Goods").

9. The specimen of use submitted with the Application touts that users can make their own “silly math question[s]” using the MATHLIBS products. Online MATHLIBS products function by asking the user to provide a series of words (e.g., “A funny food is . . . _____”) that the MATHLIBS program then inserts into mathematical story problems (.pdf versions are also available).

10. The inserted words themselves do not impact the mathematical problem. The user solves the same underlying math problem, and the problem will have the same solution, regardless of the words input by the user. Thus, the fill-in-the-blanks feature of the MATHLIBS product is gratuitous, and the products – essentially fill-in-the-blank humorous story problems – are highly similar to the books, apps, and online products offered under Opposer’s MAD LIBS mark.

11. Prior to Applicant’s adoption of the MATHLIBS mark, and prior to filing the Application for the MATHLIBS mark, Applicant was on constructive notice of Opposer’s prior rights in its MAD LIBS mark by virtue of the registration thereof.

12. Upon information and belief, prior to Applicant’s adoption of the MATHLIBS mark, and prior to filing the Application for the MATHLIBS mark, Applicant was on actual notice of Opposer’s prior rights in its MAD LIBS mark by virtue of the extensive use and renown thereof.

13. Upon information and belief, Applicant adopted the MATHLIBS mark intentionally to trade on the goodwill associated with Opposer’s MAD LIBS mark. There is no other reason for Applicant to have included the term “libs” in a mark for a humorous fill-in-the-blanks math education product. Whereas “MAD LIBS” is a creative play on the terms “ad-lib” (creating unscripted material off the cuff) and “mad” (crazy) – to allude to the zany, unexpected

stories that result from playing the fill-in-the-blanks game – MATHLIBS for a math education product can only be a reference to MAD LIBS mark, as the term “libs” by itself (without “ad”) means nothing.

**FIRST CLAIM FOR RELIEF:
LIKELIHOOD OF CONFUSION UNDER 15 U.S.C. § 1052(d)**

14. Opposer incorporates by reference paragraphs 1 through 13 above as if fully set forth herein.

15. Opposer and its predecessors acquired common law rights in and secured a registration for its MAD LIBS mark long before the filing date of the Application, the alleged first use date in the Application, or any other priority date upon which Applicant can rely. As such, Opposer’s rights in its MAD LIBS mark are prior and superior to any rights Applicant may claim in Applicant’s MATHLIBS mark.

16. Applicant’s MATHLIBS mark is nearly identical to Opposer’s MAD LIBS mark both in sight and sound, merely replacing the internal “D” with the similar sounding “TH.”

17. Applicant’s Goods under the MATHLIBS mark are closely related to goods and services Opposer offers under the MAD LIBS mark.

18. In view of the similarity of the marks and relatedness of the parties’ respective offerings under those marks, Applicant’s use of Applicant’s MATHLIBS mark for Applicant’s Goods is likely to confuse consumers into believing, falsely, that Applicant’s Goods originate with, are sponsored or approved by, or are otherwise connected with Opposer, or are connected with goods and services offered under Opposer’s MAD LIBS mark. Any use of Applicant’s MATHLIBS mark for Applicant’s Goods by Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

19. As a result of the foregoing, registration to Applicant of the MATHLIBS mark for Applicant's Goods as sought in the Application would be inconsistent with Opposer's prior rights in its MAD LIBS mark and would threaten the investment and goodwill of Opposer in its mark. Opposer therefore would be injured by registration of the MATHLIBS mark for Applicant's Goods.

**SECOND CLAIM FOR RELIEF:
TRADEMARK DILUTION UNDER 15 U.S.C. § 1052(f)**

20. Opposer incorporates by reference paragraphs 1 through 19 above as if fully set forth herein.

21. Opposer's MAD LIBS mark is inherently distinctive and has acquired fame through extensive promotion and long and exclusive use in connection with the MAD LIBS books and other offerings under the MAD LIBS mark. Opposer's MAD LIBS mark is widely recognized by the consuming public of the United States as being exclusively associated with Opposer and its goods.

22. Opposer's MAD LIBS mark is the subject of longstanding federal trademark registrations, and the MAD LIBS mark was registered prior to any priority date upon which Applicant can rely.

23. Opposer and its predecessors have been using the MADS LIBS mark nationally for many decades, have engaged in nationwide promotion featuring the MAD LIBS mark, and have otherwise publicized the MAD LIBS mark throughout the United States.

24. In addition, media and other third parties have referred to and publicized the MAD LIBS mark. Opposer's MAD LIBS mark has received extensive recognition and has become a famous mark designating goods and services of Opposer.

25. The filing date of the Application, and any other priority date upon which Applicant can rely, were long after Opposer's MAD LIBS mark became famous.

26. Applicant's MATHLIBS marks calls to mind, creates the same mental impression as, and otherwise reminds consumers of Opposer's MAD LIBS mark.

27. By virtue of (i) the similarity between Opposer's MAD LIBS mark and Applicant's MATHLIBS mark, (ii) the fame of Opposer's MAD LIBS mark, and (iii) the exclusive association between the MAD LIBS mark and Opposer and its offerings under that mark, the use and registration of the MATHLIBS mark by Applicant in connection with Applicant's Goods will dilute and/or create a likelihood of dilution of Opposer's famous MAD LIBS mark by impairing the distinctiveness of the MAD LIBS mark and its ability to identify exclusively goods and services from Opposer, in violation of Section 2(f) of the Lanham Act, 15 U.S.C. § 1052(f).


28. By reason of the foregoing, Opposer will be harmed by registration of Applicant's Marks for Applicant's Services as sought in the Applications.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that registration of Applicant's MATHLIBS mark in Classes 9 and 16 as sought in the Application be denied.

Dated: New York, New York
December 18, 2024

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

By: 
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Telephone: (212) 813-5900

Attorneys for Opposer

EXHIBIT A

Applicant's Goods (App. Serial No. 98242543):

Class 9: Downloadable educational course materials in the field of mathematics for children; Downloadable educational course materials in the field of mathematics for students from elementary through junior high; Downloadable educational course materials in the field of mathematics for students in grades 0-8; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for children; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for students from elementary through junior high; Downloadable educational media, namely, digital documents, audio files, video recordings and multimedia files featuring mathematics for grades 0-8; Downloadable children's educational computer applications; Downloadable children's educational mobile applications; Downloadable children's educational software; Downloadable children's educational tablet applications; Downloadable printable educational materials in the field of mathematics for children; Downloadable printable educational materials in the field of mathematics for students from elementary through junior high; Downloadable printable educational materials in the field of mathematics for students in grades 0-8

Class 16: Printed educational materials in the field of mathematics; Printed instructional and teaching materials in the field of mathematics; Printed instructional, educational, and teaching materials in the field of mathematics; Printed publications, namely, brochures, booklets, and teaching materials in the field of mathematics; Printed teaching materials in the field of mathematics; Educational kits sold as a unit in the field of mathematics for children consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for students from elementary through junior high consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for students in grades 0-8 consisting primarily of printed instructional materials and also including audio CDs; Educational kits sold as a unit in the field of mathematics for children consisting primarily of printed instructional materials and also including DVDs; Educational kits sold as a unit in the field of mathematics for students from elementary through junior high consisting primarily of printed instructional materials and also including DVDs; Educational kits sold as a unit in the field of mathematics for students in grades 0-8 consisting primarily of printed instructional materials and also including DVDs