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Attorneys for Merrill Lynch & Co., Inc.

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

In the Matter of Trademark Reg. No. 2,825,379 and Application Serial No. 75/753,438
Marks: MERRILLCONNECT and MERRILL E-COLLABORATE
Registrant/Applicant: MERRILL COMMUNICATIONS LLC.

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MERRILL LYNCH & CO., INC.,
: Cancellation No. _____
Petitioner/Opposer,
:
-against-
: Opposition No. _____
MERRILL COMMUNICATIONS LLC.,
:
Registrant/Applicant.

12/03/2004 SWILSON1 00000115 192385 2825379 ----- x
01 FC:6402 300.00 DA

**COMBINED PETITION FOR CANCELLATION
AND NOTICE OF OPPOSITION**

Merrill Lynch & Co., Inc. ("Merrill Lynch"), a corporation organized and existing under the laws of the State of Delaware, and having a business address at Four World Financial Center, North Tower, New York, NY 10080, believes that: (i) it is being, and will continue to be, damaged by U.S. Registration No. 2,825,379 for the mark MERRILLCONNECT to Merrill Communications LLC. ("MCC"); and (ii) it would be damaged by the registration of the mark MERRILL E-COLLABORATE, shown in U.S. Trademark Application Serial No. 75/753,438, to MCC.



Accordingly, Merrill Lynch hereby: (i) petitions to cancel the registration of MCC's MERRILLCONNECT mark pursuant to 15 U.S.C. § 1064 and 37 C.F.R. § 2.111; and (ii) opposes the registration of MERRILL E-COLLABORATE pursuant to 15 U.S.C. § 1063 and 37 C.F.R. § 2.101.

As grounds for cancellation, Merrill Lynch alleges upon personal knowledge for its own acts and upon information and belief with respect to all other matters, as follows:

**FACTS COMMON TO PETITION TO
CANCEL AND NOTICE OF OPPOSITION**

Merrill Lynch's Famous Family of Merrill Lynch Marks

1. For many years and since long prior to any date of first use upon which Respondent relies, Merrill Lynch has offered throughout the United States, a variety of financial and other services under or in connection with numerous MERRILL and MERRILL LYNCH marks (collectively, the "MERRILL LYNCH Marks"), including, without limitation, the following: MERRILL LYNCH, U.S. Reg. No. 1,272,653 (incontestable); 1-800 MERRILL, U.S. Reg. No. 2,366,321; ASKMERRILL.COM, U.S. Reg. No. 2,482,166; MERRILL LYNCH DIRECT, U.S. Reg. No. 2,465,877, and MERRILL LYNCH ONLINE, U.S. Reg. No. 2,353,416. (See Exhibit A hereto).

2. By virtue of extensive use and promotion of the MERRILL LYNCH Marks in connection with Merrill Lynch's goods and services in the United States and throughout the world, the Merrill Lynch Marks have acquired substantial distinctiveness, goodwill, and secondary meaning in the United States and elsewhere in

the world as indicating goods and services having their origin exclusively with Merrill Lynch.

3. By virtue of extensive use and promotion of Merrill Lynch's MERRILL LYNCH Marks throughout the United States and elsewhere in the world, the MERRILL LYNCH Marks have become famous as that term is used in Section 43(c) of the Lanham Act.

MCC's MERRILLCONNECT and MERRILL E-COLLABORATE Marks

4. On March 23, 2004, MCC registered the mark MERRILLCONNECT for the following goods and services in the following classes: (i) computer software for use in database management and generating financial reports in the field of sales and marketing information for use in business in Class 9; (ii) business and management consultation services in Class 36; and (iii) providing telecommunications connections via a global computer network for the transfer and dissemination of a business' sales, marketing and financial data; electronic transmission of a business' sales, marketing and financial data via a global computer network in Class 38.

5. On July 14, 1999, MCC filed an application to register the mark MERRILL E-COLLABORATE, which application currently is pending for communication services, namely, providing on-line chat rooms and on-line bulletin boards for the transmission of electronic messages among computer users concerning the drafting and proofing of financial documents; electronic transmission of financial data and documents via computer terminals in Class 38.

6. The MERRILLCONNECT and MERRILL E-COLLABORATE marks feature terms similar to the MERRILL LYNCH Marks, for which Merrill Lynch and its goods and services have come to be identified. MCC's goods and services are

related to Merrill Lynch's goods and services, and are directed to the same channels of trade and some of the same customers to which Merrill Lynch's goods and services offered under the MERRILL LYNCH Marks are directed.

7. The MERRILL LYNCH Marks have priority of use and registration to MCC's MERRILLCONNECT and MERRILL E-COLLABORATE marks.

**PETITION TO CANCEL AND
NOTICE OF OPPOSITION**

Confusion and Dilution

8. On November 18, 2002, Merrill Lynch filed Application Serial No. 76/467846 for registration of the mark TOTAL MERRILL for financial services, namely insurance agency and brokerage services, real estate financing services, real estate investment services, real estate management services, real estate agency and brokerage services, security and commodity brokerage and dealing services, underwriting mortgage lending, investment banking, mortgage banking, financial management services and financial advisory services, namely, financial analysis and consultation in Class 36.

9. On March 31, 2003, the PTO issued an Office Action suspending Merrill Lynch's TOTAL MERRILL application on grounds that "there may be a likelihood of confusion between [Merrill Lynch's TOTAL MERRILL] mark and [MCC's MERRILL E-COLLABORATE and MERRILLCONNECT] mark[s] under Section 2(d) of the Act."

10. The MERRILLCONNECT and MERRILL E-COLLABORATE marks are confusingly similar to MERRILL LYNCH Marks, and MERRILLCONNECT and MERRILL E-COLLABORATE thereby create a likelihood of confusion that MCC's

products and services originate with or are otherwise licensed, sponsored, or authorized by Merrill Lynch.

11. Given the close similarity in commercial impression of the MERRILLCONNECT and MERRILL E-COLLABORATE marks to the MERRILL LYNCH Marks, the MERRILLCONNECT and MERRILL E-COLLABORATE marks create a likelihood of dilution of Merrill Lynch's distinctive and famous MERRILL LYNCH Marks.

Injury to Merrill Lynch

12. By reason of all of the foregoing, Merrill Lynch: (i) is being, and will continue to be, damaged by U.S. Registration No. 2,825,379 for the mark MERRILLCONNECT to MCC; and (ii) will be damaged by the registration of the mark MERRILL E-COLLABORATE, shown in U.S. Trademark Application Serial No. 75/753,438, to MCC.

Relief Requested

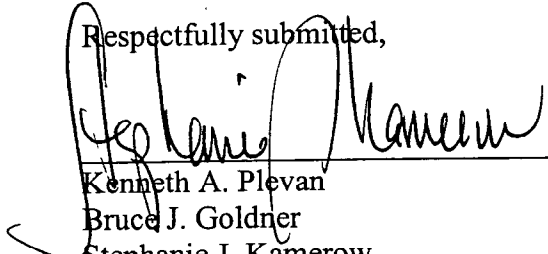
WHEREFORE, Merrill Lynch requests that: (i) the MERRILLCONNECT registration be cancelled in its entirety, and that the Petition for Cancellation be sustained in favor of Merrill Lynch; and (ii) the Notice of Opposition be sustained, and the registration of MERRILL E-COLLABORATE to MCC be refused.

A duplicate copy of this Combined Petition for Cancellation and Notice
Opposition is enclosed herewith pursuant to 37 C.F.R. § 2.112(a).

Please charge the \$600 filing fee to Merrill Lynch's undersigned attorneys'
[Deposit Account No. 19-2385.]

Dated: November 19, 2004

Respectfully submitted,



A handwritten signature in black ink, appearing to read 'Kenneth A. Plevan', is written over a horizontal line. The signature is stylized and cursive.

Kenneth A. Plevan

Bruce J. Goldner

Stephanie J. Kamerow

SKADDEN, ARPS, SLATE,

MEAGHER & FLOM LLP

Four Times Square

New York, New York 10036-6522

(212) 735-3000

Attorneys for Petitioner/Opposer
Merrill Lynch & Co., Inc.

CERTIFICATE OF MAILING UNDER 37 CFR § 1.10

"Express Mail" Mailing Label Number EV 384041668 US

Date of Deposit: November 19, 2004

I hereby certify that the foregoing is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

Name of Person Mailing: Sylvia Marquez

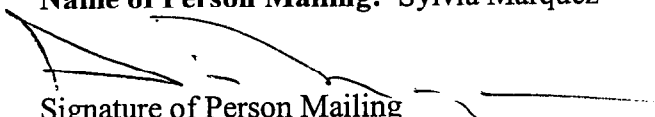

Signature of Person Mailing

Exhibit A



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Typed Drawing

Word Mark MERRILL LYNCH

Goods and Services IC 016. US 038. G & S: Books, Pamphlets, Newsletters, and Brochures Concerning Financial Services. FIRST USE: 19790501. FIRST USE IN COMMERCE: 19790501

Mark Drawing Code (1) TYPED DRAWING

Serial Number 73390207

Filing Date September 27, 1982

Current Filing Basis 1A

Original Filing Basis 1A

Published for Opposition January 10, 1984

Registration Number 1272653

Registration Date April 3, 1984

Owner (REGISTRANT) Merrill Lynch & Co., Inc. CORPORATION DELAWARE 4 World Financial Center New York NEW YORK 10080

Attorney of Record PATRICK ROMAIN

Type of Mark TRADEMARK

Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040430.

Renewal 1ST RENEWAL 20040430

Other Data THE NAMES "MERRILL" AND "LYNCH" REFER TO CHARLES E. MERRILL AND EDMUND CALVERT LYNCH, RESPECTIVELY, CO-FOUNDERS OF A SUCCESSOR COMPANY OF MERRILL LYNCH & CO., INC., NEITHER OF WHOM IS ALIVE TODAY.

Live/Dead Indicator LIVE

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Typed Drawing

Word Mark	1-800 MERRILL
Goods and Services	IC 036. US 100 101 102. G & S: financial consulting services. FIRST USE: 19850101. FIRST USE IN COMMERCE: 19850101
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75766942
Filing Date	August 3, 1999
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	April 18, 2000
Registration Number	2366321
Registration Date	July 11, 2000
Owner	(REGISTRANT) Merrill Lynch & Co., Inc. CORPORATION DELAWARE 222 Broadway New York NEW YORK 10038
Attorney of Record	Patrick Romain
Prior Registrations	1280908
Disclaimer	NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "1-800" APART FROM THE MARK AS SHOWN
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Live/Dead	LIVE



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Askmerrill.com

Word Mark ASKMERRILL.COM

Goods and Services IC 036. US 100 101 102. G & S: Financial Services, namely the provision of financial information including information concerning banking, investment, real estate brokerage, stocks, bonds, shares, securities and futures brokerage, insurance, mortgage, mutual funds, monetary exchange, financial management and investment services, asset management, contracts for difference (Options/derivatives), pension fund management, trust services, estate planning, financial planning, unit trusts, open-ended investment companies and investment trusts. FIRST USE: 19981102. FIRST USE IN COMMERCE: 19981102

Mark Drawing Code (5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Serial Number 76086533

Filing Date July 11, 2000

Current Filing Basis 1A

Original Filing Basis 1A

Published for Opposition June 5, 2001

Registration 2482166

Number

Registration Date August 28, 2001

Owner (REGISTRANT) Merrill Lynch & Co., Inc. CORPORATION DELAWARE 222 Broadway, 17th Floor New York NEW YORK 10038

Type of Mark SERVICE MARK

Register PRINCIPAL

Live/Dead Indicator LIVE

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Typed Drawing

Word Mark	MERRILL LYNCH DIRECT
Goods and Services	IC 036. US 100 101 102. G & S: financial services, in the nature of investment planning. FIRST USE: 19991231. FIRST USE IN COMMERCE: 19991231
Mark Drawing Code	(1) TYPED DRAWING
Serial Number	75131126
Filing Date	July 8, 1996
Current Filing Basis	1A
Original Filing Basis	1B
Published for Opposition	December 23, 1997
Registration Number	2465877
Registration Date	July 3, 2001
Owner	(REGISTRANT) Merrill Lynch & Co., Inc. CORPORATION DELAWARE 250 Vesey Street, 34th Floor New York NEW YORK 10281
Attorney of Record	PATRICK ROMAIN
Prior Registrations	1272653;1280908;AND OTHERS
Type of Mark	SERVICE MARK
Register	PRINCIPAL
Other Data	The mark does not identify a living individual.

**Live/Dead
Indicator**

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Typed Drawing

Word Mark MERRILL LYNCH ONLINE
Goods and Services IC 009. US 021 023 026 036 038. G & S: COMPUTER SOFTWARE FOR ACCESSING FINANCIAL AND ACCOUNT INFORMATION. FIRST USE: 19960430. FIRST USE IN COMMERCE: 19960430

IC 036. US 100 101 102. G & S: FINANCIAL SERVICES IN THE NATURE OF FINANCIAL CONSULTATION AND INVESTMENT ACCOUNT PLANNING AND FINANCIAL SERVICES IN THE NATURE OF FINANCIAL CONSULTATION AND INVESTMENT ACCOUNT PLANNING PROVIDED THROUGH A GLOBAL NETWORK. FIRST USE: 19960430. FIRST USE IN COMMERCE: 19960430

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75615711

Filing Date January 5, 1999

Current Filing Basis 1A

Original Filing Basis 1A

Published for Opposition March 7, 2000

Registration Number 2353416

Registration Date May 30, 2000

Owner (REGISTRANT) Merrill Lynch & Co., Inc. CORPORATION DELAWARE 250 Vesey Street World Financial Center New York NEW YORK 102811334

Attorney of Record PATRICK ROMAIN
Prior Registrations 1280908;1757209;1789640;AND OTHERS
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Type of Mark TRADEMARK. SERVICE MARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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