

ESTTA Tracking number: **ESTTA554817**

Filing date: **08/19/2013**

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	Monroe County Heritage Museum, Inc.
Granted to Date of previous extension	08/18/2013
Address	31 North Alabama Avenue Monroeville, AL 36460 UNITED STATES

Attorney information	Matthew I. Goforth Gordon, Dana, Knight & Gilmore, LLC 600 University Park Place Suite 100 Birmingham, AL 35209 UNITED STATES mgoforth@gattorney.com Phone:205-874-7974
----------------------	--

**Applicant Information**

Application No	85726786	Publication date	02/19/2013
Opposition Filing Date	08/19/2013	Opposition Period Ends	08/18/2013
Applicant	Lee, Nelle Harper P.O. Box 278 Monroeville, AL 36461 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 025. All goods and services in the class are opposed, namely: Clothing for men, women and children, namely T-shirts, hats, jackets
---

**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

**Mark Cited by Opposer as Basis for Opposition**

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	TO KILL A MOCKINGBIRD		

Goods/Services	CLOTHING FOR MEN, WOMEN AND CHILDREN, AND OTHER GIFT SHOP ITEMS SUCH AS COFFEE MUGS, HUGGERS, CUPS, WRITING PADS, VASES, SOAPS, FANS AND OTHER COLLECTIBLES
----------------	---

Attachments	Notice of Opposition (8.19.13).pdf(155744 bytes )
-------------	---

### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Matthew I. Goforth/
Name	Matthew I. Goforth
Date	08/19/2013

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

<b>Monroe County Heritage Museum</b>	)	
	)	
	)	<b>Re: Serial No. 85726786</b>
<b>Opposer,</b>	)	
	)	
v.	)	<b>OPPOSITION NO. _____</b>
	)	
<b>Nelle Harper Lee</b>	)	
	)	
<b>Applicant.</b>	)	

**NOTICE OF OPPOSITION**

In the matter of Application Serial No. **85726786** by Nelle Harper Lee (“Applicant”) for registration of the mark TO KILL A MOCKINGBIRD in Class 25 for “clothing for men, women and children, namely T-shirts, hats, jackets,” the Monroe County Heritage Museum, a county-owned 501(c)3 non-profit corporation, whose address is 31 North Alabama Avenue, Monroeville, AL 36460 (“Opposer”), believes it would be damaged by the registration of the mark covered by the referenced application and hereby opposes the registration of said mark on behalf of Opposer and its licensors.

The grounds for opposition are as follows:

1. Opposer believes that it would be damaged by the registration on the Principal Register of the mark TO KILL A MOCKINGBIRD that is the subject of Application Serial No. **85726786** (the “Application”).

2. The Application declares intent to use the mark TO KILL A MOCKINGBIRD on “clothing for men, women and children, namely T-shirts, hats, jackets.” Opposer has engaged in the sale of clothing and gift shop items (described in detail below) under the mark TO KILL A MOCKINGBIRD, and various stylizations and variations thereof, and also under various

mockingbird design marks, including, without limitation, as shown in the marks below (and referred to hereinafter as “Opposer’s Marks”):



Such trademark use on clothing and gift shop items by Opposer of Opposer’s Marks predates and has been continuous to the present since before the filing date of the Application. Such trademark use on clothing and gift shop items by Opposer has been continuous to the present and, upon information and belief, predates any prior use (if any) by Applicant of TO KILL A MOCKINGBIRD as a mark.

3. Opposer has used various stylizations and variations of Opposer’s Marks on and in connection with the sale of the following items which are virtually identical to the Class 25 goods that are the subject of the Application: clothing for men and women, namely, aprons, t-shirts and outerwear in the nature of fleece vests; clothing for children, namely, onesies for babies and t-shirts for toddlers and children. In addition to clothing items, Opposer has also engaged in the sale

of gift shop items in the nature of (by way of non-limiting examples): tote bags, hand towels, flour sack towels, soaps, wine bags, linen napkins, keychains, magnets, memo pads, ornaments, glass ware, plastic/acrylic tumbler glasses, seat cushions, car decals, bumper stickers, coasters, bookmarks, teacher's instructional guides, fans, postcard and beverage huggers.

4. At least one or more of Opposer's Marks have been used continuously and actively in commerce in connection with selling items of clothing and various gift shop items since at least as early as 1995.

5. The Application evidences that Applicant's goods and the mark applied for relate to and specifically target the precise market occupied by the Opposer's Marks.

6. Products bearing the Opposer's Marks are sold in Opposer's gift shop located at the Old Courthouse Museum in Monroeville, Alabama (located in Monroe County). The Opposer maintains and operates six historic sites in Monroe County, Alabama, in an effort to preserve the area's rich history, including the area's connection to the literacy legacy of both Truman Capote and the Applicant, Harper Lee. The Opposer provides the general public, local residents, tourists, scholars and school children with historical and educational opportunities that contribute greatly to the quality of life in the local region. The Old Courthouse Museum maintained and operated by Opposer (including Opposer's gift shop at the museum) serves as a tourist attraction for tourists from all of the country and from overseas as well. Opposer has advertised and promoted the clothing and gift shop goods bearing Opposer's Marks via Opposer's website, [www.tokillamockingbird.com](http://www.tokillamockingbird.com), and receives email and telephone orders for goods sold under the Opposer's Marks from throughout the United States and from foreign countries. One of the Opposer's primary advertising and fundraising events each year is the annual production of Christopher Sergel's play "To Kill a Mockinbird,"

which has been performed since 1991 at the Old Courthouse Museum maintained and operated by Opposer. The production has received international recognition, helping to put the town of Monroeville and the Opposer in the national and international spotlight.

7. Opposer has owned the domain name [www.tokillamockingbird.com](http://www.tokillamockingbird.com) and has operated its website at that url since at least as early as 1998. The website advertises the Opposer's museum, exhibits and gift shop. The website also has information telling potential purchasers how to contact the Opposer to place an order for the goods sold under Opposer's Marks.

8. As a result of the extensive and long-term use and promotion of Opposer's Marks by Opposer in connection with the sale of clothing and gift shop goods, Opposer's Marks have become and remain associated with Opposer in the relevant trade. Additionally, Opposer's Marks have become famous and strong as marks that are well recognized by purchasers in the relevant market as a unique linkage between Opposer's Marks and Opposer.

9. The use and registration (and either separately) of the mark TO KILL A MOCKINGBIRD by Applicant for use in connection with the goods described in the Application reduces and is likely to reduce the distinctiveness of Opposer's Marks, and reduces and is likely to reduce the capacity of Opposer's Marks to distinguish and identify Opposer and Opposer's goods in commerce. As a result, Applicant's registration and use (and either separately) of the TO KILL A MOCKINGBIRD mark in connection with the goods described in the Application dilutes and is likely to dilute Opposer's Marks.

10. In view of the strength of Opposer's Marks, the fact that the Applicant's goods and the mark applied for are related to and specifically target the precise market occupied by Opposer's Marks, and the fact that the mark applied for so resembles Opposer's Marks, Opposer

believes that use by the Applicant of the mark for which registration is sought is likely to cause confusion, or to cause mistake, or to deceive purchasers in that they are likely to believe that Applicant's goods are Opposer's goods or are in some way legitimately connected with, sponsored, or approved by Opposer. Therefore, registration of Applicant's mark would cause damage to Opposer, and registration is opposed pursuant to Section 13(a) of the Lanham Act (15 U.S.C. § 1063(a)) and on the basis of Section 2(d) of the Lanham Act (15 U.S.C. § 1052(d)).

11. In view of the strength and fame of Opposer's Marks and the fact that the parties' goods are related and are likely to be sold through similar channels of trade to the same class of purchasers, Opposer believes that both use and registration (and either of them separately) by the Applicant of the mark for which registration is sought would damage Opposer and Opposer's Marks, including as a result of dilution under Section 43(c) of the Lanham Act, and would diminish the distinctiveness, uniqueness, effectiveness and prestigious connotations of Opposer's Marks. Therefore, registration of Applicant's mark would cause damage to Opposer, and registration is opposed pursuant to Section 13(a) of the Lanham Act (15 U.S.C. § 1063(a)).

12. Applicant is a resident of Monroeville, Alabama, living not far from the location of Applicant's gift shop. In November 2008, Oscar winning actress Patricia Neal visited the Opposer's museum to perform Truman Capote's "A Christmas Memory." During that visit, the Applicant, Harper Lee, met with Patricia Neal after the performance outside the courtroom. Also during that same visit to Opposer's museum, the Applicant toured the exhibits at the museum (including the exhibit about Applicant herself). She saw the Opposer's gift shop, which is prominently located near the main entrance to the museum, where at least one or more of the Opposer's Marks were then being used in connection with the sale of clothing and gift shop items.

13. The Application includes a verification and declaration by Applicant (via her attorney of record's signature) that "he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive....", which declaration is required pursuant to 15 U.S.C. §1051(b); 37 C.F.R. §2.33(b)(2).

14. In light of Applicant's prior knowledge of Opposer's gift shop and Opposer's prior use of one or more of Opposer's Marks in connection with the sale of clothing and gift shop items, upon information and belief, Opposer asserts that Applicant's declaration pursuant to 15 U.S.C. Section 1051(b) and 37 C.F.R. §2.33(b)(2) is a knowingly false misrepresentation of fact and constitutes fraud on the Trademark Office, as an attempt to procure a trademark application to which Applicant is not entitled, as Applicant has (and had at the time of the making of the declaration by Applicant's attorney) actual knowledge of Opposer's preexisting rights in and to Opposer's Marks. Accordingly, any registration resulting from the Applicant's Application should be void for fraud on the office.

15. This Notice of Opposition is filed in a timely manner pursuant to 15 U.S.C. § 1063. Opposer has previously requested, and has been granted, Requests for Extension of Time for Filing Notice of Opposition, which extended the time in which to file this Notice of Opposition to August 18, 2013. Pursuant to 37 C.F.R. § 1.7 and TBMP § 209.02, because the expiration of the extension period fell on a Sunday, this Notice of Opposition is timely filed on the next succeeding day, Monday, August 19, 2013.



WHEREFORE, Opposer requests that the registration sought by the Applicant be refused and that this Opposition be sustained.

August 19, 2013  
Date

/Matthew I. Goforth/  
Matthew I. Goforth, Esq.  
Attorney for Opposer  
Monroe County Heritage Museum

**OF COUNSEL:**

Gordon, Dana, Knight & Gilmore, LLC  
600 University Park Place Suite 100  
Birmingham, AL 35209  
PHONE: 205-874-7974  
FAX: 205-776-6541  
EMAIL: mgoforth@gattorney.com

**CERTIFICATE OF SERVICE**

I hereby certify that I have this date served the foregoing Notice of Opposition regarding Application **85726786** for the mark TO KILL A MOCKINGBIRD, on the following:

ROBERT W. CLARIDA  
REITLER KAILAS & ROSENBLATT, LLC  
885 3RD AVE  
NEW YORK, NY 10022-4834

by deposit in First Class U.S. Mail to the address shown above, on this the 19<sup>th</sup> day of August, 2013.

August 19, 2013  
Date

/Matthew I. Goforth/  
Matthew I. Goforth, Esq.  
Attorney for Opposer  
Monroe County Heritage Museum

**CERTIFICATE OF SUBMISSION VIA ESTTA**

I hereby certify that foregoing Notice of Opposition regarding Application **85726786** for the mark TO KILL A MOCKINGBIRD, is being transmitted to the Trademark Trial and Appeal Board via the ESTTA system on August 19, 2013.

August 19, 2013

Date

/Matthew I. Goforth/

Matthew I. Goforth, Esq.

Attorney for Opposer

Monroe County Heritage Museum