

The Freecycle Network, Inc. v. Tim Oey
U.S. District Court
District of Arizona
06-CV-173-TUC-RCC
Exhibit H to Beal Declaration

ESTTA Tracking number: **ESTTA62464**

Filing date: **01/18/2006**

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	FreecycleSunnyvale		
Entity	Unincorporated association	Citizenship	California
Address	P.O. Box 1 Sunnyvale, CA 94807 UNITED STATES		

Attorney information	Ian N. Feinberg Mayer Brown Rowe & Maw LLP Two Palo Alto Square, Suite 300 3000 El Camino Real Palo Alto, CA 94306 UNITED STATES ifeinberg@mayerbrownrowe.com,eevans@mayerbrownrowe.com Phone:650-331-2055		
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Applicant Information

Application No	78475113	Publication date	01/17/2006
Opposition Filing Date	01/18/2006	Opposition Period Ends	02/16/2006
Applicant	THE FREECYCLE NETWORK 901 NORTH PERRY AVENUE TUCSON, AZ 85705 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 2003/05/01 First Use In Commerce: 2003/05/01 All goods and services in the class are opposed, namely: Providing a website which features advertisements for giving and receiving of free property of others on a global computer network

Attachments	Freecycle Not of Oppos Trademark.PDF (8 pages) TTAB_exhibits.pdf (29 pages)
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Signature	/Ian N. Feinberg/
Name	Ian N. Feinberg
Date	01/18/2006

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

In the matter of trademark application Serial No. 78/475,113
Filed: August 27, 2004
For the mark: FREECYCLE
Published in the Official Gazette on: January 17, 2006

FreecycleSunnyvale,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
The Freecycle Network,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Opposer, FreecycleSunnyvale, believes that it will be damaged by registration of the mark FREECYCLE as shown in the above-identified application, and hereby opposes the same pursuant to Section 13(a) of the Trademark Act of 1946, as amended (the "Lanham Act"), 15 U.S.C. § 1063 (a).

The grounds for opposition are as follows:

1. Opposer FreecycleSunnyvale is an unincorporated non-profit association with its principal place of business in Sunnyvale, California, which is located in the Northern District of California.
2. Upon information and belief, applicant The Freecycle Network is an Arizona non-profit corporation with its principal place of business in Tucson, Arizona.
3. Freecycling is the common or generic name for the practice of recycling by giving something away to another, often a person who is poor or disadvantaged in some way, for free. A person who freecycles is called a freecycler.

4. FreecycleSunnyvale promotes freecycling by providing support and advice to freecyclers who wish to create Internet fora for freecycling.

5. The Freecycle Network also promotes freecycling by providing support and advice to freecyclers who wish to create Internet fora for freecycling.

6. Freecycling is the common or generic name for the practice of recycling by giving something away to another, often a person who is poor or disadvantaged in some way, for free. A person who freecycles is called a freecycler. Freecycling has two principal advantages for society: (1) it reduces landfill by preventing or delaying the disposal of items unwanted by their current owners; and (2) it gives those same items to others for free, who do want them and may be unable to afford to purchase them.

7. Many freecyclers announce the availability of the items they wish to give away online by, for example, sending an email message to an email distribution list. Many of the email distribution lists freecyclers use are hosted by Yahoo! as part of its Yahoo! Groups online service.

8. Freecyclers who use the Yahoo! Groups online service to freecycle items enter into a contract with Yahoo! In exchange for their compliance with Yahoo!'s conditions, the freecyclers receive Yahoo!'s online services. These services allow freecyclers to reach many other freecyclers in their area by sending a single email message.

9. The Freecycle Network was founded in May 2003. The Freecycle Network helped popularize freecycling by assisting local freecycling groups, including FreecycleSunnyvale, in using Yahoo!'s online services to freecycle items.

10. FreecycleSunnyvale was founded in October 2003. It entered into a contractual relationship with Yahoo! and used Yahoo!'s online services to assist freecyclers in the Sunnyvale, California area freecycling items.

11. FreecycleSunnyvale used a Yahoo! Group with the name “freecyclesunnyvale.”

12. FreecycleSunnyvale initially received enthusiastic support from The Freecycle Network.

13. The Freecycle Network granted FreecycleSunnyvale a license in 2003 to use a mark derived from the mark covered by the present application. On or about October 9, 2003, after a member of FreecycleSunnyvale requested assistance in creating a graphic logo reading “FreecycleSunnyvale,” the Board Chair and Executive Director of The Freecycle Network granted permission to do so, provided that the logo was not used for commercial purposes. The text of the email granting permission reads: “Yeah, Sunnyvale! ... You can get the neutral logo from <http://www.freecycle.org> , just don't use it for commercial purposes or maybe Mark or Albert can help you to do your own fancy schmancy logo!”

14. Freecyclers and The Freecycle Network treated freecycling as the common or generic name for giving something away to another for free. In August 2004, The Freecycle Network’s home page included, among others, the references to freecycling:

(a) “Number of cities freecycling: 1,210”

(b) “Number of people freecycling: 406,949”

(c) “Have fun and keep on Freecyclin’!”

(d) “How does Freecycling work?”

(e) “Who can Freecycle?”

The Freecycle Network submitted a copy of the home page of its website, containing these uses of freecycle and freecycling in a generic sense, as a specimen to its pending application for registration of the mark FREECYCLE on the Principal Register on or about August 27, 2004. A copy of the specimen submitted is attached as Exhibit 1.

15. The Freecycle Network's use of the terms freecycle and freecycling in a generic sense is consistent with prevailing practice in the national media. Examination of publicly-accessible media sources reveals hundreds of newspaper and magazine articles that use freecycle

and freecycling to refer to the practice of recycling by giving something away to another for free.

Examples include:

- (a) “If a true packrat hordes [sic], a ‘freecycler’ can’t stand to see something that might be useful to someone go to waste, languishing unused in a musty garage, attic, bottom dresser-drawer or—worse yet—a landfill.” Katharine Mieszkowski, *From each according to his junk, to each according to her need*, Salon.com, Nov. 23, 2003, at <http://www.salon.com/tech/feature/2003/11/25/freecycle/print.html> (Attached as Exhibit 2);
- (b) “Freecyclers use Yahoo Groups as a free bulletin board, requiring registration only. Givers post their excess items on Yahoo and takers send an e-mail saying they will come and pick it up.” Mike Cassidy, *Freecycling Movement Gains Ground in Valley*, San Jose Mercury News, Jan. 27, 2004, at C1 (Attached as Exhibit 3);
- (c) “Dusty but new exercise equipment, a five-person hot tub, and enough white Ikea bookshelves to furnish a small college town have been posted online through a new group that practices freecycling, the giving away of useful but unwanted goods to keep them out of landfills and maybe help someone less fortunate in the process.” Tina Kelley, *One Sock, With Holes? I’ll Take It; Freecycling Brings Castoff Goods Back From the Bin*, The New York Times, March 16, 2004, at B1 (Attached as Exhibit 4);
- (d) “Known as ‘freecycling,’ the approach creates Web-based communities in cities across the country that allow members to post by e-mail a listing of items they are looking to unload. The catch? Everything much be given away free.” *Gambits and Gambles in the World of Technology*, The Wall Street Journal, May 6, 2004 (Attached as Exhibit 5); and
- (e) “And just how does one freecycle? . . . If there’s an object, or even a service, you want to give or receive, you post an e-mail, leave a contact and, if someone bites,

arrange for a pickup. The rules are simple: no politics or spam, and everything must be free.” Richard Jerome and Strawberry Saroyan, *Free For All, People*, May 10, 2004, at 195 (Attached as Exhibit 6).

16. Despite the generic nature of the terms freecycle and freecycling, The Freecycle Network filed the instant application for the registration of the mark FREECYCLE and a graphic logo using that mark on the Principal Register of trademarks on August 27, 2004.

17. In late 2004 or early 2005, The Freecycle Network altered the text of its website to remove some, but not all, uses of freecycle and freecycling in a generic sense. The Freecycle Network's website continues to include many hundreds of instances where freecycle and freecycling are used in the generic sense to refer to the practice of recycling by giving something away to another for free.

18. In January or February 2005, The Freecycle Network began to assert the right to exclusive use of the terms freecycle and freecycling.

19. The Freecycle Network has created usage guidelines for users of its services. These guidelines direct users to avoid using the terms freecycle and freecycling in a generic sense.

20. The Freecycle Network has not found an adequate substitute for the generic term freecycling. “[A] gifting or exchange-oriented [web]site” or “gifting or exchanging unwanted items with fellow users” have not achieved wide acceptance.

21. The Freecycle Network has replaced the simple question “How does Freecycling work?” on its home page with “How does it work?”

22. FreecycleSunnyvale will be damaged by the registration of the mark FREECYCLE and/or the graphic logo The Freecycle Network had licensed to FreecycleSunnyvale for non-commercial use on the Principal Register or the Supplemental Register because such registration would grant The Freecycle Network an improper monopoly over the use of the generic terms freecycle and freecycling and/or the logo licensed to FreecycleSunnyvale. The Freecycle Network has already asserted such an improper monopoly

by, among other things, inducing Yahoo! Inc., FreecycleSunnyvale's online service provider, to terminate FreecycleSunnyvale's Yahoo! Group online service by claiming that the group's name, freecyclesunnyvale, and/or its use of the logo licensed to it infringed The Freecycle Network's trademark rights.

WHEREFORE, Opposer, FreecycleSunnyvale, believes and alleges that freecycle is a generic term. In the alternative, FreecycleSunnyvale believes and alleges that The Freecycle Network has dedicated the terms freecycle and freecycling and/or the graphic logo The Freecycle Network had licensed to FreecycleSunnyvale for non-commercial use to the public domain. In the second alternative, FreecycleSunnyvale believes and alleges that The Freecycle Network has engaged in uncontrolled or naked licensing of the terms freecycle and freecycling and/or the graphic logo The Freecycle Network had licensed to FreecycleSunnyvale for non-commercial use and thereby abandoned any trademark rights it might otherwise have acquired.

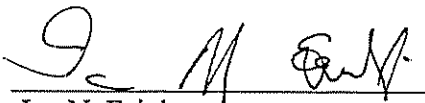
FreecycleSunnyvale therefore believes and alleges that Applicant's FREECYCLE is not registrable on the Principal Register or on the Supplemental Register.

Opposer requests that:

1. Judgment in the present opposition be entered in favor of the Opposer and against Applicant, with prejudice;
2. The present opposition be sustained; and
3. Registration on the application of Applicant for the trademark FREECYCLE, Serial No. 78/475,113, be rejected and refused.

Respectfully submitted,

FREECYCLESUNNYVALE

By: 

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