

TAB

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

In the Matter of Application Serial No. 76/155,723
Mark: KERMIT
Published: July 31, 2001
Opposer's Ref: HEN USA TC-01/06537



04-26-2002

U.S. Patent & TMO/TC/TM Mail Rcpt Dt. #56

-----X
THE JIM HENSON COMPANY, INC.,

Opposer,

Opposition No. _____

- against -

PEDRO TELLERIA SOPENA

Applicant.
-----X

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-2 PM 23
BOX 11AB
FEE 02

NOTICE OF OPPOSITION

Opposer, The Jim Henson Company, Inc., a New York corporation with a principal place of business at 1416 N. La Brea Avenue, Los Angeles, California 90028, believes that it would be damaged by the issuance of a registration for the mark KERMIT as applied for in Application Serial No. 76/155,723, and therefore opposes the same. As grounds for its opposition, Opposer, by its attorneys Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Opposer The Jim Henson Company is the world famous entertainment company founded by the late Jim Henson, and is the creator and owner of all rights in the "Muppet" family of puppet characters. Opposer is internationally renowned for its high quality television entertainment and motion pictures, which it and its predecessors have been producing for close to fifty years. In addition to its entertainment services, Opposer is actively engaged in, *inter alia*,

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operating websites and licensing of consumer goods bearing the likenesses of the MUPPET puppets and the names and trademarks associated therewith.

2. One of the earliest and best-loved of Opposer's regular cast of Muppet characters is the famous character KERMIT, who was created by Jim Henson in 1955. KERMIT was performed by Jim Henson until Jim's death in 1990 and has often been portrayed as Jim's alter-ego. KERMIT has played a leading role in virtually every program, series, film and website featuring the MUPPET puppets, and has been featured on hundreds of licensed products. KERMIT symbolizes Opposer and its good will. His image is the logo that appears on Opposer's letterhead, as well as the video trailer that appears on its entertainment products. Through KERMIT's widespread exposure to the public, his name and image are closely identified with Opposers and its entertainment products and services.

3. Since 1955, Opposer and its predecessors in interest have used and continue to use the name and visual image of the KERMIT character regularly as part of Muppets performances on such widely broadcast television series as Sesame Street, The Muppet Show, Muppets Tonight, and Jim Henson's Muppet Babies and in feature films such as The Muppet Movie, The Muppets Take Manhattan, The Great Muppet Caper and Muppets From Space. Opposer has also used the name and visual image of KERMIT as a trademark on its websites and a wide range of consumer goods including toys, games, figurines, clothing, greeting cards and other printed materials and food products, and for a variety of different promotions for third parties.

4. In addition to the rights of Opposer resulting from the aforementioned adoption and use of the name and image of KERMIT in the United States, and the public association thereof

with Opposer, Opposer owns the following U.S. trademark registrations:

MARK	REG. #	GOODS	DATE OF REG.
KERMIT THE FROG	1,117,341	Dolls	5/1/79
KERMIT THE FROG	1,177,453	Puppets	11/10/81
KERMIT	1,269,282	T-shirts, sweatshirts and jerseys	3/6/84
KERMIT (Stylized)	1,242,154	T-shirts, sweatshirts and jerseys	6/14/83
MUPPET PARODIES THE SINCEREST FORM OF FLATTERY (Stylized)	2,009,102	Posters and calendars, sweatshirts and T-shirts	10/15/96
KERMIT COLLECTION and Design	2,250,270	Telephones, watches, bookends, straws, mini-bell jars, musical figurines, key chains, ornaments, mugs, bowls, clothing, accessories	6/1/99

Attached as Exhibit A are copies of Opposer's aforementioned registrations. Reg. Nos.

1,117,341 and 1,177,453 have become incontestable. Opposer's common law and registered trademark rights in the name and visual image of KERMIT are hereafter collectively referred to as the "KERMIT Marks."

5. Opposer has invested a substantial amount of time, effort and money in promoting the KERMIT Marks. As a result, the KERMIT Marks have become distinctive of Opposer's goods and services and have come to represent enormous goodwill for Opposer.

6. On October 27, 2000, Applicant, Pedro Telleria Sopena, filed the intent-to-use application at issue to register the mark KERMIT for "communications services, namely, radio and television broadcasting services, telecommunication services in the nature of electronic

transmission of messages and data, electronic transmission of data and documents via computer terminals” in Class 38 (“Applicant’s Mark”). On information and belief, Applicant made no use of this mark on the aforementioned services prior to its filing date.

7. As the result of Opposer’s extensive ongoing use of the KERMIT Marks in the United States in motion pictures, on television and on a wide range of clothing and merchandise, Opposer’s KERMIT Marks had obtained widespread fame and notoriety in the United States prior to the filing date of Applicant’s application for Applicant’s Mark and prior to the date of Applicant’s first use of the Applicant’s Mark in the United States.

8. Applicant’s Mark is identical to Opposer’s KERMIT word mark, and has been and will be used on services that are identical or closely related to the services for which Opposer uses its KERMIT Marks. Based on the similarities of the marks and goods involved, the public is likely to mistakenly associate the goods sold by Applicant under the Applicant’s Mark with Opposer or with Opposer’s goods and services, or to believe that Applicant’s goods are sponsored, endorsed or licensed by Opposer, or that there is some relationship between Applicant and Opposer.

9. Upon information and belief, Applicant applied to register Applicant’s Mark with full knowledge of Opposer’s rights to the well-known KERMIT Marks and with full knowledge of Opposer’s existing federal trademark registrations for the KERMIT Marks.

10. For the above reasons, any use of the Applicant’s Mark by Applicant is likely to cause confusion, cause mistake or deceive the public, and cause the public to believe that the goods sold under the Applicant’s Mark emanate from or are otherwise sponsored by or endorsed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

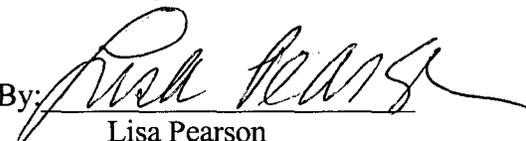
WHEREFORE, it is respectfully requested that this opposition be sustained and that the registration sought by Application Serial No. 76/155,723 be denied.

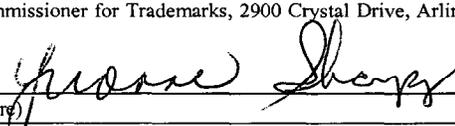
The Opposition fee in the amount of \$300.00 for one class is filed herewith. If for any reason this amount is insufficient, it is requested that Opposer's attorneys' Deposit Account No. 23-0825-0576900 be charged with any deficiency. This paper is filed in duplicate.

Dated: New York, New York
April 25, 2002

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 
Lisa Pearson
Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

"Express Mail" mailing label No. <u>EV097541465US</u> Date of Deposit <u>April 26, 2002</u>
I hereby certify that this paper or fee 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 Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.
<u>Yvonne Sharpy</u> (Printed name of person mailing paper or fee)
 (Signature)

LP:ysis



KERMIT THE FROG

Status: RENEWED **Date:** 04/22/1999

Gds/Svcs: Int'l. Cl.: 28 (U.S. Cl.: 22)
DOLLS
First Use: 09/14/1976 **In Commerce:** 09/14/1976

Reg. No.: 1,117,341 **Registered:** 05/01/1979 **Renewed:** 05/01/1999 T
Serial No.: 73-131105 **Filed:** 06/20/1977 **Published:** 02/06/1979

Disclaims: WITHOUT WAIVING ANY COMMON LAW RIGHTS WHICH APPLICANT MAY HAVE,
APPLICANT DISCLAIMS THE EXCLUSIVE RIGHT TO THE WORD "FROG" APART FROM THE
MARK AS A WHOLE.

Affidavits: 8 & 15

Corresp.: LAWRENCE E APOLZON
FROSS ZELNICK LEHRMAN & ZISSU PC
866 UNITED NATIONS PLZ
NEW YORK NY 10017

Owner: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69TH STREET
NEW YORK, NY 10021

Registrant: HENSON ASSOCIATES, INC. (NY CORP.)
NEW YORK, NY

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
1416 NORTH LABREA AVENUE, HOLLYWOOD, CA 90028

Assignor: CREDIT SUISSE FIRST BOSTON, AS AGENT LONDON BRANCH (DE CORP.)

Recorded: 04/16/2001 **Assigned:** 03/30/2001 **Reel/Fr.:** 2279/0827

Action: RELEASE OF SECURITY INTEREST AGREEMENT

Assignee: CREDIT SUISSE FIRST BOSTON, AS AGENT LONDON BRANCH (DE CORP.)
ONE CABOT SQUARE, LONDON, GBX E14 4QJ

Assignor: JIM HENSON COMPANY, INC., THE (NY CORP.)

Recorded: 02/09/2001 **Assigned:** 01/30/2001 **Reel/Fr.:** 2238/0001

Action: SECURITY AGREEMENT

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024

Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)

Recorded: 04/03/1998 **Assigned:** 10/07/1997 **Reel/Fr.:** 1712/0785

Action: CHANGE OF NAME

Assignee: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
117 EAST 69TH ST., NEW YORK, NY

Assignor: MUPPETS, INC. CHANGED ITS NAME TO JIM HENSON PRODUCTIONS, INC.
MERGED WITH AND INTO (NY CORP.)

Doc F-2 of Set #2

KERMIT THE FROG

Status: RENEWED Date: 11/10/2001
RENEWED

Gds/Svcs: Int'l. Cl.: 28 (U.S. Cl.: 22)
PUPPETS
First Use: 07/25/1978 In Commerce: 07/25/1978

Reg. No.: 1,177,453 Registered: 11/10/1981 Renewed: 11/10/2001 T
Serial No.: 73-264284 Filed: 06/02/1980 Published: 08/18/1981

Owns: 11,173,410

Disclaims: WITHOUT WAIVING ANY COMMON LAW RIGHTS WHICH APPLICANT MAY HAVE,
APPLICANT HEREBY DISCLAIMS THE EXCLUSIVE RIGHT TO THE WORD "FROG" APART FROM
THE MARK AS A WHOLE.

Affidavits: 8 & 15 04/22/1987

Corresp.: PETER SCHUBE
THE JIM HENSON COMPANY, INC.
1416 N LA BREA AVE
LOS ANGELES CA 90028

Owner: JIM HENSON COMPANY, INC., THE (NY CORP.)
1416 NORTH LA BREA AVENUE
LOS ANGELES, CA 90028

Registrant: HENSON ASSOCIATES, INC. (NY CORP.)
117 E. 69TH ST.
NEW YORK, NY 10021

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024

Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)

Recorded: 04/03/1998 Assigned: 10/07/1997 Reel/Fr.: 1712/0785

Action: CHANGE OF NAME

Assignee: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
117 EAST 69TH ST., NEW YORK, NY

Assignor: MUPPETS, INC. CHANGED ITS NAME TO JIM HENSON PRODUCTIONS, INC.
MERGED WITH AND INTO (NY CORP.)

Assignor: HENSON ASSOCIATES, INC. CHANGED ITS NAME TO (NY CORP.)

Recorded: 12/23/1991 Assigned: 11/25/1991 Reel/Fr.: 0836/0182

Action: MERGER AND CHANGE OF NAME JULY 2, 1991 NY

Doc F-3 of Set #2

KERMIT

Status: REGISTERED

Gds/Svcs: Int'l. Cl.: 25 (U.S. Cl.: 39)
ADULT'S AND CHILDREN'S T-SHIRTS, SWEATSHIRTS AND JERSEYS
First Use: 1980 In Commerce: 1980

Reg. No.: 1,269,282 Registered: 03/06/1984
Serial No.: 73-342414 Filed: 12/18/1981 Published: 12/13/1983

Owns: 1,117,341 AND OTHERS

Add. Info.: IN A DIFFERENT FORM JUL. 5, 1978 IN A DIFFERENT FORM JUL. 5, 1978
Affidavits: 8 ACCEPTED 04/27/1990

Corresp.: STEVEN M. WEINBERG
WEISS, DAWID, FROSS, ZELNICK & LEHRMAN
633 THIRD AVENUE
NEW YORK NY 10017-6703

Registrant: HENSON ASSOCIATES, INC. (NY CORP.)
117 E. 69TH ST.
NEW YORK, NY 10021

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024
Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
Recorded: 04/03/1998 Assigned: 10/07/1997 Reel/Fr.: 1712/0785
Action: CHANGE OF NAME

Assignee: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
117 EAST 69TH ST., NEW YORK, NY
Assignor: MUPPETS, INC. CHANGED ITS NAME TO JIM HENSON PRODUCTIONS, INC.
MERGED WITH AND INTO (NY CORP.)
Assignor: HENSON ASSOCIATES, INC. CHANGED ITS NAME TO (NY CORP.)
Recorded: 12/23/1991 Assigned: 11/25/1991 Reel/Fr.: 0836/0182
Action: MERGER AND CHANGE OF NAME JULY 2, 1991 NY

Kermit

KERMIT (Stylized)

Status: REGISTERED **Date:** 09/06/1989

Gds/Svcs: Int'l. Cl.: 25 (U.S. Cl.: 39)
ADULT'S AND CHILDREN'S SNEAKERS, T-SHIRTS, JERSEYS, SWEATSHIRTS AND BELTS
First Use: 07/01/1980 **In Commerce:** 07/01/1980

Reg. No.: 1,242,154 **Registered:** 06/14/1983
Serial No.: 73-342677 **Filed:** 12/21/1981 **Published:** 03/22/1983

Owns: 11,173,410, 11,774,530

Affidavits: 8 ACCEPTED 09/06/1989

Corresp.: STEVEN M. WEINBERG
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-6799

Registrant: HENSON ASSOCIATES, INC. (NY CORP.)
117 E. 69TH ST.
NEW YORK, NY 10021

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024

Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)

Recorded: 04/03/1998 **Assigned:** 10/07/1997 **Reel/Fr.:** 1712/0785

Action: CHANGE OF NAME

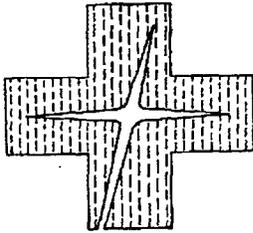
Assignee: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
117 EAST 69TH ST., NEW YORK, NY

Assignor: MUPPETS, INC. CHANGED ITS NAME TO JIM HENSON PRODUCTIONS, INC.
MERGED WITH AND INTO (NY CORP.)

Assignor: HENSON ASSOCIATES, INC. CHANGED ITS NAME TO (NY CORP.)

Recorded: 12/23/1991 **Assigned:** 11/25/1991 **Reel/Fr.:** 0836/0182

Action: MERGER AND CHANGE OF NAME JULY 2, 1991 NY



MUPPET PARODIES THE SINCEREST FORM OF FLATTERY and Design

Status: REGISTERED Date: 10/15/1996

Gds/Svcs: Int'l. Cl.: 16 (U.S. Cl.: 2, 5, 22, 23, 29, 37, 38, 50)
POSTERS AND CALENDARS
First Use: 03/1994 In Commerce: 03/1994

Int'l. Cl.: 25 (U.S. Cl.: 22, 39)
SWEATSHIRTS AND T-SHIRTS
First Use: 06/1994 In Commerce: 06/1994

Reg. No.: 2,009,102 Registered: 10/15/1996
Serial No.: 74-641291 Filed: 03/02/1995 Published: 10/03/1995

Owns: 948,503, 1,250,429, 1,837,376 AND OTHERS

Descript: THE STIPPLING IS FOR SHADING PURPOSES ONLY AND DOES NOT INDICATE
COLOR.

Add. Info.: FILED AS INTENT TO USE - ACTUAL USE ALLEGED.

Corresp.: LAWRENCE E. APOLZON
WEISS DAWID FROSS ZELNICK & LEHRMAN, PC
633 THIRD AVENUE
NEW YORK, NY 10017-6754

Registrant: JIM HENSON PRODUCTIONS, INC. (NY CORP.)
5358 MELROSE AVENUE
WEST OFFICE BLDG., 3RD FLOOR
HOLLYWOOD, CA 90038

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024

Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)

Recorded: 04/03/1998 Assigned: 10/07/1997 Reel/Fr.: 1712/0785

Action: CHANGE OF NAME



KERMIT COLLECTION and Design

Status: REGISTERED **Date:** 04/12/1999

Gds/Svcs: Int'l. Cl.: 9 (U.S. Cl.: 21, 23, 26, 36, 38)
TELEPHONES
First Use: 06/01/1996 **In Commerce:** 06/01/1996

Int'l. Cl.: 14 (U.S. Cl.: 2, 27, 28, 50)
WATCHES
First Use: 11/1998 **In Commerce:** 11/1998

Int'l. Cl.: 16 (U.S. Cl.: 2, 5, 22, 23, 29, 37, 38, 50)
BOOKENDS
First Use: 10/01/1997 **In Commerce:** 10/01/1997

Int'l. Cl.: 20 (U.S. Cl.: 2, 13, 22, 25, 32, 50)
DRINKING STRAWS; MINI BELL JARS, NAMELY, FIGURINES MADE OF RESIN DISPLAYED UNDER A GLASS COVER; MUSICAL MECHANICAL FIGURINES MADE OF RESIN; PLASTIC KEY CHAINS
First Use: 10/31/1997 **In Commerce:** 10/31/1997

Int'l. Cl.: 21 (U.S. Cl.: 2, 13, 23, 29, 30, 33, 40, 50)
GLASS ORNAMENTS; MUGS; BOWLS
First Use: 10/01/1997 **In Commerce:** 10/01/1997

Int'l. Cl.: 25 (U.S. Cl.: 22, 39)
CLOTHING AND ACCESSORIES, NAMELY, TIES, BOXER SHORTS, T-SHIRTS, HATS; BASEBALL CAPS, HEADWEAR
First Use: 03/1997 **In Commerce:** 03/1997

Int'l. Cl.: 28 (U.S. Cl.: 22, 23, 38, 50)
TOYS, NAMELY, JACK IN THE BOXES, DRUMS, MAGNETIC PAPER DOLLS; DOLLS; CHRISTMAS TREE ORNAMENTS; PUPPETS
First Use: 10/1997 **In Commerce:** 10/1997

Reg. No.: 2,250,270 **Registered:** 06/01/1999
Serial No.: 75-304032 **Filed:** 06/05/1997 **Published:** 08/25/1998

Owns: 1,117,341, 1,242,154, 1,269,282, 1,821,214, 1,913,310, 2,030,762 AND OTHERS

Corresp.: LAWRENCE E APOLZON
FROSS ZELNICK LEHRMAN & ZISSU PC
866 UNITED NATIONS PLAZA
NEW YORK NY 10017

Registrant: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST.
NEW YORK, NY 10024

Assignments:

Assignee: JIM HENSON COMPANY, INC., THE (NY CORP.)
117 EAST 69 ST., NEW YORK, NY 10024

Assignor: JIM HENSON PRODUCTIONS, INC. (NY CORP.)

Recorded: 04/03/1998 **Assigned:** 10/07/1997 **Reel/Fr.:** 1712/0785

Action: CHANGE OF NAME