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U.S. Patent & TMO/TM Mail Rpt. Dt. #40

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

In the matter of U.S. Trademark Application Serial No. 78/076565
Filed: July 31, 2001
Published for opposition: November 12, 2002
Extended Date for Filing of Opposition: March 12, 2003
Mark: FASHION DIVA^v

Mattel, Inc.,)
)
Opposer,)
)
v.)
)
Castlesprings Enterprises Ltd.)
)
Applicant.)
_____)

Opposition No.:

TRADEMARK TRIAL AND
APPEAL BOARD
03 MAR 25 AM 9:30

NOTICE OF OPPOSITION--FASHION DIVA

Mattel, Inc. ("Mattel"), a corporation organized and existing under the laws of the State of Delaware, believes it would be damaged by registration of the mark shown in Application Serial No. 78/076565 in U.S. Classes 22, 23, 38 and 50 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Applicant Castlesprings Enterprises Ltd. ("Castlesprings") seeks to register, in U.S. classes 22, 23, 38 and 50 the mark "FASHION DIVA" for use in commerce in connection with the sale of electronic dolls. Applicant's intent to use the mark in this manner is evidenced by its application for registration upon the Principal Register of the United States Patent and Trademark Office on or about July 31, 2001 and by the publication thereof in the November 12, 2002 issue of the Official Gazette.

2. Mattel is presently using the mark "DIVA STARZ" in connection with the sale of goods in the United States classes referenced above, as well as in International Class 28. Mattel has used the DIVA STARZ mark in interstate commerce continuously and without interruption since approximately October 2000. Mattel filed an application with this office for registration of the DIVA STARZ mark on October 10, 2000 (Serial No. 76/144216).

3. Mattel has invested a great deal of time, effort and money to promote the DIVA STARZ mark and products. Because of Mattel's extensive promotional activities involving the DIVA STARZ mark, and as a consequence of Mattel's fair and honorable dealings with its customers, the relevant consuming public has come to recognize products bearing the DIVA STARZ mark as connected with or offered by Mattel.

4. The DIVA STARZ mark is arbitrary and fanciful and thus inherently distinctive. The DIVA STARZ mark has become well known in the United States and around the world in connection with Mattel's DIVA STARZ products. These products include dolls, interactive dolls, poseable dolls, doll clothing, computer games and other accessories. Mattel has also used the marks DIVA PETZ, DIVA CRUIZER and FASHIONZ as part of its promotion of these DIVA STARZ products. A registration was granted for DIVA PETZ on December 17, 2002 (No. 2664621). An application for DIVA CRUIZER was filed on May 25, 2001, Serial No. 78/065791.

5. The FASHION DIVA mark is similar to DIVA STARZ, as well as the other marks Mattel uses to promote its DIVA STARZ products, in both sound and appearance. Registration of the mark in Application Serial No. 78/076565 should be refused pursuant to 15 U.S.C. § 1052(d), because it is likely to cause confusion with the DIVA STARZ mark previously used by Mattel.

6. If Castlesprings is permitted to use and register its FASHION DIVA mark for its goods or services, as specified in the application herein opposed, confusion resulting in damage and injury to Mattel and the public would be caused and would result by reason of the similarity between Castlesprings' FASHION DIVA mark and Mattel's DIVA STARZ mark. Persons familiar with Mattel's mark would be likely to conclude that goods or services offered by Castlesprings were affiliated, connected or associated with Mattel or sponsored or approved by Mattel. Furthermore, any defect, objection or fault found with Castlesprings' goods or services marketed using the FASHION DIVA mark would necessarily reflect upon and seriously injure the reputation which Mattel has carefully established through usage for its services and products merchandised under Mattel.

7. In addition, the use of the FASHION DIVA mark by Castlesprings is calculated to trade upon the enormous goodwill and reputation of Mattel. Castlesprings is thus attempting to dilute the distinctive quality of Mattel's DIVA STARZ mark by using a confusingly similar mark to advertise and sell its goods or services as though sponsored or endorsed by the Mattel.

8. Mattel has invested significant sums in developing, naming, labeling and promoting its DIVA STARZ mark, and desires to continue to so designate its products. If Castlesprings is granted the registration herein opposed, it would thereby

obtain at least a prima facie exclusive right to the use of its mark. Such registration would be a source of substantial damages and injuries to Mattel.

9. Mattel's mark has priority. Castlesprings has filed its application in July 2001 and makes no representation of having used the mark in commerce. By contrast, Mattel has continually used its mark in commerce since approximately October 2000.

WHEREFORE, Mattel prays that Application Serial No. 78/076565 be rejected, and that the mark therein sought for the goods specified in United States Classes 22, 23, 38 and 50 be denied and refused.

A duplicate copy of this Notice of Opposition--FASHION DIVA and the fee required by § 2.6(a)(17) are enclosed herewith.

DATED: March 12, 2003

Respectfully submitted,

By: John S. Purcell *JSP*

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CERTIFICATE OF EXPRESS MAILING

Express Mail No.: EV 096175275 US

Date of Deposit: March 12, 2003

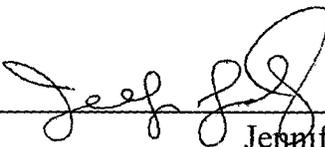
I hereby certify that the foregoing NOTICE OF OPPOSITION--FASHION DIVA is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to BOX TTAB FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.



Jennifer Leetz

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing NOTICE OF OPPOSITION--FASHION DIVA was served on the Applicant by mailing same, via first-class mail, postage prepaid, to the Applicant's counsel, **Jonathan S. Becker, ANJAR Co., 200 5th Avenue, Suite 1305, New York, New York 10010-3501** on this 12th day of March, 2003.



Jennifer Leetz