

TTAB

Attorney Docket No.: 923622-919410

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

In the matter of trademark Application Serial No. 78/165,521
For the mark: WISH CENTER And Design

MAKE A WISH FOUNDATION OF AMERICA)
)
 Opposer)
)
 v.)
)
 WISH HOLDINGS, LLC)
)
 Applicant)

Opposition No.: 91/158,850



01-26-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

ANSWER OF APPLICANT

1. Make-A-Wish is the world's largest and most well-known wish granting charity, with 75 chapter across the United States and its territories and a network of over 25,000 volunteers. Since its inception in 1980, Make-A-Wish has granted the wishes of over 100,000 children with life-threatening illnesses. The Make-A-Wish name and mark, as well as the services offered under that name and mark, are famous and well-known throughout the United States.

Answer to Paragraph 1:

Admitted that Opposer is a "wish granting charity", that Opposer is large, with multiple chapters, and has granted wishes of many children. Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the additional allegations of the paragraph and accordingly denies same. The characterizations "largest", "most well-known", "famous" and the like are denied. The legal conclusions are denied.

2. Among other federally registered and common law trademarks and service marks, Opposer is the owner of the following "Make-A-Wish" marks: MAKE-A-WISH FOUNDATION, Registration No. 1,266,624, registered on February 7, 1984 in International Class 42 for "charitable services relating to terminally ill children"; MAKE-A-WISH, Registration No. 1,570,208, registered on December 5, 1989 in International Class 36 for "charitable fundraising services relating to children with life threatening illnesses"; and MAKE-A-WISH, Registration No. 1,565,443, registered on November 14, 1989 in International Classes 6, 14, 16, 18, 20, 21, 25, 28 for various goods including jewelry, stationery, tote bags, coffee mugs, baseball caps, and t-shirts. Each of these registrations are incontestable pursuant to the provisions of Section 15 of the Lanham Act, 15 U.S.C. § 1065, meaning that the registrations are conclusive evidence of Opposer's exclusive right to use the marks in commerce or in connection with the goods and services stated in the registrations, as provided by Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b). Copies of those registrations are attached as Exhibits A, B, and C hereto. Opposer also owns numerous other federally registered trademarks for charitable fundraising services that incorporate the word "wish", such as SHARE THE POWER OF A WISH, ADOPT-A-WISH, WISHWORKS, THE EYES OF A WISH and WISHMAKER.

Answer to Paragraph 2:

Admitted that copies of registrations were attached. Admitted that registrations with those numbers and descriptions of goods issued and that records of the Trademark Office tend to show the status alleged. Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the additional allegations of the paragraph and accordingly denies same. The legal conclusions are denied.

3. Opposer is the owner of the mark MAKE-A-WISH with swirl-and-star design (the "MAKE-A-WISH STAR LOGO"), Registration No. 2,468,522, which was registered on July 10, 2001 in International Class 36 for "charitable fundraising services" and International Class 42 for "charitable services for gravely ill children in the nature of arranging activities and providing donations of goods and services for the children based on their express requests." A copy of that registration is attached as Exhibit D hereto.

Answer to Paragraph 3:

Admitted that a copy of the registration was attached. Admitted that a registration with that number and descriptions of goods issued and that records of the Trademark Office tend to

show the status alleged. The characterization MAKE-A-WISH STAR LOGO is denied, as there are thousands of marks with stars. Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the additional allegations of the paragraph and accordingly denies same. The legal conclusions are denied.

4. Opposer has used the MAKE-A-WISH STAR LOGO not only in connection with its charitable fundraising services and its provision of charitable services to children with life-threatening illnesses, but has also used the mark extensively on various promotional products, including shirts, caps, bags, pens, writing pads, pins, picture frames, CD cases, mugs, balloons, and golf balls.

Answer to Paragraph 4:

Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the allegations of the paragraph and accordingly denies same.

5. Opposer has been using the MAKE-A-WISH STAR LOGO in commerce consistently since at least as early as November 1999, long prior to Applicant's claimed first use of its WISH CENTER STAR LOGO of July 31, 2001.

Answer to Paragraph 5:

Applicant used its design at least as early as July 31, 2001. Applicant denies that the dates, if proven, are "long prior." Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the allegations of the paragraph and accordingly denies same.

6. Each year, Opposer widely advertises the services it offers throughout the United States under the MAKE-WISH FOUNDATION mark and the MAKE-A-WISH STAR LOGO, with an annual advertising placement value of between \$20 and 25 million through print broadcast, internet, and out-of-home advertisements. These advertisements

reach every state in the nation, as well as various United States territories. Since Opposer first began use of the MAKE-A-WISH STAR LOGO, the estimated total value of its advertising using that mark is at last \$75 million.

Answer to Paragraph 6:

Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the allegations of the paragraph and accordingly denies same.

7. As a result of Opposer's extensive advertising and exclusive use of the MAKE-A-WISH STAR LOGO, this mark has come to be widely recognized by the public as identifying Opposer exclusively and uniquely as the source of goods and services bearing the mark, and represents enormous goodwill of Opposer.

Answer to Paragraph 7:

Denied.

8. MAKE-A-WISH FOUNDATION and the MAKE-A-WISH STAR LOGO are two of the most distinctive and well-known service marks and trade names in the charitable services industry; are extraordinarily famous and well-known throughout the United States; and became famous and well-known prior to the date that Applicant acquired any rights in the WISH CENTER STAR LOGO.

Answer to Paragraph 8:

Denied.

9. Applicant's WISH CENTER STAR LOGO is confusingly similar to the MAKE-A-WISH STAR LOGO and dilutes the distinctive quality of the MAKE-A-WISH STAR LOGO, as both logos prominently featuring the word "wish" along with a swirl-and-star type design, and with both logos having a star dotting the letter "i" in the word "wish".

Answer to Paragraph 9:

Denied.

10. Both Opposer's services and Applicant's services are marketed to those in need of medical care: Applicant offers its services to adults and children aged 13 and over who are clinically obese, and Opposer offers its services to children between the ages of 2 ½ and 18 who are suffering from life-threatening medical conditions. Both Opposer and Applicant advertise their services on the internet, in newspapers, on national television and in hospitals/medical centers.

Answer to Paragraph 10:

Admitted that Applicant offers its services to adults and children aged 13 and over who are clinically obese and that Applicant advertises on the internet, in newspapers, and on television. Applicant is without sufficient information and after reasonable inquiry has been unable to obtain sufficient information to admit or deny the additional allegations of the paragraph and accordingly denies same. The legal conclusions are denied.

11. Upon information and belief, Applicant applied to register the WISH CENTER STAR LOGO with full knowledge of Opposer's rights to the MAKE-A-WISH STAR LOGO and with full knowledge of Opposer's existing federal trademark registration for the MAKE-A-WISH STAR LOGO. At a minimum, Applicant is deemed to have been on constructive notice of Opposer's prior rights by virtue of Opposer's existing federal trademark registration.

Answer to Paragraph 11:

Denied.

12. Applicant's application and the presumption of exclusivity that would come from a registration to Applicant of the WISH CENTER STAR LOGO sought to be registered is inconsistent with the prior rights of Opposer in the MAKE-A-WISH STAR LOGO.

Answer to Paragraph 12:

Denied.

13. The use by Applicant of its WISH CENTER STAR LOGO is likely to cause consumers or other members of the public, upon seeing applicant's mark used in connection with Applicant's goods and services, to believe that Applicant's goods and services are sponsored or authorized by Opposer, that Applicant received permission or authorization to use the mark, or that Applicant's goods and services are somehow affiliated or connected with Opposer.

Answer to Paragraph 13:

Denied.

14. Applicant's commercial use of the WISH CENTER STAR LOGO in connection with its goods and services is also likely to dilute the distinctive quality of Opposer's famous MAKE-A-WISH STAR LOGO to identify and distinguish Opposer exclusively as the source of goods and services provided in connection with the MAKE-A-WISH STAR LOGO.

Answer to Paragraph 14:

Denied.

15. By reason of the foregoing, Opposer is likely to be harmed by the registration of Application Serial No. 78/165,521 for the WISH CENTER STAR LOGO and Applicant is not entitled to a registration for the mark.

Answer to Paragraph 15:

Denied.

AFFIRMATIVE DEFENSES

1. There is no likelihood of confusion.
2. There is no actual or likely dilution.
3. The common term "wish" is descriptive as to Opposer's services.
4. The term "make a wish" is commonly used and descriptive, and accordingly, if protectable as a mark, is weak.
5. Opposer will not be injured by grant of a registration to Applicant.

Dated this 27th day of January 2004

By:



David C. Brezina
Barnes & Thornburg
1 North Wacker Drive
Suite 4400
Chicago, IL 60606
(312) 214-4802 (Voice)
(312) 759-5646 (Facsimile)