

TTAB

BOX TTAB/FEE

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



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MARS, INCORPORATED, :

Opposer, :

Opposition No. :

v. :

Mr. Goodcents Franchise Systems, Inc., :

Applicant. :

-----X

NOTICE OF OPPOSITION

This Notice of Opposition is brought in the matter of pending trademark application Serial No. 76/519,556 filed on June 4, 2003, by Mr. Goodcents Franchise Systems, Inc. (hereinafter "Applicant"), against registration of the mark PENNY 1989 KC and Design for "delivery of restaurant food to others" in International Class 39 and "restaurant services; namely, fast-food for eat-in retail service and carry-out purposes" in International Class 43. The application was published in the Official Gazette of January 13, 2004. Mars, Incorporated (hereinafter "Opposer"), whose address is 6885 Elm Street, McLean, Virginia 22101-3883, believes it will be damaged by the registration of such trademark and hereby opposes same.

The grounds for opposition are as follows:

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01 FC:6402 600.00 BA



07-09-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

1. Applicant has applied to register the character design mark (hereinafter sometimes referred to as “Applicant’s Mark”), which design consists of a character that is confusingly similar in appearance to numerous famous character trademarks owned by Opposer. The dominant features of Applicant’s Mark include the same elements as are present in Opposer’s character trademarks. Specifically, Applicant’s Mark consists of a round-shaped character having human features, including eyes, mouth, legs, hands with gloves, and feet with foot apparel, each of which are elements common to Opposer’s famous character trademarks. The published version of Applicant’s Mark is attached hereto at Exhibit 1.

2. Opposer is, and for many years has been, an internationally known manufacturer, distributor and seller of food products, including the famous M&M’s® brand candies and other confectionery products.

3. Long prior to the filing of the instant application by Applicant, Opposer has adopted and used, and continues to use, numerous trademarks depicting an oval or round-shaped character with human features, including eyes, mouth, hands with four fingers and gloves, legs, and feet with shoes (hereinafter sometimes referred to as “Opposer’s Trademarks” or “Character Trademarks”).

4. Opposer is using its Character Trademarks in interstate commerce, and has used its Character Trademarks in the form described in paragraph 3, in connection with the advertising and sale of its famous M&M’s® brand candies and other confectionery products, since at least as early as the 1960's.

5. In addition, Opposer and/or its licensees have offered various licensed items for sale or as premiums, such as toy dolls, candy dispensers, ornaments, ornamental lights, and clothing, among many other products, which represent these characters. In addition, Opposer's Trademarks appear prominently on Opposer's Internet website.

6. Opposer is the owner of the following United States Federal registrations, among many others, for its Character Trademarks, which consist of characters having human features, and which are incontestible and currently in full force and effect:

<u>REG. NO.</u>	<u>REG. DATE</u>	<u>GOODS</u>
1,567,387	November 21, 1989	candy
1,567,386	November 21, 1989	candy
983,429	May 7, 1974	candy
981,235	March 26, 1974	candy

Copies of each certificate of registration are attached hereto as Exhibit 2. A certified copy of each certificate of registration will be submitted during Opposer's testimony period.

7. Opposer has extensively advertised and promoted its Character Trademarks in television and print advertisements, as well as by displaying the characters on packaging and various other licensed, promotional and/or premium items. As a result of such advertising and promotion, Opposer's Character Trademarks have become strongly associated with Opposer and have become famous trademarks under U.S.C. § 1125 (c) of the Lanham Act.

8. Upon information and belief, Applicant is currently offering the services bearing Applicant's Mark to the general public, which comprises the same class of consumers who purchase goods and services bearing Opposer's Character Trademarks.

9. Applicant's Mark so resembles Opposer's Character Trademarks that there is a strong likelihood that confusion will result, causing the public to believe that there is some connection, sponsorship, affiliation or association between the source of Applicant's services and Opposer.

10. In addition, Opposer's Character Trademarks are famous trademarks and were so at the time Applicant filed its application. Applicant's Mark will cause dilution of the distinctive quality of Opposer's famous Character Trademarks.

11. Based on the foregoing, Opposer believes that it will be damaged by the registration of Applicant's Mark.

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

Please charge the \$600.00 opposition fee to Deposit Account No. 06-1205.

Dated: July 8, 2004

Respectfully submitted,

By: Erica R. Halstead

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Erica R. Halstead
FITZPATRICK, CELLA, HARPER
& SCINTO
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New York, New York 10112
(212) 218-2100

Attorneys for Opposer
Mars, Incorporated

Attachments (Exhibits 1-2)

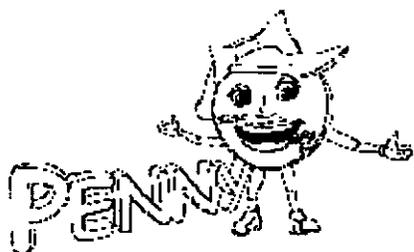
Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2004-07-08 14:39:04 ET

Serial Number: 76519556

Registration Number: (NOT AVAILABLE)

Mark



(words only): PENNY 1989 KC

Standard Character claim: No

Current Status: A request for an extension of time to file an opposition has been filed at the Trademark Trial and Appeal Board.

Date of Status: 2004-02-09

Filing Date: 2003-06-04

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 112

Attorney Assigned:
PERRY KIMBERLY B Employee Location

Current Location: 657 -Pre-Publication Final Review

Date In Location: 2004-03-08

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MR. GOODCENTS FRANCHISE SYSTEMS, INC.

Address:
MR. GOODCENTS FRANCHISE SYSTEMS, INC.

8997 Commerce Drive
DeSoto, KS 66018
United States
Legal Entity Type: Corporation
State or Country of Incorporation: Kansas

GOODS AND/OR SERVICES

DELIVERY OF RESTAURANT FOOD TO OTHERS

International Class: 039

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

RESTAURANT SERVICES; NAMELY, FAST-FOOD FOR EAT-IN RETAIL SERVICE AND CARRY-OUT PURPOSES

International Class: 043

First Use Date: (DATE NOT AVAILABLE)

First Use in Commerce Date: (DATE NOT AVAILABLE)

Basis: 1(b)

ADDITIONAL INFORMATION

Prior Registration Number(s):

2617340

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

2004-02-09 - Extension of time to oppose - Filed

2004-01-13 - Published for opposition

2003-12-24 - Notice of publication

2003-11-03 - Approved for Pub - Principal Register (Initial exam)

2003-10-23 - Case file assigned to examining attorney

CONTACT INFORMATION

Correspondent

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Fax Number: 816-474-9057

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

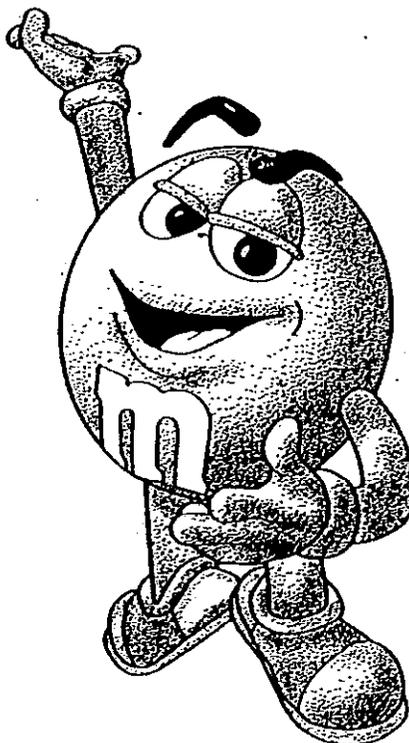
Amended

Reg. No. 1,567,387

Registered Nov 21, 1989

OG Date Nov. 14, 2000

**TRADEMARK
PRINCIPAL REGISTER**



MARS, INCORPORATED (DELAWARE
CORPORATION)
6885 ELM STREET
MCLEAN, VA 221013883

OWNER OF U.S. REG. NOS. 418,332,
1,272,035 AND OTHERS.

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).

FIRST USE 0-0-1987; IN COMMERCE
0-0-1987.

SER. NO. 73-753,739, FILED 9-23-1988.

*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Nov. 14, 2000.*

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

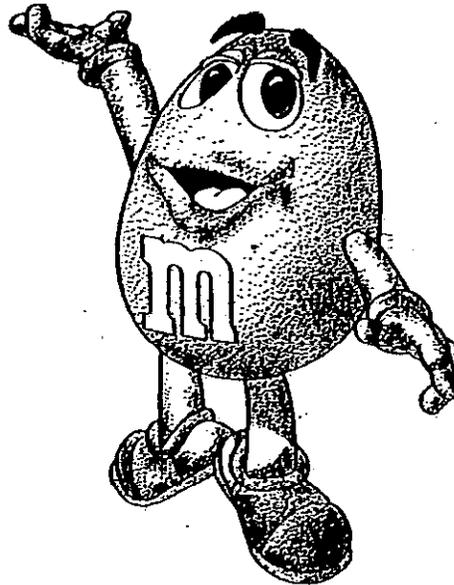
Amended

Reg. No. 1,567,386

Registered Nov. 21, 1989

OG Date Aug. 29, 2000

TRADEMARK
PRINCIPAL REGISTER



MARS, INCORPORATED (DELAWARE COR-
PORATION)
6885 ELM STREET
MCLEAN, VA 221013883

OWNER OF U.S. REG. NOS. 418,332,
1,272,035 AND OTHERS.

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).

FIRST USE 0-0-1987; IN COMMERCE
0-0-1987.

SER. NO. 73-753,685, FILED 9-23-1988.

*In testimony whereof I have hereunto set my hand and
caused the seal of The Patent and Trademark Office to
be affixed on Aug. 29, 2000.*

A handwritten signature in cursive script that reads "T. Todd Johnson".

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Amended

Reg. No. 983,429

Registered May 7, 1974

OG Date Oct. 26, 1999

TRADEMARK
PRINCIPAL REGISTER



MARS, INCORPORATED (DELAWARE
CORPORATION)
6885 ELM STREET
MCLEAN, VA 221013883

FOR: CANDY, IN CLASS 46 (INT. CL.
30).
FIRST USE 8-18-1972; IN COMMERCE
8-18-1972.

SER. NO. 72-433,766, FILED 8-25-1972.



*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 26, 1999.*

A handwritten signature in cursive script that reads "J. Todd Johnson".

COMMISSIONER OF PATENTS AND TRADEMARKS

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

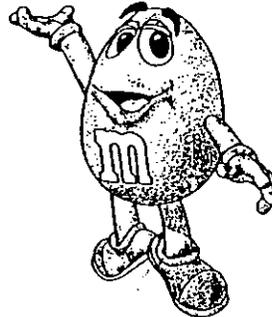
Amended

Reg. No. 981,235

Registered Mar. 26, 1974

OG Date Oct. 26, 1999

**TRADEMARK
PRINCIPAL REGISTER**



MARS, INCORPORATED (DELAWARE
CORPORATION)
6885 ELM STREET
MCLEAN, VA 221013883

FOR: CANDY, IN CLASS 46 (INT. CL.
30).

FIRST USE 8-18-1972; IN COMMERCE
8-18-1972.

SER. NO. 72-433,765, FILED 8-25-1972.



*In testimony whereof I have hereunto set my hand
and caused the seal of The Patent and Trademark
Office to be affixed on Oct. 26, 1999.*

A handwritten signature in black ink that reads 'L. Todd Johnson'.

COMMISSIONER OF PATENTS AND TRADEMARKS