

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

In the Matter of Application Serial Nos. 78/461,339 and 78/461,336
Filed: August 3, 2004
For the Mark: TABOO TUESDAY in International Classes 9 and 28
Published in the Official Gazette: August 16, 2005 at TM 155 and TM 234

TTAB

HASBRO, INC.

Opposer,

v.

WORLD WRESTLING
ENTERTAINMENT, INC.

Applicant.

Opposition No.

12/22/2005 GTHOHAS2 00000058 78461339

Q1 FC:6402

300.00 OP

Commissioner for Trademarks
Trademark Assistance Center
600 Dulany Street
Alexandria, VA 22313
ATTN.: BOX TTAB - FEE

12/22/2005 GTHOHAS2 00000059 78461336

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300.00 OP

NOTICE OF OPPOSITION

Hasbro, Inc. ("Opposer") believes that it will be damaged by the registration of the trademark covered by Application Serial Nos. 78/461,339 and 78/461,336 (the "Applications") filed on August 3, 2004, by World Wrestling Entertainment, Inc. (the "Applicant"), and hereby opposes the registration of the trademark.

Opposer is a Rhode Island corporation having its headquarters and its principal place of business at 1027 Newport Avenue, Pawtucket, Rhode Island 02862-1059.

Applicant is, upon information and belief, a corporation having a place of business at 1241 East Main Street, Stamford, Connecticut, 06902.



12-14-2005

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

Opposer has obtained the necessary extensions of time to file this Notice of Opposition and such Notice is timely made.

As grounds for opposition, it is alleged that:

1. As illustrated in the Official Gazette dated August 16, 2005 at pages TM 155 and TM 234, Applicant seeks to register and use the trademark "TABOO TUESDAY" for "electrical and scientific apparatus" in International Class 9 and "toys and sporting goods" in International Class 28, alleging an intent to use.

2. Opposer markets and sells the word-famous TABOO®, TABOO® For Kids, and Celebrity TABOO® board games (collectively, the "TABOO® games"). Opposer, via its predecessor in interest Milton Bradley Company, holds an exclusive license to the TABOO® trademark (the "Trademark"), which is registered on the Principal Register under U.S. Registration No. 1,606,501 in International Class 28 for "board games and parlor games." This registration is in full force and effect and is incontestable pursuant to 15 U.S.C. § 1065, as shown by the records of the U.S. Patent and Trademark Office. A print-out of the U.S. Trademark Electronic Search System ("TESS") record for the Trademark is attached hereto as Exhibit A.

3. Opposer or its predecessor in interest began using the TABOO® mark in commerce on June 1, 1988, and has continuously used the Trademark in the United States since then by marketing and selling the world-famous TABOO® games.

4. Opposer or its predecessor in interest began selling the TABOO® board game in commerce in the United States in 1988 and has continuously used the Trademark in United States commerce in substantially identical form in connection with the world-famous TABOO® games for almost 20 years.

5. No issue of priority exists between Opposer's Trademark and the alleged "TABOO TUESDAY" trademark. As set out in Exhibit A, Opposer's date of adoption and first use of the Trademark was in 1988. Opposer's date of adoption and first use precedes Applicant's, as the Applicant has sought registration based only on an intent to use.

6. Since adoption and first use of Opposer's Trademark, Opposer has marketed and is presently marketing its TABOO® games throughout the United States. Opposer's games are identified as originating from Opposer through the use of the Trademark on the packaging and playing equipment for the games. The TABOO® trademark is readily recognizable and closely associated in the mind of the public with the TABOO® games.

7. Since the adoption and first use of Opposer's TABOO® game and Trademark, Opposer has expended and continues to expend substantial time, money, and effort in promoting its Trademark to identify Opposer as the source of the game displaying this Trademark. From 1995 to 2004, Opposer sold almost five million TABOO® games, and in 2001 alone, spent over one million advertising and promoting the TABOO® games. As a result, Opposer believes and alleges that the public has come to recognize the TABOO® games as emanating from a single source.

8. The immense sales of the TABOO® games have been supported by extensive advertising and promotions, all of which typically feature the Trademark. By virtue of its efforts and expenditure of considerable sums for promotional activities and by virtue of the excellence of its goods, Opposer has gained a valuable reputation for its TABOO® games and the related Trademark and has developed valuable goodwill with respect to that Trademark.

9. By virtue of the widespread use by Opposer of the TABOO® trademark, Opposer is entitled to a broad scope of protection for the mark.

10. The "TABOO" portion of Applicant's alleged trademark is identical to a large, distinctive portion of Opposer's famous TABOO® trademark.

11. Applicant's alleged "TABOO TUESDAY" trademark is almost identical to Opposer's famous TABOO® trademark. Applicant intends to use its alleged "TABOO TUESDAY" trademark for numerous goods including but not limited to "video and computer game tapes, video and computer game discs, video and computer game cassettes, video and computer game cartridges, video and computer game CD-roms, video output game machines for use with televisions; video and computer game software" (International Class No. 9) and "Toy action figures and accessories therefor; cases for action figures; toy vehicles; board games; playing cards; toy spinning tops . . . [and] card games" (International Class No. 28) that are designed for the same consumers to whom Opposer markets its TABOO® games.

12. Registration of the alleged "TABOO TUESDAY" trademark will lead the public to incorrectly conclude that Applicant or its services displaying the alleged "TABOO TUESDAY" trademark have been authorized, sponsored or licensed by Opposer. Accordingly, issuance of any Registration to Applicant for the "TABOO TUESDAY" trademark is contrary to the provisions of 15 U.S.C. § 1052(a), and will result in damage to Opposer and the public.

13. The alleged "TABOO TUESDAY" trademark is sufficiently similar to the Opposer's Trademark in the word used and the commercial impression it creates so as to cause confusion, to cause mistake or to deceive the public as to the origin of Applicant's services bearing that trademark. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1052(d).

14. The alleged "TABOO TUESDAY" trademark is deceptively similar to and likely to dilute the distinctive quality of Opposer's famous mark and hamper its ability to

function as a source-identifying trademark. Therefore, registration of said trademark is prohibited by 15 U.S.C. § 1125(c)(1).

15. Registration of the alleged "TABOO TUESDAY" trademark would constitute prima facie evidence of the validity of such Registration, of Applicant's ownership of that trademark, and of Applicant's exclusive right to use said trademark pursuant to the provisions of 15 U.S.C. § 1057(b). Such registration would be a source of damage and injury to the Opposer and to the public and would be contrary to the principles of registration set out in 15 U.S.C. § 1051, et seq.

16. Registration of the alleged "TABOO TUESDAY" trademark would be incorrect and improper in view of the requirements of the Trademark Act of 1946, as amended, including specifically, but not limited to, the provisions of 15 U.S.C. §§ 1051, 1052 and 1127.

WHEREFORE, Opposer prays that this Opposition be sustained, and that registration to Applicant for the "TABOO TUESDAY" trademark in International Classes 9 and 28 be denied.

Please recognize Kim J. Landsman and Joanne N. Kwong, Patterson, Belknap, Webb & Tyler LLP, 1133 Avenue of the Americas, New York, NY 10036-6710, both members of the Bar of the State of New York, as the attorneys for the Opposer in this proceeding. All communications are to be directed to Joanne N. Kwong at the address identified above.

Opposer hereby files this Notice of Opposition in triplicate. Enclosed herewith are PBW&T Check Nos. 151897 and 151898 in the total amount of \$600.00 to cover the official statutory filing fee. If the actual fee is greater than the payment submitted or is inadvertently not enclosed or if any additional fee is due during the prosecution of this opposition, the TTAB and/or PTO is authorized to charge the underpayment to Deposit Account No. 16-0633.

Dated: December 14, 2005
New York, New York

Respectfully submitted,

PATTERSON, BELKNAP, WEBB & TYLER LLP

By 

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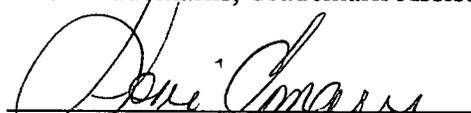
Attorneys for Opposer Hasbro, Inc.

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Date of Deposit: December 14, 2005

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Lorri Emanu



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Typed Drawing

Word Mark TABOO
Goods and Services IC 028. US 022. G & S: BOARD GAMES AND PARLOR GAMES. FIRST USE: 19880601. FIRST USE IN COMMERCE: 19880601
Mark Drawing Code (1) TYPED DRAWING
Design Search Code
Serial Number 73764705
Filing Date November 21, 1988
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition April 24, 1990
Registration Number 1606501
Registration Date July 17, 1990
Owner (REGISTRANT) HERSCH AND COMPANY COMPOSED OF BRIAN HERSCH, M.E. HERSCH, AND MITCHELL HERSCH, ALL CITIZENS OF THE USA COMPOSED OF BRIAN HERSCH, M.E. HERSCH, AND MITCHELL HERSCH, ALL CITIZENS OF THE USA PARTNERSHIP CALIFORNIA SUITE 1625 1900 AVENUE OF THE STARS LOS ANGELELS CALIFORNIA 90067
Assignment Recorded ASSIGNMENT RECORDED
Attorney of Record ANTHONY O. CORMIER
Type of Mark TRADEMARK
Register PRINCIPAL

Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20001223.
Renewal 1ST RENEWAL 20001223
Live/Dead Indicator LIVE

TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DICT	SEARCH OG	TOP	HELP	PREV LIST	CURR LIST
NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC					

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