

ESTTA Tracking number: **ESTTA106023**

Filing date: **10/25/2006**

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

**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Toho Co., Ltd.
Granted to Date of previous extension	10/29/2006
Address	2029 Century Park East Suite 1150 Los Angeles, CA 90067 UNITED STATES

Attorney information	Joan Kupersmith Larkin Seyfarth Shaw LLP 2029 Century Park East Suite 3300 Los Angeles, CA 90067 UNITED STATES jlarkin@seyfarth.com, jjacobs@seyfarth.com Phone:310 277-7200
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**Applicant Information**

Application No	78687453	Publication date	05/02/2006
Opposition Filing Date	10/25/2006	Opposition Period Ends	10/29/2006
Applicant	DACCO, Incorporated 741 Dacco Drive Cookeville, TN 38506 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 041. All goods and services in the class are opposed, namely: entertainment services, namely performing and competing in monster truck motor sports competitions, events, and exhibitions
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Attachments	Notice of Opposition.pdf ( 11 pages )(457113 bytes )
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Signature	/Jill A. Jacobs/
Name	Jill A. Jacobs
Date	10/25/2006

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

In the Matter of Application Serial No. 78/687,453  
Published in the Official Gazette of May 2, 2006

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TOHO CO., LTD., ) )  
 ) )  
Opposer, ) )  
 ) )  
vs. ) )  
DACCO, INCORPORATED, ) )  
 ) )  
Applicant. ) )  
\_\_\_\_\_)

Opposition No. \_\_\_\_\_

**CERTIFICATE OF ON-LINE FILING**

I hereby certify that on October 25, 2006, this paper is being filed on-line with the Trademark Trial and Appeal Board.

  
\_\_\_\_\_  
Eleanor Elko

**NOTICE OF OPPOSITION**

Opposer Toho Co., Ltd. ("Opposer") believes that it will be damaged by registration of the mark shown in Application Serial No. 78/687,453, and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is a corporation organized and existing under the laws of Japan, with its United States offices at 2029 Century Park East, Suite 1150, Los Angeles, California.
2. Upon information and belief, Applicant Dacco, Incorporated ("Applicant") is a Delaware corporation, with a place of business at 741 Dacco Drive, Cookeville, TN 38506.
3. On August 8, 2005, Applicant filed Application Serial No. 78/687,453 (the "Opposed Application") to register the mark "TORQZILLA" on the Principal Register for "entertainment services, namely performing and competing in monster truck motor sports competitions, events, and exhibitions" on the basis of Applicant's alleged bona fide intention to use the mark in commerce.
4. Since at least as early as 1956, a time long prior to the filing date of the Opposed Application, or any earlier date of actual use of the mark shown in the Opposed Application

upon which Applicant can rely, Opposer has been engaged in the production and distribution of a series of motion pictures starring a character called Godzilla (the "Godzilla Character"). The Godzilla Character is a large, two-footed green lizard-like/reptilian creature with fins on its back and the ability to breath fire, and has been represented visually in several depictions.

5. Numerous motion pictures featuring the Godzilla Character have been distributed in the United States. In 1998, Opposer's licensee, TriStar Pictures, Inc., released a GODZILLA motion picture in the United States and numerous foreign countries. The 1998 GODZILLA motion picture received extensive publicity in the United States and grossed many millions of dollars in the United States alone.

6. For many decades, Opposer and its various licensees have extensively advertised, promoted, and sold in the United States a wide variety of goods and services under and in connection with the GODZILLA mark, various derivative marks, and design marks featuring the Godzilla Character. The GODZILLA marks and the Godzilla Character are famous in the United States and became famous in the United States long before the filing date of the Opposer Application, or any earlier date of actual use of the mark shown in the Opposed Application upon which Applicant can rely.

7. Opposer owns the following United States Trademark Registrations for the mark GODZILLA:

- (a) Reg. No. 1,161,858 for the mark GODZILLA for comic books;
- (b) Reg. No. 1,163,122 for the mark GODZILLA for entertainment services in the nature of a continuing motion picture film series;
- (c) Reg. No. 1,174,377 for the mark GODZILLA for toys and games, namely, plastic model/hobby kit consisting primarily of molded plastic pieces used to assemble lizard-like monster with display base;

(d) Reg. No. 1,858,403 for the mark GODZILLA for cinematographic and motion picture films featuring entertainment; pre-recorded video tapes and cassettes featuring entertainment, and toys and games, namely, video and computer game programs; video and computer game software; electronic game programs; video and computer game cartridges; vinyl toy figures; plastic inert figures; and plastic action figures;

(e) Reg. No. 2,134,696 for the mark GODZILLA for toys and games, namely, painted toy figures; playsets with toy figures; toy vehicles; plush toys; and stuffed toys;

(f) Reg. No. 2,211,328 for the mark GODZILLA for comic books; greeting cards; clothing, namely, sweatshirts; t-shirts; shirts; and tops.

8. All of these registrations are valid and subsisting and belong to Opposer, and Registration Nos. 1,161,858, 1,163,122, 1,174,377, and 1,858,403 have become incontestable. Registration No. 2,211,328 has become incontestable as to “comic books”. Copies of Opposer's registrations are attached hereto as Exhibit 1 and are incorporated by reference herein as if set forth in full.

9. Upon information and belief, Applicant was aware of Opposer's famous “GODZILLA” marks when Applicant selected the “TORQZILLA” mark shown in the Opposed Application, and intended and intends to use the same in such a manner as to trade on the goodwill of the “GODZILLA” marks in the United States.

**FIRST CLAIM FOR RELIEF**  
**(Likelihood of Confusion With Registered Trademarks and Service Marks)**

10. Opposer repeats and realleges the allegations contained in preceding paragraphs 1-9, inclusive, as if fully set forth herein.

11. The mark shown in the Opposed Application so resembles Opposer's registered GODZILLA marks as to be likely, when used in connection with the services identified in the Opposed Application, to cause confusion, to cause mistake, or to deceive, and Applicant's mark

is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.

12. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration of the mark would give Applicant prima facie evidence of its ownership of, and exclusive right to use in commerce, a mark that is confusingly similar to Opposer's marks.

**SECOND CLAIM FOR RELIEF**  
**(Likelihood of Confusion With Previously-Used Marks)**

13. Opposer repeats and realleges the allegations in preceding paragraphs 1-9, inclusive, as if fully set forth herein.

14. The mark shown in the Opposed Application so resembles Opposer's GODZILLA Marks previously used in the United States and not abandoned as to be likely, when used in connection with the services identified in the Opposed Application, to cause confusion, to cause mistake, and to deceive, and Applicant's mark is thus unregistrable under § 2(d) of the United States Trademark Act, 15 U.S.C. § 1052(d), as amended.

15. Opposer will be damaged by registration of the mark shown in the Opposed Application because registration of the mark would give Applicant prima facie evidence of its ownership of, and exclusive right to use in commerce, a mark that is confusingly similar to Opposer's previously-used and not abandoned marks.

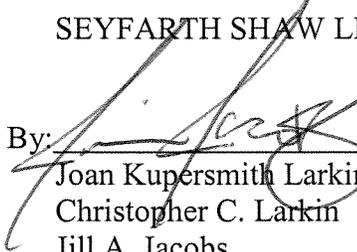
WHEREFORE, Opposer prays for the entry of judgment sustaining this opposition and refusing registration to Applicant of the mark shown in the Opposed Application. Please charge

the \$300 filing fee to Deposit Account No. 50-2291 and direct all correspondence in connection with this opposition to the undersigned.

Dated: October 25, 2006

Respectfully submitted,

SEYFARTH SHAW LLP

By: 

Joan Kupersmith Larkin

Christopher C. Larkin

Jill A. Jacobs

Attorneys for Opposer

TOHO CO., LTD.

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Los Angeles, California 90067-3063

Telephone: (310) 277-7200

Facsimile: (310) 201-5219

Int. Cl.: 16

Prior U.S. Cl.: 38

United States Patent and Trademark Office

Reg. No. 1,161,858  
Registered Jul. 21, 1981

TRADEMARK  
Principal Register

GODZILLA

Toho Co., Ltd. (Japan corporation)  
2049 Century Park East  
Los Angeles, Calif. 90067

~~For COMIC BOOKS AND COLORING SETS  
CONSISTING PRIMARILY OF BLACK AND  
WHITE PAGES WITH COLOR ILLUSTRATIONS, in  
CLASS 16 (U.S. Cl. 38).~~  
First use May 1, 1977; in commerce May 1, 1977.

Sec. No. 217,732, Filed May 30, 1979.

HENRY S. ZAK, Primary Examiner

JOHN M. WILKE, Examiner

Int. Cl.: 41

Prior U.S. Cl.: 107

United States Patent and Trademark Office

Reg. No. 1,163,122  
Registered Jul. 28, 1981

SERVICE MARK  
Principal Register

GODZILLA

Toho Co., Ltd. (Japan corporation)  
2049 Century Park East  
Los Angeles, Calif. 90067

For ENTERTAINMENT SERVICES IN THE  
NATURE OF A CONTINUING MOTION PIC-  
TURE FILM SERIES, in CLASS 41 (U.S. Cl. 107).  
First use 1956; in commerce 1956.

Sec. No. 217,718, filed May 30, 1979.

J. C. DEMOS, Deputy Director

GARY L. SHAFFER, Examiner



Int. Cls.: 9 and 28

Prior U.S. Cls.: 22 and 38

United States Patent and Trademark Office

Reg. No. 1,858,403

Registered Oct. 18, 1994

TRADEMARK  
PRINCIPAL REGISTER

GODZILLA

TOHO CO., LTD (JAPAN CORPORATION)  
2049 CENTURY PARK EAST  
LOS ANGELES, CA 90067

FOR: CINEMATOGRAPHIC AND MOTION  
PICTURE FILMS FEATURING ENTERTAIN-  
MENT; PRE-RECORDED VIDEO TAPES AND  
CASSETTES FEATURING ENTERTAINMENT,  
IN CLASS 9 (U.S. CL. 38).

FIRST USE 0-0-1956; IN COMMERCE  
1-0-1956.

FOR: TOYS AND GAMES; NAMELY, VIDEO  
AND COMPUTER GAME PROGRAMS; VIDEO  
AND COMPUTER GAME SOFTWARE; ELEC-  
TRONIC GAME PROGRAMS; VIDEO AND  
COMPUTER GAME CARTRIDGES, ~~discs and~~

~~TAPES; VINYL TOY FIGURES; FRICTION-  
POWERED ACTION TOYS, PLASTIC INERT  
FIGURES; PLASTIC ACTION FIGURES;  
BUBBLE BLOWING TOYS, INFLATABLE TOY  
FIGURES, AND INFLATABLE POP DOTS, IN~~  
CLASS 28 (U.S. CLS. 22 AND 38).

FIRST USE 0-0-1985; IN COMMERCE  
0-0-1985.

OWNER OF U.S. REG. NOS. 1,163,122, 1,174,377  
AND OTHERS.

SER. NO. 74-322,225, FILED 10-13-1992.

M. L. HERSHKOWITZ, EXAMINING ATTOR-  
NEY

Int. Cls.: 16 and 28

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

United States Patent and Trademark Office

Reg. No. 2,134,696

Registered Feb. 3, 1998

TRADEMARK  
PRINCIPAL REGISTER

GODZILLA

TOHO CO., LTD. (JAPAN CORPORATION)  
2049 CENTURY PARK EAST  
LOS ANGELES, CA 90067

FOR: ~~PAPER PLAIN MATS~~, IN CLASS 16  
(U.S. CLS. 2, 5, 22, 23, 25, 37, 38 AND 50).

FIRST USE: 6-1-1996; IN COMMERCE  
6-1-1996.

FOR: TOYS AND GAMES, NAMELY, ~~MANUALLY OPERATED ACTION TOYS; WIND UP TOYS; MANUALLY OPERATED ROBOT ACTION TOYS; GRABBING TOYS; PAINTED TOY FIGURES; MODEL BIRD FOR MAKING TOY MONSTERS; PLAYSETS WITH TOY FIGURES; TOY VEHICLES; TOY WEAPONS; PLASTIC TOYS~~

~~THE TOY CARRY CASES FOR CHILDREN; PLUSH TOYS; MANIPULATIVE TOYS; STUFFED TOYS; MECHANICAL ACTION TOYS; AND HOBBY CRAFT KITS OF WOOD OR PLASTIC FOR ASSEMBLING INTO TOYS.~~  
IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

FIRST USE: 12-0-1993; IN COMMERCE  
12-0-1993.

OWNER OF U.S. REG. NOS. 1,163,122,  
1,174,377, AND OTHERS.

SN 74-322,029; FILED 10-13-1992

M. L. HERSHKOWITZ, EXAMINING ATTORNEY

Int. Cls.: 16 and 25

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, 39, and 50

United States Patent and Trademark Office

Reg. No. 2,211,328

Registered Dec. 15, 1998

TRADEMARK  
PRINCIPAL REGISTER

GODZILLA

TOHO CO., LTD. (JAPAN CORPORATION)  
2049 CENTURY PARK EAST  
LOS ANGELES, CA 90067

FOR: ~~PAPER BAGS, PAPER BANNERS, COMIC BOOKS, COLORING AND CHILDRENS EDUCATIONAL PICTURE BOOKS, CALENDARS, TRADING CARDS, GREETING, NOTE AND PLANK CARDS; PEN AND PENCIL CASES, BOOK COVERS, CRATONS, DECALS; PAPER NAPKINS, PEN AND PENCIL HOLDERS, RUBBER STAMPS, PENS AND PENCILS; ERASERS, NOTEBOOKS, PAPER PARTY HATS, POSTERS, WRAPPING PAPER, NOTE BIDS, SERIES OF FICTION BOOKS FOR ENTERTAINMENT AND AMUSEMENT, FICTION MAGAZINES FOR ENTERTAINMENT AND AMUSEMENT, IN CLASS 16 (U.S. CLS. 2, 5, 22, 3, 29, 37, 38 AND 50).~~

FIRST USE 8-0-1987; IN COMMERCE -0-1987.

FOR: CLOTHING, NAMELY, ~~HATS, SWEAT SHIRTS; GYM SHORTS; MASQUERADE AND HALLOWEEN COSTUMES; T-SHIRTS; HINT SHIRTS; PJAMAMAS; SLEEPWEAR, RAIN COATS, RAINWEAR, FOOTWEAR, HEAD WEAR, NECKWEAR, HOSIERY AND SOCKS; PANTS AND SLACKS, SHORTS; SHIRTS; TOPS; PLAYSUITS, COATS; BRIEFS, UNDERPANTS; AND BOXER SHORTS, IN CLASS 25 (U.S. CLS. 22 AND 39).~~

FIRST USE 12-0-1994; IN COMMERCE 12-0-1994.

OWNER OF U.S. REG. NOS. 1,163,122, 1,174,377, AND OTHERS.

SN 74-525,545, FILED 5-17-1994.

MELVIN AXILBUND, EXAMINING ATTORNEY