

ESTTA Tracking number: **ESTTA340514**

Filing date: **04/02/2010**

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	Mark Rice		
Entity	Individual	Citizenship	UNITED STATES
Address	785 Olde Clubs Drive Alpharetta, GA 30022 UNITED STATES		

Correspondence information	Mark Rice 785 Olde Clubs Drive Alpharetta, GA 30022 UNITED STATES markrice@bellsouth.net Phone:770-645-5545		
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Applicant Information

Application No	77893539	Publication date	03/30/2010
Opposition Filing Date	04/02/2010	Opposition Period Ends	04/29/2010
Applicant	Desert Sky Graphics, Inc. 34522 North Scottsdale Road, D-8 #486 Scottsdale, AZ 85266 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2009/06/12 First Use In Commerce: 2009/06/12 All goods and services in the class are opposed, namely: Three-dimensional plastic molded characters in the form of toy figures prepackaged in translucent plastic acorn capsules for sale from non-electric bulk capsule vending machines upon the rotation of a coin slot handle
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Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Federal Trademark Act of 1946 (15 USC 1051 et seq.), Lanham Act.

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	2113925	Application Date	09/26/1996
Registration Date	11/18/1997	Foreign Priority	NONE

		Date	
Word Mark	ZOO MANIA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1996/06/01 First Use In Commerce: 1996/06/01 equipment sold as a unit for playing card games		

Related Proceedings	In The United States District Court For The Northern District Of Georgia Atlanta Division, File No. 09-CV-3254-MHS, Mark Rice v. Desert Sky Graphics Inc. et al, etc...
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Attachments	001.pdf (1 page)(47013 bytes) 002.pdf (1 page)(70958 bytes) 003.pdf (1 page)(65893 bytes) 004.pdf (1 page)(69369 bytes) 005.pdf (1 page)(70984 bytes) 006.pdf (1 page)(63724 bytes) 007.pdf (1 page)(74770 bytes) 008.pdf (1 page)(69737 bytes) 009.pdf (1 page)(66769 bytes) 010.pdf (1 page)(68576 bytes) 011.pdf (1 page)(26044 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mark Rice/
Name	Mark Rice
Date	04/02/2010

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

In the matter of trademark application Serial No. 77-893,539

For the mark: ZOO MANTA

Published in the Official Gazette on March 30, 2010.

MARK RICE

Opposer

v.

Desert Sky Graphics, Inc.

Applicant

NOTICE OF OPPOSITION

Mark Rice, an individual having his principal place of business at 785 Olde Clubs Drive, Alpharetta, Georgia 30022 ("Rice" or "Opposer"), believes that he will be damaged by Desert Sky Graphics Inc.'s ("Desert Sky" or "Applicant") registration of the mark shown in the above identified application, and hereby opposes the same.

As grounds for opposition, Opposer alleges:

1. On November 20, 2009 Mark Rice filed a civil action against Desert Sky in The United States District Court For The Northern District Of Georgia Atlanta Division, file number 09-CV-3254-MHS, an action for infringement of rights granted under the Federal Trademark Act of 1946 (15 USC 1051 et seq.) surrounding Rice's Federal Trademark ZOO MANIA. Mark Rice, the "opposer" was granted a Federal Registration No. 2,113,925 for the trademark "ZOO MANIA®" on November 18, 1997. The registration to date is valid, subsisting and un-canceled. Said trademark, "ZOO MANIA®" was classified under classification 028, otherwise known as "games and playthings". Products carrying the trade name "ZOO MANIA®" have been sold and distributed nationwide by Rice.

2. Opposer Rice has used and continues to use in interstate commerce and is and has been at all times pertinent hereto the owner of all right, title, and interest in and to the mark ZOO MANIA ("Opposer's Mark"), for and in connection with "games and playthings", in International Class 28 ("Opposer's Services"). Rice's ownership of Federal Registration No. 2,113,925 has become incontestable. Opposer Rice has used his Mark Zoo Mania for and in connection with Rice's Services in interstate commerce in and throughout the United States continuously and extensively

since at least as early as 1996.

3. As a result of the long, widespread, and extensive use by Opposer Rice's of his Mark Zoo Mania, Rice's Mark identifies and distinguishes Rice's Services and Rice's Goods from the goods, services, and businesses of others, symbolizes the goodwill of Rice's business, and is well known. As a result, Rice's Mark is of great value to Rice in connection with the offering of Rice's Services and Rice's Goods.

4. Upon information and belief, Applicant's Goods and Rice's Goods bearing the Zoo Mania mark are and may be offered through the same, essentially the same, or related channels of trade, to the same, substantially the same, or related classes of purchasers.

5. Applicant's Mark is identical to Rice's Mark, sharing an identical spelling, identical pronunciation, identical appearance, and identical meaning. Upon information and belief, Applicant's Mark, when used in connection with Applicant's Goods, is likely to cause confusion, or to cause mistake, or to deceive with respect to the source or origin or Applicant's Goods, with respect to the source or origin of Applicant's Goods, with respect to Rice's sponsorship thereof or connection or affiliation therewith, and/or in other ways.

6. As a result of long, widespread, and extensive use by Rice of Rice's Mark Zoo Mania in and throughout the United States, Rice's Mark has acquired a significant degree of fame amongst members of the public and has become a famous mark, as that term is used in Section 43(c) of the Lanham Act, 15 U.S.C. 1125(c). Upon information and belief, Applicant's Mark will cause dilution of the distinctive quality of Rice's Mark.

7. According to the application to register Zoo Mania by Desert Sky, on or about 06/12/2009 Desert Sky may have begun to manufacture, distribute, license and/or sell in interstate commerce toy figures under the exact name to that of Rice's, "ZOO MANIA". Henceforth, Applicant Desert Sky has made **four (4)**¹ attempts to register the name "ZOO MANIA" with the United States Patent and Trademark Office (hereinafter the "USPTO").

8. To fully understand the full extent of Applicant Desert Sky's deception, the USPTO only has to view their multitude of filings. Desert Sky's own words as submitted to the USPTO indict them as applying for a Mark that would result in consumer confusion with Rice's trademark.

¹ At the time of this application on 12/15/2009, Desert Sky had already filed two (2) applications for the trade name Zoo Mania with the United States Patent and Trademark Office. On February 19, 2010, Defendants filed a fourth (4th) application.

9. Desert Sky has launched and licensed toy figures in the same industry that have the “identical mark”, “identical sound”, “identical appearance”, and “identical meaning” as Rice’s well established and branded trademark “ZOO MANIA”. Desert Sky’s first attempt to register “ZOO MANIA” to ride the coattails of what Rice had already established in the toy industry nationwide via major retailers was their application with the USPTO on May 13, 2009, serial number 77736395. After receiving an USPTO notice of refusal on August 11, 2009 due to likelihood of confusion with Rice’s trademark “ZOO MANIA”, Applicant Desert Sky responded with a long winded pleading that their items were **Toy Figures** and deserved trademark protection in what they claimed were goods not found “within the same trade channels” as Rice’s.

10. Realizing potential problems with an attempt to circumvent the laws applying to trademark protection and an obvious knowledge of Rice’s trademark “ZOO MANIA”, Desert Sky filed a second trademark application with the USPTO on October 2, 2009, serial number 77840473 and placed additional lettering on the Mark, with the Mark reading DSG ZOO MANIA.

11. On November 20, 2009, Rice sued Desert Sky for trademark infringement after receiving no response back from a November cease and

desist letter sent to Desert Sky's listed address for service. Two (2) weeks later after Desert Sky received the Complaint, on December 15, 2009, Desert Sky's vice president, Lauri Logue quickly submitted a "request for express abandonment" to the USPTO for the first application for "ZOO MANIA" .

12. Desert Sky clearly established in their second application for DSG ZOO MANIA, it was for **Toy Figures** , and this too was abandoned on January 4, 2010 due to the "likelihood of confusion" as expressed by the USPTO.

13. In the midst of a trademark infringement action by Rice, Desert Sky decided to change the terminology for the Mark Zoo Mania by submitting this third application with the USPTO that defined the goods, not as **Toy Figures** , but now defined as **"Three dimensional plastic molded characters prepackaged in translucent plastic acorn capsules for sale from non-electric bulk capsule vending machines upon the rotation of a coin slot handle"** .

14. Desert Sky specifically states in this third application for "ZOO MANIA" after Rice had filed his Complaint for Trademark Infringement, that they (Desert Sky), as the applicant, first used the Mark in

commerce as early as June 12, 2009 . After the USPTO cites refusal for this third application based on the same reasoning as application one and two, “Likelihood of Confusion” , Desert Sky responds:

- a. “The Applicant (Desert Sky) provides prizes² (ZOO MANIA) for hand-cranked bulk vending machines” .
- b. “The Applicant (Desert Sky) sells three-dimensional plastic characters³ (ZOO MANIA) that are prepackages (sic) in translucent capsules” .
- c. “The Applicant (Desert Sky) sells prizes (ZOO MANIA) prepackaged in acorn capsules for hand-cranked bulk vending machines” .
- d. “The Applicant (Desert Sky) sells products (ZOO MANIA) only to vending machine operators” .
- e. “The Applicants (Desert Sky) products (ZOO MANIA) are typically sold for one, two, three, or four quarters” .
- f. “The Applicant (Desert Sky) sells it products (ZOO MANIA) for a dollar or less from hand-cranked bulk vending machines” .
- g. “The Applicants (Desert Sky) good (sic) (ZOO MANIA) are purchased completely and totally by impulse upon the viewing of the possible prizes displayed on the bulk vending machine” .
- h. “The Applicant (Desert Sky) already owns Jungle Mania and Sea Mania and seeks only to add ZOO MANIA to its family” .

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² Desert Sky changes tactics and refers to all Zoo Mania products they manufacture, sell, license and distribute as prizes, thus avoiding the term Toy Figure which is considered related markets as deemed by the USPTO.

³ Desert Sky flips flops back and forth calling their Zoo Mania toy figures “prizes” and then “three dimensional plastic characters to avoid the terminology Toy Figure.

15. Desert Sky states that irregardless of the work and efforts that Rice has put forth in building the brand ZOO MANIA in the toy industry, they admit to the USPTO their desire to claim ownership of Zoo Mania to add to their family of products within the toy industry.

16. Applicant Desert Sky removes the references to **Toy Figure** , even though that is exactly what they desire to engage in, selling little 1 inch and 2 inch toy figures nationwide that carry the name Zoo Mania that infringe upon Rice's trademark in the toy industry.

17. On February 19, 2010, Desert Sky proceeded with submitting their fourth application to the USPTO for trademark ZOOMANIA, serial number 77939625 . The difference? They remove the space between Zoo and Mania to create one word instead of two. Here, the applicant, Desert Sky states that they themselves have used the Mark in commerce at least as early as 01/22/2009 . Desert Sky even submit's a specimen attached to the application that depicts their product bearing the name of Rice's trademark "ZOO MANIA". It does not matter that Desert Sky places a DSG in front of Zoo Mania, or that they remove the space between the words Zoo and Mania to make one word, Zoomania...in every instance, Desert Sky continues to infringe upon Rice's trademark by finding every way possible

to use Zoo Mania.

18. Despite Rice's written demand that Desert Sky discontinue use of the imitation of Rice's trademark "ZOO MANIA", Desert Sky has refused to comply with this request; at present, Desert Sky continues to use the imitation of Rice's trademark in the marketing and licensing of playthings via Desert Sky's continual manufacturing, selling, licensing and marketing toy figures bearing the Plaintiff's mark "ZOO MANIA®".

19. Desert Sky has most recently engaged in the unauthorized licensing of the Mark "ZOO MANIA" to third parties with false and misleading statements that suggest they own the rights to the "Zoo Mania" Mark. Said licensing agreements involve a variety of products; plush animals, clothing, and other products not yet identified. As evidenced by its licensing agreements with third parties for the use of "Zoo Mania", Desert Sky has used and continue to use Rice's "Zoo Mania" Mark with the specific intent of exploiting the good will associated with Plaintiff's "Zoo Mania" Mark and causing consumer confusion.

20. In filing its third application for "Zoo Mania" and subsequently the fourth application, Desert Sky falsely certified to the USPTO that they

believe “applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.”

21. Desert Sky knew the statements made to the United States Patent and Trademark Office were false at the time made. As evidenced by its fraudulent statements made in an attempt to obtain a Federal Trademark registration for “Zoo Mania” in the immediate aftermath of receiving Rice’s cease and desist letter, Desert Sky has used and continues to use Rice’s “Zoo Mania” Mark persistently with the specific intent of exploiting the good will associated with Plaintiff’s “Zoo Mania” Mark and causing consumer confusion.

WHEREFORE, Opposer Rice respectfully prays that a judgment be entered canceling the application serial number 77893539, of “ZOO MANIA” in International Class 28, and that this Opposition Petition be

sustained in favor of Opposer Rice.

This 2nd day of April, 2010.

Respectfully submitted,

/Mark Rice/

Mark Rice
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