

ESTTA Tracking number: **ESTTA340934**

Filing date: **04/06/2010**

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	Miss World Limited
Granted to Date of previous extension	04/07/2010
Address	Pier Road St. Helier, Jersey, UNITED KINGDOM

Attorney information	Richard J. Groos Fulbright & Jaworski L.L.P. 600 Congress Avenue Suite 2400 Austin, TX 78701 UNITED STATES aotrademark@fulbright.com, rgroos@fulbright.com, acallahan@fulbright.com, klambert@fulbright.com, kpfertner@fulbright.com Phone:512.474.5201
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Applicant Information

Application No	77789604	Publication date	12/08/2009
Opposition Filing Date	04/06/2010	Opposition Period Ends	04/07/2010
Applicant	Drakeford Productions, LLC 1504 NW 57th Ter Kansas City, MO 64118 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. All goods and services in the class are opposed, namely: Entertainment in the nature of beauty pageants

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	877221	Application Date	04/05/1968
Registration Date	09/16/1969	Foreign Priority Date	NONE
Word Mark	MISS WORLD		

Design Mark	MISS WORLD
Description of Mark	NONE
Goods/Services	Class U107 (International Class 041). First use: First Use: 1951/07/01 First Use In Commerce: 1951/11/01 ENTERTAINMENT SERVICES-NAMELY, CONDUCTING OF BEAUTY COMPETITIONS

Attachments	72295043#TMSN.gif (1 page)(bytes) mswo029 noo.pdf (8 pages)(183252 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	/Karla Lambert/
Name	Karla Lambert
Date	04/06/2010

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

In the matter of Application Serial No.: 77/789,604
Mark: **MISS U.S. WORLD & MRS. U.S. WORLD PAGEANT**
Filed: July 25, 2009
Published in the *Official Gazette* on December 8, 2009

MISS WORLD LIMITED,

Opposer,

v.

DRAKEFORD PRODUCTIONS, LLC DBA
MISS U.S. WORLD & MRS. U.S. WORLD
PAGEANT,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Miss World Limited, a company incorporated under the laws of Jersey, Channel Islands and having a place of business at Pier Road, St. Helier, Jersey, Channel Islands, believes that it will be damaged by registration of the mark shown in Application Serial No. 77/789,604 owned by Drakeford Productions, LLC dba Miss U.S. World & Mrs. U.S. World Pageant, and hereby opposes the same under the provisions of 15 U.S.C. § 1063.

As grounds of opposition, Miss World Limited (“Opposer”) asserts that:

1. Opposer is the owner of the name and mark MISS WORLD (the “MISS WORLD Mark”).
2. Opposer, through its predecessors in interest, commenced use of the MISS WORLD Mark in connection with its beauty pageants and competitions at least as early as November 1, 1951 and has continuously used its MISS WORLD Mark since that time.
3. For many years, Opposer has conducted, promoted and produced the MISS WORLD beauty pageant and competition, a global event, with participants from as many as 112

countries. The MISS WORLD beauty pageant and competition has been held in the United States on numerous occasions and is televised nationally in the United States.

4. Opposer uses its MISS WORLD Mark extensively on the Internet to promote its MISS WORLD beauty pageant and is the owner of the domain www.missworld.com.

5. As a result of Opposer's usage and promotion of the MISS WORLD Mark, Opposer has developed great and valuable goodwill in the MISS WORLD Mark.

6. Opposer's MISS WORLD Mark is a distinctive designation serving to identify and indicate the source of Opposer's beauty pageants and competitions to the public, and to distinguish its beauty pageants and competitions from those of others.

7. Opposer's MISS WORLD Mark is famous.

8. Opposer has acquired strong common-law rights in the MISS WORLD Mark as a result of its continuous usage and promotion of the mark.

9. In addition to its common law rights, Opposer owns United States Trademark Registration No. 877,221 registered September 16, 1969, for MISS WORLD for "entertainment services-namely, conducting of beauty competitions" in International Class 41. This registration is valid and subsisting, and is incontestable under 15 U.S.C. § 1065. A current printout of information from the electronic database records of the USPTO showing the current status and title of this registration is attached hereto.

10. On July 25, 2009, Drakeford Productions, LLC dba Miss U.S. World & Mrs. U.S. World Pageant ("Applicant") filed U.S. Application Serial No. 77/789,604 under §1(b) of the Lanham Act for the mark "MISS U.S. WORLD & MRS. U.S. WORLD PAGEANT" ("Applicant's Mark") for "Entertainment in the nature of beauty pageants" in International Class 41. This application was published for opposition on December 8, 2009.

11. Opposer timely filed, and was granted, Requests for Extension of Time to Oppose on December 31, 2009 and February 2, 2010, securing an extension of the deadline until April 7, 2010.

12. There is no issue as to priority. Opposer's dates of first use and first use in commerce of its MISS WORLD Mark long precede the date of Applicant's application, or any date upon which Applicant may rely to claim rights in Applicant's alleged mark.

13. Opposer will be damaged if Applicant's Mark matures to registration because Applicant's Mark is so similar to Opposer's MISS WORLD Mark in sight, sound and meaning, and because Applicant's Mark identifies services so highly related to those services for which Opposer's MISS WORLD Mark is used and registered, that Applicant's use and registration of Applicant's Mark will create a likelihood of consumer confusion, deception, and/or mistake as to source, sponsorship, and/or connection. Registration should therefore be refused under 15 U.S.C. § 1052(d).

14. Opposer will be damaged if Applicant's Mark matures to registration because it will cause dilution of the distinctive quality of Opposer's MISS WORLD Mark. Registration should therefore be refused under 15 U.S.C. § 1125(c).

15. Opposer will be damaged if Applicant's Mark matures to registration because such registration would purport to give Applicant at least *prima facie* evidence of the exclusive right to use Applicant's Mark in connection with the services of the application, which is inconsistent with Opposer's prior rights in its MISS WORLD Mark.

WHEREFORE, Opposer prays that Application Serial No. 77/789,604 be rejected, and that registration of the mark therein be refused, and that this opposition be sustained.

The filing fee in the amount of \$300 as required by 37 C.F.R. § 2.6(a)(17) is submitted herewith. If the amount is insufficient the Commissioner is authorized to deduct said fees from the deposit account of Fulbright & Jaworski L.L.P., Account No.: 50-1212/MSWO:029/RJG.

Respectfully submitted,

Dated: April 5, 2010

By: Karla S. Lambert
Richard J. Groos
C. Ashley Callahan
Karla S. Lambert
FULBRIGHT & JAWORSKI L.L.P.
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Suite 2400
Austin, Texas 78701-3248
(512) 536-3007

ATTORNEYS FOR MISS WORLD LIMITED

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served upon the parties identified below via U.S. Mail on April 6, 2010.

Drakeford Productions, LLC
dba Miss U.S. World & Mrs. U.S. World Pageant
1504 NW 57th Ter
Kansas City, MO 64118


Kellie Pfertner

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

This page was generated by the TARR system on 2010-04-06 10:36:26 ET

Serial Number: 72295043 Assignment Information Trademark Document Retrieval

Registration Number: 877221

Mark

MISS WORLD

(words only): MISS WORLD

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2010-03-13

Filing Date: 1968-04-05

Transformed into a National Application: No

Registration Date: 1969-09-16

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: (NOT AVAILABLE)

Date In Location: 2010-03-13

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

1. MISS WORLD LIMITED

Address:

MISS WORLD LIMITED
P.O. BOX 83 ORDNANCE HOUSE 31 PIER ROAD
ST. HELIER, NJ 07068
United States

Legal Entity Type: LIMITED UNITED KINGDOM COMPANY

State or Country Where Organized: (NOT AVAILABLE)

GOODS AND/OR SERVICES

U.S. Class: 107 (International Class 041)

Class Status: Active

ENTERTAINMENT SERVICES-NAMELY, CONDUCTING OF BEAUTY COMPETITIONS

Basis: 1(a)

First Use Date: 1951-07-01

First Use in Commerce Date: 1951-11-01

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

2010-03-13 - Third renewal 10 year

2010-03-13 - Section 8 (10-year) accepted/ Section 9 granted

2010-03-11 - Case Assigned To Post Registration Paralegal

2010-03-10 - TEAS Section 8 & 9 Received

2008-11-17 - Case File In TICRS

1999-11-18 - Second renewal 10 year

1999-11-18 - Section 9 granted/check record for Section 8

1999-08-09 - Section 9 filed/check record for Section 8

1990-02-20 - First renewal 10 year

1990-02-05 - Response received for Post Registration action

1989-09-25 - Post Registration action mailed - Section 9

1989-08-21 - Section 9 filed/check record for Section 8

1981-05-06 - Cancellation dismissed for Proceeding

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Ronald E. Shapiro

Correspondent

Ronald E. Shapiro

Shapiro and Silverstein PLLC

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Domestic Representative

Vorys, Sater, Seymour and Pease, L.L.P.
