

ESTTA Tracking number: **ESTTA348292**

Filing date: **05/19/2010**

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	Madonna Ciccone
Granted to Date of previous extension	05/19/2010
Address	c/o Padell Nadell Fine Weinberg & Co 1775 Broadway New York, NY 10019 UNITED STATES
Party who filed Extension of time to oppose	MadonnaCiccone
Relationship to party who filed Extension of time to oppose	Opposer is the same individual who filed the Extension of Time to Oppose, except a space between Opposer's first and last name was omitted from the USPTO record

Correspondence information	Madonna Ciccone c/o Padell Nadell Fine Weinberg & Co 1775 Broadway New York, NY 10019 UNITED STATES trademark@proskauer.com
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Applicant Information

Application No	77000702	Publication date	01/19/2010
Opposition Filing Date	05/19/2010	Opposition Period Ends	05/19/2010
Applicant	Phicon Investment Holdings (Pty) Ltd 20 Greyton Road Milnerton, SOUTH AFRICA		

Goods/Services Affected by Opposition

Class 032. All goods and services in the class are opposed, namely: Mineral water, aerated water, sports drinks, energy drinks, and isotonic drinks
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Grounds for Opposition

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

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1473554	Application Date	12/09/1985
Registration Date	01/19/1988	Foreign Priority Date	NONE
Word Mark	MADONNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1979/03/00 First Use In Commerce: 1979/07/00 ENTERTAINMENT SERVICES -NAMELY, LIVE AND RECORDED MUSICAL, DANCE AND DRAMATIC PERFORMANCES		

U.S. Registration No.	1463601	Application Date	12/09/1985
Registration Date	11/03/1987	Foreign Priority Date	NONE
Word Mark	MADONNA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1985/04/10 First Use In Commerce: 1985/04/15 CLOTHING - NAMELY, T-SHIRTS, VESTS, SWEATSHIRTS, TOPS, PANTS AND DRESSES		

Attachments	77000702 Notice of Opposition.pdf (4 pages)(138376 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	/Jenifer deWolf Paine/
Name	Jenifer deWolf Paine
Date	05/19/2010

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

MADONNA CICCONE
p/k/a "MADONNA"

Opposer,

v.

PHICON INVESTMENT HOLDINGS
(PTY) LTD

Applicant

Mark: MADONNA

Serial No. 77/000702

Opposition No. _____

Madonna Ciccone, p/k/a "Madonna" ("Opposer", or "Madonna"), hereby opposes the above-identified application and states as follows:

1. Opposer is a world famous entertainer, performing artist, composer, record producer, author, actress, and public figure. Since 1979, and on an internationally famous level since the early 1980's, Madonna has rendered a wide variety of entertainment services under her name, trademark, and service mark MADONNA (the "MADONNA Mark"). Madonna has achieved unparalleled success in the entertainment industry offering services under the MADONNA Mark, and is arguably one of the most famous women in the world.
2. The MADONNA Mark is internationally known and famous as a result of Madonna's extensive, high-profile, and overwhelmingly commercially successful activities in the entertainment industry.
3. Madonna is the owner of U.S. Trademark Registrations No. 1,473,554 (entertainment services) and 1,463,601 (clothing) for the mark MADONNA. In addition, Madonna is the owner of strong common-law rights in the MADONNA Mark.
4. Through long, extensive, and continuous use, through extensive advertizing and promotion, and through extensive unsolicited media attention, the MADONNA Mark has achieved enormous fame, has become synonymous in the minds of the public with Madonna and her activities in the music, film, and entertainment industries, and serves as a symbol of the goodwill and excellent reputation associated with Madonna. The

MADONNA Mark is famous and entitled to the widest scope of protection afforded by law, including protection against dilution.

5. Madonna has also licensed the MADONNA Mark in connection with clothing and numerous other items of merchandise.

6. Long before Applicant's filing date, Madonna has been using the MADONNA Mark to identify her services in the entertainment industry.

7. Long before Applicant's filing date, the MADONNA Mark became famous within the meaning of 15 U.S.C. § 1125(c).

8. On September 15, 2006, Applicant filed application SN 77/000,702 for the mark MADONNA in connection with "mineral water, aerated water, sports drinks, energy drinks, and isotonic drinks" (the "'702 Application").

9. The '702 Application was published for opposition on January 19, 2010. On February 17, 2010, Madonna timely filed a Request for Extension of Time to Oppose.

10. Applicant's filing date is long after Madonna's first use date of the MADONNA Mark.

11. Applicant's filing date is long after the MADONNA Mark became famous.

12. It is common for celebrities to endorse a line of products or come out with their own line of products.

13. One of the many things Madonna is well-known for is her fitness level and being in excellent physical shape.

14. Upon seeing bottled water or sports drinks / energy drinks labeled "MADONNA", consumers would no doubt believe that these products either originated with Madonna or were sponsored, licensed, endorsed, or approved by Madonna.

15. Applicant's proposed mark, MADONNA, is identical to the world-famous MADONNA Mark.

16. Due to the identical nature of the trademarks, due to the overwhelming fame of the MADONNA Mark, and due to the nature of the goods covered by Applicant's application and what the public knows about

Madonna, concurrent use of the mark MADONNA by Applicant and MADONNA by Madonna would likely result in consumer confusion as to source, sponsorship, approval, or affiliation within the meaning of 15 U.S.C. §§ 1114 and 1125(a).

17. Use by Applicant of the MADONNA Mark in connection with “mineral water, aerated water, sports drinks, energy drinks, and isotonic drinks” is likely to dilute the distinctive quality of the famous MADONNA Mark within the meaning of 15 U.S.C. § 1125(c).

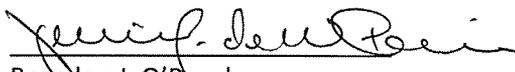
18. Therefore, Madonna is likely to be damaged by registration of Phicon’s proposed mark within the meaning of 15 U.S.C. § 1063(a).

19. Applicant’s proposed mark is unregistrable pursuant to 15 U.S.C. § 1052(d), as it so resembles a mark previously used in the United States by another and not abandoned as to be likely to cause confusion, mistake or to deceive.

19. WHEREFORE, Opposer prays that the instant opposition be sustained and registration refused.

Respectfully submitted,

Date: May 19, 2010



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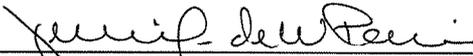
Attorneys for Opposer

Certificate of Service

I hereby certify that on May 19, 2010 I caused a true copy of the foregoing Notice of Opposition to be served on counsel for Applicant by first class mail as follows:

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Jenifer deWolf Paine