

ESTTA Tracking number: **ESTTA582441**

Filing date: **01/17/2014**

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	Shirley's World, L.P.
Granted to Date of previous extension	01/18/2014
Address	101 Lakeview Dr. Woodside, CA 94062 UNITED STATES
Attorney information	Jackie M. Joseph Eisner Kahan Gorry, et al. 9601 Wilshire Blvd.Suite 700 Beverly Hills, CA 90049 UNITED STATES jjoseph@eisnerlaw.com Phone:3108553200

Applicant Information

Application No	85723707	Publication date	11/19/2013
Opposition Filing Date	01/17/2014	Opposition Period Ends	01/18/2014
Applicant	Prater, Earl C. J. 3540 Yosemite Place Reno, NV 89503 USX		

Goods/Services Affected by Opposition

Class 032. First Use: 1987/04/28 First Use In Commerce: 1987/04/28 All goods and services in the class are opposed, namely: Soda pops; Soft drinks, namely, sodas
--

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Consists of or comprises a name, portrait, or signature of a living individual without written consent, or the name, portrait, or signature of a deceased president without the written consent of the surviving spouse	Trademark Act section 2(c)
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)

Mark Cited by Opposer as Basis for Opposition

U.S. Application No.	85962864	Application Date	06/18/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	SHIRLEY TEMPLE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 0 First Use In Commerce: 0 Soda pops; Soft drinks		

Related Proceedings	Cancellation Proceeding No. 92757484 (Parent Case)
---------------------	--

Attachments	85962864#TMSN.jpeg(bytes) Opposition (Whole).pdf(1264849 bytes)
-------------	---

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	/Jackie Joseph/
Name	Jackie M. Joseph
Date	01/17/2014

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

In the Matter of Application Serial No. 85723707
Filed on September 7, 2012

Shirley's World, L.P.,
Opposer,

Opposition No.:

- against -

Earl C.J. Prater,
Applicant

NOTICE OF OPPOSITION

Shirley's World, L.P., a company organized and existing under the laws of the state of California, located and doing business at Woodside, California, believes that it will be damaged by registration of the mark "The Original Shirley Temple Soda Pop" by Applicant and hereby opposes the same.

As grounds for opposition it is alleged that:

1. Shirley Temple Black ("**Mrs. Black**"), a living individual, is a world-famous and highly acclaimed actor, singer and author.
2. On or about December 27, 2000, Mrs. Black assigned to Shirley's World, L.P., which is her family limited partnership that she caused to be formed ("**Opposer**"), all right, title and interest of every kind and nature whatsoever in and to her name, voice, likeness, and other personal characteristics and attributes, as a child and as an adult, including, without limitation, her maiden name "Shirley Temple" (collectively, the "**Persona**"), with certain minor exceptions that do not include, relate to, or otherwise implicate the exploitation of the Persona in trademark class 032 (the "**Assignment**"). Opposer has been using or licensing the name "Shirley Temple" commercially in connection with entertainment services, DVD sets, apparel, collectible dolls,

collectible plates, collectible mugs, collectible trinket items, and other products and services since at least the time of the Assignment.

3. Prior to the Assignment to Opposer, and since at least the 1930s, the Persona (including the name “Shirley Temple”) was licensed and/or otherwise exploited in interstate commerce by Mrs. Black, either individually or through a living trust.

4. Therefore, since at least the 1930s, Opposer and/or its predecessor (Mrs. Black), has been engaged in the provision of services under, and the manufacture and sale of various goods bearing, the mark “Shirley Temple” in interstate commerce in the United States and has continuously so used the mark since at least the 1930s.

5. As a result of Mrs. Black’s widespread and worldwide fame and use of her name, as referenced above, Mrs. Black’s name has acquired great distinctiveness and extensive goodwill, and is extremely well known and recognized by the public (indeed, it is a household name) as identifying Mrs. Black, and products and services that are affiliated with or have been authorized by Opposer or Mrs. Black.

6. Applicant filed trademark application S.N. 85723707 on September 7, 2012 to register the mark “The Original Shirley Temple Soda Pop” in Class 032.

7. Applicant applied for the mark without requesting Mrs. Black’s or Opposer’s consent to utilize Mrs. Black’s name in the mark.

8. Mrs. Black and Opposer did not and do not consent to the use of Mrs. Black’s name in said mark.

9. The application for the mark “The Original Shirley Temple Soda Pop” falsely suggests a connection with Mrs. Black in violation of 15 U.S.C. § 1052(a).

10. Applicant represented in his application to the USPTO that the name shown in the

mark does not identify a particular living individual. This representation is patently false, and is in violation of 15 U.S.C. § 1052(c).

11. Applicant filed trademark application S.N. 85723707 fraudulently in that he knowingly made a false, material misrepresentation of fact in connection with his application. Applicant also knowingly made a false, material misrepresentation of fact in his response to Office Action dated June 10, 2013, in which he asserted, in response to inquiry from the USPTO Examining Attorney, that Mrs. Black's name shown in the mark does not identify a particular living individual. See Exhibit A. Opposer hereby gives notice that, in accordance with Trademark Rule 2.122(c), it will rely on said Response to Office Action as evidence on its behalf in this proceeding, and copies thereof will be introduced into evidence during the period for the taking of testimony.

12. Moreover, Applicant's use of the mark is likely to cause confusion, mistake or deception as to the source of origin of Applicant's goods in that the public, the trade and others are likely to believe that Applicant's goods are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Mrs. Black.

13. Registration of the mark sought to be registered by Applicant is barred by the provisions of Sections 2(a) and 2(c) of the Trademark Act of 1946 (15 U.S.C. §§ 1052(a), 1052(c)) for the reasons that it falsely suggests a connection to Mrs. Black, and consists of or comprises a name, portrait, or signature identifying a particular living individual without written consent.

14. Opposer filed Application S.N. 85962864 on June 18, 2013, to register its mark for "Soda pops; Soft drinks," a date subsequent to Applicant's filing date. Therefore, Opposer's application has been blocked by Applicant's application, to Opposer's damage.

15. In addition, the existence of Applicant's "The Original Shirley Temple Soda Pop" trademark casts a cloud upon Opposer's right to continue to use and to expand the use of Mrs. Black's name and mark.

16. Insofar as Mrs. Black's name has been famous since at least the 1930s, well before Applicant's April 23, 1987 claim of first use or the filing date of September 7, 2012 under Applicant's trademark application S.N. 85723707, Applicant's use of the mark and attempted registration of same has and will dilute the distinctive quality of Mrs. Black's famous name and the Persona under Trademark Act § 43(c), 15 U.S.C. § 1125. Accordingly, Opposer will be damaged by the registration sought by Applicant because such registration would support and assist Applicant in use of its mark and thereby dilute Opposer's rights in its distinctive and famous SHIRLEY TEMPLE mark and the Persona.

17. WHEREFORE, Opposer believes that it will be damaged by registration of Application No. 85723707 on the Principal Register, and prays that this Opposition be sustained and the registration sought by Applicant be refused.

Dated: January 17, 2014

EISNER KAHAN
GORRY CHAPMAN ROSS & JAFFE

By: /s/ Jackie M. Joseph
Jackie M. Joseph
Attorneys for Opposer, Shirley's World, L.P.

EXHIBIT A

Response to Office Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85723707
LAW OFFICE ASSIGNED	LAW OFFICE 110
MARK SECTION (no change)	
GOODS AND/OR SERVICES SECTION (current)	
INTERNATIONAL CLASS	032
DESCRIPTION	Soda pops; Soft drinks, namely, sodas
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 04/28/1987
FIRST USE IN COMMERCE DATE	At least as early as 04/28/1987
GOODS AND/OR SERVICES SECTION (proposed)	
INTERNATIONAL CLASS	032
DESCRIPTION	Soda pops; Soft drinks, namely, sodas
FILING BASIS	Section 1(a)
FIRST USE ANYWHERE DATE	At least as early as 04/28/1987
FIRST USE IN COMMERCE DATE	At least as early as 04/28/1987
STATEMENT TYPE	"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use].
SPECIMEN FILE NAME(S)	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0002.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0003.JPG</u>

	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0004.JPG</u>
SPECIMEN DESCRIPTION	Photo 1. Grocery Store end aisle display stand, The Original Shirley Temple Soda Pop Photo 2. The Original Shirley Temple Soda Pop, Shirley Temple Diet Soda Pop and Hollywood's Original Shirley Temple sodas on ice. Photo 3. Cold Original Shirley Temple sodas, Shirley Temple Diet sodas and Hollywood's Original Shirley Temple sodas on ice.
ADDITIONAL STATEMENTS SECTION	
DISCLAIMER	No claim is made to the exclusive right to use Shirley Temple Soda Pop apart from the mark as shown.
COLOR(S) CLAIMED (If applicable)	The color(s) The colors blue, pink, purple, pink magenta, blue teal, white, teal and magenta is/are claimed as a feature of the mark.
SECTION 2(f) Claim of Acquired Distinctiveness, IN PART, based on Prior Registration(s)	The Original Shirley Temple Soda Pop and Shirley Temple Diet Soda Pop has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s). 1642212 2540238.
SECTION 2(f) Claim of Acquired Distinctiveness, IN PART, BASED ON EVIDENCE	The Original Shirley Temple Soda Pop and The Original Shirley Temple Diet Soda Pop has become distinctive of the goods/services, as demonstrated by the attached evidence.
2(f) EVIDENCE FILE NAME(S)	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0005.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0006.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0007.JPG</u>
	<u>\\TICRS\EXPORT16\IMAGEOUT</u> <u>16\857\237\85723707\xml5\ ROA0008.JPG</u>
NAME(S), PORTRAITS(S), SIGNATURE(S) OF INDIVIDUAL(S)	The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.
	The Original Shirley Temple Soda Pop was first produced in April of 1987 and has been U.S. Trademarked for over 25 years. The Original Shirley Temple Soda Pop design established since 1987 and Hollywood's Original Shirley Temple Soda Pop design and brand name introduced in 2012, have been recognized in commerce as our distinctive signature trademark. Our product name and distinct design over the past twenty five years has never identified nor currently identifies any particular living individual. The name

MISCELLANEOUS STATEMENT

The Original Shirley Temple Soda Pop and Hollywood's Original Shirley Temple Soda Pop on our products only identify our beverages and promotional products. We have never been required by the USPTO to obtain written permission from anyone to obtain our past or currently registered trademarks. The USPTO twice prior approved expired Registration No. 1642212, October 8, 1997 and No. 2540238, November 2, 2008, both under the same product name, design, logo and colors. It was again reapplied for on September 7, 2012 per advisement by the USPTO under Serial No. 85723707. There have been no design, logo or color changes made on the artwork or mark for this trademark application. We have the name Hollywood's Original Shirley Temple Soda Pop already registered with the USPTO (No. 4191275). Per advisement by the USPTO, we also submitted our design artwork for Hollywood's Original Shirley Temple Pop for registration (Serial No. 85698663). This design artwork is exactly the same design format as our registered trademark No. 3418196 with the addition of our Hollywood's brand name. Claim: The name "Shirley Temple" in the submitted mark and drawing of "The Original Shirley Temple Soda Pop" carbonated soft drink beverage does not identify nor implies any relationship to any particular living individual. It has always been and currently is a beverage product only, not a person.

SIGNATURE SECTION

DECLARATION SIGNATURE	/Earl C J Prater/
SIGNATORY'S NAME	Earl C.J. Prater
SIGNATORY'S POSITION	Owner
SIGNATORY'S PHONE NUMBER	775-747-2470
DATE SIGNED	06/10/2013
RESPONSE SIGNATURE	/Earl C J Prater/
SIGNATORY'S NAME	Earl C. J. Prater
SIGNATORY'S POSITION	Owner
SIGNATORY'S PHONE NUMBER	775 747 2470
DATE SIGNED	06/10/2013
AUTHORIZED SIGNATORY	YES

FILING INFORMATION SECTION

SUBMIT DATE	Mon Jun 10 17:51:18 EDT 2013
	USPTO/ROA-99.92.97.127-20

TEAS STAMP

130610175118743427-857237
07-50077ae124ff434c98106d
b772dca3fbd030f0987e208c4
e81f3ac281f928c4-N/A-N/A-
20130610165334132428

PTO Form 1507 (Rev. 02/2006)
USPS No. 6251, 0250 (Rev. 09/11/2014)

Response to Office Action

To the Commissioner for Trademarks:

Application serial no. **85723707** has been amended as follows:

CLASSIFICATION AND LISTING OF GOODS/SERVICES

Applicant proposes to amend the following class of goods/services in the application:

Current: Class 032 for Soda pops; Soft drinks, namely, sodas

Original Filing Basis:

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 04/28/1987 and first used in commerce at least as early as 04/28/1987, and is now in use in such commerce.

Proposed: Class 032 for Soda pops; Soft drinks, namely, sodas

Filing Basis: Section 1(a), Use in Commerce: The applicant is using the mark in commerce, or the applicant's related company or licensee is using the mark in commerce, on or in connection with the identified goods and/or services. 15 U.S.C. Section 1051(a), as amended. The mark was first used at least as early as 04/28/1987 and first used in commerce at least as early as 04/28/1987, and is now in use in such commerce.

Applicant hereby submits one(or more) specimen(s) for Class 032. The specimen(s) submitted consists of Photo 1. Grocery Store end aisle display stand, The Original Shirley Temple Soda Pop Photo 2. The Original Shirley Temple Soda Pop, Shirley Temple Diet Soda Pop and Hollywood's Original Shirley Temple sodas on ice. Photo 3. Cold Original Shirley Temple sodas, Shirley Temple Diet sodas and Hollywood's Original Shirley Temple sodas on ice..

"The substitute (or new, if appropriate) specimen(s) was/were in use in commerce at least as early as the filing date of the application" [for an application based on Section 1(a), Use in Commerce] OR "The substitute (or new, if appropriate) specimen(s) was/were in use in commerce prior either to the filing of the Amendment to Allege Use or expiration of the filing deadline for filing a Statement of Use" [for an application based on Section 1(b) Intent-to-Use].

Specimen File1

Specimen File2

Specimen File3

ADDITIONAL STATEMENTS

Disclaimer

No claim is made to the exclusive right to use Shirley Temple Soda Pop apart from the mark as shown.

Color Claim

The color(s) The colors blue, pink, purple, pink magenta, blue teal, white, teal and magenta is/are claimed as a feature of the mark.

Section 2(f) Claim of Acquired Distinctiveness, in part, Prior Registration(s)

The Original Shirley Temple Soda Pop and Shirley Temple Diet Soda Pop has become distinctive of the goods/services as evidenced by the ownership on the Principal Register for the same mark for related goods or services of U.S. Registration No(s). 1642212 2540238.

Section 2(f) Claim of Acquired Distinctiveness, in part, based on Evidence

The Original Shirley Temple Soda Pop and The Original Shirley Temple Diet Soda Pop has become distinctive of the goods/services, as demonstrated by the attached evidence.

2(f) evidence-1

2(f) evidence-2

2(f) evidence-3

2(f) evidence-4

Name(s), Portrait(s), Signature(s) of individual(s)

The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

Miscellaneous Statement

The Original Shirley Temple Soda Pop was first produced in April of 1987 and has been U.S. Trademarked for over 25 years. The Original Shirley Temple Soda Pop design established since 1987 and Hollywood's Original Shirley Temple Soda Pop design and brand name introduced in 2012, have been recognized in commerce as our distinctive signature trademark. Our product name and distinct design over the past twenty five years has never identified nor currently identifies any particular living individual. The name The Original Shirley Temple Soda Pop and Hollywood's Original Shirley Temple Soda Pop on our products only identify our beverages and promotional products. We have never been required by the USPTO to obtain written permission from anyone to obtain our past or currently registered trademarks. The USPTO twice prior approved expired Registration No. 1642212, October 8, 1997 and No. 2540238, November 2, 2008, both under the same product name, design, logo and colors. It was again reapplied for on September 7, 2012 per advisement by the USPTO under Serial No. 85723707. There have been no design, logo or color changes made on the artwork or mark for this trademark application. We have the name Hollywood's Original Shirley Temple Soda Pop already registered with the USPTO (No. 4191275). Per advisement by the USPTO, we also submitted our design artwork for Hollywood's Original Shirley Temple Pop for registration (Serial No. 85698663). This design artwork is exactly the same design format as our registered trademark No. 3418196 with the addition of our Hollywood's brand name. Claim: The name "Shirley Temple" in the submitted mark and drawing of "The Original Shirley Temple Soda Pop" carbonated soft drink beverage does not identify nor implies any relationship to any particular living individual. It has always been and currently is a beverage product only, not a person.

SIGNATURE(S)**Declaration Signature**

If the applicant is seeking registration under Section 1(b) and/or Section 44 of the Trademark Act, the applicant has had a bona fide intention to use or use through the applicant's related company or licensee

the mark in commerce on or in connection with the identified goods and/or services as of the filing date of the application. 37 C.F.R. Secs. 2.34(a)(2)(i); 2.34 (a)(3)(i); and 2.34(a)(4)(ii); and/or the applicant has had a bona fide intention to exercise legitimate control over the use of the mark in commerce by its members. 37 C.F. R. Sec. 2.44. If the applicant is seeking registration under Section 1(a) of the Trademark Act, the mark was in use in commerce on or in connection with the goods and/or services listed in the application as of the application filing date or as of the date of any submitted allegation of use. 37 C.F.R. Secs. 2.34(a)(1)(i); and/or the applicant has exercised legitimate control over the use of the mark in commerce by its members. 37 C.F.R. Sec. 2.44. The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes 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; that if the original application was submitted unsigned, that all statements in the original application and this submission made of the declaration signer's knowledge are true; and all statements in the original application and this submission made on information and belief are believed to be true.

Signature: /Earl C J Prater/ Date: 06/10/2013

Signatory's Name: Earl C.J. Prater

Signatory's Position: Owner

Signatory's Phone Number: 775-747-2470

Response Signature

Signature: /Earl C J Prater/ Date: 06/10/2013

Signatory's Name: Earl C. J. Prater

Signatory's Position: Owner

Signatory's Phone Number: 775 747 2470

The signatory has confirmed that he/she is not represented by either an authorized attorney or Canadian attorney/agent, and that he/she is either (1) the applicant or (2) a person(s) with legal authority to bind the applicant; and if an authorized U.S. attorney or Canadian attorney/agent previously represented him/her in this matter, either he/she has filed a signed revocation of power of attorney with the USPTO or the USPTO has granted the request of his/her prior representative to withdraw.

Serial Number: 85723707

Internet Transmission Date: Mon Jun 10 17:51:18 EDT 2013

TEAS Stamp: USPTO/ROA-99.92.97.127-20130610175118743

427-85723707-50077ae124ff434c98106db772d

ca3fbd030f0987e208c4e81f3ac281f928c4-N/A

-N/A-20130610165334132428















CERTIFICATE OF SERVICE

I hereby certify that the foregoing **NOTICE OF OPPOSITION** was served upon Respondent in this action addressed as follows:

Mr. Earl C.J. Prater, Applicant
P.O. Box 51542
Sparks, NV 89435-1542

BY MAIL. I am readily familiar with the firm's practice of collection and processing correspondence for mailing with the U.S. Postal Service. Under that practice such envelope(s) is deposited with the U.S. Postal Service on the same day this declaration was executed, with postage thereon fully prepaid at 9601 Wilshire Boulevard, Suite 700, Beverly Hills, California 90210, in the ordinary course of business.

Executed on January 17, 2014, at Beverly Hills, California.

EISNER KAHAN
GORRY CHAPMAN ROSS & JAFFE

By: /s/ Jackie M. Joseph
Jackie M. Joseph
9601 Wilshire Boulevard, Suite 700
Beverly Hills, CA 90210
Tel: (310) 855-3200
Fax: (310) 855-3201

Attorneys for Opposer,
Shirley's World, L.P.