

ESTTA Tracking number: **ESTTA626852**

Filing date: **09/12/2014**

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	Disney Enterprises, Inc.
Granted to Date of previous extension	09/17/2014
Address	500 South Buena Vista Street Burbank, CA 91521 UNITED STATES
Attorney information	Linda K. McLeod Kelly IP, LLP 1330 Connecticut Avenue, N.W.Suite 300 WASHINGTON, DC 20036 UNITED STATES linda.mcleod@kelly-ip.com, docketing@kelly-ip.com, larry.white@kelly-ip.com

Applicant Information

Application No	79140899	Publication date	05/20/2014
Opposition Filing Date	09/12/2014	Opposition Period Ends	09/17/2014
International Registration No.	1187947	International Registration Date	08/20/2013
Applicant	Tomorrowland Co., Ltd. 18-9, 3-chome JAPAN		

Goods/Services Affected by Opposition

<p>Class 018. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Folding briefcases; shoulder bags; Gladstone bags; Japanese kori wicker trunks;briefcases; suitcases; carry-on bags; trunks; handbags; Boston bags; rucksacks;charm bags; business card cases; shopping bags, namely, wheeled shopping bags; purses; key cases; money pouches of leather and textile; wallets; wallets including card holders; business card cases; unfitted vanity cases; umbrellas; unworked or semi-worked leather and fur; handbag frames; purse frames; clothing for domestic pets; walking sticks; canes; metalparts of canes and walking-sticks; handles for canes and walking-sticks</p>
<p>Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Evening dresses; children's wear, namely, skirts, trousers, and shirts; jackets; jogging pants; sweat pants; suits; skirts; trousers; formalwear, namely, tuxedos; coats; overcoats; topcoats; mantles;raincoats; cardigans; sweaters; vests and waistcoats; open-necked shirts; cuffs; collars for clothing; sport shirts; blouses; polo shirts; shirts for suits; night gowns; negligees; Japanese sleeping robes; pajamas; bath robes; undershirts;foundation underclothing, namely, corsets; clothing, namely, combinations; chemises; drawers and underpants;</p>

slips; panties, shorts and briefs; brassieres; petticoats; camisoles; tee-shirts; Japanesetraditional clothing, namely, kimonos; sleep masks; clothing, namely, aprons; collar protectors; socks and stockings; puttees and gaiters; fur stoles; shawls; scarves; Japanese style socks (tabi); Japanese style socks covers (tabi covers);clothing, namely, gloves and mittens; neckties; neckerchiefs, namely, bandannas; thermal underwear; mufflers; clothing,namely, ear muffs; nightcaps; headgear for wear, namely, caps and hats; garters; sock suspenders; braces, namely, suspenders; waistbands; belts for clothing; footwear, other than special footwear forsports; masquerade costumes; clothes for sports, namely, shirts and pants; special footwear for sports, namely, shoes

Class 035. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Retail store and wholesale distributorship services for cotton fabrics, silk fabrics, wool yarn fabrics, chemical fiberfabrics, mixed fiber fabrics; retail store and wholesale distributorship services featuring pillows, mattresses, futon quilts, futon and quilt cases in the nature of linen, bedsheets, blankets, textile sheets; retail store and wholesale distributorship services featuring towels of textile, Japanese cotton towels (tenugui), handkerchiefs, Japanese ceremonialwrapping cloth (fukusa), Japanese general wrapping cloth (furoshiki); retail store and wholesale distributorship services featuring clothing; retail store and wholesale distributorship services featuring footwear other than special footwear for sports; retail store and wholesaledistribut- orship services featuring bagsand pouches

Applicant Information

Application No	79144969	Publication date	05/20/2014
Opposition Filing Date	09/12/2014	Opposition Period Ends	
International Registration No.	1197902	International Registration Date	12/26/2013
Applicant	Tomorrowland Co., Ltd. 18-9, 3-chome JAPAN		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: High-end and luxury clothing for men and women, namely, knit sweaters, cardigans, coats, jackets, shirts, pants, trousers, shawls, gloves, neckties, mufflers, scarves, suits, footwear, shoes, boots, hats, and belts, designed in Japan

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	895722	Application Date	01/28/1970
Registration Date	07/28/1970	Foreign Priority Date	NONE
Word Mark	TOMORROWLAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1955/07/17 First Use In Commerce: 1955/12/31 PROVIDING PARTICIPATION TYPE ENTERTAINMENT IN AMUSEMENT AND EDUCATIONAL PARK		

Attachments	TOMORROWLAND Notice of Opposition.pdf(230684 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	/Linda K. McLeod/
Name	Linda K. McLeod
Date	09/12/2014

2. Opposer's amusement parks include numerous well-known and well-loved areas, attractions, and rides, including the TOMORROWLAND attraction.

3. Since 1955, Opposer has used its TOMORROWLAND mark in connection with amusement park and education services.

4. The TOMORROWLAND attraction is a key destination within Opposer's five theme parks, namely, Disneyland, Magic Kingdom, Tokyo Disneyland, and Disneyland Park (Paris). The TOMORROWLAND attraction is home to one of the world's most famous roller coasters, SPACE MOUNTAIN, among others.

5. For many years, the TOMORROWLAND attraction within Opposer's theme parks has featured retail stores selling a wide variety of consumer products including apparel, accessories, pins, gifts, toys, and housewares

6. In addition, Opposer has used its TOMORROWLAND mark in connection with clothing products. Representative samples of Opposer's apparel bearing its TOMORROWLAND mark are shown below:





7. In addition to its TOMORROWLAND attractions and clothing, Opposer is releasing its upcoming film *Tomorrowland* on May 25, 2015. The film is a science-fiction mystery adventure about a former boy-genius with scientific curiosity who embarks on a danger-filled mission to unearth the secrets of an enigmatic place somewhere in time and space known only as “Tomorrowland.”

8. Opposer is also launching *Miles from Tomorrowland*—a Disney Junior television series set in the TOMORROWLAND attraction of Disney parks, which will feature educational programs about science, technology, and space travel.

9. In sum, through its long use and substantial advertising and promotion of the TOMORROWLAND mark in connection with Opposer’s attractions and goods and services described above, Opposer has developed valuable goodwill in its TOMORROWLAND mark.

Opposer’s Registration and Applications for its TOMORROWLAND and TOMORROWLAND-Formative Marks

10. Opposer owns valid and subsisting U.S. Registration No. 895722 for the mark TOMORROWLAND in connection with “providing participation type entertainment in amusement and educational park” services in Class 41. A printout from the USPTO TSDR database of U.S. Registration No. 895722 is attached as Exhibit A. This registration is incontestable and constitutes conclusive evidence of the mark’s validity and of Opposer’s exclusive right to use the TOMORROWLAND mark in connection with the services recited in the registration. (Collectively, the goods and services set forth in Paragraphs 2-10 are referred to as “Opposer’s Goods and Services”).

11. Opposer has also filed for the following trademark applications for its MILES OF TOMORROWLAND mark:

MARK	SERIAL NO. FILING DATE	GOODS/SERVICES FIRST USE IN COMMERCE
MILES FROM TOMORROWLAND	Serial. No.: 86197022 Filing Date: February 18, 2014	Non-alcoholic beverages; juices; syrups for making soft drinks in Class 32

MARK	SERIAL NO. FILING DATE	GOODS/SERVICES FIRST USE IN COMMERCE
MILES FROM TOMORROWLAND	Serial. No.: 86197013 Filing Date: February 18, 2014	Bakery goods; biscuits and bread; breakfast cereals and preparations made from cereals; brownie and cake mixes; candy; cereal bars; snack foods; confectionery and chewing gum; chocolate; cocoa; coffee; condiments; cookie mixes; corn chips; crackers; flavorings for beverages; flour; food flavorings; frozen confectionery; frozen meals consisting primarily of pasta or rice; honey; ices; ice; ice cream; ice milk; ketchup; macaroni and cheese; mayonnaise; muffin bars; mustard; oatmeal; pancakes; pancake mixes and syrup; pasta and noodles; peppermint sweets; pies; pita; pizza; pizza dough and sauce; popcorn; pretzels; puddings; rice; sandwiches; sauces; spaghetti; spices; sugar and sugar substitutes; staple foods; sweets; tea; tortilla chips; tortillas; waffles in Class 30
MILES FROM TOMORROWLAND	Serial. No.: 86197000 Filing Date: February 18, 2014	Processed foods; processed, canned, bottled, dried, frozen, cooked, or preserved fruits and vegetables; frozen, prepared or packaged entrees or meals consisting primarily of meat, fish, poultry or vegetables; frozen, prepared or packaged vegetable-based entrees; applesauce; banana chips; butter or butter substitutes; candied fruits, fruit snacks; cheese and cracker combinations; chili; dips; dried fruit-based snacks; eggs; fruits; fruit peels and preserves; fruit salads; fruit-based snack foods; hamburgers; hot dogs; jellies; jams; margarine; marmalades; meat, fish, poultry and game; dairy products excluding ice cream, ice milk and frozen yogurt; nuts; nut butters; pickles; potato chips; potato salad; potato-based snack foods; raisins; soup mixes; soups; vegetables; veggie burger patties in Class 29
MILES FROM TOMORROWLAND	Serial. No.: 86196986 Filing Date: February 18, 2014	Toys, games and playthings; gymnastic and sporting articles (except clothing); hand-held units for playing electronic games for use with or without an external display screen or monitor; Christmas stockings; Christmas tree ornaments and decorations; snow globes in Class 28

MARK	SERIAL NO. FILING DATE	GOODS/SERVICES FIRST USE IN COMMERCE
MILES FROM TOMORROWLAND	Serial. No.: 86196472 Filing Date: February 18, 2014	Clothing, footwear and headwear in Class 25
MILES FROM TOMORROWLAND	Serial. No.: 86196462 Filing Date: February 18, 2014	Textiles; fabric; bed linen; table linen; bath linen; household linens; textile articles not included in other classes; plastic table covers in Class 24
MILES FROM TOMORROWLAND	Serial. No.: 86196447 Filing Date: February 18, 2014	Paper and paper articles; cardboard and cardboard articles; printed matter; publications; books; photographs; portraits; paintings; stationery; office and school supplies; temporary tattoos; foam stamps; party bags; shopping bags; plastic party decorations in Class 16

12. Opposer's U.S. Trademark Application Serial No. 86196472 for MILES FROM TOMORROWLAND was preliminarily refused registration based on Tomorrowland Co., Ltd.'s ("Applicant") Application Serial No. 79144969 for the mark TOMORROWLAND in Class 25, and Application Serial No. 79140899 for the mark LAND OF TOMORROW in Classes 18, 25, and 35 (collectively, the "Applications"), among others.

Applicant and its TOMORROWLAND and LAND OF TOMORROW Marks

13. Tomorrowland Co., Ltd., the listed owner of Application Serial Nos. 79140899 and 79144969, is a corporation of Japan with an address of 18-9, 3-chome, Minamiaoyama Minato-ku; Tokyo 107-0062, Japan.

14. On December 26, 2013, Applicant filed Application Serial No. 79144969 under Section 66 (a), 15 U.S.C. § 1141(f), to register the TOMORROWLAND mark for "High-end and luxury clothing for men and women, namely, knit sweaters, cardigans,

coats, jackets, shirts, pants, trousers, shawls, gloves, neckties, mufflers, scarves, suits, footwear, shoes, boots, hats, and belts, designed in Japan” in Class 25.

15. On August 20, 2013, Applicant filed Application Serial No. 79140899 under Section 66(a), 15 U.S.C. § 1141(f), to register the LAND OF TOMORROW mark for “Folding briefcases; shoulder bags; Gladstone bags; Japanese kori wicker trunks; briefcases; suitcases; carry-on bags; trunks; handbags; Boston bags; rucksacks; charm bags; business card cases; shopping bags, namely, wheeled shopping bags; purses; key cases; money pouches of leather and textile; wallets; wallets including card holders; business card cases; unfitted vanity cases; umbrellas; unworked or semi-worked leather and fur; handbag frames; purse frames; clothing for domestic pets; walking sticks; canes; metal parts of canes and walking-sticks; handles for canes and walking-sticks” in Class 18; “Evening dresses; children's wear, namely, skirts, trousers, and shirts; jackets; jogging pants; sweat pants; suits; skirts; trousers; formalwear, namely, tuxedos; coats; overcoats; topcoats; mantles; raincoats; cardigans; sweaters; vests and waistcoats; open-necked shirts; cuffs; collars for clothing; sport shirts; blouses; polo shirts; shirts for suits; night gowns; negligees; Japanese sleeping robes; pajamas; bath robes; undershirts; foundation underclothing, namely, corsets; clothing, namely, combinations; chemises; drawers and underpants; slips; panties, shorts and briefs; brassieres; petticoats; camisoles; tee-shirts; Japanese traditional clothing, namely, kimonos; sleep masks; clothing, namely, aprons; collar protectors; socks and stockings; puttees and gaiters; fur stoles; shawls; scarves; Japanese style socks (tabi); Japanese style socks covers (tabi covers); clothing, namely, gloves and mittens; neckties; neckerchiefs, namely, bandannas; thermal underwear; mufflers; clothing, namely, ear

muffs; nightcaps; headgear for wear, namely, caps and hats; garters; sock suspenders; braces, namely, suspenders; waistbands; belts for clothing; footwear, other than special footwear for sports; masquerade costumes; clothes for sports, namely, shirts and pants; special footwear for sports, namely, shoes” in Class 25; and “Retail store and wholesale distributorship services for cotton fabrics, silk fabrics, wool yarn fabrics, chemical fiber fabrics, mixed fiber fabrics; retail store and wholesale distributorship services featuring pillows, mattresses, futon quilts, futon and quilt cases in the nature of linen, bedsheets, blankets, textile sheets; retail store and wholesale distributorship services featuring towels of textile, Japanese cotton towels (tenugui), handkerchiefs, Japanese ceremonial wrapping cloth (fukusa), Japanese general wrapping cloth (furoshiki); retail store and wholesale distributorship services featuring clothing; retail store and wholesale distributorship services featuring footwear other than special footwear for sports; retail store and wholesale distributorship services featuring bags and pouches” in Class 35. (Collectively, the goods and services listed in Application Serial No. 79140899 and Application Serial No. 79144969 are referred to as “Applicant’s Goods and Services.”)

16. On May 20, 2014, these Applications were published for opposition in the *Trademark Official Gazette* (TMOG), and Opposer filed a timely extension of time to oppose on June 13, 2014.

Likelihood of Confusion, 15 U.S.C. § 1052(d)

17. Opposer repeats and realleges each and every allegation set forth above.

18. Opposer has priority based on its U.S. Registration No. 895722 for the mark TOMORROWLAND.

19. Opposer also has priority based on its prior use in commerce of its TOMORROWLAND mark before the filing dates of the Applications, and any date of first

use that may be alleged by Applicant.

20. Applicant's TOMORROWLAND mark is identical in sound, appearance, and connotation to Opposer's TOMORROWLAND mark.

21. Applicant's LAND OF TOMORROW mark is highly similar in sound, appearance, and connotation to Opposer's TOMORROWLAND mark. Applicant's mark merely transposes the beginning and end of Opposer's mark and adds a preposition in the middle. The resulting mark, LAND OF TOMORROW, creates the same commercial impression as Opposer's TOMORROWLAND mark.

22. Applicant's Goods and Services are identical and/or closely related to Opposer's Goods and Services advertised, promoted, offered, and/or sold by Opposer in connection with Opposer's TOMORROWLAND mark.

23. Accordingly, Applicant's LAND OF TOMORROW mark shown in Application Serial No. 79140899 and Applicant's TOMORROWLAND mark shown in Application Serial No. 79144969 so resemble Opposer's TOMORROWLAND mark set forth above as to be likely, when registered and used in connection with Applicant's Goods and Services, to cause confusion, or to cause mistake, or to deceive under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. § 1052(d).

WHEREFORE, Opposer believes that it is being damaged, and will be damaged, by the registration of the marks shown in Application Serial Nos. 79140899 and 79144969, and requests that the consolidated opposition be sustained, and that registration to Applicant be refused.

The filing fee has been submitted electronically. Any deficiency in the fee should be charged to Deposit Account No. 506154.

Respectfully submitted,

Dated: September 12, 2014

By: /Linda K. McLeod/

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Attorneys for Opposer

CERTIFICATE OF SERVICE

I certify that a true and accurate copy of the foregoing CONSOLIDATED NOTICE OF OPPOSITION was served on September 12, 2014, upon Applicant's counsel at the following correspondence addresses of record:

By First Class Mail, postage prepaid:

Eleanor M. Lackman
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Tokyo 106-6123
Japan

/Larry L. White/
Larry L. White
Litigation Case Manager

EXHIBIT A

Correspondent

Correspondent Name/Address: Barbara J. Quinn
THE WALT DISNEY COMPANY
500 SOUTH BUENA VISTA STREET
CORPORATE LEGAL - TRADEMARK DEPARTMENT
BURBANK, CALIFORNIA 91521
UNITED STATES

Phone: (818) 560-3997

Fax: (818) 848-6424

Correspondent e-mail: trademarks@disney.com

Correspondent e-mail Authorized: Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 15, 2009	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	75461
Aug. 15, 2009	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Aug. 14, 2009	ASSIGNED TO PARALEGAL	75461
Aug. 12, 2009	TEAS SECTION 8 & 9 RECEIVED	
Nov. 17, 2008	CASE FILE IN TICRS	
May 09, 2001	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
May 09, 2001	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Apr. 13, 2001	RESPONSE RECEIVED TO POST REG. ACTION - SEC. 8 & 9	
Feb. 27, 2001	POST REGISTRATION ACTION MAILED - SEC. 8 & 9	
May 19, 2000	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
May 31, 1990	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
May 17, 1990	RESPONSE RECEIVED TO POST REG. ACTION	
May 09, 1990	POST REGISTRATION ACTION MAILED - SEC. 9	
Feb. 20, 1990	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	

Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

Renewal Date: Jul. 28, 2010

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION

Date in Location: Aug. 15, 2009

Assignment Abstract Of Title Information

Summary

Total Assignments: 3

Registrant: WALT DISNEY PRODUCTIONS

Assignment 1 of 3

Conveyance: CHANGE OF NAME 19860211

Reel/Frame: 0543/0288

Pages: 4

Date Recorded: Nov. 04, 1986

Supporting Documents: No Supporting Documents Available

Assignor

Name: WALT DISNEY PRODUCTIONS

Execution Date: Feb. 11, 1986

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Assignee

Name: WALT DISNEY COMPANY, THE

Legal Entity Type: UNKNOWN

State or Country Where Organized: No Place Where Organized Found

Address: No Assignee Address Found

Correspondent

Correspondent Name: THE WALT DISNEY COMPANY

Correspondent Address: 500 SOUTH BUENA VISTA ST.
BURBANK, CA 91521

Domestic Representative - Not Found

Assignment 2 of 3

Conveyance: ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

Reel/Frame: 0589/0128

Pages: 4

Date Recorded: Jan. 04, 1988

Supporting Documents: No Supporting Documents Available

Assignor

Name: WALT DISNEY COMPANY, THE

Execution Date: Dec. 08, 1987

Legal Entity Type: CORPORATION

State or Country Where Organized: CALIFORNIA

Assignee

Name: WALT DISNEY COMPANY, THE

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 500 SOUTH BUENA VISTA STREET
BURBANK, CALIFORNIA 91521

Correspondent

Correspondent Name: THE WALT DISNEY COMPANY

Correspondent Address: 500 SOUTH BUENA VISTA STREET
BURBANK, CA 91521

Domestic Representative - Not Found

Assignment 3 of 3

Conveyance: CHANGE OF NAME

Reel/Frame: 1544/0172

Pages: 8

Date Recorded: Jan. 13, 1997

Supporting Documents: No Supporting Documents Available

Assignor

Name: WALT DISNEY COMPANY, THE

Execution Date: Dec. 04, 1996

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Assignee

Name: DISNEY ENTERPRISES, INC.

Legal Entity Type: CORPORATION

State or Country Where Organized: DELAWARE

Address: 500 SOUTH BUENA VISTA STREET
BURBANK, CALIFORNIA 91521

Correspondent

Correspondent Name: LADAS & PARRY

Correspondent Address: FRANCIE R. GOROWITZ
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LOS ANGELES, CA 90036

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