

ESTTA Tracking number: **ESTTA664443**

Filing date: **04/01/2015**

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	Nintendo of America, Inc.
Granted to Date of previous extension	04/01/2015
Address	4600 150th Avenue NE Redmond, WA 98052 UNITED STATES

Attorney information	Katherine Keating Bryan Cave LLP 560 Mission Street, 25th Floor San Francisco, CA 94105 UNITED STATES katherine.keating@bryancave.com, jill.chalmers@bryancave.com, judi.cope@bryancave.com Phone:415-268-1972
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Applicant Information

Application No	86283191	Publication date	12/02/2014
Opposition Filing Date	04/01/2015	Opposition Period Ends	04/01/2015
Applicant	Jones, Mario 355 Crescendo Way Silver Spring, MD 20901 UNITED STATES		

Goods/Services Affected by Opposition

Class 041. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Entertainment, namely, live performances by a musical band

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.	2345441	Application Date	06/03/1999
Registration Date	04/25/2000	Foreign Priority Date	NONE
Word Mark	SUPER MARIO		

Design Mark	SUPER MARIO		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/10/18 First Use In Commerce: 1985/10/18 Video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges		

U.S. Registration No.	2345410	Application Date	06/03/1999
Registration Date	04/25/2000	Foreign Priority Date	NONE
Word Mark	SUPER MARIO BROS.		
Design Mark	SUPER MARIO BROS.		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1985/10/18 First Use In Commerce: 1985/10/18 use with video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges		

U.S. Registration No.	1546563	Application Date	10/24/1988
Registration Date	07/04/1989	Foreign Priority Date	NONE
Word Mark	SUPER MARIO BROS. 2		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1988/06/04 First Use In Commerce: 1988/06/04 ELECTRONIC GAME PROGRAMS		

U.S. Registration No.	1592182	Application Date	09/05/1989
Registration Date	04/17/1990	Foreign Priority Date	NONE
Word Mark	SUPER MARIO LAND		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1989/06/02 First Use In Commerce: 1989/06/02 ELECTRONIC GAME PROGRAMS		

U.S. Registration No.	4126557	Application Date	01/18/2011
Registration Date	04/10/2012	Foreign Priority Date	NONE
Word Mark	SUPER MARIO LAND		
Design Mark	<p style="text-align: center;">SUPER MARIO LAND</p>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1989/06/02 First Use In Commerce: 1989/06/02 Downloadable multimedia files, namely, video games; downloadable electronic game programs; downloadable electronic gamesoftware; electronic game programs; electronic game software; video game programs; video game software		

U.S. Registration No.	1704302	Application Date	10/02/1990
Registration Date	07/28/1992	Foreign Priority Date	NONE
Word Mark	SUPER MARIO WORLD		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1991/06/07 First Use In Commerce: 1991/06/07 video games, electronic games and videogame software		

U.S. Registration No.	2319991	Application Date	10/23/1996
Registration Date	02/22/2000	Foreign Priority Date	NONE
Word Mark	SUPER MARIO 64		
Design Mark	<p style="text-align: center;">SUPER MARIO 64</p>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1996/05/17 First Use In Commerce: 1996/05/17 toys and games, namely, video game programs, video game software and electronicgame programs		

U.S. Registration No.	3282201	Application Date	11/28/2006
Registration Date	08/21/2007	Foreign Priority Date	NONE
Word Mark	SUPER MARIO GALAXY		
Design Mark	<p style="text-align: center;">SUPER MARIO GALAXY</p>		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2006/05/10 First Use In Commerce: 2006/05/10 compact discs and optical discs featuring entertainment content, namely, [stories, music, and] games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive game discs; interactive game programs; interactive game software; video game discs; video game programs; video game software		

U.S. Registration No.	2951313	Application Date	02/06/2003
Registration Date	05/17/2005	Foreign Priority Date	NONE
Word Mark	MARIO BROS.		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1983/04/06 First Use In Commerce: 1983/04/06 Cartridges featuring entertainment content, namely, games, game facts, game hints, stories and music; computer game cartridges; computer game programs; computer game software; electronic game cartridges; electronic game programs; electronic game software; interactive game cartridges; interactive game programs; interactive game software; [magnetic trading cards featuring game program and data content;] video game cartridges; video game programs; video game software		

U.S. Registration No.	1646158	Application Date	07/03/1990
Registration Date	05/28/1991	Foreign Priority Date	NONE
Word Mark	DR. MARIO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1990/06/01 First Use In Commerce: 1990/06/01		

	electronic game programs		
U.S. Registration No.	2345411	Application Date	06/03/1999
Registration Date	04/25/2000	Foreign Priority Date	NONE
Word Mark	MARIO KART		
Design Mark	MARIO KART		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1992/09/08 First Use In Commerce: 1992/09/08 video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges		

U.S. Registration No.	2387966	Application Date	12/03/1999
Registration Date	09/19/2000	Foreign Priority Date	NONE
Word Mark	MARIO PARTY		
Design Mark	MARIO PARTY		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1998/12/18 First Use In Commerce: 1998/12/18 Video game software, video game programs, video game cartridges electronic gamesoftware, electronic game programs, electronic game cartridges		

U.S. Registration No.	4474791	Application Date	06/14/2013
Registration Date	01/28/2014	Foreign Priority Date	NONE
Word Mark	MARIO GOLF		

Design Mark	<h1>Mario Golf</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1999/07/26 First Use In Commerce: 1999/07/26 Pre-recorded cartridges and memory cards containing entertainment content, namely, video games and computer games; downloadable multimedia files, namely, videogames and computer games; downloadable electronic game programs; downloadable electronic game software; electronic game programs; electronic game software; video game cartridges; video game memory cards; video game programs; video game software

U.S. Registration No.	2496094	Application Date	08/22/2000
Registration Date	10/09/2001	Foreign Priority Date	NONE

Word Mark	MARIO TENNIS
Design Mark	<h1>MARIO TENNIS</h1>
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2000/05/14 First Use In Commerce: 2000/05/14 computer game software; computer game programs; electronic game cartridges; electronic game software; electronic game programs; interactive game programs; interactive game software; interactive game cartridges; video game cartridges; videogame software and video game programs

U.S. Registration No.	2503838	Application Date	08/22/2000
Registration Date	11/06/2001	Foreign Priority Date	NONE
Word Mark	PAPER MARIO		

Design Mark	PAPER MARIO		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2000/05/14 First Use In Commerce: 2000/05/14 computer game softwares; computer game programs; [electronic game cartridges;] electronic game software; electronic game programs; interactive game programs; interactive game softwares; [interactive game cartridges; video game cartridges;] video game software and video game programs		

U.S. Registration No.	3408861	Application Date	08/13/2007
Registration Date	04/08/2008	Foreign Priority Date	NONE

Word Mark	MARIO STRIKERS		
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Design Mark	MARIO STRIKERS		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2007/07/11 First Use In Commerce: 2007/07/11 [Compact discs and optical discs featuring entertainment content, namely, stories, music,] and games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive game discs; interactive game programs; interactive game software; video game discs; video game programs; video game software		

U.S. Registration No.	3825823	Application Date	10/02/2008
Registration Date	07/27/2010	Foreign Priority Date	NONE

Word Mark	MARIO & LUIGI		
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Design Mark	MARIO & LUIGI
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2003/11/17 First Use In Commerce: 2003/11/17 Computer/video game cartridges and memory cards featuring entertainment, informational and educational content; computer game cartridges; computer game memory cards; computer game programs; computer game software; electronic video/computergame cartridges; electronic video/computer game memory cards; electronic game programs; electronic game software; interactive video/computer cartridges; interactive video/computer game memory cards; interactive video game programs; interactive video/computer game software; videogame cartridge; video game memory cards; video game programs; video game software

U.S. Registration No.	3711238	Application Date	10/31/2008
Registration Date	11/17/2009	Foreign Priority Date	NONE

Word Mark	DR. MARIO ONLINE RX		
Design Mark	DR. MARIO ONLINE RX		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2008/05/26 First Use In Commerce: 2008/05/26 Computer game programs; computer game software; electronic game programs; electronic game software; interactive video game programs; interactive video game software; video game programs; video game software		

U.S. Registration No.	3851109	Application Date	06/02/2009
Registration Date	09/21/2010	Foreign Priority Date	NONE
Word Mark	MARIO VS. DONKEY KONG		

Design Mark	MARIO VS. DONKEY KONG
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2004/05/24 First Use In Commerce: 2004/05/24 Cartridges and memory cards featuring entertainment, informational and educational content, educational instruction, entertainment instruction and informational instruction, all pertaining to games, puzzles; computer game cartridges; computer game memory cards; computer game programs; computer game software; electronic game cartridges; electronic game memory cards; electronic game programs; electronic game software; interactive game cartridges; interactive game memory cards; interactive game programs; interactive game software; interactive video game cartridges; interactive video game memory cards; interactive video game programs; interactive video game software; video game cartridges; video game memory cards; video game programs; video game software; downloadable multimedia files, namely, games, downloadable computer game programs, downloadable computer game software; downloadable electronic game programs; downloadable electronic game software; downloadable interactive electronic game programs; downloadable interactive game software; downloadable video game programs, downloadable video game software

U.S. Registration No.	4096780	Application Date	06/15/2010
Registration Date	02/07/2012	Foreign Priority Date	NONE
Word Mark	MARIO SPORTS MIX		
Design Mark	MARIO SPORTS MIX		
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2011/02/07 First Use In Commerce: 2011/02/07 Pre-recorded compact discs and optical discs featuring entertainment, educational and informational content pertaining to video and computer games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive electronic game discs; interactive electronic game programs; interactive electronic game software; interactive video game discs; interactive video game pro-		

	grams; interactive video game software; video game discs; video game programs; video game software
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Signature	/katherine keating/
Name	Katherine Keating
Date	04/01/2015

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

NINTENDO OF AMERICA INC.,

Opposer,

v.

MARIO JONES,

Applicant.

Opposition No. _____

Serial No.: 86/283,191

Mark: SUPAH MARRIO

Filed: May 16, 2014

Published: December 2, 2014

Classes: 41

NOTICE OF OPPOSITION

Nintendo of America Inc. (“Nintendo”) believes it will be damaged by registration of Application No. 86/283,191 (the “Application”) for the mark SUPAH MARRIO (“Applicant’s Mark”), filed on May 16, 2014, by Mario Jones (“Applicant”), and hereby opposes such registration. As grounds for opposition, Nintendo alleges as follows:

1. Opposer Nintendo of America Inc. is a Washington corporation with its principal place of business at 4600 150th Avenue NE, Redmond, Washington 98052.
2. Nintendo is informed and believes, and on that basis alleges, that Applicant is an individual with U.S. citizenship and an address of 355 Crescendo Way, Silver Spring, Maryland 20901.
3. Nintendo is an industry leader in the fields of video games, electronic gaming consoles, handheld gaming devices, entertainment services, and related goods and services.
4. Nintendo is the exclusive owner of all rights, title, and interest in, to, and under the mark SUPER MARIO in the United States in connection with goods and services that include video games, online entertainment services, and related entertainment properties.

5. Nintendo began using the SUPER MARIO mark in connection with video games and related goods and services at least as early as 1985, and has used the mark continuously in interstate commerce from that time to the present.

6. Since 1985, Nintendo's Super Mario franchise has become one of the most successful video game franchises of all time, setting records and earning numerous industry awards.

7. Nintendo has also offered video games and related goods and services under related marks that incorporate SUPER MARIO or MARIO (including MARIO BROS., SUPER MARIO BROS., SUPER MARIO BROS. 2, SUPER MARIO LAND, DR. MARIO, SUPER MARIO WORLD, SUPER MARIO 64, SUPER MARIO GALAXY, MARIO KART, MARIO PARTY, MARIO TENNIS, PAPER MARIO, MARIO STRIKERS, MARIO & LUIGI, DR. MARIO ONLINE RX, MARIO VS. DONKEY KONG, MARIO SPORTS MIX, and MARIO GOLF), and is the exclusive owner of all rights, title, and interest in, to, and under such marks in the United States in connection with goods and services that include video games, online entertainment services, and related entertainment properties.

8. Through the widespread and continuous use of Nintendo's SUPER MARIO mark by Nintendo and its authorized licensees, the public has become accustomed to encountering the mark in connection with a wide range of consumer-oriented goods and services, including toys, costumes, home décor items, television programs, movies, and music.

9. Over the decades, Nintendo has expended a substantial amount of time, money, and effort promoting, marketing, and advertising its goods and services under its SUPER MARIO mark.

10. Nintendo's SUPER MARIO mark is inherently distinctive.

11. Nintendo's SUPER MARIO mark is famous.

12. Nintendo owns numerous federal trademark registrations and pending applications for the mark SUPER MARIO and related marks that incorporate SUPER MARIO or MARIO, including the following:

Mark	App. / Reg. No.	Goods / Services	First-Use Date
SUPER MARIO	2,345,441	<i>video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges</i>	Oct. 18, 1985
SUPER MARIO BROS.	2,345,410	<i>video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges</i>	Oct. 18, 1985
SUPER MARIO BROS. 2	1,546,563	<i>electronic game programs</i>	June 4, 1988
SUPER MARIO LAND	1,592,182	<i>electronic game programs</i>	June 2, 1989
SUPER MARIO LAND	4,126,557	<i>downloadable multimedia files, namely, video games; downloadable electronic game programs; downloadable electronic game software; electronic game programs; electronic game software; video game programs; video game software</i>	June 2, 1989
SUPER MARIO WORLD	1,704,302	<i>video games, electronic games and video game software</i>	June 7, 1991
SUPER MARIO 64	2,319,991	<i>toys and games, namely, video game programs, video game software and electronic game programs</i>	May 17, 1996

Mark	App. / Reg. No.	Goods / Services	First-Use Date
SUPER MARIO GALAXY	3,282,201	<i>compact discs and optical discs featuring entertainment content, namely, games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive game discs; interactive game programs; interactive game software; video game discs; video game programs; video game software</i>	May 10, 2006
MARIO BROS.	2,951,313	<i>cartridges featuring entertainment content, namely, games, game facts, game hints, stories and music; computer game cartridges; computer game programs; computer game software; electronic game cartridges; electronic game programs; electronic game software; interactive game cartridges; interactive game programs; interactive game software; video game cartridges; video game programs; video game software</i>	April 6, 1983
DR. MARIO	1,646,158	<i>electronic game programs</i>	June 1, 1990
MARIO KART	2,345,411	<i>video game software, video game programs, video game cartridges, electronic game software, electronic game programs, electronic game cartridges</i>	Sept. 8, 1992
MARIO PARTY	2,387,966	<i>Video game software, video game programs, video game cartridges electronic game software, electronic game programs, electronic game cartridges</i>	Dec. 18, 1998
MARIO GOLF	4,474,791	<i>pre-recorded cartridges and memory cards containing entertainment content, namely, video games and computer games; downloadable multimedia files, namely, video games and computer games; downloadable electronic game programs; downloadable electronic game software; electronic game programs; electronic game software; video game cartridges; video game memory cards; video game programs; video game software</i>	July 26, 1999

Mark	App. / Reg. No.	Goods / Services	First-Use Date
MARIO TENNIS	2,496,094	<i>computer game software; computer game programs; electronic game cartridges; electronic game software; electronic game programs; interactive game programs; interactive game software; interactive game cartridges; video game cartridges; video game software and video game programs</i>	May 14, 2000
PAPER MARIO	2,503,838	<i>computer game software; computer game programs; electronic game software; electronic game programs; interactive game programs; interactive game software; video game software and video game programs</i>	May 14, 2000
MARIO STRIKERS	3,408,861	<i>games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive game discs; interactive game programs; interactive game software; video game discs; video game programs; video game software</i>	July 11, 2007
MARIO & LUIGI	3,825,823	<i>computer/video game cartridges and memory cards featuring entertainment, informational and educational content; computer game cartridges; computer game memory cards; computer game programs; computer game software; electronic video/computer game cartridges; electronic video/computer game memory cards; electronic game programs; electronic game software; interactive video/computer cartridges; interactive video/computer game memory cards; interactive video game programs; interactive video/computer game software; video game cartridge; video game memory cards; video game programs; video game software</i>	Nov. 17, 2003
DR. MARIO ONLINE RX	3,711,238	<i>computer game programs; computer game software; electronic game programs; electronic game software; interactive video game programs; interactive video game software; video game programs; video game software</i>	May 26, 2008

Mark	App. / Reg. No.	Goods / Services	First-Use Date
MARIO VS. DONKEY KONG	3,851,109	<i>cartridges and memory cards featuring entertainment, informational and educational content, educational instruction, entertainment instruction and informational instruction, all pertaining to games, puzzles; computer game cartridges; computer game memory cards; computer game programs; computer game software; electronic game cartridges; electronic game memory cards; electronic game programs; electronic game software; interactive game cartridges; interactive game memory cards; interactive game programs; interactive game software; interactive video game cartridges; interactive video game memory cards; interactive video game programs; interactive video game software; video game cartridges; video game memory cards; video game programs; video game software; downloadable multimedia files, namely, games, downloadable computer game programs, downloadable computer game software; downloadable electronic game programs; downloadable electronic game software; downloadable interactive electronic game programs; downloadable interactive game software; downloadable video game programs, downloadable video game software</i>	May 24, 2004
MARIO SPORTS MIX	4,096,780	<i>pre-recorded compact discs and optical discs featuring entertainment, educational and informational content pertaining to video and computer games; computer game discs; computer game programs; computer game software; electronic game discs; electronic game programs; electronic game software; interactive electronic game discs; interactive electronic game programs; interactive electronic game software; interactive video game discs; interactive video game programs; interactive video game software; video game discs; video game programs; video game software</i>	Feb. 7, 2011

13. On May 16, 2014, Applicant filed Application No. 86/283,191 for the mark SUPAH MARRIO, in connection with “*entertainment, namely, live performances by a musical band*” (“Applicant’s Services”) in class 41.

14. Through the filing of the Application, Applicant claims to have a bona fide intent to use the SUPAH MARRIO mark in commerce in connection with Applicant’s Services.

15. Applicant has not alleged use of the SUPAH MARRIO mark in connection with Applicant’s Services.

16. Nintendo has priority and is the senior user in these opposition proceedings.

17. Nintendo’s SUPER MARIO mark was famous long before May 16, 2014, the date on which Applicant filed the Application.

18. Section 2(d) of the Lanham Act precludes registration of Applicant’s Mark because Applicant’s Mark is confusingly similar to Nintendo’s SUPER MARIO mark in sound, appearance, and commercial impression, and the use of Applicant’s Mark in connection with Applicant’s Services is likely to cause confusion, mistake, and/or deception as to the source of Applicant’s Services.

19. Applicant’s Mark falsely suggests a connection with Nintendo and its goods and services.

20. Registration of Applicant’s Mark will lead the public to incorrectly conclude that Applicant’s Services are or have been authorized, sponsored, or licensed by Nintendo, resulting in damage to Nintendo and the public.

21. Registration of Applicant’s Mark would be inconsistent with Nintendo’s rights in its SUPER MARIO mark.

22. Registration of Applicant's Mark will give the color of exclusive right in Applicant's Mark to Applicant, in violation and derogation of the prior and superior rights of Nintendo.

23. Applicant's mark is likely to impair the distinctiveness of Nintendo's SUPER MARIO mark.

24. Applicant's mark is likely to cause dilution of Nintendo's SUPER MARIO mark.

WHEREFORE, Nintendo of America Inc. prays that this opposition be sustained and registration for Applicant's Mark in connection with the services listed in the Application be denied.

Respectfully submitted,

BRYAN CAVE LLP



Katherine Keating

Dated: April 1, 2015

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Attorneys for NINTENDO OF AMERICA INC.