

ESTTA Tracking number: **ESTTA769282**

Filing date: **09/07/2016**

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	Mattel, Inc.
Granted to Date of previous extension	09/07/2016
Address	333 Continental Blvd. El Segundo, CA 90245 UNITED STATES

Correspondence information	Matt Solmon Senior Counsel Mattel, Inc. 333 Continental Blvd., M1-1518 El Segundo, CA 90245 UNITED STATES matt.solmon@mattel.com, Ronellie.Pasion@Mattel.com, BrandAssurance@Mattel.com Phone:3102522724
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Applicant Information

Application No	86850854	Publication date	05/10/2016
Opposition Filing Date	09/07/2016	Opposition Period Ends	09/07/2016
Applicant	Radio Corporation of America 49R Kings Highway East Haddonfield, NJ 08033 UNITED STATES		

Goods/Services Affected by Opposition

Class 028. First Use: 2015/11/30 First Use In Commerce: 2015/11/30
All goods and services in the class are opposed, namely: Toys, namely, dolls, doll clothing, toy race tracks, miniature dolls, board games, sport balls, and toy trains

Grounds for Opposition

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

U.S. Registration No.	3002016	Application Date	03/08/2005
Registration Date	09/27/2005	Foreign Priority Date	NONE
Word Mark	TYCO		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1953/00/00 First Use In Commerce: 1953/00/00 TOY VEHICLES		

U.S. Registration No.	1326761	Application Date	05/22/1984
Registration Date	03/26/1985	Foreign Priority Date	NONE
Word Mark	TYCO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1984/02/20 First Use In Commerce: 1984/02/20 [Telephones] Class 028. First use: First Use: 1953/08/00 First Use In Commerce: 1953/08/00 Toy [or Scale Model Train and] Road Racing Sets and Accessories; [Toy or Scale Model Planes; Building Blocks; Batting Trainers; Equipment Sold as a Unit forPlaying Racquet Games]		

Attachments	78583143#TMSN.png(bytes) Notice of Opposition of TYCO - Radio Corporation of America - Final - DMS 2068928_1.pdf(49914 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	/mss/
Name	Matt Solmon
Date	09/07/2016

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

Mattel, Inc.,	§	
	§	
Opposer,	§	Opposition No. _____
	§	
v.	§	Application Ser. No.: 86/850,854
	§	
Radio Corporation of America,	§	Date of Filing: December 16, 2015
	§	
Applicant.	§	Subject Mark: TYCO
	§	
	§	

NOTICE OF OPPOSITION

Opposer Mattel, Inc., a Delaware corporation ("Mattel"), having a place of business at 333 Continental Boulevard, El Segundo, California 90245, believes that it will be damaged by the registration of U.S. Ser. No. 86/850,854 ("the '854 Application"), filed December 16, 2015, for the mark TYCO and hereby opposes same on the following grounds:

MATTEL'S TYCO MARKS

1. Mattel is the world's largest toy company and is the owner of various famous brands, including its well-known TYCO franchise of toys and related goods and services.
2. Over the past 60 years, Mattel (and/or its predecessor-in-interest) have used the TYCO mark in connection with a wide range of toys, games, playthings and toy vehicles, including model trains, radio control cars, toy vehicles, dolls, consumer electronics, and video games. Such use long predates Applicant's claimed first use of TYCO.
3. Mattel and/or its predecessor-in-interest owned a number of registrations for TYCO and TYCO-formative marks in connection with a variety of goods and services ("prior TYCO registrations"). Those registrations predate Applicant's claimed first use of TYCO.
4. An affidavit of continued use was not filed for any of the prior TYCO registrations and such registrations were cancelled for failure to file such affidavit. Notwithstanding such cancellation, Mattel maintained common-law rights in the TYCO mark. In no event did Mattel or its predecessor-in-interest cease use of the TYCO mark with an intent not to resume use. Mattel has valid and continuing rights in the TYCO marks and has not abandoned the marks. To the extent there were periods during which Mattel did not use the marks, Mattel never lacked an intent to resume use of the marks.

5. Specifically, Mattel’s (and its predecessor-in-interest’s) products sold under the TYCO marks continue to be advertised, sold, and distributed in the secondary market and the primary market. Those products are, and remain, popular among fans and collectors alike. Such longstanding use and public awareness has generated significant goodwill for Mattel for goods sold under the TYCO mark.

6. Because of their long-standing use and recognition, Mattel’s highly distinctive TYCO mark represents tremendous goodwill. The TYCO mark is instantly recognizable and associated exclusively with Mattel in connection with toys, toy vehicles, games, playthings, electronics, and related goods and services.

7. Mattel has expended considerable effort and expense in promoting the TYCO mark, and goods and services offered in connection with these marks, in the United States.

APPLICANT’S TYCO MARK

8. Applicant seeks to register the mark TYCO in connection with “Toys, namely, dolls, doll clothing, toy race tracks, miniature dolls, board games, sport balls, and toy trains” in International Class 28. Applicant claimed first use of the mark as of November 30, 2015, and first use in commerce as of November 30, 2015. Applicant attached a specimen of use of the mark showing a picture of a toy train with a “TYCO” logo on it that copies, nearly identically, if not identically, Mattel’s TYCO logo that is or has been used for numerous years prior to Applicant’s use or filing date. Mattel suspects that the specimen of use, in fact, is a photo of Mattel’s and/or its predecessor-in-interest’s previously-distributed genuine product, and is not Applicant’s product and, therefore, is not bona fide use in commerce of the mark by Applicant. See Figure 1, below.



Mattel’s TYCO Logo



Applicant’s Specimen of Use

Figure 1

9. The '854 Application was published for opposition on May 10, 2016. Mattel timely took an extension of time to oppose the '854 Application on June 8, 2016, giving Mattel until September 7, 2016, to oppose the application. Thus, Mattel's Opposition is timely.

10. Upon information and belief, Applicant selected the TYCO mark with knowledge of Mattel's TYCO mark, with intent to copy Mattel's TYCO logo, and with intent to trade off of Mattel's goodwill in the TYCO mark.

11. Mattel is not affiliated or connected with Applicant or its goods or services; nor has Mattel endorsed or sponsored Applicant or its goods or services.

FIRST GROUND FOR OPPOSITION:

LIKELIHOOD OF CONFUSION

12. Mattel incorporates by reference paragraphs 1 through 11, inclusive, as if fully set forth here.

13. Mattel (through its predecessor-in-interest) began using its TYCO mark, and enjoys priority as a result of its use and based on the filing dates of its prior TYCO registrations, all of which were well prior to the filing date of the '854 application.

14. Applicant's TYCO Mark is identical in sound, appearance, and commercial impression to Mattel's TYCO mark. Moreover, Applicant's logo, as shown in its specimen of use, is, or is nearly, identical to Mattel's TYCO logo that is or has been used.

15. In view of the strength of the TYCO mark, Mattel's longstanding use of the mark on a variety of goods and services, including but not limited to toys and toy vehicles, and the identical nature of Applicant's goods to Mattel's products and services, purchasers are likely to mistakenly believe that Applicant's TYCO goods and services originate from, are sponsored by, or are in some way associated with Mattel, when they are not.

16. Neither Mattel's nor Applicant's identifications of goods and services contain any limitation on channels of trade. Thus, because the goods and services are of a type that would be offered to and obtained by the general public, the channels of trade for the respective parties' goods and services completely overlap.

17. Applicant's mark was filed as a standard character mark; therefore, nothing prevents Applicant from using a font or stylization similar to that used by Mattel in connection with its TYCO marks, as demonstrated by its specimen of use. Nothing would prevent

Applicant from using a stylization similar to Mattel's additional logo, as shown in Application Ser. No. 86/853,572.

18. Registration of Applicant's TYCO mark will injure Mattel by causing the public to be confused or mistaken into believing that the goods and services provided by Applicant are endorsed or sponsored by Mattel. Mattel has no control over the nature and quality of the goods and services offered by Applicant under the identical TYCO mark, and Mattel's reputation and goodwill will be damaged and the value of Mattel's TYCO marks jeopardized, all to Mattel's detriment.

19. Any defect, objection, or fault found with Applicant's goods or services marketed under the TYCO mark would necessarily reflect upon and injure the reputation that Mattel has established for the goods and services it offers in connection with the TYCO mark.

20. Accordingly, registration of the mark herein will damage Mattel because the mark is likely, when used on or in connection with the goods and services identified in the registration, to cause confusion, or to cause mistake or to deceive.

21. For all of these reasons, Mattel is likely to be damaged by the registration for TYCO by Applicant.

WHEREFORE, Petitioner respectfully requests that Application Serial No. 86/850,854 be refused registration.

Respectfully submitted,
Mattel, Inc.

Date: September 7, 2016

By: /s/ Matt Solmon
Matt Solmon
Senior Counsel
MATTEL, INC.
333 Continental Blvd., M1-1518
El Segundo, CA 90245
(310) 252-2724

CERTIFICATE OF ELECTRONIC TRANSMISSION
September 7, 2016
I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.
<u>/s/ Matt Solmon</u> Matt Solmon

CERTIFICATE OF SERVICE VIA MAIL

I, Matt Solmon., of Mattel, Inc., hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION was served via postage prepaid first class mail on September 7, 2016 on Applicant at Radio Corporation of America, 49R Kings Highway East, Haddonfield, New Jersey 08033.

/s/ Matt Solmon

Matt Solmon