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

IN THE MATTER OF APPLICATION

Mark: ES MAS & Design
Applicant: Televisa S.A. de C.V.
Serial No.: 76/006,285
Filed: March 21, 2000
Published in
the Official Gazette: June 5, 2001



05-01-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #34

_____ X

MASTERCARD INTERNATIONAL
INCORPORATED, :

Opposer, :

Opposition No. __, __

v. :

TELEVISA S.A. DE C.V., :

Applicant. :

_____ X

05/06/2002 HPETTY 00000133 76006285

01 FC:377

1500.00 DP

NOTICE OF OPPOSITION

MasterCard International Incorporated, a Delaware corporation located and doing business at 2000 Purchase Street, New York 10577-2509 (hereinafter referred to as "MasterCard" or "Opposer") believes that it will be damaged by the registration of application Serial No. 76/006,285, filed on March 21, 2000, by Televisa S.A. de C.V. for the alleged mark ES MAS & Design for "promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through a global computer network and computer databases; dissemination of advertising for others via global computer networks and

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computer databases; sales promotion for others, namely promoting goods and services of others featuring general merchandise and general consumer goods; online retail department and convenience stores; computerized online retail and mail order services featuring general merchandise and general consumer goods; providing an online commercial information directory; providing a searchable database in the field of business information available via a global computer network; providing a searchable online advertising guide featuring the goods and services of online vendors in class 35; providing finance information by means of a global communications network in class 36; providing multiple user access to a global computer information network in class 38; providing music, entertainment, and sports information by means of a global communications network in class 41; and providing news, politics, family life, and children's topics information by means of a global communications network; providing computer search engine services for others, namely, creating indexes of information, data, sites and other resources, available via a global computer network and computer databases; searching and retrieving information, data, sites and other resources available via a global computer network, and computer databases; computer services, namely providing search engines for obtaining information and data on a global computer network; computer services, namely designing and implementing web sites for others and hosting web sites of others in a global computer network in class 42" and, having previously been granted extensions of time to oppose, hereby opposes same.

The specific grounds for this opposition are as follows:

1. Opposer is an incorporated association of banks and other domestic and foreign financial institutions whose purpose is, inter alia, to facilitate various financial services transactions, including the interchange of funds through payment cards, credit cards, debit cards and smart cards on a worldwide basis. Many of Opposer's services are designed to facilitate e-

commerce and promote the goods and services of others. Opposer also provides a wide-range of financial information services, which are provided by electronic and non-electronic means.

2. Opposer has been in the payment card business since 1966 and has become well and favorably known to members of the public, as well as to members of the banking and financial services community, as a leader in the payment card field. Since 1966, Opposer has used a prominent design element, namely, the famous "Interlocking Circles" device, to identify its various services and products. Opposer initially owned and administered the celebrated MASTERCHARGE payment program and it now owns and administers the MASTERCARD payment card program. There are over 437 million MASTERCARD payment cards in circulation worldwide, which have been issued by over 20,000 licensed member banks and financial institutions having more than 200,000 branches. Approximately 235 million of these cards are currently in circulation in the United States. Opposer's MASTERCARD payment cards are accepted at more than 20.7 million locations, including ATMs, merchants and cash advance locations, and more than \$850 billion dollars worth of purchases or cash advances were transacted in the year 2000 using a MASTERCARD payment card. During the last 3 years alone, MasterCard has expended in excess of \$390,000,000 in advertising its MASTERCARD payment card services and other related products and services in North America, and over \$510,000,000 on marketing and advertising its products and services worldwide and, for the period prior thereto, spent comparably substantial sums.

3. Each and every MASTER CHARGE and MASTERCARD payment card that has ever been issued by Opposer and virtually all advertising therefore has borne the famous "Interlocking Circles" device.

4. Opposer is the owner of, inter alia, the following United States Trademark and Service Mark registrations, each of which incorporate the "Interlocking Circles" device:

<u>Mark</u>	<u>Reg. No.</u>
MASTERCARD II & Design	1,241,417
MASTERCARD & Design	1,257,853
MASTERCARD TRAVELERS CHEQUE & Design	1,270,220
MASTERCARD TRAVELERS CHEQUE & Design Card Design	1,285,549
Interlocking Circles Design	1,365,901
Interlocking Circles Design	1,494,516
Interlocking Circles Design	1,723,718
Globe Hologram Design	1,738,276
MASTERCARD & Design	1,814,279
MASTERCARD & Design	2,168,736
SHOP SMART MASTERCARD & Design	2,348,129
MASTERCARD EXCLUSIVES ONLINE & Design	2,428,346
Interlocking Circles Design	2,376,729
Interlocking Circles Design	2,038,134
MASTERCARD & Design	1,890,786
Card Design	2,212,340

These registrations are valid and subsisting, uncancelled and unrevoked, and in full force and effect. Many of the foregoing registrations are incontestable pursuant to 15 U.S.C. § 1065.

5. Use of the "Interlocking Circles" device has been continuous since the date of first use in 1966 and said device has not been abandoned. As a result of enormous advertising, promotion, card usage, point of sale signage and other extensive usage, the "Interlocking Circles" device has become one of the most renowned brands in the world, including the United States, and represents an asset of enormous goodwill of inestimable value to Opposer.

6. As a result of the long, extensive and widespread use, advertising and registration of the "Interlocking Circles" device on and in association with Opposer's various

services and products, consumers have become accustomed to associate marks consisting of or containing an interlocking circles device with Opposer.

7. By the application opposed herein, Applicant seeks to register the alleged mark ES MAS & Design as a service mark for "promoting the goods and services of others by placing advertisements and promotional displays in an electronic site accessed through a global computer network and computer databases; dissemination of advertising for others via global computer networks and computer databases; sales promotion for others, namely promoting goods and services of others featuring general merchandise and general consumer goods; online retail department and convenience stores; computerized online retail and mail order services featuring general merchandise and general consumer goods; providing an online commercial information directory; providing a searchable database in the field of business information available via a global computer network; providing a searchable online advertising guide featuring the goods and services of online vendors in class 35; providing finance information by means of a global communications network in class 36; providing multiple user access to a global computer information network in class 38; providing music, entertainment, and sports information by means of a global communications network in class 41; and providing news, politics, family life, and children's topics information by means of a global communications network; providing computer search engine services for others, namely, creating indexes of information, data, sites and other resources, available via a global computer network and computer databases; searching and retrieving information, data, sites and other resources available via a global computer network, and computer databases; computer services, namely providing search engines for obtaining information and data on a global computer network; computer services, namely designing and implementing web sites for others and hosting web sites of others in a global computer network in class 42."

8. The design portion of Applicant's alleged mark, ES MAS & Design, is a colorable imitation of Opposer's aforementioned previously used and registered, famous "Interlocking Circles" device.

9. Upon information and belief, the services which are to be offered by Applicant under its alleged mark, ES MAS & Design, are closely related to the services long offered by Opposer under its famous "Interlocking Circles" device.

10. Upon information and belief, the services which are to be offered by Applicant under its alleged mark, ES MAS & Design, will be encountered by the same or a similar class of purchasers as those who are interested in or familiar with the services long offered by Opposer under its famous "Interlocking Circles" device.

11. The design portion of Applicant's alleged mark, ES MAS & Design, so resembles Opposer's previously used and registered famous "Interlocking Circles" device as to be likely to cause confusion, to cause mistake or to deceive, with consequent injury to Opposer and the public.

12. Specifically, and without limitation, the marketing and sale of Applicant's aforementioned services under the alleged mark ES MAS & Design is likely to cause consumers to believe that Applicant's services are those of Opposer, or that Applicant's services are connected with those of Opposer, or that Applicant is somehow related or sponsored by Opposer. Accordingly, Applicant's alleged mark is not entitled to registration pursuant to 15 U.S.C. §1052(d).

13. Further, the design portion of Applicant's alleged mark will lessen the capacity of Opposer's famous and distinctive "Interlocking Circles" device to distinguish and identify Opposer's services and products from those of others, thereby diluting the distinctive

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quality of said device in violation of 15 U.S.C. § 1125(c). Accordingly, Applicant's alleged mark is not entitled to registration under 15 U.S.C. § 1052(f).

14. Opposer will be damaged by the registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading and dilutive use of Applicant's alleged mark, ES MAS & Design, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

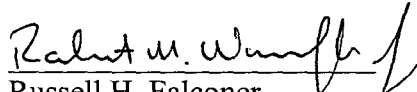
WHEREFORE, Opposer prays that this Notice of Opposition be sustained and that the registration sought by Applicant be denied.

Respectfully submitted,

BAKER BOTTS L.L.P.

Dated: May 1, 2002

By:



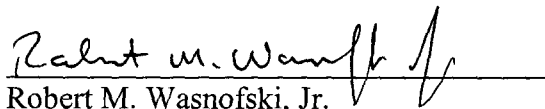
Russell H. Falconer
Robert M. Wasnofski, Jr.
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Attorneys for Opposer

CERTIFICATE OF EXPRESS MAILING

I hereby certify that on the date set forth below that this paper is being deposited with the United States Postal Service "Express Mail Post Office To Addressee Service" in an envelope with sufficient postage addressed to: BOX TTAB FEE, Assistant Commissioner For Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

5/1/02
Date of Deposit


Robert M. Wasnofski, Jr.

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May 1, 2002

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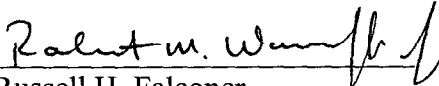
Re: Mark : ES MAS & Design
Applicant : Televisa S.A. de C.V.
Serial No. : 76/006,285

Dear Madam:

I enclose for filing on behalf of Opposer, MasterCard International Incorporated, a Notice of Opposition to the above-captioned mark. A check in the amount of \$1,500.00 is enclosed to cover the filing fee.

If the fee enclosed is found to be inadequate, please draw the additional amount from our deposit account number 02-4377.

Respectfully submitted,

By: 
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Attorney for Opposer

Enclosures