

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

In re Application No. 76/491,767 for the mark MUNCHKIN CLUB filed on February 24, 2003,  
and published on October 28, 2003

TURNER ENTERTAINMENT CO.	:	
	:	
Opposer	:	
	:	
v.	:	Opp. No. _____
	:	
TIM KASBERGER PHOTOGRAPHY	:	
	:	
Applicant	:	

**NOTICE OF OPPOSITION**

Turner Entertainment Co. believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to the mark MUNCHKIN for a variety of goods and services.
2. Since long prior to the acts complained of in this notice, Opposer has continuously used the MUNCHKIN mark for various products and services.
3. Opposer has filed the following applications to register the mark MUNCHKIN in the Patent and Trademark Office: Application Nos. 74/516183, 74/516189, 76/360786, and 76/447,592.
4. The mark MUNCHKIN has been widely used and publicized for a period of many years, through association with *The Wizard of Oz*, one of the most popular motion pictures ever created.

03/01/2004 TSMITH 00000112 76491767<sup>5</sup> Opposer owns all rights to the trademarks associated with said motion

01 FC:6402 300.00 OP

picture, including MUNCHKIN, which have been widely used for a period of many years in connection with a wide variety of goods and services.

6. A substantial investment has been made in advertising and promoting goods and services sold under Opposer's mark MUNCHKIN.

7. Opposer has built extensive goodwill in its MUNCHKIN mark, as a result of the significant advertising and publicity, and the mark has become well known and famous as a distinctive indicator of the origin of Opposer's goods and it symbolizes Opposer's valuable goodwill.

8. Since the first use of the MUNCHKIN mark, Opposer and its related companies have distributed products bearing the mark throughout the United States.

9. Opposer's MUNCHKIN mark has been used on a variety of goods by licensees, pursuant to agreements under which Opposer controls the nature and quality of the goods.

10. Notwithstanding Opposer's prior rights in its mark, Applicant filed the above referenced application for registration of the mark MUNCHKIN CLUB photography services.

11. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the date of first use alleged its application.

12. Upon information and belief, Applicant knew or had reason to know of Opposer's MUNCHKIN mark when Applicant filed its application.

13. Opposer has used its MUNCHKIN mark continuously on or in connection with its good and services in interstate commerce since long prior to the date of first use alleged in Applicant's application.

**Likelihood of Confusion - §2(d)**

14. The mark which Applicant seeks to register is identical to or so resembles Opposer's name and mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark.

15. The goods and services of Applicant are so related to the goods and services sold under Opposer's mark, that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods and services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

16. Likelihood of confusion in this case is enhanced by the fame of Opposer's mark and by the fact that consumers associate said mark with goods sold, approved or endorsed by Opposer; moreover, individuals that might purchase Applicant's goods are prospective purchasers of products sold under Opposer's mark.

**Deception/False Suggestion of Connection - §2(a)**

17. Applicant's mark so closely resembles Opposer's mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods.

18. Applicant's alleged mark so closely resembles Opposer's mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that

goods offered under Applicant's alleged mark are connected with Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TURNER ENTERTAINMENT CO.

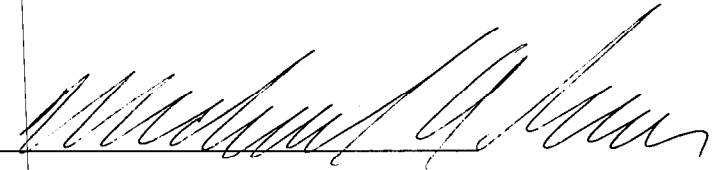
By 

Michael A. Grow  
Chiara Giuliani  
Arent Fox Kintner Plotkin & Kahn, PLLC  
1050 Connecticut Avenue, NW  
Washington, D.C. 20036  
(202) 857-6000

Attorney for Opposer

**CERTIFICATE OF MAILING**

It is hereby certified that the attached Notice of Opposition and check (re S/N 76/491767) are being deposited with the U.S. Postal Service addressed to the Hon. Commissioner of Patents and Trademarks, Washington, DC 20231 this 25th day of February 2004 marked first class mail, postage prepaid.



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

In re Application No. 76/491,767 for the mark MUNCHKIN CLUB filed on February 24, 2003,  
and published on October 28, 2003

TURNER ENTERTAINMENT CO. :

Opposer :

v. :

Opp. No. \_\_\_\_\_

TIM KASBERGER PHOTOGRAPHY :

Applicant :

**NOTICE OF OPPOSITION**

Turner Entertainment Co. believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to the mark MUNCHKIN for a variety of goods and services.
2. Since long prior to the acts complained of in this notice, Opposer has continuously used the MUNCHKIN mark for various products and services.
3. Opposer has filed the following applications to register the mark MUNCHKIN in the Patent and Trademark Office: Application Nos. 74/516183, 74/516189, 76/360786, and 76/447,592.
4. The mark MUNCHKIN has been widely used and publicized for a period of many years, through association with *The Wizard of Oz*, one of the most popular motion pictures ever created.
5. Opposer owns all rights to the trademarks associated with said motion

picture, including MUNCHKIN, which have been widely used for a period of many years in connection with a wide variety of goods and services.

6. A substantial investment has been made in advertising and promoting goods and services sold under Opposer's mark MUNCHKIN.

7. Opposer has built extensive goodwill in its MUNCHKIN mark, as a result of the significant advertising and publicity, and the mark has become well known and famous as a distinctive indicator of the origin of Opposer's goods and it symbolizes Opposer's valuable goodwill.

8. Since the first use of the MUNCHKIN mark, Opposer and its related companies have distributed products bearing the mark throughout the United States.

9. Opposer's MUNCHKIN mark has been used on a variety of goods by licensees, pursuant to agreements under which Opposer controls the nature and quality of the goods.

10. Notwithstanding Opposer's prior rights in its mark, Applicant filed the above referenced application for registration of the mark MUNCHKIN CLUB photography services.

11. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the date of first use alleged its application.

12. Upon information and belief, Applicant knew or had reason to know of Opposer's MUNCHKIN mark when Applicant filed its application.

13. Opposer has used its MUNCHKIN mark continuously on or in connection with its good and services in interstate commerce since long prior to the date of first use alleged in Applicant's application.

**Likelihood of Confusion - §2(d)**

14. The mark which Applicant seeks to register is identical to or so resembles Opposer's name and mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods and services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's mark.

15. The goods and services of Applicant are so related to the goods and services sold under Opposer's mark, that the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods and services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by or affiliated with Opposer, all to Opposer's irreparable damage.

16. Likelihood of confusion in this case is enhanced by the fame of Opposer's mark and by the fact that consumers associate said mark with goods sold, approved or endorsed by Opposer; moreover, individuals that might purchase Applicant's goods are prospective purchasers of products sold under Opposer's mark.

**Deception/False Suggestion of Connection - §2(a)**

17. Applicant's mark so closely resembles Opposer's mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods.

18. Applicant's alleged mark so closely resembles Opposer's mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that

goods offered under Applicant's alleged mark are connected with Opposer.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TURNER ENTERTAINMENT CO.

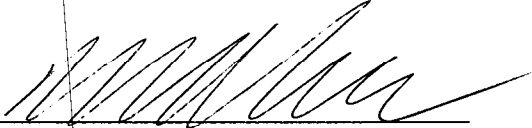
By 

Michael A. Grow  
Chiara Giuliani  
Arent Fox Kintner Plotkin & Kahn, PLLC  
1050 Connecticut Avenue, NW  
Washington, D.C. 20036  
(202) 857-6000

Attorney for Opposer

**CERTIFICATE OF MAILING**

It is hereby certified that the attached Notice of Opposition and check (re S/N 76/491767) are being deposited with the U.S. Postal Service addressed to the Hon. Commissioner of Patents and Trademarks, Washington, DC 20231 this 25th day of February 2004 marked first class mail, postage prepaid.





TTAB

**Arent Fox**  
ATTORNEYS AT LAW

February 25, 2004

**Michael A. Grow**  
202.857.6389 DIRECT  
202.857.6395 FAX  
grow.michael@arentfox.com

Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202

**Re: Turner Entertainment Co. v.  
Tim Kasberger Photography  
Appl. S/N 76/491,767 – MUNCHKIN CLUB  
Our Ref: 019429-135**



02-26-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64

Dear Sir:

Enclosed for filing, in duplicate, is a notice of opposition to the above referenced application.

Also enclosed is our check for \$300.00 to cover the filing fee. Please charge any additional fee that may be required to our deposit account No. 01-2300.

All correspondence pertaining to this application should be directed to Applicant's counsel Michael A. Grow at Arent Fox Kintner Plotkin & Kahn, PLLC, 1050 Connecticut Avenue, NW, Washington, DC 20036.

Sincerely,

ARENT FOX PLLC

Michael A. Grow

Enclosures



02-26-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #64

PRE-SHIP **neopost**  
 LOGISTICS SYSTEMS

[Profile](#) [Address Book](#) [History](#)

Your Parcel is Ready to Ship

Ship Via: Letter Mail

<b>From:</b> Bertha Flores 1050 Connecticut Ave NW Washington DC 20036 flores.bertha@arentfox.com	<b>To:</b> Commissioner for Trademarks 2900 Crystal Dr Arlington VA 22202-3514
<b>Dest. Type:</b> Business <b>Enter Attorney #:</b> 1177 <b>Enter Client #:</b> 019429 <b>Enter Matter #:</b> 00135 <b>Weight:</b> 2.0 Lb.	<b>Parcel ID#:</b> 0000110360

Additional Instructions:

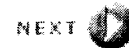
[Empty box for additional instructions]

POSTAL SERVICES:

- Registered Mail
- Certified Mail
- Return Receipt

**Print Document**

**Add a Parcel**



Print this travel document and affix to parcel for mailroom processing

Due in Mail Center by 6:30 PM

Created 02/25/04 17:10

NOTICE: Prices and delivery times are based on information provided at time of online processing. All price and time-in-transit information determined at the time of actual processing will supercede values calculated online.

[Home](#) | [Ship](#) | [Track](#) | [Help](#)