

ESTTA Tracking number: **ESTTA449340**

Filing date: **01/04/2012**

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	Pilot Corporation of America
Granted to Date of previous extension	01/04/2012
Address	3855 Regent Blvd Jacksonville, FL 32224 UNITED STATES
Attorney information	EDMUND J FERDINAND III JEFFERS COWHERD PC 55 WALLS DRIVE FAIRFIELD, CT 06824 UNITED STATES jferdinand@jeffers-law.com Phone:203-259-7900

### Applicant Information

Application No	85185293	Publication date	09/06/2011
Opposition Filing Date	01/04/2012	Opposition Period Ends	01/04/2012
Applicant	Tech 4 Kids Inc. Unit 28 1200 Aerowood Drive Mississauga, Ontario, L4W2S7 CANADA		

### Goods/Services Affected by Opposition

Class 028. All goods and services in the class are opposed, namely: children's multiple activity toys; children's toy drawing boards; drawing toys and accessories therefor
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### 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.	1437414	Application Date	06/19/1986
Registration Date	04/21/1987	Foreign Priority Date	NONE
Word Mark	MAGNA DOODLE		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 028. First use: First Use: 1986/06/16 First Use In Commerce: 1986/06/16 DRAWING TOY

Attachments	Notice of Opposition to MAGNA COLOR.pdf ( 5 pages )(95748 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	/ejf/
Name	EDMUND J FERDINAND III
Date	01/04/2012

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

In the Matter of Application Serial No. 85/185,293  
For the Mark MAGNA COLOR  
Published in the Official Gazette on September 6, 2011

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Pilot Corporation of America,	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No.:
	:	
Tech 4 Kids, Inc.,	:	
	:	
Applicant.	:	
-----X	:	

**NOTICE OF OPPOSITION**

Pilot Corporation of America (“Opposer” or “PCA”) believes that it will be damaged by registration of the mark shown in Application Serial No. 85/185,293 for the mark MAGNA COLOR and hereby opposes the same. The grounds for opposition are as follows:

1. PCA is a corporation organized and existing under the laws of Delaware, having an office at 3855 Regent Boulevard, Jacksonville, Florida 32224 (having relocated from its address of record in Trumbull, Connecticut).

2. Upon information and belief, Applicant, Tech 4 Kids, Inc. (“Applicant”), filed an intent-to-use trademark application bearing serial number 85/185,293 for the mark MAGNA COLOR for use in connection with “children’s multiple activity toys; children’s toy drawing boards; drawing toys and accessories therefor” in International Class 28 on December 1, 2010.

3. PCA is the owner of the MAGNA DOODLE trademark and U.S. Trademark Registration No. 1,437,414 for use in connection with a “drawing toy” in International Class 28

on the Principal Register. This mark is incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065.

4. Opposer's MAGNA DOODLE drawing toy product is a highly successful and enduring product that has been a top-selling toy in the United States since at least as early as 1986. Opposer has been using its MAGNA DOODLE trademark in continuous and widespread use in commerce since at least June 16, 1986, and it also acquired rights to the MAGNA DOODLE mark that date from 1978.

5. Opposer and its authorized licensees use the MAGNA DOODLE trademark on packaging for the MAGNA DOODLE toy, in advertisements, on the Internet and in other forums.

6. As a result of the widespread use in interstate commerce by the Opposer and its licensees of the aforesaid MAGNA DOODLE trademark, the mark has acquired extensive goodwill and has developed a high degree of distinctiveness in connection with drawing toys in International Class 28. Further, the MAGNA DOODLE trademark is well-known and is recognized as identifying high quality toy products which have their origin with or have been authorized by the Opposer.

7. Applicant's MAGNA COLOR mark falsely suggests a connection with the identity of Opposer's MAGNA DOODLE trademark.

8. Applicant's MAGNA COLOR mark is confusingly similar to Opposer's registered and well-known MAGNA DOODLE trademark in appearance, sound and commercial impression. As the term "MAGNA" comprises the dominant and most important component of Opposer's trademark, such usage by Applicant is confusingly similar in appearance, sound and commercial impression. Moreover, the use of MAGNA in Applicant's mark was obviously

selected to draw an association with Opposer's renowned MAGNA DOODLE trademark and to purposefully trade on the goodwill and strong commercial recognition Opposer has gained over the years with its MAGNA DOODLE mark for use in connection with drawing toys.

9. Applicant's MAGNA COLOR trademark will be used in connection with the exact same type of drawing toy sold and provided in connection with Opposer's MAGNA DOODLE trademark. Such toys are likely to travel and be promoted through the same channels of trade for sale to, and use by, the same class of purchasers. As such, consumers are likely to believe mistakenly that the MAGNA COLOR toy is the same as, from the same source as, or otherwise affiliated with, the MAGNA DOODLE drawing toy line.

10. Opposer's MAGNA DOODLE trademark has acquired secondary meaning and distinctiveness. Through longstanding and widespread use and controlled marketing, the MAGNA DOODLE trademark has become highly distinctive and strongly associated in the United States with high quality drawing toys emanating from a single source. Therefore, it is quite likely that distributors, retailers and consumers will believe mistakenly that drawing toys bearing Applicant's MAGNA COLOR trademark are associated with Opposer's MAGNA DOODLE drawing toys.

11. Applicant's use of the MAGNA COLOR trademark is likely to cause confusion, mistake and/or deception as to the source of origin of Applicant's products in that the public, the trade and others are likely to believe that Applicant's products are Opposer's MAGNA DOODLE products and/or that Applicant's products are provided by, sponsored by, approved by, licensed by, affiliated with or in some other way legitimately connected to Opposer's MAGNA DOODLE products.

12. Finally, any doubt about the likelihood of confusion must be resolved in favor of

Opposer because Applicant had a legal duty to select a mark that was totally dissimilar to a trademark already in use, and it knowingly and willfully failed to do so.

WHEREFORE, PCA respectfully requests that this Opposition be sustained and that Applicant's application to register MAGNA COLOR as a mark for goods in International Class 28 be refused in all respects.

Dated: January 4, 2012

Respectfully submitted,

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Attorneys for Opposer

**CERTIFICATE OF SERVICE AND FILING**

This certifies that a copy of the foregoing Notice of Opposition was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to Applicant's counsel of record:

Gerald Gowan, Esq.  
Gowan Intellectual Property  
Suite 204  
627 Lyons Lane  
Oakville, Ontario L6J5Z7  
CANADA

and further certifies that the aforementioned document was filed with the Trademark Trial and Appeal Board on the date indicated below via the Board's online electronic filing system.

Dated: January 4, 2012

\_\_\_\_\_/ejf/\_\_\_\_\_  
Edmund J. Ferdinand, III