

ESTTA Tracking number: **ESTTA834697**

Filing date: **07/21/2017**

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                                  | Robert Anderson  |
| Granted to Date of previous extension | 07/22/2017   |
| Address                               | P.O. Box 23481<br>Santa Fe, NM 87502<br>UNITED STATES  |
| Attorney information                  | Robert J. Itri<br>Milligan Lawless, P.C.<br>5050 N. 40th Street, Suite 200<br>Phoenix, AZ 85018<br>UNITED STATES<br>Email: bob.itri@milliganlawless.com, jeanette@milliganlawless.com<br>Phone: 602-792-3532 |

**Applicant Information**

|                                |   |                                 |            |
|--------------------------------|---|---------------------------------|------------|
| Application No                 | 87124063  | Publication date                | 05/23/2017 |
| Opposition Filing Date         | 07/21/2017  | Opposition Period Ends          | 07/22/2017 |
| International Registration No. | NONE  | International Registration Date | NONE       |
| Applicant                      | MATTEL, INC.<br>M1-1518<br>333 CONTINENTAL BOULEVARD<br>EL SEGUNDO, CA 90245<br>UNITED STATES |                                 |            |

**Goods/Services Affected by Opposition**

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|--|
| Class 028. First Use: 0 First Use In Commerce: 0<br>All goods and services in the class are opposed, namely: Sporting articles, namely, roller skates, in-line skates, skateboards, sport balls, play balls, elbow, knee, wrist and shin guards for athletic use, play swimming pools, swim floats for recreational use; decorations for Christmas trees; dolls; doll clothing; doll accessories; toy figures; toy action figures; playsets for dolls; construction toys; toy vehicles |
|--|

**Applicant Information**

|                        |              |                        |            |
|------------------------|--------------|------------------------|------------|
| Application No         | 87124065     | Publication date       | 06/13/2017 |
| Opposition Filing Date | 07/21/2017   | Opposition Period Ends |            |
| Applicant              | MATTEL, INC. |                        |            |

|  |   |
|--|---|
|  | M1-1518<br>333 CONTINENTAL BOULEVARD<br>EL SEGUNDO, CA 90245<br>UNITED STATES |
|--|---|

## Goods/Services Affected by Opposition

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|--|
| <p>Class 009. First Use: 0 First Use In Commerce: 0<br/>All goods and services in the class are opposed, namely: DVDs featuring children's entertainment; computer game software; computer application game software for mobile phones, portable media players, handheld computers and tablet computers for playing games; protective covers and cases for tablet computers; protective covers and cases for cell phones, laptops and portable media players; electronics, namely, radios and digital music players; eyewear; safety helmets; swimming aids, namely, swimming goggles, swimming masks, snorkels</p>  |
| <p>Class 016. First Use: 0 First Use In Commerce: 0<br/>All goods and services in the class are opposed, namely: Children's books; stationery; writing utensils; printed matter, namely, greeting cards and paper invitations; temporary tattoo transfers; paper, cardboard and goods made from these materials, namely, blank journals, diaries, folders, notebooks, book marks, temporary tattoo transfers, note cards, invitation cards, document portfolios, adhesive note pads, agendas, postcards, memo pads; paper school supplies, namely, decorative paper for use in decorating lockers; paper and cardboard products, namely, paper napkins, table cloths of paper, crepe paper, banners of paper, party goodie bags of plastic or paper; comic books, printed magazines of general interest for teenagers and children; adhesives for stationery or household purposes, namely, glue for stationery or household use, adhesive tape and adhesive tape dispensers, both for stationery and household purposes; artists' materials, namely, markers, pens, pencils, pencil and pen cases, erasers, drawing rulers, sketch design books, stencil sets consisting of stencils and colored pencils; typewriters and office requisites, namely, magnetic boards for scheduling activities and appointments, dry erase writing boards, desktop organizers, binders, paper clips and staplers; lap desks; rubber stamps; iron-on transfers; coloring books</p> |
| <p>Class 025. First Use: 0 First Use In Commerce: 0<br/>All goods and services in the class are opposed, namely: Clothing, namely, tops, bottoms, shirts, pants, underwear, sleepwear, bathing suits, jackets, socks, mittens, gloves, Halloween costumes; footwear; headwear</p>  |
| <p>Class 041. First Use: 0 First Use In Commerce: 0<br/>All goods and services in the class are opposed, namely: Entertainment services, namely, providing ongoing webisodes and a website featuring non-downloadable videos featuring animation for children via a global computer network; providing interactive websites featuring information, and non-downloadable photos and videos related to children's entertainment and providing on-line computer games</p>   |

## Grounds for Opposition

|                                      |                            |
|--------------------------------------|----------------------------|
| Priority and likelihood of confusion | Trademark Act Section 2(d) |
|--------------------------------------|----------------------------|

## Mark Cited by Opposer as Basis for Opposition

|                                    |                                   |                  |      |
|------------------------------------|-----------------------------------|------------------|------|
| U.S. Application/ Registration No. | NONE                              | Application Date | NONE |
| Registration Date                  | NONE                              |                  |      |
| Word Mark                          | ENCHANTIMALS                      |                  |      |
| Goods/Services                     | SEE ATTACHED NOTICE OF OPPOSITION |                  |      |

|             |   |
|-------------|---|
| Attachments | Notice of Opposition.pdf(398233 bytes ) |
|-------------|---|

|           |                  |
|-----------|------------------|
| Signature | /Robert J. Itri/ |
|-----------|------------------|

|      |                |
|------|----------------|
| Name | Robert J. Itri |
| Date | 07/21/2017     |

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

Robert Anderson and Faye Granieri,

Opposer,

v.

Mattel, Inc.,

Applicant.

**E-FILING**

Opposition No. \_\_\_\_\_  
Serial Nos. 87/124,063 and 87/124,065  
Mark: ENCHANTIMALS  
Published: May 23, 2017 and June 13, 2017

**NOTICE OF OPPOSITION**

Robert Anderson and Faye Granieri (jointly, “Opposers”), believe that they would be damaged by the registration of the ENCHANITMALS marks which are the subject of Intent-to-Use (“ITU”) Application Serial No. 87/124,063 (the “‘063 Application”) and ITU Application Serial No 87-124,065 (the “‘065 Application”) filed by Mattel, Inc., a Delaware corporation (“Applicant”). The ‘063 Application and the ‘065 Application are collectively referred to as the “Applications.”

Opposers oppose registration for all goods and services cited in the ‘063 Application, namely:

- Sporting articles, namely, roller skates, in-line skates, skateboards, sport balls, play balls, elbow, knee, wrist and shin guards for athletic use, play swimming pools, swim floats for recreational use; decorations for Christmas trees; dolls; doll clothing; doll accessories; toy figures; toy action figures; playsets for dolls; construction toys; toy vehicles in International Class 028.

Opposers also oppose registration of the ‘065 Application for the following goods and services:

- DVDs featuring children's entertainment; computer game software; computer application game software for mobile phones, portable media players, handheld computers and tablet computers for playing games; protective covers and cases for tablet computers; protective covers and cases for cell phones, laptops and portable media players; electronics, namely, radios and digital music players; eyewear; safety

- helmets; swimming aids, namely, swimming goggles, swimming masks, snorkels in International Class 009;
- Children's books; stationery; writing utensils; printed matter, namely, greeting cards and paper invitations; temporary tattoo transfers; paper, cardboard and goods made from these materials, namely, blank journals, diaries, folders, notebooks, book marks, temporary tattoo transfers, note cards, invitation cards, document portfolios, adhesive note pads, agendas, postcards, memo pads; paper school supplies, namely, decorative paper for use in decorating lockers; paper and cardboard products, namely, paper napkins, table cloths of paper, crepe paper, banners of paper, party goodie bags of plastic or paper; comic books, printed magazines of general interest for teenagers and children; adhesives for stationery or household purposes, namely, glue for stationery or household use, adhesive tape and adhesive tape dispensers, both for stationery and household purposes; artists' materials, namely, markers, pens, pencils, pencil and pen cases, erasers, drawing rulers, sketch design books, stencil sets consisting of stencils and colored pencils; typewriters and office requisites, namely, magnetic boards for scheduling activities and appointments, dry erase writing boards, desktop organizers, binders, paper clips and staplers; lap desks; rubber stamps; iron-on transfers; coloring books in International Class 016;
  - Clothing, namely, tops, bottoms, shirts, pants, underwear, sleepwear, bathing suits, jackets, socks, mittens, gloves, Halloween costumes; footwear; headwear in International Class 025; and
  - Entertainment services, namely, providing ongoing webisodes and a website featuring non-downloadable videos featuring animation for children via a global computer network; providing interactive websites featuring information, and non-downloadable photos and videos related to children's entertainment and providing on-line computer games in International Class 041.

As grounds for opposition, Opposers hereby alleges as follows:

1. Applicant is a Delaware Corporation having a principal place of business at M1-1518 333 Continental Boulevard, El Segundo California, 90245.

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**Notice of Opposition**

2. Applicant is seeking to register the mark ENCHANTIMALS under the '063 Application for "Sporting articles, namely, roller skates, in-line skates, skateboards, sport balls, play balls, elbow, knee, wrist and shin guards for athletic use, play swimming pools, swim floats for recreational use; decorations for Christmas trees; dolls; doll clothing; doll accessories; toy figures; toy action figures; playsets for dolls; construction toys; toy vehicles" in International Class 028

3. Applicant is also seeking to register the mark ENCHANTIMALS under the '065 Application for, among other goods and services, 1) DVDs featuring children's entertainment; computer game software; computer application game software for mobile phones, portable media players, handheld computers and tablet computers for playing games; protective covers and cases for tablet computers; protective covers and cases for cell phones, laptops and portable media players; electronics, namely, radios and digital music players; eyewear; safety helmets; swimming aids, namely, swimming goggles, swimming masks, snorkels in International Class 009; 2) Children's books; stationery; writing utensils; printed matter, namely, greeting cards and paper invitations; temporary tattoo transfers; paper, cardboard and goods made from these materials, namely, blank journals, diaries, folders, notebooks, book marks, temporary tattoo transfers, note cards, invitation cards, document portfolios, adhesive note pads, agendas, postcards, memo pads; paper school supplies, namely, decorative paper for use in decorating lockers; paper and cardboard products, namely, paper napkins, table cloths of paper, crepe paper, banners of paper, party goodie bags of plastic or paper; comic books, printed magazines of general interest for teenagers and children; adhesives for stationery or household purposes, namely, glue for stationery or household use, adhesive tape and adhesive tape dispensers, both for stationery and household purposes; artists' materials, namely, markers, pens, pencils, pencil and pen cases, erasers, drawing rulers, sketch design books, stencil sets consisting of stencils and colored pencils; typewriters and office requisites, namely, magnetic boards for scheduling activities and appointments, dry erase writing boards, desktop organizers, binders, paper clips and staplers; lap desks; rubber stamps; iron-on transfers; coloring books in International Class 016; 3) Clothing, namely, tops, bottoms, shirts, pants, underwear, sleepwear, bathing suits, jackets, socks, mittens, gloves, Halloween costumes; footwear; headwear in International Class 025; and 4) Entertainment services, namely, providing ongoing webisodes and a website

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featuring non-downloadable videos featuring animation for children via a global computer network; providing interactive websites featuring information, and non-downloadable photos and videos related to children's entertainment and providing on-line computer games in International Class 041.

4. The '063 Application was published in the *Official Gazette* on May 23, 2017.
5. The '065 Application was published in the *Official Gazette* on June 13, 2017.
6. Opposers obtained an extension of time to oppose the '063 Application through and including July 22, 2017.
7. Opposers obtained an extension of time to oppose the "065 Application through and including August 12, 2017.
8. Opposers are husband and wife and are professional artists residing in Santa Fe, New Mexico.
9. Opposers' art work has been displayed and sold through a number of fine art galleries throughout the Western United States over the past 25 years.
10. In the latter part of 2011, Opposers developed a business plan to market a series of fine art paintings/prints targeting children's books, animation, toys, clothing, games, and other manufactured goods.
11. The concept at the center of the plan was premised upon a magical world of enchanted animals living together in an enchanted forest who live and work together in harmony to preserve and protect their enchanted way of living.
12. In late 2011, early 2012 Opposers commenced creating a series of paintings/images depicting the fanciful, enchanted animals, including foxes, skunks, birds, and rabbits which exhibited extraordinary capabilities and human traits, such as the ability to sing and play musical instruments.
13. At the time, Opposers coined the term "Enchantimals" for their enchanted animal characters.
14. In August 2012, Opposers began selling their ENCHANTIMALS branded artwork through a fine art gallery in Santa Fe, New Mexico, images of which are set forth below:

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15. In February 2013, Opposers registered the domain name [www.enchantimals.com](http://www.enchantimals.com) and created the following ENCHANTIMALS logo:



16. Also in February 2013, Opposers commenced marketing, distributing and selling prints and postcards depicting their ENCHANTIMALS brand characters.

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17. Later in 2013, Opposers expanded the marketing, distribution and sale of their ENCHANTIMALS prints to various other retail establishments and directly to the public through their website at [www.enchantimals.com](http://www.enchantimals.com), Facebook and Ebay.

18. Also in 2013, Opposers developed business cards and postcards and established an [enchantimals@gmail.com](mailto:enchantimals@gmail.com) email account depicting the ENCHANTIMALS logo, mark and branded characters through which they advertised the ENCHANTIMALS brand artwork and prints for sale. Opposers also used such material and means to promote the use of the ENCHANTIMALS brand to interior designers, puzzle companies, art licensing reps, art agents, book publishers, toy companies, and gift wrapping paper companies

19. In 2013, Opposers developed an ENCHANTIMALS children's book treatment and book mock-up and distributed the same to various literary agents and children's book publishers.

20. From 2013 through 2016, Opposers expanded their offerings of ENCHANTIMALS branded artwork, prints and images and marketed, distributed and/or sold the same through their [www.enchantimals.com](http://www.enchantimals.com) website, Facebook and Ebay. They also continued to market, distribute and sell the ENCHANTIMALS brand artwork, prints and images through various art galleries and retail establishments.

21. During such period, Opposers contacted various manufacturers to develop various toys, stuffed animals and sundry based on the ENCHANTIMALS brand characters.

22. As of February 2, 2016, Opposers inadvertently failed to renew their [enchantimals.com](http://enchantimals.com) domain name registration.

23. On April 20, 2016, the grace period for reinstatement and renewal of the [enchantimals.com](http://enchantimals.com) domain name expired and on April 21, 2016, upon information and belief, Applicant, through its brand protection agent acquired the [enchantimals.com](http://enchantimals.com) domain name.

24. As a consequence of Applicant's acquisition of the [enchantimals.com](http://enchantimals.com) domain name, Opposers were required to obtain the domain name [enchantimals.net](http://enchantimals.net) at which their website now appears and through which they continue to market, distribute and sell ENCHANTIMALS artwork and prints.

25. In addition to their website at [Enchantimals.net](http://Enchantimals.net), Opposers continue to market their ENCHANTIMALS brand artwork and prints depicting the ENCHANTIMALS brand characters online on Facebook, Ebay and Etsy.

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26. Moreover, in addition to ENCHANTIMALS brand artwork and prints, Opposers market, distribute, offer for sale and sell the following goods under the ENCHANTIMALS brand and/or depicting the ENCHANTIMALS characters:

- Adult and Children's Apparel:
- Stationery, journals, postcards, greeting cards, note cards, stickers and magnets
- Tote bags, reusable shopping bags, "Bucket" style bags, lunch bags
- Cell phone covers
- Puzzles
- Blankets, pillows, chair cushions, bedding, curtains, aprons, potholders, and Cutting boards, and shower curtains
- Glassware
- Jewelry, Key chains & Charms
- Christmas Ornaments
- Calendars
- Mouse pads, laptop skins, and clipboards
- Wallets

27. Opposers' ENCHANTIMALS mark is inherently distinctive, fanciful and a term coined by Opposers to identify their ENCHANTIMALS branded products and characters.

28. By virtue of Opposers' substantial use, advertising, promotion and sales of products under the ENCHANTIMALS products throughout the United States the ENCHANTIMALS mark, Opposers have developed substantial good will in and developed significant common law rights to the ENCHANTIMALS mark.

29. Upon information and belief, Applicant had actual notice of Opposers' prior common law rights in the ENCHANTIMALS mark.

30. The mark for which Applicant seeks registration under the Applications is Opposers' exact mark—ENCHANTIMALS.

31. Opposers have priority over Applicant's in the ENCHANTIMALS as Opposers' first use of the mark is well prior to the filing date of the Applications.

32. The goods and services set forth in the Applications and to which Opposers object are the same or are highly related to the products for which Opposers mark is used, in that the various goods and services set forth in the subject application could encompass products offered for the same or similar indications as Opposers ENCHANTIMALS branded products and characters, or could reasonably be expected to originate from the same source as products offered under the Opposers' ENCHANTIMALS mark, such that many consumers who encounter

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Applicant's mark in connection with such products and services are likely to think that Applicant or Applicant's use of the ENCHANTIMALS mark in connection with the objected-to goods and services are authorized by, sponsored by, licensed by, affiliated with, or related to Opposers or otherwise emanate from the same source.

33. As a result, Applicant's applied-for mark ENCHANTIMALS, if used in conjunction with the goods and services set forth in the Applications, is likely to cause confusion, mistake, or to deceive as to the origin, source, sponsorship or affiliation of Applicant's goods.

34. Accordingly, Applicant's applied-for mark ENCHANTIMALS so resembles Opposers ENCHANTIMALS mark, as to be likely, when applied to the goods set forth in Applicant's application, to cause confusion, mistake or deception within the meaning of 15 U.S.C. § 1052(d).

35. Applicant's applied-for mark ENCHANTIMALS mark is a close approximation of Opposers' previously used ENCHANTIMALS mark, which is a name or identity of substantial reputation that is closely identified with Opposers, so as to be likely, when applied to the goods set forth in Applicant's application, to falsely suggest a connection with the Opposers within the meaning of 15 U.S.C. § 1052(a).

**WHEREFORE**, Opposers request that Applications Serial Nos. 87/124,063 and 87/124,065 be rejected, that no registration issue in connection with the objected-to goods and services, and that this opposition be sustained in favor of Opposers.

Respectfully submitted,

Dated: July 21, 2017

By: s/Robert J. Itri/

Robert J. Itri, Esq.  
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**CERTIFICATE OF SERVICE**

I hereby certify that on this 21st day of July, 2017, a true and correct copy of the foregoing NOTICE OF OPPOSITION was served on the following via email and first class mail:

Matt Solmon, Esq.  
MATTEL, INC.  
333 Continental Boulevard, M1-1518  
El Segundo, California 90245  
Email: [USPTO@mattel.com](mailto:USPTO@mattel.com)  
*Counsel for Applicant*

s/Robert J. Itri/  
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