

ESTTA Tracking number: **ESTTA1108027**

Filing date: **01/15/2021**

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	Tootsie Roll Industries, LLC
Granted to Date of previous extension	01/27/2021
Address	7401 SOUTH CICERO AVENUE CHICAGO, IL 60629 UNITED STATES

Correspondence information	JOHN L. WELCH WOLF, GREENFIELD & SACKS, P.C. 600 ATLANTIC AVENUE BOSTON, MA 02210 UNITED STATES Primary Email: jlwtrademarks@wolfgreenfield.com Secondary Email(s): drwtrademarks@wolfgreenfield.com, kirakhanh.mccarthy@wolfgreenfield.com 617-646-8000
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Applicant Information

Application No.	88930210	Publication date	09/29/2020
Opposition Filing Date	01/15/2021	Opposition Period Ends	01/27/2021
Applicant	MVRK Research, LLC 7427 NC HIGHWAY 58 SOUTH STANTONSBURG, VA 27883 UNITED STATES		

Goods/Services Affected by Opposition

Class 034. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Dried hemp for use as a tobacco substitute; hemp cigarettes; hemp cigars; cigarettes and cigars containing tobacco substitutes not for medical purposes; all of the foregoing solely consisting of, containing, and for use with hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on dry weight basis

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2536259	Application Date	01/30/2001
Registration Date	02/05/2002	Foreign Priority Date	NONE
Word Mark	TOOTSIE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1908/09/00 First Use In Commerce: 1908/09/00 candy		

U.S. Registration No.	963446	Application Date	08/02/1972
Registration Date	07/10/1973	Foreign Priority Date	NONE
Word Mark	TOOTSIE ROLL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 1966/02/00 First Use In Commerce: 1966/02/00 TOY BANKS		

U.S. Registration No.	1302714	Application Date	01/24/1983
Registration Date	10/30/1984	Foreign Priority Date	NONE
Word Mark	TOOTSIE ROLL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1982/11/01 First Use In Commerce: 1982/11/01 [Children's Polo Shirts, Dress Shirts,] Tank Tops, Sweatshirts, [Two-Piece Short Sets, Slack Sets, Sunsets, Swimsuits, Shortalls, Overalls, Jeans, Slacks, Skirts,] Shorts, [Sweaters, Jackets, Coats, Vests and Snowsuits]		

U.S. Registration No.	1369332	Application Date	08/02/1984
Registration Date	11/05/1985	Foreign Priority Date	NONE
Word Mark	TOOTSIE ROLL		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1908/09/00 First Use In Commerce: 1908/09/00 CANDY		

U.S. Registration No.	5396471	Application Date	08/02/2017
Registration Date	02/06/2018	Foreign Priority Date	NONE

Word Mark	TOOTSIE ROLL
Design Mark	
Description of Mark	NONE
Goods/Services	Class 030. First use: First Use: 2014/09/00 First Use In Commerce: 2014/09/00 hot cocoa powder

U.S. Registration No.	292927	Application Date	12/02/1931
Registration Date	03/29/1932	Foreign Priority Date	NONE
Word Mark	TOOTSIE POPS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1931/09/01 First Use In Commerce: 1931/09/01 CANDY		

U.S. Registration No.	2402373	Application Date	10/21/1997
Registration Date	11/07/2000	Foreign Priority Date	NONE
Word Mark	TOOTSIE TARTS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 2000/02/01 First Use In Commerce: 2000/02/01 candy		

Attachments	889302010 NOTICE OF OPPOSITION.pdf(75529 bytes)
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Signature	/johnlwelch/
Name	JOHN L. WELCH
Date	01/15/2021

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

Tootsie Roll Industries, LLC,

Opposer,

v.

MVRK Research, LLC,

Applicant.

Mark: TOOSIES

Serial No. 88/930,210

Opposition No. _____

NOTICE OF OPPOSITION

Tootsie Roll Industries, LLC (“Opposer”), a limited liability company organized and existing under the laws of Delaware, having a place of business at 7401 South Cicero Avenue, Chicago, Illinois, 60629, believes it would be damaged by registration of the mark depicted in Application Serial No. 88/930,210 filed by MVRK Research, LLC (“Applicant”), a limited liability company organized and existing under the laws of North Carolina, having a place of business at 7427 NC Highway 58 South, Stantonsburg, Virginia, 27883, which application was published for opposition in the *Official Gazette* on September 29, 2020, and hereby opposes the same.

The grounds for this Opposition are as follows:

1. Applicant seeks to register the mark TOOSIES (Serial No. 88/930,210) as a trademark for “dried hemp for use as a tobacco substitute; hemp cigarettes; hemp cigars; cigarettes and cigars containing tobacco substitutes not for medical purposes; all of the foregoing


solely consisting of, containing, and for use with hemp with a delta-9 tetrahydrocannabinol (THC) concentration of not more than 0.3 percent on a dry weight basis” in International Class 34.

2. The opposed application was filed on May 22, 2020 based on an alleged bona fide intent to use the mark in commerce, pursuant to Section 1(b) of the Lanham Act.

3. Opposer and its predecessors in interest have continuously and exclusively used the trademarks TOOTSIE, TOOTSIE ROLL, TOOTSIE POPS, and TOOTSIE TARTS (hereinafter “the Marks”) in commerce, in the United States, in connection with the goods listed in paragraph 5 below, since at least as early as the dates indicated in paragraph 5 below.

4. Through Opposer’s substantial marketing and sales activities, which extend throughout the United States, and its extensive and continuous use of the Marks, Opposer has created valuable goodwill therein. Consumers have come to recognize the Marks as identifying high quality candy and other products that originate from Opposer. From a date long prior to Applicant’s filing date, the marks TOOTSIE, TOOTSIE ROLL, and TOOTSIE POP have been famous as source indicators for Opposer’s candy.

5. In addition to common law rights in the Marks, Opposer owns the following federal trademark registrations therefor:

Mark	Registration No.	Goods	First Use Date (at least as early as)
TOOTSIE	2536259	Class 30: Candies	Sep. 1908
TOOTSIE ROLL	0963446	Class 28: Toy banks	Feb. 1966
	1302714	Class 25: Tank tops, sweatshirts, shorts	Nov. 1, 1982

Mark	Registration No.	Goods	First Use Date (at least as early as)
TOOTSIE ROLL	1369332	Class 30: Candy	Sep. 1908
TOOTSIE ROLL	5396471	Class 30: Hot cocoa powder	Sep. 2014
TOOTSIE POPS	0292927	Class 30: Candy	Sep. 1, 1931
TOOTSIE TARTS	2402373	Class 30: Candy	Feb. 1, 2000

6. Under 15 U.S.C. § 1115(b), all of Opposer’s above-identified registrations are conclusive evidence of the validity of the respective registered Marks and of the registration of each of the Marks, of Opposer’s ownership thereof, and of Opposer’s exclusive right to use the Marks in commerce in connection with the goods specified in the registrations.

Likelihood of Confusion Under 15 U.S.C. § 1052(d)

7. Notwithstanding Opposer’s prior rights in the Marks, Applicant filed Application Serial No. 88/930,210 on May 22, 2020 to register TOOSIES.

8. The goods identified in the TOOSIES application are closely related to the goods offered by Opposer under the Marks and are likely to be encountered by the same classes of consumers.

9. Applicant’s TOOSIES mark is confusingly similar to each of the Marks in appearance, sound, connotation, and commercial impression.

10. In light of the relatedness of the goods and the similarities in appearance, sound, connotation, and commercial impression between Applicant’s mark and the Marks of Opposer, consumers are likely to believe that Applicant’s goods offered under the TOOSIES mark emanate from – or are licensed or otherwise approved by – Opposer, when that is not the case. Any dissatisfaction with Applicant’s goods will reflect upon and irreparably damage the

reputation and goodwill of Opposer as embodied in the Marks. Consequently, there exists a likelihood of confusion under § 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

Dilution by Blurring Under 15 U.S.C. § 1125(c)

11. Additionally, Applicant's use of TOOSIES is likely to cause dilution by blurring of Opposer's famous marks TOOTSIE, TOOTSIE ROLL, and TOOTSIE POPS in violation of the anti-dilution provisions of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

12. If Applicant is granted registration of the opposed mark, Applicant would obtain a prima facie exclusive right to use TOOSIES for the goods identified in its application here opposed, which would be a further source of significant damage to Opposer.

WHEREFORE, Opposer believes it will be damaged by registration of Applicant's mark, and prays that this Opposition be sustained, that Application Serial No. 88/930,210 be rejected, and that the mark applied for therein be refused registration.

Respectfully submitted,

TOOTSIE ROLL INDUSTRIES, LLC



Date: January 15, 2021

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