

ESTTA Tracking number: **ESTTA1293701**

Filing date: **06/26/2023**

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	MATTEL, INC.
Granted to date of previous extension	06/25/2023
Address	333 CONTINENTAL BOULEVARD TWR 15-1 EL SEGUNDO, CA 90245 UNITED STATES
Attorney information	SHARONI S. FINKELSTEIN VENABLE LLP 2049 CENTURY PARK EAST, SUITE 2300 LOS ANGELES, CA 90067 UNITED STATES Primary email: ipdocketingsf@venable.com Secondary email(s): ssfinkelstein@venable.com, asharon@venable.com, tli@venable.com 310-229-9900
Docket no.	110030.57474

Applicant information

Application no.	97512109	Publication date	12/27/2022
Opposition filing date	06/26/2023	Opposition period ends	06/25/2023
International registration no.	NONE	International registration date	NONE
Applicant	Burberry Limited HORSEFERRY HOUSE, HORSEFERRY ROAD LONDON, SW1P2AW UNITED KINGDOM		

Goods/services affected by opposition

<p>Class 018. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Leather and imitations of leather; duffel bags; holdalls; handbags; shoulder bags; trunks being luggage; valises; suitcases; travelling bags; crossbody bags; tote bags; garment bags for travel; bum-bags; belt bags; vanity cases, sold empty; baby diaper bags; baby carriers worn on the body; baby harnesses; rucksacks; satchels; reusable shopping bags; canvas shopping bags; wheeled shopping bags and leather general purpose trolley bags; purses; leather pouches; coin pouches; wallets; key holders being key cases; credit card holders; pochettes; carrying cases for documents; luggage labels and luggage tags made of leather and imitation leather; labels of leather; cosmetic cases and bags, not fitted and sold empty; tie cases; leather cases for cufflinks; leather boxes; umbrellas; parasols; walking sticks; horse blankets; pet</p>

clothing; pet collars; animal leashes
Class 025. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Clothing articles and outer clothing articles, namely, coats, clothing jackets, rainwear, ponchos, gilets, detachable coat linings being ready-made linings being parts of clothing, raincoats; blousons; casual coats; polo shirts; blouses; t-shirts; dresses; pajamas; knitwear, namely, jerseys being clothing, jumpers in the nature of coveralls, cardigans, sweaters, knitted leggings; shorts; trousers; suits for men women and children; skirts; clothing jackets; clothing jackets containing microprocessors; articles of underclothing, namely, boxer shorts, lingerie, loungewear, nightwear, underwear, undergarments, hosiery; sports clothing, namely, ski wear, sports jackets, sports jerseys, sports shirts, sports trousers, sweat pants, sweat shirts, sweat shorts, tracksuits, tennis wear, swimwear; sports footwear; tracksuits; ready-made linings, namely, finished textile linings for garments; ties as clothing; clothing belts; clothing wraps; serapes; scarves; shawls and stoles; gloves; footwear; headgear in the nature of headwear; Leather belts for clothing; shirts; jeans

Grounds for opposition

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

Marks cited by opposer as basis for opposition

U.S. registration no.	0689055	Application date	07/02/1958
Register	Principal		
Registration date	12/01/1959	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 022. First use: First Use: May 9, 1958 First Use In Commerce: May 9, 1958 DOLL		

U.S. registration no.	0741208	Application date	10/18/1960
Register	Principal		
Registration date	11/27/1962	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 022. First use: First Use: Sep 2, 1960 First Use In Commerce: Sep 2, 1960 Accessories for Doll Clothes		

U.S. registration no.	0768331	Application date	08/30/1962
Register	Principal		
Registration date	04/21/1964	Foreign priority	NONE

		date	
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 003. First use: First Use: Oct 16, 1960 First Use In Commerce: Oct 16, 1960 Doll Case, [Record Tote Case,] Trunk, and Wallet		

U.S. registration no.	0768397	Application date	04/16/1963
Register	Principal		
Registration date	04/21/1964	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 022. First use: First Use: Apr 17, 1959 First Use In Commerce: Apr 17, 1959 Doll Clothes and Doll Accessories		

U.S. registration no.	1693139	Application date	07/23/1990
Register	Principal		
Registration date	06/09/1992	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Dec 31, 1963 First Use In Commerce: Dec 31, 1963 jackets, sweatshirts, T-shirts, jeans, skirts		

U.S. registration no.	1754535	Application date	07/23/1990
Register	Principal		
Registration date	02/23/1993	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Oct 1, 1990 First Use In Commerce: Oct 1, 1990 dresses, shorts, T-shirts, blouses, skirts, pants, leggings, leggings with skirts attached		

U.S. registration no.	2678386	Application date	10/08/1997
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Register	Principal		
Registration date	01/21/2003	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 003. First use: First Use: Jun 1998 First Use In Commerce: Jun 1998 [TOILET SOAPS, BUBBLE BATHS, BATH BEADS, MOISTURIZING LOTIONS, COLOGNES, HAIR SHAMPOOS; COSMETICS FOR USE BY LITTLE GIRLS, NAMELY, EYE SHADOWS, LIPSTICKS, LIP GLOSSES, PERFUMES, COLOGNES, NAIL POLISHES, BLUSHES, EMERY BOARDS;] BATH GELS, [BABY POWDER,] BODY LOTIONS, HAIR CONDITIONERS, SKIN CREAMS, EYE MAKEUP, EYE PENCILS,[HAND CREAMS,] MAKEUP,[SKIN SOAPS, LIQUID SOAPS FOR HANDS, FACE AND BODY, SUN BLOCKS, EAU DE TOILETTE,] TOOTHPASTES, [COMPACTS CONTAINING MAKEUP, SCENTED BODY SPRAYS, SUN SCREENS, BODY GLITTERS, HAIR GELS]</p> <p>Class 006. First use: First Use: Dec 1999 First Use In Commerce: Dec 1999 METAL KEY RINGS [, METAL DECORATIVE BOXES, METAL PIGGY BANKS]</p> <p>Class 008. First use: First Use: Mar 1995 First Use In Commerce: Mar 1995 [SHOVELS, TABLEWARE NAMELY, KNIVES, FORKS AND SPOONS, SCISSORS]</p> <p>Class 009. First use: First Use: Mar 2000 First Use In Commerce: Mar 2000 [CALCULATORS, DISPOSABLE CAMERAS,] EYEGLASS CASES, RADIOS INCORPORATING CLOCKS, DECORATIVE MAGNETS, TELEPHONES, [ELECTRIC OUTLET COVERS,] HEADPHONES, BICYCLE HELMETS, [ELECTRIC SWITCH PLATES, RADIOS, SUNGLASSES, KALEIDOSCOPES;] MUSICAL, AUDIO AND VIDEO SOUND RECORDINGS FEATURING GAMES AND STORYTELLING; [AUDIO AND VIDEO CASSETTES,] [CD-ROMS TAPES AND DISCS ALL FEATURING MUSIC, GAMES AND STORYTELLING;] [COMPUTER MOUSE,]COMPUTER MOUSE PADS, SCREENSAVER PROGRAMS, [COMPUTER GAME JOYSTICKS,] VIDEO GAME CARTRIDGES, INTERACTIVE VIDEO GAME PROGRAMS, INTERACTIVE MULTIMEDIA COMPUTER GAME PROGRAMS, COMPUTER GAME CARTRIDGES; [PRERECORDED COMPUTER STORYTELLING SOFTWARE, COMPUTER SOFTWARE, COMPUTER PROGRAMS AND CD-ROMS ALL FEATURING ACTIVITIES, EDUCATIONAL INFORMATION, STORIES, GAMES, AND THE LIKE FOR CHILDREN AND YOUNG ADULTS, AND FOR CREATING GRAPHIC DESIGNS FOR CREATING PRINTED MATERIALS SUCH AS GREETINGS CARDS, BANNERS, CALENDARS, AND THE LIKE, AND FOR DESIGNING FASHION CLOTHING FOR DOLLS FOR USE BY NON-PROFESSIONALS, CD-ROMS FEATURING DIRECTORIES OF DOLLS AND TOY RELATED COLLECTIBLES FOR COLLECTORS]</p> <p>Class 011. First use: First Use: Dec 1998 First Use In Commerce: Dec 1998 [ELECTRIC LIGHTING FIXTURES,][HAND-HELD ELECTRIC HAIR DRYERS,] [ELECTRIC NIGHT LIGHTS,] [BICYCLE LIGHTS,] CEILING FANS [, LAMP SHADES, LAMPS] [, FLASHLIGHTS, BICYCLE REFLECTORS]</p> <p>Class 012. First use: First Use: Dec 1999 First Use In Commerce: Dec 1999 BICYCLES, BICYCLE BELLS, TRICYCLES [, WHEEL CHAIRS, AUTOMOBILE WINDSHIELD SUNSHADES]</p> <p>Class 014. First use: First Use: Dec 2000 First Use In Commerce: Dec 2000 CLOCKS, [ANKLE BRACELETS, BROOCHES,] [EAR CLIPS, TIE CLIPS,] COSTUME JEWELRY, RINGS BEING JEWELRY, [PINS BEING JEWELRY,] EARRINGS, BRACELETS, NECKLACES AND CHARMS, LOCKETS,</p>		

WATCHES [, JEWELRY MAKING BEAD KITS COMPRISED OF BEADS,]
[NEEDLES, CLASPS AND CORDING]

Class 016. First use: First Use: Mar 1993 First Use In Commerce: Mar 1993

PHOTOGRAPH ALBUMS, [CARDBOARD PHOTOGRAPH BOXES, PAPER BOXES, DRAWER LINER PAPER,] NOTE CARDS, [AGENDA BOOKS; DAILY, DESK TOP AND PERSONAL PLANNERS;] PENCIL CASES, [ARTS AND CRAFTS PAINT KITS,] PAPER PARTY BAGS, [BOOK COVERS, BOOK ENDS, BOOK MARKS,] ADDRESS BOOKS, LOOSE LEAF BINDERS, [STATIONERY BOXES, PAINT BRUSHES,] CALENDARS, POST CARDS, [TRADING CARDS, TRIVIA CARDS, CHALK,] PAPER TABLE CLOTHS, COMPOSITION BOOKS, CONFETTI, [CRAFT PAPER,] CRAYONS, CREPE PAPER, [DECALS,] PAPER PARTY DECORATIONS, [DESK SETS,] ERASERS, SERIES OF FICTION BOOKS, GIFT CARDS, GIFT WRAPPING PAPER, MARKERS, PAPER NAPKINS, NOTE PADS, [PAINTING SETS,] PAPER PARTY HATS, PEN AND PENCIL HOLDERS, PENCIL SHARPENERS, DECORATIVE PENCIL TOP ORNAMENTS, PENCILS, PENS, PLAYING CARDS, POSTERS, BOOKS IN THE FIELD OF COLLECTIBLES, NAMELY, DOLLS, DOLL CLOTHING AND DOLL ACCESSORIES, DRAWING RULERS, RUBBER STAMPS, STAMP PADS, [STATIONERY,] STICKERS, STICKER BOOKS, FOLDERS, LUNCH BAGS, PAPER GIFT BAGS, [PLASTIC PLACE MATS,] PRINTED INVITATIONS, PERSONAL JOURNALS, [TALKING CHILDREN'S BOOKS,] TEMPORARY TATTOOS, [TRADING CARD MILK BOTTLE CAPS,] WRITING INSTRUMENTS, [BOOKS OF GAMES,] PAPER BANNERS, [COASTERS MADE OF PAPER,] MEMO PADS, [GREETING CARDS, FACIAL TISSUES AND STICKERS FOR FINGERNAILS; AUTOGRAPH BOOKS, DIARIES, NOTEBOOKS, AND SCRAPBOOKS, COLORING BOOKS, ACTIVITY BOOKS,] MAGAZINES FOR TEENAGERS AND CHILDREN

Class 018. First use: First Use: Dec 2000 First Use In Commerce: Dec 2000

BACKPACKS, BEACH BAGS, GYM BAGS, OVERNIGHT BAGS, COIN PURSES, DUFFEL BAGS, HANDBAGS, KEY CASES, LUGGAGE, SUITCASES, UMBRELLAS, [FANNY PACKS, WAIST PACKS,] LIPSTICK HOLDERS; [PURSES, COSMETIC CASES SOLD EMPTY,] LUGGAGE TRUNKS, WALLETS [, HAT BOXES] [, TRAIN CASES]

Class 020. First use: First Use: Aug 2000 First Use In Commerce: Aug 2000

SLEEPING BAGS, PLASTIC CAKE DECORATIONS, [TOY CHESTS,] [BED FRAMES,] PICTURE FRAMES, [DECORATIVE GLITTER,] JEWELRY BOXES NOT OF METAL, [DECORATIVE MOBILES,] PILLOWS, [DESKS, BEDROOM FURNITURE, SNOW GLOBES,] NON-METAL KEY RINGS [, HAND MIRRORS]

Class 021. First use: First Use: Jun 1995 First Use In Commerce: Jun 1995

PLATES, CUPS AND BOWLS MADE OF MELAMINE, [NON-METAL PIGGY BANKS,]WASTEPAPER BASKETS, BOWLS, LUNCH BOXES, [COSMETIC BRUSHES, SUN CATCHERS, COOKIE CUTTERS,] PAPER CUPS, DECORATIVE PLATES, PORCELAIN FIGURINES, PAPER PLATES, PLASTIC CUPS, [COMMEMORATIVE PLATES,] [VACUUM BOTTLES, VASES,] [WIND CHIMES,] [COOKIE JARS,] THERMAL INSULATED TOTE BAGS AND CONTAINERS FOR FOOD OR BEVERAGES, TOOTHBRUSHES, CAKE MOLDS, [TOOTHBRUSH HOLDERS,][WATERING CANS,] [BASINS, PAILS, COASTERS NOT OF PAPER AND NOT BEING OF TABLE LINEN, SOAP DISHES, SOAP DISPENSERS,] DRINKING GLASSES, MUGS, [TEA SETS FEATURING PLATES, SAUCERS, CUPS, POTS AND PITCHERS; VANITY SETS AND DRESSES SETS, COMPRISING MIRRORS, BRUSHES, COMBS, EMPTY COMPACTS AND LIPSTICK CASES FOR USE BY CHILDREN, SOLD AS A UNIT; POWDER PUFFS; COSMETIC SPONGES FOR USE IN APPLYING OR REMOVING MAKEUP; HAIR BRUSHES, HAIR COMBS, NAIL BRUSHES, NON-METAL DECORATIVE BOXES, FITTED PICNIC BASKETS]

Class 024. First use: First Use: Mar 1998 First Use In Commerce: Mar 1998

[CLOTH BANNERS, FABRIC BATH MATS,] BATH LINEN, BED LINEN, BED

SHEETS, BED SPREADS, BED BLANKETS,[BED CANOPIES,] PILLOW CASES,[CLOTH FLAGS,] WASH CLOTHS,[TABLE CLOTHS NOT OF PAPER,] COMFORTERS, [DUVET COVERS, CRIB BUMPERS, CRIB SHEETS,] CURTAINS,[DRAPERIES,] DUST RUFFLES, PILLOW SHAMS, [TEXTILE AND LINEN PLACE MATS, QUILTS,] BATH TOWELS, BEACH TOWELS,[KITCHEN TOWELS, TEXTILE WALL HANGINGS, SHOWER CURTAINS, SWAGS, FABRIC VALANCES]

Class 025. First use: First Use: Jun 1988 First Use In Commerce: Jun 1988

BATHING SUITS, BATHROBES, BEACH COVER-UPS, BELTS, [BERETS,] BOOTS, CARDIGANS, COATS, RAIN COATS, GLOVES, NIGHT GOWNS, HATS, HEAD BANDS, HEADWEAR, [HOSIERY,] [JUMPERS,] [KNEE HIGHS,] LEOTARDS, MITTENS, [NECKTIES,] NIGHT SHIRTS, OVERALLS, PAJAMAS, PANTIES, [PANTYHOSE,] SANDALS, SCARVES, SHIRTS, SLIPPERS, [SLIPS,] SOCKS, [STOCKINGS,] [SUSPENDERS,] SWEATERS, TANK TOPS, THERMAL UNDERWEAR, TIGHTS, TURTLENECKS, UNDERWEAR, VESTS, CAPS, SKORTS, [BLANKET SLEEPERS,] MITTEN CLIPS, EARMUFFS, SWIMSUITS, SWIMSUIT COVERS,[JACKETS, SWEATSHIRTS, T-SHIRTS, JEANS, SKIRTS;] HALLOWEEN COSTUMES AND MASKS; DRESSES, SHORTS, T-SHIRTS, BLOUSES, SKIRTS,[PANTS, LEGGINGS WITH SKIRT ATTACHED; SHOES]

Class 026. First use: First Use: Dec 2000 First Use In Commerce: Dec 2000

BARRETTES, HAIR BOWS, [BOWS FOR GIFT WRAPPING, TEA COSIES, HOUSEHOLD APPLIANCE COVERS,] ELASTIC RIBBONS, [FABRIC APPLIQUES,] PONYTAIL HOLDERS, SHOE LACES, ORNAMENTAL NOVELTY PINS AND BUTTONS, [HAIR BANDS AND HAIR RIBBONS]

Class 027. First use: First Use: Jun 1998 First Use In Commerce: Jun 1998

RUGS [, DOOR MATS, FLOOR MATS FOR VEHICLES,] PLASTIC WALL COVERINGS [, VINYL WALL COVERINGS, BATH MATS AND WALL PAPER]

Class 028. First use: First Use: Dec 1998 First Use In Commerce: Dec 1998

ACTION FIGURES AND ACCESSORIES THEREFOR, STUFFED TOY ANIMALS, TOY AIRPLANES, BALLOONS, TOY BAKEWARE AND COOKWARE, SPORT BALLS, TOY BANKS, BATH TOYS, [BEAN BAGS, TOY BUILDING BLOCKS,] PLAY WANDS, MUSIC BOX TOYS, BUBBLE MAKING WAND AND SOLUTION SETS, CARD GAMES, CHRISTMAS TREE ORNAMENTS,[CHRISTMAS TREE SKIRTS,] CHILDREN'S PLAY COSMETICS, PARTY FAVORS IN THE NATURE OF CRACKERS OR NOISEMAKERS, [TOY MOBILES, FLYING DISCS,] PORCELAIN DOLLS, PAPER DOLLS, PARTY FAVORS IN THE NATURE OF SMALL TOYS, ICE SKATES, JIGSAW PUZZLES, JUMP ROPES,[KITES,] MUSICAL TOYS, PLAY SWIMMING POOLS, PLUSH TOYS, [PUPPETS,] RIDE-ON TOYS, MANIPULATIVE PUZZLES, ROLLER SKATES, WATER-SQUIRTING TOYS, YO-YOS, [FOOTBAGS USED IN A KICKING GAME, ADULT AND CHILDREN PARTY GAMES, CHRISTMAS STOCKINGS,] COLLECTIBLE TOY FIGURES, DOLL HOUSES, DRAWING TOYS, IN-LINE SKATES, PLAY TENTS, PLAY HOUSES, RADIO CONTROLLED TOY VEHICLES, [SAND TOYS, SAND BOX TOYS,] TALKING TOYS; [SLIDE PUZZLES, PADDLE BALL GAMES;] SWIM GOGGLES, SWIM VESTS FOR FLOATATION FOR RECREATIONAL USE, DOLLS; PLAYSETS, NAMELY, DOLL FURNITURE, DOLL FURNITURE ACCESSORIES, TOY FOOD MAKING ACCESSORIES, NAMELY, BOWLS, SPOONS, BLENDERS, OVENS, MIXERS AND THE LIKE; DOLL CLOTHES AND DOLL ACCESSORIES; BOARD GAMES; ACCESSORIES FOR DOLL CLOTHES, TOY FURNITURE, SPECIFICALLY BEDS, WARDROBES, [CHIFFOROBES,] VANITIES AND CHESTS; DOLL CASES; TOY VEHICLES; [OUTDOOR PLAY EQUIPMENT, NAMELY, PLAY SLIDES AND SWINGS, SAND SANDBOXES;] [COIN-OPERATED ARCADE GAMES,] ELECTRONIC HAND-HELD GAMES [, PLASTIC TOY HOOPS, PINWHEELS]

Class 030. First use: First Use: Dec 1995 First Use In Commerce: Dec 1995

	EDIBLE CAKE DECORATIONS, CANDY, [BREAKFAST CEREALS,] [CHEWING GUM,]COOKIES, [MACARONI AND CHEESE, BAKERY GOODS,] CHOCOLATE CANDY		
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U.S. registration no.	2040801	Application date	06/11/1996
Register	Principal		
Registration date	02/25/1997	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Apr 1990 First Use In Commerce: Apr 1990 shoes		

U.S. registration no.	0814995	Application date	01/07/1965
Register	Principal		
Registration date	09/13/1966	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 037. First use: First Use: Jan 1962 First Use In Commerce: Jan 1962 [SERIES OF BOOKS-NAMELY, AUTOGRAPH BOOKS, DIARIES, NOTE-BOOKS, AND SCRAPBOOKS] Class 038. First use: First Use: Jan 1962 First Use In Commerce: Jan 1962 SERIES OF BOOKS AND PRINTED ARTICLES-NAMELY, [DICTIONARIES,] STORYBOOKS, COLORING BOOKS, ACTIVITY BOOKS, PAINTING BOOKS, [NOVELTY AND TOY BOOKS, PRINTED CUT-OUTS, PRINTED PUNCH-OUTS] AND PRINTED PUZZLES		

U.S. registration no.	1946918	Application date	02/15/1995
Register	Principal		
Registration date	01/09/1996	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Feb 1, 1995 First Use In Commerce: Feb 1, 1995 greeting cards		

U.S. registration no.	1769285	Application date	03/25/1991
Register	Principal		

Registration date	05/04/1993	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 016. First use: First Use: Jan 9, 1992 First Use In Commerce: Jan 9, 1992 facial tissues and stickers for fingernails		

U.S. registration no.	0772298	Application date	10/28/1963
Register	Principal		
Registration date	06/30/1964	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 027. First use: First Use: Apr 3, 1963 First Use In Commerce: Apr 3, 1963 Time Pieces, Specifically Wrist Watches		

U.S. registration no.	0810106	Application date	01/25/1965
Register	Principal		
Registration date	06/21/1966	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 022. First use: First Use: Apr 1, 1961 First Use In Commerce: Apr 1, 1961 TOY FURNITURE SPECIFICALLY BED, WARDROBE, CHIFFOROB, VANITY, AND CHEST		

U.S. registration no.	0814091	Application date	02/04/1965
Register	Principal		
Registration date	08/30/1966	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 040. First use: First Use: Jun 1, 1962 First Use In Commerce: Jun 1, 1962 VANITY SETS AND DRESSER SETS, COMPRISING MIRRORS, BRUSHES, COMBS, COMPACTS, AND LIPSTICK CASES, FOR USE BY CHILDREN		

U.S. registration no.	1000125	Application date	04/22/1974
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Register	Principal		
Registration date	12/24/1974	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 025. First use: First Use: Mar 8, 1972 First Use In Commerce: Mar 8, 1972 HALLOWEEN COSTUMES AND MASKS		

U.S. registration no.	1300766	Application date	12/05/1983
Register	Principal		
Registration date	10/16/1984	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 028. First use: First Use: Aug 18, 1983 First Use In Commerce: Aug 18, 1983 Toy Vehicles		

U.S. registration no.	1773571	Application date	03/25/1991
Register	Principal		
Registration date	05/25/1993	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 014. First use: First Use: Jan 1, 1991 First Use In Commerce: Jan 1, 1991 jewelry; namely, earrings, bracelets, necklaces, charms		

U.S. registration no.	1775637	Application date	03/25/1991
Register	Principal		
Registration date	06/08/1993	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 003. First use: First Use: Jan 9, 1992 First Use In Commerce: Jan 9, 1992 cosmetics for use by little girls; namely, eyeshadow, lipstick, lip gloss, perfume, cologne, nail polish, blush, emery boards, and cosmetic sponges Class 021. First use: First Use: Jan 9, 1992 First Use In Commerce: Jan 9, 1992		

	powder puffs, and accessories therefor
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U.S. registration no.	2087842	Application date	10/09/1996
Register	Principal		
Registration date	08/12/1997	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	Class 028. First use: First Use: Apr 20, 1995 First Use In Commerce: Apr 20, 1995 doll, doll clothing and doll accessories		

U.S. registration no.	2639971	Application date	07/09/1998
Register	Principal		
Registration date	10/22/2002	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 025. First use: First Use: May 12, 2002 First Use In Commerce: May 12, 2002 [after ski boots, anoraks, athletic uniforms, bandannas, jackets, sweatshirts, sweat pants,] T-shirts [, jeans, skirts, Halloween costumes and masks; dresses, shorts, blouses, pants, leggings with skirt attached; shoes, bathing suits, bath-robes, beach cover-ups, belts, berets, boots, cardigans, coats, rain coats, gloves, night gowns, hats, head bands, headwear, hosiery, jumpers, knee highs, leotards, mittens, neckties, night shirts, overalls, pajamas, panties, pantyhose, sandals, scarves, shirts, slippers, slips, socks, stockings, suspenders, sweaters, tank tops, thermal underwear, tights, turtlenecks, underwear, vests, caps, skorts, blanket sleepers, earmuffs, swimsuits, swimsuit cover ups]</p> <p>Class 028. First use: First Use: Jul 13, 2000 First Use In Commerce: Jul 13, 2000 dolls, doll clothing, doll accessories [, doll houses and doll furniture, board games, card games, role playing games, children's play cosmetics, swim masks, elbow, wrist and knee pads for athletic use, swim fins, hand held units for playing electronic games, swim goggles, jump ropes, inflatable swimming pools, ride-on toys, ice skates, roller skates, inline skates, yo-yos, flying discs, balloons, plastic balls, beach balls, toys candy dispensers, card games, cases for play accessories, toy vehicles, high bounce balls, kites, costume masks, jigsaw puzzles, remote controlled vehicles, three-dimensional puzzles, toy banks, plush toys, Christmas tree ornaments, water squirting toys, craft kits comprised of beads, toy jewelry making kits, swimming aids, namely, pool rings and arm floats for recreational use, toy snow globes, and toy toiletry sets]</p>		

U.S. registration no.	2151953	Application date	11/12/1996
Register	Principal		
Registration date	04/21/1998	Foreign priority	NONE

		date	
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 035. First use: First Use: Oct 21, 1996 First Use In Commerce: Oct 21, 1996 on-line retail store services featuring toys</p> <p>Class 042. First use: First Use: Oct 21, 1996 First Use In Commerce: Oct 21, 1996 providing information over a global comoputer network featuring games, stories, directories for toys and games, toy collectibles [, and chat sessions]</p>		

U.S. registration no.	2495195	Application date	03/16/1995
Register	Principal		
Registration date	10/09/2001	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: 1961 First Use In Commerce: 1961 [Prerecorded computer storytelling software] [; prerecorded audio and video musical, storytelling and/or game recordings in cassette form; screensaver programs; software featuring directories of toys, all for informational, educational and entertainment uses]</p> <p>Class 028. First use: First Use: Sep 1996 First Use In Commerce: Sep 1996 [Coin-operated arcade games, prerecorded computer game cartridges, cassettes, cards, discs and programs for informational, educational and entertainment uses ; electronic hand-held games; computer game joysticks, adapters, connectors and controllers for use with prerecorded computer software, audio and video cassettes, CD-ROM, game cartridges, game cassettes, game cards and game discs, all for informational, educational and entertainment uses]</p> <p>Class 041. First use: First Use: Sep 1996 First Use In Commerce: Sep 1996 Providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children</p>		

U.S. registration no.	6267202	Application date	11/29/2018
Register	Principal		
Registration date	02/09/2021	Foreign priority date	NONE
Word mark	BARBIE		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 041. First use: First Use: Apr 16, 2020 First Use In Commerce: Apr 16, 2020 ENTERTAINMENT SERVICES, namely, PROVIDING NON-DOWNLOADABLE</p>		

	ANIMATED MOVIES, ON-GOING TELEVISION PROGRAMS AND NON-DOWNLOADABLE WEBISODE SERIES, ALL FEATURING CHILDREN'S ENTERTAINMENT PROVIDED VIA A GLOBAL COMPUTER NETWORK AND VIA STREAMING SERVICES; PROVIDING ONLINE COMPUTER GAMES AND PROVIDING A WEBSITE FEATURING NON-DOWNLOADABLE PHOTOS AND NON-DOWNLOADABLE VIDEOS, AND INFORMATION IN THE FIELD OF TOYS, GAMES AND CHILDREN'S ENTERTAINMENT
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Attachments	BRBY Notice of Opposition 60343650.2.pdf(187425 bytes)
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Signature	/Sharoni S. Finkelstein/
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Name	SHARONI S. FINKELSTEIN
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Date	06/26/2023
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

MATTEL, INC.

Opposer,

Opposition No.:

Mark: BRBY

v.

Serial No. 97/512,109

BURBERRY LIMITED,

Applicant.

_____ /

NOTICE OF OPPOSITION

Opposer Mattel, Inc. (“Opposer”), by its attorneys Venable LLP, for its Notice of Opposition against Burberry Limited (“Applicant”), alleges as follows:

Parties

1. Opposer is a Delaware corporation with an address at 333 Continental Boulevard, El Segundo, CA 90245.
2. Applicant is a United Kingdom limited company with an address at Horseferry House, Horseferry Road, London, UK SW1P2AW.
3. Opposer believes that it will be damaged by registration of the mark BRBY (“Applicant’s Mark”). Therefore, pursuant to Lanham Act § 13(a), 15 U.S.C. § 1063(a), Opposer has standing to oppose Applicant’s Application No. 97/512,109 (the “Application”).

Opposer and Its World-Famous BARBIE® Trademarks

4. Opposer is an American multinational company founded in 1945, and a world leader in the design, manufacture and marketing of toys, games, playthings and family products. It has a presence in over 35 countries and territories and sells products in more than 100 nations.

5. BARBIE® is one of the most popular and valuable brands in the children's entertainment industry. Mattel's "BARBIE" trademark became famous as early as 1959, and over the ensuing six decades has used dozens of variations of the BARBIE® mark on several thousand different BARBIE®-branded goods and services, selling more than two billion BARBIE® dolls and BARBIE®-branded accessories.

6. On the strength of this strong consumer recognition, the BARBIE® brand also long ago expanded beyond toys and into various other accessories and products, including but not limited to clothing, printed journals, household goods including mugs, and entertainment services.

7. Opposer's BARBIE® Mark is one of the most recognizable brands in the world. Opposer's BARBIE® Mark is famous and was famous prior to any use or filing by Applicant. For example, in 1991, the U.S. Court of Appeals for the Second Circuit recognized that "the 'Barbie' doll is the best-selling toy doll in the world—96 percent of three to eleven-year-old girls in the United States own at least one. In the past 30 years 600 million Barbie dolls have been sold—one is sold every two seconds—and, in 1990 alone 26 million of them were sold, earning gross revenues for Mattel of \$740 million." *Miss America Organization v. Mattel, Inc.*, 945 F. 2d 536, 537 (2d Cir. 1991). And in 1998, now-Justice Sonia Sotomayor "conclude[d] that—by any measure— . . . the world-known BARBIE is a 'famous' trademark under the Federal Anti-Dilution Act." *Mattel, Inc. v. Jcom, Inc.*, 1998 U.S. Dist. LEXIS 16195 *9; 48 U.S.P.Q.2D (BNA) 1467; 1998 WL 766711 (S.D.N.Y. Sep. 10, 1998) (awarding injunction, damages, and legal fees for dilution against unauthorized user of BARBIE PLAYHOUSE mark for adult entertainment services); see also *Mattel, Inc. v. Internet Dimensions Inc.*, No. 99 CIV. 10066, 2000 WL 973745, at *6 (S.D.N.Y. Jul. 13, 2000) ("Mattel's BARBIE trademark is both 'famous' and 'distinctive' . . . within the meaning of subsection (c)(1) of [Lanham Act] section 43.").

8. In 1998, the BARBIE® doll was inducted into the National Toy Hall of Fame. Her entry in its website notes that, over the decades since her introduction in 1959, BARBIE® dolls have been sold representing various ethnicities and more than 75 different professions,¹ a number that has since risen to more than 200.

9. In February 2022, The NPD Group, a leading global information company, named BARBIE® the top global toy property for a second consecutive year. During the same month, BARBIE® starred in the USA TODAY Ad Meter’s highest-ranked Super Bowl® commercial. In April 2022, NASA collaborated with Opposer to bring BARBIE® dolls to the International Space Station to encourage children to pursue careers in STEM. In October 2022, timed to International Day of the Girl, the Barbie character became associated with her 250th career—which Opposer celebrated by announcing a new career-themed NFT collaboration with the Boss Beauties Foundation. In July 2023, Opposer plans to release a live-action *Barbie* film starring actor Margot Robbie in the title role.

10. In addition to its extensive common law rights, Mattel is the owner of numerous U.S. Registrations of BARBIE® and BARBIE-formative marks, including but not limited to:

U.S. Reg. No.	Mark	Excerpt of Goods
0689055	BARBIE	“Doll,” in International Class 28.
0741208	BARBIE	“Accessories for doll clothes,” in International Class 28.
0768331	BARBIE	“Doll case, trunk and wallet,” in International Class 18.
0768397	BARBIE	“Doll clothes and doll accessories,” in International Class 28.
1693139	BARBIE	“Jackets, sweatshirts, T-shirts, skirts,” in International Class 25.
1754535	BARBIE	“Dresses, shorts, T-shirts, blouses, skirts, pants, leggings, leggings with skirts attached,” in International Class 25.
2678386	BARBIE	“Bathing suits, bathrobes, beach cover-ups, boots, coats, rain coats, gloves, night gowns, hats, head bands,

¹ See < <https://www.toyhalloffame.org/toys/barbie> > (visited February 13, 2023).

U.S. Reg. No.	Mark	Excerpt of Goods
		headwear, night shirts, pajamas, panties, sandals, scarves, shirts, slippers, socks, sweaters, tank tops, turtlenecks, underwear, vests, caps, skorts, swimsuits, swimsuit covers, dresses, shorts, t-shirts, blouses, skirts,” in International Class 25; and “Backpacks, beach bags, handbags, wallets,” in International Class 18, and various other goods in classes 3, 6, 9, 12, 14, 16, 20, 21, 24, 25, 26, 28, and 30.
2040801	BARBIE	“Shoes,” in International Class 25.
0814995	BARBIE	“Series of books and printed articles-namely, storybooks, coloring books, activity books, painting books, and printed puzzles,” in International Class 16.
1946918	BARBIE	“Greeting cards,” in International Class 16.
1769285	BARBIE	“Facial tissues and stickers for fingernails,” in International Class 16.
0772298	BARBIE	“Time pieces, specifically wrist watches,” in International Class 14.
0810106	BARBIE	“Toy furniture specifically bed, wardrobe, chifforobe, vanity, and chest,” in International Class 28.
0814091	BARBIE	“Vanity sets and dresser sets, comprising mirrors, brushes, combs, compacts, and lipstick cases, for use by children,” in International Class 21.
1000125	BARBIE	“Halloween costumes and masks,” in International Class 25.
1300766	BARBIE	“Toy vehicles,” in International Class 28.
1773571	BARBIE	“Jewelry, namely, earrings, bracelets, necklaces, and charms,” in International Class 14.
1775637	BARBIE	“Cosmetics for use by little girls; namely, eyeshadow, lipstick, lip gloss, perfume, cologne, nail polish, blush, emery boards, and cosmetic sponges,” in International Class 3.
2087842	BARBIE (Stylized)	“Doll, doll clothing and doll accessories,” in International Class 28.
2639971	BARBIE (Stylized)	“T-shirts,” in International Class 25; and “Dolls, doll clothing, doll accessories,” in International Class 28.
2151953	BARBIE	“On-line retail store services featuring toys,” in International Class 35; and “Providing information over a global computer network featuring games, stories, directories for toys and games, toy collectibles,” in International Class 42.

U.S. Reg. No.	Mark	Excerpt of Goods
2495195	BARBIE	“Providing educational and entertainment services via a global computer network web site featuring stories, games, and directories for toys and games, intended for adults and children,” in International Class 41.
6267202	BARBIE	“Entertainment services, namely, providing non-downloadable animated movies, on-going television programs and non-downloadable webisode series, all featuring children’s entertainment provided via a global computer network and via streaming services; providing online computer games and providing a website featuring non-downloadable photos and non-downloadable videos, and information in the field of toys, games and children’s entertainment,” in International Class 41.

11. Many of the foregoing registrations are incontestable. Collectively, the foregoing registrations and related common law rights are referred to herein as “Opposer’s Marks,” and the goods and services provided in connection therewith are “Opposer’s Goods and Services.”

12. Opposer’s Goods and Services provided under Opposer’s Marks have been extensively and continuously sold, marketed, advertised and promoted throughout the United States. As a result of the quality of Opposer’s Goods and Services and the widespread promotion thereof under Opposer’s Marks, the goods have met with great commercial success and widespread consumer and media recognition. In addition, Opposer’s Marks have become symbols of Opposer and its related companies. Opposer’s Goods and Services, and Opposer’s goodwill, had come to be associated with Opposer prior to any use in commerce by Applicant.

Applicant and its Application to Register BRBY

13. Applicant’s Application, filed July 20, 2022, seeks to register Applicant’s Mark BRBY for use with the following goods and services (“Applicant’s Goods”):

- Class 18 - Leather and imitations of leather; duffel bags; holdalls; handbags; shoulder bags; trunks being luggage; valises; suitcases; travelling bags; crossbody bags; tote bags; garment bags for travel; bum-bags; belt bags; vanity cases, sold empty; baby diaper bags; baby carriers worn on the body; baby harnesses;

rucksacks; satchels; reusable shopping bags; canvas shopping bags; wheeled shopping bags and leather general purpose trolley bags; purses; leather pouches; coin pouches; wallets; key holders being key cases; credit card holders; pochettes; carrying cases for documents; luggage labels and luggage tags made of leather and imitation leather; labels of leather; cosmetic cases and bags, not fitted and sold empty; tie cases; leather cases for cufflinks; leather boxes; umbrellas; parasols; walking sticks; horse blankets; pet clothing; pet collars; animal leashes

- Class 25 - Clothing articles and outer clothing articles, namely, coats, clothing jackets, rainwear, ponchos, gilets, detachable coat linings being ready-made linings being parts of clothing, raincoats; blousons; casual coats; polo shirts; blouses; t-shirts; dresses; pajamas; knitwear, namely, jerseys being clothing, jumpers in the nature of coveralls, cardigans, sweaters, knitted leggings; shorts; trousers; suits for men women and children; skirts; clothing jackets; clothing jackets containing microprocessors; articles of underclothing, namely, boxer shorts, lingerie, loungewear, nightwear, underwear, undergarments, hosiery; sports clothing, namely, ski wear, sports jackets, sports jerseys, sports shirts, sports trousers, sweat pants, sweat shirts, sweat shorts, tracksuits, tennis wear, swimwear; sports footwear; tracksuits; ready-made linings, namely, finished textile linings for garments; ties as clothing; clothing belts; clothing wraps; serapes; scarves; shawls and stoles; gloves; footwear; headgear in the nature of headwear; Leather belts for clothing; shirts; jeans

14. Applicant filed its Application based on Section 44(d) of the Lanham Act, and amended its Application to claim Section 44(e) based on its UK Reg. No. UK00003747929 for BRBY.

15. Upon information and belief, Applicant has not used the BRBY mark on or in connection with Applicant's Goods in the United States.

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

16. Opposer incorporates herein by reference each of the foregoing paragraphs.

17. Opposer has priority based on its valid and subsisting registrations for Opposer's Marks and based on its prior and continuous use of Opposer's Marks in commerce in connection with Opposer's Goods and Services long before the filing date of the opposed Application and before any use in commerce by Applicant.

18. Applicant's Mark is highly similar to Opposer's Marks in appearance, sound, and commercial impression. The dominant (and, in most cases, the sole) portion of Opposer's Mark is the word BARBIE. Applicant's mark is the word BRBY. These marks are visually similar. Further, when spoken aloud, the marks are phonetically identical. This is particularly so given that there is no correct pronunciation of a mark. Thus, because Applicant's mark lacks any vowels to guide pronunciation, it would likely be read in a manner phonetically identical to BARBIE. Applicant's Mark could reasonably be viewed by consumers as a subset or expansion of the BARBIE® trademarks.

19. Applicant's Goods directly overlap with many of Opposer's Goods and Services. For example, Opposer has used and uses the BARBIE® mark (and owns registrations for the BARBIE® mark) in connection with handbags, overnight bags, luggage, a broad range of clothing and apparel, footwear, and headwear—all of which are also proposed to be offered under the Applicant's Mark. Consumers would be likely to wonder if, or assume that, Applicant's Goods are licensed by or affiliated with Opposer.

20. Opposer's Marks are or have been used in virtually all mainstream channels of trade, and marketed generally across virtually all demographic lines—not only to children, but also to the family members who purchase gifts for children and to adults nostalgic for the toys bearing Opposer's Marks. Members of each of these groups are likely to be among those who may purchase, consume, or see advertisements for Applicant's Goods, and Applicant's Application does not place any limits on the consumers to whom Applicant's Goods are marketed or provided.

21. Applicant's Goods, customers, and marketing channels so closely overlap with Opposer's Goods and Services as to be highly likely to cause confusion or mistake, or to deceive consumers under Section 2(d) of the Lanham Act, as amended, 15 U.S.C. §1052(d).

Dilution, 15 U.S.C. §1125(c)

22. Opposer incorporates herein by reference each of the foregoing paragraphs.

23. Opposer and its related companies have engaged in nationwide advertising, promotion, and use of its distinctive Opposer's Marks, and specifically of the BARBIE® Mark, for more than 60 years. Further, Opposer, directly and through its related companies, has had extensive sales of Opposer's Goods and Services in connection with its BARBIE® Mark over several decades.

24. Opposer's BARBIE® Mark has for many years received extensive media attention and publicity nationwide. Such pervasive and frequent media attention and publicity has had a substantial impact on the public and has long created an association in the minds of consumers between the BARBIE® Mark and Opposer and Opposer's related companies.

25. BARBIE® is a strong and distinctive mark that became famous, as defined under Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), well before both the filing date of the opposed Application, and before any first use alleged by Applicant.

26. Applicant's Mark is identical to, or a spurious imitation of, Opposer's Marks.

27. Upon information and belief, Applicant has intentionally chosen Applicant's Mark in order to create an association in the minds of those in the marketplace between the BARBIE® Mark and Applicant and Applicant's Goods.

28. In view of the similarities of the parties' marks and the fame of Opposer's BARBIE® Mark, Applicant's Mark so closely resembles Opposer's famous BARBIE® Mark that it is likely to cause dilution by blurring the distinctive quality of the BARBIE® Mark.

29. In addition, Applicant's Mark, if registered for or used on or in connection with Applicant's Goods, is likely to cause dilution by tarnishing the distinctive quality, reputation and goodwill of Opposer's famous BARBIE® Mark.

WHEREFORE, Opposer prays that Application Serial No. 97/512,109 be refused registration, that no registration be issued thereon to Applicant and that this opposition be sustained in favor of Opposer.

A filing fee for the Notice of Opposition in the required amount is being submitted herewith via credit card. If for any reason this payment method is unsuccessful, authorization is granted to charge the filing fee to Deposit Account No. 22-0261 and notify the undersigned accordingly.

Respectfully submitted,

Date: June 26, 2023

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