

ESTTA Tracking number: **ESTTA1300787**

Filing date: **07/31/2023**

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	The Rudolph Company, L.P.
Granted to date of previous extension	08/02/2023
Address	254 WEST 54TH ST. SUITE 1200 NEW YORK, NY 10019-5511 UNITED STATES
Attorney information	CRAIG S. MENDE FROSS ZELNICK LEHRMAN & ZISSU, P.C. 151 WEST 42ND STREET, 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary email: cmende@fzlj.com Secondary email(s): rlehv@fzlj.com, ttabfiling@fzlj.com 212-813-5900
Docket no.	RUDY 2303961

Applicant information

Application no.	97406750	Publication date	04/04/2023
Opposition filing date	07/31/2023	Opposition period ends	08/02/2023
Applicant	Destiny Soria 5309 WHEATLAND ST SAN ANTONIO, TX 78219 UNITED STATES		

Goods/services affected by opposition

Class 040. First Use: None First Use In Commerce: None All goods and services in the class are opposed, namely: Customized imprinting of company names and logos on the goods of others, namely, on promotional merchandise, apparel and corporate gifts; Customized printing of company names and logos for promotional and advertising purposes on the goods of others

Grounds for opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
No bona fide intent to use mark in commerce for identified goods or services	Trademark Act Section 1(b), 44(e) or 66(a)
Dilution by blurring	Trademark Act Sections 2 and 43(c)

Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
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Marks cited by opposer as basis for opposition

U.S. registration no.	1508079	Application date	03/26/1987
Register	Principal		
Registration date	10/11/1988	Foreign priority date	NONE
Word mark	RUDOLPH		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 016. First use: First Use: Aug 25, 1948 First Use In Commerce: Aug 25, 1948 CHILDREN'S BOOKS, GIFT ENCLOSURE CARDS AND GREETING CARDS</p> <p>Class 028. First use: First Use: Jun 16, 1947 First Use In Commerce: Jun 16, 1947 CHRISTMAS TREE DECORATIONS, CHRISTMAS STOCKINGS, STUFFED TOY ANIMALS, MUSIC BOX TOYS [AND EQUIPMENT SOLD AS A UNIT FOR PLAYING A CARD GAME]</p> <p>Class 030. First use: First Use: Sep 24, 1948 First Use In Commerce: Sep 24, 1948 CANDY</p>		

U.S. registration no.	1309723	Application date	07/03/1980
Register	Principal		
Registration date	12/18/1984	Foreign priority date	NONE
Word mark	RUDOLPH THE RED-NOSED REINDEER		
Design mark			
Description of mark	NONE		
Goods/services	<p>Class 009. First use: First Use: 1947 First Use In Commerce: 1947 Filmstrips With [and Without] Sound Tracks</p> <p>Class 016. First use: First Use: 1947 First Use In Commerce: 1947 Coloring and Activity Books</p> <p>Class 028. First use: First Use: 1947 First Use In Commerce: 1947 [Equipment Sold as a Unit for Playing Board and Dart Board Games,] Stuffed Toys, Christmas Tree Ornaments, Hand Puppets and Jigsaw Puzzles</p>		

U.S. registration no.	2803953	Application date	10/16/2000
Register	Principal		
Registration date	01/13/2004	Foreign priority date	NONE
Word mark	REINDEER NOSES		
Design mark			
Description of	NONE		

mark	
Goods/services	Class 030. First use: First Use: Jun 13, 1998 First Use In Commerce: Jun 13, 1998 CANDY

U.S. registration no.	1974435	Application date	01/09/1989
Register	Principal		
Registration date	05/21/1996	Foreign priority date	NONE
Word mark	NONE		
Design mark			
Description of mark	THE MARK COMPRISES A RED-TIPPED NOSE ON ANY FANCIFUL DEER-LIKE ANIMAL.		
Goods/services	<p>Class 009. First use: First Use: 1965 First Use In Commerce: 1965 PRERECORDED AUDIO AND VIDEO TAPES, [TRANSPARENCIES FOR VIEWING AND FILM STRIPS]ALL CONTAINING CHILDREN'S ENTERTAINMENT</p> <p>Class 016. First use: First Use: 1977 First Use In Commerce: 1977 CHILDREN'S BOOKS [, PAPER PARTY GOODS - NAMELY, NAPKINS, TABLECLOTHS AND HATS]</p> <p>Class 020. First use: First Use: 1950 First Use In Commerce: 1950 NOVELTY ITEMS, NAMELY, [MUSICAL AND] LIGHTED PIN-ON BUTTONS, WOODEN FIGURES AND STATUETTES, WOODEN [PLANT HOLDERS AND]CENTERPIECES</p> <p>Class 021. First use: First Use: 1984 First Use In Commerce: 1984 GLASS AND CRYSTAL FIGURINES</p> <p>Class 025. First use: First Use: 1970 First Use In Commerce: 1970 CLOTHING, NAMELY, SWEATSHIRTS, [LIGHTED SWEATSHIRTS] AND MASQUERADE COSTUMES</p> <p>Class 028. First use: First Use: 1952 First Use In Commerce: 1952 MUSICAL PLUSH TOYS, PUPPETS, MECHANICAL PLUSH TOYS AND BALLOONS, CHRISTMAS TREE ORNAMENTS AND DECORATED CHRISTMAS STOCKINGS</p> <p>Class 030. First use: First Use: 1984 First Use In Commerce: 1984 CANDY</p> <p>Class 035. First use: First Use: 1950 First Use In Commerce: 1950 SERVICES IN LICENSING THE NAME AND LIKENESS OF A FICTIONAL CHARACTER IN CONNECTION WITH VARIOUS GOODS AND PRODUCTS, NAMELY, PRERECORDED TAPES, BOOKS, STATIONERY, PAPER GOODS, NOVELTY ITEMS OF WOOD AND PLASTIC, CRYSTAL FIGURINES, CLOTHING, TOYS AND GAMES, CANDY, AND ENTERTAINMENT SERVICES</p> <p>Class 042. First use: First Use: 1964 First Use In Commerce: 1964 ENTERTAINMENT SERVICES IN THE NATURE OF ANIMATED CARTOON TELEVISION SHOWS</p>		

U.S. registration no.	1554634	Application date	10/19/1987
Register	Principal		
Registration date	09/05/1989	Foreign priority date	NONE

Word mark	NONE
Design mark	
Description of mark	NONE
Goods/services	<p>Class 016. First use: First Use: 1985 First Use In Commerce: 1985 GREETING CARDS, COMIC BOOKS [AND MUSIC BOX BOOKS]</p> <p>Class 020. First use: First Use: 1985 First Use In Commerce: 1985 NOVELTY ITEMS, NAMELY, ELECTRICAL LIGHTED BUTTONS</p> <p>Class 028. First use: First Use: 1977 First Use In Commerce: 1977 PLUSH TOYS, BALLOONS [AND EQUIPMENT SOLD AS A UNIT FOR PLAY- ING A BOARD GAME]</p> <p>Class 030. First use: First Use: 1984 First Use In Commerce: 1984 CANDY</p> <p>Class 035. First use: First Use: 1981 First Use In Commerce: 1981 SERVICES IN LICENSING USE OF THE NAME AND IMAGE OF A FICTIONAL CHARACTER IN CONNECTION WITH VARIOUS GOODS AND PRODUCTS, NAMELY, BOOKS, STATIONARY, PAPER GOODS, CLOTHING, CANDY, [TOYS] AND GAMES</p>

Attachments	F5201741.pdf(227505 bytes)
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Signature	/Craig S. Mende/
Name	CRAIG S. MENDE
Date	07/31/2023

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

-----X	:	
THE RUDOLPH COMPANY, L.P.,	:	
Opposer,	:	
	:	
- against -	:	NOTICE OF OPPOSITION
	:	
DESTINY SORIA DBA LADY DESTINY	:	
PRODUCTIONS,	:	
Applicant.	:	
-----X	:	

Opposer, The Rudolph Company, L.P., a Delaware limited partnership with an address at 254 West 54th St, Suite 1200, New York, New York 10019-5516, believes that it would be damaged by registration of the red-nosed reindeer skull design mark shown below (“Applicant’s Mark”) for “Customized imprinting of company names and logos on the goods of others, namely, on promotional merchandise, apparel and corporate gifts; Customized printing of company names and logos for promotional and advertising purposes on the goods of others” in Class 40, as sought in Application Serial No. 97406750 (the “Application”), and therefore opposes the same on grounds of (1) priority and likelihood of confusion, (2) dilution by blurring, (3) dilution by tarnishment, and (4) lack of bona fide intent to use the mark for the applied-for services. As specific grounds for opposition, Opposer alleges as follows:



FACTS COMMON TO ALL CLAIMS FOR RELIEF

A. Opposer and its Famous RUDOLPH Marks

1. Opposer is the owner of all trademark and other rights in the name and appearance of the beloved Rudolph the Red-Nosed Reindeer character (the “Rudolph Character”) and associated indicia, including the marks RUDOLPH, RUDOLPH THE RED-NOSED REINDEER, the Design of a Reindeer with a Shiny Nose, a Drawing of a Red-Tipped Nose on any Fanciful Deer-Like Animal, and a Drawing of a Deer’s Head (together, the “RUDOLPH Marks”).

2. The Rudolph Character, created more than a century after Santa’s original eight flying reindeer were conceived, is the star of the seminal stop-motion animated holiday television special “Rudolph the Red-Nosed Reindeer” (the “Rudolph Special”). The Rudolph Special was first broadcast nationally in 1964 and has been re-broadcast in the United States every year since.

3. The Rudolph Character is also the subject of the original “Rudolph the Red-Nosed Reindeer” storybook by Robert L. May, and the famous “Rudolph the Red-Nosed Reindeer” song, which is owned by St. Nicholas Music Inc. and is featured in the Rudolph Special. The Robert L. May Company, LLC and St. Nicholas Music Inc. are Opposer’s General Partners. “Rudolph the Red-Nosed Reindeer” is among the handful of songs that most Americans know by heart, and its popularity is enduring: Gene Autrey’s recording of the song reached #21 on the Billboard Hot 100 chart during the last week of December 2022, more than seven decades after it reached #1 upon its initial release in 1949.

4. As both children and adults know well, the defining feature of the Rudolph Character’s appearance is his bright red nose. As the song says:

Rudolph the Red-Nosed Reindeer
Had a very shiny nose
And if you ever saw it
You would even say it glows

Indeed, it was his red nose that distinguished Rudolph from Santa's other reindeer and caught Santa's eye:

Rudolph, with your nose so bright
Won't you guide my sleigh tonight?

5. The RUDOLPH Marks – including the depiction of a red-tipped nose on any fanciful deer-like animal – are featured under license in the Rudolph Special. They have also been featured in connection with a wide array of other authorized goods, services, events, and productions over many years. These licensed offerings include toys, stuffed animals, books, greeting cards, figurines, clothing, candy, coffee, video games, mobile apps, amusement park attractions, parades, theatrical productions, and audiovisual productions.

6. Through many decades of use, promotion, and licensing, the RUDOLPH Marks have become exclusively associated with Opposer's offerings, have become famous marks of Opposer, and represent enormous goodwill among people of all ages.

7. The RUDOLPH Marks are also the subject of multiple trademark registrations covering numerous different licensed goods and services in various classes, including the following:

- (a) **Reg. No. 1508079** for the mark RUDOLPH for:
- “Children's books, gift enclosure cards and greeting cards” in Class 16
 - “Christmas tree decorations, Christmas stockings, stuffed toy animals, music box toys” in Class 28
 - “Candy” in Class 30
- (b) **Reg. No. 1309723** for RUDOLPH THE RED-NOSED REINDEER for:
- “Filmstrips With ... Sound Tracks” in Class 9

- “Coloring and Activity Books” in Class 16
- “Stuffed Toys, Christmas Tree Ornaments, Hand Puppets and Jigsaw Puzzles” in Class 28

(c) **Reg. No. 2803953** for the mark REINDEER NOSES for:

- “Candy” in Class 30

(d) **Reg. No. 1974435** for “a red-tipped nose on any fanciful deer-like animal”



for:

- “Prerecorded audio and video tapes, ... all containing children’s entertainment” in Class 9
- “Children’s books” in Class 16
- “Novelty items, namely, ... lighted pin-on buttons, wooden figures and statuettes, wooden ... centerpieces” in Class 20
- “Glass and crystal figurines” in Class 21
- “Clothing, namely, sweatshirts, ... and masquerade costumes” in Class 25
- “Musical plush toys, puppets, mechanical plush toys and balloons, Christmas tree ornaments and decorated Christmas stockings” in Class 28
- “Candy” in Class 30
- “Services in licensing the name and likeness of a fictional character in connection with various goods and products, namely, prerecorded tapes, books, stationery, paper goods, novelty items of wood and plastic, crystal figurines, clothing, toys and games, candy, and entertainment services” in Class 35
- “Entertainment services in the nature of animated cartoon television shows” in Class 42

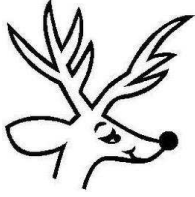
(e) **Reg. No. 1554634** for a depiction of a reindeer with a shiny nose



for:

- “Greeting cards, comic books” in Class 16
- “Novelty items, namely, electrical lighted buttons” in Class 20
- “Plush toys, balloons” in Class 28
- “Candy” in Class 30
- “Services in licensing use of the name and image of a fictional character in connection with various goods and products, namely, books, stationary [sic], paper goods, clothing, candy, and games” in Class 35

(f) **Reg. No. 3,141,200** for “drawing of a deer’s head”



for:

- “Wholesale distributorships featuring tires and tire accessories, On-line retail store services featuring tires and tire accessories, Retail stores featuring tires and tire accessories, Transportation logistics services, namely, arranging the transportation of goods for others” in Class 35.

The foregoing registrations are all valid, subsisting, and in full force and effect and constitute evidence of Opposer’s exclusive rights in these marks for the recited goods and services as a matter of law.

B. Applicant’s Development of Unauthorized RUDOLPH-Based Movie and Mark

8. Upon information and belief, Applicant is an individual residing at 5309 Wheatland St., San Antonio, Texas 78219.

9. Without any notice to or authorization from Opposer, Applicant created and commenced production of a horror film entitled “Christmas Slasher” (“Applicant’s Movie”) featuring a gory adaptation of Opposer’s Rudolph Character.

10. Applicant repeatedly referenced the Rudolph Character during its development and promotional activities. For example, in a 2020 live-streamed interview about the intended project, Applicant stated, among other things:

- “Yes, we have Rudolph the Red-Nosed Reindeer as an evil monster”;
- “Yes, it is about Rudolph the Red-Nosed Reindeer becoming a zommed-out monster”; and
- “Let’s make something with Rudolph being an evil bad guy.”

11. Explaining the origin of the concept for Applicant’s Movie, Applicant stated in the interview: “I mean, we had gingerbread man, we had snow man, Jack Frost, a lot of Mrs. and

Mr. Claus and one that had to do with zombie elves, and I was like, ‘What about Rudolph? Why are we forgetting Rudolph? **Rudolph needs a starring role in a horror movie. So let’s make this happen.**’ (Emphasis added.)

12. In a movie synopsis posted on Facebook, under the heading “About the Film – Christmas Slasher,” Applicant stated: “During a fight for survival, the question remains – who killed Rudolph?” She stated further: “The Christmas Slasher ... brings a horror twist to classic characters including Santa Clause, Rudolph, and Mrs. Clause”

13. In 2021, on the same Facebook page promoting her intended movie, Applicant posted the image that is now Applicant’s Mark – a drawing of a reindeer skull and antlers that is rendered entirely in black and white except for the prominent bulbous red nose on the face, red blood dripping from the red nose, and red Christmas lights hanging from the antlers.

14. Applicant subsequently posted two trailers for Applicant’s Movie, one referred to as a “Teaser Trailer” and the other as a “Proof of Concept”. Both featured the “Rudolph the Red-Nosed Reindeer” song. (Applicant neither sought nor received a license covering such use of the song.)

15. Applicant also touted the merchandise and promotional tie-ins planned for Applicant’s Movie.

16. In April 2022, Opposer’s general partner St. Nicholas Music sent a cease-and-desist letter and follow-up communications to Applicant, objecting to Applicant’s unauthorized use of the “Rudolph the Red-Nosed Reindeer” song in the trailers, and, on behalf of The Rudolph Company, objecting to Applicant’s use of the Rudolph Character in the trailers, other promotional materials, and the intended slasher film.

17. The April 2022 correspondence to Applicant specifically objected to use of the red-nosed reindeer skull image that Applicant has now applied to register as Applicant's Mark, stating in relevant part: "we have seen various uses (such as in your film credits, and on your Facebook page), of an illustration of a reindeer skull with a bright red nose (the red color presumably being intended to imply blood). That image is, quite simply, an image of a red-nosed reindeer, which surely is intended to evoke, and would be perceived by viewers as being, 'Rudolph.'" "

18. In the exchange of correspondence in April 2022, Applicant asserted that she did not intend to re-tell the Rudolph the Red-Nosed Reindeer "story," but she admitted that her "intention was to use the Rudolph character."

19. Applicant ultimately advised that she now understood that she was not permitted to use the Rudolph Character, and that she would therefore make substantial changes, including removal of the red nose in her imagery. Likewise, at that time, Applicant posted on Facebook her professed intention to remove the red-nosed reindeer imagery from her materials, including specifically the image of Applicant's Mark featured on her poster, stating: "Hello friends: As of today, we can not use the skull poster and name of Rudolph. However, this is a very easy fix for our production as 'Christmas Slasher' had absolutely no retelling of the Rudolph story. **Even his nose wasn't red.**" (Emphasis added.)

20. Applicant also posted that: "we also have to adjust the teaser poster, as a 'reindeer with a red nose' of any sort also falls into their copyright [sic] laws. **So, we will be adjusting the poster to a standard black nose.**" (Emphasis added.)

C. **Applicant’s Application to Register the Red-Nosed Reindeer Skull Mark**

21. Just weeks later, on May 12, 2022, Applicant filed an application to register as a service mark Applicant’s Mark shown below for “Customized imprinting of company names and logos on the goods of others, namely, on promotional merchandise, apparel and corporate gifts; Customized printing of company names and logos for promotional and advertising purposes on the goods of others” (“Applicant’s Services”).



22. The description of Applicant’s Mark in the USPTO filing makes abundantly clear that Applicant, in fact, had no intention to change or remove from Applicant’s Mark a defining element of Opposer’s Rudolph Character and depiction – the prominent red nose:

The color(s) black, white, and **red is/are claimed as a feature of the mark**. The mark is comprised of a white reindeer skull with black eyes, black accents, and **red blood** dripping from the mouth and visible through the skeletal **nasal bones**. The reindeer skull's horns are decorated with holiday lights featuring white cording and red bulbs. The remainder of the black in the mark is background area which is not a part of the mark. (Emphasis added.)¹

¹ Applicant initially included the following as the description of Applicant’s Mark in her Application (prior to revision by an Examiner’s Amendment): “The mark consists of Slasher 2D logo: The Slasher the reindeer logo is comprised of a reindeer skull with black eyes and blood dripping from the mouth and visible through the skeletal nasal bones. The reindeer skull's horns are decorated with red holiday lights. (The mark comprises a reindeer skull with black eyes and blood visible from the nasal bone and dripping from the mouth with holiday lights on the antlers and either a black, red or white background). Any content containing such a sleigh is not acceptable for commercial, media, and film use due to trademark. Photo below of logo Under trademark Laws, anyone who uses the name of Christmas Slasher with an image of slasher reindeer logo image, likeness, names without permission is potentially violating terms of a trademark owned by Lady Destiny Productions, San Antonio- based ‘entertainment rights’ company LLC.”

FIRST CLAIM FOR RELIEF – LIKELIHOOD OF CONFUSION

23. Opposer repeats and realleges the allegations in paragraphs 1 through 22.

24. Opposer's first use of the RUDOLPH Marks, and Opposer's registration of each of the RUDOLPH Marks listed above, were long prior to the filing date of Applicant's intent-to-use Application or any other priority date upon which Applicant can rely. As such, Opposer's rights in the RUDOLPH Marks are prior and superior to any rights Applicant may claim in Applicant's Mark.

25. Applicant's Mark is based upon, adapted from, and highly similar in appearance and commercial impression to Opposer's RUDOLPH Marks. Applicant's Mark is a rendering of the skull and antlers of a reindeer featuring a prominent, distinctive red nose that is a defining feature of Opposer's RUDOLPH Marks associated with Opposer and its Rudolph Character.

26. Opposer's RUDOLPH Marks have been used and licensed for a wide array of authorized goods and services. Applicant's Services are related to goods and services offered by Opposer and its licensees under Opposer's RUDOLPH Marks, and consumers are likely to be deceived into believing that any use of Applicant's Mark in connection with Applicant's Services is approved by Opposer.

27. The numerous references by Applicant to the Rudolph Character during the development and promotion of Applicant's Movie and Applicant's Mark demonstrate that Applicant's conduct is willful and intended to trade on the goodwill associated with Opposer's RUDOLPH Marks.

28. Applicant's use of Applicant's Mark in connection with Applicant's Services is likely to cause confusion among consumers and deceive them into believing, falsely, that Applicant's services originate with, are licensed, sponsored or approved by, or are otherwise connected with

Opposer or the goods and services Opposer and its licensees have offered under the RUDOLPH Marks. Any use of the Applicant's Mark by Applicant is, therefore, likely to cause confusion, cause mistake or to deceive the public, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

29. As a result of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in Opposer's RUDOLPH Marks and would threaten the investment and goodwill of Opposer in its RUDOLPH Marks. Opposer therefore would be harmed by registration of Applicant's Mark.

SECOND CLAIM FOR RELIEF – DILUTION BY BLURRING

30. Opposer repeats and realleges the allegations in paragraphs 1 through 29.

31. Opposer's RUDOLPH Marks are federally registered trademarks.

32. Opposer's RUDOLPH Marks are inherently distinctive and strong marks.

33. Opposer's RUDOLPH Marks have been used nationally, have been promoted extensively, and have garnered extensive publicity and coverage over many years. Through long and exclusive use, promotion, and publicity, including in connection with the iconic Rudolph Special – one of the most beloved and enduring entertainment properties in existence – the RUDOLPH Marks have become famous marks of Opposer.

34. Opposer's RUDOLPH Marks were registered and became famous long before the filing date of Applicant's intent-to-use Application or any other priority date upon which Applicant can rely.

35. Applicant's Mark, which features a bright red nose on a reindeer skull image with antlers, was intended to and does call to mind, create the same mental impression as, and otherwise remind consumers of Opposer's RUDOLPH Marks.

36. By virtue of (i) the similarity between the parties' respective marks, (ii) the fame of Opposer's RUDOLPH Marks, and (iii) the exclusive association between the RUDOLPH Marks and Opposer and its offerings under those marks, the use and registration of Applicant's Mark in connection with Applicant's Services will dilute and/or create a likelihood of dilution of Opposer's famous RUDOLPH Marks by impairing the distinctiveness of these marks and their ability to identify exclusively goods and services offered or licensed by Opposer.

37. Thus, Applicant's use of Applicant's Mark in connection with the services identified in the Application will cause and/or is likely to cause dilution by blurring of Opposer's famous RUDOLPH Marks, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

38. By reason of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in the RUDOLPH Marks and would threaten the investment and goodwill of Opposer in its RUDOLPH Marks. Opposer therefore would be harmed by registration of Applicant's Mark.

THIRD CLAIM FOR RELIEF – DILUTION BY TARNISHMENT

39. Opposer repeats and realleges the allegations in paragraphs 1 through 38.

40. Opposer's RUDOLPH Marks are federally registered trademarks, and were registered and became famous long before the filing date of the Application or any other priority date upon which Applicant can rely.

41. Opposer's RUDOLPH Marks are closely associated with Opposer's family-friendly offerings under the RUDOLPH Marks, including the Rudolph Special, which have been beloved by children for decades.

42. Applicant's Mark, which features a bright red nose on a reindeer skull image with antlers, is based directly on and is a mutilation and alteration of Opposer's RUDOLPH Marks.

43. Consistent with its history as the intended iconography for Applicant's violent slasher movie and related materials, Applicant's Mark portrays the reindeer and iconic red nose of Opposer's RUDOLPH Marks by using of a reindeer skull or skeleton image with a blood-covered red nose and four red vertical lines to depict blood dripping from the skull.

44. Applicant's gruesome portrayal of the Rudolph Character in Applicant's Mark creates an unsavory association and threatens great harm to the family-friendly reputation and tremendous goodwill long associated with Opposer's RUDOLPH Marks.

45. Thus, Applicant's use of Applicant's Mark in connection with the services identified in the Application will cause and/or is likely to cause dilution by tarnishment of Opposer's famous RUDOLPH Marks, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

46. By reason of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with Opposer's prior exclusive rights in Opposer's RUDOLPH Marks and would threaten the investment and goodwill of Opposer in its RUDOLPH Marks. Opposer therefore would be harmed by registration of Applicant's Mark.

FOURTH CLAIM FOR RELIEF – LACK OF BONA FIDE INTENT

47. Opposer repeats and realleges the allegations in paragraphs 1 through 46.

48. The Application is based on an alleged intent to use Applicant's Mark for Applicant's Services, namely: "Customized imprinting of company names and logos on the goods of others, namely, on promotional merchandise, apparel and corporate gifts; Customized printing of company names and logos for promotional and advertising purposes on the goods of others."

49. Upon information and belief, Applicant has never provided third parties with customized printing of their corporate logos on corporate gifts or provided any other Applicant's Services to third parties.

50. Upon information and belief, Applicant does not own equipment required to provide customized printing of customers' corporate logos on goods of others or to provide any other Applicant's Services.

51. Upon information and belief, Applicant has no written plans for establishing a business capable of offering Applicant's Services under Applicant's Mark.

52. Applicant did not, when filing the Application, have "a bona fide intention, under circumstances showing the good faith of such person, to use [Applicant's Mark] in commerce" in connection with Applicant's Services as required to file a valid intent-to-use application under Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

53. Thus, Applicant is not entitled to a registration of Applicant's Mark for Applicant's Services as sought in the Application.

54. By reason of the foregoing, registration to Applicant of Applicant's Mark would be inconsistent with the requirements of Section 1(b) of the Lanham Act, and Opposer would be harmed by registration of Applicant's Mark.

WHEREFORE, Opposer respectfully requests that this opposition be sustained and that registration of Applicant's Mark as sought in her Application be denied in its entirety.

Dated: New York, New York
July 31, 2023

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU,
P.C.

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