

ESTTA Tracking number: **ESTTA1239448**

Filing date: **10/03/2022**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner information

Name	Disney Enterprises, Inc.		
Entity	Corporation	Citizenship	Delaware
Address	500 SOUTH BUENA VISTA STREET BURBANK, CA 91521 UNITED STATES		

Attorney information	LINDA K. MCLEOD KELLY IP, LLP 1300 19TH STREET, NW, SUITE 420 WASHINGTON, DC 20036 UNITED STATES Primary email: linda.mcleod@kelly-ip.com Secondary email(s): saul.cohen@kelly-ip.com, lit-docketing@kelly-ip.com No phone number provided		
Docket no.			

Registration subject to cancellation

Registration no.	6193792	Registration date	11/10/2020
Register	Principal		
Registrant	Notion Dynamics, LLC PO BOX 878 WASHINGTON, MI 48094 UNITED STATES		

Goods/services subject to cancellation

Class 028. First Use: Mar 25, 2020 First Use In Commerce: Mar 25, 2020 All goods and services in the class are subject to cancellation, namely: Board games
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Grounds for cancellation

Abandonment	Trademark Act Section 14(3)
Other	Void ab Initio, 15 U.S.C 1051(a) and 1127

Attachments	WHERE IS PLUTO Petition for Cancellation.pdf(2807910 bytes)
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Signature	/Linda McLeod/
Name	Linda K. McLeod
Date	10/03/2022

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

<p>DISNEY ENTERPRISES, INC.,</p> <p style="text-align: center;">Petitioner,</p> <p style="text-align: center;">v.</p> <p>NOTION DYNAMICS, LLC,</p> <p style="text-align: center;">Respondent.</p>	<p>Cancellation No.:</p> <div style="text-align: center;"></div> <p>Mark: Registration No.: 6193792 Issued: November 10, 2020</p>
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PETITION FOR CANCELLATION

Petitioner Disney Enterprises, Inc., a Delaware corporation having a principal place of business at 500 South Buena Vista Street, Burbank, California 91521, believes that it is being and will continue to be damaged by the registration of Notion Dynamics, LLC's ("Respondent") mark ("Respondent's Mark") shown in Registration No. 6193792 (the "Registration"), and petitions to cancel the same in its entirety. As grounds for cancellation and a statutory cause of relief, Petitioner alleges the following, upon actual knowledge with respect to Petitioner's own acts, and upon information and belief as to other matters:

Petitioner and Its Business

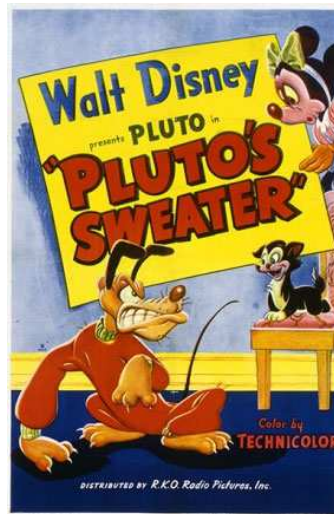
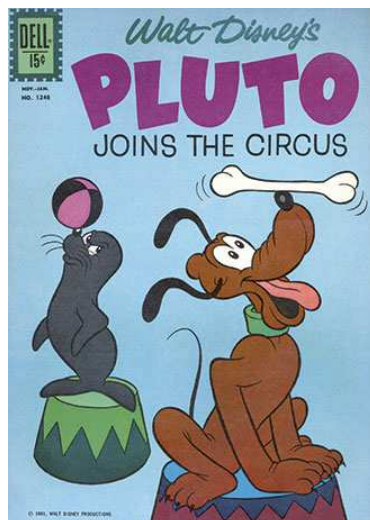
1. Disney Enterprises, Inc., by and through its predecessors-in-interest and related companies (collectively, "Petitioner"), is one of the world's leading producers and providers of entertainment, films, music, and consumer products. Petitioner engages in a vast licensing program under which it uses or licenses the use of its properties and characters in connection with a wide variety of products and services, including but not

limited to entertainment services, television programs, motion picture films, comic books, toys, dolls, sporting goods, bags, personal care products, linens, towels, apparel, food, interactive theme parks, online games, computer games, video games, music, and mobile applications.

Petitioner and Its PLUTO Mark and Character

2. For decades, Petitioner has used its PLUTO mark and name (the “PLUTO Mark”) in commerce in connection with a wide variety of products and services featuring its PLUTO character, including entertainment services, films, games, toys, apparel, and books. Many millions of people have been exposed to Petitioner’s PLUTO Mark.

Representative images showing Petitioner’s PLUTO Mark are below.





Adult Pluto Calf Socks

★★★★☆ 19008 Reviews

Color: Pluto



\$20.00

Size: L

[Size Guide](#)



One Purchased = One Donated™



LEGO® Disney™ Goofy & Pluto BrickHeadz - 40378

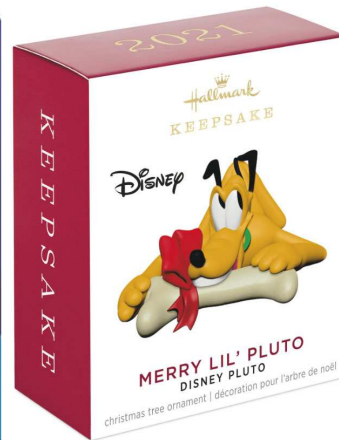
\$14.99

[ADD TO CART](#)

[BUY IT NOW](#)

PRODUCT #40378
AGE 10+
214 PIECES

QUANTITY LIMIT 6 PER CUSTOMER



3. Petitioner owns U.S. Trademark Application No. 90660770 for the PLUTO Mark, which was filed on April 21, 2021 under Section 1(b). The Application currently covers the following goods in Class 28:

Action figures; children's multiple activity toys; balloons; bath toys; bean bags; bean bag dolls; bobblehead dolls; bubble making wand and solution sets; toy imitation cosmetics; Christmas stockings; Christmas tree ornaments and decorations; collectable toy figures; crib mobiles; crib toys; dolls; doll clothing; doll accessories; doll playsets; electric

action toys; hand-held units for playing electronic games for use with or without an external display screen or monitor; magic tricks; marbles; mechanical toys; music box toys; musical toys; paper party favors; paper party hats; plush toys; puppets; role playing toys in the nature of play sets for children to imitate real life occupations; snow globes; squeeze toys; stuffed toys; teddy bears; toy action figures and accessories therefor; toy boats; toy bucket and shovel sets in the nature of sand toys; toy building blocks; toy mobiles; toy vehicles; toy scooters; toy cars; toy figures; toy banks; toy vehicles in the nature of trucks; toy watches; toy weapons; toy building structures and toy vehicle tracks; video game machines for use with televisions; wind-up toys; toy trains and parts and accessories therefor; toy aircraft; fitted plastic films known as skins for covering and protecting electronic game playing apparatus, namely, video game consoles, and hand-held video game units

4. On June 9, 2022, the U.S. Patent and Trademark Office issued a Final Office Action refusing registration of Petitioner's PLUTO Mark under Section 2(d), 15 U.S.C. Section 1052(d), based on an alleged likelihood of confusion with Respondent's Mark (and another mark that is not addressed in this Petition).

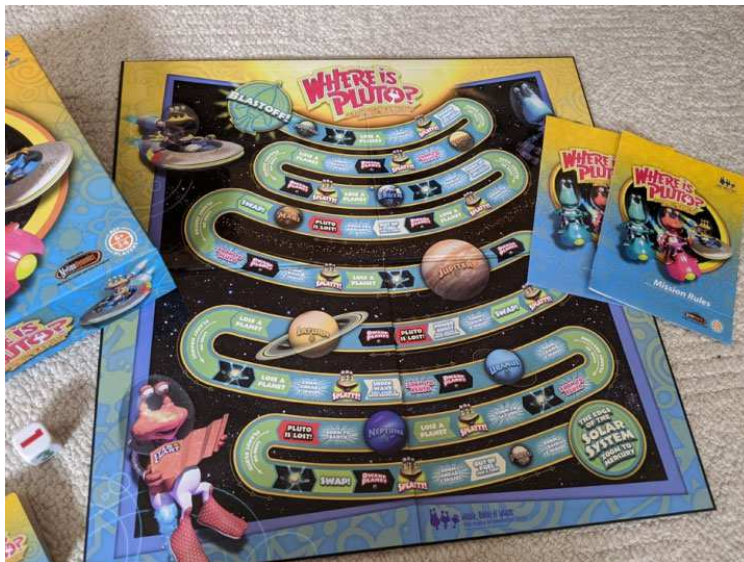
5. Because Petitioner has been refused registration of its PLUTO Mark based on an alleged likelihood of confusion with Respondent's Mark, Petitioner has been damaged by the Registration and therefore has an entitlement to a statutory cause of action. TBMP § 309.03(b).

Respondent, the Registration, and Respondent's Mark

6. Respondent is the listed owner of the Registration, which issued on November 10, 2020 for "Board games" in Class 28 ("Respondent's Goods").

7. Respondent purports to use Respondent's Mark in connection with a board game called WHERE IS PLUTO?, as purportedly shown in the specimen shown

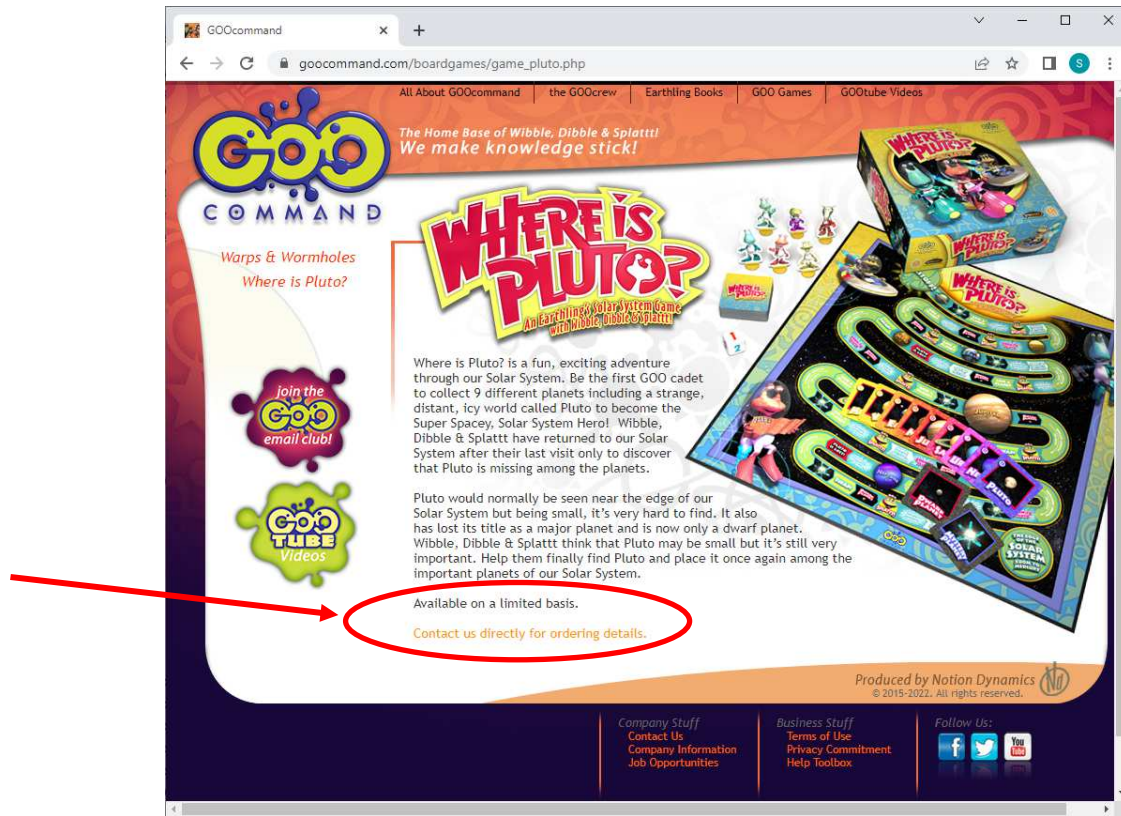
below, which was submitted by Respondent in connection with Respondent's Application for Respondent's Mark.



8. The Registration claims that Respondent's Mark was first used in commerce with Respondent's Goods "[a]t least as early as" March 25, 2020.

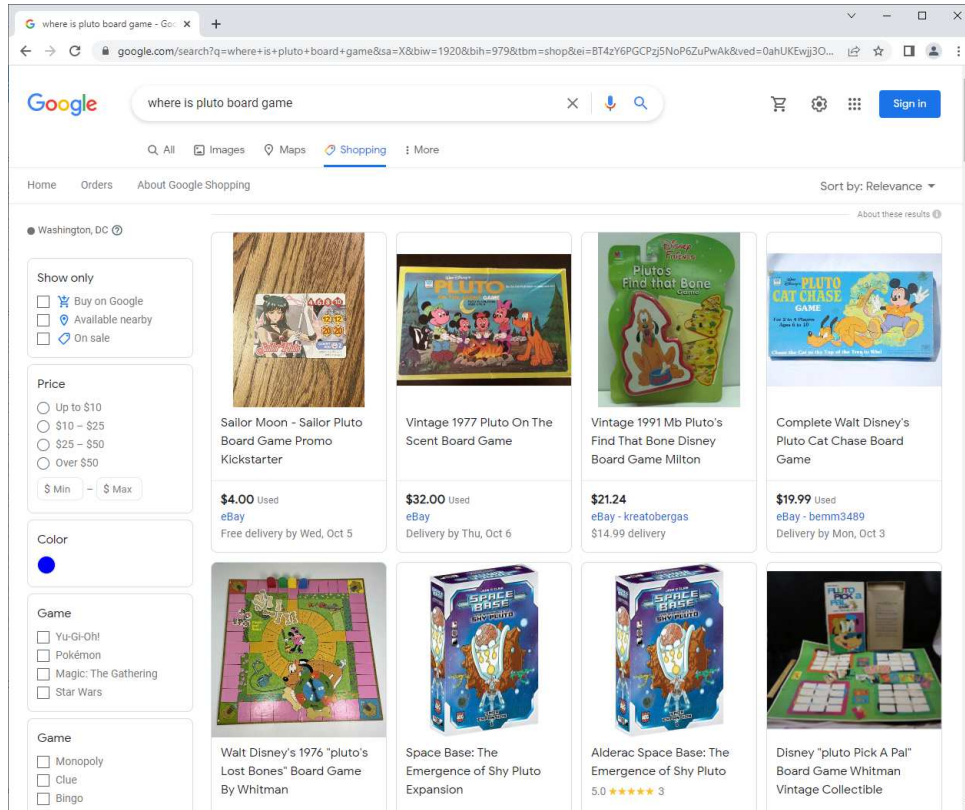
9. On information and belief, and as set forth in more detail in the paragraphs below, Respondent does not use Respondent's Mark in commerce in the ordinary course of trade.

10. The page for the WHERE IS PLUTO? board game on Respondent's website claims that the WHERE IS PLUTO? board game is only "[a]vailable on a limited basis" and that interested parties must "[c]ontact us directly for ordering details" via an online contact form. On information and belief, this reflects the fact the WHERE IS PLUTO? board game is not currently available and is only made and transported in commerce via on-demand manufacturing. An image of Respondent's webpage for the WHERE IS PLUTO? board game is shown below:



11. Furthermore, Petitioner has not been able to locate any other retail outlets where the WHERE IS PLUTO? board game is offered for sale or available for purchase. For example, Petitioner's Amazon page does not list the WHERE IS PLUTO? board game or any other products other than two books.¹ A search for "where is pluto board game" on Google's shopping portal has no listings for Respondent's WHERE IS PLUTO? board game, as shown below.

¹ See <https://www.amazon.com/kindle-dbs/entity/author/B014BUZ8HO>.



12. Furthermore, the website www.boardgamegeek.com, a popular board gaming website that claims to have an “extensive database of more than 120,000 board games (as of October 2020),”² has no listing for the WHERE IS PLUTO? board game.³

13. On information and belief, the specimens shown in Respondent’s application for Respondent’s Mark do not depict a WHERE IS PLUTO? board game that was sold or offered for sale in commerce in the ordinary course of trade, but rather depict a prototype product. Respondent’s application describes the specimens merely as “[p]hotos of the final Where is Pluto? board game product.”

² https://boardgamegeek.com/wiki/page/Guide_To_BoardGameGeek.

³ A search for “WHERE IS PLUTO” on that website leads to the page for a different game called “Where is Maui?” that is not offered in connection with Respondent’s Mark and that does not appear to be associated with Respondent.

Count I: Void *ab Initio*, 15 U.S.C. §§ 1051(a) and 1127

14. Petitioner repeats and realleges each and every allegation set forth above.

15. Section 1(a) of the Lanham Act, 15 U.S.C. § 1051(a), requires that an applicant for a use-based trademark application make a verified statement that the applied-for mark is in use in commerce—which is defined to mean bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark—for all of the covered goods as of the application filing date.

16. Upon information and belief, Respondent had not used Respondent's Mark in United States commerce on or in connection with Respondent's Goods as of the April 10, 2020 filing date of the application for Respondent's Mark as required under Sections 1(a) and 45 of the Lanham Act, 15 U.S.C. §§ 1051(a) and 1127.

17. Accordingly, the Registration is void *ab initio* and should be cancelled.

Count II: Abandonment Under Section 45, 15 U.S.C. § 1127

18. Petitioner repeats and realleges each and every allegation set forth in the paragraphs above.

19. Respondent has, on information and belief, abandoned Respondent's Mark shown in the Registration by not commencing use of Respondent's Mark in commerce and by ceasing any and all purported use of Respondent's Mark with Respondent's Goods, or any other goods or services, with no intent to resume such use in any capacity.

20. On information and belief, Respondent has abandoned Respondent's Mark shown in the Registration based on non-use of Respondent's Mark with

Respondent's Goods, or any other goods or services, in U.S. commerce in the ordinary course of trade under Section 45 of the Trademark Act, 15 U.S.C. § 1127.

21. To the extent that Respondent has made any use of Respondent's Mark in U.S. commerce for any of Respondent's Goods & Services, or any other goods or services, such use has been token, de minimis, and/or not in the ordinary course of trade as required under section 45 of the Lanham Act, 15 U.S.C. § 1127.

22. Accordingly, the Registration should be cancelled based on abandonment under Section 45 of the Lanham Act, 15 U.S.C. § 1127.

WHEREFORE, Petitioner believes that it is being and will continue to be damaged by the Registration. Petitioner is entitled to a statutory cause of relief and respectfully requests that this Petition for Cancellation be granted and that the Registration be cancelled in its entirety.

The filing fee has been submitted electronically. Any deficiency in the fee should be charged to Deposit Account No. 506154.

Respectfully submitted,

Dated: October 3, 2022

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