

ESTTA Tracking number: **ESTTA758043**

Filing date: **07/13/2016**

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	Wm. Wrigley Jr. Company
Granted to Date of previous extension	07/13/2016
Address	1132 W. Blackhawk Street Chicago, IL 60642 UNITED STATES
Attorney information	Douglas N. Masters Loeb & Loeb LLP 321 N. Clark Street, Suite 2300 Chicago, IL 60654 UNITED STATES chdocket@loeb.com, wrigley@loeb.com, dmasters@loeb.com Phone:312-464-3100

Applicant Information

Application No	86752170	Publication date	03/15/2016
Opposition Filing Date	07/13/2016	Opposition Period Ends	07/13/2016
Applicant	CMG Leisure Limited Moss Side Industrial Estate Callington Cornwall, PL177SD,A UNITED KINGDOM		

Goods/Services Affected by Opposition

Class 010. First Use: 2015/09/08 First Use In Commerce: 2015/09/08
All goods and services in the class are opposed, namely: Electric massage appliances, namely, electric vibrating massager; Sex toys

Grounds for Opposition


Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)
False suggestion of a connection with persons, living or dead, institutions, beliefs, or national symbols, or brings them into contempt, or disrepute	Trademark Act Section 2(a)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration	1221105	Application Date	04/14/1981
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No.			
Registration Date	12/21/1982	Foreign Priority Date	NONE
Word Mark	SKITTLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1971/03/10 First Use In Commerce: 1971/03/10 Candy		

U.S. Registration No.	1415102	Application Date	04/11/1986
Registration Date	10/28/1986	Foreign Priority Date	NONE
Word Mark	SKITTLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1986/02/20 First Use In Commerce: 1986/02/20 CLOTHING, NAMELY, SHIRTS FOR SLEEPING		


U.S. Registration No.	3278045	Application Date	04/13/2006
Registration Date	08/07/2007	Foreign Priority Date	NONE
Word Mark	SKITTLES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 2006/10/00 First Use In Commerce: 2006/10/00 bubble bath, body lotion and shampoo		

U.S. Registration No.	4175199	Application Date	11/18/2011
Registration Date	07/17/2012	Foreign Priority Date	NONE
Word Mark	SKITTLES		

Design Mark	SKITTLES
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 2004/03/00 First Use In Commerce: 2004/03/00 Lip balm

U.S. Registration No.	4377303	Application Date	02/20/2012
Registration Date	07/30/2013	Foreign Priority Date	NONE
Word Mark	SKITTLES		
Design Mark			
Description of Mark	The mark consists of the word "SKITTLES" in white letters outlined in red, an "S" lentil - shaped piece over the letter "i" in the word "SKITTLES" and an upside rainbow in red, orange, yellow, green, blue and purple behind the word "SKITTLES", with "S" lentil - shaped pieces over the rainbow in red, orange, yellow, purple and green.		
Goods/Services	Class 030. First use: First Use: 2012/12/00 First Use In Commerce: 2012/12/00 Candy		

U.S. Registration No.	4393854	Application Date	09/04/2012
Registration Date	08/27/2013	Foreign Priority Date	NONE

Word Mark	SKITTLES
Design Mark	
Description of Mark	The mark consists of the word "SKITTLES", an "S" lentil - shaped piece over the letter "i" in the word "SKITTLES" and a distinctive rainbow design behind the word "SKITTLES", with "S" lentil - shaped pieces over the rainbow.
Goods/Services	Class 030. First use: First Use: 2012/12/31 First Use In Commerce: 2012/12/31 Candy

Attachments	78978432#TMSN.png(bytes) 85476253#TMSN.png(bytes) 85547164#TMSN.png(bytes) 85719890#TMSN.png(bytes) OPPOSITION - SKITTLE.pdf(4922090 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Douglas N. Masters/
Name	Douglas N. Masters
Date	07/13/2016

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

In The Matter of Application Serial No. 86/752,170: SKITTLE
Published in the *Official Gazette* of March 15, 2016 in International Class 10

Wm. Wrigley Jr. Company,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
CMG Leisure Limited,)	
)	
Applicant.)	

NOTICE OF OPPOSITION

Wm. Wrigley Jr. Company (“Opposer”) believes it will be damaged by the registration in International Class 10 of the mark shown in Application Serial No. 86/752,170 (the “Application”) filed by CMG Leisure Limited (“Applicant”), and hereby opposes the same.


As grounds for its opposition, Opposer alleges:


1. Opposer is a leading manufacturer and seller of non-chocolate confectionery products, including candy and gum.
2. Beginning in the 1970s, Opposer introduced its SKITTLES candy in the United States in the original and now famous flavor combination of orange, lemon, lime, grape and strawberry. Starting in 1989, Opposer began offering new flavor combinations including TROPICAL SKITTLES candy and WILD BERRY SKITTLES candy. Since that time, Opposer has continued to rely on its SKITTLES brand to innovate in the confections space, creating new varieties of its SKITTLES candy, and expanding the line of SKITTLES products to include licensed products such as clothing, accessories, lotions, soaps, and lip balm.

3. For many years, Opposer's SKITTLES candy has been a top 10 seller in the non-chocolate candy category by market share across all retail channels in the United States, and last year cemented its status as number 1.

4. Opposer also maintains a tremendously robust and popular online and social media presence for its SKITTLES candy at <http://skittles.com/>, <https://www.facebook.com/skittles/>, <http://twitter.com/skittles>, and <http://www.youtube.com/skittlesbrand>. SKITTLES Facebook page alone has received nearly 24 million likes, indicative of the nationwide popularity and fame of the brand with its loyal and enthusiastic fans.

5. Opposer owns several registrations for its SKITTLES marks ("SKITTLES Marks"), including but not limited to the following, made as of record in the registration certificates attached as Exhibit A:

Trademark	Registration No.	Goods
SKITTLES	1,221,105	Candy
SKITTLES	1,415,102	Clothing, namely, shirts for sleeping
SKITTLES	4,175,199	Lip balm
SKITTLES	3,278,045	Bubble bath, body lotion, and shampoo
SKITTLES and Upside Down Rainbow Device (color) 	4,377,303	Candy

Trademark	Registration No.	Goods
SKITTLES and Upside Down Rainbow Device 	4,393,854	Candy

6. Opposer has sold many millions of dollars' worth of products in connection with its SKITTLES Marks and has spent millions of dollars advertising and promoting its SKITTLES Marks throughout the United States, including running televised advertisements during the Super Bowl broadcasts of 2015 and 2016.

7. By virtue of the popularity of Opposer's goods offered in connection with its SKITTLES Marks, and its advertising and promotion of its SKITTLES Marks, Opposer had built up prior to September 8, 2015 and now owns an extremely valuable goodwill which is symbolized by its SKITTLES Marks.

8. Also, by virtue of the popularity of Opposer's goods offered in connection with its SKITTLES Marks, and its advertising and promotion of its SKITTLES brand, SKITTLES became a famous mark prior to September 8, 2015, uniquely representing Opposer's SKITTLES confections in the minds of the U.S. consuming public.

9. On September 9, 2015, Applicant filed Application Serial No. 86/752,170 seeking registration of the mark SKITTLE (the "SKITTLE Mark") for "Electric massage appliances, namely, electric vibrating massager; Sex toys" in Class 10.

10. Applicant's registration of the SKITTLE Mark is without Opposer's consent or permission and would be damaging to Opposer. Consumers, used to associating the SKITTLES

brand only with Opposer's confections and related products, will now associate Opposer's famous brand with Applicant's sex toys impairing the distinctiveness of the mark.

11. Applicant has admitted the fame of Opposer's SKITTLES mark and the association with Opposer's candy that its product will elicit. According to Applicant's counsel, "While the mark may bring to mind Skittles Candy, as does Applicant's, it makes no connection to female sexual organs, particularly as used in its plural form. Here, by invoking the name of the famous sweet the mark connotes the sort of luxurious self-indulgence that one might associate with consuming a piece of candy, or in using Registrant's soothing lotions or bubble bath. The mark additionally suggests that Registrant's products have a sweet, fruit-like aroma or flavor. Reminiscent of Skittles candy." *See* Applicant's Response to Office Action, filed with the United States Patent and Trademark Office on January 27, 2016 ("Applicant's Response").

12. Applicant intends to profit from this unlawful association. As its Counsel has acknowledged: "Applicant's 'SKITTLE' immediately that brings to mind the well-known confection. As applied to applicant's products, the mark connotes a titillating sweetness and innocence, presented as a sensually subversive contrast to what consumers might consider a 'taboo' product. The cutesy name, with its association to something as benign as candy, additionally suggests that Applicant's products are harmless and normal, and consumers should not be ashamed to purchase them." *See* Applicant's Response.

13. Applicant's use of SKITTLE for the applied for goods likely will result in consumer confusion as to source, affiliation, connection or association with Opposer and its SKITTLES Marks. As such, Applicant is not entitled to registration of the SKITTLE Mark pursuant to 15 U.S.C. § 1052.

14. Applicant's use of the SKITTLE Mark for sex toys is also likely to cause dilution of the SKITTLES Marks – which are used on confections enjoyed by minors and bought by parents for minors – by tarnishing the reputation of the SKITTLES Marks. As such, Applicant is not entitled to registration of the SKITTLE Mark pursuant to 15 U.S.C. § 1052.

15. Applicant's use and proposed registration of SKITTLE is without Opposer's consent or permission.

16. If Applicant were granted a registration of SKITTLE for Applicant's Goods, Applicant would obtain certain statutory rights, including *prima facie* rights to the exclusive use of the SKITTLE Mark for Applicant's goods, and such registration would be the source of irreparable damage and injury to Opposer.

WHEREFORE, Opposer respectfully prays that this opposition be sustained and that Application Serial No. 86/752,140 be denied registration.

Please debit our Deposit Account No. 502876 for the filing fee and any additional necessary fees.

Please address all correspondence to Douglas N. Masters, Loeb & Loeb, LLP, 321 North Clark Street, Suite 2300, Chicago, IL 60654.

-----SIGNATURE PAGE FOLLOWS -----

Date: July 13, 2016

LOEB & LOEB LLP

By: /s/ Douglas N. Masters
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Attorneys for Opposer

Exhibit A

Int. Cl.: 30

Prior U.S. Cl.: 46

United States Patent and Trademark Office

Reg. No. 1,221,105

Registered Dec. 21, 1982

TRADEMARK
Principal Register

SKITTLES

Mars, Incorporated (Delaware corporation)
1651 Old Meadow Rd.
McLean, Va. 22102

For: CANDY, in CLASS 30 (U.S. Cl. 46).
First use Mar. 10, 1971; in commerce Mar. 10,
1971.

Ser. No. 305,850, filed Apr. 14, 1981.

RICHARD A. STRASER, Examining Attorney

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Reg. No. 1,415,102

Registered Oct. 28, 1986

**TRADEMARK
PRINCIPAL REGISTER**

SKITTLES

MARS, INCORPORATED (DELAWARE COR-
PORATION)
6885 ELM STREET
MCLEAN, VA 22101

FIRST USE 2-20-1986; IN COMMERCE
2-20-1986.

SER. NO. 592,855, FILED 4-11-1986.

FOR: CLOTHING, NAMELY, SHIRTS FOR
SLEEPING, IN CLASS 25 (U.S. CL. 39).

LUCY A. MARINO, EXAMINING ATTORNEY

Int. Cl.: 3

Prior U.S. Cls.: 1, 4, 6, 50, 51, and 52

Reg. No. 3,278,045

United States Patent and Trademark Office

Registered Aug. 7, 2007

**TRADEMARK
PRINCIPAL REGISTER**

SKITTLES

MARS, INCORPORATED (DELAWARE CORPORATION)
6885 ELM STREET
MCLEAN, VA 221013883

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: BUBBLE BATH, BODY LOTION AND SHAMPOO, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

SN 78-978,432, FILED 4-13-2006.

FIRST USE 10-0-2006; IN COMMERCE 10-0-2006.

JENNIFER KRISP, EXAMINING ATTORNEY

United States of America
United States Patent and Trademark Office

SKITTLES

Reg. No. 4,175,199

Registered July 17, 2012

Int. Cl.: 3

TRADEMARK

PRINCIPAL REGISTER

WM. WRIGLEY JR. COMPANY (DELAWARE CORPORATION)
410 NORTH MICHIGAN AVENUE
CHICAGO, IL 60611

FOR: LIP BALM, IN CLASS 3 (U.S. CLS. 1, 4, 6, 50, 51 AND 52).

FIRST USE 3-0-2004; IN COMMERCE 3-0-2004.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 85-476,253, FILED 11-18-2011.

KATHLEEN LORENZO, EXAMINING ATTORNEY



David J. Kyros

Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 4,377,303

Registered July 30, 2013

Int. Cl.: 30

TRADEMARK

PRINCIPAL REGISTER

WM. WRIGLEY JR. COMPANY (DELAWARE CORPORATION)
1132 WEST BLACKHAWK STREET
CHICAGO, IL 60642

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).

FIRST USE 12-0-2012; IN COMMERCE 12-0-2012.

THE MARK CONSISTS OF THE WORD "SKITTLES" IN WHITE LETTERS OUTLINED IN RED, AN "S" LENTIL - SHAPED PIECE OVER THE LETTER "I" IN THE WORD "SKITTLES" AND AN UPSIDE RAINBOW IN RED, ORANGE, YELLOW, GREEN, BLUE AND PURPLE BEHIND THE WORD "SKITTLES", WITH "S" LENTIL - SHAPED PIECES OVER THE RAINBOW IN RED, ORANGE, YELLOW, PURPLE AND GREEN.

THE COLOR(S) WHITE, RED, ORANGE, YELLOW, GREEN, BLUE AND PURPLE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SN 85-547,164, FILED 2-20-2012.

MARK RADEMACHER, EXAMINING ATTORNEY



Lea Street Lee

Acting Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 4,393,854

Registered Aug. 27, 2013

Int. Cl.: 30

TRADEMARK

PRINCIPAL REGISTER

WM. WRIGLEY JR. COMPANY (DELAWARE CORPORATION)
1132 WEST BLACKHAWK STREET
CHICAGO, IL 60642

FOR: CANDY, IN CLASS 30 (U.S. CL. 46).

FIRST USE 12-31-2012; IN COMMERCE 12-31-2012.

OWNER OF U.S. REG. NOS. 1,221,105, 3,101,167, AND OTHERS.

THE MARK CONSISTS OF THE WORD "SKITTLES", AN "S" LENTIL - SHAPED PIECE OVER THE LETTER "I" IN THE WORD "SKITTLES" AND A DISTINCTIVE RAINBOW DESIGN BEHIND THE WORD "SKITTLES", WITH "S" LENTIL - SHAPED PIECES OVER THE RAINBOW.

SN 85-719,890, FILED 9-4-2012.

BARNEY CHARLON, EXAMINING ATTORNEY



Lisa Street Lee

Acting Director of the United States Patent and Trademark Office

CERTIFICATE OF SERVICE

I, Elisabeth K. O'Neill hereby certify that a copy of the NOTICE OF OPPOSITION has been served upon:

Luke Brean, Esq.
Breanlaw Llc
PO Box 4120
Portland, Oregon, 97208

via first class mail on this 13th day of July, 2016.

/s/ Elisabeth K. O'Neill