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

In the Matter of Application S.N. 75/192,631 in Class 41  
Published September 29, 1998

In the Matter of Application S.N. 75/192,629 in Class 35  
Published July 27, 1999

VIACOM INTERNATIONAL INC.,

Opposer,

-against-

MINATAUR PROMOTIONS  
ENTERPRISES, INC.,

Applicant.

Opposition No. 112,850  
(Consolidated with Opp. No. 112,851)

02-10-2003  
U.S. Patent & TMOc/TM Mail Rcpt Dt. #77

**OPPOSITION TO MOTION TO AMEND APPLICATION**

Opposer, Viacom International Inc. ("Opposer"), requests that the motion of Minataur Productions, Inc. ("Minataur Productions") to amend the application of Minataur Promotions Enterprises, Inc. ("Applicant"), Serial No. 192,631 (the "Application"), which is the subject of Opposition No. 112,851, be denied.

First, Minataur Productions is neither a party to this proceeding, nor is it the owner of the Application sought to be amended. Certainly, it has not recorded any assignment of the subject Application with the Patent and Trademark Office pursuant to the Trademark Rules of Practice. See 37 C.F.R. §§ 3.71 and 3.73(b). Thus, the motion is facially defective.

Moreover, the Trademark Rules of Practice state:

"An application involved in a proceeding may not be amended in substance nor may a registration be amended or disclaimed in part, except with the consent of

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the other party or parties and the approval of the Trademark Trial and Appeal Board, or except upon motion.”

37 C.F.R. § 2.133(a).

By its motion to amend, Minataur Productions seeks to delete “production and distribution of motion pictures” from the description of Applicant’s services in the Application. Opposer has not consented and hereby expressly objects to the requested amendment. Given that this proceeding has been pending for four years, and the discovery period closes in three weeks, the motion is untimely. Minataur Productions provides no explanation why the motion to amend was not filed years ago. One can only speculate that it is being done now to prevent Opposer from pursuing relief on the grounds of fraud. Specifically, the evidence in this proceeding shows that Applicant represented to the Patent and Trademark Office that it had been using its mark since 1988 in connection with production and distribution of motion pictures, the services it now seeks to delete. In fact, Applicant *never* offered such services under its mark. It is proposed that Minataur Productions has filed the motion to amend the Application because it recognizes that this misrepresentation alone could be a basis for sustaining the opposition.<sup>1</sup> See Coldwater Seafood Corp. v. Magnusson, 188 U.S.P.Q. 522, 524 (T.T.A.B. 1975) (ordering cancellation of registration based, in part, on false statements of use in renewal application).

Notwithstanding this attempt, and regardless of whether the Board grants Minataur Productions’ motion, the proposed amendment does not resolve the issues in this proceeding. Even if the motion was granted, the Application would cover “television scheduling (programming),” the core services of Opposer under its trademarks. Indeed, the proposed

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<sup>1</sup> Opposer is considering whether the discovery of these facts at this stage of the proceeding warrants filing a motion seeking leave to amend its Notice of Opposition to allege a claim for fraud and that the Application should be invalid for being void ab initio.

amendment will not alleviate the strong likelihood of consumer confusion between Applicant's and Opposer's respective marks.

We note also that the proposed amendment renders the Application wholly duplicative of Applicant's Registration No. 2,317,477. Thus, as a practical matter, it makes no sense that Applicant should need a second registration for the same mark for the same services.

For these reasons, Opposer asks that the Board deny Minataur Productions' motion to amend.

Dated: New York, NY  
February 10, 2003

"Express Mail" mailing label No. EL 718086814 US

Date of Deposit February 10, 2003

I hereby certify that this paper or fee is being deposited with the United States Postal Service as "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Valerie Mason  
Printed name of person mailing paper or fee)

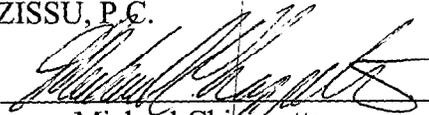


(Signature)

Respectfully submitted,

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By:

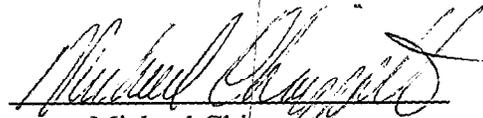


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**CERTIFICATE OF SERVICE**

The undersigned, counsel for Viacom International Inc., hereby certifies under penalty of perjury that I caused a true and correct copy of the attached OPPOSER'S FIRST SET OF INTERROGATORIES AND FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS TO APPLICANT to be sent by first class mail on February 10, 2003 to Dorie G. Choderker, Russ, August & Kabat, 12424 Wilshire Boulevard, Suite 1200, Los Angeles, California 90025.

  
Michael Chiappetta

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