

ESTTA Tracking number: **ESTTA135416**

Filing date: **04/13/2007**

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	Miramax Film Corp.
Granted to Date of previous extension	04/15/2007
Address	161 Avenue of the Americas15th Floor New York, NY 10013 UNITED STATES

Attorney information	Rosanne T. Yang Baker & Hostetler LLP 65 E. State St., Ste. 2100 Columbus, OH 43215 UNITED STATES columbusip@bakerlaw.com Phone:614.462.2684
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### Applicant Information

Application No	78546284	Publication date	10/17/2006
Opposition Filing Date	04/13/2007	Opposition Period Ends	04/15/2007
Applicant	Roll, Dean P.O. Box 493 Middletown, OH 45042 UNITED STATES		

### Goods/Services Affected by Opposition

Class 009. First Use: 2003/09/01 First Use In Commerce: 2003/09/01 All goods and services in the class are opposed, namely: Video tapes and DVD's featuring video productions, namely, games and prerecorded performances
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Related Proceedings	Cancellation Action No. 92044617
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Attachments	NoticeOppositionCL9.pdf ( 3 pages )(140547 bytes )
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Signature	/ttabrty/
Name	Rosanne T. Yang
Date	04/13/2007

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

In The Matter Of Application Serial No. 78/546284  
Published In The *Official Gazette*, October 17, 2006

Miramax Film Corp.,	)	MARK: SHARK BOY
	)	
Opposer,	)	CLASS: 09
	)	
vs.	)	GOODS: Video tapes and DVD's featuring video
	)	productions, namely, games and
Dean Roll,	)	prerecorded performances
	)	
Applicant.	)	FILED: January 12, 2005
	)	
	)	<b>NOTICE OF OPPOSITION</b>
	)	

Opposer, Miramax Firm Corp., a corporation organized under the laws of the State of New York having its principal place of business at 161 Avenue of the Americas, New York, N Y 10013, believes that it will be damaged by the registration of the mark covered by Application Serial No. 78/546284, and hereby opposes the registration of said mark. As grounds for the opposition it is alleged as follows:

1. Opposer is the distributor of a movie bearing the title THE ADVENTURES OF SHARKBOY AND LAVAGIRL IN 3-D (the "Movie"), and has manufactured merchandise for sale featuring, among other things, the movie title and SHARKBOY character.

2. Following the theatrical release of the Movie, the Movie was released to DVD and/or VHS and remains in distribution to the public in DVD and/or VHS format. The theatrical release of the Movie was June 10, 2005. The Movie was released to DVD and/or VHS on September 20, 2005.

3. Applicant seeks to register SHARK BOY as a trademark for "video tapes and DVD's featuring video productions, namely, games and prerecorded performances." The filing date of Applicant's use-based application is January 12, 2005, and he claims a first use date, both

anywhere and in interstate commerce, of September 1, 2003 in connection with all of the goods identified in the subject application.

4. Applicant commenced trademark infringement litigation in June 2005 against Opposer for its use of the term SHARKBOY in the above-referenced movie, alleging infringement under 15 U.S.C. § 1114 of his Registration No. 2,357,366 for the mark SHARK BOY in Class 41 and under 15 U.S.C. § 1125 of his common law rights in the mark SHARK BOY for merchandise relating to his services, including but not limited to pre-recorded DVDs and video tapes. Opposer continues to vigorously defend this litigation on the grounds, inter alia, that Applicant's mark has not been used as a trademark in connection with DVDs and video tapes and that he has therefore acquired no such trademark rights.

5. Upon information and belief, Applicant had no bona fide use of his alleged SHARK BOY mark as a trademark in commerce in connection with DVDs and video tapes featuring games as of the date the Applicant submitted the subject use-based application under 15 U.S.C. § 1051(a): January 12, 2005.

6. Upon information and belief, Applicant had no bona fide use of his alleged SHARK BOY mark as a trademark in commerce in connection with DVDs and video tapes featuring prerecorded performances as of the date Applicant submitted the subject use-based application under 15 U.S.C. § 1051(a): January 12, 2005.

7. Upon information and belief, Applicant knew at the time of filing Application Serial No. 78/546284 that he had not used the claimed SHARK BOY mark in connection with some or all of the goods identified in said application and intentionally misrepresented to the United States Patent and Trademark Office that such use had occurred prior to the filing of the application under 15 U.S.C. § 1051(a).

8. Upon information and belief, Application Serial No. 78/546284 is void *ab initio* and/or due to fraud in the application process.

9. By virtue of the foregoing, if Applicant obtains such rights as conferred under the Principal Register of the Trademark Act of 1946, Opposer will be subjected to damage within the meaning of Section 13 of the Lanham Act, 15 U.S.C. § 1063, in that it will need to defend litigation for an infringement claim based on a registration for a mark that issued without the requisite use of the mark in commerce for the goods identified in the application, including having to overcome a presumption of Applicant's rights which presumption was obtained by Applicant without the requisite use of his mark in commerce for the goods identified in his application.

10. The fee required in § 2.6(a)(16) is submitted herewith.

WHEREFORE, Opposer Miramax Film Corp. prays that its opposition be sustained and that registration of Application Serial No. 78/546284 be denied.

Date: April 13, 2007

  
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