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

Proceeding	91205896
Party	Defendant Wild Brain Entertainment, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Application Serial No. 85/509929
For the Trademark/Service Mark DIZZY
Application Filed on January 5, 2012/Published on June 5, 2012

BEAU L. TARDY,	)	
	)	
Opposer	)	
	)	
v.	)	
	)	Opposition No. 91205896
WILD BRAIN ENTERTAINMENT, INC.,	)	
	)	
Applicant	)	
	)	

APPLICANT'S BRIEF IN OPPOSITION TO

OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION

In response to Opposer's Motion To Amend Notice Of Opposition (the "Motion") filed by Beau L. Tardy ("Opposer"), Wild Brain Entertainment, Inc. ("Applicant") files this Brief in Opposition.

BACKGROUND

Opposer filed his Notice of Opposition on July 3, 2012; Applicant filed its Answer on August 6, 2012; and Opposer filed Opposer's Motion To Amend Notice Of Opposition on October 4, 2012. Opposer may amend his Notice of Opposition only with Applicant's written consent or the TTAB's leave. TMBP Section 507.01(2). Applicant does not consent and urges the TTAB not to grant leave, in whole or in part, for the reasons set forth herein.

Opposer had 21 days (plus 5 days for mail service) to amend his Notice Of Opposition after Applicant filed its Answer pointing out that Opposer's claimed registrations were cancelled, that the entity that filed the Section 8 Affidavits in 2006 had been dissolved in 2002, that there

was no material on most of the websites cited by Opponent, that there appeared to be no current trademark use in connection with any goods or services whatsoever, and that Opposer's copyright claims were not relevant, among other things. Opposer did not file an amended Notice of Opposition within his statutory time period and instead seeks the TTAB's leave to file one now.

There has been no discovery in this case, and therefore there are no new facts that might necessitate Opposer's Amended Notice of Opposition. Yet, in his proposed Amended Notice of Opposition, Opposer seeks to base his Opposition on wholly different trademark rights, namely, claimed trademark rights in what appears to be an entertainment property and in digital media in Class 9. This differs dramatically from Opponent's original Notice of Opposition, which was based on claimed trademark rights for services described as the "production of television commercials" in Class 35, which services Opponent apparently does not provide. Further, Opposer seeks to base his Opposition on a trademark application, filed after the filing of the Notice of Opposition, for a wide variety of digital media in Class 9, which is not appropriate because Opposer's new application was filed after after he filed the Notice of Opposition. Without any new facts in this case and beyond the statutory period for filing an Amended Notice of Opposition, Opposer now seeks to assert wholly different trademark rights (to the extent they exist), to Applicant's detriment.

The other major way in which Opposer seeks to amend his Notice of Opposition is to question Applicant's intent in filing this Application. Applicant's intent was not raised as an issue in Opposer's Notice of Opposition and there have been no new facts that might form the basis for such a claim now. Further, Opposer's basis for his allegations is pure speculation, which violates the requirements for pleading a claim regarding intent, as set forth in detail below.

If Opposer is allowed to file his Amended Notice of Opposition, Applicant will have to file an Amended Answer to address Opposer's wholly new allegations. For example, Applicant will have to address the following new assertions:

1. **Standing.** Opposer claims to be a competitor of Applicant, which based on information and belief, Applicant denies, noting that Applicant is very familiar with its competitors. Opposer is not even clear as to who the Opposer is in this matter, stating in his Amended Notice of Opposition that "DIZZY is the brand name owned by Beau Tardy as an individual and as several business entities," when in the original Notice of Opposition, Opposer claimed to be the successor in interest of a number of entities which he claimed used the DIZZY trademark and assigned it to him. Finally, Opposer states that "[t]he DIZZY name is and has been a company name, merchandise, pop culture websites, cartoon character, TV show, comics, and web streaming entertainment," which even if true (and Applicant denies upon information and belief), do not appear to be trademark uses.

2. Opposer now claims that "[b]oth parties produce cartoon characters for entertainment purposes and use these characters to advertise collateral goods and entertainment services." While this is true of Applicant, it is a wholly new claim by Opposer (and denied by Applicant upon information and belief), noting that Opposer's original Notice of Opposition was based on using the DIZZY trademark for the "production of television commercials."

3. **Additional Standing.** Opposer then seeks to base his Opposition on an new application filed by Opposer **after** the filing date of his Notice of Opposition. Since that application did not exist on the date of filing the Notice of Opposition, the application is not a proper basis for the Notice of Opposition. By filing this new application, Opposer is claiming that all of the following goods bear the DIZZY trademark and **are currently being sold in**

interstate commerce: Digital materials, namely, CDs featuring television programs, cartoons, music in the field of entertainment; Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring animation; Digital media, namely, DVDs, downloadable audio and video recordings, downloadable files featuring television programs, cartoons, music in the field of entertainment; Downloadable videos and downloadable audio visual recordings featuring television programs, cartoons, music in the field of entertainment via the internet and wireless devices; Prerecorded digital video disks featuring television programs, cartoons, music in the field of entertainment; Prerecorded video cassettes featuring television programs, cartoons, music in the field of entertainment. Assuming this is true (which Applicant denies on information and belief), none of these goods were mentioned in Opposer's original Notice of Opposition, namely, using the DIZZY trademark for services described as the "production of television commercials." Finally, in his application, Opposer states that "[t]he mark was first used anywhere in a different form other than that sought to be registered at least as early as 12/31/1996, and in commerce at least as early as 12/31/1996," which makes no sense with respect to a word mark with a standard character claim.

4. **Opposer's Priority.** Opposer then claims common law rights in **additional but unidentified goods** outside of Class 9 and in services provided since at least 1996 for "[p]roduction of television commercials, television programs, cartoons, animation, games, screensavers and other forms of entertainment." Applicant denies these statements upon information and belief, objects to the inclusion of unidentified goods, and objects to the inclusion of additional production services (which these additional alleged services appear to be) or of other services outside of the "production of television commercials" that served as the basis for

Opposer's original Notice of Opposition. In addition, Opposer does not appear to appreciate that trademarks can be abandoned through non-use, which based on information and belief Applicant asserts has occurred here.

5. **Opposer's Ownership.** Opposer asserts that "any Opposer's predecessor-in-interest **abandoned** any rights it had in the DIZZY Marks and DIZZY trade names." By this statement, Opposer has admitted that all of his predecessors-in-interest have abandoned all rights in the DIZZY trademark, which means that Opposer can have no possible trademark rights in DIZZY deriving from any predecessor-in-interest. Then Opposer asserts the inconsistent position that Opposer is the sole owner of rights in DIZZY "with privity of interest" (Applicant is unsure what this means) "dating back to 1996," when in fact, if the predecessors-in-interest abandoned the DIZZY trademark, it is not possible for Opposer to now claim ownership of their rights.

6. Opposer then claims common law rights since 1996, but Opposer has admitted that those rights were abandoned by his predecessors-in-interest, and seeks to base his Opposition on an application filed after the filing date of the original Notice of Opposition and common law uses (presumably by Opposer's predecessors-in-interest) that are different from the services of "production of television commercials."

7-9. These paragraphs assert that Opposer's DIZZY is an inherently distinctive mark and therefore protectable, that DIZZY operates as a source identifier for Opposer's services (but oddly, not Opposer's goods), and that DIZZY should be given a broad scope of protection, all of which Applicant denies upon information and belief.

10. Opposer then asserts that Applicant filed the Application.

11-19. In these paragraphs, Opposer questions Applicant's bona fide intent to use the DIZZY trademark upon filing the Application and other DIZZY applications, which Applicant

categorically denies. Opposer's claim is based on pure speculation, such as Applicant's failing to file Statements of Use for different trademarks (TEAM SMITHEREEN and OKI'S OASIS) and replacing an expired application for a different trademark (TEAM SMITHEREEN). Opposer also specifically questions Applicant's intent to use the DIZZY trademark on handheld units (with no substantiating facts), states that Applicant has not offered any goods listed in the Application for sale to the public (which even if true is irrelevant), and states that Applicant has no documents to show actual or planned promotional expenditures, no documents concerning trade shows and the like, and no projected date of first use, all based on pure speculation. As set forth under "Legal Argument Re Intent" below, it is necessary that any claim involving intent be plead with specificity, and not based on pure speculation. Applicant therefore objects strenuously to and specifically requests that the TTAB refuse its consent to all of Opposer's claims involving Applicant's intent in Opposer's Motion To Amend Notice Of Opposition.

20.-30. **Likelihood of Confusion/Inevitable Confusion.** Opposer then asserts that there is a likelihood of confusion and inevitable confusion between Applicant's mark and Opposer's mark, which Applicant denies.

LEGAL ARGUMENT RE INTENT

By claiming that Applicant did not have the requisite intent in filing this Application, Opposer is claiming that Applicant has perpetrated a fraud on the U.S. Patent and Trademark Office ("USPTO"). Opposer has failed to allege the requisite intent and has failed to state with particularity the circumstances constituting fraud as required by Fed. R. Civ. P. 9(b). Therefore, the TTAB cannot consent to Opposer's Motion To Amend Notice Of Opposition to the extent it contains allegations regarding Applicant's intent.

Opposer must allege the elements of fraud with particularity in accordance with Fed. R. Civ. P. 9(b), made applicable to TTAB proceedings by Trademark Rule 2.116(a). *Asian and*

Western Classics B. V. v. *Selkow, 92* USPQ2d 1478 (TTAB 2009). Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with its application with an intent to deceive. *In re Bose Corp.,* 580 F.3d 1240, 91 USPQ2d 1938, 1941 (Fed. Cir. 2009).

A party opposing a trademark registration for fraud bears a heavy burden of proof. *W.D. Byron & Sons, Inc.* v. *Stein Bros. Mfg. Co.,* 377 F.2d 1001, 153 USPQ 749, 750 (CCPA 1967). Indeed, "the very nature of the charge of fraud requires that it be proven 'to the hilt' with clear and convincing evidence. There is no room for speculation. inference or surmise and, obviously, any doubt must be resolved against the charging party. *Smith Int'l, Inc.* v. *Olin Corp.,* 209 USPQ 1033, 1044 (TTAB 1981).

Opposer fails to sufficiently plead fraud because Opposer failed to allege the requisite intent to mislead the USPTO. A pleading of fraud on the USPTO must include an appropriate allegation of intent. *In re Bose Corp.,* 91 USPQ2d at 1939-1940. In his Amended Notice of Opposition, Opposer fails to sufficiently plead the requisite intent. All of Opposer's allegations in Paragraphs 11-19 are based on Opposer's "information and belief" except for Paragraph 12, in which Opposer asserts that Applicant has "shown a propensity" for applying for trademarks for which it did not file Statements of Use (TEAM SMITHEREEN and OKI'S OASIS), which even if true (and which Applicant categorically denies) would not be a basis for finding that Applicant has committed fraud with respect to the Application at issue in this Proceeding.

Opposer does not state with particularity the circumstances constituting fraud required by Fed. R. Civ. P. 9(b). Pleadings of fraud made "on information and belief," when there is no allegation of "specific facts upon which the belief is reasonably based" are

insufficient. *Asian and Western Classics B. V.* v. *Selkow, 92* USPQ2d 1478 (TTAB 2009)(citations omitted); *see also In Re Bose Corp.,* 91 USPQ2d at 1938. Allegations based solely on information and belief do not constitute pleading of fraud with particularity. *Asian and Western Classics B. V., 92* USPQ2d 1478, *3. Thus, to satisfy Rule 9(b), any allegations based on "information and belief" must be accompanied by a statement of facts upon which the belief is founded. *See id., citing Exergen Corp.,* 91 USPQ2d at 1670 n.7.

In this case, Opposer's allegations in Paragraphs 11-19 of his Amended Notice of Opposition are based solely upon information and belief, except for Paragraph 12, which is irrelevant. These allegations fail to meet the Fed. R. Civ. P. 9(b) requirements as they are unsupported by any statement of facts providing the information upon which Opposer relies or the belief upon which the allegation is founded. *Asian and Western Classics B.V.,92* USPQ2d 1478, *3. Because Opposer has not plead his fraud claim with particularity as required by Fed. R. Civ. P. 9(b), the TTAB must refuse to allow Opposer to file an amended Notice of Opposition with a fraud claim against Applicant.

WHEREFORE, Applicant prays that Opposer's Motion To Amend Notice Of Opposition be refused, in whole and in part, and that the Certificate of Registration for Applicant's Mark be issued.

Respectfully submitted,

Date: October 24, 2012

WILD BRAIN ENTERTAINMENT, INC.

By: _____

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	)	
Applicant	)	
	)	

CERTIFICATE OF SERVICE

STATE OF CALIFORNIA	)	
	)	ss:
COUNTY OF LOS ANGELES	)	

I, Adam Stocks, am employed in the county aforesaid; I am over the age of 18 years and not a party to the within action; my business address is 6060 Center Drive, Tenth Floor, Los Angeles, California 90045.

On October 24, 2012, I caused the foregoing document described as: **APPLICANT'S BRIEF IN OPPOSITION TO OPPOSER'S MOTION TO AMEND NOTICE OF OPPOSITION** to be served on the parties in this action at the following address via First Class U.S. Mail, postage prepaid:

Wendy Peterson, Attorney for Opposer, Beau L Tardy
PO Box 18716
Minneapolis, MN 55418

I am readily familiar with the firm's practice of collection and processing correspondence for mailing. Under that practice, it would be deposited with U.S. Postal Service on that same day, with postage thereon fully prepaid at Los Angeles, California in the ordinary course of business.

I declare that I am employed in the office of a member of the bar at whose direction the service was made.

Executed on **October 24, 2012**, at Los Angeles, California.

Adam Stocks