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

Proceeding	91205896
Party	Plaintiff Beau L. Tardy
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Date	02/01/2013
Attachments	Motion for Second Amended Notice of Opposition with Exhibit.pdf (14 pages) (127848 bytes)

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

Opposition Proceeding 91205896

In the matter of Trademark Application No. 85509929

For the mark: DIZZY

Published for Opposition Date: June 5, 2012

Beau Tardy, Opposer

v.

Wild Brain Entertainment, Inc., Applicant

OPPOSER'S MOTION FOR SECOND AMENDED NOTICE OF OPPOSITION

Opposer asks leave to amend the 4th paragraph in the Amended Notice of Opposition. A Second Amended Notice of Opposition follows with changes to the 4th paragraph in order to specify the common law rights being claimed and contains an updated TSDR in the exhibit.

Submitted By: /Wendy Peterson/

Date: February 1, 2013

Wendy Peterson, Attorney for Opposer, Beau Tardy

CERTIFICATE OF SERVICE

I hereby certify that on February 1, 2013, the foregoing was served upon Applicant's attorney by first class mail (and by email as a courtesy) to:

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UNITED STATES

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By: /Wendy Peterson/

Date: February 1, 2013

Wendy Peterson, Attorney for Opposer, Beau Tardy

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AMENDED NOTICE OF OPPOSITION

The above-identified Opposer believes that it will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same. On July 3, 2012, Opposer timely filed a Notice of Opposition against the above-identified application.

Opposer through its counsel now amends its Notice of Opposition. This Amended Notice of Opposition is intended to supercede and completely replace the prior pleading.

Based upon information and belief, Opposer avers it will be damaged by the registration of the opposed mark and asks the Board to sustain the opposition in favor of the prior user, the Opposer. Opposer submits that actions by Applicant thwart the intent to use provisions set forth by Congress by reserving rights in the mark and using the system to traffic in marks.

The public also has a right not to be confused by the identical trademarks for DIZZY and Opposer asks the Board to sustain the opposition also for the public's benefit.

1. **Standing.** Opposer is a competitor of Applicant. DIZZY is the brand name owned by Beau Tardy as an individual and as several business entities continuously, substantially exclusively, openly and obviously throughout the years 1996 to present (2012). The DIZZY name is and has been a company name, merchandise, pop culture websites, cartoon character, TV show, comics, and web streaming entertainment. Dizzy went from being the name of a business that provided production services, to a brand on its own.
2. Both parties produce cartoon characters for entertainment purposes and use these characters to advertise collateral goods and entertainment services. The web site for Wild Brain Entertainment www.wildbrain.com self-identifies that it: "Provides animation for commercials, TV series, feature films and other media." Opposer has therefore established its standing because of its interest as a competitor. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298 (TTAB 2000); and *Hartwell Co. v. Shane*, 17 USPQ2d 1569 (TTAB 1990).
3. **Additional Standing.** Opposer has a pending trademark application SN 85741800 (see Exhibit A) for DIZZY for IC 009: *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 that is reasonably expected to be refused because of a likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. §1052(d) because of a likelihood of confusion with the subject pending application. Opposer has standing under *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953 (TTAB 2008).

4. **Opposer's Priority.** Opposer claims common law rights in the goods produced under the DIZZY trademark, 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 The mark was first used anywhere in a different form other than that sought to be registered at least as early as 12/31/1996. Opposer also claims common law rights from actual use in commerce since at least 1996 in the service mark DIZZY for

Production of television commercials, television programs, cartoons, animation, games, screensavers and other forms of entertainment.

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 and that Opposer is the sole owner of the rights with privity of interest dating back to 1996.
6. Because Opposer has not pleaded any registrations, Opposer claims common law rights since 1996 prior to applicant's priority date, Jan. 5, 2012, the filing date of the intent-to-use application. *Hydro-Dynamics Inc. v. George Putnum and Company Inc.*, 811 F.2d 1470, 1 USPQ2d 1772, 1773 (Fed. Cir. 1987).
7. **Opposer's Mark is Protectable.** Opposer's mark DIZZY is an inherently distinctive mark.
8. Opposer's mark DIZZY operates as a source identifier for Opposer's services.
9. Opposer's trademark should be given a broad scope of protection based on the inherent distinctiveness and priority of use.
10. **Applicant.** Applicant Wild Brain Entertainment Inc. submitted an intent to use application and is attempting to register the word mark DIZZY for IC 9 for *Electrical and scientific apparatus, namely, electronic game software; computer game software; downloadable computer games; computer and video-game cassettes, cartridges, discs and programs; downloadable game software; motion picture films featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; pre-recorded video and audio cassettes, video and audio tapes, video and audio discs, CD ROMs, compact discs, digital versatile discs, musical video recordings, musical sound recordings and phonograph*

records featuring music, animated cartoons, live-action performances and live action performances by costumed characters all in the field of children's education; software and manuals sold as a unit in the field of children's education, namely, for use in creating, updating and maintaining calendars, for information management and for use as computer screen savers; decorative refrigerator magnets; hand held units for playing electronic games for use with external display screen or monitor.

11. **Lack of Bona Fide Intent-to-Use Grounds.** Upon information and belief Applicant did not have a bona fide intention to use the mark in commerce on all the specified goods when it filed this and its other applications covering DIZZY for the many goods specified therein under Trademark Act § 1(b), 15 U.S.C. § 1052(b). *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1506 (TTAB 1993).
12. Applicant has shown a propensity for applying for trademarks for goods and goods categories for which it did not file Statements of Use (TEAM SMITHEREEN SN 77581487, OKI'S OASIS SN 77015865) indicating applications may be made merely to reserve a right in a mark. *Paramount Pictures Corp. v. White*, 31 USPQ 1768 (TTAB 1996) (“use in commerce” involves the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark).
13. Upon information and belief Applicant has shown a propensity for the filing of intent-to-use applications (TEAM SMITHEREEN) to replace applications which have lapsed (TEAM SMITHEREEN) because no timely statement of use was filed and provides additional evidence bearing on applicant's lack of a bona fide intent to use the mark. *Research in Motion Limited v. Nbor Corp.* (TTAB 2009).

14. Upon information and belief Applicant has claimed an intent to use as 'hand held units for playing electronic games for use with external display screen or monitor' without bona fide intent to develop and market these products.
15. Upon information and belief Applicant has not offered any of the goods listed in the application for sale to the public under the involved mark, DIZZY.
16. Upon information and belief Applicant has no documents sufficient to show actual or planned promotional expenditures under the mark for DIZZY for the goods listed.
17. Upon information and belief Applicant has no documents concerning trade shows, conventions, seminars and other events open to the public at which the listed goods sold or were offered for sale under the DIZZY mark were or are planned to be displayed.
18. Upon information and belief there is no projected date of first use in commerce for all of the goods listed under the mark DIZZY.
19. Upon information and belief there is no projected date of first use in commerce for any of the goods listed under the mark DIZZY.
20. **Likelihood of Confusion Grounds.** Applicant's word mark DIZZY and Opposer's word mark DIZZY are identical.
21. The fact that the cartoon characters do not look like each other is immaterial here because Applicant seeks to register the mark DIZZY alone. See, e.g. *Sealy, Inc. v. Simmons Co.*, 265 F.2d 934, 121 USPQ 456, 459 (CCPA 1959); *Hat Corp. of America v. John B. Stetson Co.*, 223 F.2d 485, 106 USPQ 200, 203 (CCPA 1955); and *ITT Canteen Corp. v. Haven Homes Inc.*, 174 USPQ 539, 540 (1972).

Beau Tardy's DIZZY THE CAT

Wild Brain's DIZZY



22. **Inevitable confusion will result from Applicant's use of DIZZY as a mark.** Identical marks for identical goods and services cause inevitable confusion.
23. The Applicant's mark DIZZY is legally identical in appearance to Opposer's DIZZY.
24. The Applicant's mark DIZZY is legally identical in sound to Opposer's DIZZY.
25. The parties' goods are identical or highly similar goods and have an identical connotation.
26. Neither parties' description of the goods have restrictions as to the intended channels of trade.
27. The parties' services are identical and intended and assumed to be in the same channels of trade and intended and assumed to be for the same class of purchasers.
28. The marks are likely to be confused under 15 U.S.C. §1052(d).
29. Identical trademarks for identical goods or services lead to inevitable confusion.
30. The public interest is the dominant interest and served by removing marks that cause inevitable confusion from the register. See, e.g., *Swank, Inc. v. Ravel Perfume Corp.*, 438 F.2d 622, 58 CCPA 948 (1971); *Chum King Corp. v. Genii Plant Line, Inc.*, 403 F.2d 274, 56 CCPA 740 (1968); *Cohen & Sons Co., Inc. v. Hearst Magazines, Inc.*, 220 F.2d 763, 42 CCPA 836 (1955); see also *In re Avedis Zildjian Co.*, 394 F.2d 860, 55 CCPA 1126 (1968); *In re Continental Baking Co.*, 390 F.2d 747, 55 CCPA 967 (1968).

Inasmuch as the issuance of a federal registration for Applicant will harm Opposer's prior rights and the public interest, Opposer respectfully requests that this registration be denied and that the Opposition is sustained in favor of Opposer. .

Submitted By: /Wendy Peterson/

Date: February 1, 2013

Wendy Peterson, Attorney for Opposer, Beau Tardy

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CERTIFICATE OF SERVICE

I hereby certify that on February 1, 2013, the foregoing was served upon Applicant's attorney by first class mail (and by email as a courtesy) to:

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UNITED STATES

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By: /Wendy Peterson/

Date: February 1, 2013

Wendy Peterson, Attorney for Opposer, Beau Tardy

EXHIBIT A

Generated on: This page was generated by TSDR on 2013-01-31 11:54:45 EST

Mark: DIZZY

DIZZY

US Serial Number: 85741800

Application Filing Date: Sep. 28, 2012

Filed as TEAS Plus: Yes

Currently TEAS Plus: Yes

Register: Principal

Mark Type: Trademark

Status: A non-final Office action has been sent (issued) to the applicant. This is a letter from the examining attorney requiring additional information and/or making an initial refusal. The applicant must respond to this Office action. To view all documents in this file, click on the Trademark Document Retrieval link at the top of this page.

Status Date: Jan. 28, 2013

Mark Information

Mark Literal Elements: DIZZY

Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type: 4 - STANDARD CHARACTER MARK

Goods and Services

Note:

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For: 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

International Class: 009 - Primary Class

U.S Class: 021, 023, 026, 036, 038

Class Status: ACTIVE

Basis: 1(a)

First Use: Dec. 31, 1996

Use in Commerce: Dec. 31, 1996

Used Anywhere in Another The mark was first used anywhere in a different

Used in Commerce in The mark was first used in commerce in a different

Form: form other than that sought to be registered at least as early as 12/31/1996

Another Form: form other than that sought to be registered at least as early as 12/31/1996

Basis Information (Case Level)

Filed Use: Yes

Currently Use: Yes

Amended Use: No

Filed ITU: No

Currently ITU: No

Amended ITU: No

Filed 44D: No

Currently 44D: No

Amended 44D: No

Filed 44E: No

Currently 44E: No

Amended 44E: No

Filed 66A: No

Currently 66A: No

Filed No Basis: No

Currently No Basis: No

Current Owner(s) Information

Owner Name: Tardy, Beau

DBA, AKA, Formerly: FORMERLY Dizzy Productions, Dizzy Worldwide Corp., Dizzy TV, Aquarium Creative Agency

Owner Address: 1659 Hill Top Lane
Kingwood, TEXAS 77339
UNITED STATES

Legal Entity Type: INDIVIDUAL

Citizenship: UNITED STATES

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Wendy Peterson

Correspondent

Correspondent WENDY PETERSON

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Correspondent e-mail: wsp@NJPLS.com

Correspondent e-mail Yes
Authorized:

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Jan. 28, 2013	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Jan. 28, 2013	NON-FINAL ACTION E-MAILED	6325
Jan. 28, 2013	NON-FINAL ACTION WRITTEN	83189
Jan. 28, 2013	ASSIGNED TO EXAMINER	83189
Oct. 04, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Oct. 02, 2012	NEW APPLICATION ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: FLOWERS, JAY K

Law Office Assigned: LAW OFFICE 112

File Location

Current Location: TMO LAW OFFICE 112 - EXAMINING ATTORNEY
ASSIGNED

Date in Location: Jan. 28, 2013