

ESTTA Tracking number: **ESTTA490507**

Filing date: **08/22/2012**

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 | Turner Entertainment Co. |
| Granted to Date of previous extension | 08/22/2012 |
| Address | 4000 Warner Boulevard Burbank, CA 91522 UNITED STATES |
| Attorney information | Michael A. Grow Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES grow.michael@arentfox.com, cohen.elizabeth@arentfox.com, henrye@arentfox.com, tmdocket@arentfox.com Phone:202 857 6389 |

Applicant Information

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|------------------------|---|------------------------|------------|
| Application No | 85456717 | Publication date | 04/24/2012 |
| Opposition Filing Date | 08/22/2012 | Opposition Period Ends | 08/22/2012 |
| Applicant | Tin Man Brewing Company LLC 350 Summertime Lane Evansville, IN 47712 UNITED STATES | | |

Goods/Services Affected by Opposition

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| Class 040. All goods and services in the class are opposed, namely: brewery services |
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Grounds for Opposition

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| Deceptiveness | Trademark Act section 2(a) |
| False suggestion of a connection | Trademark Act section 2(a) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Marks Cited by Opposer as Basis for Opposition

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| U.S. Registration No. | 2480274 | Application Date | 03/10/1998 |
| Registration Date | 08/21/2001 | Foreign Priority Date | NONE |

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| Word Mark | TIN MAN |
| Design Mark |  |
| Description of Mark | NONE |
| Goods/Services | Class 025. First use: First Use: 1996/05/04 First Use In Commerce: 1996/05/04 Clothing for men, women and children - namely, [shirts, T-shirts, sweatshirts, jogging outfits, trousers, jeans, shorts, tank tops, rainwear, cloth bibs, skirts, blouses, dresses, suspenders, sweaters, jackets, coats, raincoats, snow suits, ties, robes, hats, caps, sunvisors, belts, scarves, sleepwear, pajamas, lingerie, underwear, boots, shoes, sneakers, sandals, booties, slipper socks, swimwear, and] costumes comprised of body suits and face mask |

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| U.S. Registration No. | 2451305 | Application Date | 03/10/1998 |
| Registration Date | 05/15/2001 | Foreign Priority Date | NONE |
| Word Mark | TIN MAN | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 016. First use: First Use: 1999/09/21 First Use In Commerce: 1999/09/21 Printed matter and paper goods, namely, [books featuring characters from animated, action adventure, comedy and/or drama features, comic books, children's books, magazines featuring characters from animated, action adventures, comedy and/or drama features, coloring books, activity books; stationery, writing paper, envelopes, notebooks, diaries, note cards, greeting cards, trading cards; lithographs; pens, pencils, cases therefor, erasers, crayons, markers, colored pencils, painting sets, chalk and chalkboards; decals, heat transfers; posters; photographs; book covers,] book marks, [calendars, gift wrapping paper; paper party favors and paper party decorations-namely, paper napkins, paper doilies, paper place mats, crepe paper, paper hats, invitations, paper table cloths, paper cake decorations; printed transfers for embroidery or fabric appliques ; printed patterns for costumes, pajamas, sweatshirts and T-shirts] | | |

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|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 2511127 | Application Date | 11/29/1999 |
| Registration Date | 11/20/2001 | Foreign Priority Date | NONE |
| Word Mark | TIN MAN | | |

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| Design Mark | TIN MAN |
| Description of Mark | NONE |
| Goods/Services | Class 028. First use: First Use: 1998/09/30 First Use In Commerce: 1998/09/30 Toys [and sporting goods, including games and playthings-] -namely, action figures and accessories therefor; plush toys [; balloons; bathtub toys; ride-on toys; equipment sold as a unit for playing card games; toy vehicles;] dolls;[flying discs; electronic hand-held game unit; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlor game, an action type target game; stand alone video output game machines; jigsaw and manipulative puzzles; paper face masks; skateboards; ice skates; water squirting toys; balls- -namely, playground balls, soccer balls, baseballs, basketballs; baseball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; surfboards; swim boards for recreational use; swim fins; toy bakeware and toy cookware; toy banks;] and Christmas tree ornaments |

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| U.S. Registration No. | 2595070 | Application Date | 11/29/1999 |
| Registration Date | 07/16/2002 | Foreign Priority Date | NONE |
| Word Mark | TIN MAN | | |
| Design Mark | TIN MAN | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 021. First use: First Use: 2000/11/30 First Use In Commerce: 2000/11/30 [GLASS, CERAMIC AND EARTHENWARE GOODS, NAMELY, COFFEE MUGS, MUGS, JUGS, BOWLS, PLATES, COFFEE CUPS, AND CUPS; BEVERAGE GLASSWARE, NAMELY, JUGS, MUGS AND-DRINKING GLASSES; DEMITASSE SETS CONSISTING OF CUPS AND SAUCERS; SUGAR AND CREAMER SETS; INFANT CUPS; COOKIE JARS;] CERAMIC, GLASS AND CHINA FIGURINES [; NON-ELECTRIC COFFEE POTS, NOT OF PRECIOUS METAL; WASTEPAPER BASKETS; ICE BUCKETS; PLASTIC BUCKETS; SHOWER CADDIES; TEA CADDIES; CAKE MOLDS; SERVING UTENSILS, NAMELY, PIE SERVERS, CAKE TURNERS, SPATULAS, SCRAPERS, AND CAKE SERVERS; CANTEENS; CHAMPAGNE BUCKETS; PLASTIC COASTERS; COCKTAIL SHAKERS; THERMAL INSULATED CONTAINERS FOR FOOD OR BEVERAGES; COOKIE CUTTERS; CORK SCREWS; CORN COB HOLDERS; WATER BOTTLES, SOLD EMPTY; VACUUM BOTTLES; DECANTERS; DRINKING FLASKS; GARDENING | | |

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| | GLOVES; RUBBER HOUSEHOLD GLOVES; AND DINNERWARE, NAMELY, PAPER PLATES AND PAPER CUPS] | | |
| U.S. Registration No. | 4087827 | Application Date | 06/14/2011 |
| Registration Date | 01/17/2012 | Foreign Priority Date | NONE |
| Word Mark | TIN MAN | | |
| Design Mark |  | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 028. First use: First Use: 2006/01/20 First Use In Commerce: 2006/01/20 Water Globes | | |

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| Attachments | 75447834#TMSN.gif (1 page)(bytes) 75861141#TMSN.gif (1 page)(bytes) 75861148#TMSN.gif (1 page)(bytes) 85346155#TMSN.jpeg (1 page)(bytes) Tin Man opp.pdf (8 pages)(310770 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 | /Michael A. Grow/ |
| Name | Michael A. Grow |
| Date | 08/22/2012 |

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

In re Application No. 85456717 for the mark TIN MAN

TURNER ENTERTAINMENT CO.

Opposer

v.

TIN MAN BREWING COMPANY LLC

Applicant

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: Opp. No. _____
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NOTICE OF OPPOSITION

Opposer Turner Entertainment Co. believes that it will be damaged by the registration of the above identified mark and hereby opposes the application with respect to both classes of goods and services listed therein under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to several trademarks and services marks derived from its famous motion picture THE WIZARD OF OZ (the “WIZARD OF OZ” Marks), which was initially released in 1939.
2. Among these marks is the word mark and design mark TIN MAN (“Opposer’s Mark”), which has been used for a variety of goods, including clothing, printed matter, toys and water globes.
3. The Patent and Trademark Office has recognized Opposer’s exclusive right to use its Mark by issuing the following registrations:
 - Registration No. 2480274, TIN MAN, issued on May 15, 2001

- Registration No. 2451305, TIN MAN, issued on May 15, 2001
 - Registration No. 2511127, TIN MAN, issued on November 20, 2001
 - Registration No. 2595070, TIN MAN, issued on July 20, 2002
 - Registration No. 4087827, TIN MAN, issued on January 17, 2012
4. Registration Nos. 2480274, 2451305, 2511127, and 2595070 are incontestable.

All of the foregoing registrations are valid and subsisting and provide prima facie and conclusive evidence of Opposer's ownership of the Mark, and of its exclusive right to use the Mark in commerce.

5. Opposer also has established exclusive common law rights in TIN MAN and other WIZARD OF OZ Marks through an extensive merchandise licensing program under which many businesses have been granted the right to display Opposer's Mark and other marks derived from the movie.

6. The fame of Opposer's Mark is enhanced by the extraordinary and enduring fame of Opposer's movie, *The Wizard of Oz* movie

7. The movie is one of the most popular ever made and it has been recognized by the American Film Institute as one of the 10 Best Movies of All Time.

8. The film tells the story of Dorothy, a girl from Kansas, who is swept away to the Land of Oz by a tornado. Once there, she must travel to the Emerald City to find the Wizard of Oz who may help her to return home.

9. Accompanying her on the journey are three characters whom she befriends early in the film. One of these is TIN MAN, who hopes that the Wizard can give him a heart.

10. Opposer's TIN MAN is an endearing and popular character in the film and these qualities have caused the mark TIN MAN to become widely known as a merchandising tool and as a valuable symbol of Opposer's goodwill.

11. Because the TIN MAN character resembles a robot, Opposer's mark has been licensed from time to time for use on toy robots.

12. The fame of the TIN MAN mark has been enhanced by the fact that Opposer's motion picture is televised annually on stations throughout the country and Opposer has sold millions of WIZARD OF OZ videos and DVDs in which the TIN MAN character is prominently featured. .

13. Because of its many showings in theaters and on television, *The Wizard of Oz* has been recognized by the Library of Congress as having been seen by more viewers than any other film.

14. Opposer's Mark has been used with a wide variety of licensed goods including, for example, printed materials, toys, clothing, and water globes.

15. Opposer has built an extensive licensing business by authorizing others to sell merchandise under TIN MAN and other marks derived from Opposer's famous motion picture, *The Wizard of Oz*.

16. Opposer's Mark has become well known and famous through extensive publicity and through sales of products bearing the mark over a period of many years.

17. Opposer established prior common law rights in Opposer's Mark, through use and advertising, directly or through its related companies and licensees, long prior to any use date or filing date that Applicant may claim.

18. Opposer's Mark is inherently distinctive and it is a valuable symbol of Opposer's goodwill.

19. All use of Opposer's Mark by its licensees inures to Opposer's benefit pursuant to 15 U.S.C. § 1055.

20. Applicant has never sought nor obtained a license to use Opposer's Mark for any goods or services.

21. Notwithstanding Opposer's prior established rights in its Mark, Applicant filed an application seeking registration of the identical mark TIN MAN for "brewery services."

22. Upon information and belief, Applicant has made no use of its alleged mark in commerce prior to the filing date of its application.

23. Upon information and belief, Applicant knew of Opposer's Mark when Applicant filed the application for registration.

24. Upon information and belief Applicant's owner allegedly adopted the name TIN MAN because as a child he owned a robot sold under the mark TIN MAN.

25. Upon information and belief, the TIN MAN robot owned by Applicant's owner was a WIZARD OF OZ TIN MAN robot.

26. Upon information and belief, Applicant adopted the mark TIN MAN with a deliberate intent to cause confusion and to profit from the enormous goodwill established by Opposer through continuous use of Opposer's Mark.

27. Upon information and belief, Applicant adopted the mark TIN MAN with a deliberate intent to cause confusion and to profit from the enormous goodwill established by Opposer through continuous use of Opposer's Mark on a wide variety of goods.

28. Likelihood of confusion is enhanced in this case by the fact that Applicant's alleged mark is identical to Opposer's Mark.

29. Upon seeing Applicant's alleged mark, members of the public are likely to be misled into believing that Applicant has obtained a license from Opposer or that Applicant's products are sponsored or approved by Opposer.

LIKELIHOOD OF CONFUSION - §2(d)

30. The mark that Applicant seeks to register is identical to or so resembles Opposer's name and mark that the use and registration thereof is likely to cause confusion, mistake and deception as to the source or origin of Applicant's goods or services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Mark.

31. Applicant's proposed goods or services are related to the goods sold under Opposer's Mark and the public is likely to be confused, to be deceived and to assume erroneously that Applicant's goods or services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by, or affiliated with Opposer.

32. Likelihood of confusion is enhanced by the fame of Opposer's Mark and by the fact that consumers associate said mark with services and goods sold, approved or endorsed by Opposer.

33. Likelihood of confusion is enhanced by the fact that prospective purchasers of Applicant's goods or services are also prospective purchasers of products sold under Opposer's Mark.

34. Likelihood of confusion may be presumed in this case because Applicant obviously adopted an imitation of Opposer's Mark in bad faith with an intent to cause confusion,

with an intent to profit from the popularity of Opposer's Mark, and to induce purchasers to believe that Applicant's goods or services originate with or are licensed or endorsed by Opposer.

DECEPTION/FALSE SUGGESTION OF CONNECTION - §2(a)

35. Applicant's alleged mark so closely resembles Opposer's Mark that it is likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the mark misdescribes the nature or origin of the goods or services, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods or services, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods or services.

36. Applicant's alleged mark so closely resembles Opposer's Mark that it falsely suggests a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged mark points uniquely to Opposer, and purchasers will assume that goods or services offered under Applicant's alleged mark are connected with Opposer.

37. When Applicant's alleged mark is used on services of the type described in its application, Applicant's alleged mark will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods or services by permitting Applicant's alleged mark to be used on such goods or services.

38. Applicant's mark is deceptive in that it falsely suggests a connection with, or approval by, Opposer.

DILUTION - §43(d)

39. For many years, Opposer's name and the WIZARD OF OZ Marks and the TIN MAN Mark have been widely used and extensively advertised in the United States and, therefore, this name and the Marks has become well known and famous as distinctive symbol of Opposer's goodwill.

40. On information and belief, Applicant intends to use its alleged mark in commerce, with a willful intent to trade on Opposer's reputation or to cause dilution of Opposer's famous name and Mark.

41. Opposer's name and Mark became well known and famous before Applicant made any use of its alleged mark, and before Applicant filed any application to register its alleged mark.

42. The use and registration of Applicant's alleged mark will cause dilution of the distinctive quality of Opposer's name and Mark.

43. Use or registration of the alleged mark will lessen the capacity of Opposer's famous name and Mark to identify and distinguish Opposer's goods and services.

44. Likelihood of confusion, dilution and deception is enhanced by the fact that Applicant's alleged mark is identical to Opposer's TIN MAN Mark.

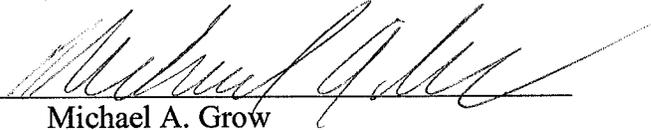
45. Use and registration of Applicant's alleged mark will deprive Opposer of the ability to protect its reputation, persona and goodwill.

46. Applicant's use or registration of TIN MAN for the services listed in its application will tarnish the goodwill symbolized by Opposer's Mark.

47. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that Opposer has no control over the nature and quality of any goods or services sold under Applicant's alleged mark, and prospective customers who encounter defects in the quality of Applicant's goods or services will attribute those defects to Opposer and this will tarnish Opposer's goodwill.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TURNER ENTERTAINMENT CO.

By 

Michael A. Grow
Elizabeth H. Cohen
Arent Fox LLP
1050 Connecticut Avenue, NW
Washington, DC 20036
(202) 857-6000
Attorney for Opposer

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing is being served upon Applicant's correspondent of record Gary K. Price, Esq. of Terrell, Baugh, Salmon & Born, LLP, at 700 S Green River Road, Suite 2000, Evansville, Indiana 47715-7907 by first class mail, postage prepaid, on August 22, 2012.

