

ESTTA Tracking number: **ESTTA559538**

Filing date: **09/16/2013**

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	James Dean, Inc.
Granted to Date of previous extension	09/18/2013
Address	10500 Crosspoint Boulevard Indianapolis, IN 46256 UNITED STATES

Correspondence information	James Dean, Inc. 10500 Crosspoint Boulevard Indianapolis, IN 46256 UNITED STATES tjminch@sovichminch.com Phone:3173353601
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**Applicant Information**

Application No	85811152	Publication date	05/21/2013
Opposition Filing Date	09/16/2013	Opposition Period Ends	09/18/2013
Applicant	Totality Films, LLC 68 Timberidge Dr Clover, SC 29710 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 009. All goods and services in the class are opposed, namely: Computer game software; Computer game software downloadable from a global computer network; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Downloadable computer game software via a global computer network and wireless devices
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**Grounds for Opposition**

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**

U.S. Registration No.	1496806	Application Date	12/12/1985
Registration Date	07/19/1988	Foreign Priority	NONE

		Date	
Word Mark	JAMES DEAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1984/09/01 First Use In Commerce: 1984/09/01 GIFTWARE -NAMELY, PORCELAIN PLATES, MUGS AND FIGURINES		

U.S. Registration No.	1492324	Application Date	06/02/1987
Registration Date	06/14/1988	Foreign Priority Date	NONE
Word Mark	JAMES DEAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1984/12/00 First Use In Commerce: 1984/12/00 CLOTHING, NAMELY, T-SHIRTS, JACKETS AND HEADWEAR		

Related Proceedings	None
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Attachments	Notice of Opposition 09-16-13.pdf(41281 bytes ) Exhibit A.pdf(268493 bytes ) Exhibit B.pdf(279224 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	/theodorejminch/
Name	James Dean, Inc.
Date	09/16/2013

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

In the Matter of Application Serial No. 85/811,152  
Mark: GAMES DEAN  
Published in the Official Gazette on May 1, 2013

JAMES DEAN, INC.	)
	)
Opposer,	)
	)
-against-	)
	)
Totality Films, LLC,	)
	)
Applicant.	)
	)

**NOTICE OF OPPOSITION**

James Dean, Inc. (“JDI”), an Indiana corporation, believes that it will be damaged by the registration of the mark GAMES DEAN (the “Mark”), applied for by Totality Films, LLC (“Applicant”) in application Serial No. 85/811,152 (the “Application”) currently before the United States Patent and Trademark Office for “Computer game software; Computer game software downloadable from a global computer network; Computer game software for personal computers and home video game consoles; Computer game software for use on mobile and cellular phones; Downloadable computer game software via a global computer network and wireless devices” in Int. Cl. 9 (collectively the “Goods”) and, as such, hereby respectfully opposes the same pursuant to Section 13(a) of the Lanham Trademark Act of 1946, 15 U.S.C. § 1063(a).

In support of this Notice, JDI hereby states and avers as follows:

**A. JDI AND THE “JAMES DEAN” MARK**

1. One of Indiana’s most beloved superstars, born and raised in Grant County, Indiana, the late Hollywood icon and International superstar, James Dean, is a legendary hero with a legendary story; live fast and die young. For over half a century, both in life and after death, James Dean has captured the world with his casual style, unflinching look and rebel attitude. From Fairmount, Indiana, by way of Hollywood, California, James Dean has defined the essence of cool and “without-a-cause” for generations. His star continues to shine brighter and brighter. Never has there ever been, never will there ever be; the one, the only, James Dean.

2. James Dean, Inc. (JDI), a corporation organized and existing under the laws of the State of Indiana in Hamilton County, Indiana, is the exclusive owner of the name, likeness, voice, right of publicity and endorsement, trademarks, copyrights, and other intellectual property including but not limited to visual and aural depictions, artifacts, memorabilia, and life story rights of the late internationally recognized movie star, James Dean.

3. For decades, JDI in cooperation with its exclusive licensing agent, CMG Worldwide, Inc., has carried on James Dean’s legacy, managing all aspects of his iconic image in film, culture, and lifestyle as well as administering all licenses for the use of James Dean’s name and likeness and the Dean Intellectual Property. JDI’s licensing of the name and likeness rights of James Dean has led to the worldwide use of his name in connection with many hundreds of goods and services, including but not limited to on and off-line games, entertainment services, clothing, dining establishments and wine, to name a few.

4. As a result of decades of use, a substantial investment in promoting goods and services offered in connection with James Dean's name, and aggressive enforcement of the Dean Intellectual Property under the federal trademark law, state common-law and statutory right of publicity, and state and federal copyright laws, JDI has established strong rights in the JAMES DEAN mark and the public have come to exclusively identify James Dean, Inc. with all things related to James Dean's name, image, and likeness. As a result, the JAMES DEAN mark have become assets of significant value to JDI and serve to identify exclusively goods and services offered in connection with James Dean's name and likeness.

5. JDI is the owner of U.S. federal trademark Reg. No. 1,496,806 for JAMES DEAN for "Giftware - namely, porcelain plates, mugs and figurines" in International Class 21. JDI filed its application to register the JAMES DEAN mark on December 12, 1985—based on its first use of the mark in 1984—and the mark was registered on July 19, 1988. A true and correct TARR printout reflecting Registration No.1,496,806 is attached hereto as Exhibit A.

6. JDI is also the owner of U.S. federal trademark Reg. No. 1,492,324 for JAMES DEAN for "Clothing, namely, t-shirts, jackets and headwear" in International Class 25. JDI filed its application to register the JAMES DEAN mark on June 2, 1987—based on its first use of the mark in 1984—and the mark was registered on June 14, 1988. A true and correct TARR printout reflecting Registration No. 1,492,324 is attached hereto as Exhibit B.

**B. APPLICANT AND ITS JAMES DEAN APPLICATION**

7. Upon information and belief, Applicant, Totality Films, LLC, is a limited liability company organized in South Carolina with an address at 68 Timberidge Drive, Clover, South Carolina 29710.

8. On December 27, 2012, Applicant filed an application with the U.S. Patent and Trademark Office to register the mark GAMES DEAN for the Goods based on Section 1(b) of the Lanham Act, 15 U.S.C. § 1051(b).

9. Upon information and belief, Applicant is neither associated with nor authorized by Rocket Jump Studios which began to run an action comedy web series from May 11, 2012 about episodes that take place at a futuristic elite high school which teaches a curriculum of video games, which featured a character, Games Dean, whose name, appearance and personality to a degree are all based on James Dean. Moreover, even if Applicant was associated or authorized by Rocket Jump, the class of goods in which this Application has been filed would not cover the Goods (as contained in the Application).

10. Because the Application was filed in the name of an entity (i.e. -- Totality Films, LLC) yet did not specify the name of counsel and, instead, listed owner entity's name and address, a copy of this Notice will be sent to Applicant at the address listed for the owner.

**FIRST CLAIM FOR RELIEF UNDER LANHAM ACT SECTION 2(a)**  
**(FALSE SUGGESTION WITH PERSONS, LIVING OR DEAD)**

11. JDI repeats and re-alleges each and every allegation contained in Paragraphs 1 through 9 as if fully set forth herein.

12. The Mark falsely suggests a connection with persons, living or dead, namely, James Dean.

13. Registration of the Mark in connection with the Goods therefore violates Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a).

14. By reason of the foregoing, JDI is likely to be irreparably harmed by registration of the Mark.

**SECOND CLAIM FOR RELIEF UNDER  
LANHAM ACT SECTION 2(d) (LIKELIHOOD OF CONFUSION)**

15. JDI repeats and re-alleges each and every allegation contained in Paragraphs 1. through 14. as if fully set forth herein.

16. The JAMES DEAN mark has been used continuously and / or registered by JDI and / or its predecessors prior to any date on which Applicant can rely for the alleged first use by Applicant of the Mark.

17. The Mark is so similar to the JAMES DEAN mark that consumers would be confused as to the source, origin, or sponsorship of the Mark and the Goods as associated with the Mark such that registration of the Mark should be prohibited.

18. As a result of this consumer confusion, JDI will be irreparably harmed by the registration of the Mark.

19. Registration of the Mark in connection with the Goods is likely to cause confusion, cause mistake, or to deceive the public into the false belief that the goods offered by Applicant under the Mark come from or are otherwise sponsored by or connected with JDI, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

20. By reason of the foregoing, JDI will be irreparably harmed by a registration of Mark on and / or in association with the Goods.

**THIRD CLAIM FOR RELIEF UNDER  
LANHAM ACT SECTION 43(c) (DILUTION)**

21. Petitioner repeats and re-alleges each and every allegation contained in Paragraphs 1 through 20 as if fully set forth herein.

22. Because the mark JAMES DEAN has become famous, Applicant's use and registration of the Mark will irreparable damage JDI by trading on the enormous goodwill

associated with JDI's marks and diluting their distinctiveness and their ability to identify goods and services offered by JDI.

23. Registration for the Mark will create a false association between the Mark and JDI's world famous JAMES DEAN.

24. This false association with the mark will necessarily harm the reputation of JDI and the JAMES DEAN mark owned by JDI.

25. Applicant's use and registration of the Mark in connection with the Goods is likely to cause dilution of JDI's famous JAMES DEAN mark, in violation of Sections 13(a) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1063(a), 1125(c).

26. Based upon foregoing, JDI will be irreparably harmed by registration of the Mark on and / or in association with the Goods.

THEREFORE, JDI hereby respectfully requests this Opposition be SUSTAINED and that registration of the Mark be REFUSED in its entirety.

Dated: September 16, 2013  
Indianapolis, Indiana

SOVICH MINCH LLP

/theodorejminch/

By: \_\_\_\_\_

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*Attorney for James Dean, Inc.*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 16<sup>th</sup> day of September, 2013, I caused a true and correct copy of the NOTICE OF OPPOSITION to be mailed via first class mail postage prepaid to Applicant's counsel of record as follows:

Totality Films, LLC  
68 Timberidge Drive,  
Clover, South Carolina 29710

/theodorejminch/

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Theodore J. Minch  
Sovich Minch, LLP

**EXHIBIT A**

**Int. Cl.: 21**

**Prior U.S. Cls.: 30 and 50**

**United States Patent and Trademark Office** **Reg. No. 1,496,806**  
**Registered July 19, 1988**

**TRADEMARK  
PRINCIPAL REGISTER**

**JAMES DEAN**

**JAMES DEAN FOUNDATION (INDIANA  
TRUST)  
1000 WATERWAY BOULEVARD  
INDIANAPOLIS, IN 46202**

**FIRST USE 9-1-1984; IN COMMERCE  
9-1-1984.**

**OWNER OF U.S. REG. NO. 1,440,661.**

**FOR: GIFTWARE —NAMELY, PORCELAIN  
PLATES, MUGS AND FIGURINES, IN CLASS  
21 (U.S. CLS. 30 AND 50).**

**SER. NO. 573,073, FILED 12-12-1985.**

**HENRY S. ZAK, EXAMINING ATTORNEY**

**EXHIBIT B**

**Int. Cl.: 25**

**Prior U.S. Cl.: 39**

**United States Patent and Trademark Office**

**Reg. No. 1,492,324**

**Registered June 14, 1988**

**TRADEMARK  
PRINCIPAL REGISTER**

**JAMES DEAN**

**TRUSTEES OF THE JAMES DEAN FOUNDATION (INDIANA TRUST)  
1000 WATERWAY BOULEVARD  
INDIANAPOLIS, IN 46202**

**FOR: CLOTHING, NAMELY, T-SHIRTS, JACKETS AND HEADWEAR, IN CLASS 25 (U.S. CL. 39).**

**FIRST USE 12-0-1984; IN COMMERCE 12-0-1984.**

**OWNER OF U.S. REG. NO. 1,440,661. THE NAME ON THE DRAWING IDENTIFIES A DECEASED INDIVIDUAL.**

**SER. NO. 664,302, FILED 6-2-1987.**

**CRAIG K. MORRIS, EXAMINING ATTORNEY**