

DOCKET 13078.144

TRADEMARK

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

In re Application Serial No. 86/101,155  
Filed: October 25, 2013  
For Mark: FOR THAT REASON, I'M OUT. I'M OUT  
Published in the *Official Gazette* of March 25, 2014

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SONY PICTURES TELEVISION INC., :  
Opposer, : Opposition No. 91217464  
- against - :  
WALLACE OM ROTHSMAN and :  
SPEEDVENTURE HOLDINGS, INC. :  
Applicants. :

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**OPPOSER'S OPPOSITION TO APPLICANTS' MOTION FOR SUMMARY  
JUDGMENT AND CROSS-MOTION FOR ENTRY OF A DEFAULT JUDGMENT**

Opposer Sony Pictures Television Inc. ("Opposer") submits this opposition to the motion for summary judgment filed by Applicants Wallace Om Rothsman and Speedventure Holdings, Inc. and in support of Sony's cross-motion for a default judgment.

Because Applicant has not made its required initial disclosures, or indeed even answered the opposition, the motion for summary judgment is premature under the Board's rules and should be summarily denied. Moreover, inasmuch as Applicant has not answered the opposition, Opposer cross-moves for entry of a default judgment.

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09-29-2014

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## **FACTS RELEVANT TO MOTION AND CROSS-MOTION**

Opposer filed this opposition on July 21, 2014 alleging that Applicants' proposed mark FOR THAT REASON, I'M OUT. I'M OUT ("Applicants' Mark") was likely to cause confusion with and dilution of the designation FOR THAT REASON, I'M OUT in which Opposer had developed trademark rights as a result of its popular usage on its hit television show SHARK TANK. Mandel Decl. ¶ 2.

That same day, the Board issued an order initiating the proceeding and setting a schedule, including a deadline of August 30, 2014 for Applicants' answer. Mandel Decl. ¶ 3. Applicants never served or filed an answer to the notice of opposition. Instead, on August 29, 2014, Applicants served and filed a motion for summary judgment. *Id.* ¶ 4. Applicants have also never served their initial disclosures in this proceeding. *Id.* ¶ 5.

## **ARGUMENT**

### **THE MOTION IS PROCEDURALLY IMPROPER AND SHOULD BE DENIED**

Trademark Rule 2.127(e)(1) provides that "[a] party may not file a motion for summary judgment until the party has made its initial disclosures, except for a motion asserting claim or issue preclusion or lack of jurisdiction by the Trademark Trial & Appeal Board." 37 CFR § 2.127(e)(1). *See also* TBMP § 528.02; *Qualcomm, Inc. v. FLO Corp.*, 93 U.S.P.Q.2d 1768, 1769-70 (TTAB 2010) (denying summary judgment motion as premature where movant had not yet served initial disclosures).

Here Applicants have not yet served their initial disclosures. Mandel Decl. ¶ 5. Indeed, they have not even answered the notice of opposition. *Id.* ¶ 4. Accordingly, their motion for summary judgment is plainly improper and should be denied as premature.

Moreover, the motion cannot be treated as a motion to dismiss under Fed. R. Civ. P. 12(b)(6). The motion expressly references Rule 56, cites cases regarding summary judgment, is supported by a declaration and purports to present facts outside the pleadings. Simply put, the motion does not argue that a claim has not been properly plead, but rather repeatedly references that a claim has not been proven by the evidence.

In any event, even were the Board to consider the motion as being directed at the pleading under Rule 12, it is plainly without merit. Opposer properly alleged that it has established trademark rights in the designation FOR THAT REASON, I'M OUT as a result of its widespread usage on Opposer's hit television show SHARK TANK. See Notice of Opposition ¶ 6. It has long been recognized that trademark protection under the Lanham Act "extend[s] to the specific ingredients of a successful T.V. series." Warner Bros., Inc. v. Gay Toys, Inc., 658 F.2d 76, 78 (2d Cir. 1981) (protecting "General Lee symbols" appearing on car prominently featured on "The Dukes of Hazzard" TV show). See also DC Comics v. Kryptonite Corp., 336 F. Supp.2d 324 (S.D.N.Y. 2004) (protecting Kryptonite as an element closely associated with Superman entertainment products); Universal City Studios, Inc. v. The T-Shirt Gallery, Ltd., 634 F. Supp. 1468 (S.D.N.Y. 1986) (Lanham Act "applies to the 'broad spectrum of marks, symbols, design elements and characters which the public directly associates with the 'Miami Vice' series"); DC Comics, Inc. v. Filmation Associates, 486 F. Supp. 1273 (S.D.N.Y. 1980) ("where the product sold by plaintiff is 'entertainment' in one form or another, then not only the advertising of the product but also an ingredient of the product itself can amount to a trademark protectable under § 43(a) because the ingredient can come to symbolize the plaintiff or its product in the public mind"); DC Comics, Inc. v. Powers, 465 F. Supp. 843 (S.D.N.Y. 1978) (granting injunction against DAILY PLANET publication based on fictional paper of same name

in Superman properties; “the Daily Planet has become so closely associated with the presentation of the Superman story that any use thereof by defendants would create a substantial likelihood of confusion”). It is of course not necessary that Opposer own a federal registration in order to assert an opposition based on common law rights.

Moreover, the notice of opposition properly alleges that Applicants’ Mark is likely to cause consumer confusion, thereby preventing registration under section 2(d) of the Lanham Act. Notice of Opposition ¶ 10. The notice of opposition also alleges the necessary elements for a claim of dilution as well as false association under section 2(a) of the Lanham Act. *Id.* ¶¶ 11-13. Accordingly, even were the Board to treat the motion as a motion to dismiss (and there is no basis for doing so), the motion would be without merit.

#### **CROSS-MOTION**

Pursuant to Trademark Rule 2.106(a), Opposer hereby cross-moves for a default judgment in this proceeding because Applicant has failed to file a timely answer. In the alternative, should this proceeding be reopened, Opposer requests that the discovery and trial periods be reset.

#### **MEMORANDUM IN SUPPORT OF CROSS-MOTION**

Opposer's cross-motion for default judgment should be granted because Applicants have failed to submit an answer to the Notice of Opposition. The order instituting this opposition was mailed by the Board on July 21, 2014. Applicant’s deadline to file an answer to the Notice of Opposition was August 30, 2014. As no answer has been filed or received, and no good cause shown, a default judgment should be entered.

**CONCLUSION**

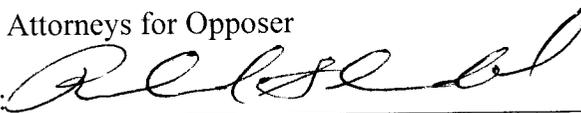
For the foregoing reasons, Applicants' motion for summary judgment should be denied and Opposer's cross-motion for a default judgment should be granted.

Dated: New York, New York  
September 29, 2014

Respectfully submitted,

COWAN LIEBOWITZ & LATMAN, P.C.  
Attorneys for Opposer

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



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New York, New York 10036  
(212)790-9200

**Certificate of Service**

A copy of the foregoing Opposer's Opposition to Applicants' Motion for Summary Judgment and Cross-Motion for Entry of a Default Judgment was served upon Applicants by sending a copy by first-class mail, postage prepaid, addressed to Applicants' correspondent of record, Wallace Rothsman, Roc Nation Ventures, LLC, 2221 NE 164<sup>th</sup> St., Suite 296, Aventura, Florida 33160-3703, on this 29th day of September, 2014.

A handwritten signature in black ink, appearing to read "R. S. Mandel", written over a horizontal line.

Richard S. Mandel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
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- against - :

WALLACE OM ROTHSMAN and :  
SPEEDVENTURE HOLDINGS, INC. :  
Applicants. :

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**DECLARATION OF RICHARD S. MANDEL, ESQ.  
IN OPPOSITION TO APPLICANTS' MOTION  
FOR SUMMARY JUDGMENT AND IN SUPPORT OF  
OPPOSER'S CROSS-MOTION FOR A DEFAULT JUDGMENT**

RICHARD S. MANDEL, pursuant to 28 U.S.C. § 1746, declares as follows:

1. I am a shareholder of Cowan, Liebowitz & Latman, P.C., attorneys for Opposer Sony Pictures Television Inc. ("Opposer"). I submit this declaration in opposition to Applicants' motion for summary judgment and in support of Opposer's cross-motion for a default judgment.

I have personal knowledge of the facts set forth herein.

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Trademarks, P.O. Box 1451, Alexandria, Virginia 22313-1451 on  
9/29/14 Kristine Natale  
(Date of Deposit) (Print name)  
Kristine Natale  
(Signature)

2. Opposer filed this opposition on July 21, 2014 alleging that Applicants' proposed mark FOR THAT REASON, I'M OUT. I'M OUT ("Applicants' Mark") was likely to cause confusion with and dilution of the designation FOR THAT REASON, I'M OUT in which Opposer had developed trademark rights as a result of its popular usage on its hit television show SHARK TANK.

3. That same day, the Board issued an order initiating the proceeding and setting a schedule, including a deadline of August 30, 2014 for Applicants' answer.

4. Applicants never served or filed an answer to the notice of opposition. Instead, on August 29, 2014, Applicants served and filed a motion for summary judgment.

5. Applicants also have never served their initial disclosures in this proceeding.

I DECLARE UNDER PENALTY OF PERJURY THAT THE FOREGOING IS TRUE AND CORRECT. EXECUTED ON SEPTEMBER 29, 2014 AT NEW YORK, NEW YORK.

  
RICHARD S. MANDEL

Certificate of Service

A copy of the foregoing Declaration of Richard S. Mandel, Esq. in Opposition to Applicants' Motion for Summary Judgment and Cross-Motion for a Default Judgment was served upon Applicants by sending a copy by first-class mail, postage prepaid, addressed to Applicants' correspondent of record, Wallace Rothsman, Roc Nation Ventures, LLC, 2221 NE 164<sup>th</sup> St., Suite 296, Aventura, Florida 33160-3703, on this 29th day of September, 2014.



Richard S. Mandel