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

Proceeding	91225166
Party	Plaintiff Warner Bros. Entertainment Inc.
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Date	12/09/2015
Attachments	Amended notice of opposition.pdf(330766 bytes)

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

In re Opposition No. 86202212 for the mark TAZ filed February 24, 2014, and published August 4, 2015

WARNER BROS. ENTERTAINMENT INC.	:	
Opposer	:	
v.	:	Opp. No. 91225166
TREASURY WINE ESTATES AMERICA COMPANY	:	
Applicant	:	

AMENDED NOTICE OF OPPOSITION

Opposer believes that it will be damaged by the registration of the above identified mark and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition Opposer alleges that:

1. Opposer is the owner of all rights, title and interest in and to a family of marks that include the words TAZ, TASMANIAN DEVIL and various distinctive cartoon character design marks ("Opposer's TAZ Marks"),

2. Opposer's TAZ Marks have been used extensively on a wide variety of goods and services including, among other things, food and beverage products, cups and glasses, bottles, cup holders, DVDs and videos, entertainment services, clothing, toys and games, wrist watches, jewelry, flash drives, cell phone cases, pens and pencils, sporting goods, and automotive products,

3. The TAZ Marks and other marks derived from Opposer's LOONEY TUNES series of films and videos have been used by Opposer and its licensees on a broad range of

goods and services, many of which are directed to children, including food and beverage products or services such as the HAPPY MEALS food and drinks offered to children by McDonalds which operates the world's largest network of franchised restaurants. See for example, http://www.youtube.com/watch?v=Q0vz5mMNuWo and http://www.ebay.com/itm/Looney-Tunes-Mcdonalds-TASMANIAN-DEVIL-Taz-Flash-MIP-/171067356132#ht_2926wt_904

4. Some of the motion pictures in which the TAZ Marks have been displayed have led to licensing opportunities in the food and beverage field, http://www.ebay.com/itm/1996-Space-Jam-Looney-Tunes-McDonalds-Happy-Meal-Toy-Complete-Set-Loose-/130913138286#ht_811wt_1018 .

5. For more than 60 years Opposer has invested substantial sums in advertising and promoting its TAZ Marks and in insuring that the marks are suitable for use on products having a high standard of quality.

6. Through many years of extensive use, advertising and publicity, Opposer's Mark TAZ has been become well known and famous as a distinctive indicator of the origin of Opposer's goods and services and it is a valuable symbol of Opposer's goodwill.

7. As a result of Opposer's successful efforts to enhance the fame and goodwill symbolized by its TAZ Marks, numerous companies have sought and obtained licenses to use those marks.

8. The Patent and Trademark Office has recognized Opposer's exclusive right to use its TAZ Marks by issuing several registrations, including the following.

- Registration No. 1,846,790, TAZ in Class 25, issued on July 26, 1994
- Registration No. 2,130,049, TAZ in Class 25, issued on January 20, 1998

- Registration No. 3,168,693, TAZ in Class 28, issued on November 7, 2006
- Registration No. 1,836,849, TASMANIAN DEVIL in Class 25, issued on May 17, 1994
- Registration No. 1,998,467, TASMANIAN DEVIL in Class 28, issued on September 3, 1996

9. These registrations for TAZ and TASMANIAN DEVIL are valid and subsisting, and some are incontestable. Accordingly, they provide prima facie and conclusive evidence of Opposer's ownership of the TAZ and TASMANIAN DEVIL Marks, and of its exclusive right to use the marks in commerce.

10. Since long prior to any first use date that Applicant may claim, Opposer's TAZ and TASMANIAN DEVIL Marks have been widely publicized and have become well-known and famous symbols of Opposer's valuable goodwill.

11. Because of the strength and fame of Opposer's TAZ and TASMANIAN DEVIL Marks they have become indelibly linked in the minds of the public with Opposer.

12. Opposer's TAZ and TASMANIAN DEVIL Marks have been used extensively with the TASMANIAN DEVIL design marks, which were first used in connection with animated productions in the early 1950s.

13. Since at least the 1950s, the fame of the TAZ and TASMANIAN DEVIL Marks has been enhanced significantly through continuous use in connection with highly popular animated productions and motion pictures, including movies that have featured such well known celebrities as Michael Jordan.

14. Opposer's Mark has been used since long prior to any use date or filing date that Applicant may claim.

15. Notwithstanding Opposer's prior established rights, Applicant recently applied for registration of the identical mark TAZ for wine.

16. Upon information and belief, Applicant made no use of its alleged mark in connection with the sale of any products or services prior to the date of first use alleged in its application.

17. Upon information and belief, Applicant adopted its alleged mark with full knowledge of Opposer's Mark with a deliberate intent to imitate and cause confusion with Opposer's Mark.

LIKELIHOOD OF CONFUSION

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

19. Applicant's goods are so closely related to the goods and services of Opposer that the public is likely to be confused, to be deceived, and to assume erroneously that Applicant's goods are those of Opposer or that Applicant has been licensed to use the mark TAZ by Opposer, or that Applicant is in some way connected with or sponsored by or affiliated with Opposer.

20. Likelihood of confusion is enhanced by the fact that the parties' marks are identical.

21. Likelihood of confusion is enhanced by the fact that the parties' goods and services are closely related.

22. Likelihood of confusion is enhanced by the fact that consumers are likely to believe that Applicant is using its alleged mark pursuant to a license from Opposer.

23. Applicant has never sought any license to use Opposer's marks TAZ and TASMANIAN DEVIL.

24. Likelihood of confusion may be presumed in light of the fct that Applicant obviously adopted an imitation of Opposer's Mark with prior knowledge of Opposer's Mark and with an intent to cause cnfusin and to capitalize on the popularity of Opposer's TAZ Marks.

25. Applicant is not affiliated or connected with or endorsed or sponsored by Opposer, nor has Opposer approved any of the goods offered or sold by Applicant under the mark TAZ nor has Opposer granted Applicant permission to use said mark.

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

26. Applicant's 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, purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, and this is likely to materially alter purchasers' decisions to acquire Applicant's goods or services.

27. Applicant's alleged mark so closely resembles Opposer's TAZ Marks 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 services sold under Applicant's alleged mark are connected with Opposer.

28. When Applicant's alleged mark is used on goods of the type described in its application, Applicant's alleged mark will cause purchasers to buy Applicant's goods or services based on the mistaken assumption that Opposer is endorsing, attempting to

promote, or encouraging the sale of Applicant's services by permitting Applicant to use said mark.

29. Applicant's alleged mark is the same as, or is a close approximation of, the name or identity previously used by Opposer.

30. Applicant's mark would be recognized as such, in that it points uniquely and unmistakably to Opposer.

31. Applicant is not connected with Opposer and Opposer is not connected with any activities performed by Applicant under Applicant's alleged mark.

32. Opposer's fame or reputation is such that, when Applicant's alleged mark is used with the applicant's alleged services, a connection with Opposer would be presumed.

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

34. Use and registration by Applicant of the mark TAZ will deprive Opposer of the ability to protect its reputation, persona and goodwill.

35. Likelihood of damage to Opposer's goodwill is enhanced by the fact that prospective customers who encounter defects in the quality of Applicant's goods will attribute those defects to Opposer and this will injure Opposer's reputation and goodwill.

DILUTION - §43(d)

36. As a separate ground for opposition, Opposer alleges that Applicant's alleged mark is likely to dilute Opposer's famous TAZ Marks through dilution or tarnishment.

37. For many years, Opposer's TAZ Marks have been widely used and extensively advertised in the United States and, therefore, these names and marks have become well known and famous as distinctive symbols of Opposer's goodwill.

38. Opposer's TAZ Marks became well known and famous before long before Applicant made any use of its alleged mark and long before Applicant applied to register its alleged mark.

39. The mark shown in Applicant's application will cause dilution of the distinctive quality of Opposer's TAZ Marks.

40. Use or registration of Applicant's alleged mark will blur Opposer's famous TAZ Marks or lessen the capacity of these marks to identify and distinguish Opposer's goods and services.

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

42. Applicant's use or registration of its alleged mark for the goods listed in its registration will tarnish the goodwill symbolized by Opposer's TAZ Marks.

43. The likelihood of tarnishment resulting from the use or registration of TAZ on an alcoholic beverage because such use poses a serious risk to children who may be old enough to recognize the word TAZ but too young to understand the difference in the beverages bearing the mark.

44. Likelihood of tarnishment is enhanced by the fact that Applicant has a callous disregard for the potential harm that the use of its mark may cause to children in that Applicant has selected a mark that has an appeal to minors in the hope of inducing such underage individuals to consume its products in violation of law.

45. By reason of the foregoing, Opposer will be damaged by the registration of Applicant's alleged mark and registration should be cancelled.

WHEREFORE, Opposer requests that the Board grant this petition for cancellation.

WARNER BROS. ENTERTAINMENT INC.

By_____

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By /s/ Michael A. Grow

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing is being served upon Applicant's attorney Gary D. Krugman of Sughrue Mion, PLLC, at 2100 Pennsylvania Avenue, NW, Washington, DC 20037 by first class mail, postage prepaid, on December 9, 2015.

/s/ Michael A. Grow