

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

NOV 26 2002 9:00

In re Application No. 75/813,747 for the mark TASMANIAN DEVIL & Design filed on October 4, 1999, and published on April 25, 2000

TIME WARNER ENTERTAINMENT COMPANY L.P. :

Opposer :

v. :

Opp. No. 119,790

STEINBECK BREWING COMPANY, INC. :  
d/b/a BUFFALO BILL'S BREWPUB :

Applicant :

U.S. Patent & TMO/TM Mail Rcpt. Dt. #57  
11-17-2002

**OPPOSER'S MOTION FOR SUMMARY JUDGMENT**

Pursuant to Rule 56 of the Federal Rules of Civil Procedure, Opposer Time Warner Entertainment Company, L.P., hereby moves for summary judgment sustaining its opposition to registration of the mark "TASMANIAN DEVIL" and Design (the "Tasmanian Devil Mark and Design"). In the course of discovery, Applicant Steinbeck Brewing Company, Inc., d/b/a Buffalo Bill's Brewpub made several admissions which show that there is no genuine issue as to any material issue of fact and that Opposer is entitled to Judgment as a matter of law. Accordingly, Opposer respectfully submits that it is entitled to summary judgment on the following grounds: (1) the Application is void *ab initio* as Applicant was not the owner at the time of filing; (2) the TASMANIAN DEVIL and Design Mark is deceptive; (3) the TASMANIAN DEVIL and Design Mark is primarily geographically deceptively misdescriptive; and (4) Applicant has committed fraud on the United States Patent and Trademark Office by falsely representing that the TASMANIAN

DEVIL and Design Mark has been used on all of the goods listed in the Application. In support of its motion, Opposer submits the accompanying Memorandum of Law, and the Declarations of Joseph R. Price, Eileen Henry and Jodi Arlen with attached exhibits.

Respectfully submitted,

TIME WARNER ENTERTAINMENT COMPANY L.P.

By:



Michael A. Grow

Elizabeth H. Cohen

Joseph R. Price

**ARENT FOX KINTNER PLOTKIN & KAHN, PLLC**

1050 Connecticut Avenue, N.W.

Washington, D.C. 20036

(202) 775-5769

(202) 857-6395 (facsimile)

Date: October 15, 2002

Attorneys for Opposer Time Warner Entertainment Co., L.P.

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

In re Application No. 75/813,747 for the mark TASMANIAN DEVIL & Design filed on October 4, 1999, and published on April 25, 2000

TIME WARNER ENTERTAINMENT COMPANY L.P.	:	
	:	
Opposer	:	
	:	
v.	:	Opp. No. 119,790
	:	
STEINBECK BREWING COMPANY, INC.	:	
d/b/a BUFFALO BILL'S BREWPUB	:	
	:	
Applicant	:	

**MEMORANDUM OF LAW IN SUPPORT OF OPPOSER'S  
MOTION FOR SUMMARY JUDGMENT**

**INTRODUCTION**

On October 4, 1999, Applicant Steinbeck Brewing Company, Inc., d/b/a Buffalo Bill's Brewpub ("Steinbeck"), applied to register the mark TASMANIAN DEVIL and Design. Summary judgment should be granted on each of the following grounds. First, the applications listed Steinbeck Brewing, Inc., as the owner when in fact the mark is, and at the time of filing was, owned by another company. Second, the Applicant represented that the mark had been used for both beer and ale, when it had never been used on beer. Third, the mark implies and the ale is advertised as containing Tasmanian hops when, in fact, it rarely if ever contains this ingredient and, therefore, the mark is deceptive under Section 2(a) of the Trademark Act. Fourth, because there is a goods place association between the geographical area known as Tasmania and ale or ale containing Tasmanian hops, the mark is also primarily deceptively geographically misdescriptive.

For these reasons, the Board should grant summary judgment sustaining the opposition, and it is not necessary at this time to decide the issue of likelihood of confusion and the other grounds set forth in the notice of opposition filed by Opposer Time Warner Entertainment Company, Inc. ("Time Warner").

### I. UNDISPUTED FACTS

Rule 56 of the Federal Rules for Civil Procedure mandates entry of summary judgment when there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law. In this case, the facts are viewed in the light most favorable to Steinbeck; and Time Warner contends that they are undisputed for purposes of this motion. *Lantech, Inc. v. Keip Mach. Co.*, 32 F.3d 542, 547. The deposition transcripts and admissions on file show that the following material facts are undisputed.

Steinbeck filed its application on October 4, 1999, seeking to register TASMANIAN DEVIL and Design for "beer and ale." Time Warner previously registered and used a family of TASMANIAN DEVIL marks extensively on a variety of goods and services since at least as early as 1982. (Henry Decl. ¶ 2, Ex. A.) Moreover, Time Warner has used its TASMANIAN DEVIL marks in the advertising, promotion and sale of a wide variety of goods and services, including non-alcoholic beverages that appeal to both adults and to children. Time Warner owns several principal registrations for its TASMANIAN DEVIL marks.<sup>1/</sup> *Id.* at ¶ 2, Ex. A.

---

<sup>1/</sup> The registrations for TASMANIAN DEVIL Marks owned by Time Warner include the following:

1,836,849 issued in Class 25 on May 17, 1994, for TASMANIAN DEVIL, for use with T-shirts and dorm shirts, with a first use date of August 1, 1988.

Notwithstanding Opposer's prior rights in its marks, Steinbeck is seeking registration of the mark TASMANIAN DEVIL and Design for "beer and ale." Steinbeck operates a restaurant and bar called "Buffalo Bill's Brewpub" in Hayward, California. (Owens Dep. at 11-12, attached as Exhibit D to Price Decl.; Harries Dep. at 7, attached as Exhibit E to Price Decl.) Buffalo Bill's Brewpub ("Buffalo Bill's"), is a microbrewery which manufactures various beverages for on and off-premises consumption. (Harries Dep. at 12, 40, 70, 76; Owens Dep. Ex. 1.)<sup>2/</sup> Its "microbrews" include, among others, Pumpkin Ale, Alimony Ale, Billy Bock beer, Buffalo Brew ale, White Buffalo ale, and

---

1,846,790 issued in Class 25 on July 26, 1994 for TAZ, for use with T-shirts, with a first use date of August 1, 1988.

1,879,822 issued in Class 25 on February 21, 1995, for a TASMANIAN DEVIL Design, for use with clothing, namely, T-shirts, shirts, shorts, socks, sweatshirts, ties, caps, and jackets, with a first use date of November 1, 1987.

1,982,818 issued in Class 9 on June 25, 1996, for a TASMANIAN DEVIL Design, for use with a series of motion picture, video, and television films and prerecorded audio and video tapes, cassettes and/or discs featuring animation and/or music, with a first use date of July 28, 1993.

1,998,467 issued in Class 28 on September 3, 1996, for TASMANIAN DEVIL, for use with toys, games, and sporting goods, with a first use date of June 1, 1982.

2,033,589 issued in Class 25 on January 28, 1997, for TASMANIAN DEVIL, for use with printed matter and paper goods, with a first use date of June 1, 1982.

2,130,049 issued in Class 25 on January 20, 1998 for TAZ, for use with clothing for men, women, and children, with a first use date of August 1, 1988.

True copies of printouts from the Patent and Trademark Office website, for each of these registrations are attached to the Declaration of Eileen Henry at Exhibit A to her declaration.

<sup>2/</sup> Deposition exhibits cited to in this memorandum are attached to the transcripts of the appropriate deponent.

Tasmanian Devil ale. *Id.* The Tasmanian Devil ale has been sold on draft and in bottles and jugs bearing the TASMANNIAN DEVIL and Design Mark. (Harries Dep. at 60-65, Exs. 23, 25, 26.) The TASMANNIAN DEVIL and Design Mark is also used on coasters, t-shirts, and menus used to advertise and sell Applicant's Tasmanian Devil ale. (*Id.*; Owens Dep. Ex. 1.)

On November 23, 2001, Time Warner filed its Amended Notice of Opposition to include on the grounds that the Application was not filed under the name of the proper owner, the TASMANNIAN DEVIL and Design Mark is deceptive, the TASMANNIAN DEVIL and Design Mark is primarily geographically deceptively misdescriptive; and Applicant has committed fraud on the Patent and Trademark Office ("PTO") by falsely representing that the TASMANNIAN DEVIL and Design Mark has been used on all of the goods listed in the Application, when in fact it has not.

## II. ARGUMENT

The summary judgment is granted under Rule 56 of the Federal Rules of Civil Procedure where there "is no genuine issue as to any material fact," and where the moving party is entitled to judgment as a matter of law. *Conroy v. Reebok International, Ltd.*, 14 F.3d 1570 (Fed. Cir. 1984); FRCP 56(c); *Anderson v. Liberty Lobby, Inc.*, 106 S. Ct. 2505, 2511 (1986) (material facts are "those that might affect the outcome of the suit under governing law").

### A. **The Application is Void *Ab Initio* Because Applicant is Not the Owner of the Tasmanian Devil Mark & Design.**

The Lanham Act requires that only the owner of a mark may apply to register. 15 U.S.C. §1051. Further, the applicant must verify that he or she is the owner of the mark sought to be registered. 15 U.S.C. §1051 1(a)(3)(A). When an application is filed by someone other than the true

owner of a mark, the application must be declared void *ab initio*. TMEP § 802.01.

Although Steinbeck listed itself as the stated owner in the Application, it is in fact not the owner of the TASMANIAN DEVIL and Design Mark. At the time the application was filed, Steinbeck was only a licensee. The microbrewery at which Steinbeck's products are sold, Buffalo Bill's, was founded in 1983 by Bill Owens, the principal of Owens Brewing Co., Inc. ("Owens Brewing"). (Owens Dep. at 11, 84.) Owens Brewing sold Buffalo Bill's to Steinbeck on June 28, 1994. *Id.* at 84, Ex. 11. Pursuant to the terms of the sale, Steinbeck obtained the assets of Buffalo Bill's as well as ownership and all rights in *some* of the trademarks, trade names and trade secrets used by Buffalo Bill's. (*Id.* at 86-93, Exs. 11, 12; Harries Dep. at 48-53.) However, Owens Brewing **retained** the ownership of and rights to certain other trademarks and trade names, including the TASMANIAN DEVIL and Design Mark, which were subsequently licensed for use to Steinbeck. (*See* Owens Dep. at 91-94, 100-01, Exs. 11, 12; Harries Dep. at 52-53.) The Asset Purchase Agreement entered into by Steinbeck and Owens Brewing expressly states that Steinbeck obtained a "license for the use by Buyer of the trade names, labels and slogans . . . (and associated label artwork) identified in Exhibit "C" hereof . . ." (Asset Purchase Agreement ¶ 1.3, Ex. C, attached to this memorandum at Owens Ex. 11.) Exhibit C of the Asset Purchase Agreement lists those marks and designs which were licensed to Steinbeck, including the TASMANIAN DEVIL and Design Mark. *Id.* at 86-87, 91. Steinbeck and Owens Brewing subsequently also executed a Trademark Licensing Agreement, further defining the nature of the licensing relationship. (Trademark Licensing Agreement ¶¶ 1.4, 1.5, Ex. A, attached to this memorandum at Owens Ex. 12.) That licensing agreement also states that the TASMANIAN DEVIL and Design Mark is entirely owned by Owens Brewing, and is merely

licensed to Steinbeck. (Owens Dep. at 94-95, 100-01, Ex. 12; Harries Dep. at 49-53.)

Steinbeck's 30(b)(6) designee and owner Geoff Harries (Harries Dep. at 48), conceded that Applicant does not own the TASMANIAN DEVIL and Design Mark and that Owens Brewing is, in fact, the actual owner of the TASMANIAN DEVIL and Design Mark. (Harries Dep. at 52-53.)

MR. PRICE:                   And Exhibit A of this document, the last page of Exhibit 12, lists a variety of slogans and trade names, trademarks including No. 3, the Tasmanian Devil name, and then the slogan "Good for drinkin' 'n dog bites." Now, am I -- is it correct, then, that Owens Brewing owns these names, slogans, and marks?

MR. HARRIES:               That's correct.

*Id.* at 52.

Accordingly, the application is void *ab initio*, and this deficiency cannot be corrected by a subsequent amendment. TMEP § 802.06; *see generally, Hyang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458 (Fed. Cir. 1988). Thus, the opposition should be sustained.

**B.     The Opposition Should be Sustained Because the TASMANIAN DEVIL and Design Mark is Deceptive.**

The TASMANIAN DEVIL and Design Mark is deceptive because it affirmatively misdescribes the ingredients of the ale, and misleads purchasers as to the composition of the ale. Therefore, registration should also be denied under section 2(a) of the Trademark Act "which bars registration of a mark which 'Consists of or compromises . . . deceptive . . . matter . . .'" *In re Budge Mfg. Co., Inc.*, 857 F.2d 773, 774 (Fed. Cir. 1988). The United States Trademark Trial and Appeal Board ("TTAB"), applies the following three part analysis in determining whether a mark consists of

or compromises “deceptive matter”:

- (1) Is the term misdescriptive of the character, quality, function, composition or use of the goods?
- (2) If so, are prospective purchasers likely to believe that the misdescription actually describes the goods?
- (3) If so, is the misdescription likely to affect the decision to purchase?

*Id.* at 775.

Steinbeck's admissions show that the mark is deceptive.

**1. The TASMANIAN DEVIL and Design Mark is misdescriptive of the composition of Applicant's goods.**

Steinbeck admits that ale sold under the TASMANIAN DEVIL and Design Mark seldom, if ever, contain hops from Tasmania notwithstanding the express representation to the contrary on the label. The TASMANIAN DEVIL and Design Mark appears on the containers, labels, menus, t-shirts, and coasters used to market and sell Tasmanian Devil ale. (Harries Dep. at 60-65, Exs. 1, 23, 25, 26.) The mark that Steinbeck is attempting to register is the entire label used on its bottles of ale *Id.* The label submitted as specimens with the application contains the following list of ingredients: “Barley - Tasmanian Hops - water - Yeast.” *See*, Ser. No. 75/813,747.

The name TASMANIAN DEVIL was originally adopted by Owens, who testified that he created and named the TASMANIAN DEVIL ale sold by Buffalo Bill's to reflect that the ale was made with Tasmanian hops that were produced in and obtained from Tasmania, Australia.<sup>3/</sup> (Owens

---

<sup>3/</sup> Hops is a major Tasmanian crop and the Tasmanian hops industry is a major farming interest in Tasmania and is recognized by Tasmania as one of its major industries. *See* Arlen Decl. ¶¶ 4-9, 12-15, 17, 19, 21, Exs. 1-6, 9-12, 14, 16, 18.

Dep. at 20-22.) Steinbeck's owner Geoff Harries testified that he "always understood" Tasmanian hops, as reflected on the TASMANNIAN DEVIL and Design Mark, to be from "Tasmania, Australia" and that the TASMANNIAN DEVIL name reflected that fact. (Harries Dep. at 18.)

However, later in his deposition, Harries admitted that ale sold under the TASMANNIAN DEVIL and Design Mark, is often, if not always, made without the use of any Tasmanian hops. *Id.* 28-29, 31-33, 36. In fact, Harries testified that when he purchase his hops from a "hops broker," he does not request that the hops provided come from any particular geographic area. *Id.* at 29. Accordingly, he conceded that the hops he uses could be grown domestically or in a country other than Australia, and he knows that some of the hops "varietals" he orders are in fact grown domestically. *Id.* at 31-33. Thus the word "Tasmanian" is deceptive when used on goods sold under the TASMANNIAN DEVIL and Design Mark. *Cf. In re Budge Mfg.*, 857 F.2d at 775 (holding that based on the applicant's admission that its seat covers were not made with lamb or sheep products, the term LAMB in the mark LOVEE LAMB for automotive seat covers was misdescriptive).

**2. Prospective purchasers are likely to believe that the TASMANNIAN DEVIL and Design Mark actually describe the Tasmanian Devil ale.**

The second factor in the 2(a) analysis, whether purchasers are likely to believe the misdesription applies to the goods, is also met based on undisputed facts. Because Applicant's label falsely lists "Tasmanian Hops" as an ingredient of the ale, purchasers obviously will be deceived and will mistakenly believe that ale sold under Applicant's mark contains hops from Tasmania. *Cf. In re Budge Mfg.*, 857 F.2d at 775-76 (holding that the TTAB's "factual inference is reasonable that purchasers are likely to believe that automobile seat covers denominated by the term LAMB or

SHEEP are actually made from natural sheep or lamb skins”).

In addition, Harries testified that he believes a purchaser would associate the product with Tasmania based on the use of the TASMANIAN DEVIL and Design Mark as the label:

MR. PRICE: . . . well, let’s say, if someone sees the bottle or whatever and they get it, will they think that this thing has something to do with Tasmania, that it’s from there or that it contains ingredients from there?

MR. HARRIES: After they make the purchase, yes.

(Harries Dep. 96.) Harries further conceded that the label, which is the TASMANIAN DEVIL and Design Mark, clearly conveys that the product is made with Tasmanian hops, and that a purchaser, reading the label, would believe the product to contain Tasmanian hops:

MR. PRICE: And I think it’s fair to say that that’s true, if you read the Tasmanian Devil label -- that you see it says, you know, Tasmanian hops, that you would then think, oh, this beer is made with Tasmanian hops?

MR. HARRIES: That’s correct.

*Id.* at 99.

**3. The misdescription of the ale as containing Tasmanian hops is likely to affect the decision to purchase.**

The misdescription of the ale as containing Tasmanian hops will affect the consuming public’s decision to purchase Applicant’s ale. Harries testified that the TASMANIAN DEVIL and Design Mark conveys a unique product made with unique ingredients. (Harries Dep. at 91, 93-94, 96-97.) Describing the Tasmanian Devil ale brand, Harries explained, “I think the brand is multidimensional. I

think -- I think just putting the words "Tasmanian Devil" up there would be a flop. I think by adding, you know, brewed with hops from Tasmania is another facet." (Harries Dep. at 93-94) (emphasis added). Harries further testified that the uniqueness of the brand, conveyed by the TASMANIAN DEVIL and Design Mark, attracts customers:

[P]eople are looking for something different on the shelf, and I think that's why they make the first purchase. I think when they get home with it, like that Pumpkin Ale, they look on the bottom of the six-pack. They want more information. Where is it produced? Is there a Web site? Oh, look. They use -- they use Tasmanian -- or hops from Tasmania, or what a cool slogan.

*Id.* at 96-97. Accordingly, Steinbeck itself admits that customers are very likely to purchase the TASMANIAN DEVIL ale based on the representations, conveyed by the TASMANIAN DEVIL and Design Mark, that the product is either from or contains primary ingredients from Tasmania.

Hops are among the products sold in Tasmania. Consequently, because the TASMANIAN DEVIL and Design Mark deceptively describes the Tasmanian Devil ale by indicating it is made with Tasmanian hops when in fact it is not, and because that misdescription is likely to affect the decision to purchase the goods, the mark is deceptive and Time Warner is entitled to a summary judgment sustaining the opposition and denying registration of the mark TASMANIAN DEVIL and Design.

**C. The TASMANIAN DEVIL and Design Mark is Primarily Geographically Deceptively Misdescriptive.**

"Under § 2(e)(2) of the Lanham Act, a mark may not be registered on the Principal Register if the mark 'when applied to the goods of the applicant is . . . primarily geographically deceptively misdescriptive.'" *In re Loew's Theaters, Inc.*, 769 F.2d 764, 767 (Fed. Cir. 1985). A mark is primarily geographically deceptively misdescriptive if the "mark was the name of a generally known geographic

place” and “the public would be likely to believe that the goods for which the mark is sought to be registered originate in that place.” *Id.*; see also *In re Nantucket, Inc.*, 677 F.2d 95 (CCPA 1982); *In re Pan-O-Gold Baking Co.*, 20 U.S.P.Q.2d 1761 (TTAB 1991). The Federal Circuit has held that it is not necessary for that place to be “well known or noted for the goods.” *Loew’s Theaters*, 769 F.2d at 767. Instead, there must simply be “a reasonable basis for concluding that the public is likely to believe the mark identifies the place from which the goods originate and that the goods do not come from there.” *Id.* at 767-68 (citing *Singer Mfg. Co. v. Birginal-Bigsby Corp.*, 319 F.2d 273, 275 (CCPA 1963) (AMERICAN BEAUTY for sewing machines of Japanese manufacturer properly refused registration under § 2(e)(2)).

Under this standard, the TASMANIAN DEVIL and Design Mark is primarily geographically misdescriptive because it implies, falsely, that the product emanates from Tasmania. As noted above, the advertising for Applicant's TASMANIAN DEVIL and Design Mark indicates that the ale is made from hops that originate in Tasmania. The name of the ale is “Tasmanian Devil.” Tasmania is known as a place that produces hops used in ale. And Applicant falsely lists “Tasmanian hops” as ingredients on labels for its products. (Harries Dep. at 96, 99.) Tasmania, as used in the TASMANIAN DEVIL and Design Mark, is readily identifiable as the name of an island off the southern coast of Australia that is well known to the public both as a tourist destination and a source of hops. (See Price Decl. ¶¶ 5, 6, Exs. A, B, C; Harries Dep. Ex. 22; Arlen Decl. ¶¶ 4-9, 12-15, 17, 19, 21, Exs. 1-6, 9-12, 14, 16, 18 ).

Further, while Tasmania need not be well known as a source of ale and beer for Steinbeck's TASMANIAN DEVIL and Design Mark to be primarily geographically deceptively misdescriptive,

*Loew's Theaters*, 769 F.2d at 767, in fact, Tasmania is a well known as a source of hops and a major producer of a variety of beers and ales manufactured from Tasmanian hops. (See Arlen Decl. ¶¶ 4-9, 12-15, 17-19, 21, 24, 31, Exhibits 1-6, 9-12, 14-16, 18, 21, 29.) While there are more than 50 varieties of hops, they are principally grown commercially in only five regions in world: Germany, southern Australia, Tasmania and Washington state. *Id.* at Ex. 9. In fact, Bushy Park in Tasmania is reputed to be the largest producer of hops in the southern hemisphere. *Id.* at ¶ 9, Ex. 6. Moreover, beer producers recognize that Tasmania's "climatic conditions and extremely low incidence of disease and pests make it an ideal place to grow world class hops." *Id.* at Ex. 29.

Despite Tasmania's reputation as a source of hops and beer made from Tasmanian hops, and despite the clear geographic reference contained in the TASMANNIAN DEVIL and Design Mark, Steinbeck has admitted that the product is not made with Tasmanian hops. In fact, Steinbeck concedes that no effort is made to specify or verify the actual geographic source of the hops used in manufacturing the ale sold under the TASMANNIAN DEVIL and Design Mark. *Id.* at 28-29, 31-33, 36. Moreover, as Steinbeck also admits, a member of the public reading the TASMANNIAN DEVIL and Design Mark would conclude that the TASMANNIAN DEVIL ale originated from or contained hops originating from Tasmania. (Harries Dep. at 96, 99.) In fact, it does not. Consequently, the TASMANNIAN DEVIL and Design Mark is primarily geographically deceptively misdescriptive, and therefore the Application should be denied on that basis.

**D. Applicant has Committed Fraud on the PTO by Falsely Representing that the TASMANIAN DEVIL and Design Mark has Been Used on All of the Goods Listed in the Application.**

“Fraud in procuring a trademark registration or renewal occurs when an applicant knowingly makes false, material representations of fact in connection with his application.” *Torres v. Torresella*, 808 F.2d 46, 48 (Fed. Cir. 1986).

[a]n application for registration of a trademark is required to exercise uncompromising candor in his communications with the United States Patent and Trademark Office, lest any registration he obtains will be [sic] invalid and/or unenforceable. He must not only refrain from making false representations to the United States Patent and Trademark Office, but he must make full disclosure of all facts to his knowledge which might bear in any way on the Office’s decision to grant the registration sought.

*Orient Express Trading Co. Ltd. v. Federal Dept. Stores, Inc.*, 2 U.S.P.Q.2d 1106, 1117 (S.D.N.Y. 1987) (quoting *T.A.D. Avanti, Inc. v. Phone-Mate, Inc.*, 199 U.S.P.Q. 648, 6545-56 (C.D. Cal. 1978)) (changes in original). Moreover, “proof of specific intent to commit fraud is not required, rather, fraud occurs when an applicant or registrant makes a false material misrepresentation that the applicant knew or should have known was false.” *General Car & Truck Leasing Sys., Inc. v. General Rent-A-Car, Inc.*, 17 U.S.P.Q.2d 1398 (S.D. Fla. 1990).

The United States Patent and Trademark Appeal Board (“TTAB”) has held that a statement in an application for registration that a mark has been used on specific goods, when in fact the mark has never been used on such goods, is not inadvertence but rather is a willful and false representation upon the PTO. *Western Farmers Ass’n v. Loblaw, Inc.*, 180 U.S.P.Q. 345, 347 (TTAB 1973) (cancelling entire registration based on fact that mark was used on only some of goods listed). *See also, e.g.*,

*Torres*, 808 F.2d at 49 (cancelling entire registration on basis of registrant's fraud on the PTO by stating that "mark was in use on wine, vermouth, and champagne when he knew it was in use only on wine"); *General Car & Truck*, 17 U.S.P.Q.2d at 1398 (cancelling entire registration on basis of fraud on the PTO by falsely stating that the mark had been used on all services when registrant knew it had only been used on some of the services); *Orient Express*, 2 U.S.P.Q.2d at 1117 (cancelling entire registration on basis of fraud on the PTO by including false statements that mark had been used on a variety of merchandise when it was used only on luggage and clothing).

Here, Applicant stated in its application that the TASMANIAN DEVIL and Design Mark is in use on "beer and ale." Yet, during his deposition Applicant admitted that the TASMANIAN DEVIL and Design Mark, to his knowledge, has never been used on beer and has only been used on ale. (Harries Dep. at 85-87.) The distinction between beer and ale is significant in the brewing business and, indeed, is one that was well known to Harries who has more than twenty years of brewing experience. *Id.* 9-10. He testified:

MR. PRICE: Is there a difference between a beer and an ale?

MR. HARRIES: There is.

MR. PRICE: And can you tell me what that is?

MR. HARRIES: It's my understanding that if a beer contains less than 3.2 percent alcohol, it's beer. Anything over 3.2 percent must be distinguished by its beer classification, be it strong ale, barley wine, pale ale, bock, stout, porter, amber ale, pumpkin ale. You know, once you exceed the 3.2, it's no longer technically beer.

MR. PRICE: Now, with regard to Tasmanian Devil, is the –  
does the alcohol level vary such that it could be  
either beer or ale?

MR. HARRIES: No.

MR. PRICE Is it always beer?

MR. HARRIES: Never beer.

MR. PRICE: It's never beer?

MR. HARRIES: Always ale.

*Id.* at 85-86. Moreover, even a cursory review of the trademark registry reveals that there are a number of registrations for marks used on ale but not beer. (Henry Decl. ¶ 3, Ex. B.)

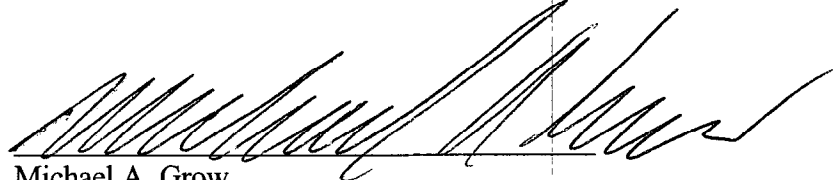
Accordingly, Applicant made knowing and false statements in his application which constitute fraud on the PTO under *Torres*, 808 F.2d at 49; *General Car & Truck*, 17 U.S.P.Q.2d at 1398; *Orient Express*, 2 U.S.P.Q.2d at 1117; *Western Farmers*, 180 U.S.P.Q. at 347. Consequently, the registration, in its entirety, should be denied.

**CONCLUSION**

For the foregoing reasons, Opposer respectfully requests that summary judgment be entered in its favor, that the opposition be sustained and that registration of the mark TASMANIAN DEVIL & Design be denied.

TIME WARNER ENTERTAINMENT COMPANY L.P.

By



Michael A. Grow

Elizabeth H. Cohen

Joseph Price

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC

1050 Connecticut Avenue, NW

Washington, D.C. 20036

(202) 775-5769

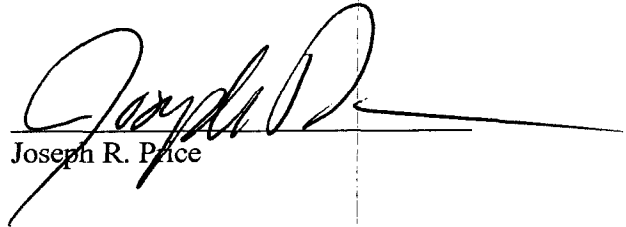
(202) 857-6395 (facsimile)

Date: October 15, 2002

Attorneys for Opposer Time Warner Entertainment Co., L.P.

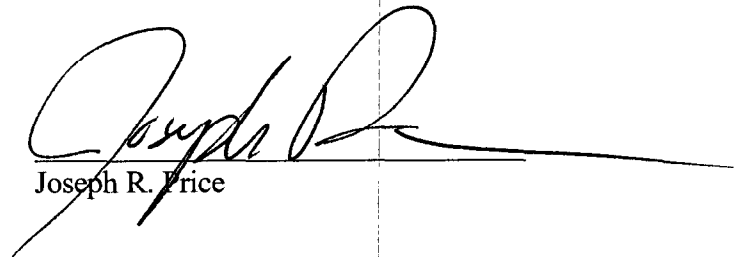
**CERTIFICATE OF MAILING**

It is hereby certified that the attached Opposer's Motion for Summary Judgment and Extension of Time (re Opp No. 119,790) is being deposited with the U.S. Postal Service addressed to the Hon. Commissioner of Patents and Trademarks, Washington, DC 20231 this 15th day of October 2002, marked first class mail, postage prepaid.

  
Joseph R. Price

**CERTIFICATE OF SERVICE**

It is hereby certified that a copy of the foregoing motion, memorandum and accompanying declarations and exhibits have been served upon Applicant Steinbeck Co., Mr. Geoff Harries, Steinbeck Co., 1082 B Street, Hayward, California 94541 this 15th day of October 2002, marked first class mail, postage prepaid.

  
Joseph R. Price