TTAB

01-15-2003
U.S. Patent & TMOfc/TM Mail Rcpt Dt. #30

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	:	

OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT

On October 15, 2002, Opposer Time Warner Entertainment Company, L.P., filed a Motion for Summary Judgment on specified grounds in the above captioned matter. Opposer is seeking summary judgment sustaining its opposition to registration of the mark "TASMANIAN DEVIL" and Design (the "TASMANIAN DEVIL and Design Mark") on the following grounds: (1) the 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 ("PTO") by falsely representing that the TASMANIAN DEVIL and Design Mark has been used on all of the goods listed in the Application.

On December 23, 2002, long after the response deadline, Applicant Steinbeck Brewing Company, Inc., d/b/a Buffalo Bill's Brewpub ("Steinbeck"), filed a document captioned "Stipulation to Opposer's Motion for Summary Judgment (On Specified Grounds) and Partial

Opposition in Connection Therewith (Specified Grounds) (hereinafter "Applicant's Stipulation and Opposition"). Although Applicant refers to the document as a stipulation, it did not seek or obtain Opposer's consent to the filing of the document. In the document, Applicant admits that Opposer's motion for summary judgment should be granted on the ground that Applicant is not the owner of the TASMANIAN DEVIL and Design Mark which it seeks to register. (Appl.'s Opp. at 1.)

Applicant "generally and specifically" opposes the remainder of Opposer's Motion for Summary Judgment which set forth the aforementioned specific additional grounds justifying denial of the application. However, Applicant failed to identify any genuine issue of material fact that would preclude entry of summary judgment in Opposer's favor on the other grounds. Similarly, Applicant made no attempt to rebut Opposer's showing that Opposer is entitled to judgment as a matter of law.

Applicant's Stipulation and Opposition is untimely and, therefore it is entitled to no consideration. Even if the filing is accepted, however, Summary Judgment should be entered in favor of Opposer on all of the grounds specified therein. Accordingly, Opposer respectfully requests that its Motion for Summary Judgment be granted in its entirety.

ARGUMENT

I. APPLICANT'S STIPULATION AND OPPOSITION IS UNTIMELY AND THEREFORE SHOULD NOT BE CONSIDERED.

Opposer's Motion for Summary Judgment and supporting declarations were filed on October 15, 2002. Rule 2.127(e) of the Trademark Rules of Practice ("TMRP")provides that a brief opposing the motion for summary judgment must be filed within thirty days from the date on

which the motion was served, unless the time is extended by stipulation of the parties or by order of the Board. Rule 2.119 of the TMRP grants five additional days to respond when, as in this case, a motion is served by first class mail. As there was no extension of time requested or granted, Applicant should have served any opposition to the motion by November 19, 2002. Instead, Applicant filed its Stipulation and Opposition on December 23, 2002, more than sixty-eight (68) days after Opposer's Motion for Summary Judgment was served and 34 days late. Accordingly, because Applicant's Stipulation and Opposition is untimely, it should be rejected and the Board should treat Opposer's Motion for Summary Judgment as conceded in its entirety. *See, Chesebrough-Pond's, Inc. v. Faberge, Inc., 618 F.2d 776, 778 (CCPA 1980);* and *Rule 2.127(a) TMRP.*

II. THE OPPOSITION SHOULD BE SUSTAINED ON ALL THE OF THE GROUNDS IN OPPOSER'S MOTION BECAUSE THERE IS NO GENUINE ISSUE OF FACT AND OPPOSER IS ENTITLED TO JUDGMENT AS A MATTER OF LAW.

The sum of Applicant's two and a half page Stipulation and Opposition is that because Applicant is willing to stipulate to the fact that Applicant was not the owner of the TASMANIAN DEVIL and Design Mark at the time of filing, Opposer is not entitled to summary judgment on the additional grounds raised in Opposer's Motion for Summary Judgment. With ample legal support, Opposer asserted in its motion that the undisputed factual record of this case makes clear that the following independent grounds also warrant denial of Applicant's registration: (1) the TASMANIAN DEVIL and Design Mark is deceptive; (2) the TASMANIAN DEVIL and Design Mark is primarily geographically deceptively misdescriptive; and (3) 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.

Applicant does not challenge Opposer's summary of the applicable law nor does Applicant seek to distinguish this case from the many prior decisions, statues and rules cited by Opposer in its motion and supporting memorandum. In fact, Applicant's Stipulation and Opposition is bereft of citation to a single legal authority and in short, raises no challenge to Opposer's legal arguments.

The only rationale offered by Applicant for denying Opposer's motion regarding these additional grounds, is Applicant's unsupported assertion--in the space of two paragraphs--that there are material facts in dispute. (Appl.'s Opp. at 2.) Regarding Opposer's well supported claims that the TASMANIAN DEVIL and Design Mark is deceptive and is primarily geographically deceptively misdescriptive, Applicant states only that "[t]he record is replete with evidence that the use of the name is not deceptive either from the perspective of the consuming public or, to the extent relevant, as a geographical reference." *Id.* This single sentence comprises Applicant's entire argument on these two grounds for denial. Applicant fails to specify what evidence is contained in the record that supports Applicant's argument, or for that matter, where in the record such support can be found.

Applicant's failure to provide any affidavits or to cite to any of the three depositions taken in this matter, including that of Geoff Harries, the principal of Steinbeck, is telling. As fully set forth in Opposer's Motion for Summary Judgment and Memorandum in Support thereof, the factual record of this case clearly demonstrates that pursuant to section 2(a) of the Trademark Act

and the authorities relied upon by Opposer interpreting that Act, the TASMANIAN DEVIL and Design Mark is deceptive; and pursuant to Section 2(e) it is primarily geographically deceptively misdescriptive.

Applicant makes a similarly unsupported and meritless argument regarding Opposer's claim that the application should be denied because Applicant has committed fraud on the PTO by falsely representing that the TASMANIAN DEVIL and Design Mark has been used on both beer and ale. In response, Applicant merely argues that it should not be held to have committed fraud because the terms beer and ale "are often used synonymously" and thus Applicant's statement that the Mark is used on both was simple inadvertence. *Id.* This assertion, regardless of its veracity, does not raise a genuine issue of material fact, nor does it have any bearing on the law, which is quite clear.

The Board 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) (canceling 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 (canceling 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 (canceling 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 (canceling 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's principal admitted that he knew the distinction between beer and ale and 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, attached as Exhibit E to Opposer's Memorandum of Law in Support of its Motion for Summary Judgment.) 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, attached as Exhibit B to Opposer's Memorandum of Law in Support of its Motion for Summary Judgment.)

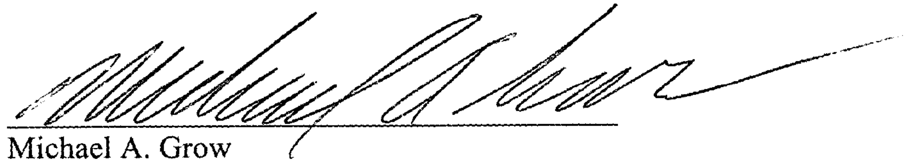
Accordingly, it is clear on the undisputed factual record that Applicant made knowing and false statements in its application which constitute fraud on the PTO under *Torres*, 808 F.2d at 49; *General Car & Truck*, 17 U.S.P.Q.2d at 1398; *Orient Express*, 2 U.S.P.Q.2d at 1117; and *Western Farmers*, 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 on all of the grounds asserted in the motion, that the opposition be sustained, and that registration of the mark TASMANIAN DEVIL & Design be denied.

Respectfully submitted,

TIME WARNER ENTERTAINMENT COMPANY L.P.

By: 

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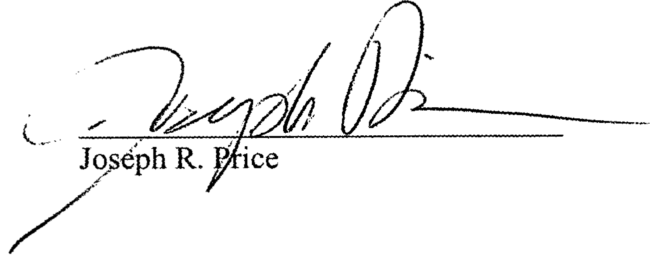
Date: January 13, 2003

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

CERTIFICATE OF MAILING

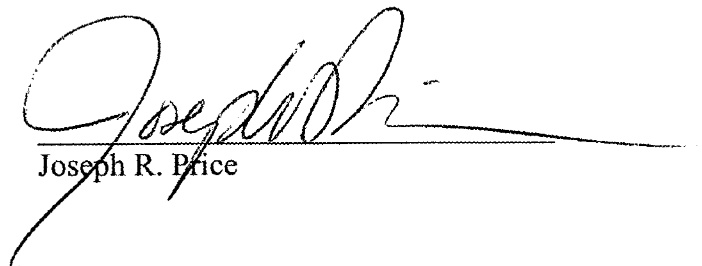
It is hereby certified that the attached **OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** (re Opp No. 119,790) is being deposited with the U.S. Postal Service addressed to the Hon. Commissioner of Patents and Trademarks, Washington, DC 20231 this 13th day of January 2003, marked first class mail, postage prepaid.



Joseph R. Price

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the foregoing **OPPOSER'S REPLY BRIEF IN SUPPORT OF MOTION FOR SUMMARY JUDGMENT** has been served upon Applicant Steinbeck Co., Mr. Geoff Harries, Steinbeck Co., 1082 B Street, Hayward, California 94541 this 13th day of January 2003, marked first class mail, postage prepaid.



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