

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

In the matter of trademark application Serial No. 78-095,659

Filed: November 29, 2001

For the mark SQRAT

Published in the *Official Gazette* on December 17, 2002



04-14-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

FOX ENTERTAINMENT GROUP, INC.

and

TWENTIETH CENTURY FOX FILM  
CORPORATION,

Opposers,

v.

IVY SILBERSTEIN,

Applicant.

Opposition No. \_\_\_\_\_

04/24/2003 K6IBBONS 00000013 502547 78095659  
01 FC:6402 600.00 CH

**NOTICE OF OPPOSITION**

1. FOX ENTERTAINMENT GROUP, INC., a corporation organized and existing under the laws of the State of Delaware, with a principal place of business at 2121 Avenue of the Stars, Suite 700, Los Angeles, California 90067 and TWENTIETH CENTURY FOX FILM CORPORATION, a corporation organized and existing under the laws of the State of Delaware with a principal place of business at 10201 W. Pico Boulevard, Los Angeles, California 90035 (collectively, "Opposers") believe that they will be damaged by registration of the mark SQRAT shown in the above-identified application Serial No. 78-095,659 (hereinafter referred to as the

“Opposed Application”) filed by IVY SILBERSTEIN (“Applicant”) and hereby oppose the same pursuant to 37 C.F.R. § 2.101(b).

2. Opposers are informed and believe that Applicant, Ivy Silberstein, is an individual residing in New York, New York with an address of One Irving Place, Apt. P201, New York, New York 10003.

3. Opposer, Fox Entertainment Group, Inc. is the parent corporation of Opposer, Twentieth Century Fox Film Corporation. Opposers for many years have been engaged in the development, production and worldwide distribution of feature films and television programs.

4. In approximately June of 2001, and before Applicant filed the Opposed Application, Opposers began distributing in theaters throughout the United States trailers advertising the March 2002 release (in approximately 3,000 theaters nationwide) of an animated feature film entitled *Ice Age*. Production and pre-production work began on the *Ice Age* feature film in 1998. One animated character developed and included in the *Ice Age* feature film was a fictional prehistoric rodent/squirrel-type animal identified by Opposers using the name “Scrat.” This “Scrat” character appeared in the trailers for the film that were publicly distributed in theaters beginning in June of 2001, and later appeared in advertising and promotional materials associated with *Ice Age*.

5. Opposers developed the “Scrat” character included in the *Ice Age* feature film without any knowledge of and completely independently of any activities of Applicant, including Applicant’s filing of the Opposed Application.

6. On February 13, 2002, Applicant commenced an action in the United States District Court for the Southern District of New York (Case No. 02 Civ. 1131 (GBD)) against Opposers and other defendants for copyright infringement, trademark infringement and state unfair competition relating to Opposers' development and use of the "Scrat" character in their animated *Ice Age* feature film and associated promotional and advertising materials (hereinafter referred to as the "Ice Age Litigation"). The Ice Age Litigation is currently pending in the United States District Court for the Southern District of New York.

7. Applicant filed the Opposed Application on November 29, 2001 under section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a) for the word mark SQRAT to identify "entertainment in the nature of animated and live action movies and television programs; entertainment services, namely, the creation, development, conceptualization and/or merchandising of movies and television programs; and entertainment services, namely, on-line computer games" in International Class 41. The Opposed Application as filed included a specimen of use consisting of a copy of the front cover of a draft of a script labeled "SQRAT, The Animated Series Pilot Episode, Draft II," a copy of which is attached as **Exhibit A**, and a claim of October of 1999 as the date of first use in commerce of the proposed mark set forth in the Opposed Application and in the specimen of use submitted therewith.

8. On August 26, 2002, Applicant filed a response to an Office Action issued on May 17, 2002 in which Applicant amended and limited the identification of services in the Opposed Application to only "merchandising of movies and television programs" in International Class 35. The Opposed Application was subsequently published for opposition in

the *Official Gazette* on December 17, 2002. Opposers have filed Requests for Extensions of Time to File a Notice of Opposition with the Board up to and including April 16, 2003.

9. Applicant filed the Opposed Application, Serial No. 78-095,659, after Opposers had independently developed their “Scrat” character, after Opposers’ “Scrat” character had appeared in movie trailers distributed in theaters beginning in June of 2001, and after Applicant learned of Opposers’ feature film and their independently developed “Scrat” character.

10. By Applicant’s own admissions, she has made no sales of any goods or services bearing the SQRAT mark that is the subject of the Opposed Application, except for the sale (at cost) of three t-shirts, and Applicant has not spent any appreciable funds on any advertising nor has she established any sales infrastructure.

11. Applicant’s proposed mark cannot be registered because Applicant’s own specimen of use submitted with the Opposed Application demonstrates that it has not been used in commerce in connection with any goods or services and, in particular, has not been used in commerce in connection with the services specifically identified in the Opposed Application, namely, “merchandising of movies and television programs.”

12. Applicant’s proposed mark cannot be registered, because Applicant’s own specimen of use submitted with the Opposed Application is nothing more than an alleged title page of a single, unproduced script and indicates that the services or goods, if any, to which said specimen pertains are inconsistent with and at variance with the services set forth in the Opposed Application.

13. Applicant's proposed mark cannot be registered because, by Applicant's own admission, it is a merely descriptive conjunction that describes a squirrel/rat animal that Applicant claims to have seen in parks in New York City. The term "sqrat" immediately conveys the idea that it refers to a squirrel/rat animal or character. Further, the name "sqrat" is a common contraction of "squirrel" and "rat" used by people to refer to actual squirrels with thin, hairless rat-type tails.

14. Applicant's proposed mark cannot be registered because it is merely descriptive, and Applicant has not established and cannot establish that said proposed mark has attained secondary meaning (i.e., has acquired distinctiveness).

15. Applicant's statement in the Opposed Application that she had used the proposed mark in commerce at least as early as October of 1999 was false in that the true facts were that at the time of the filing of the Opposed Application Applicant had not made any use in commerce of the proposed mark in connection with the services set forth in the Opposed Application, or in connection with any other services or goods, and Applicant's sole intention and purpose in filing the Opposed Application was to attempt to further the unfounded claims she asserted in the Ice Age Litigation. Upon information and belief, said false statement was made by Applicant with the knowledge and belief that said statement was false and with the intent to induce the authorized agents of the United States Patent and Trademark Office to grant Applicant a registration for the proposed mark and constitutes fraud on the United States Patent and Trademark Office.

16. The issuance of Applicant's requested registration would be a source of damage and injury to Opposers and others in the entertainment and film industries, specifically, and to the general public.

WHEREFORE, Opposers pray that this Opposition be sustained and that application Serial No. 78-095,659, filed November 29, 2001, be rejected and that registration of the alleged trademark recited therein be refused and denied.

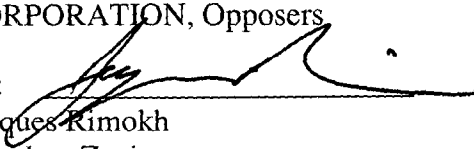
A duplicate copy of this Notice of Opposition and the statutory fees required for each Opposer are enclosed herewith.

Please recognize as attorneys for Opposers Jonathan Zavin and Jacques Rimokh (members of the Bar of the State of New York) and the firm of Loeb & Loeb LLP, 345 Park Avenue, New York, New York 10154. Please address all communications to Jonathan Zavin of said firm and address.

Respectfully submitted,

FOX ENTERTAINMENT GROUP, INC.  
and TWENTIETH CENTURY FOX FILM  
CORPORATION, Opposers

Dated: April 14, 2003

By:   
Jacques Rimokh  
Jonathan Zavin  
Attorneys for Opposers  
Loeb & Loeb LLP  
345 Park Avenue, 18<sup>th</sup> Floor  
New York, N.Y. 10154  
(212) 407-4000

"EXHIBIT A"

ORIGINAL SPECIMEN

Internet Transmission Date:

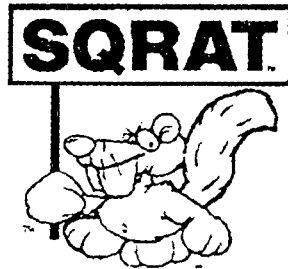
2001/11/29

Serial Number:

78095659

Filing Date:

2001/11/29



THE ANIMATED SERIES

PILOT EPISODE

DRAFT II

DRAFT

DRAFT

Written by

Norah Pierson

with

Ivy Silberstein

Based on a Character Created & Owned by

Ivy Supersonic

© Norah Pierson and Ivy Silberstein 2000

The applicant has submitted required color specimen.  
The USPTO has printed only one copy of the specimen,  
and extra copies can be produced in-house as needed.

TTAB

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EXPRESS MAILING CERTIFICATE

I, Vicki Foley (Signature) hereby certify that the foregoing documents are being deposited with the United States Postal Service as Express Mail postage prepaid in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on this date of 4/14/03 (date)

Vicki Foley (Name)

EL 753056601US (Express Mail Label Number)

4/14/03 (Date of Deposit)

April 14, 2003

EL753056601US



## VIA EXPRESS MAIL

Commissioner for Trademarks  
2900 Crystal Drive  
Box TTAB FEE  
Arlington, VA 22202-3513

04-14-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Re: Notice of Opposition for Application Serial No. 78-095,659  
Mark: SQRAT

Dear Sir/Madam:

Enclosed for filing please find two copies (an original and one copy) of a Notice of Opposition with respect to the above-referenced application to register the mark "SQRAT," which application was filed by Ivy Siberstein.

Please charge our Deposit Account (Account No. 50-2547) in the amount of \$600 to cover the prescribed \$300 filing fee for Opposer, Fox Entertainment Group, Inc. and the prescribed \$300 filing fee for Opposer, Twentieth Century Fox Film Corporation.

Once the enclosed Notice of Opposition has been received, kindly return the enclosed self-addressed, postage-paid postcard confirming your receipt of these materials.

Sincerely,

*James R. Guerette*  
James R. Guerette

20289410003  
NY276487.1

cc: Bonnie Bogin, Esq.  
Jon Del Barrio, Esq.  
Jonathan Zavin, Esq.