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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

The Saul Zaentz Company dba Tolkien Enterprises
v.
Joseph M. Bumb

Combined Opposition No. 91170589
to application Serial Nos.
78085111 and 78085108¹

¹ In addition to the present combined opposition proceeding involving applicant's September 23, 2001 applications to register the MIDDLE EARTH JEWELRY and ARAGORN marks for jewelry, the parties are involved in two other opposition proceedings. Opposition No. 91156452 involves applicant's application Serial No. 78083686 (filed September 12, 2001) to register the mark MITHRIL for jewelry. Opposition No. 91156518 involves applicant's application Serial No. 78083685 (filed September 12, 2001) to register the mark LOTR for jewelry.

Finding there to be common issues of law and fact in the three oppositions involving the four applications, the Board consolidated the three proceedings in orders dated July 23, 2004, January 24, 2007 and February 9, 2007, with the MITHRIL opposition serving as the parent case. The cases have proceeded as consolidated cases for purposes of discovery, trial and briefing.

However, we deem it appropriate for purposes of final decision to decide the three cases separately, in separate opinions. Although the three cases share common legal and factual issues which warranted consolidation for purposes of discovery, trial and briefing, the issues and evidence are not identical in the three cases. In the interest of clarity, we find that each of the three cases warrants its own opinion at final decision. We have considered the evidence in each case independently and we are deciding each of the cases based on the evidence pertinent to each case.

Carole F. Barrett, Blake J. Lawit and Sarah J. Givan of Howard Rice et al. for The Saul Zaentz Company dba Tolkien Enterprises.

Joseph M. Bumb, pro se.

Before Grendel, Walsh and Cataldo, Administrative Trademark Judges.

Opinion by Grendel, Administrative Trademark Judge:

Introduction.

This opposition proceeding involves the famous series of fantasy literary works by J.R.R. Tolkien set in his imaginary world of Middle Earth ("the Tolkien works"). The books include *The Fellowship of the Ring*, *The Two Towers*, and *The Return of the King* (the "Lord of the Rings" trilogy), and its prequel, *The Hobbit*. In *The Hobbit*, the hero Bilbo Baggins, a hobbit (a smaller relative of humans), goes on a journey across Middle Earth during which he discovers the dangerous Ring of Power. The sequel "Lord of the Rings" trilogy is the story of the perilous journey across Middle Earth of the hobbit hero Frodo Baggins and

his companions to destroy the Ring of Power and defeat the armies of the evil wizard Saruman and the dark lord Sauron.²

Millions of copies of the Tolkien works have been sold in the United States since their first publication in the 1950's. In a 2008 Harris poll, the Tolkien works together ranked as the third most popular book of all time among American readers, trailing only *The Bible* and *Gone With the Wind*.³

On September 23, 2001, Joseph M. Bumb ("applicant") filed an application (Serial No. 78085108) seeking registration on the Principal Register of the mark **MIDDLE EARTH JEWELRY** (JEWELRY disclaimed) for goods identified in the application as "jewelry, namely, rings, bracelets, pendants, charms, necklaces, earrings, pins, tie pins and tie clasps, brooches, cufflinks, money clips, all made of precious metal and alloyed precious metal." The application was based on applicant's allegation of a bona fide intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

² Undisputed evidence establishing these and other facts relating to the plot and characters in the Tolkien works appears throughout the record.

³ Drotos depo. (see below at footnote 7) at 46-48, 207-208; Imhoff depo. (see below at footnote 7) at 39-40.

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Also on September 23, 2001, applicant filed an application (Serial No. 78085111) seeking registration on the Principal Register of the mark **ARAGORN** for the same jewelry goods. This application also was based on applicant's allegation of a bona fide intention to use the mark in commerce, under Trademark Act Section 1(b), 15 U.S.C. §1051(b).

The Saul Zaentz Company dba Tolkien Enterprises ("opposer") filed a combined notice of opposition to registration of each of the marks. In its amended notice of opposition, opposer alleged, in pertinent part, (a) that it owns various trademarks based on characters, places, things and events described in the Tolkien works, and that these marks include the marks MIDDLE EARTH and variants thereof (including MIDDLE EARTH JEWELRY), and ARAGORN; (b) that applicant lacked the requisite bona fide intent to use the marks MIDDLE EARTH JEWELRY and ARAGORN at the time he filed the respective applications to register those marks, rendering each of the applications void ab initio under Trademark Act Section 1(b), 15 U.S.C. §1051(b); and (c) that opposer is the prior user of the marks MIDDLE EARTH (and variants thereof) and ARAGORN, that applicant's use of the MIDDLE EARTH JEWELRY and ARAGORN marks he seeks to register is likely to cause confusion with opposer's

previously-used MIDDLE EARTH and ARAGORN marks, and that registration of each of these marks therefore is barred under Trademark Act Section 2(d), 15 U.S.C. §1052(d).⁴

Applicant answered the amended notice of opposition by denying the salient allegations thereof.

Opposer submitted evidence at trial; applicant did not.⁵ The case is fully briefed.

After careful consideration of all of the evidence of record and all of the arguments of the parties (including evidence and arguments not specifically discussed in this opinion), we **sustain** opposer's opposition to each of the marks applicant seeks to register, i.e., MIDDLE EARTH JEWELRY and ARAGORN, on the ground that applicant lacked the requisite bona fide intent to use each of the marks in commerce when he filed the respective intent-to-use applications for registration of the respective marks, rendering each of the applications void ab initio under Trademark Act Section 1(b), 15 U.S.C. §1051(b).⁶

⁴ Opposer also alleged a dilution claim, but has specifically withdrawn that claim in its brief. (Opposer's brief at 23, n.4.) We give it no further consideration.

⁵ See below at footnote 8.

⁶ Because we find that opposer has established its standing and its Section 1(b) ground of opposition to registration of applicant's marks, we need not and do not reach opposer's Section 2(d) ground of opposition. See *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926 (TTAB 2009). We note that opposer states

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The evidence of record in these combined oppositions includes the pleadings and, by rule, the files of applicant's opposed MIDDLE EARTH JEWELRY and ARAGORN applications. Trademark Rule 2.122(b)(1), 37 C.F.R. §2.122(b)(1).

In addition, opposer submitted the following evidence at trial which we deem to be most pertinent to our findings and conclusions in this case:⁷

1. The October 24, 2008 testimony deposition (with exhibits) of Akram Saigh, an employee of opposer's licensee The Noble Collection;

in its brief: "This issue of Applicant's bona fide intent to use is dispositive - if Applicant lacks a bona fide intent to use the marks at issue, the Board need not expend resources and effort on SZC's likelihood of confusion ground for opposition." (Opposer's brief at 28, n.7.)

⁷ Opposer's additional evidence (to which we shall cite in this opinion when appropriate), is summarized as follows. Opposer's Notice of Reliance also includes: (a) NOR Exh. 50-112, which are numerous printed publications referring to the Tolkien works and to opposer's movies based thereon; and (b) NOR Exh. 113-121, which are official USPTO records concerning seven other intent-to-use applications (now-abandoned) for registration of other Tolkien-related marks (in addition to MITHRIL and LOTR; see above at footnote 1) filed by applicant between September 2001 and December 2001 (see below at footnote 14). Opposer also submitted the testimony depositions, with exhibits, of various of its employees and licensees. These are the depositions of: Albert Bendich ("Bendich 2005 depo." and "Bendich 2008 depo."); Fredrica Drotos ("Drotos depo."); Juliet Mason ("Mason depo."); Laurie Battle ("Battle depo."); David Imhoff ("Imhoff depo."); and Lars Edman ("Edman depo.") Also of record is the December 1, 2004 testimony deposition (with exhibits) of applicant Joseph Bumb ("Bumb 2004 depo."), taken by opposer in connection with the MITHRIL and LOTR cases prior to the consolidation of the present case with those cases (see above at footnote 1).

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2. The November 6, 2008 testimony deposition (with exhibits) of applicant Joseph Bumb (taken by opposer) ("Bumb depo."); and

3. Opposer's Notice of Reliance ("NOR Exh. ___") on:

a. status and title copies of opposer's registrations of the marks MIDDLE EARTH (NOR Exh. 1, 3-7) and ARAGORN (NOR Exh. 8-10); and

b. applicant's discovery responses, including his responses to opposer's interrogatories ("Int. No. ___"), requests for admissions ("RFA No. ___") and requests for production of documents ("RFP No. ___") (NOR Exh. 45-49).

Applicant submitted no evidence at trial.⁸

Opposer, The Saul Zaentz Company, d.b.a. Tolkien Enterprises, is a film production company. (Bendich 2005

⁸ At page 2 of his brief, in his "Description of the Record," applicant asserts that "Applicant's record in this case" includes "The Pleadings, including any and all of Applicant's declarations." To the extent that applicant by this reference to "declarations" might be referring to his June 28, 2007 declaration in opposition to opposer's summary judgment motion, we have given that declaration no consideration because it was not made of record at trial. See, e.g., *Levi Strauss & Co. v. R. Joseph Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); see generally Trademark Board Manual of Procedure (TBMP) (2d Ed., Rev. 2004) at §528.05(a) and cases cited therein. We note that the Board, in its July 29, 2008 order denying opposer's summary judgment motion, advised the parties (at footnote 2) that summary judgment evidence is of record only for purposes of determining the summary judgment motion. Additionally, we find that applicant's assertions in his answer to the notice of opposition and in his final brief on the case are not in themselves evidence of the facts asserted except to the extent that they are supported by evidence at trial, or except to the extent that they may have probative value as admissions against interest. See TBMP at §706 and cases cited therein. Finally, we add that our decision in this case would have been the same even if we had considered these materials to be evidence of record on applicant's behalf.

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depo. at 7.) In 1976, opposer, by mesne assignments, acquired from the J.R.R. Tolkien estate the exclusive world-wide performance, motion picture and ancillary rights in and to the Tolkien works. (Bendich 2008 depo. at 7-17, exh. 270-274; Drotos depo. at 21-22, 32-33.) Since acquiring the rights, opposer has used and licensed the use of various trademarks based on names, objects, places and events depicted in and derived from the Tolkien works (the "Tolkien marks"), on a wide variety of goods and services. (Drotos depo. at 50-198, exh. 108-198.) Opposer owns numerous federal trademark registrations of many of the Tolkien marks, covering a variety of goods. (NOR Exh. 1-38.)⁹

In 2001-2003, opposer's licensee, New Line Cinema, produced and distributed a series of three feature films based on the books of the Lord of the Rings trilogy, i.e., *The Fellowship of the Ring*, *The Two Towers*, and *The Return of the King*. (Drotos depo. at 28-29; Mason depo. at 19.) These movies are among the most successful movies in U.S.

⁹ Opposer's registrations of Tolkien-related marks include multiple registrations of the mark ARAGORN (see below at footnote 15), multiple registrations of the mark MIDDLE EARTH and variants thereof (see below at footnote 12), multiple registrations of the mark LORD OF THE RINGS and variants thereof, and registrations of the marks EVENSTAR, ONE RING TO RULE THEM ALL, MORDOR, ARWEN, MY PRECIOUS, SARUMAN, GOLLUM, ELROND, EOWYN, FRODO, GALADRIEL, RIVENDELL, THE ONE RING, AND GANDALF.

box office history, having grossed approximately one billion dollars in theaters. (Imhoff depo. at 41-42; Drotos depo. at 48-50.) Beginning in 1999, well prior to the release of the first film in December 2001, the trilogy film project was the subject of substantial media attention and great anticipation, especially among the devoted fans of the Tolkien works. (Drotos depo. at 42-44; Imhoff depo. at 32-34).¹⁰ Tens of millions of DVD copies of the movies have been sold in the U.S. (Imhoff depo. at 41-42.)

Over three hundred of opposer's licensees and sub-licensees have marketed thousands of different products (including jewelry) under the Tolkien marks as part of opposer's extensive and highly successful merchandising

¹⁰ Opposer's notice of reliance includes press articles appearing prior to the first film's release which referred to opposer's trilogy film project, such as:

- Newsweek (April 24, 2000) (NOR Exh. 76): "J.R.R. Tolkien fans downloaded the first 'Lord of the Rings' trailer nearly 1.7 million times in its first 24 hours on the Net. ... Says a LOTR megafan, 'It's so amazing to finally see this world come to life.' If you haven't already, the first installment premieres Christmas - 2001.";

- Detroit Free Press (March 5, 2001) (NOR Exh. 72): "The first of the three long-awaited 'Lord of the Rings' films doesn't even open until Dec. 19, but the Internet buzz has already reached heights unheard of, even in the world of Hollywood hype."; and

- Atlanta Journal and Constitution (April 30, 2001) (NOR Exh. 77): "Based on the J.R.R. Tolkien classic, the movie won't debut until Christmas. But, realizing that there was intense interest among LOTR fans, New Line began its online promotions in May - of 1999."

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program based on the movies. (Imhoff depo. at 15-23; Drotos depo. at 37.) The dollar amounts of opposer's sales and advertising expenditures in connection with the movies and the related merchandising program have been submitted under seal, but suffice it to say that they are very substantial. (Imhoff depo. at 24-32; Mason depo. at 12-31, exh. 103-104.)

Applicant, Joseph M. Bumb, operates a store at the San Jose Flea Market in California, where he buys and sells a range of products including jewelry, collectibles and memorabilia. (Bumb depo. at 10, 13.) Applicant also engages in the custom design and manufacture of jewelry. (Bumb depo. at 15.)

MIDDLE EARTH JEWELRY Opposition.

In this combined opposition proceeding, we turn first to opposer's opposition to applicant's application (Ser. No. 78085108) to register the mark MIDDLE EARTH JEWELRY.¹¹

To review, applicant seeks registration of the mark MIDDLE EARTH JEWELRY for various jewelry items. Opposer's ground of opposition is lack of bona fide intent under Trademark Act Section 1(b).

¹¹ We shall address opposer's opposition to applicant's ARAGORN application below.

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The evidence of record establishes that "Middle Earth" is the name of the imaginary world in which the Tolkien works are set. (Drotos depo. at 24-25.) Applicant acknowledged that Middle Earth is "a world that was created by J.R.R. Tolkien," and that he "would expect that people who had read the books when they hear of Middle Earth would think of the books." (Bumb depo. at 34; RFA 3 (NOR Exh. 46).)

To prevail in its opposition to applicant's application to register the mark MIDDLE EARTH JEWELRY, opposer must establish its standing to oppose and at least one statutory ground of opposition to registration of the mark. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

To establish its standing to oppose registration of the MIDDLE EARTH JEWELRY mark applicant seeks to register, opposer must prove that it has a real interest in the outcome of this proceeding and that it has a reasonable basis for its belief that it would be damaged by issuance of a federal trademark registration of the mark to applicant. *See Ritchie v. Simpson*, 170 F.3d 1092, 50

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USPQ2d 1023 (Fed. Cir. 1999); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

The evidence of record establishes that, pursuant to license from opposer, opposer's licensee The Noble Collection has marketed a line of jewelry under the mark "Middle Earth Jewelry" in the United States since 2002. (Saigh depo. at 25-28, Exh. 250-251; Drotos depo. at 50-51, 96-98, 118-119, Exh. 108, 133, 143; Imhoff depo. at 46-48.) Additionally, opposer has made of record status and title copies of six existing registrations it owns of variations of the mark MIDDLE EARTH for various goods in Classes 16, 21 and 28. (NOR Exh. 1, 3-7.)¹²

Based on this evidence of opposer's licensee's use of the mark MIDDLE EARTH JEWELRY on jewelry, and opposer's ownership of registrations of the mark MIDDLE EARTH for various goods, we find that opposer has established that it has a real interest in this proceeding and a reasonable basis for believing that it would be damaged by issuance to applicant of a registration of the mark MIDDLE EARTH

¹² Reg. Nos. 1109520, 2897943, 2919668, 2971045, 3109215 and 3470907. We note that opposer also made of record a status and title copy of a seventh MIDDLE EARTH registration, Reg. No. 2633940, but the Office's records indicate that this registration has been cancelled pursuant to Trademark Act Section 8. We therefore give it no consideration.

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JEWELRY. Opposer therefore has established its standing in this case.

Having found that opposer has standing, we turn next to opposer's Section 1(b) ground of opposition, i.e., its claim that applicant's MIDDLE EARTH JEWELRY application is void ab initio because applicant lacked the requisite bona fide intent to use the mark when he filed his application.

In pertinent part, the Trademark Act provides that "A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register...." Trademark Act Section 1(b)(1), 15 U.S.C. §1051(b)(1).

The Board has held that "...the determination of whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances." *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1355 (TTAB 1994). The Board also has stated that the requirement that an applicant must have a bona fide intent to use the mark in commerce "must be read in conjunction with the revised definition of 'use in commerce' in Section 45 of the Trademark Act, which the Trademark Law Revision Act of 1988 amended to require that such use be 'in the ordinary course

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of trade, and not made merely to reserve a right in a mark.'" *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507 (TTAB 1993).

Because the determination of whether applicant had the requisite bona fide intent to use the mark is to be based on objective evidence of such intent, "...applicant's mere statement of subjective intention, without more, would be insufficient to establish applicant's bona fide intention to use the mark in commerce." *Lane Ltd., supra*, 33 USPQ2d at 1355. See also *Research In Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883 (TTAB 2008).

"Opposer has the initial burden of demonstrating by a preponderance of the evidence that applicant lacked a bona fide intent to use the mark on the identified goods." *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008). If opposer meets this initial burden of proof, the burden of production shifts to applicant "...to rebut the opposer's prima facie case by offering additional evidence concerning the factual circumstances bearing upon its intent to use its mark in commerce." *Commodore Electronics Ltd., supra*, 26 USPQ2d at 1507 n.11.

One way in which an opposer can establish its prima facie case of no bona fide intent is by proving that

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applicant has no documentary evidence to support its allegation in the application of its claimed bona fide intent to use the mark in commerce as of the application filing date. *See Research In Motion Ltd., supra*, 92 USPQ2d at 1931; *Boston Red Sox Baseball Club LP, supra*, 88 USPQ2d at 1587; and *Commodore Electronics Ltd., supra*, 26 USPQ2d at 1507. If opposer makes out its prima facie case by showing that applicant lacks documentary evidence to support its allegation of bona fide intent, "the burden shifts to applicant to come forward with evidence which would adequately explain or outweigh his failure to provide such documentary evidence." *Research In Motion Ltd., supra*, 92 USPQ2d at 1931.

Applying these principles in the present case, we find as follows.

Applicant filed his intent-to-use application for MIDDLE EARTH JEWELRY on September 23, 2001. Applicant has admitted that aside from documents filed with the USPTO pertaining to his intent-to-use trademark application, he has no documents relating to his adoption of or intent to use the MIDDLE EARTH JEWELRY mark. (RFP Nos. 2, 10, 14, and 39 (NOR Exh. 47); Bumb depo. at 49.)

Pursuant to the authorities discussed above, we find that applicant's lack of any documents to support his claim

of bona fide intent suffices to establish, prima facie, that applicant lacked a bona fide intent to use the MIDDLE EARTH JEWELRY mark in commerce when he filed the application to register that mark. The burden thus is shifted to applicant to present evidence which explains or outweighs that absence of documents and establishes his bona fide intent to use the mark in commerce at the application filing date. We find that applicant has failed to rebut that prima facie case.

Applicant submitted no evidence at trial, whether on the issue of bona fide intent or otherwise.¹³ The only evidence of record on this issue is applicant's trial testimony (taken by opposer) and certain of applicant's discovery responses (made of record by opposer), which we now shall consider.

First, applicant's testimony establishes that applicant chose the mark MIDDLE EARTH JEWELRY based on his knowledge of the significance of the term in the Tolkien works:

Q. Well, the reason you picked those words, "Middle Earth Jewelry," or at least one of the reasons, was that you had read the books, right?

A. Yes.

(Bumb depo. at 35.)

¹³ See above at footnote 8.

Second, applicant's testimony contains several admissions which establish that he filed the application merely to reserve a right in the mark. For example:

Q. Okay. Do you intend to sell jewelry bearing the Middle Earth Jewelry trademark online?

A. It was my intent to trademark Mithril. And I think I've stated even in my past declarations that the other trademark names were set up as a protective insulation. You know, had I to do it over again I wouldn't have done it the same way.

(Bumb depo. at 26-27.)¹⁴

Q. And Middle Earth Jewelry is one of those marks that you registered as an insulator or a buffer, right?

A. I think that's where you started with your question. Did I have any intent to manufacture a jewelry line or a product using the trademark Middle Earth Jewelry. I don't recollect what was going through my mind in, was that '01, you know, seven years ago. ... so to pinpoint exactly what I was thinking I can't say for the record what it was.

Q. So you can't say for the record that at that time you had an intent to manufacture a line of jewelry under a Middle Earth Jewelry or Aragorn trademark?

¹⁴ As context for this testimony, we note that MITHRIL is the mark involved in Opposition No. 91156452, and that Opposition No. 91170589 involves the mark LOTR. (See above at footnote 1.) In addition to those two marks and the ARAGORN and MIDDLE EARTH JEWELRY marks involved in this combined opposition proceeding, applicant also filed seven additional applications (now abandoned) to register other Tolkien-related marks for jewelry between September 2001 and December 2001. (NOR Exh. 113-121.) These other marks were GALADRIEL, LORD OF THE RINGS JEWELRY, FRODO, GANDALF, THE ONE RING, ISILDUR'S BANE, and ARWEN.

A. Correct. I don't recollect what I was thinking at that particular time.
(Bumb depo. at 28-29.)

Q. Now so is it also true that you can't say at the time that you registered the LOTR trademark that you had an intent to manufacture or sell jewelry under that mark?

A. Yes.

Q. And that's true also for the Aragorn and Middle Earth trademarks, right?

A. I don't recall. I mean it - you are asking me about that same issue of linking them together. I can't tell you right off the top of my head what I was thinking when - remember I explained that I thought that it was kind of insulating?

Q. Right. So as you sit here today you can't say for sure at the time that you registered Aragorn or Middle Earth Jewelry that you had an intent to manufacture or sell the jewelry under those marks?

A. I don't recall.

(Bumb depo. at 39-40.)

Q. And you don't have any document showing any product development for a line of jewelry under Middle Earth, under the Middle Earth Jewelry trademark, true?

A. The only thing I did was trademark the name.

(Bumb depo. at 43.)

After reviewing all of the evidence of record, we conclude that the preponderance of the evidence establishes that applicant lacked the requisite bona fide intention to use the MIDDLE EARTH JEWELRY mark in commerce when he filed his intent-to-use application to register that mark.

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Specifically, applicant has no documentary evidence to support his bona fide intent claim, a fact which suffices in itself to establish, prima facie, that applicant lacked a bona fide intention to use the mark when he filed his application. Applicant has failed to rebut that prima facie showing. See *Research In Motion Ltd., supra*, 92 USPQ2d at 1931 ("The absence of documentation coupled with applicant's failure to take testimony or offer any evidence supporting its bona fide intent to use convince us that applicant did not have a bona fide intent to use the mark.") Indeed, applicant's testimony includes what essentially are his admissions that he filed his intent-to-use application merely to reserve a right in the MIDDLE EARTH JEWELRY mark "as an insulator or a buffer."

For all of the reasons discussed above, we conclude that applicant lacked the requisite bona fide intent to use the MIDDLE EARTH JEWELRY mark in commerce when he filed his application to register that mark, that the application therefore is void ab initio under Trademark Act Section 1(b), and that opposer has established this ground of opposition to registration of applicant's mark. We have considered applicant's arguments to the contrary, but we are not persuaded by them.

**MIDDLE EARTH JEWELRY Opposition
Conclusion and Decision.**

Based on our review of all of the evidence of record, and for all of the reasons discussed above, we conclude that opposer has established its standing, and has established its Section 1(b) ground of opposition. Accordingly, we sustain opposer's opposition to registration of applicant's MIDDLE EARTH JEWELRY mark on that ground.

ARAGORN Opposition.

We turn next to opposer's opposition to applicant's application (Ser. No. 78085111) to register the mark ARAGORN.

The record establishes that Aragorn is a central character in Tolkien's "Lord of the Rings" trilogy and in opposer's "Lord of the Rings" movie trilogy based thereon. Indeed, he is the king to whom the final work of the trilogy, *The Return of the King*, refers in its title. (Drotos depo. at 22-24; Bumb depo. at 36-37; RFA No. 1 (NOR Exh. 46).)

The record establishes that opposer licenses the mark ARAGORN for various products, including jewelry. (Drotos depo. at 141, Exh. 155.) Opposer's licensee The Noble

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Collection has sold a jewelry item called the "Ring of Aragorn" in the United States since 2002. (Saigh depo. at 28-30, Exh. 251; Imhoff depo. at 39, 48-49, 67, 49, 117-118, Exh. 214-216; Drotos depo. at 44-45, 118, 141-42, Exh. 143, 155.)

Additionally, opposer has made of record status and title copies of three existing registrations it owns of the mark ARAGORN for various goods in Classes 6, 16, 21, 28, and 34. (NOR Exh. 8-10.)¹⁵

Based on opposer's licensee's use of the ARAGORN mark on jewelry, and on opposer's ownership of its three ARAGORN registrations, we find that opposer has established that it has a real interest in this proceeding and a reasonable basis for believing that it would be damaged by issuance to applicant of a registration of the mark ARAGORN. Opposer therefore has established its standing in this case. See *Ritchie v. Simpson, supra*; *Time Warner Entertainment Co. v. Jones, supra*.

Having found that opposer has standing, we turn next to opposer's Section 1(b) ground of opposition, i.e., its claim that applicant's ARAGORN application is void ab initio because applicant lacked the requisite bona fide intent to use the mark when he filed his application.

¹⁵ Reg. Nos. 2897945, 2976576 and 3378020.

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We have discussed the legal principles pertaining to the bona fide intent issue above, in connection with the MIDDLE EARTH JEWELRY case. These include the definition of bona fide intent, opposer's initial burden of proof (which can be satisfied by a showing that applicant lacks documentary evidence of his bona fide intent), and the shifting of the burden of rebuttal to applicant upon opposer's establishment of its prima facie case. Those principles apply in this ARAGORN opposition as well.

Applicant filed his intent-to-use application for ARAGORN on September 23, 2001. Applicant has admitted that aside from documents filed with the USPTO pertaining to his intent-to-use trademark application, he has no documents relating to his adoption of or intent to use the ARAGORN mark. (RFP Exh. Nos. 1, 9, 13; 38 (NOR Exh. 47).)

Pursuant to the authorities discussed above, we find that applicant's lack of documentary evidence suffices to establish, prima facie, that applicant lacked the requisite bona fide intent to use the ARAGORN mark in commerce when he filed his application to register that mark.

Moreover, applicant's testimony includes what essentially are his admissions that he filed the application merely to reserve a right in the mark. For example:

Q. And that's why you registered [sic - applied to register] the Aragorn trademark, for instance?

A. First it was Mithril, and then LOTR, kind of in conjunction. And the others were probably insulating as well, you know, just - it was kind of there and it was late that night and I was just ...

Q. So at the time that you were doing it you didn't have an intent to make an Aragorn line of jewelry?

A. Not anything that would pertain to New Line anyway ... Any kind of movie connection. But as to - I don't know where it could go. You say intent. ... I do intend to be prosperous in the future, but that doesn't necessarily mean it's going to happen. ...

Q. And so Aragorn is one of those marks that you registered [sic - applied to register] as an insulator or a buffer, right?

A. Yes.

...
Q. So you can't say for the record that at that time you had an intent to manufacture a line of jewelry under a Middle Earth Jewelry or Aragorn trademark?

A. Correct. I don't recollect what I was thinking at that particular time.

(Bumb depo. at 26-29.)¹⁶

Q. Right. Okay. So as you sit here today you can't say for sure at the time that you registered Aragorn or Middle Earth Jewelry that you had an intent to manufacture or sell the jewelry under those marks?

A. I don't recall.

(Bumb depo. at 39-40.)

¹⁶ See above at footnote 14 regarding these marks other than ARAGORN which applicant sought to register.

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After reviewing all of the evidence of record, we conclude that applicant lacked the requisite bona fide intention to use the ARAGORN mark in commerce when he filed his intent-to-use application to register that mark. Specifically, applicant has no documentary evidence to support his bona fide intent claim, a fact which suffices in itself to establish, prima facie, that applicant lacked a bona fide intention to use the mark when he filed his application. Applicant has failed to rebut that prima facie showing. See *Research In Motion Ltd., supra*, 92 USPQ2d at 1931 ("The absence of documentation coupled with applicant's failure to take testimony or offer any evidence supporting its bona fide intent to use convince us that applicant did not have a bona fide intent to use the mark.") Indeed, applicant's testimony includes what essentially are his admissions that he filed his intent-to-use application merely to reserve a right in the mark "as an insulator or a buffer."

For all of the reasons discussed above, we conclude that applicant lacked the requisite bona fide intent to use the ARAGORN mark in commerce when he filed his application to register that mark, that the application therefore is void ab initio under Trademark Act Section 1(b), and that opposer has established this ground of opposition to

registration of applicant's mark. We have considered applicant's arguments to the contrary, but we are not persuaded by them.

ARAGORN Opposition - Conclusion and Decision.

Based on our review of all of the evidence of record, and for all of the reasons discussed above, we conclude that opposer has established its standing, and has established its Section 1(b) ground of opposition. Accordingly, we sustain opposer's opposition to registration of applicant's ARAGORN mark on that ground.

Decisions in Combined Oppositions.

Opposer's opposition to applicant's application (Serial No. 78085108) to register the mark MIDDLE EARTH JEWELRY is **sustained**.

Opposer's opposition to applicant's application (Serial No. 78085111) to register the mark ARAGORN is **sustained**.