UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: January 4, 2012

Opposition No. 91192402
Opposition No. 91192413
Opposition No. 91192414
Opposition No. 91192434
Opposition No. 91192435
Opposition No. 91192507
Opposition No. 91192508
Opposition No. 91192568
Opposition No. 91192626
Opposition No. 91192634
Opposition No. 91192635
Opposition No. 91192639
Opposition No. 91192643
Opposition No. 91192647
Opposition No. 91192650
Opposition No. 91192955
Opposition No. 91193030
Opposition No. 91193031
Opposition No. 91193032
Opposition No. 91193033
Opposition No. 91193034
Opposition No. 91193036
Opposition No. 91193040
Opposition No. 91193041
Opposition No. 91193042
Opposition No. 91193043
Opposition No. 91193574

Disney Consumer Products Inc.
and Disney Destinations LLC

v.

Thoip

IT IS HEREBY ORDERED:

Because the civil action disposed of all pleaded issues, the consolidated opposition is dismissed.

DISCUSSION

This consolidated proceeding has been suspended, with the consent of both parties, pending the disposition of Thoip v. Disney Consumer Products Inc. and Disney Destinations LLC (hereafter, Disney), Civil Action No. 08-Civ-6823-SAS, pending in the United States District Court for the Southern District of New York. On August 31, 2011, applicant submitted copies of the three court orders described below, and with the statement that no motions or appeals remain pending.

In the civil action the parties are in reversed position, and Thoip alleged infringement of its unregistered marks by Disney. On August 23, 2010, the court issued an order which (i) found Thoip's marks inherently distinctive and entitled to trademark protection without a showing of secondary meaning, (ii) granted Disney's motion for summary judgment as to likelihood of forward confusion, and (iii) reopened discovery on the issue of the likelihood of reverse confusion. On May 10, 2011, the court issued an order which granted Disney's motion for summary judgment on the issue of likelihood of reverse confusion. On May 17, 2011, the court issued an order entering final judgment for Disney for the reasons stated in the court's May 10, 2011 opinion and order.

Since the court orders do not direct Board action, and applicant's submission of the court's orders is not accompanied by a motion seeking Board action, a review of the pleadings filed in the twenty-seven consolidated proceedings is necessary to determine the impact of the court's orders on this consolidated proceeding.

As a preliminary matter, the Board notes that the notice of opposition filed in Opposition No. 91193043 is a duplicate to the notice of opposition filed in Opposition No. 91193030. The second opposition should not have been instituted, and Opposition No. 91193043 is null and void. The opposition is dismissed, and a refund of the filing fee will issue. See Trademark Trial and Appeal Board Manual of Procedure (TBMP) §119.03 (3rd ed. 2011). .

In Opposition No. 91192402 (MR. GRUMPY), Disney alleges that it produces and provides entertainment and consumer products (¶1-3); that the opposed application seeks registration of a descriptive phrase (¶4); that, because applicant's mark is merely descriptive, it lacks inherent distinctiveness and applicant has not shown acquired distinctiveness (¶5); that registration of applicant's mark would inhibit competitors'' interest in using the descriptive term (¶6); and that registration should be refused (¶7). Upon review, the Board finds that Disney filed essentially the same notice of opposition in Opposition Nos. 91192413 (MR. HAPPY),

91192414 (MR. STUBBORN), 91192434 (MR. RUDE), 91192435 (MR. BUMP), 91192507 (MR. BOUNCE), 91192508 (MR. NOISY), and 91192568 (LITTLE MISS NAUGHTY).

In Opposition No. 91192626 (LITTLE MISS BOSSY), Disney uses the ESTTA notice of opposition, attaches the same allegations ¶1-6, before ¶4 inserts "Count I", and adds "Count II" with new allegations that applicant is aware of third party users of marks incorporating identical terms on the goods identified in the application (¶7), that applicant stated in its application that no one else has the right to use the mark (¶8), and that applicant committed fraud in submitting a false statement with the intent to deceive the Office (¶9). Upon review, the Board finds that Disney filed essentially the same notice of opposition in Opposition Nos. 91192634 (LITTLE MISS GIGGLES), 91192635 (MR. MESSY), 91192639 (LITTLE MISS DAREDEVIL), 91192643 (LITTLE MISS SCARY), 91192647 (MR. SMALL), 91192650 (LITTLE MISS GIGGLES), 91192955 (MR. BUMP and design), 91193030 (MR. MESSY and design), 91193031 (MR. BOUNCE and design), 91193032 (MR. HAPPY and design), 91193033 (LITTLE MISS FUN and design), 91193034 (LITTLE MISS SUNSHINE and design), 91193036 (LITTLE MISS BOSSY and design), 91193040 (LITTLE MISS DAREDEVIL and design)[1],

[1] For reasons unknown, Opposition No. 91193040 was terminated April 5, 2011 and opposed application Serial No. 77312616 issued May 10, 2011 as Registration No. 3956374. The Board regrets the error, and Registration No. 3956374 will be forwarded to the Office of the Commissioner for Trademarks for appropriate action.

91193041 (LITTLE MISS NAUGHTY and design)[2], and 91193042 (LITTLE MISS SCARY and design).

In Opposition No. 91193574 (MR. STUBBORN and design), Disney omitted the ESTTA notice of opposition, but filed the same two claims and essentially the same numbered paragraphs as in Opposition Nos. 91192626, 91192634, 91192635, 91192639, 91192643, 91192647, 91192650, 91192955, 91193030, 91193031, 91193032, 91193033, 91193034, 91193036, 91193040, 91193041, and 91193042.

A decision by the United States District Court is binding on the Board. Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805, 807 (TTAB 1971). Here, the court's finding that applicant's marks are inherently distinctive and entitled to trademark protection without a showing of secondary meaning is dispositive of opposer's claims that applicant's marks are merely descriptive. Moreover, the court's finding that applicant has a protectable trademark interest in its marks is dispositive of opposer's claim that applicant committed fraud in averring in its application that no one else had the right to use the mark in commerce.

[2] For reasons unknown, Opposition No. 91193041 was terminated April 13, 2011 and opposed application Serial No. 77312640 issued May 17, 2011 as Registration No. 3960272. The Board regrets the error, and Registration No. 3960272 will be forwarded to the Office of the Commissioner for Trademarks for appropriate action.

With the exception of Opposition No. 91193043, which is dismissed as a nullity, the consolidated opposition is dismissed with prejudice based upon the district court order.

By the Trademark Trial and Appeal Board