

ESTTA Tracking number: **ESTTA1182051**

Filing date: **12/31/2021**

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

Proceeding no.	91217941
Party	Plaintiff Robert Kirkman, LLC
Correspondence address	JAMES D WEINBERGER FROSS ZELNICK LEHRMAN & ZISSU PC 151 WEST 42ND STREET 17TH FLOOR NEW YORK, NY 10036 UNITED STATES Primary email: jweinberger@fzlz.com 212-813-5900
Submission	Rebuttal Brief
Filer's name	James D. Weinberger
Filer's email	jweinberger@fzlz.com
Signature	/s/ James D. Weinberger
Date	12/31/2021
Attachments	F4417012.pdf(152940 bytes)

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

ROBERT KIRKMAN, LLC,
Opposer,
-against-
PHILLIP THEODOROU and ANNA
THEODOROU,
Applicants.

**Cons. Opp. and Canc. Nos. 91217941
(parent), 91217992, 91218267, 91222005,
91222719, 91227277, 91233571, 91233806,
91240356, 92068261 and 92068613**

ROBERT KIRKMAN, LLC,
Opposer/Petitioner,
-against-
STEVEN THEODOROU and PHILLIP
THEODOROU,
Applicants.

REPLY TRIAL BRIEF FOR OPPOSER/PETITIONER

James D. Weinberger
Shelby P. Rokito
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
151 West 42nd Street, 17th Floor
New York, New York 10036
jweinberger@fzlz.com
srokito@fzlz.com

Attorneys for Opposer/Petitioner

TABLE OF CONTENTS

TABLE OF AUTHORITIES2

I. INTRODUCTION4

II. ARGUMENT5

A. Applicants Have Conceded The Facts Necessary to Establish Opposer’s Claims5

B. Applicants’ Arguments Regarding The Strength of Opposer’s THE WALKING DEAD Marks Are Inadequately Pled and Meritless7

 1. Applicants’ Arguments That THE WALKING DEAD Marks Are Descriptive or Generic Are Inadequately Pled and Factually and Legally Unsupported.....8

 2. There is Not a “Crowded Field” of “THE WALKING DEAD” Marks.....10

C. Applicants’ Claims of Misuse, Misrepresentation, Fraud, and Deceptive Practices Are Baseless..... 11

D. Applicants’ Assertion of Priority Contradicts the Record Evidence.....15

E. Applicants’ Arguments Regarding Opposer’s Use of The Registered Trademark Symbol Are Irrelevant and Without Merit16

III. CONCLUSION.....20

TABLE OF AUTHORITIES

CASES

<i>Chromalloy American Corp. v. Alloy Surfaces Co.</i> , 173 U.S.P.Q. 295, 339 F. Supp. 859 (D. Del. 1972).....	17
<i>Exergen Corp. v. Wal-Mart Stores, Inc.</i> , 91 U.S.P.Q.2d 1656, 575 F.3d 1312 (Fed. Cir. 2009)	18
<i>Fladeboe v. American Isuzu Motors Inc.</i> , 58 Cal. Rptr. 3d 225 (Cal. Ct. App. 2007).....	19
<i>Four Roses Products Co. v. Small Grain Distilling & Drug Co.</i> , 29 F.2d 959 (D.C. 1928).....	19
<i>Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.</i> , 4 U.S.P.Q.2d 1026, 826 F.2d 837 (9th Cir. 1987)	18
<i>Gap (Apparel), LLC v. Gap One Enterprises, LLC</i> , Opp. No. 91172505, 2008 WL 3333842 (T.T.A.B. July 28, 2008).....	11
<i>Gay Professional Men of Color v. CBE Pride</i> , Opp. No. 91252308, 2020 WL 2394376 (T.T.A.B. May 8, 2020).....	12
<i>H.D. Lee Co. v. Maidenform, Inc.</i> , 87 U.S.P.Q.2d 1715 (T.T.A.B. 2008)	8
<i>Hole in 1 Drinks, Inc. v. Lajtay</i> , Canc. No. 92065860, 2020 WL 859853 (T.T.A.B. Feb. 19, 2020).....	7
<i>In re Association of Energy Engineers, Inc.</i> , 227 U.S.P.Q. 76 (T.T.A.B. 1985)	10
<i>In re Cosmetic Factory, Inc.</i> , 208 U.S.P.Q. 443 (T.T.A.B. 1980)	10
<i>In re Phillips-Van Heusen Corp.</i> , 228 U.S.P.Q. 949 (T.T.A.B. 1986)	16
<i>In re Southern National Bank of North Carolina</i> , 219 U.S.P.Q. 1231 (T.T.A.B. 1983)	9
<i>In re Weather Channel, Inc.</i> , 229 U.S.P.Q. 854 (T.T.A.B. 1985)	9
<i>Kendall-Jackson Winery, Ltd. v. Superior Court of Stanislaus County</i> , 90 Cal. Rptr. 2d 743 (Cal. Ct. App. 1999).....	19
<i>Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.</i> , 469 U.S. 189, 224 U.S.P.Q. 327 (1985)	9
<i>Plus Products v. Physicians Formula Cosmetics, Inc.</i> , 198 U.S.P.Q. 111 (T.T.A.B. 1978)	7

<i>Strong v. General Electric Co.</i> , 162 U.S.P.Q. 141, 305 F. Supp. 1084 (N.D. Ga. 1969).....	17
<i>Tea Board of India v. Republic of Tea, Inc.</i> , 80 U.S.P.Q.2d 1881 (T.T.A.B. 2006).....	9
<i>UVeritech, Inc. v. Amax Lighting, Inc.</i> , 115 U.S.P.Q.2d 1242 (T.T.A.B. 2015).....	12
<i>VIP Foods, Inc. v. V.I.P. Food Products</i> , 200 U.S.P.Q. 105 (T.T.A.B. 1978).....	18

STATUTES

15 U.S.C. § 1052.....	5, 7, 20
15 U.S.C. § 1125.....	5, 7, 20
15 U.S.C. § 1127.....	10, 14

RULE

Federal Rule of Civil Procedure 9	12
---	----

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE

TBMP § 311.02.....	8
TBMP § 314.....	8
TBMP § 704.05.....	7

TREATISE

J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (5th ed. 2021).....	<i>passim</i>
---	---------------

I. INTRODUCTION¹

Applicants' trial brief is rife with factual and legal inaccuracies, conjecture, and nonsequiturs; but what is most telling about Applicants' brief is not actually what it *says*, but rather what it *fails* to say. Applicants' brief is devoid of any denial or refutation of the operative facts set forth in Opposer's trial brief, which clearly establish Opposer's ownership of rights in THE WALKING DEAD derived from Opposer's prior use for comic books and licensing activities (including but not limited to the famous television series) and Opposer's claims for likelihood of confusion and dilution. At no point in Applicants' brief do Applicants dispute that Opposer's THE WALKING DEAD Marks are famous and have been since at least 2003; that Opposer owns seven federal trademark registrations for THE WALKING DEAD Marks (three of which issued before the first of Applicant's Applications); that Applicants have applied for marks which are *identical* to Opposer's for highly related goods; and that this Board and the USPTO have previously found THE WALKING DEAD to be a famous trademark.

Rather than contest—or even address—the legally relevant facts and arguments set forth in Opposer's trial brief, Applicants advance the same irrelevant, inadequately pled, and/or factually unsupported arguments that Applicants have espoused to no avail throughout this proceeding.² Applicants repeat their erroneous assertions concerning the strength of Opposer's THE WALKING DEAD Marks, Opposer's copyright registrations, Applicants' claimed priority, and Opposer's purportedly improper use of the registered trademark symbol on merchandise sold

¹ Capitalized terms used herein shall have the same meaning ascribed to them in Opposer's trial brief filed on August 25, 2021 (55 TTABVUE).

² See, e.g., Applicants' Motion to Dismiss filed March 15, 2015 (7 TTABVUE); Motion to Dismiss filed November 25, 2015 (11 TTABVUE); Motion to Dismiss filed May 26, 2017 (20 TTABVUE); Motion for Summary Judgment filed September 25, 2020 (41 TTABVUE).

by Opposer under THE WALKING DEAD Marks—despite the fact that each one of these arguments have been made and rejected on numerous occasions.³

Applicants' arguments continue to be just as misguided as their attempts to register THE WALKING DEAD and TWD marks ("collectively, THE WALKING DEAD Marks") and offer no rebuttal to the clear showing made by Opposer that Applicants' proposed use and registration of marks identical to Opposer's will cause confusion and dilution. Accordingly, this Opposition should be sustained and the Applications and Registrations should be denied under Sections 2(d) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1125(c).

II. ARGUMENT

A. Applicants Have Conceded The Facts Necessary to Establish Opposer's Claims

During its testimony period, Opposer properly submitted evidence satisfying its burdens of proof on its claims for likelihood of confusion and dilution. Applicants' trial brief does not contest these facts. In other words, it is *undisputed* that:

- Opposer's use of THE WALKING DEAD Marks dates back to 2003, when Mr. Kirkman authored the first comic book in a series he called *The Walking Dead*. (55 TTABVUE 10.)
- In 2009 Opposer entered into a license agreement with AMC to create and produce a television series based on *The Walking Dead* comic series. (*Id.* at 12.)
- The license between Opposer and AMC granted AMC an exclusive right to use THE WALKING DEAD Marks in connection with both *The Walking Dead* television series and related merchandise. (*Id.*)

³ See March 3, 2016 Order denying Applicants' November 25, 2015 Motion to Dismiss (15 TTABVUE); see also March 16, 2018 Order denying May 26, 2017 Motion to Dismiss (23 TTABVUE).

CONFIDENTIAL INFORMATION REDACTED

- The *Walking Dead* television series has seen enormous success, generating the highest total viewership of any series in cable television history, and garnering significant critical acclaim, including Writers Guild of America, Golden Globe and Emmy nominations, among many other nominations and awards. (*Id.* at 13-14.)
- *The Walking Dead* television series has acquired enormous consumer recognition and has created a high demand for merchandise sold under THE WALKING DEAD Marks. (*Id.* at 14-16.)
- AMC promotes a wide variety of merchandise based on *The Walking Dead* television series, including but not limited to, t-shirts, sweatshirts, shorts, onesies, flip-flops, hats, and other apparel; mugs and beverage ware; phone cases; pens; jewelry; bags and luggage tags; action figures; food; construction sets; trivia games; dart boards; video games; guitars; dog collars; mobile games; slot machines; and calendars. (*Id.* at 16.)
- Sales of THE WALKING DEAD merchandise have generated over [REDACTED] since 2010. (*Id.*)
- Opposer heavily promotes *The Walking Dead* comics, literary works, merchandise, and services and AMC heavily promotes *The Walking Dead* television series. (*Id.* at 17.)
- *The Walking Dead* comic books and television series have received extensive coverage in the press, including unsolicited placements which create hundreds of millions of media impressions per year, and which generate broad exposure and extremely high levels of commercial awareness. (*Id.* at 17-18.)
- Opposer owns numerous registrations for THE WALKING DEAD Marks, which cover a wide variety of products and services. (*Id.* at 19-20.)

- Opposer is the owner of seven federal registrations for THE WALKING DEAD Marks, three of which issued before Applicants filed their first Application to register THE WALKING DEAD. (*Id.*)
- Opposer owns three pending use-based trademark applications, namely Application Serial Nos. 86/145,914, 86/849,482, and 87/177,696 collectively covering a wide variety of collateral merchandise offered under THE WALKING DEAD Marks, all based on first use dates going back to 2011, 2012, 2013, 2014, or 2015. (*Id.* at 20.)
- Both this Board and the USPTO have found THE WALKING DEAD mark to be a famous mark for purposes of the likelihood of confusion analysis. (*Id.* at 21-22.)

The above facts, none of which Applicants have disputed in their trial brief, conclusively establish Opposer’s claims for likelihood of confusion and dilution under Sections 2(d) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1125(c).

B. Applicants’ Arguments Regarding The Strength of Opposer’s THE WALKING DEAD Marks Are Inadequately Pled and Meritless⁴

Applicants assert in “Point I” of their brief that Opposer’s THE WALKING DEAD Marks are descriptive or generic, and that because the term “the walking dead” has been used in other films and literature, there exists a “crowded field” of THE WALKING DEAD marks that renders

⁴ Applicants attached 27 exhibits to their trial brief. Because such materials were not properly made of record during Applicants’ trial period, they should receive no consideration. *See Hole in I Drinks, Inc. v. Lajtay*, Canc. No. 92065860, 2020 WL 859853, at *2, 42 TTABVUE 4-5 (T.T.A.B. Feb. 19, 2020) (Board would not consider evidence attached to Respondent’s brief); *Plus Prods. v. Physicians Formula Cosmetics, Inc.*, 198 U.S.P.Q. 111, 112 n.3 (T.T.A.B. 1978) (exhibits attached to applicant’s brief and not made of record during applicant’s trial period were not considered); *see also* Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) § 704.05(b).

Opposer's marks "unprotected." (60 TTABVUE 9-11.⁵) As a threshold matter, Applicants' failure to plead descriptiveness or genericness as an affirmative defense precludes consideration of such claims at this stage in the proceedings. However, even if considered, Applicants' assertions should be rejected since they disregard rudimentary principles of trademark law. Moreover, Applicants' "crowded field" argument should be rejected since the record in this proceeding establishes that Opposer is the only *trademark* user when it comes to THE WALKING DEAD Marks.

1. *Applicants' Arguments That THE WALKING DEAD Marks Are Descriptive or Generic Are Inadequately Pled and Factually and Legally Unsupported*

First, by failing to assert descriptiveness or genericness in their Answer, Applicants waived any claim that Opposer's THE WALKING DEAD Marks are invalid on these grounds. As the Board explained in its March 16, 2018 order denying Applicants' May 26, 2017 motion to dismiss, "a party may not rely and thereafter obtain judgment on an unpleaded claim or defense, such as Applicants' claim/defense of genericness." (23 TTABVUE 6.) Even after the Board granted Applicants an opportunity to replead their defenses (*see* 23 TTABVUE 8), Applicants still did not plead descriptiveness or genericness (24 TTABVUE), thereby precluding Applicants from relying upon such grounds at trial. *See H.D. Lee Co. v. Maidenform, Inc.*, 87 U.S.P.Q.2d 1715, 1720 (T.T.A.B. 2008) ("[A]n unpleaded defense cannot be relied upon by the defendant unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter.") (citations omitted); *see also* TBMP §§ 311.02(c); 314 (parties may not rely on unpleaded grounds in seeking judgment from the Board).

Second, even if Applicants had adequately pled these defenses, Applicants' assertions that THE WALKING DEAD Marks are descriptive or generic and "not secondary" reflects a

⁵ Applicants' Point I heading actually states that THE WALKING DEAD mark is "NOT GENERIC OR SECONDARY," which, like much of Applicants' brief, is nonsensical. (60 TTABVUE 9).

misunderstanding of both the factual record in this proceeding and fundamental concepts of trademark law. (60 TTABVUE 9.) Descriptive marks convey an immediate idea of the ingredients, qualities or characteristics of the goods or services. *In re S. Nat'l Bank of N.C.*, 219 U.S.P.Q. 1231, 1232 (T.T.A.B. 1983). Suggestive marks require consumer imagination, thought, or perception to determine what the product is. *Id.* At the very least, THE WALKING DEAD Marks are suggestive, as they call for consumer imagination, thought, or perception to determine what they refer to. This is confirmed by the seven federal trademark registrations that Opposer owns for THE WALKING DEAD Marks. (55 TTABVUE 19-20.) As the USPTO did not require Opposer to show evidence of secondary meaning to obtain Opposer's registrations, it is presumed that the marks are inherently distinctive. *See Tea Bd. of India v. Rep. of Tea, Inc.*, 80 U.S.P.Q.2d 1881, 1899 (T.T.A.B. 2006) ("A mark that is registered on the Principal Register is entitled to all Section 7(b) presumptions including the presumption that the mark is distinctive and moreover, in the absence of a Section 2(f) claim in the registration, that the mark is inherently distinctive for the goods."); *see also* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:43 (5th ed. 2021) (hereinafter "*McCarthy*") ("when the USPTO registers a mark without requiring evidence of secondary meaning ('acquired distinctiveness'), it is presumed to be inherently distinctive").

Nor are THE WALKING DEAD Marks generic. "A generic term is one that refers to the genus of which the particular product is a species." *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194, 224 U.S.P.Q. 327 (1985); *see also In re Weather Channel, Inc.*, 229 U.S.P.Q. 854, 855 (T.T.A.B. 1985) (THE WEATHER CHANNEL generic for a television channel concerning weather); *In re Ass'n of Energy Eng'rs, Inc.*, 227 U.S.P.Q. 76, 77 (T.T.A.B. 1985) (ASSOCIATION OF ENERGY ENGINEERS generic for an organization of engineers

specializing in the field of energy); *In re Cosmetic Factory, Inc.*, 208 U.S.P.Q. 443, 446 (T.T.A.B. 1980) (BODY SOAP generic for body shampoo). Here, Applicants offer no support for their assertion of genericness, *i.e.*, that the relevant public would actually understand THE WALKING DEAD or TWD to refer to a genus of the goods or services for which the marks are registered.

Finally, THE WALKING DEAD Marks have clearly acquired secondary meaning. Applicants do not submit evidence to contradict or otherwise dispute that THE WALKING DEAD Marks are widely recognized by the consuming public (55 TTABVUE 13-15), that Opposer has substantially advertised and promoted THE WALKING DEAD Marks (*id.* at 17), that THE WALKING DEAD Marks have received extensive press coverage and unsolicited placements in various media (*id.* at 17-19), and in fact, that this Board and the USPTO have found THE WALKING DEAD to be a famous mark (*id.* at 21-22.)

2. There is Not a “Crowded Field” of “THE WALKING DEAD” Marks

Applicants also assert that because “The Walking Dead” has been used in other films and literature, there is a “crowded field” of marks incorporating the term “the walking dead,” and this somehow renders Opposer’s THE WALKING DEAD Marks invalid. (60 TTABVUE 9-10.) As an initial matter, even if Applicants were correct that a crowded field of marks incorporating THE WALKING DEAD existed (and they are not), this would not serve to invalidate Opposer’s registered trademarks. Rather, the “crowded field” argument is only relevant to determining the *strength* of Opposer’s marks—not whether Opposer’s marks are protectable. *See 2 McCarthy* § 11:85 (discussing crowded trademark markets in the context of assessing trademark strength).

Moreover, none of the uses of “the walking dead” that Applicants reference can support Applicants’ claim that there is a crowded field of third parties using the term THE WALKING DEAD as a *trademark*. A person or entity makes use of a term as a “trademark” when he or she uses the term “in commerce . . . to identify and distinguish his or her goods.” 15 U.S.C. § 1127.

Applicants' reference to other uses of "the walking dead" do not constitute use *as a trademark* to identify the source of any goods or services. For instance, Applicants refer to the 1936 film *The Walking Dead* starring Boris Karloff (60 TTABVUE 9); this does nothing to establish third party use *as a trademark* since it is well-established that titles of single expressive works, such as a film, song, book and album, are not registerable as trademarks with the USPTO and cannot be protected as trademarks unless they have acquired secondary meaning. 2 *McCarthy* § 10:4. Applicants do not, of course, argue that these titles have achieved secondary meaning. As such, these are no *trademark* uses of "The Walking Dead" on record in this proceeding that serve to weaken the strength of Opposer's THE WALKING DEAD trademarks and they certainly do not rebut the presumption that Opposer's THE WALKING DEAD Marks are valid and protectable trademarks.⁶

C. Applicants' Claims of Misuse, Misrepresentation, Fraud, and Deceptive Practices Are Baseless

Applicants suggest in "Point II" of their brief that because they have been confused as to whether Mr. Kirkman or AMC owns THE WALKING DEAD Marks, Opposer has engaged in "misuse, fraud, and deception." (60 TTABVUE 15.) Applicants' claims should be rejected for several reasons.

As an initial matter, again, Applicants failed to properly plead a claim for fraud; thus, Point II should receive no consideration to the extent Applicants allege Opposer has committed fraudulent acts. As this Board has recognized, claims of fraud must be pled with heightened

⁶ The Board has explained that even evidence of third-party *registrations* for the same or similar marks are entitled to little weight where there is no evidence of actual commercial use of the marks or public recognition thereof. *See Gap (Apparel), LLC v. Gap One Enters., LLC*, Opp. No. 91172505, 2008 WL 3333842, at *5, 66 TTABVUE 15 (T.T.A.B. July 28, 2008) (rejecting applicant's "crowded field" argument and noting that "third-party registrations have little value in determining the issue of likelihood of confusion . . . because they do not prove that the registered marks are in commercial use or that the public is familiar with them").

particularity as required by Federal Rule of Civil Procedure 9(b). *See Gay Prof'l Men of Color v. CBE Pride*, Opp. No. 91252308, 2020 WL 2394376, at *4, 13 TTABVUE 7 (T.T.A.B. May 8, 2020) (“Opposer has failed to plead each of the required elements of fraud, let alone with the heightened particularity required by Rule 9(b).”). Applicant’s Answer states: “There is no likelihood of confusion AMC and Kirkman are committing fraud, unclean hands, and filed application in bad faith.” (24 TTABVUE ¶ 11.) Applicants’ pleading is entirely conclusory and does not identify any actual facts on which their fraud claim is based. Put simply, this pleading “is devoid of any factual allegations regarding [Opposer’s] knowledge of the purportedly false statement or of its intent to deceive the USPTO into issuing a registration to which it is not entitled.” *Gay Prof'l Men of Color*, 2020 WL 2394376, at *4, 13 TTABVUE 7. Since Applicants never properly pled fraud in this proceeding, Applicants’ fraud claim should receive no consideration. *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 U.S.P.Q.2d 1242, 1244 (T.T.A.B. 2015) (Board declined to hear unpleaded allegations relating to fraud).

Second, Applicants’ claim that Opposer has been “confusing Defendants as to who owned the mark in question” (60 TTABVUE 12) is plainly contradicted by the record in this proceeding. Beginning with Opposer’s Notice of Opposition filed in this proceeding on August 20, 2014, Opposer fully disclosed the licensor-licensee relationship that exists between Opposer and AMC.

The first two paragraphs of Opposer’s Notice of Opposition read:

Opposer is the owner of all rights in and to THE WALKING DEAD trademark (“Opposer’s Mark”) as used in connection with its series of comic books and graphic novels, and by Opposer’s licensee AMC Network Entertainment LLC (“AMC”), in connection with The Walking Dead television series (the “Series”). The Series, now in its fourth season of production, is the most watched drama in cable television history.

In addition, Opposer, through AMC, its corporate affiliates and sublicensees, have marketed an array of Series-related goods and services under Opposer’s Mark.

(1 TTABVUE ¶¶ 1-2.) Moreover, Opposer submitted testimonial declarations of Robert Kirkman and Stefan Reinhardt as well as a trial brief in which Opposer again explained the relationships at play: Mr. Kirkman formed Robert Kirkman, LLC to own all rights in the comics authored by him and the related indicia, including THE WALKING DEAD Marks. (37 TTABVUE ¶ 2; 55 TTABVUE 9-10). In 2009, Robert Kirkman, LLC entered into a license with AMC to create and produce a television series based on Mr. Kirkman's *The Walking Dead* comic series. (35 TTABVUE ¶ 7; 37 TTABVUE ¶ 21; 55 TTABVUE 12.) This license between Robert Kirkman, LLC and AMC granted AMC an exclusive right to use THE WALKING DEAD Marks in connection with *The Walking Dead* television series and related merchandise. (35 TTABVUE ¶ 8; 37 TTABVUE ¶ 22; 55 TTABVUE 12.) All of these facts have been made known to Applicants from the start of this proceeding seven years ago.

Third, Applicants point to the contents of copyright registrations for *The Walking Dead* comic books to suggest that Opposer has engaged in "deceptive" practices. (60 TTABVUE 12.) Again, as an initial matter, Applicants failed to submit any evidence during their testimony period regarding this claim. Moreover, Applicants' allegations pertaining to Opposer's copyright registrations should be dismissed out of hand because they fall far afield from the scope of this proceeding, which is pending before the United States Patent and Trademark Office, and does not involve copyright. The suggestion that the scope of Opposer's copyright registrations should have any bearing on the scope of Opposer's rights under their trademark registrations makes no sense. Moreover, Applicants' assertion that Opposer's claims in this proceeding are somehow invalid because Mr. Kirkman allegedly created content for some of THE WALKING DEAD comic book series with co-authors, namely Cory Walker, Ottley Ryan, Robert Kirkman, LLC, Tony Moore,

and Charlie Adlard, is not only factually incorrect, but also misunderstands basic copyright and trademark principles. (60 TTABVUE 12.)

According to Applicants, “had Kirkman and/or AMC disclosed that his/their work consisted of pre-existing third-party co-authors and materials, the Copyright Office may or may not have granted a registration covering Kirkman or AMC’s copyright material.” (60 TTABVUE 12.) First, the record in this proceeding is devoid of any evidence to support Applicants’ claim that Mr. Kirkman is not the sole author of THE WALKING DEAD comic book; but this is beside the point—even if there were co-authors of THE WALKING DEAD comic books for *copyright* purposes, that is entirely irrelevant for trademark purposes. While joint authors of a literary work who each contribute copyrightable material may claim to co-own the copyright in such work, this principle is not relevant to trademark rights. Trademark rights vest in the person or entity that *uses* a trademark in commerce to designate the source of his or her goods or services. 15 U.S.C. § 1127 (definition of “trademark”). Here, the record clearly establishes that Opposer and Opposer’s licensees and sublicensees have used THE WALKING DEAD Mark in commerce as a trademark since 2003. (55 TTABVUE 10-11; 38 TTABVUE 29 (Ex. PX 11, showing October 31, 2003 as the date of first use in commerce for Opposer’s U.S. Reg. No. 4,443,715).)

For these reasons, Applicants’ allegations of fraud, misrepresentation, or deception concerning the ownership of THE WALKING DEAD Marks are baseless, irrelevant to this case, and do nothing to refute the evidence of record in this proceeding regarding Opposer’s longstanding use and registration of THE WALKING DEAD Marks.

D. Applicants' Assertion of Priority Contradicts the Record Evidence

In "Point III" of their brief, Applicants claim to possess "senior rights to THE WALKING DEAD trademark having registered the first of Defendants trademarks with the USPTO on December 2, 2013." (60 TTABVUE 15.) Applicants' claim of seniority not only disregards the factual record in this proceeding but also ignores fundamental principles of trademark priority.

First, Applicants falsely suggest that they "registered" THE WALKING DEAD as a trademark on December 2, 2013. This is incorrect. Applicants *applied* to register THE WALKING DEAD on December 2, 2013 (App. Serial No. 86/133,235). (55 TTABVUE 23).

Second, Opposer properly made of record in this proceeding seven federal registrations for THE WALKING DEAD, three of which issued before the first of Applicants' Applications, which again, was filed on December 2, 2013. (U.S. Reg. Nos. 4,007,681, 4,314,918, and 4,429,084). (55 TTABVUE 19-20; 38 TTABVUE 12-27 (PX 8 – PX 10).) At the time Applicants filed their December 2, 2013 application for THE WALKING DEAD, AMC already owned three federal trademark registrations for THE WALKING DEAD for a wide array of good and services based on first use of the mark in interstate commerce in 2010, 2011 or 2012. (38 TTABVUE 12-27 (PX 8 – PX 10).) All three of these registrations were later assigned to Opposer in 2014. (*Id.*) As the assignee, Opposer owns these registrations and benefits from their first use dates in 2011, 2012, and 2013. *See 3 McCarthy* § 18:1 & n.1 (explaining that "[a]n 'assignment' of a mark is an outright sale of all rights in that mark" and that "[t]he assignee acquires all the ownership rights of the assignor and steps into the shoes of the assignor"). Moreover, Opposer itself filed an application to register THE WALKING DEAD for comic books on April 22, 2013 based on a first use of the mark in October 2003. (38 TTABVUE 29 (PX 11).) The filing date of this application

was more than seven months before Applicants filed their December 2, 2013 application, and the first use was 10 years prior to that.

Accordingly, Applicants' arguments do nothing to refute the factual record establishing Opposer's prior rights to THE WALKING DEAD Marks.

E. Applicants' Arguments Regarding Opposer's Use of The Registered Trademark Symbol Are Irrelevant and Without Merit

In "Point IV" of Applicants' brief, Applicants repeat the same argument they have previously advanced without success regarding Opposer's alleged misuse of the "® symbol" in connection with goods identified in an unregistered application.⁷ (60 TTABVUE 17.) Applicants' arguments fail—yet again—for several reasons.

First, Opposer's THE WALKING DEAD Marks are registered trademarks—and have been since August 2, 2011. Opposer owns *seven* federal registrations for THE WALKING DEAD Marks (55 TTABVUE 19-20.) Thus, Opposer has not placed the ® symbol next to a mark that is not federally registered. In particular, Opposer is the owner of U.S. Reg. No. 4,007,681, registered on August 2, 2011 for THE WALKING DEAD in International Class 41 for, *inter alia*, "entertainment services," with a first use date in October 2010. This registration grants Opposer the exclusive right to use THE WALKING DEAD mark for its entertainment property, which encompasses its use of imagery from the comics and television series on merchandise such as t-shirts, action figures, glassware and lighters. It is well-established that collateral merchandise is often licensed and sold in connection with entertainment properties such as Opposer's. *See In re Phillips-Van Heusen Corp.*, 228 U.S.P.Q. 949, 951 (T.T.A.B. 1986) ("The licensing of commercial trademarks for use on 'collateral' products (such as clothing, glassware, linens, etc.), which are

⁷ *See, e.g.*, March 16, 2015 Motion to Dismiss (7 TTABVUE 2-4); November 25, 2015 Motion to Dismiss (11 TTABVUE 2-4); May 26, 2017 Motion to Dismiss (20 TTABVUE 6-9); September 25, 2020 Motion for Summary Judgment (41 TTABVUE 9-13).

unrelated in nature to those goods or services on which the marks are normally used, has become a common practice in recent years.”); 2 *McCarthy* § 10:18 (“With the advent of mass-marketing of licensed merchandise marked with the titles and characters of motion pictures and television programs, consumers young and old are accustomed to assuming a licensing link between all such products and the associated movie or television program.”). As the USPTO remarked in rejecting a third-party’s attempt to register the mark FEAR THE WALKING DEAD, “it is common for providers of television shows and movies to also provide a variety of related goods and memorabilia.” (55 TTABVUE 31-32; 38 TTABVUE 77 (PX 20).) And as the Board noted in denying a registration for THE TOKING DEAD, “[i]t is common knowledge that famous marks are frequently used on collateral or merchandising products such as clothing, mugs and other consumer goods.” (55 TTABVUE 32; 38 TTABVUE 260 (PX 21).) Accordingly, there can be no question that Opposer’s registration for “entertainment services” entitled it to use THE WALKING DEAD for related merchandise and to note the mark’s registered status.⁸

Second, Applicants’ allegations are apparently grounded in the doctrine of unclean hands. (60 TTABVUE 17-18.) As the Board noted in its March 16, 2018 order denying this very argument asserted by Applicants in their May 26, 2017 motion to dismiss, “allegations of intent

⁸ The cases cited by Applicants in support of the proposition that Opposer’s “fraud, inequitable conduct, or violations of the duty [of] disclosure” renders Opposer’s registrations unenforceable are inapposite. (60 TTABVUE 21-22). Both *Chromalloy* and *Strong* are patent cases involving the application of 35 U.S.C. § 102(b), a statute that is inapplicable to trademarks. Moreover, in *Chromalloy*, defendants met their burden to establish that plaintiff’s patent was invalid, and therefore unenforceable, based on plaintiff’s affirmative misrepresentations which misled the patent examiner. *Chromalloy Am. Corp. v. Alloy Surfaces Co.*, 173 U.S.P.Q. 295, 305-07, 339 F. Supp. 859, 874-76 (D. Del. 1972). Likewise, in *Strong v. General Electric Co.*, 162 U.S.P.Q. 141, 144, 305 F. Supp. 1084, 1088 (N.D. Ga. 1969), *aff’d* 168 U.S.P.Q. 8, 434 F.2d 1042 (5th Cir. 1970), defendant established that plaintiff had fraudulently withheld a prior publication invalidating some of plaintiff’s claims. Neither *Chromalloy* nor *Strong* has any application here, where Applicants have not come close to meeting their burden of demonstrating that Opposer made a fraudulent statement or non-disclosure in applying for and obtaining their seven federal trademark registrations for THE WALKING DEAD Marks.

on the part of Opposer to deceive the public or of sufficient underlying facts from which such intent may reasonably be inferred” are required to adequately plead the unclean hands defense. (23 TTABVUE 7-8 (citing *Exergen Corp. v. Wal-Mart Stores, Inc.*, 91 U.S.P.Q.2d 1656, 1667, 575 F.3d 1312 (Fed. Cir. 2009)).) Because the Board found that Applicants had failed to meet the pleading requirement, the Board ordered Applicants’ unclean hands defense stricken, but allowed Applicants to replead their claim. (23 TTABVUE 8.) In Applicants’ subsequently filed Answer, they merely asserted that “AMC and Kirkman are committing fraud, unclean hands, and filed application in bad faith.” (24 TTABVUE ¶ 11.) Applicants’ naked allegations again failed to satisfy the pleading requirements for the defense of unclean hands. Accordingly, Applicants’ unclean hands defense should not be considered for this reason alone.

As the Board explained in its March 3, 2016 order (15 TTABVUE 3), to assert the affirmative defense of unclean hands, a defendant must demonstrate not only that the plaintiff has engaged in inequitable conduct, but that “the conduct relates to the subject matter of its claims.” *Fuddrucker, Inc. v. Doc’s B.R. Others, Inc.*, 4 U.S.P.Q.2d 1026, 1034, 826 F.2d 837, 847 (9th Cir. 1987). In other words, “misconduct in the abstract, unrelated to the claim in which it is asserted as a defense[,] does not constitute unclean hands.” *VIP Foods, Inc. v. V.I.P. Food Prods.*, 200 U.S.P.Q. 105, 113 (T.T.A.B. 1978). Here, Opposer’s alleged use or non-use of the ® symbol is entirely unrelated to the subject of this proceeding, *i.e.*, Applicants’ Applications and Registrations for marks that are likely to cause confusion with and dilution of Opposer’s THE WALKING DEAD Marks. Accordingly, Applicants’ unclean hands claim should be disregarded outright on this basis as well.

The cases cited by Applicants in support of their unclean hands defense are inapposite. *Kendall-Jackson* concerned application of the defense in the context of a malicious prosecution

action. *Kendall-Jackson Winery, Ltd. v. Super. Ct. of Stanislaus Cnty.*, 90 Cal. Rptr. 2d 743, 754 (Cal. Ct. App. 1999). Not only is this proceeding not an action for malicious prosecution, but here, unlike in *Kendall-Jackson*, there is no record evidence suggesting the improper conduct which Applicants allege. *See id.* at 747 (noting that defendant Kendall-Jackson had identified documents containing both direct and circumstantial evidence showing the unclean hands conduct which Kendall-Jackson alleged plaintiff engaged in). *Fladeboe* concerned a car dealer’s lawsuit against defendant manufacturer American Isuzu Motors, Inc. based on defendant’s alleged unreasonable refusal to consent to a dealership transfer under California Vehicle Code § 11713.3(d). *Fladeboe v. Am. Isuzu Motors Inc.*, 58 Cal. Rptr. 3d 225, 233 (Cal. Ct. App. 2007). Defendant asserted the unclean hands defense based on plaintiffs’ own violation of California Vehicle Code § 11713.3(d), which prohibited the transfer of a dealership without the manufacturer’s consent. *Id.* at 236. Again, unlike here, the record contained actual evidence that plaintiffs had acted inequitably by violating the same statute under which plaintiffs brought their claims. *Id.* In *Four Roses*, appellant labeled its goods with the words “Trade-Mark Reg. U.S. Pat. Off” despite the fact that “[t]he mark had not been registered.” *Four Roses Prods. Co. v. Small Grain Distilling & Drug Co.*, 29 F.2d 959 (D.C. 1928). By contrast, Opposer does own federal trademark registrations for THE WALKING DEAD Marks, and indeed has owned a registration for THE WALKING DEAD for “entertainment services” (among other goods and services) since August 2, 2011.

Put simply, Opposer is not now—and never has—used the ® symbol next to a mark for which it does not own a federal registration and, thus, it is not misusing the symbol, is not engaged in false advertising and does not have unclean hands. There is nothing about Applicants’

arguments in this regard that would suffice to invalidate Opposer's registered THE WALKING DEAD Marks.⁹

III. CONCLUSION

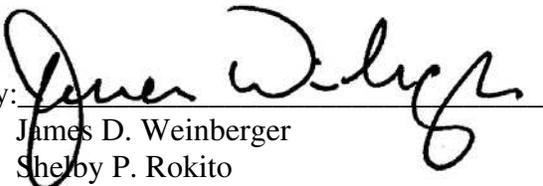
None of Applicants' arguments offer any refutation of Opposer's claims that Applicants' Applications and Registrations are likely to cause confusion with and to dilute THE WALKING DEAD Marks in violation of Sections 2(d) and 43(c) of the Lanham Act, 15 U.S.C. §§ 1052(d), 1125(c). Accordingly, based on the evidence of record in this proceeding and for the reasons set forth herein and in Opposer's Trial Brief, Opposer respectfully requests that the Applications be denied and the Registrations be cancelled and that final judgment for Opposer be entered in this proceeding.

⁹ Applicants also assert that Opposer acted improperly by amending Application Serial No. 86145914, which was originally filed on an intent to use basis, to allege a first use in commerce date that preceded Opposer's intent to use filing date. (60 TTABVUE 18.) As the Board explained in its March 3, 2016 order denying this very claim, "an intent-to-use applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use. *See* TMEP § 903 (October 2015). Accordingly, even if Applicants could base an unclean hands defense on Opposer's conduct in the prosecution of application Serial No. 86145914, the dates of use set forth in the amendment to allege use in that application would not appear to be a proper basis for an unclean hands defense." (15 TTABVUE 4.) Applicants' argument fails today for the same reasons it failed nearly five years ago.

Dated: December 31, 2021

Respectfully submitted,

FROSS ZELNICK LEHRMAN & ZISSU, P.C.

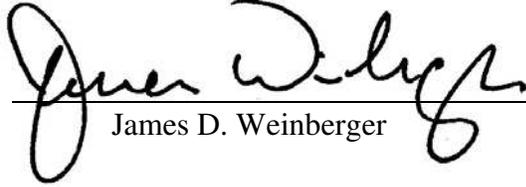
By: 
James D. Weinberger
Shelby P. Rokito

151 West 42nd St., 17th Floor
New York, New York 10036
(212) 813-5900
jweinberger@fzlz.com
srokito@fzlz.com

Attorneys for Opposer/Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on December 31, 2021, I caused a true and correct copy of the foregoing **REPLY TRIAL BRIEF FOR OPPOSER/PETITIONER** to be delivered to Applicants at the email address Weprinttheworld@gmail.com.


James D. Weinberger