

ESTTA Tracking number: **ESTTA999705**

Filing date: **09/04/2019**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	TURNER ENTERTAINMENT CO.
Granted to Date of previous extension	09/04/2019
Address	4000 WARNER BLVD BURBANK, CA 91522 UNITED STATES

Attorney information	Michael A. Grow Arent Fox LLP 1717 K Street, NW Washington, DC 20006 UNITED STATES tmdocket@arentfox.com, michael.grow@arentfox.com, chiara.giuliani@arentfox.com, teresa.myers@arentfox.com 2028576389
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Applicant Information

Application No	88255623	Publication date	05/07/2019
Opposition Filing Date	09/04/2019	Opposition Period Ends	09/04/2019
Applicant	Stone Pigman Walther Wittmann L.L.C. 909 Poydras Street, Suite 3150 New Orleans, LA 70112 UNITED STATES		

Goods/Services Affected by Opposition

Class 045. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Legal advice; Legal research; Legal services

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
Dilution by blurring	Trademark Act Sections 2 and 43(c)
Dilution by tarnishment	Trademark Act Sections 2 and 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2034720	Application Date	05/02/1994
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Registration Date	02/04/1997	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 1988/11/00 First Use In Commerce: 1988/11/00 [bed linens,] namely, [pillow cases,sheets, comforters and] blankets, table linens, namely, [tableclothes, napkins and place mats,] and towels		

U.S. Registration No.	2298902	Application Date	03/10/1998
Registration Date	12/07/1999	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark	WIZARD OF OZ		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 Printed matter and paper goods, namely,[books featuring characters from animated, action-adventure, comedy and/or drama features; comic books; children's books; magazines featuring characters from animated, action-adventure, comedy and/or drama features; coloring books; activity books;]stationery; writing paper and envelopes; notebooks; diaries; note cards; greeting cards; trading cards; lithographs; pens, pencils and cases therefor; erasers; crayons; markers; colored pencils; painting sets; chalk and chalkboards; decals; heat transfers; posters; photographs; book covers]; bookmarks; calendars; gift-wrapping paper; [paper party favors and paper party decorations, namely, paper napkins, paper doilies, paper place mats, crepe paper, paper hats, invitations, paper table cloths], paper cake decorations;[printed iron-on transfers for embroidery or fabric appliques; printed patterns for making costumes, pajamas, sweatshirts and T-shirts]		

U.S. Registration No.	2298903	Application Date	03/10/1998
Registration Date	12/07/1999	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark	WIZARD OF OZ		
Description of Mark	NONE		

Goods/Services	Class 028. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 Toys [and sporting goods,] including games and playthings, namely, [action figures and accessories therefor;] plushtoy; [balloons; bathtub toys; ride-ontoys; equipment sold as a unit for playing cards; toy vehicles;] dolls; [flying discs;] hand held unit for playing electronic games; a board game, [a card game, a manipulative game, a parlor game, a parlor-type computer game, an actiontype target game;] stand alone video output game machines; jigsaw and manipulative puzzles; [paper face masks; balls,namely, playground balls, toy bakeware and toy cookware,] toy banks and Christmas tree ornaments
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U.S. Registration No.	2284100	Application Date	03/31/1998
Registration Date	10/05/1999	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark	WIZARD OF OZ		
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 [luggage,] tote bags [, duffel bags,all-purpose sports bags, backpacks, waist packs, and umbrellas]		

U.S. Registration No.	2273098	Application Date	03/31/1998
Registration Date	08/24/1999	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1988/09/00 First Use In Commerce: 1988/09/00 [ice cream,] cakes, pastries [, breakfast cereals, and candy]		


U.S. Registration No.	2510837	Application Date	06/29/1998
Registration Date	11/20/2001	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 2000/08/30 First Use In Commerce: 2000/08/30 PICTURE FRAMES, MIRRORS,[PLASTIC KEY CHAINS, PLASTIC BIBS, BOOSTER SEATS,] POINT-OF-PURCHASE DISPLAYS [, HAND-HELD FANS, DECORATIVE MOBILES, ROOM DIVIDERS, SLEEPING BAGS AND SOFT SCULPTURE WALL DECORATIONS]		

U.S. Registration No.	2547649	Application Date	06/29/1998
Registration Date	03/12/2002	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 1998/12/31 First Use In Commerce: 1998/12/31 CUPS, MUGS, DRINKING GLASSES, DISHES, DECORATIVE GLASSWARE, [AND PORCELAIN ANDEARTHENWARE PLATES]		


U.S. Registration No.	2700697	Application Date	05/04/1999
Registration Date	03/25/2003	Foreign Priority Date	NONE
Word Mark	WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 1998/10/09 First Use In Commerce: 1998/10/09 [Entertainment services in the nature of live drama or comedy shows, or a series of prerecorded television shows; amusement park services; amusements, namely,rides and arcades;] providing entertainment and/or recreation information by means of a global computer network [; entertainment fan club services; all of the foregoing] related to the film "The Wizard Oz" and/or the characters contained therein		


U.S. Registration No.	4444093	Application Date	04/21/2010
Registration Date	12/03/2013	Foreign Priority Date	NONE
Word Mark	THE WIZARD OF OZ		
Design Mark			
Description of Mark	The mark consists of the words "THE WIZARD OF OZ" with a pair of shoes within the "O" of the word "OZ".		
Goods/Services	Class 003. First use: First Use: 2013/09/01 First Use In Commerce: 2013/09/01		

	Cosmetics, namely, lipstick, lip gloss and non-medicated lip balm; make-up kits comprised of lip gloss and lip balms; mascara; nail enamel; face powder, face cream, skin lotion and skin gel; body powder; bath oil, bath gel and non-medicated bath salts; hand cream and lotion; body cream and lotion; sunscreen preparation, namely, cream and lotion; shaving cream and after-shave lotion, skin cleanser and non-medicated body soaks; body deodorant, cologne and perfume; soaps, namely, liquid bath soap, gel soap and bar soap; detergent soap, namely, liquid and powder; fabric softener; deodorant soap, skin soap; and shampoo and shampoo conditioner
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U.S. Registration No.	4549029	Application Date	05/07/2013
Registration Date	06/10/2014	Foreign Priority Date	NONE
Word Mark	THE WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 2013/09/13 First Use In Commerce: 2013/09/13 Table and desk lamps, electric night lights, flashlights, electric lighting fixtures, and lamp shades; electric toasters		

U.S. Registration No.	4589723	Application Date	05/08/2013
Registration Date	08/19/2014	Foreign Priority Date	NONE
Word Mark	THE WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 2013/07/13 First Use In Commerce: 2013/07/13 Salt and pepper shakers; dinnerware, namely, plates, cups and saucers; cookie cutters		

U.S. Registration No.	4657004	Application Date	05/07/2013
Registration Date	12/16/2014	Foreign Priority Date	NONE
Word Mark	THE WIZARD OF OZ		
Design Mark			
Description of Mark	The mark consists of the wording "THE WIZARD OF OZ" in white, outlined in gold and black, and red shoes with a white interior located within the letter "O" of the word "OZ".		
Goods/Services	Class 011. First use: First Use: 2013/09/16 First Use In Commerce: 2013/09/16 Table and desk lamps, electric night lights, flashlights, electric lighting fixtures, and lamp shades; electric toasters		

U.S. Registration No.	5676435	Application Date	12/19/2017
Registration Date	02/12/2019	Foreign Priority Date	NONE
Word Mark	THE WIZARD OF OZ		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 028. First use: First Use: 2011/01/01 First Use In Commerce: 2011/01/01 Gaming machines, namely, devices which accept a wager; Reconfigurable casino and lottery gaming equipment, namely, gaming machines and operational computer games software therefor sold as a unit		

Attachments	75447786#TMSN.png(bytes) 75447790#TMSN.png(bytes)
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	75459668#TMSN.png(bytes) 85019592#TMSN.png(bytes) 85925739#TMSN.png(bytes) 85926877#TMSN.png(bytes) 85925755#TMSN.png(bytes) 87727383#TMSN.png(bytes) Turner v. Stone Pigman - notice of opposition.pdf(201975 bytes)
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Signature	/Michael A. Grow/
Name	Michael A. Grow
Date	09/04/2019

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

In re Application No. 88/255,623 WIZARD OF OZ, published on May 7, 2019

TURNER ENTERTAINMENT CO.	:	
	:	
Opposer	:	
	:	
v.	:	Opp. No. _____
	:	
STONE PIGMAN WALTHER WITTMANN L.L.C.	:	
	:	
	:	
Applicant	:	

NOTICE OF OPPOSITION

Opposer Turner Entertainment Co. believes that it will be damaged by the registration of the above identified mark and hereby opposes the same in all classes under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for the opposition, it is alleged that:

1. Opposer is the owner of all right, title and interest in and to a family of marks containing the words “WIZARD OF OZ” (collectively, “Opposer’s Marks”), which have been used and registered for decades in connection with a wide variety of goods and services.
2. Opposer’s Marks are derived from Opposer’s extraordinarily famous motion picture, *The Wizard of Oz*, which was released in 1939.
3. The *Wizard of Oz* is one of the most well-known and beloved films ever made and it has been recognized by the American Film Institute as one of the 10 Best Movies of All Time.
4. Opposer’s motion picture is televised annually on various cable and television stations throughout the country and millions of *Wizard of Oz* videos and DVDs have been sold.

5. Because of its many television showings, *The Wizard of Oz* has been recognized by the Library of Congress as having been seen by more viewers than any other film.

6. Like many companies in the motion picture business, Opposer has developed a very successful merchandising business through which it sells and licenses others to sell a wide variety of products and services under marks derived from its movies.

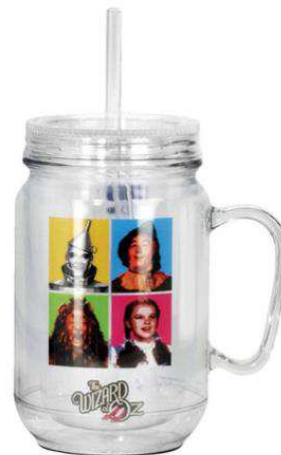
7. Consumers are well aware of the fact that motion picture companies sell merchandise under marks derived from the movies and many seek such items because of their interest in such movies. Examples of goods sold under Opposer's Marks are shown below.



Wizard Of Oz Yellow Brick Road Koozie



Wizard Of Oz Ceramic Travel Mug



Wizard Of Oz Straw Tumbler

8. Since long prior to the acts complained of in this notice, Opposer has established common law rights in Opposer's Marks and other marks derived from *The Wizard of Oz* movie,

directly or through its related companies and licensees, by continuously using the marks on a wide variety of products.

9. Opposer's Marks have become well known and famous through extensive publicity and sales over a period of many decades.

10. The Patent and Trademark Office has recognized Opposer's exclusive rights by issuing many registrations for Opposer's Marks, including:

- (a) Registration No. 2034720, WIZARD OF OZ for goods in Class 24, issued on February 4, 1997
- (b) Registration No. 2298902, WIZARD OF OZ for goods in Int. Class 16, issued on December 7, 1999
- (c) Registration No. 2298903, WIZARD OF OZ for goods in Int. Class 28, issued on December 7, 1999
- (d) Registration No. 2284100 WIZARD OF OZ for goods in Int. Class 18, issued on October 5, 1999
- (e) Registration No. 2273098 WIZARD OF OZ for goods in Int. Class 30, issued on August 24, 1999
- (f) Registration No. 2510837 WIZARD OF OZ for goods in Int. Class 20, issued on November 20, 2001
- (g) Registration No. 2547649 WIZARD OF OZ for goods in Int. Class 21, issued on March 12, 2002
- (h) Registration No. 2700697 WIZARD OF OZ for services in Int. Class 41, issued on March 25, 2003
- (i) Registration No. 4444093 THE WIZARD OF OZ & Design for goods in Int. Class 3, issued on December 3, 2013
- (j) Registration No. 4549029 THE WIZARD OF OZ for goods in Int. Class 11, issued on June 10, 2014
- (k) Registration No. 4589723 THE WIZARD OF OZ for goods in Int. Class 21, issued on August 19, 2014

- (l) Registration No. 4657004 THE WIZARD OF OZ & Design for goods in Int. Class 11, issued on December 16, 2014
- (m) Registration No. 5676435 THE WIZARD OF OZ for goods in Int. Class 28, issued on February 12, 2019

11. These registrations are valid and subsisting, and many of them are incontestable, providing prima facie and conclusive evidence of Opposer's ownership of, and exclusive right to use, Opposer's Marks in commerce.

12. Numerous companies have been licensed to distribute products bearing Opposer's Marks.

13. The fame of Opposer's Marks has increased over the many decades during which the marks have been publicized through annual television broadcasts of the famous *The Wizard of Oz* motion picture and through the sale of products, through retail outlets and various online stores owned by Opposer or its related company Warner Bros. See, e.g. www.tcm.com, www.wbshop.com, www.amazon.com and www.walmart.com

14. A substantial investment has been made in advertising and promoting goods and services sold under Opposer's Marks and the marks have become famous and very valuable symbols of Opposer's goodwill.

15. Opposer has built extensive common law rights and goodwill in its Marks and they have become well known and famous as distinctive indicators of the origin of Opposer's goods and they symbolize Opposer's valuable goodwill.

16. Since the first use of Opposer's Marks, Opposer and/or its related companies have distributed products bearing Opposer's Marks throughout the United States pursuant to agreements under which Opposer controls the nature and quality of the goods.

17. Unlike those companies that have been duly authorized to use Opposer's Marks, Applicant has never sought nor obtained a license to use any of Opposer's Marks on any goods or services.

18. Notwithstanding Opposer's prior established rights in its Marks, Applicant filed Application S/N 88255623 seeking registration of the identical mark WIZARD OF OZ for "Legal advice; Legal research; Legal services," in Class 45, based on an intent to use.

19. Upon information and belief, Applicant made no use of its alleged mark in commerce prior to the filing date of its application.

20. Upon information and belief, Applicant knew of Opposer's Marks when Applicant filed the application for registration.

21. Upon information and belief, Applicant adopted the mark WIZARD OF OZ with a deliberate intent to cause confusion and to profit from the enormous goodwill established by Opposer through continuous use of Opposer's Marks in interstate commerce since long prior to the filing date of Applicant's application.

22. Likelihood of confusion is enhanced in this case by the fact that Applicant's alleged mark is identical to Opposer's WIZARD OF OZ Marks.

23. Upon seeing Applicant's mark, members of the public are likely to be misled into believing that Applicant has obtained a license or endorsement or approval from Opposer, when that is not the case.

LIKELIHOOD OF CONFUSION - §2(d)

24. The mark that Applicant seeks to register is identical to or so resembles Opposer's Marks that the use and registration thereof is likely to cause confusion, mistake and deception as

to the source or origin of Applicant's services and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer's Marks.

25. The public is likely to be confused, to be deceived, and to assume erroneously that Applicant's services are those of Opposer or that Applicant is in some way connected with, licensed or sponsored by, or affiliated with Opposer.

26. Likelihood of confusion is enhanced by the fact that the mark identified in Applicant's application is identical to Opposer's WIZARD OF OZ Marks.

27. Likelihood of confusion is enhanced in this case by the fact that Opposer's Marks have been used for decades on a wide variety of goods and services.

28. Likelihood of confusion is enhanced by the fame of Opposer's Marks and by the fact that consumers associate said mark with goods and services sold, approved or endorsed by Opposer.

29. Likelihood of confusion is further enhanced by the fact that prospective purchasers of Applicant's services are also prospective purchasers of products sold under Opposer's Marks.

30. Likelihood of confusion may be presumed in this case because Applicant obviously adopted an imitation of Opposer's Marks in bad faith with an intent to cause confusion, with an intent to profit from the popularity of Opposer's Marks, and to induce purchasers to believe that Applicant's services originate with or are licensed or endorsed by Opposer.

DILUTION - §43(c)

31. For many years, Opposer's Marks have been widely used and publicized throughout the United States and, therefore, Opposer's Marks have become well known and famous as distinctive symbols of Opposer's goodwill.

32. On information and belief, Applicant is planning to use its alleged mark in commerce with a willful intent to trade on Opposer's reputation or to cause dilution of Opposer's famous Marks through blurring and tarnishment.

33. Opposer's Marks became well known and famous before Applicant made any use of its alleged mark, and before Applicant filed any application to register this alleged mark.

34. The alleged mark shown in Applicant's application will cause dilution of the distinctive quality of Opposer's Marks.

35. Use or registration of Applicant's alleged mark will lessen the capacity of Opposer's famous Marks to identify and distinguish Opposer's goods.

36. Likelihood of confusion, dilution, and deception is enhanced by the fact that Applicant's alleged mark is virtually identical to Opposer's Marks.

37. Use and registration of the alleged mark by Applicant will deprive Opposer of the ability to protect its reputation, persona, and goodwill.

38. Applicant's use or registration of WIZARD OF OZ for the services listed in its application will tarnish the goodwill symbolized by Opposer's Marks.

39. Likelihood of tarnishment and damage to Opposer's goodwill is enhanced by the fact that Opposer has no control over the nature and quality of any goods or services sold under Applicant's alleged mark, and prospective customers who encounter defects in the quality of

Applicant's goods or services will attribute those defects to Opposer and this will tarnish Opposer's goodwill.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied.

TURNER ENTERTAINMENT CO.



Date: 09/04/2019

By: _____

Michael A. Grow
Elizabeth H. Cohen
Chiara Giuliani
Arent Fox LLP
1717 K Street, NW
Washington, DC 20006
(202) 857-6389

Attorney for Opposer