

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: May 27, 2003

Opposition No. **91119790**

TIME WARNER ENTERTAINMENT
COMPANY L.P.

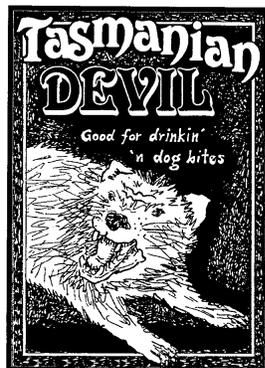
v.

STEINBECK BREWING COMPANY,
INC. DBA BUFFALO BILL'S
BREW PUB

Before Hanak, Hairston and Bottorff, Administrative
Trademark Judges.

By the Board:

On August 11, 2000, opposer, Time Warner Entertainment
Company L.P., filed an opposition against registration of
the design mark reproduced below for "beer and ale":¹



¹ Application Ser. No. 75/813,747, filed October 4, 1999; first
use in commerce alleged as of June, 1985.

In the notice of opposition, opposer alleges that the mark so resembles opposer's previously-used and registered TASMANIAN DEVIL marks for motion picture, video and television films featuring animation and/or music² as to cause confusion, mistake, or deception among purchasers. Opposer also alleges that applicant's mark is deceptive under Section 2(a) of the Trademark Act; that applicant's mark is primarily geographically descriptive or deceptively misdescriptive under Sections 2(e)(2) and 2(e)(3) of the Act; that applicant's mark dilutes the distinctive quality of opposer's marks under Section 43(c); that applicant's use of its mark is unlawful under United States Food and Drug Administration and Bureau of Alcohol, Tobacco and Firearms regulations; and that applicant committed fraud at the time of filing its application by signing a false declaration.

On February 19, 2002, the Board granted opposer's motion for leave to amend its notice of opposition. The amended opposition claimed, in addition to restating the above claims, that "Applicant has admitted that it is not

² Opposer alleges ownership of three registrations for the mark TASMANIAN DEVIL; two registrations for the TASMANIAN DEVIL Design mark; and two registrations for the mark TAZ.

The most pertinent of these are the three registrations for the mark TASMANIAN DEVIL:

Reg. No. 1,836,849; which covers "t-shirts and dorm shirts"; registered May 17, 1994; Section 8 and 15 affidavit accepted and acknowledged;

Reg. No. 1,998,467; which covers various goods in Class 28; registered September 3, 1996; and

Reg. No. 2,033,589; which covers various goods in Class 16; registered January 28, 1997.

the owner of the mark sought to be registered. Accordingly, the opposition should be sustained because the application is void ab initio." *Amended Notice of Opposition*, paragraph 25. In answer to paragraph 25 of the amended notice, applicant states that "Applicant admits that it was the exclusive licensee of the mark at the time of filing the application." *Answer to Amended Notice of Opposition*, p. 4. Applicant denies the remaining salient allegations of the complaint.

On October 15, 2002, opposer filed a motion for summary judgment on five of the pleaded grounds in the notice of opposition: ownership, deception, geographic descriptiveness (or misdescriptiveness), and fraud. Applicant filed a response to opposer's motion for summary judgment, and opposer filed a reply brief.

Opposer also filed a cross-motion to strike applicant's response as being untimely. While applicant's response is technically untimely by six days, because it aids in our understanding of the issue of ownership of applicant's mark, we have considered applicant's response. Accordingly, opposer's motion to strike is denied.

In its response to opposer's motion for summary judgment, applicant makes the following statement:

Applicant, Steinbeck Brewing Company, Inc. dba Buffalo Bill's Brewpub, hereby stipulates to the entry of a Motion for Summary Judgment, without prejudice, pursuant to the undisputed fact that

the Applicant was a licensee of the mark TASMANIAN DEVIL and Design which were (sic) the subject of Applicant's Application to register said mark and Design. Applicant mistakenly believed that Applicant's right pursuant to the License Agreement by and between Applicant and the owner of the mark TASMANIAN DEVIL provided sufficient authority for the Applicant to file for the subject registration.

Applicant "both generally and specifically opposes those other portions of the Opposer's motion for summary judgment" that allege that the mark is deceptive or geographic, or that applicant committed fraud on the Office. *Applicant's Stipulation to Opposer's Motion for Summary Judgment (on Specified Grounds) and Partial Opposition in Connection Therewith (Specified Grounds)*, pp. 1-2.

If an applicant does not own an applied-for mark on the application filing date, the application is void. See Trademark Rule 2.71(d); *Huang v. Tzu Wei Chen Food Co. Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988); and TMEP §1201.02(b). Applicant has indicated that it was not the owner of the mark when it filed the application. Thus, as a matter of law, the application is void. Summary judgment is appropriate where the movant has established that there is no genuine issue of material fact in dispute, thus leaving the case to be resolved as a matter of law. Fed. R. Civ. P. 56(c). In this case, there is no genuine issue of material fact in dispute on the issue of ownership of the mark.

Accordingly, opposer's motion for summary judgment on the pleaded issue of ownership is granted; the remaining pleaded issues upon which opposer's motion is based, as well as the remaining pleaded issues in the notice of opposition, are moot; the opposition is hereby sustained and registration to applicant is refused.

-o0o-