

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Goodman

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THE TTAB**

Mailed: January 21, 2010

Opposition No. 91189827

Missing Cougar Company

v.

Edgar Rice Burroughs, Inc.

Before Hairston, Cataldo and Bergsman, Administrative
Trademark Judges.

By the Board:

Edgar Rice Burroughs, Inc. ("applicant") has filed an application to register the mark JOHN CARTER OF MARS in standard character form for goods and services in International Classes 9, 16, 25, 28 and 41.¹ Missing Cougar Company ("opposer") has opposed registration in Class 28²

¹ Application Serial No. 77263965, filed August 24, 2007 asserting intent to use the mark under Section 1(b) of the Trademark Act.

² Applicant's Class 28 goods are as follows: "Mechanical and electric action toys; toy water globes; bath toys; bendable toys; children's multiple activity toys, construction toys; drawing toys; fantasy character toys; inflatable toys; non-riding transportation toys; party favors in the nature of small toys; rubber and plastic character toys; plush toys; pop up toys; ride-on toys; sand toys; squeeze toys; talking toys; water squirting toys; toy vehicles; toy weapons; toy animals; collectable toy figures; disc toss toys; flying discs; punching toys; toy model hobbycraft kits; wind up toys; hand held unit for playing electronic games; hand held unit for playing video games; trading card games; action skill games; arcade games; board games; card games; stand alone video game machines; paddle ball games; parlor games; party games; pinball games; role playing games; target games; dolls; puzzles; beach balls; sport balls; skateboards; toy

only on the grounds that applicant lacks a bona fide intent to use the mark in commerce and fraud.³

In its answer, applicant denies the salient allegations in the notice of opposition.

This case now comes up on applicant's motion for summary judgment on the lack of a bona fide intent to use the mark in commerce and fraud grounds. Applicant's evidence on summary judgment consists of the declarations, with related exhibits, of James J. Sullos, President of applicant (Sullos declaration), David Donahue, counsel for applicant, and the supplemental declarations, with related exhibits, of James J. Sullos (supplemental Sullos declaration) and David Donahue. Opposer's evidence on summary judgment consists of the declaration, with related exhibits, of Stephen Ruwe, President of opposer.

scooters; play tents; toy watches; costume masks; Christmas tree ornaments; playing cards."

³ Opposer's prayer for relief seeks refusal of registration for all classes of goods and services of the involved application. However, the ESTTA coversheet references Class 28 as the opposed class and opposer has paid the fee to oppose only Class 28. We note too in the notice of opposition that opposer's claim of damage relates to Class 28 only (preamble notice of opposition) as do its allegations in paragraphs 1 and 2 of the notice of opposition. Because opposer paid the fee to oppose only one class, the other classes remain unopposed. TBMP Section 308.01 (2d ed. rev. 2004). We note in any event that an entire application will not be deemed void for lack of a bona fide intention to use the mark on some, but not all, of the goods or services identified in an application. *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1633 (TTAB 2007). Similarly, a finding of fraud in one class does not subject the entire application to refusal as the application is void only in the class in which fraud has been committed. *G&W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1573 (TTAB 2009).

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material fact and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). In reviewing a motion for summary judgment, the evidentiary record and all reasonable inferences to be drawn from the undisputed facts must be viewed in the light most favorable to the nonmoving party. *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). The Board may not resolve issues of material fact; it may only ascertain whether such issues are present. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

The following facts asserted in the Sullos declaration are not disputed by opposer.

1. Applicant was created by author Edgar Rice Burroughs ("Burroughs") to conduct the business of licensing rights to his literary creations which include the JOHN CARTER OF MARS series and TARZAN. Sullos declaration, paragraph 7.
2. Applicant and Disney have a license agreement with respect to applicant's TARZAN property and mark for Class 28 goods. Sullos Declaration paragraph 36.
3. Burroughs' TARZAN character and Disney's TARZAN movie and musical "have spawned a wide range of TARZAN related merchandise" in Class 28. Sullos declaration paragraphs 17 and 36.
4. Burroughs and applicant "have at all times owned all existing copyrights in the JOHN CARTER OF MARS series in the U.S. and other countries. Six of the eleven books in the JOHN CARTER OF MARS series are still

protected under U.S. copyright. Sullos declaration, paragraph 13.

5. The JOHN CARTER OF MARS mark appeared on "several Big Little Books" in the 1930s and 1940, appeared in "various licensed comic books" in 1952-1953, 1972-1973, 1977-1979 and the 1990s, was licensed for action figures and play sets in 1995⁴, and has been used in connection with a website since 2004.⁵ Sullos declaration paragraphs 19-22.
6. In the 1930s and 1980s, applicant entered into agreements to license the "stories, character collateral merchandise, and other indicia in connection with a major motion picture" for the JOHN CARTER OF MARS series but the projects were shelved. Sullos declaration paragraphs 23-24.
7. In 2001, applicant entered into a deal with Paramount to make a motion picture based on the JOHN CARTER OF MARS series and applied with the Office to register the JOHN CARTER OF MARS mark (application Serial no. 78139064) in connection with various goods and services, including the Class 28 goods at issue herein. Sullos declaration paragraphs 25-27.
8. In August 2006, Paramount decided not to exercise its rights to make a movie based on the JOHN CARTER OF MARS series and the rights reverted to applicant; applicant allowed the JOHN CARTER OF MARS application (Serial No. 78139064) for goods and services in various classes including International Class 28 to abandon because applicant was not able to make use of the JOHN CARTER OF MARS mark during the statutory period. Sullos declaration paragraphs 27 and 29.
9. Applicant continued to seek licensing opportunities for the JOHN CARTER OF MARS series and mark, and in early August 2007 applicant entered into an "option

⁴ Applicant entered into a licensing agreement with Friedlander Publishing Group ("FPG") effective July 1, 1995 through December 31, 2000 by which FPG had the right to manufacture and sell card games, trading cards, stickers and calendars under the following marks: JOHN CARTER WARLORD OF MARS, BARSOOM and TARZAN. Supplemental Sullos declaration paragraph 6.

⁵ Applicant owned registrations for the marks JOHN CARTER and BARSOOM for comic books which registrations were allowed to expire in January 2008 because licensee Dark Horse Comics was no longer using the marks in connection with comic books. Supplemental Sullos declaration paragraphs 2-5.

and rights" agreement with Disney ("Disney agreement") to make motion pictures based on the JOHN CARTER OF MARS series. Sullos declaration, paragraphs 29-30.

10. Two weeks after entering into the Disney agreement, on August 24, 2007, applicant filed the involved JOHN CARTER OF MARS intent to use application (Serial no. 77263965). Sullos declaration paragraph 35.
11. At the end of 2008, Disney exercised its option and commenced pre-production of the first film based on the JOHN CARTER OF MARS series. Sullos declaration paragraph 31.
12. The Disney Agreement grants Disney "the right to create or license 'merchandise and commodities of every nature and description' including all manner of 'toys' and 'games'" in connection with the JOHN CARTER OF MARS movie. Sullos declaration paragraph 33.
13. The Class 28 goods identified in the involved application are closely related to the goods applicant and Disney licensed in connection with applicant's Tarzan property. Sullos declaration paragraph 36.
14. Applicant retained the right under the Disney Agreement to license its own merchandise, including toys and games, under the JOHN CARTER OF MARS mark. Sullos declaration paragraph 34.
15. On November 1, 2008, applicant entered into additional license agreements with the toy company Triad Toys, Inc. for the manufacture and sale of action figures. Sullos declaration paragraph 37.

Whether applicant had a bona fide intent to use the mark in commerce at the time of filing the involved application?

In support of its motion for summary judgment that it had the requisite bona fide intent to use the mark in commerce in Class 28, applicant asserts that its bona fide intent is substantiated by applicant's entering into a "major motion picture agreement with Disney two weeks before

filing the Application" and by its documentary evidence and corroborating declaration that establish that the Disney agreement includes "a broad grant of merchandising rights with respect to toys and games of every kind under the JOHN CARTER OF MARS Mark." Applicant further submits that its past activities of licensing to others the use of the JOHN CARTER OF MARS mark on goods in International Class 28, namely "action figures and play sets" as well as licensing activities with regard to its TARZAN property previously licensed by applicant and Disney in connection with Class 28 goods further establishes its bona fide intent to use the JOHN CARTER OF MARS mark in commerce.

Applicant has also submitted evidence of Disney's past use of other marks in connection with the identified Class 28 goods as providing "further objective indisputable evidence" of applicant's bona fide intent to use the mark on the Class 28 goods. Lastly, applicant submits that the licensing agreement with Triad Toys Inc. for the manufacture and sale of action figures further evidences its bona fide intention to use the mark on Class 28 goods.

In response, opposer submits that the Disney and Triad Toys agreements "are not valid with regard to the mark 'JOHN CARTER OF MARS'" and "should not serve . . . as persuasive evidence of Applicant's bona fide intent to use the mark" arguing that "Applicant had no exclusively held rights in

the mark 'JOHN CARTER OF MARS' at the time it purportedly entered into the agreement" and additionally, the Triad Toys agreement "should not be given evidentiary consideration" as it was not contemporaneous to the filing of the involved application and lacks consideration.

Opposer also contends that applicant's filing, abandonment and subsequent refiling of the JOHN CARTER OF MARS application as well as maintaining overlapping applications for the JOHN CARTER OF MARS mark rather than withdrawing or abandoning the earlier filed JOHN CARTER OF MARS application prior to the filing of the subject intent to use application raises genuine issues of material fact. Opposer submits that these actions by applicant "thwart[s] the intent to use provisions set forth by Congress" by reserving rights in the mark and using the system to traffic in marks.

Opposer further argues that genuine issues of material fact remain because applicant has not established its intent to use the JOHN CARTER OF MARS mark on card games and applicant would not have been able to use the JOHN CARTER OF MARS mark during the statutory time period (if this opposition had not been filed) due to the release date of the JOHN CARTER OF MARS movie in 2012. Opposer also claims that applicant's actions of filing applications for PRINCESS OF MARS, TARS TARKAS, and DEJAH THORIS coupled with the

Disney agreement evidence applicant's attempts to reserve "a variety of desirable trademarks allegedly intended to be used on a single product line," thereby raising genuine issues regarding applicant's intent.

In reply, applicant asserts that opposer's arguments regarding the validity of the Disney and Triad agreements are without merit as there is no dispute as to applicant's ownership of trademark rights in the JOHN CARTER OF MARS mark. Applicant points out that opposer has not disputed that applicant owned a registration for JOHN CARTER, had common law trademark rights in the JOHN CARTER OF MARS mark, owned the copyright of JOHN CARTER OF MARS, and had a pending application for JOHN CARTER OF MARS on the effective date of the Disney agreement. Applicant also asserts that the fact that it entered into agreements with Disney and Triad Toys is sufficient to establish applicant's bona fide intent to use the mark and "the Board need look no further . . . to grant summary judgment."

Applicant has further supported its motion to show in the late 1990s, applicant licensed a United States company to use a variant of its JOHN CARTER OF MARS mark for use in connection with card games in the United States and that Disney has engaged in the use of various marks in connection with card games in United States commerce. Applicant argues that its filing of related applications for PRINCESS OF

MARS, TARS TARKAS and DEJAH THORIS is not evidence that applicant engaged in the practice of filing intent to use applications for several trademarks intended to be used on a single product as these story and/or character names relate to the JOHN CARTER OF MARS series and applicant "expects these marks to appear on products and packaging for the same types of movie-related merchandise" for the Disney JOHN CARTER OF MARS movie.

With regard to its earlier filed and abandoned JOHN CARTER OF MARS application, applicant submits that it provided "legitimate circumstances that led to its need to file second applications for JOHN CARTER OF MARS . . . namely, Paramount's decision not to exercise its option after years of development of a prior JOHN CARTER OF MARS project, and Disney's subsequent decision to enter into an option agreement for the same rights" noting that opposer has not offered "any evidence to the contrary." Applicant points out that "it is common knowledge [in the motion picture industry] . . . that options are not picked up and movies are sometimes abandoned during pre-production or even production, causing rights to revert to their original owners . . . who must shop their rights to another studio." Applicant also argues that opposer's "self invented theory" regarding the timetable for proving use "finds no support in the law" and "contravenes Congress's directive that the

determination of whether a bona fide intention to use a mark exists should be based on the standards of the particular industry involved.”

Whether an applicant has a bona fide intention to use the mark in commerce is based on a fair, objective determination of all of the circumstances. *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1356 (TTAB 1994). In determining the sufficiency of documentary evidence demonstrating bona fide intent, the focus is on the entirety of the circumstances, as revealed by the evidence of record.” *Id.*

In this case, after reviewing the evidence and arguments submitted by the parties on summary judgment, we find that applicant’s documentary evidence and submissions establish no genuine issue of material fact exists and that, as a matter of law, applicant had the requisite bona fide intention to use its mark in commerce on Class 28 goods as of the application filing date. While opposer has submitted documentary evidence, none of the evidence submitted raises a genuine issue regarding applicant’s bona fide intent to use the involved mark in commerce. *See Honda Motor Co. v. Winkelmann*, 90 USPQ2d 1660, 1664 (TTAB 2009) (mere conclusory allegations or speculation in response brief are not enough to survive summary judgment, to raise a genuine

issue a party must offer some evidence of record regarding applicant's bona fide intent).

First, applicant's claimed bona fide intention to use its mark in commerce on the Class 28 goods is corroborated by the Disney and Triad Toys agreements. Despite opposer's arguments to the contrary, applicant's ownership in the JOHN CARTER OF MARS mark or its variants is undisputed and the agreements are relevant evidence with respect to whether applicant had a bona fide intent to use the JOHN CARTER OF MARS mark.

The Disney agreement was entered into two weeks prior to the filing of the involved JOHN CARTER OF MARS application which is sufficiently contemporaneous to serve as corroboration for the declaration asserting applicant's bona fide intent. The Disney agreement comprehensively covers the Class 28 goods under the JOHN CARTER OF MARS application, specifically mentioning JOHN CARTER OF MARS as one of the marks it will apply to merchandise and providing for the manufacturing, selling, furnishing, licensing, supply and distribution of unlimited types of merchandise and commodities of every nature ". . . including but not limited to . . ." toys and games.

Additionally, the evidences establishes that applicant has spent many years licensing or attempting to license the JOHN CARTER OF MARS mark or variants on various goods and

services, including Class 28 goods (and including card games), over various periods of time since the 1930s to the present which is supportive of applicant's bona fide intent to use the mark. Thus, applicant's claim of bona fide intention is corroborated by its agreement with Disney for the JOHN CARTER OF MARS mark especially in view of applicant's prior successful use of that same strategy in connection with applicant's TARZAN mark. Applicant's prior licensing activities with Disney with regard to its TARZAN property/mark also supports its bona fide intent to use the JOHN CARTER OF MARS mark on Class 28 goods as such licensing agreement included use of the TARZAN mark on Class 28 goods. In this regard, we note that the evidence establishes that Disney has the capability to merchandise such goods under Class 28 (including card games), having done so under the parties' prior licensing agreement with respect to applicant's TARZAN mark as well as with its own Disney marks in connection with other movies that Disney has produced.

Similarly, the Triad Toys agreement provides for the licensing of JOHN CARTER OF MARS action figures and offers further support for applicant's bona fide intent to use the mark in Class 28. While the Triad Toys agreement was entered into fifteen months after the filing of the involved application, the agreement shows the additional concrete

steps applicant was taking towards using the mark in connection with the Class 28 goods.

With regard to the filing of successive JOHN CARTER OF MARS applications, such evidence "may cast doubt on the bona fide nature of the intent . . . ", *Research in Motion Ltd. v. NBOR Corp.*, 92 USPQ2d 1926, 1931 (TTAB 2009), (quoting legislative history of the Trademark Law Revision Act). Applicant has rebutted such evidence by explaining legitimate circumstances for its failure to make use during the statutory time period that led to its need to file a second application for JOHN CARTER OF MARS, namely, Paramount's decision not to exercise its option for the JOHN CARTER OF MARS series after years of development, and Disney's subsequent decision to enter into an option agreement for the JOHN CARTER OF MARS series. We note that opposer has not provided any evidence to challenge these factual circumstances.

We also find opposer's assertions that applicant attempted to reserve rights in marks for Class 28 goods (i.e., the filing of TARS TARKAS, DEJAH THORIS, AND PRINCESS OF MARS applications) to be without merit, given that these marks are either the name of a story in the JOHN CARTER OF MARS series and/or characters in the stories which may be based on or appear in the JOHN CARTER OF MARS movie

currently in pre-production, as supported by the undisputed documentary evidence provided by applicant.

Lastly, opposer's assertions regarding a timetable for proving use are not supported by the Congressional Record with regard to an intent to use mark. See S. Rep. 100-515, 100th Cong. 2d Sess. at 25 (1988) ("The Committee rejected the proposal for statutory language that would prohibit an applicant from refiling an application and thereby extending the time during which it could 'reserve' a mark without making use the committee . . . did not want to prejudice an applicant who, after investing in a mark, could not meet the four-year-cut-off date as a result of unforeseen circumstances"). See also H. Rep. 100-1028 100th Congress 2d. Sess. at 9 (1988) ("Obviously, what is [a] real and legitimate [intention to use the mark in a commercial sense] will vary depending on the practices of the industry involved, and should be determined based on standards of that particular industry").

Because the evidence of record establishes that there is no genuine issue of material fact that applicant had the requisite bona fide intent to use the involved mark on Class 28 goods, applicant's motion for summary judgment is granted on the lack of a bona fide intent to use the mark in commerce ground.

Fraud

Turning to the fraud claim, which is based on applicant's alleged lack of a bona fide intent, we find that the claim is insufficiently pleaded under *In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009) and *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478 (TTAB 2009). Moreover, in view of our finding that applicant had a bona fide intent to use the JOHN CARTER OF MARS mark in commerce with regard to Class 28, allowing amendment on the fraud claim would be futile.

Accordingly, the fraud claim is hereby stricken.

In view of the above, the opposition is dismissed with prejudice.