

THIS DISPOSITION
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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Taylor

Mailed: September 13, 2006

Opposition No. 91156299

WARNER BROS. ENTERTAINMENT,
INC., substituted for TIME
WARNER ENTERTAINMENT COMPANY,
L.P.¹

v.

ROGER CAMPO, JULIO CALDERON
and LUZ BEDIALE, d/b/a as LOS
PRIMOS PRODUCTIONS

Before Holtzman, Kuhlke and Cataldo,
Administrative Trademark Judges.

By the Board:

Roger Campo, Julio Calderon and Luz Bediale
("applicants") seek to register the mark HARRY POTHEAD for
"entertainment services in the nature of a live-action,
comedy, drama and/or animation television programs,
production of live-action comedy, drama and/or animated
television programs; a live-action, comedy, drama and/or
animated motion picture theatrical films; production of
live-action, comedy, drama and/or animated motion picture

¹ Evidence of the relevant assignments is recorded in the
Assignment Branch of the Patent and Trademark Office as follows:
Warner Communications Inc. by assignment from Time Warner
Entertainment Company, L.P., recorded at at Reel/Frame 2641/0774;
and Warner Bros. Entertainment, Inc. by assignment from Warner
Communications Inc., recorded at Reel/Frame 2641/0774.

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theatrical films; and theatrical performances both animated and live-action; and providing information for an actual entertainment via an electronic global computer network in the nature of a live-action, comedy, drama and/or animated television programs; production of live-action comedy, drama and/or animated television programs; a live-action, comedy, drama and/or animated motion picture theatrical films; production of live-action, comedy, drama and/or animated motion picture theatrical films; and theatrical performances both animated and live action; and production of comedic and musical audio recordings."² Registration has been opposed by Time Warner Entertainment Company, L.P. ("opposer"). As grounds for opposition, opposer has alleged, *inter alia*, (1) that opposer is the owner of all rights, title and interest in and to the name and mark HARRY POTTER for a wide variety of goods and services including entertainment services and motion picture films; that opposer owns Registration Nos. 2568097, 2568098, 2497083, 2450787, 2493484, 2479341, 2450788, 2525908, 2526111, 2574410, 2530755, 2457302, 2506165, 2506166, 2685932, and 2683060 for HARRY POTTER³;

² Application Serial No. 78054817, filed March 23, 2001 and alleging July 25, 2000 as the date of first use anywhere and in commerce.

³ Examples of the goods and services recited in these registrations include:

Registration No. 2568097 for "entertainment services in the nature of a live-action, comedy, drama and/or animation television programs, production of live-action comedy, drama

that notwithstanding opposer's prior rights in its mark, applicants filed their application for registration of the

and/or animated television programs; a live-action, comedy, drama and/or animated motion picture theatrical films; production of live-action, comedy, drama and/or animated motion picture theatrical films; and theatrical performances both animated and live-action; and providing information for an actual entertainment via an electronic global computer network in the nature of a live-action, comedy, drama and/or animated television programs; production of live-action comedy, drama and/or animated television programs; a live-action, comedy, drama and/or animated motion picture theatrical films; production of live-action, comedy, drama and/or animated motion picture theatrical films; and theatrical performances both animated and live action; and production of comedic and musical audio recordings," registered May 7, 2005, and claiming December 22, 2000 as the date of first use anywhere and in commerce;

Registration No. 2568098 for "cookies, bases for making milkshakes, breakfast cereal, bubble gum, cake decorations made of candy, chewing gum, frozen confections, crackers, frozen yogurt, ice cream, pretzels, peanut butter confectionery chips, malt for food; soybean malt; malt biscuits; sugar confectionery; edible decorations for cake; rice cakes; pastilles; pastries; biscuits and bread; coffee beverages with milk; cocoa beverages with milk, chocolate-based beverages, coffee and coffee-based beverages, cocoa and cocoa-based beverages; tea, namely, ginseng tea, black tea, oolong tea, barley and barley-leaf tea; meat tenderizers for household purposes; binding agents for ice-cream," registered May 7, 2002, and claiming October 11, 2000 as the date of first use anywhere and in commerce; and

Registration No. 2497083 for "toys and sporting goods, including games and playthings - namely, action figures and accessories therefor; plush toys; balloons; bathtub toys; ride-on toys; equipment sold as a unit for playing card games; toy vehicles; dolls; flying discs; electronic hand-held game unit; game equipment sold as a unit for playing a board game, a card game, a manipulative game, a parlor game, a parlor-type computer game, an action type target game; stand alone video output game machines; jigsaw and manipulative puzzles; paper face masks; skateboards; ice skates; water squirting toys; balls - namely, playground balls, soccer balls, baseballs, basketballs; baseball gloves; swimming floats for recreational use; kickboard flotation devices for recreational use; surfboards; swim boards for recreational use; swim fins; toy bakeware and toy cookware; toy banks; and Christmas tree ornaments," registered October 9, 2001, and claiming October 6, 2000 as the date of first use anywhere and in commerce.

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mark HARRY POTHEAD for entertainment services; that applicants were aware of opposer's mark and the HARRY POTTER series of books before applicants adopted their "alleged" mark; that applicants' mark is a colorable imitation of opposer's HARRY POTTER mark in that it so closely resembles opposer's mark that use and registration thereof is likely to cause confusion and deception as to the source or origin of applicants' services and will injure and damage opposer and the goodwill and reputation symbolized by opposer's mark; that applicant's services are so closely related to the goods and services of opposer that the public is likely to be confused, to be deceived and to assume erroneously that applicants' services are those of opposer or that applicants are in some way connected with or sponsored by or affiliated with opposer, all to opposer's irreparable damage; and that likelihood of confusion is enhanced by the fame of opposer's mark; (2) that applicants' mark comprises matter that disparages or falsely suggests a connection with opposer; (3) that applicants' mark consists of matter that is scandalous within the meaning of Section 2(a), inasmuch as "pothead" is a pejorative term; (4) that applicants have used their alleged mark only in connection with a single animated motion picture prior to filing their application, thus applicants have not used their mark as a trademark or service mark prior to filing their application and (5) that

opposer's mark has become well known and famous as a distinctive symbol of opposer's goodwill; that opposer's mark became well known and famous before applicant made any use of its alleged mark; and that applicants' mark will cause dilution of the distinctive quality of opposer's mark.

Applicants, in their answer have admitted, among other things, that: (1) opposer's mark is immediately identifiable as a fanciful designation that evokes images associated with the books, the movie and a vast line of Harry Potter products and services originating with opposer or its related companies that have been sold under opposer's mark; (2) applicants were aware of opposer's mark and the Harry Potter series of books before applicants adopted their alleged mark; (3) Harry Potter books are noteworthy for their distinctive and imaginative names, including HARRY POTTER, which are known to millions of readers and others who have merely read book reviews or heard about the Harry Potter stories by word of mouth; (4) opposer's mark has been widely used and extensively publicized in the United States and, therefore, opposer's mark has become well known and famous as a distinctive symbol of opposer's goodwill; (5) opposer's mark became well known and famous before applicant⁴ made any use of its alleged mark; (6) applicants'

⁴ Opposer, in paragraph 24 of the notice of opposition, references applicants in the singular.

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