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

Mailed: March 19, 2004

Opposition No. 91154096
Opposition No. 91154098

Saul Zaentz Company, The

v.

Frodo's Concepts, LLC

Before Seeherman, Hairston, and Drost, Administrative Trademark Judges.

By the Board:

The above-captioned oppositions now come before the Board on opposer's motions for summary judgment, and applicant's cross-motions to amend its applications. All motions have been briefed.[1]

Proceedings Consolidated

As a preliminary matter, the Board notes that the parties are involved in two opposition proceedings involving common issues of law and fact. Accordingly, the Board orders that Opposition Nos. 91154096 and 91154098 are hereby consolidated and that they may be presented on the same

[1] After submission of its motion to amend the subject application, applicant filed a motion to file a supplemental brief in support thereof. In effect, applicant wishes to file a substitute brief to correct its reliance on certain language in the TMEP, which had appeared in the edition which issued in March 2002, and had been amended in the June 2002 revision, and to add

record and briefs. *See* Fed. R. Civ. P. 42(a); TBMP § 511, *citing Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440 (TTAB 1970). From this date forward, Opposition No. 91154096 is designated the "parent" case in which all papers shall be filed. Every paper filed must henceforth reference all proceeding numbers as shown in the caption of this order.[2]

Pending Motions

Opposer has moved for summary judgment, asserting that applicant is not – and was not at the time of filing – the owner of the mark, and the applications are therefore void. In response, applicant seeks to amend its applications to correct the record ownership.

Applicable Law

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); *see Celotex Corp. v. Catrett*, 477 U.S. 317 (1987). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

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a case cite. Applicant's motion is GRANTED, and it is the supplemental (i.e., substitute) brief that we have considered.

[2] The parties should promptly inform the Board in writing of any other related *inter partes* proceedings. *See* Fed. R. Civ. P. 42(a).

An application for registration must be made in the name of the owner of the mark. Trademark Act § 1(a)(1). *Huang v. Tzu Wei Chen Food Co. Ltd.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988). Nonetheless, not all errors in the name of the applicant listed in the application are fatal:

> The applicant may amend the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application. The amendment must be supported by an affidavit or declaration under § 2.20, signed by the applicant. However, the application cannot be amended to set forth a different entity as the applicant. An application filed in the name of an entity that did not own the mark as of the filing date of the application is void.

Trademark Rule 2.71(d); *see generally*, TMEP § 1201.02(b).

Facts

The material facts are not in dispute. Applicant admits that it did not own the mark at the time the applications were filed. Pursuant to documents revealed in discovery, applicant is a non-exclusive licensee of C. Clyde Roe, a/k/a Clement Roe ("Roe"). Roe, is, in turn, the sole shareholder in the applicant corporation.

Discussion

Applicant argues that since Roe was the sole shareholder of applicant at the time of application, and controlled use of the mark, applicant's use inured to the benefit of Roe. We need not decide this question, however, since it is irrelevant to the matter at hand. We are not

concerned here with whether Roe is entitled to rely upon the applicant's use of the mark; neither use of the mark by the owner nor priority of use is at issue in the current motions. Rather, the appropriate inquiry is directed toward whether applicant Frodo's Concepts was the owner of the mark as required by the Trademark Act and if not, whether the applications can be amended to reflect proper ownership.

As noted above, the first question is easily answered. Applicant readily admits that – as set out in the license agreement – it is not the owner of the mark.

As to the second question, Trademark Rule 2.71(d) permits amendment of "the application to correct the name of the applicant, if there is a mistake in the manner in which the name of the applicant is set out in the application." (emphasis added). We find that applicant is not entitled to amend the applications to reflect the proper ownership of the mark in this case. This is clearly not a case in which the name was "set out" incorrectly, but rather a case in which the wrong party applied for registration. "An application filed in the name of an entity that did not own the mark as of the filing date of the application is void." *Id. See also, Huang v. Tzu Wei Chen Food Co., Ltd.*, 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988)(application filed by individual two days after transfer to newly-formed corporation held void); *In re Tong Yang Cement Corp.*, 19

USPQ2d 1689 (TTAB 1991)(application filed by member of joint venture void where mark was owned by the joint venture). *But see, Accu Personnel Inc. v. Accustaff Inc.*, 38 USPQ2d 1443 (TTAB 1996)(application filed in the name of non-existent corporation held not void).[3]

Applicant's attempt to distinguish *Huang v. Tzu Wei Chen Food Co.* is unavailing. Applicant points out that in *Huang* the Federal Circuit carefully noted that no attempt had been made to amend the application to reflect the correct owner. *Huang*, 849 F.2d at 1460 ("Thus we need not decide whether, under the unusual circumstances of this case, the Commissioner in his discretion could have allowed correction.").

Although the Federal Circuit makes reference to the possibility that the Commissioner might exercise discretion in "unusual" circumstances, that decision also reiterates that "No authority has been cited for excusing noncompliance with 15 U.S.C. § 1051. Neither the Board nor the courts can waive this statutory requirement." *Huang*, 849 F.2d at 1460. To the extent that the USPTO has any discretion in the

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[3] Applicant has cited the Board's decision in *United States Olympic Committee v. O-M Bread, Inc.*, 26 USPQ2d 1221 (TTAB 1993), in support of its position. According to applicant, "[i]n that case, the Board granted a similar Motion to Amend and denied the Opposer's Motion for Summary Judgment based on the erroneous identification of the applicant." Opp. to Mot. for Summ. J. at 2. Suffice it to say that *Olympic Committee* has little or nothing to do with factual situation in the case at bar, and in

matter, it is clear that such discretion is rarely, if ever, exercised:

> If the application met the minimum requirements for receipt of a filing date … when originally filed, but during examination it is discovered that the applicant did not have a right to apply on the assigned filing date (*e.g.*, because the applicant did not own the mark), the application is void, because a valid application was not created. *See* TMEP §§803.06 and 1201.02(b). The Office will not refund the filing fee in such a case. If, subsequent to the assigned filing date, the applicant became eligible to apply, the applicant may file a new application, including a filing fee.

TMEP § 205.

Indeed, even if we had such discretion, we would not exercise it in this case. Unlike *Huang*, there was no confusion here surrounding the formation of the applicant corporation and the filing of the trademark applications. Nor is it a case involving an application in the name of a legal entity being formed, but not yet in existence. The applications here were apparently intentionally made in the name of an existing legal entity which did not then own the mark. That applicant did not realize the consequences of its action does not compel a different result.[4]

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particular, did not involve "the erroneous identification of the applicant."

[4] Applicant cites *Airport Canteen Services, Inc. v. Farmer's Daughter, Inc.*, 184 USPQ 622 (TTAB 1974), in its supplemental brief. As noted by opposer, however, that case was primarily concerned with whether use by a predecessor can be claimed for purposes of priority. However, to the extent that *Airport Canteen* implies that a mark may be applied for by one who is not the owner at the time of application, it is clearly superceded by *Huang*, a later-decided Federal Circuit case.

Our view is further supported by the (current) version of the TMEP, which cites several examples in which amendment to correct ownership would and would not be permitted:

> The following are examples of correctable errors in identifying the applicant:
>
> > (1) If the applicant identifies itself by a name under which it does business, which is not its name as a legal entity, then amendment to state the applicant's correct legal name is permitted.
> >
> > (2) If the applicant mistakenly names an operating division that is not a legal entity as the owner, then the applicant's name may be amended. *See* TMEP § 1201.02(d).
> >
> > (3) Clerical errors such as the mistaken addition or omission of "The" or "Inc." in the applicant's name may be corrected by amendment.
> >
> > (4) If the record is ambiguous as to who owns the mark, *e.g.*, an individual and a corporation are each identified as the owner in different places in the application, the application may be amended to indicate the proper applicant.
> >
> > (5) If the owner of a mark legally changed its name before filing an application, but mistakenly lists its former name on the application, the error may be corrected because the correct party filed, but merely identified itself incorrectly. *In re Techsonic Industries, Inc.*, 216 USPQ 619 (TTAB 1982).
> >
> > (6) If the applicant has been identified as "A and B, doing business as The AB Company, a partnership," and the true owner is a partnership organized under the name The AB Company and composed of A and B, the applicant's name should be amended to "The AB Company, a partnership composed of A and B."
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> To correct an obvious mistake of this nature, a verification or declaration is not normally necessary. The following are examples of non-correctable errors in identifying the applicant:

> (1) If the president of a corporation is identified as the owner of the mark when in fact the corporation owns the mark, the application is void as filed because the applicant is not the owner of the mark.
>
> (2) If an application is filed in the name of entity A, when the mark was assigned to entity B before the application filing date, the application is void as filed because the applicant was not the owner of the mark at the time of filing. *Huang v. Tzu Wei Chen Food Co. Ltd.,* 849 F.2d 1458, 7 USPQ2d 1335 (Fed. Cir. 1988) (application filed by an individual two days after ownership of the mark was transferred to a newly formed corporation held void).
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> (3) If the application is filed in the name of a joint venturer when the mark is owned by the joint venture, the application cannot be amended. *In re Tong Yang Cement Corp.*, *supra*.
>
> (4) If an application is filed in the name of corporation A and a sister corporation (corporation B) owns the mark, the application is void as filed because the applicant is not the owner of the mark.

TMEP § 1201.02(c)(3d ed. Rev. 2, May 2003).[5]

Applicant's situation is clearly not covered by any of the examples of cases in which amendment would be permitted. Indeed, the facts at hand are directly analogous to the first example of cases in which amendment should not be permitted.

Because we find the subject applications void as filed, applicant's motion to amend its application is DENIED and opposer's motion for summary judgment is GRANTED.

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[5] The current version of the TMEP and the Board's manual, the TBMP, are published on the web for viewing and downloading at www.uspto.gov.

Accordingly, judgment is hereby entered against applicant, the opposition is sustained, and registration to applicant is refused.[6]

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[6] Our decision herein does not preclude the actual owner of the mark from filing a new application.