

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

In the Matter of Application Serial No.: 77/937845
Published in the Official Gazette of August 18, 2020

LESLIE S. KLINGER)	Opposition No. _____
)	
Opposer,)	
v.)	
)	
CONAN DOYLE ESTATE, LIMITED,)	
)	
Applicant.)	
)	

NOTICE OF OPPOSITION

Opposer Leslie S. Klinger (“Opposer”) believes that he will be damaged by registration of the mark shown in Application Serial No. 77/937845 (the “Opposed Application”), and hereby opposes the same. As grounds for opposition, Opposer alleges as follows:

1. Opposer is an individual citizen of the United States of America and a resident of Malibu, California with a principal place of business at 10866 Wilshire Blvd., Suite 1500, Los Angeles, CA 90024.
2. Upon information and belief, applicant Conan Doyle Estate, Limited (“Applicant”) is a corporation organized under the laws of the United Kingdom with an address of record at 9 London Road, Southampton, United Kingdom SO152AE.
3. On February 17, 2010, Applicant filed Application Serial No. 77/937863 (the “Opposed Application”) for the claimed word mark SHERLOCK HOLMES in Cl. 9 for “Motion picture and television films featuring musical, dramatic, comedic and theatrical performance;

prerecorded goods, namely, prerecorded audio and video cassettes, compact discs, and digital versatile discs all featuring audio books and stories in the field of detective fiction, motion picture and television films, animated cartoons, radio programs, music; downloadable electronic publications in the nature of e-zines and electronic books in the field of detective fiction.” All of the foregoing goods are collectively referred herein as “the Cl. 9 Goods”).

4. “Sherlock Holmes” is the name of a fictional detective who was created by Sir Arthur Conan Doyle (“Conan Doyle”) and first appeared in a work of detective fiction by Conan Doyle titled *A Study in Scarlet*, which was published in 1887. Doyle thereafter wrote and published a total of four (4) novels and fifty-six (56) stories (collectively known among readers and scholars as “the Canon”), all of them in the genre of detective fiction, and all of them featuring the fictional character named Sherlock Holmes.

5. Opposer is the author and editor of more than 25 books and dozens of articles on various topics relating to the mystery, detective and thriller genres in literature, including 20 books and dozens of articles on the subject of the Canon.

6. The Canon in its entirety is now in the public domain in every country of the world except the United States, where Applicant claims to own U.S. copyrights in the last ten (10) stories by Conan Doyle that featured Sherlock Holmes (“the Ten Stories”), all of which were first published after 1923 and some of which are also now in the public domain in the United States. Despite Applicant’s claim to ownership of limited and specific elements of the Ten Stories, however, the name and character of Sherlock Holmes are in the public domain throughout the world, including the United States.

7. In 2013, Opposer filed a Complaint for Declaratory Relief against Applicant in United States District Court for the Northern District of Illinois, *Leslie S. Klinger v. Conan Doyle*

Estate, Ltd. (Case No. 13 C 1226), to confirm the public domain status of the fictional character Sherlock Holmes and all other elements of the Canon except the limited and specific elements that appeared for the first time in the Ten Stories. The District Court entered a judgment in favor of Opposer in 2013 (988 F.Supp.2d 879), the judgment was affirmed by the U.S. Court of Appeals for the Seventh Circuit in 2014 (755 F.3d 496 and 761 F.3d 789), and a Petition for Certiorari was denied by the United States Supreme Court in 2014 (135 S.Ct. 458, 190 L.Ed. 2d 331). As the Court of Appeals ruled: “When a story falls into the public domain, story elements – including characters covered by the expired copyright – become fair game.... [O]nly the original elements added in the later stories remain protected.” *Klinger v. Conan Doyle Estate, supra*, 755 F. 3d 496, 501 (Emphasis added.) Since the name and character “Sherlock Holmes” appears in every work in the Canon, starting with the first story as published in 1887, the name and character are now in the public domain in every country of the world, including the United States.

8. Applicant previously applied to register SHERLOCK HOLMES in Cl. 16 for “Printed matter, namely, books, short stories and magazines in the field of detective fiction” in USPTO Applic. Ser. No. 77/937813. Opposer filed a Notice of Opposition to the foregoing application in the Trademark Trial and Appeal Board (“TTAB”) on April 18, 2018, under Opposition No. 91240716. Applicant elected not to answer the Notice of Opposition filed by Applicant and withdrew the foregoing application on May 22, 2018. The TTAB dismissed the opposition without prejudice and terminated the opposition on May 30, 2018.

9. Applicant now seeks to register SHERLOCK HOLMES for the Cl. 9 Goods, which include but are not limited to (a) publishing industry products such as electronic books, audio books and “e-zines” (that is, electronic magazines) and (b) motion picture and television

films in various media. Authors typically publish and/or authorize the publication of their books and short stories in the form of electronic books, audio books and electronic magazines.

Producers of motion picture and television films often acquire rights from the authors of works first published as books and short stories in print and/or electronic formats. For these reasons, the Cl. 9 Goods represent both the primary market for such authors and publishers and a valuable secondary market for such authors and publishers. For the reasons set forth below, Opposer – and other authors who use the public-domain character of Sherlock Holmes in their works of authorship – will be damaged if Applicant is granted exclusive trademark rights in the name of that public-domain character. The risk is especially acute because, as alleged below, Applicant’s long-established and ongoing business conduct suggests that Applicant does not intend to produce any Cl. 9 Goods; rather, Applicant intends to use its trademark registration to extract licensing fees from those who do.

10. Applicant’s motive in seeking to register “Sherlock Holmes” as a trademark in Cl. 9, like its previous application to register “Sherlock Holmes” in Cl. 16, is to further its wrongful practice of seeking to extract licensing fees under threat of litigation for lawful uses of the Canon. The wrongful practice, as it was employed by Applicant in the context of copyright, was aptly described by Judge Posner in *Klinger v. Conan Doyle Estate*: “The Doyle estate’s business strategy is plain: charge a modest license fee for which there is no legal basis, in the hope that the ‘rational’ writer or publisher asked for the fee will pay it rather than incur a greater cost.” Indeed, Judge Posner described the Applicant’s business model as “a disreputable business practice – a form of extortion.” *Klinger v. Conan Doyle Estate, supra*, 762 F.3rd 789, 792.

11. Applicant seeks to register, own and control “Sherlock Holmes” as its exclusive trademark for the purported purpose of publishing and selling the Cl. 9 Goods, all of which are

specifically in the field of “detective fiction.” Opposer is entitled to use “Sherlock Holmes” in his works of authorship that feature the public-domain character so named by publishing and/or authorizing others to publish his works featuring the public-domain character named Sherlock Holmes as audio books, electronic books, and electronic magazines, and Opposer is entitled to sell subsidiary rights in his works to producers of motion picture and television films that feature the character of Sherlock Holmes. In this genus of goods, “Sherlock Holmes” is a term that is understood by the relevant public – that is, readers and viewers – to refer primarily to that genus and not to any particular source of goods. “Sherlock Holmes” may be freely used – and, in fact, has long been used by Opposer and many other authors and publishers and their assignees – in such goods. *H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 531-32 (Fed. Cir. 1986).

12. Because the name and character “Sherlock Holmes” have been fully and finally adjudicated to be in the public domain under U.S. copyright, the name is available for public use without restriction, and Opposer respectfully submits that Applicant should be not permitted to circumvent the public domain status of the name under copyright by seeking to register the name as a trademark for the identical goods and services that were once protected under copyright, including audio books, electronic books, electronic magazines, and motion picture and television films. “[I]n construing the Lanham Act, we have been ‘careful to caution against misuse or over-extension’ of trademark and related protections into areas traditional occupied by patent or copyright.” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 33 (2003). Applicant is attempting to engage in precisely the kind of “misuse or over-extension” of trademark that the U.S. Supreme Court warned against.

13. Applicant should not be permitted to obtain a legal monopoly to use the name of a

fictional character now in the public domain to the exclusion of all other authors, publishers and producers by registering the name as a trademark. “Generic names are regarded by the law as free for all to use. They are in the public domain. As the U.S. Supreme Court stated: ‘Sharing in the goodwill of an article unprotected by patent or trademark is the exercise of a right possessed by all — and in the free exercise of which the consuming public is deeply interested.’ To grant an exclusive right to one firm of use of the generic name of a product would be equivalent to creating a monopoly in that particular product, something that the trademark laws were never intended to accomplish. Judge Friendly remarked that to permit exclusive trademark rights in a generic name “would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.” *McCarthy on Trademark and Unfair Competition* (5th Ed.), §12.2, citing *Kellogg Co. v. National Biscuit Co.* , 305 U.S. 111, 83 L. Ed. 73, 59 S. Ct. 109 (1938), and *CES Publishing Corp. v. St. Regis Publications* , 531 F.2d 11, 188 U.S.P.Q. 612, 615 (2d Cir. 1975)

14. Opposer has used “Sherlock Holmes” as a character in original works of detective fiction in books, short stories and magazines, and he has written extensively about the fictional character named Sherlock Holmes in works of commentary, criticism and history in book and magazine formats. The name “Sherlock Holmes” has appeared in the titles and subtitles of virtually all of these publications. For these reasons, Opposer is a legitimate source of goods in the genus of audio books, electronic books and electronic magazines that depict, describe and/or discuss the fictional character of Sherlock Holmes, and Opposer is entitled to grant motion picture and television rights in his goods to producers of motion picture and television films. If Applicant is granted the registration that it now seeks, Applicant will be empowered to threaten litigation against Opposer and Opposer’s publishers and producers as a pretext for extracting

licensing fees from any producer who seeks to depict the public domain character in audio books, electronic books, motion picture and television films, and the other Cl. 9 Goods. Opposer – and not only the Opposer – will be damaged by the registration of “Sherlock Holmes” for the services in the Opposed Application. For the foregoing reasons, Opposer enjoys standing to file and litigate the claims set forth in this Notice of Opposition in the Trademark Trial and Appeal Board.

15. Beyond the rights and interests of Opposer, “Sherlock Holmes” has been used for more than 100 years– and continues to be used – in exactly the same ways as described in paragraph 14 above in countless books, short stories and magazines in various publishing media by other authors and publishers and by producers of motion picture and television dramas in various audiovisual media. Opposer is informed and believes, and thereupon alleges, that such authors, publishers and producers number in the hundreds or even the thousands. Such use does not constitute an infringement of copyright, which no longer protects the name or character, and that is why “Sherlock Holmes” is purely generic when it is used in the genus of goods and services that consists of both (a) books, short stories and magazines in various publishing media that feature and/or discuss the fictional public-domain character whose name is “Sherlock Holmes,” and (b) the production of motion picture and television films based on these books, short stories and magazines. All of the authors, publishers and producers whose books, short stories, magazines, and motion picture and television films feature the public-domain character of Sherlock Holmes – not only Opposer but countless others – are also the legitimate sources of such goods and services. For that reason, Applicant cannot show that “Sherlock Holmes” is a trademark that identifies Applicant alone as the only legitimate source of books, short stories, magazines, motion picture and television films and other Cl. 9 Goods about Sherlock Holmes.

16. “The name of a product or service itself — what it is — is the very antithesis of a mark. In short, a generic name of a product can never function as a trademark to indicate origin. The terms ‘generic’ and ‘trademark’ are mutually exclusive. [T]he function of a mark is to identify and distinguish the goods or services of one seller from those sold by all others.” *McCarthy on Trademarks, supra*, §12:1. As such, a generic term is not eligible for registration under Section 2(e) of the Lanham Act, and the Opposed Application should be refused.

FIRST CLAIM FOR RELIEF
(Applied-For Mark Is Generic)

17. Opposer repeats and realleges the allegations in preceding paragraphs 1 through 16, inclusive, as if fully set forth herein.

18. The mark shown in the Opposed Application is generic when used on or in connection with the services identified and recited in the Opposed Application, and Applicant’s mark is thus unregistrable under §2(e)(1) of the Lanham Act, U.S. Trademark Act 15 U.S.C §2051(e)(1) and Trademark Trial and Appeal Board Manual of Procedure, §309.03(c)(24).

19. Opposer will be damaged by registration of the mark in the Opposed Application, because such registration will give Applicant *prima facie* evidence of ownership of and the exclusive right to use a mark that is generic for the services described in the Opposed Application, and will empower Applicant to carry out its wrongful business practice of extorting licensing fees under threat of litigation for what is actually the lawful use of a generic term.

WHEREFORE, opposer Leslie S. Klinger prays for judgment sustaining this opposition and refusing registration to the mark shown in the Opposed Application.

Please direct all correspondence and communication in this opposition to the undersigned.

Respectfully submitted,

LAW OFFICES OF JONATHAN KIRSCH, APC

Date: September 16, 2020

By: 

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