UNITED STATES: Bother! Disney’s Rights in WINNIE THE POOH Marks Challenged

Contributor: Robert P. Felber Jr., Waller Lansden Dortch & Davis, LLP, Nashville, Tennessee
Verifier: Lisa A. Iverson, Neal & McDevitt, LLC, Northfield, Illinois

Both are members of the INTA Bulletin Law & Practice—United States & Canada Subcommittee


Stephen Slesinger, Inc. and Disney were engaged in a long-running dispute regarding the interpretation of a 1983 agreement and whether that agreement assigned to Disney all of Slesinger’s ownership rights related to author A.A. Milne’s series of children’s books featuring the Winnie the Pooh character.

In the consolidated proceedings Slesinger challenged Disney’s rights in the WINNIE THE POOH marks, alleging priority, likelihood of confusion, dilution, fraud and lack of ownership. Disney filed a motion to dismiss (which the TTAB treated as a motion for summary judgment) on the ground that Slesinger was barred under the doctrine of collateral estoppel from re-litigating ownership, that issue having been addressed in an earlier federal district court action.

The TTAB found that each of the four elements necessary for collateral estoppel was satisfied:

- The ownership issue in this proceeding was identical to that addressed in the prior district court action;
- The ownership of the marks was actually raised, litigated and adjudicated in the district court action;
- The determination of whether Slesinger assigned or only licensed its rights to Disney was necessary and essential to the judgment in the district court action; and
- Slesinger was represented by counsel and had a full and fair opportunity to litigate the issue of ownership in the district court action.

The TTAB dismissed the consolidated proceedings with prejudice, finding that as a result of the district court litigation there remained no genuine dispute regarding ownership of the WINNIE THE POOH marks.

Although every effort has been made to verify the accuracy of items in the INTA Bulletin, readers are urged to check independently on matters of specific concern or interest.

© 2011 International Trademark Association