

11-06-2002

U.S. Patent & TMOfo/TM Mail RcptDt. #73

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

In re Konami Corporation

Serial No. : 76/074,595
Filing Date : June 21, 2000
Publication Date : October 8, 2002
Mark : Design consisting of the term "Yu-Gi-Oh" in stylized Kanji characters

UGO Networks, Inc.

Opposer,

v.

Konami Corporation

Applicant.

Opposition No.:

02:00:20 AM 9:30

**Assistant Commissioner for Trademarks
U.S. Patent and Trademark Office
2900 Crystal Drive
BOX TTAB - FEE
Arlington, VA 22202-3513
Attn: Trademark Trial and Appeal Board**

NOTICE OF OPPOSITION

UGO Networks, Inc., a Delaware corporation, located at 670 Broadway, 2nd Floor, New York, NY 10012 (the "Opposer"), believes it would be damaged by registration of the design mark consisting of the term "Yu-Gi-Oh" in stylized Kanji characters, as shown in Application Serial No. 76/074,595, and hereby opposes same under the provisions of Section 13 of the Trademark Act of July 5, 1946 (the "Lanham Act"), 15 U.S.C. 1063.

GROUNDS FOR OPPOSITION

1. Opposer owns the mark UGO ("Opposer's Mark"), for which it owns the following registrations on the Principal Register:
 - Registration No. 2,450,661 in Class 41 for "providing information on computer game and video game hardware and software, music, film, television, comics, animation and sports via a global computer network; entertainment services, namely, providing online interactive games via a global computer network," registered May 15, 2001;
 - Registration No. 2,519,204 in Class 35 for "computer services, namely computerized online retail services in the field of boxed games and games related merchandise; dissemination of advertising for others via an online electronic communications network," registered December 18, 2001; and
 - Registration No. 2,562,837 in Class 42 for "providing information on technology via a global computer network; hosting Web sites of others on a computer server for a global computer network; designing and implementing network Web pages for others," registered April 23, 2002.
2. In addition, Opposer is the owner of the "UGO" trade name.
3. Since at least as early as March 1996, Opposer has used Opposer's Mark and the "UGO" trade name on or in connection with computer games, computer game programs and accessories, video games, entertainment services and providing information on subjects including comics and animation.
4. By virtue of its extensive, continuous and substantial use of Opposer's Mark, the expenditure of substantial sums on promotional and advertising activities, the excellence of Opposer's services provided under Opposer's Mark and media attention in connection with its mark, Opposer has gained substantial, valuable goodwill with respect to Opposer's Mark.
5. Opposer's promotion and use of Opposer's Mark has caused the public to associate UGO with Opposer and to believe that goods and services provided in connection with Opposer's Mark have an association with or are sponsored by Opposer.

6. Opposer's Mark has acquired secondary meaning in the eyes of the consuming public and the trade by virtue of Opposer's continuous and significant use and promotion of Opposer's Mark since at least as early as 1996.

7. Similarly, Opposer's "UGO" trade name has achieved wide recognition in the eyes of the consuming public and the trade by virtue of Opposer's continuous and significant use and promotion of the name since at least as early as 1996.

8. Upon information and belief, Applicant, Konami Corporation, is a Japanese corporation, located at 4-3-1 Toranomom Minato-Ku, Tokyo, 105-6021 Japan.

9. Applicant seeks to register a design mark consisting of the term "Yu-Gi-Oh" in stylized Kanji characters ("Applicant's Mark") for "computer products, namely, computer games programs; video game cartridges; video game CD-ROMS; video output game units; computer game CD-ROMS; video game programs; video game programs for use with television sets; video game machines for use with television sets; game-playing equipment, namely, joysticks and game controllers" in Class 9.

10. Upon information and belief, Opposer's Mark and Applicant's Mark are pronounced identically. Accordingly, because of the similarity in sound and pronunciation, and the overlap of the parties' goods and services, Applicant's Mark is confusingly similar to Opposer's Mark.

11. In addition, Opposer's Mark is likely to be confused with Applicant's trade name "Yu-Gi-Oh."

12. If Applicant were permitted to register Applicant's Mark, confusion in the trade and in the minds of the public, resulting in irreparable damage and injury to Opposer, would likely result. For example, persons familiar with Opposer's Mark and Opposer's "UGO" trade

name and services provided thereunder would likely mistakenly believe that Applicant's goods are provided by Opposer, or mistakenly believe Applicant's goods are otherwise related to Opposer, all to the detriment of and irreparable damage to Opposer. Any such confusion could result in the loss of sales to Opposer and would certainly dilute the notoriety, distinctiveness and uniqueness of Opposer's Mark and Opposer's "UGO" trade name. Further, any defect, objection or fault found with products marketed under Applicant's Mark would most likely reflect upon and injure the reputation Opposer has established with respect to the services provided under Opposer's Mark and Opposer's "UGO" trade name.

13. If Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* right to the exclusive use of Applicant's Mark. However, Opposer was first to use the UGO mark and the "UGO" trade name on and in connection with the relevant services. Applicant's registration thus would confuse the trade and public, be a source of damage and injury to Opposer, and diminish the significant investment Opposer has made in Opposer's Mark and Opposer's "UGO" trade name.

RELIEF REQUESTED

A. Registration of Applicant's Mark as shown in Application Serial No. 76/074,595 should be refused in the Class for which registration is sought, in accordance with Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), on the ground that Applicant's Mark so resembles Opposer's Mark as to cause confusion, mistake or deception.

B. Opposer thus respectfully requests that registration of Applicant's Mark as shown in Application Serial No. 76/074,595 be denied and that this opposition be sustained.

Respectfully submitted,

UGO Networks, Inc.

By:

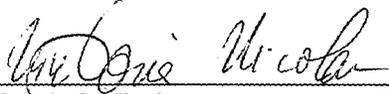

William M. Ried
Natasha Snitkovsky
Attorneys for Opposer

Dated: November 6, 2002

Willkie Farr & Gallagher
787 Seventh Avenue
New York, NY 10019

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, label number: EL798003175US, postage prepaid, in an envelope addressed to: BOX TTAB, FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on November 6, 2002.


Victoria S. Nicolau

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11-06-2002

U.S. Patent & TMOfc/TM Mail Ropt Dt. #73

WILLKIE FARR & GALLAGHER

787 Seventh Avenue
New York, NY 10019-6099
Tel: 212 728 8000
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November 6, 2002

VIA EXPRESS MAIL

Assistant Commissioner for Trademarks
BOX TTAB FEE
2900 Crystal Drive
Arlington, VA 22202-3513

Re: Trademark Application No. 76/074,595
Mark: Design consisting of the term Yu-Gi-Oh in stylized Kanji characters
International Class: 9

Dear Sir or Madam:

On behalf of UGO Networks, Inc., enclosed is an original and two copies of a Notice of Opposition against the above-referenced trademark application, together with a return receipt postcard.

We respectfully request the above-identified opposition proceeding be instituted and that, in due course, notification be sent regarding discovery and trial dates.

Please deduct the fee of \$300.00 and any deficiency therein from the Willkie Farr & Gallagher deposit account, No. 23-2405. For this purpose, a duplicate copy of this letter is enclosed.

Should any questions arise regarding this application, kindly contact the undersigned at (212) 728-8729.

Respectfully submitted,

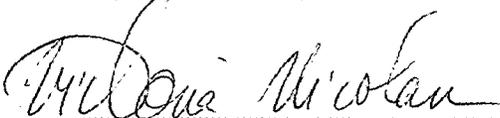


William M. Ried

Enclosures

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail Label No. EL798003175US postage prepaid, in an envelope addressed to: BOX TTAB, FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on November 6, 2002.



Victoria S. Nicolau

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