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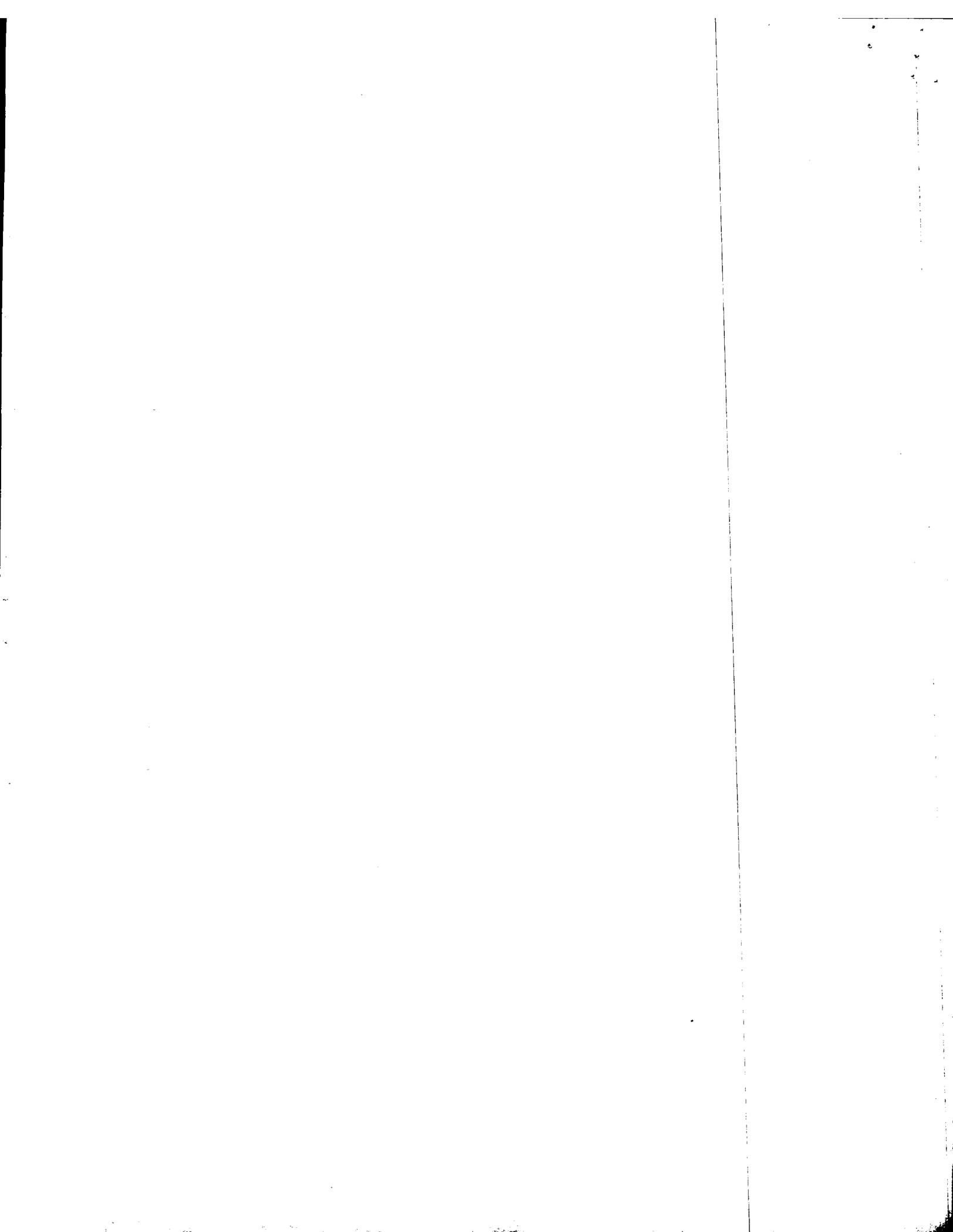
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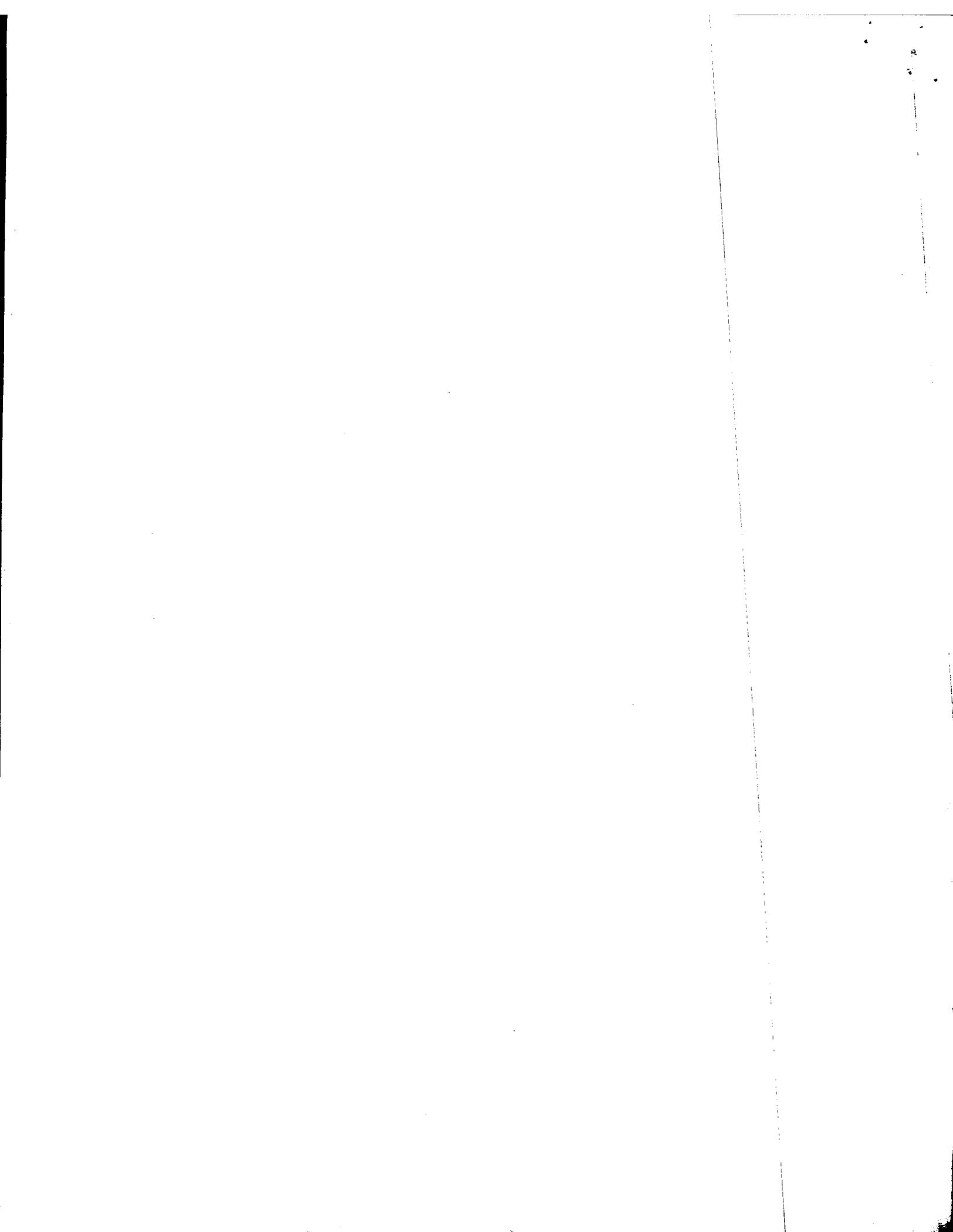
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## PRELIMINARY STATEMENT AND FACTUAL BACKGROUND

Opposer, UGO NETWORKS, INC. (“Opposer”), submits this memorandum in support of its motion to consolidate proceedings, to reset discovery and trial dates and to limit duplicative discovery, in connection with the following seven opposition proceedings:

Consolidated Opposition No. 91/153,578, Serial Nos. 76/074,595 and 76/075,729;  
Opposition No. 91/158,164, Serial No. 76/071,881;  
Opposition No. 91/158,129, Serial No. 76/074,599;  
Opposition No. 91/158,162, Serial No. 76/071,768;  
Opposition No. 91/158,165, Serial No. 76/071,879;  
Opposition No. 91/158,201, Serial No. 76/203,232; and  
Opposition No. 91/158,154, Serial No. 76/203,233.

Opposer respectfully submits that all requirements for consolidation of these seven opposition proceedings are met. The Opposer, UGO NETWORKS, INC., and the Applicant, KONAMI CORPORATION, are the same in each of the oppositions.<sup>1</sup> In each of the opposed applications, Applicant has applied to register the mark “YU-GI-OH” or a mark consisting of Kanji characters that transliterate to “YU-GI-OH” (“Applicant’s Mark”), in Classes 9, 16, 28, 35, 41 and/or 42, for various goods and services covering, *inter alia*, computer games and video games based on the YU-GI-OH animated character.<sup>2</sup> In each proceeding, Opposer has opposed the application on the grounds that the mark is likely to cause confusion with Opposer’s UGO marks (“Opposer’s Mark”), for which Opposer owns registrations on the Principal Register, in Classes 35, 41 and 42, covering services related to, *inter alia*, computer games and video games.<sup>3</sup> The salient questions of law and fact thus are common to all seven proceedings.

The parties previously stipulated, and the Board agreed, to consolidate Serial Nos.

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<sup>1</sup> See Declaration of Natasha Snitkovsky, dated December 23, 2003 (“Snitkovsky Dec.”).

<sup>2</sup> *Id.* at ¶¶ 4, 8.

<sup>3</sup> *Id.*

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76/074,595 and 76/075,729 into one proceeding, Opposition No. 91/153,578 (the “Consolidated Proceeding”).<sup>4</sup> Opposer was of the understanding that consolidation of all seven proceedings was agreeable to both parties, and asked Applicant numerous times over the past several months to proceed with consolidation.<sup>5</sup> Opposer received no substantive response to its inquiries until December 4, 2003, on which date Applicant proposed to consolidate the remaining six proceedings (the “Remaining Proceedings”) with each other, but not with the Consolidated Proceeding.<sup>6</sup> However, the Remaining Proceedings involve the same questions of law and fact as the Consolidated Proceeding, as is evident by the fact that Applicant has served discovery requests for each of the Remaining Proceedings substantially similar to the discovery requests it served in the Consolidated Proceeding.<sup>7</sup>

#### ARGUMENT

Fed. R. Civ. P. 42(a) provides that “[w]hen actions involving a common question of law or fact are pending before the court . . . it may order all actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.” See *Johnson v. Celotex Corp.*, 899 F.2d 1281, 1284 (2d Cir. 1990); *Ikerd v. Lapworth*, 435 F.2d 197, 204 (7th Cir. 1970). A court has the discretion to consolidate actions involving common questions of law or fact for trial or pretrial purposes if consolidation will facilitate the administration of justice. *Cedars-Sinai Med. Ctr. v. Revlon, Inc.*, 111 F.R.D. 24, 32 (D. Del. 1986).

In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort and expense that may be gained from consolidation against any prejudice

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<sup>4</sup> *Id.* at ¶ 6.

<sup>5</sup> *Id.* at ¶¶ 11-16.

<sup>6</sup> *Id.* at ¶ 17.

<sup>7</sup> *Id.* at ¶ 10.

or inconvenience which may be caused thereby. *See, e.g., Wright & Miller, Federal Practice and Procedure: Civil* §2383 (1971); *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982).

## POINT I

### The Questions of Law and Fact are Common to All Seven Oppositions

Consolidation is appropriate in cases where the salient questions of law and fact are common. *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

This is exactly the situation before the Board. Each of the instant oppositions is against one of Applicant's applications to register the word mark "YU-GI-OH" or the design mark consisting of the term "YU-GI-OH" in stylized Kanji characters.

The Notices of Opposition filed by Opposer against each of Applicant's applications are essentially duplicates of each other, altered only to refer to each application's listing of goods and services, which all related to cards and games based on Applicant's YU-GI-OH animated character.<sup>8</sup> Similarly, the answers filed by Applicant in response to each Notice of Opposition are also substantially similar to each other, as are Applicant's affirmative defenses.<sup>9</sup> Furthermore, the discovery requests served by Applicant in each of the seven proceedings are substantially similar.<sup>10</sup>

In each of the seven proceedings, Opposer is seeking a judgment from the Board that registration of Applicant's Mark, as shown in each of the eight applications it has filed, should be refused, 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

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<sup>8</sup> *Id.* at ¶¶ 4, 8.

<sup>9</sup> *Id.* at ¶¶ 5, 9.

<sup>10</sup> *Id.* at ¶10.

deception. Thus, the applicable law, under which each of the seven instant proceedings will be decided, is the same in all seven proceedings.

Thus, the questions of law and fact are common to all seven oppositions.

## **POINT II**

### **Consolidation Would Effect No Prejudice and Would Foster Efficiency**

Consolidating the instant proceedings would result in significant savings in time and effort by the parties and the Board, and would cause no inconvenience, unnecessary delay or expense.

Prior to consolidation of related actions, “[a] court must balance the savings of time and effort gained through consolidation against the inconvenience, delay or expense that might result from simultaneous disposition of the separate actions.” *Rohm & Haas Co. v. Mobil Oil Corp.*, 525 F. Supp. 1298, 1309 (D. Del. 1981) (citations omitted). In *Rohm & Haas*, the court granted a motion to consolidate after such a balancing process, concluding that “the Court is satisfied that any delay occasioned by consolidation is substantially outweighed by the benefits of a single trial.” *Id.* at 1310. The case involved two different patent proceedings which were in different stages of preparation. “Although the Court is well aware of the protracted nature of the 1978 action and is sensitive Mobil’s ostensible desire for expeditious resolution of this controversy, it believes that consolidation will appreciably serve the interests of judicial economy...” *Id.*

Similarly, Opposer submits that consolidation of the instant proceedings will: be economical and efficient; expedite resolution of each proceeding; eliminate duplicative discovery and depositions; avoid unnecessary costs and delay; and prevent the possibility of inconsistent results. Consolidation will conserve the time and resources of the Board as well as the parties

and their counsel.

The Board routinely consolidates proceedings involving similar marks to avoid duplication of effort, loss of time, and the extra expense involved in conducting the proceedings separately. *World Hockey Ass 'n*, 185 USPQ at 248. When the issues of fact and law to be decided are as closely intertwined as they are here, “[t]here is little logic in forcing the Court to educate itself on the intricate factual details and complex legal issues common to both suits on two occasions, in preparation for two separate trials.” *Rohm & Haas*, 525 F. Supp. at 1310. Finally, “both cases will undoubtedly involve a large number of the same witnesses, and the same documentary evidence and exhibits, thus raising the specter of inefficient and wasteful duplication.” *Id.*

The parties are currently involved in a discovery dispute before the Board in connection with the Consolidated Proceeding. Each party has filed a motion to compel, and requested that proceedings be stayed pending resolution of the motion. Because the discovery requests and responses served thus far in connection with the Remaining Proceedings have been substantially similar to the discovery requests and responses in the Consolidated Proceeding, the instant discovery dispute is likely to recur. Thus, consolidation would eliminate duplicative discovery disputes and conserve the resources of the parties and the Board.

Moreover, the motions filed by both parties in the Consolidated Proceeding are unlikely to be decided so quickly as to outpace the discovery in the Remaining Proceedings; accordingly, consolidation with the Remaining Proceedings will not result in an unnecessary delay of an earlier trial of the Consolidated Proceeding. Moreover, even if there were a short delay, it would be outweighed by the benefits of consolidation.

Finally, Opposer submits that neither party will be hampered or prejudiced in its

discovery efforts since consolidation does not change the rights of either party. Rather, the issues will still be individually adjudicated for each of Applicant's pending marks, since in a consolidated proceeding, each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, *Federal Practice and Procedure, supra*. Thus, a decision on a consolidated case takes into account any differences in the issues raised by the respective pleadings. *Id.*

### **POINT III**

#### **The Motion to Consolidate is Timely**

Finally, this motion is timely. Opposer submits this motion while discovery is open in all seven proceedings and before the testimony period in any proceeding has opened. 5 Moore's Fed., Pract. & Proc. 4(e)(2)(6) (citing *Shooter's Island Shipyard Co. v. Standard Shipbuilding Corp.*, 4 F2d 101 (3<sup>rd</sup> Cir. 1925)).

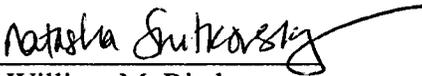
### **CONCLUSION**

For the foregoing reasons, Opposer respectfully submits that consolidation would be efficient and proper for these related proceedings. Therefore, Opposer requests that the Board grant this motion and consolidate the referenced opposition proceedings, and reset the discovery and trial dates in the newly-consolidated proceeding to follow the Board's decision on the motions to compel in the Consolidated Opposition 91/153,578 filed by Opposer and by Applicant. Finally, Opposer requests that the Board grant Opposer's motion to limit the parties from serving duplicative discovery requests in the newly-consolidated proceeding.

Dated: New York, New York  
December 23, 2003

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

By:   
William M. Ried  
Natasha Snitkovsky  
787 Seventh Avenue  
New York, New York 10019-6099  
(212) 728-8000

Attorneys for Opposer  
UGO NETWORKS, INC.

1303587.4/000930.10006

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing OPPOSER'S MEMORANDUM OF LAW IN SUPPORT OF MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY was sent via First Class mail, postage prepaid, to counsel for Applicant, Jeffrey H. Kaufman, Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1940 Duke Street, Alexandria, Virginia 22314, by first-class postage prepaid mail, on December 24, 2003.



\_\_\_\_\_  
Victoria Nicolau

**CERTIFICATE OF MAILING**

Express Mail Label No. EL798004860US

I hereby certify that this OPPOSER'S MEMORANDUM OF LAW IN SUPPORT OF MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY is being deposited as "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on December 24, 2003.



\_\_\_\_\_  
Victoria Nicolau



4. On November 6, 2002, Opposer filed Notices of Opposition (Exhibits 1 and 2) against Applicant's applications to register the design mark consisting of the term "YU-GI-OH" in stylized Kanji characters, as shown in Application Serial Nos. 76/074,595 and 76/075,729, claiming that Applicant's YU-GI-OH mark ("Applicant's Mark") was confusingly similar with Opposer's UGO mark ("Opposer's Mark"), for which Opposer owns registrations on the Principal Register, 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;" 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;" and 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." The two Notices of Opposition are substantially similar, the only difference being the listing of Applicant's goods and services covered by the application addressed by each Notice of Opposition: Application Serial No. 76/074,595 covers, "computer products, namely, computer game 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, and Application Serial No. 76/075,729 covers, "playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely strategy guides; stationery" in Class 16.

5. On December 27, 2002, and April 4, 2003, Applicant filed Applicant's Answer and Affirmative Defenses to Notice of Opposition in response to each of the two Notices of Oppositions (Exhibits 3 and 4). The two documents are substantially similar.

6. On April 23, 2003, pursuant to the parties' stipulated motion filed March 19, 2003, the Board granted consolidation of Serial Nos. 76/074,595 and 76/075,729 into one proceeding: Opposition No. 91/153,578 (the "Consolidated Proceeding") (Exhibit 5).

7. Between December 2002 and September 2003, Opposer obtained extensions to oppose Applicant's six other YU-GI-OH published applications ("Applicant's Remaining Applications"), while the parties attempted resolution of the Consolidated Proceeding and discussed possible settlement (Exhibit 6).

8. On September 18, 2003, Opposer filed Notices of Opposition against Applicant's Remaining Applications, consisting of four applications to register the mark "YU-GI-OH," as shown in Application Serial Nos. 76/071,879; 76/071,881; 76/071,768; and 76/203,232; and two additional applications to register the design mark consisting of the term "YU-GI-OH" in stylized Kanji characters, as shown in Application Serial Nos. 76/074,599 and 76/203,233, for a total of six additional oppositions (collectively, the "Remaining Proceedings") (Exhibit 7). Each of these Notices of Oppositions are substantially similar to one another and to the Notices of Opposition filed in connection with the Consolidated Proceeding, the only differences being the listing of Applicant's goods and services covered by the application addressed by each Notice of Opposition: Application Serial No. 76/071,879 covers, "computer products, namely, computer game 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; Application Serial Nos. 76/071,768 and 76/074,599 cover, “computer games, namely, stand-alone video games; hand-held units for playing electronic games; game pieces; action figures; toys, namely, action and play figures and accessories therefor; card games” in Class 28; Application Serial No. 76/071,881 covers, “playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely strategy guides; stationery” in Class 16; and Application Serial Nos. 76/203,232 and 76/203,233 cover, “providing information about the goods and services of others via the global computer network” in Class 35; “satellite communication services” in Class 38; “providing games played through communication by computer terminals, and providing information, images, music and/or sound regarding games; providing computer game software programs, images and music that are downloaded through computer networks, and providing games played through cellular telephone communication and providing information, images, music or sound regarding games; providing computer game programs, images and music that are downloaded through cellular telephone communication, and providing amusement arcade with game facilities; amusement arcades and centers; rental of computer game programs, arcade game machine and providing facilities for recreation activities, namely, amusement arcades and amusement parks; planning managing and holding events for promotion of games; entertainment services, namely, production and distribution of game shows, events featuring voice artists and card game contests; educational services, namely, conducting classes and workshops in the field of training referees for card game contests; providing a computer game that may be accessed network-wide by network users” in Class 41; and “providing an on-line computer database in the field of

providing information on planning and maintaining computer programs, arcade video game machines, and consumer video game machines” in Class 42.

9. On November 26, December 1, and December 5, 2003, Applicant filed Applicant’s Answer and Affirmative Defenses to Notice of Opposition for each of the six Remaining Proceedings (Exhibits 8-13). Each of the six documents is substantially similar to the others and to the Answers filed in the Consolidated Proceeding.

10. On November 6, November 10, and November 17, 2003, Applicant served discovery requests for four of the Remaining Proceedings (Exhibits 14-17). Each set of requests is substantially similar to each other set and to Applicant’s first set of discovery requests, dated January 7, 2003 (Exhibit 18), and Applicant’s second set of discovery requests, dated September 17, 2003 (Exhibit 19), collectively, for the Consolidated Proceeding.

11. The Consolidated Proceeding and the Remaining Proceedings involve the same marks and the same parties. Based on several telephone conversations between Opposer’s counsel and Applicant’s counsel between December 2002 and November 2003, Opposer was of the understanding that, once issue was joined in each of the Remaining Proceedings, the parties would again stipulate to consolidate all proceedings.

12. On November 19, 2003, Opposer’s counsel wrote to Applicant’s counsel, proposing consolidation of the Consolidated Proceeding and the Remaining Proceedings, in the interest in conducting discovery and depositions efficiently for all of the proceedings at once (Exhibit 20).

13. On November 21, 2003, having received no response to the November 19<sup>th</sup> letter,

Opposer's counsel wrote again to Applicant's counsel, asking for Applicant's response to Opposer's proposal to consolidate all of the proceedings (Exhibit 21).

14. On November 23, 2003, Applicant's counsel responded that it was awaiting instructions from its client regarding Opposer's consolidation proposal (Exhibit 22).

15. On November 24, 2003, Opposer's counsel wrote again to Applicant's counsel, reiterating its request for consolidation and asking again for Applicant's response (Exhibit 23).

16. On December 3, 2003, having still received no response to its proposal to consolidate, Opposer's counsel telephoned and sent another email to Applicant's counsel, asking for Applicant's response regarding consolidation (Exhibit 24).

17. On December 4, 2003, Applicant responded to Opposer regarding consolidation by stating that Applicant would agree to consolidate the Remaining Proceedings with each other, but *not* with the Consolidated Proceeding (Exhibit 25).

18. It is Opposer's position that the Consolidated Proceeding and the Remaining Proceedings should all be consolidated, in the interests of economy, efficiency, elimination of duplicative discovery and depositions, avoidance of unnecessary costs and delay, and prevention of the possibility of inconsistent results. Opposer has thus filed the instant motion to consolidate, to reset discovery and trial dates and to limit duplicative discovery.

Dated: New York, New York  
December 23, 2003

  
NATASHA SNITKOVSKY

1306809.4/000930.10006

**CERTIFICATE OF SERVICE**

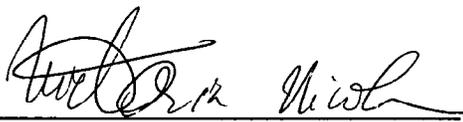
I certify that a copy of the foregoing DECLARATION OF NATASHA SNITKOVSKY IN SUPPORT OF OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY was served on counsel for Applicant, Jeffrey H. Kaufman, Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1940 Duke Street, Alexandria, Virginia 22314, by first-class postage prepaid mail, on December 24, 2003.

  
Victoria Nicolau

**CERTIFICATE OF MAILING**

Express Mail Label No. EL798004860US

I hereby certify that this DECLARATION OF NATASHA SNITKOVSKY IN SUPPORT OF OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY is being deposited as "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on December 24, 2003.

  
Victoria Nicolau

TTAB

Box TTAB, No Fee

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

UGO NETWORKS, INC.,	)	Consolidated Opposition No.
	)	91/153,578,
Opposer,	)	Serial Nos. 76/074,595 and
	)	76/075,729
v.	)	Opposition No. 91/158,164,
	)	Serial No. 76/071,881
KONAMI CORPORATION,	)	Opposition No. 91/158,129,
	)	Serial No. 76/074,599
Applicant.	)	Opposition No. 91/158,162,
	)	Serial No. 76/071,768
	)	Opposition No. 91/158,165,
	)	Serial No. 76/071,879
	)	Opposition No. 91/158,201,
	)	Serial No. 76/203,232
	)	Opposition No. 91/158,154,
	)	Serial No. 76/203,233



12-24-2003  
U.S. Patent & TMO/TM Mail RptDt. #78

**OPPOSER’S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET  
DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY**

Opposer, UGO NETWORKS, INC. (“Opposer”), by and through its undersigned attorneys of record, hereby moves the Board, pursuant to Fed. R. Civ. P. 42 and 37 C.F.R. § 2.127, for consolidation of the following seven opposition proceedings:

- Consolidated Opposition No. 91/153,578, Serial Nos. 76/074,595 and 76/075,729;
- Opposition No. 91/158,164, Serial No. 76/071,881;
- Opposition No. 91/158,129, Serial No. 76/074,599;
- Opposition No. 91/158,162, Serial No. 76/071,768;
- Opposition No. 91/158,165, Serial No. 76/071,879;
- Opposition No. 91/158,201, Serial No. 76/203,232; and
- Opposition No. 91/158,154, Serial No. 76/203,233.

Additionally, Opposer hereby moves to reset the discovery and trial dates in the newly-consolidated proceeding to follow the Board’s decision on the two pending motions to

compel, filed by Opposer and by Applicant, Konami Corporation ("Applicant"), in the Consolidated Opposition 91/153,578.

Finally, Opposer moves to limit the parties from serving duplicative discovery requests in the newly-consolidated proceeding.

Dated: New York, New York  
December 23, 2003

Respectfully submitted,

WILLKIE FARR & GALLAGHER LLP

By: *Natasha Snitkovsky*  
William M. Ried  
Natasha Snitkovsky  
787 Seventh Avenue  
New York, New York 10019-6099  
(212) 728-8000

Attorneys for Opposer  
UGO NETWORKS, INC.

1312716.1/000930.10006

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY was sent via First Class mail, postage prepaid, to counsel for Applicant, Jeffrey H. Kaufman, Oblon, Spivak, McClelland, Maier & Neustadt, P.C., 1940 Duke Street, Alexandria, Virginia 22314, by first-class postage prepaid mail, on December 24, 2003.

  
\_\_\_\_\_  
Victoria Nicolau

**CERTIFICATE OF MAILING**

Express Mail Label No. EL798004860US

I hereby certify that this OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS, TO RESET DISCOVERY AND TRIAL DATES AND TO LIMIT DUPLICATIVE DISCOVERY is being deposited as "Express Mail Post Office to Addressee" in an envelope addressed to: BOX TTAB, NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3514, on December 24, 2003.

  
\_\_\_\_\_  
Victoria Nicolau



## BULKY EXHIBITS

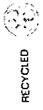
Proceeding/Serial No: 153578 →

Filed: 12/24/03

Title: Opposer's Memorandum

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RECYCLED

FILE/DOCKET

WILLKIE FARR & GALLAGHER

787 Seventh Avenue  
New York, NY 10019-6099  
Tel: 212 728 8000  
Fax: 212 728 8111

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:

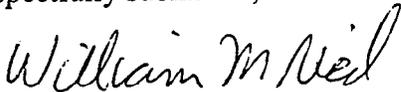
On behalf of UGO Networks, Inc., enclosed is an original and two copies of a Notice of Opposition against the above-referenced trademark application, together with a return receipt postcard.

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,

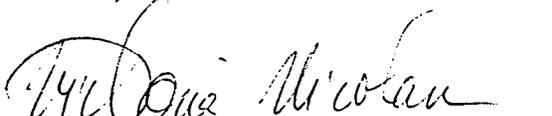


William M. Ried

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



## 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  
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  
Victoria S. Nicolau

RECEIVED IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT/REGISTRANT: *Konami Corporation*

TRADEMARK: *Design consisting of the term "Yu-Gi-Oh" in Kanji character*

SERIAL NO./REG NO./OPP. NO.: *76/074, 595*

DATE: *11/06/02*

FEE: *\$300*

DOCUMENT(S) FILED:

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| <input type="checkbox"/> APPLICATION FOR REGISTRATION | <input type="checkbox"/> AFFIDAVIT-SECTION 8                |
| <input type="checkbox"/> AMENDMENT                    | <input type="checkbox"/> AFFIDAVIT-SECTION 15               |
| <input type="checkbox"/> SPECIMENS/FACSIMILE          | <input type="checkbox"/> AFFIDAVIT-SECTION 12(c)            |
| <input type="checkbox"/> DRAWING                      | <input type="checkbox"/> APPLICATION FOR RENEWAL            |
| <input type="checkbox"/> POWER OF ATTORNEY            | <input checked="" type="checkbox"/> NOTICE OF OPPOSITION    |
| <input type="checkbox"/> AFFIDAVIT(S)                 | <input type="checkbox"/> STATEMENT OF USE                   |
| <input type="checkbox"/> ASSIGNMENT                   | <input type="checkbox"/> RESPONSE TO OFFICE ACTION          |
| <input type="checkbox"/> EXTENSION OF TIME REQUEST    | <input type="checkbox"/> REQUEST FOR CORRECT FILING RECEIPT |

COMMENTS:

*Opposition filed by USO Networks, Inc.*

*WNR/NS/US*



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FROM: (PLEASE PRINT) PHONE <u>212, 728-8729</u> <i>William Ried, Esq.</i> WILLKIE FARR & GALLAGHER 787 7TH AVE RM 2600 NEW YORK NY 10019-6099				TO: (PLEASE PRINT) PHONE <u>703, 308-9000</u> <i>BoxTTAB - FEE</i> ASSISTANT COMMISSIONER FOR TRADEMARKS 2900 CRYSTAL DR ARLINGTON VA 22202-3513			

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**WILLKIE FARR & GALLAGHER**

787 Seventh Avenue  
New York, NY 10019-6099  
Tel: 212 728 8000  
Fax: 212 728 8111

November 6, 2002

**VIA EXPRESS MAIL**

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

Re: Trademark Application No. 76/075,729  
Mark: Design consisting of the term Yu-Gi-Oh in stylized Kanji characters  
International Class: 16

Dear Sir or Madam:

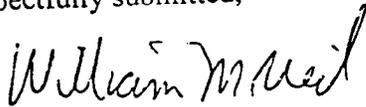
On behalf of UGO Networks, Inc., enclosed is an original and two copies of a Notice of Opposition against the above-referenced trademark application, together with a return receipt postcard.

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,

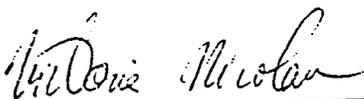


William M. Ried

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

UNITED STATES PATENT AND TRADEMARK OFFICE  
TRADEMARK TRIAL AND APPEAL BOARD

In re Konami Corporation

Serial No. : 76/075,729  
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.
	)	Opposition No.:
	)	
Konami Corporation	)	
	)	
	)	Applicant.
	)	

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, 2<sup>nd</sup> 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. 76/075,729, 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 Toranomon 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 "playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely strategy guides; stationery" in Class 16.

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

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13. If Applicant were granted the registration herein opposed, it would thereby obtain  
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icant's registration thus would confuse the trade and public, be a source of damage and  
y to Opposer, and diminish the significant investment Opposer has made in Opposer's Mark  
Opposer's "UGO" trade name.

**RELIEF REQUESTED**

A. Registration of Applicant's Mark as shown in Application Serial No. 76/075,729 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. 76/075,729 be denied and that this opposition be sustained.

Respectfully submitted,

UGO Networks, Inc.

By:

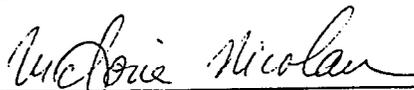
  
\_\_\_\_\_  
William M. Ried  
Natasha Snitkovsky  
Attorneys for Opposer

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

RECEIVED IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT/REGISTRANT: *Konami Corporation*  
TRADEMARK: *Design consisting of the term "YU-GI-GH" in Kanji*  
SERIAL NO./REG NO./OPP. NO.: *76/075, 729* *characters*  
DATE: *11/06/02*  
FEE: \$ *300*

DOCUMENT(S) FILED:

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| <input type="checkbox"/> APPLICATION FOR REGISTRATION | <input type="checkbox"/> AFFIDAVIT-SECTION 8                |
| <input type="checkbox"/> AMENDMENT                    | <input type="checkbox"/> AFFIDAVIT-SECTION 15               |
| <input type="checkbox"/> SPECIMENS/FACSIMILE          | <input type="checkbox"/> AFFIDAVIT-SECTION 12(c)            |
| <input type="checkbox"/> DRAWING                      | <input type="checkbox"/> APPLICATION FOR RENEWAL            |
| <input type="checkbox"/> POWER OF ATTORNEY            | <input checked="" type="checkbox"/> NOTICE OF OPPOSITION    |
| <input type="checkbox"/> AFFIDAVIT(S)                 | <input type="checkbox"/> STATEMENT OF USE                   |
| <input type="checkbox"/> ASSIGNMENT                   | <input type="checkbox"/> RESPONSE TO OFFICE ACTION          |
| <input type="checkbox"/> EXTENSION OF TIME REQUEST    | <input type="checkbox"/> REQUEST FOR CORRECT FILING RECEIPT |

COMMENTS: *Opposition filed by U60 Networks, I.*  
*WMR/NS/vsn*

EL 798003175 US



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No Delivery <input type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials	Total Postage & Fees \$		<input type="checkbox"/> WAIVER OF SIGNATURE (Domestic Only): Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.			
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METHOD OF PAYMENT: Express Mail Corporate Acct. No.				Federal Agency Acct. No. or Postal Service Acct. No.			
FROM: (PLEASE PRINT) PHONE (212) 728-8729 William Ried, Esq. WILLKIE FARR & GALLAGHER 787 7TH AVE RM 2600 NEW YORK NY 10019-6099				TO: (PLEASE PRINT) PHONE (703) 308-9600 BUTTAB - FEE ASSISTANT COMMISSIONER FOR TRADEMARKS 2900 CRYSTAL DR ARLINGTON VA 22202-3513			

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

_____	)	
UGO NETWORKS, INC.,	)	
	)	
Opposer,	)	Opposition No.: 91/153,578
	)	Appl. Serial No.: 76/074,595
v.	)	
	)	
KONAMI CORPORATION,	)	
	)	
Applicant.	)	
_____	)	

**APPLICANT’S ANSWER AND  
AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION**

Applicant, Konami Corporation (“Konami”) hereby submits this Answer and Affirmative Defenses to the Notice of Opposition in this proceeding, and as grounds therefore states as follows:

1. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 1 of the Notice of Opposition and on that basis denies those allegations.

2. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 2 of the Notice of Opposition and on that basis denies those allegations.

3. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 3 of the Notice of Opposition and on that basis denies those allegations.

4. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 4 of the Notice of Opposition and on that basis denies those

allegations.

5. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 5 of the Notice of Opposition and on that basis denies those allegations.

6. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 6 of the Notice of Opposition and on that basis denies those allegations.

7. Konami lacks knowledge or information sufficient to form a belief as to the truth of the allegations stated in paragraph 7 of the Notice of Opposition and on that basis denies those allegations.

8. Konami admits that it is a Japanese corporation with principal offices at 2-4-1, Marunouchi, Chiyoda-ku, Tokyo, 100-6330 JAPAN, and otherwise denies the allegations stated in paragraph 8 of the Notice of Opposition.

9. Konami admits that it has filed Application Serial No. 76/074,595 to register the mark YU-GI-OH in stylized Kanji characters 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. Konami denies the allegations contained in paragraph 10 of the Notice of Opposition.

11. Konami denies the allegations contained in paragraph 11 of the Notice of Opposition.

12. Konami denies the allegations contained in paragraph 12 of the Notice of Opposition.

13. Konami denies the allegations contained in paragraph 13 of the Notice of Opposition.

#### AFFIRMATIVE DEFENSES

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. The claims asserted in the Notice of Opposition are barred by the doctrines of estoppel and laches.
3. The claims asserted in the Notice of Opposition are barred by the doctrines of acquiescence and waiver.
4. There is no likelihood of confusion between any of Opposer's marks and Konami's Mark shown in Application Serial No. 76/074,595.
5. Opposer's marks are different from Konami's mark shown in Application Serial No. 76/074,595 in terms of sight, sound, meaning and overall commercial impression.
6. Opposer's Marks are weak as they are comprised of a generic and/or descriptive initialism or abbreviation in that UGO stands for Underground Online and the marks are not, have not and cannot become distinctive of Opposer's goods or services in commerce.
7. Opposer's Marks are weak due to the presence of third party marks that cover related goods and services and thus Opposer's marks are entitled only to a very narrow scope of protection, if any.
8. Applicant will assert any and all additional affirmative defenses that will be developed throughout the discovery and testimony periods in this opposition proceeding.

WHEREFORE, Applicant, Konami Corporation, prays that:

1. Application Serial No. 76/074,595 be sustained.
2. Judgment in the opposition be entered in favor of Applicant, Konami Corporation.
3. The opposition proceeding be dismissed with prejudice.

Respectfully submitted,

KONAMI CORPORATION

Dated: December 27, 2003

By: Jeffrey H. Kaufman / By BBD

Jeffrey H. Kaufman  
Brian B. Darville  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1755 Jefferson Davis Highway  
Fourth Floor  
Arlington, Virginia 22202  
(703) 413-3000  
fax (703) 413-2220

Counsel for Applicant  
Konami Corporation

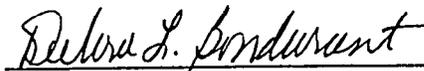
JHK/BBD/dlb

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**CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true copy of the foregoing **APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO THE NOTICE OF OPPOSITION** was served on counsel for Opposer, this 27<sup>th</sup> day of December, 2003, by sending same via First Class Mail, postage prepaid to:

William M. Ried, Esquire  
WILLKIE FARR & GALLAGHER  
787 Seventh Avenue  
New York, NY 10019

  
\_\_\_\_\_  
Debra L. Bohdurant

RECYCLED





paragraph 4 of the Notice of Opposition, and therefore denies those allegations. Applicant specifically denies that Opposer has gained substantial, valuable goodwill in its mark.

5. Applicant is without sufficient knowledge or information to form a belief as to the truth of those allegations set forth in paragraph 5 of the Notice of Opposition, and therefore denies same. Applicant specifically denies that Applicant's mark is distinctive.

6. Applicant denies the allegations set forth in paragraph 6 of the Notice of Opposition.

7. Applicant denies the allegations set forth in paragraph 7 of the Notice of Opposition.

8. Applicant admits that it is a Japanese corporation with principal offices at 2-4-1 Marunouchi, Chiyoda-ku, Tokyo, 100-6330 JAPAN, and otherwise denies the allegations stated in paragraph 8 of the Notice of Opposition.

9. Applicant admits that it has filed U.S. Application Serial No. 76/075,729 to register the mark YU-GI-OH in stylized Kanji characters for "playing cards; trading cards; calendars; posters; game instruction manuals; computer game instruction manuals; game instructions sheets; scoring sheets; books, namely strategy guides; stationary" in Class 16, as set forth in paragraph 9 of the Notice of Opposition.

10. Applicant denies the allegations set forth in paragraph 10 of the Notice of Opposition.

11. Applicant denies the allegations set forth in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations set forth in paragraph 12 of the Notice of Opposition.

13. Applicant admits that portion of paragraph 13 that alleges that Applicant would obtain a *prima facie* right to the exclusive use of Applicant's Mark once granted the registration herein opposed. Applicant otherwise denies the remaining allegations set forth in paragraph 13 of the Notice of Opposition.

### AFFIRMATIVE DEFENSES

1. The Notice of Opposition fails to state a claim upon which relief can be granted.
2. The claims asserted in the Notice of Opposition are barred by the doctrines of estoppel and laches.
3. The claims asserted in the Notice of Opposition are barred by the doctrines of acquiescence and waiver.
4. There is no likelihood of confusion between any of Opposer's marks and Konami's Mark shown in Application Serial No. 76/075,729.
5. Opposer's marks are different from Konami's mark shown in Application Serial No. 76/075,729 in terms of sight, sound, meaning and overall commercial impression.
6. Opposer's Marks are weak as they are comprised of a generic and/or descriptive initialism or abbreviation in that UGO stands for Underground Online and the marks are not, have not and cannot become distinctive of Opposer's goods or services in commerce.
7. Opposer's Marks are weak due to the presence of third party marks that cover related goods and services and thus Opposer's marks are entitled only to a very narrow scope of protection, if any.
8. Applicant will assert any and all additional affirmative defenses that will be developed throughout the discovery and testimony periods in this opposition proceeding.

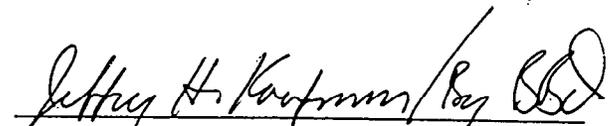
WHEREFORE, Applicant, Konami Corporation, prays that:

1. Application Serial No. 76/075,729 be sustained.
2. Judgment in the opposition be entered in favor of Applicant, Konami Corporation.
3. The opposition proceeding be dismissed with prejudice.

Respectfully submitted,

KONAMI CORPORATION

By:



Jeffrey H. Kaufman

Brian B. Darville

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.

1940 Duke Street

Alexandria, Virginia 22314

(703) 413-3000

fax (703) 413-2220

e-mail: [tmocket@oblon.com](mailto:tmocket@oblon.com)

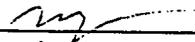
Date: April 4, 2003

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing **APPLICANT'S ANSWER AND AFFIRMATIVE DEFENSES TO NOTICE OF OPPOSITION** was served on counsel for Opposer, this 4th day of April, 2003, by sending same, via first class mail, postage prepaid to:

William M. Ried, Esquire  
Natasha Snitkovsky, Esquire  
**WILLKIE, FARR & GALLAGHER**  
787 Seventh Avenue  
New York, New York 10019

  
\_\_\_\_\_  
Regina P. Payne

RECYCLED

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

UGO NETWORKS, INC.,	)	Opposition No. 91/153,578
	)	Serial No. 76/074,595
Opposer,	)	Mark: KANJI CHARACTER Design
	)	Opposition No. 91/154,657
v.	)	Serial No. 76/075,729
	)	Mark: KANJI CHARACTER Design
KONAMI CORPORATION,	)	
	)	
Applicant.	)	
	)	
	)	

**STIPULATED MOTION TO CONSOLIDATE PURSUANT  
TO FED. R. CIV. P. 42 AND 37 C.F.R. § 2.127;  
AND STIPULATED MOTION FOR THE RESETTING  
OF DISCOVERY AND TESTIMONY PERIODS**

Serial No. 76/074,595 Opposition No. 91/153,578  
Serial No. 76/075,729 Opposition No. 91/154,657

Applicant, KONAMI CORPORATION, and Opposer, UGO NETWORKS, INC., by and  
through their undersigned attorneys of record, hereby jointly move the Board for:

(1) Consolidation of the following two opposition proceedings:

Serial No. 76/074,595 Opposition No. 91/153,578  
Serial No. 76/075,729 Opposition No. 91/154,657

(2) Re-setting of the discovery and testimony periods, with discovery closing on September 30, 2003 in the consolidated proceeding, and so that the parties can complete written discovery and depositions in an orderly fashion;

(3) an Order resetting the testimony dates as set forth below.

The parties respectfully submit that all requirements for consolidation of these two opposition proceedings, as required by Fed. R. Civ. P. 42, are met. The Opposer, UGO NETWORKS, INC., and the Applicant, KONAMI CORPORATION, are the same in both cases. Applicant has filed applications to register marks consisting of KANJI characters which transliterate to YU-GI-OH, which means "King of the Game." In each proceeding, Opposer has opposed the application on the alleged grounds that the mark is likely to cause confusion with Opposer's UGO marks, which is an initialism for the words Underground Online. There are common questions of law and fact in both proceedings. *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

This motion is timely. The Parties submit this stipulated motion while discovery is open in both proceedings and long before the testimony period in either proceeding has opened. Both oppositions are at a similar stage and consolidation is warranted. 5 Moore's Fed. Prac. & Proc. 4(e)(2)(6) (citing *Shooter's Island Shipyard Co. v. Standard Shipbuilding Corp.*, 4 F2d 101 (3<sup>rd</sup> Cir. 1925)).

The parties submit that consolidation will be economical and efficient; will expedite resolution of both proceedings; will eliminate duplicative discovery and depositions; will avoid

unnecessary costs and delay; and will prevent the possibility of inconsistent results. Consolidation will conserve the time and resources of the Board as well as the parties and their counsel.

The Board routinely consolidates proceedings involving similar marks to avoid duplication of effort, loss of time, and the extra expense involved in conducting the proceedings separately. *World Hockey Ass'n*, 185 USPQ at 248.

The parties stipulate that they will not be hampered nor prejudiced in their discovery efforts since consolidation does not change the rights of either party. Rather, the issues will still be individually adjudicated for each of Applicant's pending marks.

Conclusion

For the foregoing reasons, the Parties respectfully submit that consolidation is efficient and proper for these two related proceedings. Therefore, the Parties jointly request that the Board:

- (1) Grant this Motion and consolidate the two referenced opposition proceedings; and

(2) Reset the discovery and testimony periods in the consolidated proceeding as follows:

Discovery period to close: September 30, 2003

30-day testimony period for party  
in position of plaintiff to close: November 29, 2003

30-day testimony period for party  
in position of defendant to close: January 28, 2004

15-day rebuttal testimony period  
for plaintiff to close March 14, 2004

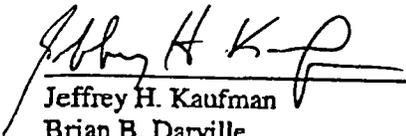
Respectfully submitted,

Respectfully submitted,

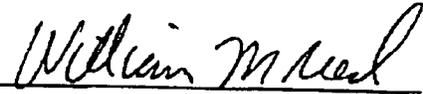
KONAMI CORPORATION

UGO NETWORKS, INC.

By:

  
Jeffrey H. Kaufman  
Brian B. Darville  
OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
1940 Duke Street  
Alexandria, VA 22314  
(703) 413-3000  
Fax: (703) 413-2220

By:

  
William M. Ried  
Natasha Snitkovsky  
WILLKIE FARR & GALLAGHER  
787 Seventh Avenue  
New York, NY 10019  
(212) 728-8000  
Fax: (212) 728-8111

Attorneys for Applicant

Attorneys for Applicant

Dated: March 19, 2003

Dated: March 17, 2003

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**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing **STIPULATED MOTION TO CONSOLIDATE PURSUANT TO F.R.C.P. RULE 42 and 37 C.F.R. § 2.127, and STIPULATED MOTION FOR THE RESETTING OF DISCOVERY AND TESTIMONY PERIODS** was sent via First Class mail, postage prepaid, this 14<sup>th</sup> day of March, 2003, to counsel for Opposer:

William M. Ried, Esquire  
WILLKIE FARR & GALLAGHER  
787 Seventh Avenue  
New York, NY 10019

Pamela L. Korcen

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

Mailed: April 23, 2003

Opposition Nos. 91-153,578  
91-154,657

UGO Networks, Inc.

v.

KONAMI CORPORATION

Peter Cataldo, Interlocutory Attorney

The parties' stipulated motion (filed March 19, 2003) to consolidate the above-referenced proceedings is hereby granted as well taken.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. See, for example, *Wright & Miller, Federal Practice and Procedure: Civil* §2383 (1971); and *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, for example, Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991).

Inasmuch as the parties to the instant proceedings are identical and the issues are substantially the same, Opposition Nos. 153,578 and 154,657 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. *See Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. 153,578 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all both proceeding numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, and briefs on the case. *See Trademark Rules 2.121(d) and 2.128.*

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate

judgment. See Wright & Miller, *Federal Practice and Procedure, supra*. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

The closing dates of the discovery and testimony periods are reset as requested in the parties' March 19, 2003 stipulated motion.

RECYCLED

FILE/DUPLICATE

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

In re Application of: )  
)  
Konami Corporation )  
)  
Serial No.: 76/203,232 )  
)  
Mark: YU-GI-OH! )  
)  
Filed: February 1, 2001 )  
)  
Published: Official Gazette )  
November 19, 2002 )  
Page TM 72 )

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
BOX TTAB - NO FEE  
Arlington, Virginia 22202-3513

Attention: Trademark Trial and Appeal Board

**REQUEST UNDER RULE 2.102 TO EXTEND  
TIME FOR FILING NOTICE OF OPPOSITION**

UGO Networks, Inc., a Delaware corporation, located at 670 Broadway, 2nd Floor, New York, New York 10012, Potential Opposer by and through its attorneys, hereby requests that the time for filing a Notice of Opposition to the above identified Application, due by December 19, 2002, be extended for an additional period of sixty (60) days up to and including February 17, 2003.

Potential Opposer is currently obtaining additional information regarding the Application. The requested extension is to enable Potential Opposer's attorneys to have

sufficient time to complete their investigation of this matter and to review this matter with Potential Opposer to determine whether an opposition against the Application should be filed.

Potential Opposer submits that it has shown good cause for this request and respectfully requests that the extension be granted.

This Request is submitted in triplicate, as required by 37 C.F.R. § 2.102(d).

Respectfully submitted,

**UGO NETWORKS, INC.**

By:   
Natasha Snitkovsky  
Attorney for Potential Opposer

WILLKIE FARR & GALLAGHER  
787 Seventh Avenue  
New York, New York 10019-6099  
(212) 728-8000

December 11, 2002

CERTIFICATE OF MAILING BY EXPRESS MAIL

EXPRESS MAIL LABEL NO.:EL798000770US

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail "Post Office to Addressee" addressed to: Assistant Commissioner for Trademarks, BOX TTAB - NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513 on December 11, 2002.



Victoria Nicolau