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

In the Matter of Application Serial No. 76/295,515  
Published in the Official Gazette on June 18, 2002



05-14-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

UNIVERSAL CITY STUDIOS, INC.,

Opposer,

v.

VALEN BROST,

Applicant.

Opposition No. 153,683

CERTIFICATE OF MAILING

I hereby certify that on May 14, 2003, this paper is being deposited with the U.S. Postal Service by "Express Mail Post Office to Addressee" service with Express Mail Label No. EL10135888US for delivery to the Commissioner for Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513.

*Eleanor Elko*  
Eleanor Elko

**OPPOSER'S REPLY BRIEF IN SUPPORT OF ITS MOTION FOR PARTIAL SUMMARY JUDGMENT STRIKING APPLICANT'S AFFIRMATIVE DEFENSES OF LACHES, ESTOPPEL, AND ACQUIESCENCE**

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Applicant Valen Brost ("Applicant") opposes the motion by opposer Universal City Studios, Inc. ("Universal")<sup>1</sup> for partial summary judgment on Applicant's equitable defenses primarily on the grounds that no discovery has yet been taken, Opp. at 2; Caldwell Decl. ¶¶ 2-4, and that the marks and goods at issue are legally equivalent for purposes of Applicant's *Morehouse* defense. As shown below, neither of these grounds is sufficient to raise a genuine

<sup>1</sup> Applicant's opposition is based in part on Universal's alleged lack of standing to oppose, in view of its motion under Rule 25(c) of the Federal Rules of Civil Procedure to substitute Universal City Studios LLLP as the opposer by virtue of the reorganization of Universal City Studios, Inc. into Universal City Studios LLLP. This portion of Applicant's opposition is utterly specious. As is self-evident from Universal's opening and reply papers on its routine motion to substitute, the same Universal entity has owned the relevant marks and name throughout this opposition; only its corporate form and name have changed. There is nothing to "be more fully explored in discovery," Opp. at 3, and this portion of Applicant's opposition should be rejected out of hand. Applicant also makes a somewhat contradictory argument that if Universal City Studios LLLP is recognized as the opposer, its claims are barred by laches and estoppel because that entity did not request an extension of time to oppose. Opp. at 4-5. This argument is equally absurd given that the opposer has been the same entity throughout the time periods relevant to Applicant's equitable defenses.

issue of material fact on any of Applicant's defenses, and Universal is entitled to judgment as a matter of law striking them.

## ARGUMENT

### I.

#### APPLICANT HAS FAILED TO CARRY HIS BURDEN UNDER RULE 56(f) OF THE FEDERAL RULES OF CIVIL PROCEDURE OF SHOWING THAT DISCOVERY IS NECESSARY TO DEFEND THIS MOTION.

Applicant's first ground for opposition is the fact that "[n]o discovery has yet been initiated in this case by either party." Opp. at 3. This is, of course, not a basis to deny an otherwise meritorious summary judgment motion. To delay the disposition of a summary judgment motion on the ground that the non-movant needs discovery pursuant to Rule 56(f) of the Federal Rules of Civil Procedure, the non-movant must specify precisely what discovery is needed and how the fruits of that discovery will create a genuine issue of material fact. *See, e.g., Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 9 USPQ2d 1736, 1738-39, n.5 (Fed. Cir. 1989).

The Caldwell declaration falls woefully short of meeting this standard. It states only that Applicant "intends to seek discovery concerning the marks and related goods claimed by Opposer, the chain of title with respect to said marks," and "any claimed damages to Opposer as they may relate to the marks 'UNIVERSAL GAMES' and 'UNIVERSAL TOYS,' respectively," and that "the discovery obtained *may allow Applicant to further identify genuine issues of material fact . . .*" Caldwell Decl. ¶¶ 3-4 (emphasis added). As shown *supra* note 1, there are no relevant issues regarding "the chain of title." On the equitable defenses of laches by acquiescence and estoppel, discovery from Universal could not yield facts that could be used by Applicant to create a triable issue. "Facts as to opposer's intent, knowledge and awareness of [A]pplicant's activities during the period preceding the institution of these opposition

proceedings could not possibly have any bearing on whether or not [A]pplicant had any reason to conclude that opposer's actions demonstrated opposer's consent to [A]pplicant's use and registration of [A]pplicant's mark. Any facts concerning opposer's acts which were interpreted by [A]pplicant in this way would necessarily be known to [A]pplicant, or else it could not have used them as a basis for concluding that opposer had decided not to object to [A]pplicant's registration of its mark." *DAK Indus. Inc. v. Daichi Kosho Co. Ltd.*, 25 USPQ2d 1622, 1625 (TTAB 1993).

Applicant has not come close to making the required showing that discovery is necessary to enable it to obtain evidence that would create a genuine issue of material fact, and Applicant's Rule 56(f) opposition to this motion should be rejected. Because Applicant has come forth with no evidence to sustain its burden of proof on the equitable defenses of laches by acquiescence and estoppel, Universal's motion as to those defenses should be granted.

## II.

### **APPLICANT HAS FAILED TO SHOW THE EXISTENCE OF A GENUINE ISSUE OF MATERIAL FACT ON APPLICANT'S MOREHOUSE DEFENSE.**

To avoid summary judgment on his *Morehouse* defense, Applicant must show a genuine issue of fact that both the marks and goods at issue are legally equivalent. He has shown neither.

#### **A. Applicant Has Failed to Show a Genuine Issue of Material Fact on the Issue of the Legal Equivalence of the Marks.**

On the issue of the legal equivalence of the marks "UNIVERSAL GAMES" and "UNIVERSAL TOYS," Applicant dismisses the Federal Circuit's decision in *O-M Bread Inc. v. United States Olympic Comm.*, 65 F.3d 933, 36 USPQ2d 1041 (Fed. Cir. 1995), holding that "OLYMPIC" and "OLYMPIC KIDS" were not legally equivalent when used on the same goods. Applicant claims that the Federal Circuit's analysis was "influenced by the Olympic Statutes cited therein and [is] not relevant here." Opp. at 3. But nothing in the Federal Circuit's decision

suggests that the fact that the opposition was based upon the Amateur Sports Act made any difference on the issue of whether the subject marks were legally equivalent. To the contrary, the Federal Circuit rejected the Board's conclusion that the *Morehouse* defense was unavailable in an opposition under the Amateur Sports Act, and considered the defense on its merits, concluding that the marks were "neither the same nor are they legal equivalents." *O-M Bread*, 36 USPQ2d at 1045-46. Applicant makes no effort to distinguish *O-M Bread* on the merits, and its analysis shows that there is no genuine issue of fact that the marks are not legally equivalent.

The only case cited by Applicant on the issue of the legal equivalence of the marks is the Board's pre-*Morehouse* decision in *Laura Scudder's v. Pacific Gamble Robinson Co.*, 136 USPQ 418 (TTAB 1962). Opp. at 3. Applicant's description of the facts of that case, however, is incomplete and misleading in a critical respect: the marks at issue in that case were not simply the words "BLUE BIRD" and "BLUE ROBIN," as suggested by Applicant, but instead were those words combined—in each instance—with a depiction of a blue bird. 136 USPQ at 419. Properly read, *Laura Scudder's* provides no support for Applicant's claim that the word marks "UNIVERSAL GAMES" and "UNIVERSAL TOYS" are legally equivalent.

To the extent that Applicant even addresses the marks at issue here, his only argument is that the words "toys" and "games" have some similarity in meaning. Opp. at 3. The dictionary definitions cited by Applicant make the opposite point, as they define "toy" and "game" differently, and Applicant is reduced to sophistry to make the word "toy" "fall within the definition of 'game'." *Id.* But even assuming that "toys" and "games" are somewhat similar in meaning when considered in the abstract, the marks "UNIVERSAL GAMES" and "UNIVERSAL TOYS" are not legally equivalent in overall sight, sound, and meaning.

Applicant himself conceded as much in his letter to the Patent and Trademark Office covering

the opposed application, in which he stated that he did not even consider the marks to be confusingly similar. Larkin Decl. Ex. 1.

But even if the marks might be considered confusingly similar for § 2(d) purposes, that is not enough; to be legally equivalent, they must be so similar as to be essentially one and the same mark. The marks here fall far short of meeting that exacting standard, and Applicant has failed to raise a genuine issue of material fact on the issue of their legal equivalence.

**B. Applicant Has Failed to Show a Genuine Issue of Material Fact on the Issue of the Legal Equivalence of the Goods.**

Applicant has also failed to show that there is a genuine issue of material fact on the legal equivalence of the goods. His position is nothing more than that “a toy is a specific type of game for children.” Opp. at 4. This argument is not based upon any real world evidence, but instead requires the strained juxtaposition of the dictionary definitions of “toy” and “game” discussed above. But more fundamentally, Applicant simply ignores what the relevant goods really are: not simply “games” and “toys” generally, but “board games” and “toy rockets.” As shown in Universal’s opening brief, these goods are clearly not legal equivalents.<sup>2</sup>

Because Applicant has failed to show the existence of a genuine issues of material fact that either the marks or goods are legally equivalent, Universal is entitled to judgment as a matter of law striking Applicant’s *Morehouse* defense.

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<sup>2</sup>Applicant’s citation of *LaFara Importing Co. v. F. Lli de Cecco*, 8 USPQ2d 1143 (TTAB 1988), Opp. at 4, is unavailing. Applicant appears to argue that the legal equivalence of “board games” and “toy rockets” somehow depends upon whether Universal’s § 2(d) claim is based upon its use of “UNIVERSAL” “in connection with ‘games’ or ‘toys.’” Opp. at 4. A review of Universal’s notice of opposition shows that it alleges use of various “UNIVERSAL” marks in connection with a wide variety of entertainment-related goods and services, including (but not limited to) toys and games. In any event, in *LaFara*, the Board rejected the very argument advanced by Applicant. *LaFara*, 8 USPQ 2d at 1147 (“[w]e do not read *Morehouse* and its progeny as broadly as does applicant”).

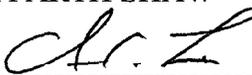
**CONCLUSION**

For all of the foregoing reasons, and for the reasons set forth in Universal's opening papers, Universal's motion for partial summary judgment striking Applicant's affirmative defenses should be granted in its entirety.

Dated: May 14, 2003

Respectfully submitted,

SEYFARTH SHAW

By: 

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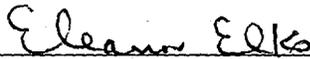
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**CERTIFICATE OF SERVICE**

I hereby certify that on May 14, 2003, I served the foregoing Opposer's Reply Brief in Support of Its Motion for Partial Summary Judgment on Applicant's Affirmative Defenses, on the applicant by depositing a true copy thereof in a sealed envelope, postage prepaid, in First-Class U.S. mail addressed to applicant's counsel as follows:

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