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

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

04-29-2003

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

<p>UNIVERSAL CITY STUDIOS, INC.,</p> <p style="text-align: center;">Opposer,</p> <p style="text-align: center;">v.</p> <p>VALEN BROST,</p> <p style="text-align: center;">Applicant.</p>	<p>Opposition No. 153,683</p> <p>I hereby certify that on April 29, 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. EL557578571US for delivery to the Commissioner for Trademarks, Box TTAB NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513</p> <p style="text-align: center;"><i>Kathy Mercado</i> Kathy Mercado</p>
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**APPLICANT'S OPPOSITION TO  
MOTION FOR PARTIAL SUMMARY JUDGMENT**

The Applicant hereby opposes the Opposer's Motion for Partial Summary Judgment to Strike Applicant's Affirmative Defenses of Laches, Estoppel, and Acquiescence.

This opposition is based upon the accompanying declaration, the pleadings in this action, the attached brief in opposition, and such other arguments and evidence as may be presented to the Board with respect to this Motion.

**APPLICANT'S BRIEF IN OPPOSITION  
TO MOTION FOR PARTIAL SUMMARY JUDGMENT**

**INTRODUCTION AND BACKGROUND**

Opposer seeks partial summary judgment with respect to three affirmative defenses alleged by the Applicant. Not only is the Motion for Partial Summary Judgment premature, in that discovery is not completed, but further, genuine issues of material fact exist with respect to said claims and partial summary judgment should be denied.

## ARGUMENT

### A. THE MOTION FOR SUMMARY JUDGMENT IS PREMATURE.

No discovery has yet been initiated in this case by either party. Where a party has been unable to exercise its opportunities for discovery, summary judgment is only possible in very narrow circumstances. Fed.R.Civ.P. 56(f); Nat'l. Life Ins.Co. v. Solomon, 529 F.2d 59, 61 (2d Cir. 1975). Many cases state that continuances should be routinely granted under Rule 56(f) where the moving party has sole possession of the relevant facts. Hebert v. Wicklund, 755 F.2d 218, 222 (1<sup>st</sup> Cir. 1984). As set forth in the Declaration of Kenneth N. Caldwell attached hereto as Exhibit A, discovery is necessary to address some of the issues raised by the Motion for Partial Summary Judgment.

### B. STANDARD FOR SUMMARY JUDGMENT.

The case of Nat'l. Cable Television Ass'n. Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 19 USPQ2d 1424, 1727 (Fed.Cir. 1991) appears to be misquoted with respect to summary judgment as to equitable defenses. That case was resolved on cross-motions for summary judgment. It would be premature in this case for the court to entertain a Motion for Partial Summary Judgment on limited defenses before discovery is completed.

### C. STANDING TO OPPOSE UNDER SECTION 2(d).

Universal Studios, Inc.'s admission<sup>1</sup> that it is not the owner of certain "UNIVERSAL" marks pleaded in its opposition means that it must show that it has some other legitimate interest in preventing confusion. Holmes Prods. Corp. v. Duracraft Corp., 30 U.S.P.Q.2d 1549, 1551 (T.T.A.B. 1994). Since Universal Studios, Inc. has not shown any other legitimate interest in preventing

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<sup>1</sup> See Opposer's Notice of Motion for Order Substituting Universal City Studios LLLP, as successor-in-interest to Universal City Studios, Inc.

confusion by affidavit or otherwise, there is a genuine issue of material fact concerning standing and the Motion for Partial Summary Judgment should be denied. Opposer's rights, if any, in the "UNIVERSAL" marks are issues that will be more fully explored in discovery, and therefore, it is too early to determine whether Opposer has any standing to respond fully to the arguments set forth herein.

**D. THE MARKS ARE LEGAL EQUIVALENTS.**

The Opposer claims that the marks "UNIVERSAL GAMES" in the prior registration and the mark "UNIVERSAL TOYS" in the opposed application are not the same or legally equivalent. It has been held, however, that the marks "BLUE BIRD" and "BLUE ROBIN" create substantially the same general impression and are thus legal equivalents. Laura Scudder's v. Pacific Gamble Robinson Co., 136 U.S.P.Q. 418, 419-20 (TTAB 1962). The same is true, if not more so, here.

In its most simplistic form, the suffix "TOYS" is a subset of the suffix "GAMES." The American Heritage Dictionary defines "game" as: "[a] way of amusing oneself; a past time; diversion." The same dictionary defines "toy" as "an object for children to play with." Since a toy can also be "a way of amusing oneself, it also falls within the definition of "game." By definition, therefore, a toy is a specific type of game, i.e. "a way of amusing oneself," for children. UNIVERSAL TOYS and UNIVERSAL GAMES thus arguably convey the same commercial impression and are legal equivalents, just as BLUE ROBIN and BLUE BIRD are legal equivalents.

The case of O-M Bread, Inc. v. United States Olympic Committee, 65 F.3d 933 (Fed.Cir. 1995) relied upon by the Opposer is influenced by the Olympic Statutes cited therein and not relevant here. And although OLYMPIC KIDS in that case was not deemed the legal equivalent of OLYMPIC, no discussion existed about whether the mark OLYMPIC KIDS would be the legal equivalent of OLYMPIC CHILDREN, a discussion which is more akin to the case here.

Furthermore, the terms “toys” and “games” are almost always used together, and are often used interchangeably to describe a single category. A Google internet search reveals millions of results that contain both search terms, i.e. “games” and “toys,” together. There are few other words that are so closely aligned with each other as the words “games” and “toys.”

**E. THE GOODS ARE LEGAL EQUIVALENTS.**

As discussed above, a toy is a specific type of game for children. Since the Applicant already has the right to the mark “UNIVERSAL GAMES,” it follows that Opposer cannot be damaged by the use of a term that is a subset of games. As admitted by Opposer, both goods are essentially toys for children and are, as such, legal equivalents.

Importantly, it is not clear whether Opposer claims damage because UNIVERSAL TOYS will be confusingly similar to the use of its marks in connection with “games” or “toys.” To the extent it claims damage in connection with games, its opposition is not timely. LaFara Importing Co. v. F.Lli de Cecco, 8 USPQ2nd 1143, 1147 (T.T.A.B. 1988). Further information on these issues is necessary and summary judgment would be premature at this time.

**F. UNIVERSAL CITY STUDIOS, LLLP IS ESTOPPED FROM MAKING ANY ARGUMENT ON ITS BEHALF.**

Universal City Studios, LLLP has filed a motion to be substituted in place of Universal City Studios, Inc., however, the affirmative act of having one entity filing an opposition is an affirmative act that would legitimately lead Applicant to believe that the former named entity would not oppose Applicant’s registration of the mark, and therefore it should be estopped from doing so.

**G. UNIVERSAL CITY STUDIOS, LLLP’s ARGUMENT IS BARRED BY LACHES.**

The Opposer’s laches argument is likewise unsustainable. Even if the laches period begins to run when the mark is published for opposition, i.e., June 18, 2002, Universal City Studios, LLLP’s attempt to file a Motion for Partial Summary Judgment when it neither requested an extension of

time nor opposed the registration constitutes laches as a matter of law.

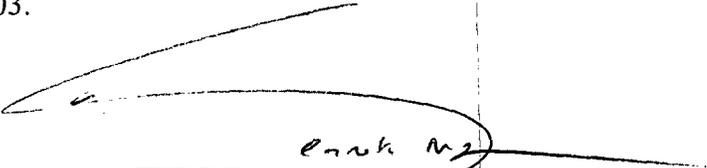
### CONCLUSION

The Applicant seeks time to conduct discovery in this action before responding to a Motion for Partial Summary Judgment, specifically to determine what marks and for what goods Opposer had an interest, if any, at the time of initiating this proceeding.

In addition, the marks "UNIVERSAL GAMES" and "UNIVERSAL TOYS" and the goods associated therewith constitute legal equivalents.

Finally, genuine issues of material fact exist which preclude entry of judgment at this time and Applicant requests time to conduct discovery pursuant to Rule 56(f). Based on the foregoing, the Applicant requests that Opposer's Motion for Partial Summary Judgment be denied.

Dated this 29<sup>th</sup> day of April, 2003.

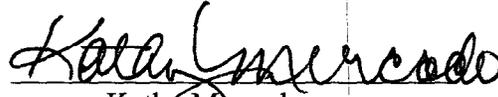
  
KENNETH N. CALDWELL, Esq.  
Skinner, Watson & Rounds  
548 California Avenue  
Reno, Nevada 89509  
Attorney for VALEN BROST

**CERTIFICATE OF SERVICE**

I hereby certify that on April 29, 2003, I served the foregoing **Applicant's Opposition to Motion for Partial Summary Judgment**, on the applicant by mailing a true copy thereof by first class mail, postage prepaid, addressed to Opposer's counsel as follows:

Joan Kupersmith Larkin  
Christoper C. Larkin  
2029 Century Park East, Suite 3300  
Los Angeles, CA 90067-3063

Dated this 29 day of April, 2003.

  
Kathy Mercado

LEGAL DIMENSIONS  
800-535-7753

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**DECLARATION OF KENNETH N. CALDWELL**  
**IN OPPOSITION TO OPPOSER'S MOTION**  
**FOR PARTIAL SUMMARY JUDGMENT**

I, Kenneth N. Caldwell, hereby declare:

1. I am an attorney licensed to practice law in the States of Nevada and Colorado and am a member of the firm of Skinner, Watson & Rounds, counsel for Applicant Valen Brost ("Brost"). I make this declaration on the basis of my own personal knowledge and in Opposition to Opposer's Motion for Partial Summary Judgment.

2. Neither party has yet initiated or completed any discovery in this proceeding.

3. Applicant intends to seek discovery concerning the marks and related goods claimed by Opposer, the chain-of-title with respect to said marks. In addition, Applicant will seek discovery concerning any claimed damages to Opposer as they may relate to the marks "UNIVERSAL GAMES" and "UNIVERSAL TOYS," respectively.

4. Upon information and belief, the discovery obtained may allow Applicant to further identify genuine issues of material fact in response to the Motion for Partial Summary Judgment.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct.

Executed this 29<sup>th</sup> day of April, 2003, at Reno, Nevada.

A handwritten signature in black ink, appearing to read "Kenneth N. Caldwell", written over a horizontal line.

Kenneth N. Caldwell