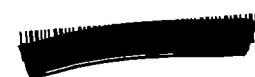


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Vivendi Universal Games, Inc.,)
)
Opposer,)
)
v.)
)
Sony Computer Entertainment America Inc.,)
)
Applicant.)

Opposition No. 91159480



04-19-2004

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

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

Sir:

**OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS
FOR FAILURE TO STATE A CLAIM OR, IN THE ALTERNATIVE,
FOR A MORE DEFINITE STATEMENT**

This memorandum is submitted on behalf of Opposer Vivendi Universal Games, Inc. ("Vivendi") in opposition to Applicant Sony Computer Entertainment America Inc.'s ("SCEA") motion to dismiss for failure to state a claim upon which relief may be granted or, in the alternative, for a more definite statement.

SCEA's motion to dismiss must be denied because the only issue at this early stage is whether Vivendi's Notice of Opposition states a valid legal claim. Vivendi has clearly satisfied this low threshold requirement. Specifically, Vivendi's Notice of Opposition states Vivendi's interest in, and use of, the LORDS OF THE REALM, LORDS OF MAGIC and LORD OF DESTRUCTION marks and corresponding federal

registrations. It also states that Vivendi will be damaged by SCEA's use and registration of the confusingly similar LORDS OF EVERQUEST mark.

ARGUMENT

1. VIVENDI'S CLAIM IS LEGALLY SUFFICIENT BECAUSE VIVENDI HAS ALLEGED THAT APPLICANT'S LORDS OF EVERQUEST MARK IS CONFUSINGLY SIMILAR TO PREVIOUSLY USED AND REGISTERED MARKS IN WHICH VIVENDI HAS AN INTEREST

A motion to dismiss under Fed. R. Civ. P 12(b)(6) for failure to state a claim upon which relief may be granted is a test solely of the legal sufficiency of the complaint. See, e.g., Advanced Cardiovascular Sys. v. SciMed Life Sys., 26 USPQ2d 1038, 1041 (Fed. Cir. 1993) ("A motion made under Rule 12(b)(6) challenges the legal theory of the complaint, not the sufficiency of any evidence that might be adduced."). Accordingly, to withstand SCEA's motion, Vivendi's Notice of Opposition needs only to have alleged facts which, if proven, would establish that (1) Vivendi has standing to challenge SCEA's right to registration, and (2) a valid ground exists for having SCEA's LORDS OF EVERQUEST application refused. Consolidated Natural Gas Co. v. CNG Fuel Systems Ltd. 228 USPQ 752, 753 (TTAB 1985). For purposes of determining a motion to dismiss for failure to state a claim, the Board must accept Vivendi's allegations as true and construe them broadly in the light most favorable to Vivendi. TBMP § 503.02 (citing various cases). Furthermore, dismissal for insufficiency is appropriate only if it appears certain that Vivendi is entitled to no relief under any set of facts that could be proved in support of its claim. Id.

A. Vivendi Has Standing to Oppose SCEA's Application to Register LORDS OF EVERQUEST

Vivendi has a direct and personal stake in the outcome of the opposition. Vivendi has alleged prior use and registration, through its predecessors, business units and itself, of LORDS OF THE REALM, LORDS OF MAGIC and LORD OF DESTRUCTION. Notice of Opposition, ¶¶2-8. SCEA has challenged Vivendi's standing by arguing that Vivendi is not the record owner of the registrations, and that Vivendi cannot therefore claim damage based on the registrations.

SCEA's argument is similar to one rejected by the TTAB in Central Mfg. Co. v. Outdoor Innovations, L.L.C., 1999 TTAB LEXIS 235 (TTAB 1999). In that case, the opposer relied on Registration No. 1,615,004 for the mark TERMINATOR in its opposition. Id. at 2. The opposer alleged that it held rights in the TERMINATOR registration, that it had used TERMINATOR long prior to applicant's filing date, and that there was a likelihood of confusion. Id. The applicant challenged standing in a Rule 12(b)(6) motion to dismiss because the TERMINATOR registration did not list the opposer as the owner. Id. The Board denied the motion to dismiss, stating:

Any issues concerning chain of title to the pleaded registration should be tested by means of discovery procedures and/or testimony rather than by means of a motion to dismiss. Opposer's failure to establish its ownership of the pleaded registration would not eliminate likelihood of confusion as a ground for opposition inasmuch as opposer has relied on prior use as well as registration of the mark.

Id. at 4.

Similarly, Vivendi has based its opposition on certain registrations *and* upon prior use of the marks in those registrations. Therefore, even assuming that Vivendi is not

entitled to the prima facie presumptions afforded federal registrations by the Lanham Act (validity, ownership, etc.), Vivendi still has standing based on its properly alleged prior use. In fact, the Fuld case cited by SCEA recognizes this distinction between registration and use in the context of a cancellation proceeding, holding that “respondent’s assertion that petitioner cannot rely upon [its subsidiary’s] use of ‘OUT’, as distinguished from the registration thereof, is without merit.” Fuld Bros., Inc. v. Carpet Technical Service Institute, Inc., 174 USPQ 473, 476 (TTAB 1972).

B. Vivendi Has Stated a Valid Basis For Opposition, Namely That a Likelihood of Confusion Exists, and the Underlying Merits of the Likelihood of Confusion Claim Should Not Be Decided on a Motion to Dismiss

SCEA has not challenged the legal sufficiency of Vivendi’s Notice of Opposition, but has instead attempted to prove that there is no likelihood of confusion. In particular, SCEA argues that: (1) there is a “crowded field” of marks with LORDS OF or LORD OF prefixes; (2) customers are used to seeing these prefixes with other distinguishing elements; (3) Vivendi’s distinguishing elements DESTRUCTION, REALM and MAGIC are ordinary dictionary words, while SCEA’s distinguishing element EVERQUEST is different from Vivendi’s distinguishing elements and is a coined word; and (4) the LORDS OF/LORD OF prefix is inherently weak.

SCEA confuses *pleading* with *proof*. These arguments do not bear in any way on the legal sufficiency of Vivendi’s claim that it will be damaged if SCEA obtains a registration. If anything, SCEA’s detailed substantive response affirms that Vivendi has in fact asserted a valid basis for its opposition.

At this early stage, Vivendi need only satisfy the low threshold of properly alleging standing and a valid basis for opposing SCEA's application. Vivendi's pleading satisfies this low threshold requirement. Whether Vivendi can actually prove its allegations is not to be determined upon motion to dismiss, but rather at final hearing or upon summary judgment, after both parties have had a full and fair opportunity to obtain and submit evidence. C.f. Syndicat de la Parfumerie Francaise v. Scaglia, 173 USPQ 383 (TTAB 1972).

2. VIVENDI'S ALLEGATIONS ARE SUFFICIENTLY DEFINITE, AND SCEA'S ALTERNATIVE MOTION FOR A MORE DEFINITE STATEMENT SHOULD BE DENIED

SCEA claims that Vivendi cannot assert rights in LORD OF DESTRUCTION by itself, because the mark is a subsidiary element of DIABLO II: LORD OF DESTRUCTION. SCEA claims that Vivendi should have to amend its Notice of Opposition to "provide full information as to the exact nature of its alleged common law mark."

However, SCEA's own papers demonstrate that a more definite statement is neither needed nor appropriate. A motion for a more definite statement is only appropriate in cases where the pleading is so vague or ambiguous that the moving party cannot reasonably be required to frame a responsive pleading. Fed. R. Civ. P. 12(e). SCEA can hardly argue that it is unable to frame a responsive pleading, because the detail and substance of SCEA's response shows that Vivendi's Notice of Opposition stated a valid and sufficiently definite basis for having SCEA's application refused. Furthermore, SCEA cannot use its motion as a pretext to obtain discovery. See TMBP § 505.01 ("A

motion for a more definite statement may not be used to obtain discovery. The only information that a movant may obtain by this motion is that which it needs to make its responsive pleading.”).

CONCLUSION

For the reasons stated above, the Board should deny SCEA’s motion to dismiss for failure to state a claim and its alternative motion for a more definite statement. Vivendi has stated a valid and sufficiently definite legal basis for the opposition, namely that because of the prior use and registration of LORDS OF THE REALM, LORDS OF MAGIC and LORD OF DESTRUCTION, Vivendi will be harmed by SCEA’s continued use and registration of the confusingly similar LORDS OF EVERQUEST mark. The Board should not resolve the opposition at this early stage, but rather should wait until after the parties have had a full and fair opportunity to present evidence.

Dated this 14th day of April, 2004.

CERTIFICATE OF MAILING

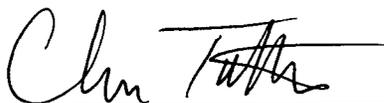
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Trademarks, BOX TTAB NO FEE, 2900 Crystal Drive, Arlington, Virginia 22202 on April 14, 2004.



Renee Knight

Respectfully submitted,

KOLISCH HARTWELL, P.C.



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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM OR, IN THE ALTERNATIVE, FOR A MORE DEFINITIVE STATEMENT, was served on Opposer, by service on its attorney James P. Williams, of Sony Computer Entertainment America Inc., 919 East Hillsdale Boulevard, Foster City, California 94404, by mailing same via first class mail, postage prepaid, to the aforementioned address this 14th day of April, 2004.



Christopher S. Tuttle
Of Attorneys for Opposer