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

In the Matter of Application Number: 76/499,795
Mark: LORDS OF EVERQUEST
Application Filed: March 24, 2003
Application Classes: 9, 41
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04-26-2004
U.S. Patent & TMO/TM Mail Rcpt Dt. #78

VIVENDI UNIVERSAL GAMES
INC.,

Opposer,

v.

SONY COMPUTER ENTERTAINMENT
AMERICA INC.,

Applicant.

Opposition No. 91159480

APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION
TO DISMISS FOR FAILURE TO STATE A CLAIM

Applicant submits this reply to Opposer's response to Applicant's Motion to Dismiss for Failure to State a Claim. Opposer's citation of Central Mfg. v. Outdoor Innovations, LLC, 1999 TTAB Lexis 235 (TTAB 1999) mischaracterizes the facts of that case and should not be given any weight by this Board.

In its Memorandum in Support of its Motion to Dismiss, Applicant presented evidence in the form of post-Notice of Opposition status and title copies to prove that

Opposer is not the owner of the registrations on which it relies in the opposition.

Applicant summarized its claim with respect to these registrations as follows:

Because Vivendi cannot claim damage based on registrations which it does not own, Vivendi has failed to state a claim with respect to the above-identified registrations for LORD OF DESTRUCTION, LORDS OF THE REALM and LORDS OF MAGIC, and the opposition **with respect to these registrations** should be dismissed. (emphasis added).

(Applicant's Memorandum, pps. 3-4)

Nowhere in its Notice of Opposition or in its response to Applicant's Motion to Dismiss does Opposer state or offer any proof that an assignment of these registrations has been effected between their record owners and Opposer. Without such statements or proof, the distinctions between claims of right under asserted registrations and common law claims must be given full weight. See Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc., 174 U.S.P.Q. 473, 475-76 (T.T.A.B. 1972).

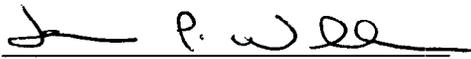
Opposer's response claims that the facts of Central Mfg. v. Outdoor Innovations, supra, are identical to the first count of Applicant's motion in this case. This claim is a mischaracterization in two critical ways. In Central Mfg., the Board treated Applicant's motion as "one to dismiss in its entirety." Id. Here, as noted above, in its first count Applicant is seeking to dismiss with respect to registration claims **only** and not with respect to any common law claims. Further, in Central Mfg., Opposer "submitted PTO assignment records" to support its claim that an assignment of title had taken place. Id. Here, as noted above, Opposer has made no claim and offered no proof that such an assignment has taken place. Thus, the central issue with respect to the first count of Applicant's Motion is not the legitimacy of an executed assignment (as in Central Mfg.) but rather the complete lack of one.

For the reasons stated above, the Board should apply the law of Fuld Brothers and grant Applicant's Motion. Accordingly, pursuant to its authority under TBMP 503.04, ~~the~~ Board should issue a notice converting Applicant's Motion to Dismiss into a Motion for Summary Judgment, and giving Opposer a reasonable opportunity to present all material pertinent to such a motion.

Dated: Foster City, California

April 26, 2004

Respectfully submitted,

By: 

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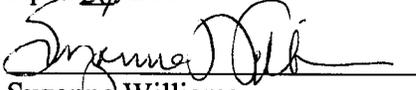
CERTIFICATE OF MAILING

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I hereby certify that this APPLICANT'S REPLY TO OPPOSER'S RESPONSE TO APPLICANT'S MOTION TO DISMISS is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513, on

April 26, 2004.


Suzanne Williams

CERTIFICATE OF SERVICE

I hereby certify that true and correct copies of APPLICANT'S REPLY TO OPPOSER'S RESPONSE APPLICANT'S MOTION TO DISMISS were served upon:

Christopher S. Tuttle, Esq.
Kolisch Hartwell P.C.
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by placing copies of the same in an envelope, properly sealed and addressed, with postage prepaid, and deposited in the United States Mail, located at 919 East Hillsdale Blvd., Foster City, CA 94404, on this 26th day of April, 2004.


Suzanne Williams