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

Proceeding	91166487
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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. 78/359,895
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For the Mark: MEMORY MAGIC in International Class 28
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HASBRO, INC. Opposer, v. CREATIVE ACTION LLC, Applicant.	:	Opposition No. 91/166,487

OPPOSER'S MEMORANDUM OF LAW IN OPPOSITION
TO APPLICANT'S MOTION FOR SUMMARY JUDGMENT

Opposer Hasbro, Inc. ("Hasbro") respectfully submits this memorandum of law in opposition to Applicant's motion for summary judgment on the validity of the MEMORY® trademark.

PRELIMINARY STATEMENT

The motion for summary judgment by Applicant Creative Action LLC ("Applicant" or "Creative Action") was based on a rather silly attempt to claim that Hasbro had admitted that its famous MEMORY® trademark for a best-selling children's game was generic. Applicant's attempt to take advantage of an uncertainty about whether Hasbro still needed to respond to a request to admit that was made before Hasbro's motion to amend its pleading failed.

The Board quickly and rightly rejected Applicant's attempt to stop Hasbro from serving the justified denials to Creative Action's request for admissions of genericism.

Creative Action is now stuck with a motion based on almost no real evidence. Against it, Hasbro has marshaled a plethora of factual evidence and expert opinion, most notably a consumer survey showing that a majority of the relevant public understands MEMORY® to be a brand name; Creative Action has no survey evidence to the contrary. Hasbro also submits fact and expert testimony showing that MEMORY® was not generic at the time of Milton Bradley's first registration of the mark and it is not generic now; Creative Action submits no fact or expert testimony to the contrary.

All that Creative Action has is a vacated preliminary injunction decision, which is not evidence, and which was reached without the survey that Hasbro now submits. Moreover, even if the decision were still a valid (rather than vacated) one, it implicitly rejected the proposition that the validity of the mark was susceptible to summary judgment by explicitly acknowledging that Hasbro might prevail at trial with the evidence then at hand. The district court also acknowledged that survey evidence on the genericness issue could be determinative, and that is what Hasbro is submitting to this Board.

Creative Action cannot meet its burden to show that no genuine issue of material fact exists with regard to MEMORY®'s alleged genericness. Creative Action's motion for summary judgment should accordingly be denied.

HASBRO'S MEMORY® GAMES AND TRADEMARKS

Through its acquisition of Milton Bradley Company ("Milton Bradley") in 1984, Hasbro has become the largest distributor of games in the United States. Milton Bradley began to sell a card matching game under the name and trademark MEMORY® in 1966. Milton

Bradley and Hasbro, its successor, have been selling MEMORY® card matching games continuously ever since the first sale in 1966. Hasbro owns an incontestible federal trademark registration for the MEMORY® mark, granted in 1967, for use on "[e]quipment comprising cards with many matching pairs of designs for playing a matching card game." Hasbro also owns a federal trademark registration for MEMORY® granted in 2004. Declaration of Mark Stark ("Stark Decl.") ¶¶ 4-5.

A. MEMORY® Game Play and Popularity

Hasbro's MEMORY® game consists of a number of pairs of matching cards, typically 36, that feature characters, images, or other artwork on one side. The players mix the cards up and place them in rows on a flat surface, face down. They then take turns turning any two cards picture-side-up. If the two cards a player selects are identical, the player has made a match; the player then removes those cards from play and takes another turn. The process is repeated until the players take all of the cards out of play. The winner is the player who has taken the most matching pairs of cards out of play. Stark Decl. ¶ 6.

In addition to the original MEMORY® game, Hasbro and its predecessor, Milton Bradley, have created numerous themed versions of the MEMORY® card matching game, which have helped to expand the popularity of Hasbro's MEMORY® line of card matching games.[1] Indeed, MEMORY® is one of the best-selling pre-school games and it has generated revenues of over $160 million since it was first introduced in 1966. Stark Decl. ¶¶ 8-9.

[1] Some of these themed versions feature characters and images from other Hasbro toys, such as MR. POTATO HEAD and TONKA. Other themed versions feature characters and images that Hasbro has licensed from others. Examples include: POOH, BOB THE BUILDER, POKEMON, DORA THE EXPLORER, DISNEY, TOY STORY, BACKYARDIGANS, and DIEGO Editions. Stark Decl. ¶ 8.

B. MEMORY® Registrations

Hasbro's predecessor Milton Bradley acquired the United States rights to the MEMORY® game from a German company called Otto Maier Verlag Ravensburg ("Ravensburg") in 1964. The agreement that granted Milton Bradley rights to the MEMORY game was negotiated by Millens W. Taft, Jr., who at the time Milton Bradley began selling the MEMORY® game in the United States in 1966, was not aware of any other use, commercial or otherwise, of the name "Memory" for a game. Declaration of Millens W. Taft ("Taft Decl.") ¶¶ 2-3. Indeed, Mr. Taft was interested in the license from Ravensburg because of the name, which he believed was the primary reason for the game's success. Id. ¶ 2.

With the knowledge and concurrence of Ravensburg, Milton Bradley applied for federal registration of the MEMORY® trademark in 1966. Taft Decl. ¶ 4. Registration was granted as of August 29, 1967. Stark Decl., Exh. 1. That registration became incontestable in 1972. Id. ¶ 5. Hasbro also filed a subsequent application to register the MEMORY® trademark, which was granted as of October 19, 2004. Id., Exh. 2.

Aside from Mr. Taft, the Trademark Examiner was in the best position in 1966 to know whether Memory was the common name for a standard card game. Just as Mr. Taft had a duty to his employer not to waste money buying what was free, the Trademark Examiner had a duty to the government and to the public not to give Milton Bradley a presumptive right to a publicly available name. The Trademark Examiner never raised a genericness objection to registration.

PRIOR LITIGATION REGARDING HASBRO'S MEMORY® TRADEMARK

Hasbro has sued twice for infringement of its MEMORY® trademark. The first case, Hasbro, Inc. v. Kellogg Company et ano., 03 Civ. 3645 (LAP), in the Southern District of New York, was settled and withdrawn pursuant to a confidential agreement in 2003. The

second, Hasbro, Inc. v. MGA Entertainment, Inc., C.A. No. 06-262 S, in the District of Rhode Island, was settled pursuant to a confidential agreement and consent judgment in 2008. In the latter case, MGA had asserted a counterclaim that Hasbro's trademark was generic. Declaration of Kim Landsman ("Landsman Decl.") ¶¶ 1-6.

The consent judgment in the MGA case (Landsman Decl., Exh. A) vacated the prior preliminary injunction decision, Hasbro, Inc. v. MGA Entertainment, Inc., 497 F. Supp.2d 337 (D.R.I. 2007), that Creative Action uses to cast doubt on the mark's validity. The judgment reiterated the Court's prior determination that Hasbro could prevail at trial, upheld the validity of the MEMORY® trademark, and enjoined MGA from further use of the mark. It provides, in pertinent part, that

> 2. This Court hereby vacates its Memorandum and Decision dated July 31, 2007, denying Hasbro's motion for a preliminary injunction. As noted in that decision, Hasbro might have at trial successfully negated MGA's attempts to prove genericness and ultimately establish its infringement claim.
>
> . . .
>
> 6. Hasbro is the owner of the valid, subsisting Registration Nos. 834,282 and 2,894,970 for the trademark MEMORY® for board games in the United States Patent and Trademark Office.
>
> 7. MGA's counterclaims filed in this action are dismissed with prejudice.
>
> 8. Pursuant to Fed. R. Civ. P. 65 and 15 U.S.C. § 1116, MGA is permanently enjoined from using the term "memory" as all or part of the name of a game, except pursuant to license from Ravensburger AG [Hasbro's licensor of the MEMORY® trademark].

Accordingly, if the MGA case has any relevance, it is in its ultimate determination that the mark is valid. It is certainly that the mark's validity cannot be determined as a matter of summary judgment.

CREATIVE ACTION'S COUNTERCLAIM AND MOTION FOR SUMMARY JUDGMENT

Hasbro initiated this opposition in August 2005, in response to Creative Action's intent-to-use application to register "Memory Magic" as a trademark in International Class 28 as a game. SJ Motion at 1. Creative Action, in turn, asserted affirmative defenses and counterclaimed to cancel the registrations for MEMORY® relied upon by Hasbro in its Notice of Opposition. Id. at 2. Creative Action's counterclaim ("Counterclaim") alleged that the word "memory" is the common or class name for matching or recall card games and therefore Hasbro's registrations for the word "memory" for such goods should be cancelled as generic. Id.

Through subsequent discovery, Hasbro learned that Creative Action's application to register "Memory Magic" inaccurately described the product in such a way as to suggest similarities to Hasbro's MEMORY® game – and a likelihood of confusion – where there is none. Simply put, Creative Action's product is not a game; it is instead a therapeutic device for senior citizens with dementia.

Once the product's true nature was determined, Hasbro moved to amend its notice of opposition, to withdraw its original claims and to introduce a claim to restrict and/ or modify Applicant's description of goods pursuant to Section 18 of the Lanham Act, 15 U.S.C. § 1068 and a claim for lack of bona fide intent to use pursuant to 15 U.S.C. § 1051(b). On May 13, 2010 the Board granted Hasbro's motion to amend.

Although it had not (and has not yet) answered Hasbro's amended notice, Creative Action filed the instant motion for summary judgment on its (now superseded) Counterclaim on May 27, 2010. In its June 3, 2010 order, the Board elected to entertain Creative Action's motion for summary judgment, notwithstanding that it was filed before an answer to the amended notice.

STANDARD OF REVIEW

Creative Action's motion for summary judgment is governed by Fed. R. Civ. P. 56. "The burden is on a party moving for summary judgment to show the absence of any genuine issue of material fact and that it is entitled to judgment as a matter of law. [citation omitted]. The evidence of record and any inferences which may be drawn from the underlying undisputed facts must be viewed in the light most favorable to the nonmoving party." Warner-Lambert Co. v. Sports Solutions, Inc., 39 U.S.P.Q.2d 1686, 1690 (T.T.A.B. 1996) (citing Olde Tyme Foods, Inc. v. Roundy's Inc., 961 F.2d 200, 22 U.S.P.Q. 2d 1542 (Fed. Cir. 1992)).

Only "[w]hen a sufficiently supported motion has been submitted" does the "burden of coming forward and showing that there is a genuine issue of material facts shift[] to the non-movant." Laitram Corp. v. NEC Corp., 952 F.2d 1357, 1363, 21 U.S.P.Q.2d 1276, 1281 (Fed. Cir. 1991). That burden on the non-movant is not, however, to prove its case, but only to "point to an evidentiary conflict created on the record," Armco, Inc. v. Cyclops Corp., 791 F.2d 147, 149, 229 U.S.P.Q. 721, 722 (Fed. Cir. 1986), and then to present sufficient evidence to show that "a reasonable fact finder could decide the question in favor of the non-moving party." Opryland USA, Inc. v. Great American Music Show, Inc., 970 F.2d 847, 850, 23 U.S.P.Q.2d 1471, 1472 (Fed. Cir. 1992). The evidence submitted by the non-movant "is to be believed, and all justifiable inferences are to be drawn in [its] favor." Id. Finally, all reasonable doubts drawn from the record should be resolved in favor of the non-movant. E.g., Colgate-Palmolive Co. v. S.C. Johnson & Son, Inc., 159 U.S.P.Q. 56, 57 (T.T.A.B. 1968).

Creative Action has failed to show that there is an absence of any genuine issue of material fact regarding MEMORY®'s alleged genericness. To the contrary, as set forth below,

substantial evidence shows that Hasbro's mark is valid, so the issue must await trial on the merits.

CREATIVE ACTION CANNOT OVERCOME THE STRONG PRESUMPTION THAT HASBRO'S MEMORY® MARK IS NOT GENERIC.

Creative Action's motion for summary judgment on its Counterclaim argues that MEMORY® is a generic term for matching or recall card games. See SJ Motion at 2. "A generic term is one that is commonly used as the name of a kind of goods . . . . Unlike a trademark which identifies the source of a product, a generic term merely identifies the genus of which a particular product is a species." Liquid Controls Corp. v. Liquid Control Corp., 802 F.2d 934, 936 (7th Cir. 1986). Terms are deemed to be generic under two principal circumstances: "where a seller appropriates an existing generic term and claims exclusive rights in it," and "where a seller establishes trademark rights in a term which a majority of the relevant public then appropriates as the name of a product." Horizon Mills Corp. v. QVC, Inc., 161 F. Supp. 2d 208, 213-214 (S.D.N.Y. 2001).

To prove a term generic, one must make a "strong, substantial showing" that the mark is [or was] perceived as generic by the majority of the relevant purchasing public. In Re American Academy, 64 U.S.P.Q.2d 1748, 1757 (T.T.A.B. 2002) (citing Magic Wand Inc. v. RDB Inc., 940 F.2d 638, 19 USPQ2d 1551, 1552-53 (Fed. Cir. 1991). More yet is required when the trademark at issue is federally registered, because the owner of a federally registered mark "enjoy[s] a strong presumption that the mark is not generic." O.C. White Co. v. Scientific Tech. Electronic Prods., No. Civ. A 03-30190, 2005 WL 3242358 at *6 (D. Mass. Nov 10, 2005) (quoting J & J Snack Foods Corp. v. Earthgrains Co., 220 F. Supp. 2d 358, 377 (D.N.J. 2002)).

"To determine that a trademark is generic and thus pitch it into the public domain is a fateful step." Ty Inc. v. Softbelly's, Inc., 353 F.3d 528, 531 (7th Cir. 2003). Such a decision

"penalizes the trademark's owner for his success," and it "may confuse consumers who continue to associate the trademark with the owner's brand." Id. Therefore, "[t]he fateful step ordinarily is not taken until the trademark has gone so far toward becoming the exclusive descriptor of the product that sellers of competing brands cannot compete effectively without using the name to designate the product they are selling." Id.

Creative Action fails to overcome the strong presumption that Hasbro's MEMORY® mark was not and is not generic.

THE MEMORY® MARK WAS NOT GENERIC AT THE TIME OF REGISTRATION

"Memory" was not a generic name for a matching or recall card game at the time Milton Bradley applied to register the MEMORY® mark in 1966. Creative Action's sole basis for its argument to the contrary is a handful of excerpts from game books that are unauthenticated and thus inadmissible. Even if they were admissible, however, Creative Action would be unable to make a "strong, substantial showing" that MEMORY® was generic at the time of registration.

A. Fact Witness Testimony and the Trademark Examiner's Decision Show that MEMORY® Was Not Generic in 1966

As described above, Millens Taft negotiated the agreement with Ravensburg that granted Milton Bradley rights to the MEMORY® game. Taft Decl. ¶ 2. Mr. Taft states that in 1964, when that license was granted, neither he nor, to his knowledge, anyone else at Milton Bradley was aware of any other use, commercial or otherwise, of the MEMORY® name for a game. Id. ¶ 3. Mr. Taft, who had devoted much of his personal life and the entirety of his business career to games, was in the best position to know whether, at that time, "Memory" was the commonly used name in this country for a standard card game. If, as Creative Action now suggests, the MEMORY® mark was a commonly known card game at the time Milton Bradley

adopted it, then Mr. Taft paid good money for what he could get for free. Mr. Taft was not such a foolish businessman.

Aside from Mr. Taft, the Trademark Examiner was in the best position in 1966 to know whether "Memory" was the common name for a standard card game. Just as Mr. Taft had a duty to his employer not to waste money buying what was free, the Trademark Examiner had a duty to the government and to the public not to give Milton Bradley a presumptive right to a publicly available name. The Trademark Examiner never raised a genericness objection to registration. This is powerful and authoritative evidence that the mark was not generic when adopted. See, e.g., Borinquen Biscuit Corp. v. M.V. Trading Corp., 443 F.3d 112, 117 (1st Cir. 2006) (federal registration is prima facie evidence of the validity of a registered mark).

B. Creative Action Submits No Admissible Evidence that MEMORY® was Generic in 1966

Creative Action rests its argument that MEMORY® was a generic name for a card matching game in 1966 on a handful of exhibits that purport to be excerpts from game books dating from the early 1960s. See SJ Motion, Exhs. 1-B - 1-D. These exhibits are unauthenticated and thus inadmissible. See Federal Rule of Evidence 901 (authentication is a condition precedent to admissibility). Creative Action puts forth no admissible evidence that MEMORY® was generic at the time of registration.

To obscure its lack of evidence, Creative Action cites extensively to the vacated preliminary injunction decision issued by the District Court in Hasbro, Inc. v. MGA Entertainment, Inc. As Creative Action concedes, that vacated decision, which was superseded by the parties' consent judgment recognizing the validity of the MEMORY® mark, is in no way binding on the Board. SJ Motion at 11. Moreover, the District Court made a point of noting that its preliminary injunction decision was indeed preliminary and that Hasbro could prevail at trial,

especially with the benefit of survey evidence. After observing that no survey evidence had been introduced that show consumers associate the term "Memory" with Hasbro's game, the Court went on to say:

> It bears noting …, in this case especially, that 'a party losing the battle on likelihood of success may nonetheless win the war at a trial on the merits.' [citation omitted]. It may be the case that, at trial, Hasbro will successfully negate MGA's attempts to prove genericness and ultimately establish its infringement claim.

497 F. Supp.2d at 345 & n. 8. As discussed below, Hasbro now has and is submitting definitive survey evidence that the MEMORY® mark is not generic.

C. Game Books Do Not Show that MEMORY® Was Generic in 1966.

Even if Creative Action's exhibits 1-B through 1-D were admissible, they would not show that MEMORY® was a common name for a card game in 1966. Creative Action's Exhibits 1-B through 1-D purport to be excerpts from three pre-1966 books about games, including two that use the name Hoyle (see SJ Motion, Exhs. 1-B – 1-D). Bruce Whitehill, an avid game collector and expert on American games, reviewed Exhibits 1-B – 1-D to Creative Action's motion for summary judgment as well as various books about games to determine whether "Memory" was the commonly known name of a card game in 1966. Id. ¶¶ 5-7. Mr. Whitehill concluded that it was not. Id. ¶ 5.

In his review of game books, the first reference Mr. Whitehill found to a game with the basic game-play of Hasbro's MEMORY® game was in a 1946 edition Hoyle book, which contains an entry for a game called Concentration. Id. ¶ 9. The game described in that entry involves essentially the same game-play as MEMORY®, but is played with a standard deck of cards. Id. As with the entries from the two Hoyle books used as exhibits by Creative Action (SJ Motion, Exhs. 1-C and 1-D), "Concentration" appears as the principal name for the game in

the 1946 Hoyle book. Under that name, in parentheses and smaller type, appear the words "Memory, Pelmanism." Id. ¶ 10.

Hoyle books are written by various authors; the books are named for Edmond Hoyle, an 18th century English writer who codified the rules of the card game Whist. Id. ¶ 10. These books are generally compendiums that strive to be exhaustive. Id. ¶ 13. "Concentration" is thus only one of hundreds of games with a principal entry in a Hoyle book. Id.; see also id., Exh. D. The fact that a game has a principal entry in the Hoyle book does not mean that the game was commonly known or played or that the name of the game was commonly known. Id. Several other books about games contain no reference to either Concentration or Memory. Id. ¶ 15; id., Exhs. E and F.

"Memory" is one of two alternate names provided in both of the Hoyle books cited by Creative Action, as well as the other Hoyle books reviewed by Mr. Whitehill. See SJ Motion, Exhs. 1-C and 1-D; Whitehill Decl. ¶ 12; Whitehill Decl., Exh. D. The other alternate name is "Pelmanism," a fairly obscure reference limited to use in England. Whitehill Decl. ¶ 16. That "Memory" appears alongside "Pelmanism" indicates that it too could be an obscure regional variation and that it would not necessarily be a name used in the United States. Id.

Ultimately, the references in these books do not enable one to tell whether there was a game commonly known by the name "Memory" in the United States at all, or, if used in the United States, whether such a name was used throughout the country or just in a specific region. Id. ¶ 17. This falls far short of demonstrating that "a substantial majority of the public" considered "Memory" generic in 1966. As was held of the "MONOPOLY" mark:

> MONOPOLY was not the generic or common descriptive name of an article or substance when registered. Plaintiff [attacking the mark] introduced uncontested testimony at trial that, prior to Parker Brothers' acquisition and manufacturer of the game, a real

> estate trading game was played in various parts of the country and that it was sometimes called "Monopoly." This, however, is insufficient to prove that the term was the common descriptive name of all real estate trading games.

Anti-Monopoly, Inc. v. General Mills Fun Group, Inc., 195 U.S.P.Q. 634, 638 (N.D. Cal. 1977), rev'd on other grounds, 611 F.2d 296 (9th Cir. 1979).

THE MEMORY® MARK HAS NOT BECOME GENERIC.

Creative Action also fails to make a "strong, substantial showing" that, since 1966, MEMORY® has become the generic name for matching or recall card games. The "majority of the public" test for genericness calls for survey evidence, but, as discussed below, it is Hasbro that has submitted survey evidence proving that the relevant public considers "Memory" to be a trademark in the context of games. Creative Action has nothing to counter that survey evidence. See, e.g., Magic Wand, Inc. v. RDB, Inc., 940 F.2d 638, 19 U.S.P.Q.2d 1551 (Fed. Cir. 1991) (rejected challenge that TOUCHLESS is a generic name for a type of auto wash services, in part because the challenger introduced no survey evidence); Heroes, Inc. v. Boomer Esiason Hero's Foundation, Inc., 43 U.S.P.Q.2d 1193, 1196 (D.D.C. 1997) (rejected challenge that HEROES was generic name of charitable services assisting surviving family of police and firefighters killed in line of duty because, in part, "defendant has introduced no consumer surveys"); Hermes Intern. v. Lederer De Paris Fifth Avenue, Inc., 50 F. Supp. 2d 212, 50 U.S.P.Q.2d 1257 (S.D.N.Y. 1999), rev'd on other grounds, 219 F.3d 104, 55 U.S.P.Q.2d 1360 (2d Cir. 2000) (challenger failed to conduct genericness survey in opposition to the survey of the mark owner: summary judgment of genericness was denied).

Instead, Creative Action relies on two unauthenticated exhibits containing what purport to be dictionary definitions of "concentration" from 1987 and 2001 (see SJ Motion, Exhs. 1-E and 1-F) and a Wikipedia entry for "concentration" (SJ Motion, Exh. G). As

discussed below, far from proving that MEMORY® has become generic, such dictionary evidence shows that the MEMORY® mark was not generic in 1966 and is not now.

Creative Action also relies on a few examples of Milton Bradley and Hasbro using "memory" as an adjective (see SJ Motion, Exhs. 4-5), a smattering of website printouts that appear to show third party sales of games involving the word "Memory" (see SJ Motion, Exhs. 1-H – 1-L), and a Google search for "memory card matching game" (see SJ Motion, Exh. 10). These are insufficient to meet Creative Action's burden to eliminate any disputed issue of fact.

Milton Bradley and Hasbro have been advertising and selling MEMORY® games for nearly 45 years. That Creative Action can locate some potentially careless uses of the phrase "memory game," without the capitalization generally used to denote MEMORY®'s trademark status, in product catalogs spanning that lengthy period is neither surprising nor legally significant. Moreover, determining the weight to assign to these exhibits requires a determination of fact that is inappropriate on a motion for summary judgment.

The existence of some third party use of the name "Memory" also does not prove that the MEMORY® mark has become generic. The law does not require Hasbro to dissipate time and resources to prevent every infringement in order to protect the validity of its mark. Hasbro is entitled to pick and choose its battles. "The owner of a mark is not required to police every conceivably related use thereby needlessly reducing non-competing commercial activity and encouraging litigation in order to protect a definable area of primary importance." V & S Vin & Spirit Aktiebolag (Publ) v. Absolute Publ'g USA Inc., No. 05 Civ 4429, 2005 WL 3272828, at *4 (S.D.N.Y. Nov. 28, 2005) (internal quotation signals and citation omitted); Nabisco, Inc. v. PF Brands, Inc., 50 F. Supp. 2d 188, 203 (S.D.N.Y. 1999) (same); aff'd, 191

F.3d 208 (2d Cir. 1999), Playboy Enter. Inc. v. Chuckleberry Publ'g, Inc., 486 F. Supp. 414, 422 (S.D.N.Y. 1980), aff'd, 687 F.2d 563 (2d Cir. 1982) (same). Any value these examples of third-party use may have as indirect evidence that the MEMORY® mark is losing distinctiveness must be weighed against the strong survey evidence put forth by Hasbro that the MEMORY® mark remains distinctive. This too requires a determination of fact that precludes summary judgment.

Creative Action is no more successful in its attempt to elevate its Google search (SJ Motion, Exh. 10) to legal status. See Pepper Patch, Inc. v. Bell Buckle Country Store, Inc., No. 305-0328, 2006 WL 2037560 at *2, 6 (M.D. Tenn. July 18, 2006) (rejecting claim of genericness where defendant's evidence consisted of internet search for term, which yielded "thousands of 'hits'"; "anecdotal evidence, in light of failure to introduce scientific survey evidence … [is] insufficient" for a finding of genericness). It is also not unusual for a famous trademark to garner large amounts of "hits." A Google search of "Barbie" gets approximately 64 million.

Creative Action's failure to meet its burden is especially evident in light of the substantial evidence that MEMORY® has not become generic: the Trademark Examiner's decision to register the MEMORY® mark in 2004; survey evidence showing that the majority of the relevant purchasing public believes "Memory" to be a brand name, not a generic name; and dictionary evidence showing that "Memory" has not become a generic term for card matching games.

1. Hasbro's 2004 Registration Shows that MEMORY® is Not Generic.

As noted above, Hasbro obtained a second registration for the MEMORY® mark in 2004. If the Trademark Office considered "memory" a generic term for a game, it would have refused to register the mark. Instead, the Trademark Office approved the registration without

objection or comment. The decision to register the mark was a determination of its inherent distinctiveness and protectibility. See, e.g., Zobmondo Entertainment, LLC v. Falls Media, LLC, 602 F.3d 1108, 1115, 1121 (9th Cir. 2020).

2. Survey Evidence Shows that MEMORY® is Not Generic.

Survey evidence also shows that MEMORY® is not a generic term for a card matching game. In February 2008, Hal Poret, Senior Vice President of InfoGROUP/ORC (formerly Guideline), prepared a study for Finnegan, Henerson, Farabow, Garrett & Dunner, L.L.P., counsel for Ravensburg, to determine whether "memory" is perceived as a generic name for a children's game. Declaration of Hal Poret (Poret Decl.) ¶¶ 1, 3. Mr. Poret's study concluded that "Memory has clear brand significance to consumers of children's games and is not generic." Poret Decl., Exh. A at 8.

Mr. Poret conducted the study by interviewing 315 qualified respondents in a mall-intercept survey conducted in eight markets around the continental United States. Poret Decl., Exh. A at 3. Respondents were read a statement explaining the difference between a brand name and a generic name, and were subsequently tested to ensure they understood the difference between a brand name and a generic name. Id.

Respondents were then instructed that they would be shown names used in connection with games for young children and that they would be asked to indicate whether they thought each was a brand name, a generic name, or both, or whether they don't know. Id. One at a time, respondents were handed nine cards, each of which contained a name – four brand names, four generic names, and the "test" name, Memory. The four brand names shown to respondents were:

- Barrel of Monkeys
- Chutes and Ladders
- I Spy
- Sorry

The four generic names shown to respondents were:

- Bingo
- Blocks
- Checkers
- Tic Tac Toe

Id. at 3-4. After each name card was shown, respondents were asked whether they understood the name to be a brand name, a generic name, or both (or if they didn't know). Id. at 4. The order in which the nine names were shown varied from respondent to respondent. Id.

The purpose of asking respondents about the eight game names other than Memory was to establish baselines. The percentage of respondents that answered Memory was a brand name could be compared to the percentage of respondents that answered that the other names were brands, to determine whether respondents' perceptions of Memory were more consistent with that of a brand name or that of a generic name. Id.

Many more respondents answered that Memory is a brand name (68.9%) than a generic name (21.0%). These responses were consistent with answers for some of the other brand names shown in the survey, and inconsistent with respondents' answers for any of the generic names shown in the survey. Id. at 6. Based on these results, Mr. Poret concluded that MEMORY is not a generic term for a children's game.

3. Dictionary Evidence Shows the Mark Has Not Become Generic.

Expert analysis conducted by David Yerkes, D. Phil., also shows that "Memory" is not a generic term for card-matching games. Dr. Yerkes, a professor at Columbia University and an expert on the English language and on the use and value of dictionaries, conducted a

review of more than 100 dictionaries from the 1960s to the present, to determine what dictionaries can reveal about whether the MEMORY® trademark was generic in 1966 or is now. Declaration of David Yerkes ("Yerkes Decl.") ¶¶ 3-6. Dr. Yerkes concluded that "Memory" was not a commonly used term for a card game in 1966 is not now. Id. ¶ 7.

Dr. Yerkes observed that of the many dictionaries published since the 1960s, only two have ever defined the word "Memory" as referring to a card game: Webster's Third New International Dictionary, first published in 1961, and the Random House Dictionary, first published in 1966. Id. ¶ 8. This fact alone – that only two dictionaries in a hundred have the card game definition – shows that "Memory" was not a commonly used term for a card game in 1966 and is not now. Id. ¶ 9.

Moreover, Webster's Third New International Dictionary and the Random House Dictionary are the two largest dictionaries published in the United States since the 1960s, and would therefore have the more esoteric meanings. Id. This confirms that "Memory" was not a commonly used term for a card game in 1966 and is not now, because a word's least common meanings are the ones that appear only in the largest dictionaries. Id. None of the smaller dictionaries – which have only the more common meanings, the meanings that people are likely to use – ever defines the word "Memory" as referring to a card game. Id.

Both of the largest abridged versions of Webster's Third New International Dictionary and the Random House Dictionary, Webster's Collegiate Dictionary and the Random House College Dictionary, drop the card game definition for "Memory". Id. ¶ 10; id., Exh. B. One edition of Webster's Collegiate Dictionary says that it "is intended to meet the needs both of the college student and of the general reader" and that "[u]sefulness is the criterion" of selection (id., Exh. B at 4). An edition of the Random House College Dictionary says that it is the "most

complete, most authoritative storehouse of information on the English language ever published as a one-volume desk dictionary" (id., Exh. B at 10); another edition says that it has "[o]ver 207,000 clear definitions with full coverage of the words you need" (id., Exh. B at 15). Yet none of these editions has the card game definition for "Memory."

Likewise the largest dictionary of all, the gigantic Oxford English Dictionary – which aims to give, not just all the current words and meanings, but all the words and meanings that have ever been in the language – does not define the word "Memory" as referring to a card game. See id., Exh. C. In the only two dictionaries that do have the card game definition for "Memory" – Webster's Third New International Dictionary and the Random House Dictionary – the card game definition comes at or near the end of their entries for "Memory." Id. ¶ 12.

The Random House Dictionary's entry for "Memory" has twelve definitions and the card game definition comes last, the twelfth of the twelve definitions. That the card game definition comes last indicates that "Memory" is not a commonly used term for a card game. This is supported by the opening of the Random House Dictionary's statement about the sequence of definitions within entries (id., Exh. D):

> Definitions within an entry are individually numbered in a sequence, regardless of any division according to part of speech. The most common part of speech is listed first, and the most frequently encountered meaning appears as the first definition for each part of speech. Specialized senses follow, and rare, archaic, and obsolete senses are usually listed at the end of their part of speech group.

Thus according to the Random House Dictionary, as a term for a card game MEMORY is "rare, archaic, [or] obsolete". Id. ¶ 12.

Further, the card game definition for "Memory" in the Random House Dictionary consists solely of a cross-reference to another entry, "Concentration." Id., Exh. D. That the card game definition for "Memory" is a cross-reference to the entry for "Concentration," where a full

definition is given, indicates that as a term for a card game "Memory" is less common than "Concentration" is. Id. ¶ 14. Then, in the Random House Dictionary's entry for "Concentration," the card game definition once again comes last – it is the seventh of seven definitions for "Concentration." Id., Exh. D. Thus as a term for a card game "Concentration" is rare but "Memory" is even rarer. Id. ¶ 14.

Likewise in Webster's Third New International Dictionary the card game definition comes near the end of the entry for "Memory" (only technical definitions from electronics and materials science follow it); the card game definition consists solely of a cross-reference to another entry, "Concentration"; and then the card game definition comes at the end of the "Concentration" entry – it is the fifth of five definitions for "Concentration". Id., Exh. E. Thus once again, this time according to Webster's Third New International Dictionary, as a term for a card game "Memory" is less common than "Concentration," and "Concentration" is rare. So once again, as a term for a card game "Memory" is rarer than the rare, less common than the uncommon. Id. ¶ 15.

As dictionary entries defining "Memory" as a game are rare and reflect an uncommon usage, they clearly fall short of demonstrating that "a substantial majority of the public" has considered the term generic at any point between the 1960s and today. Anti-Monopoly, Inc. v. General Mills Fun Group, Inc., 195 U.S.P.Q. at 638.

CONCLUSION

For the foregoing reasons, the Board should deny Creative Action's motion to for summary judgment on the validity of Hasbro's trademark.

Dated: July 8, 2010

Respectfully submitted,

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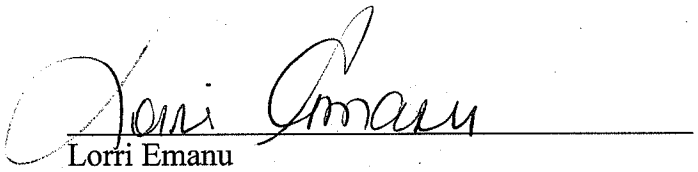
ELECTRONIC MAILING CERTIFICATE

I hereby certify that **Opposer's Memorandum of Law in Opposition to Applicant's Motion for Summary Judgment** is being submitted electronically through the Electronic System for the Trademark Trial and Appeal Board ("ESTTA") on this 8th day of July, 2010.



Lorri Emanu

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **Opposer's Memorandum of Law in Opposition to Applicant's Motion for Summary Judgment** was served by electronic mail on July 8, 2010, on the following counsel for Applicant:

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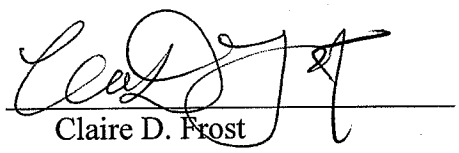

Claire D. Frost