

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: February 3, 2011

Opposition No. **91166487**

Hasbro, Inc.

v.

Creative Action, LLC

Before Quinn, Kuhlke, and Mermelstein,
Administrative Trademark Judges

By the Board:

Creative Action, LLC ("Creative") seeks to register the mark MEMORY MAGIC in standard character form for "therapeutic game in the nature of a trivia game and a bingo game for engaging persons with memory loss consisting of game cards that contain answers to questions and calling cards that contain questions and information related thereto" in International Class 28.¹

On August 29, 2005, Hasbro, Inc. ("Hasbro") filed a notice of opposition to registration of applicant's mark on the ground of likelihood of confusion with its previously used and registered marks MEMORY in stylized form for

¹ Application Serial No. 78359895, filed January 30, 2004, based on an assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). The application includes a disclaimer of MEMORY.

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"equipment comprising cards with many matching pairs of designs for playing a matching card game" in International Class 28² and MEMORY in standard character form for "card games" in International Class 28³ under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). In its answer, Creative denied the salient allegations of the notice of opposition and counterclaimed to cancel Hasbro's pleaded registrations on the grounds that the registered marks: (1) are incapable of functioning as trademarks; (2) are generic; and (3) do not have significance as trademarks and therefore have been abandoned. In its answer to the counterclaim, Hasbro denied the salient allegations of the counterclaim.

Proceedings herein were suspended in a May 9, 2008 order pending final determination of a civil action styled *Hasbro, Inc. v. MGA Entertainment, Inc.*, Case No. 1:06-cv-00262-S-DLM, filed in the United States District Court for the District of Rhode Island. That civil action was resolved by way of a stipulated final judgment that was entered on October 3, 2008. By such judgment, the parties agreed that Hasbro's pleaded registrations are "valid [and] subsisting" and that MGA is "permanently enjoined from using the term 'memory' as all or part of the name of a game,"

² Registration No. 834282, issued August 29, 1967, twice renewed.

³ Registration No. 2894970, issued October 19, 2004, Section 8 affidavit accepted.

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except under limited circumstances not at issue in this proceeding. The parties also agreed to the dismissal of MGA's counterclaim that Hasbro's pleaded MEMORY mark is generic.

Following resumption of this proceeding, on April 22, 2009, Hasbro, on December 23, 2009, filed a motion for leave to file an amended notice of opposition in which it deleted its originally pleaded Section 2(d) claim and instead set forth claims: (1) under Trademark Act Section 18, 15 U.S.C. Section 1068, to restrict the identification of goods to "therapeutic activity kit intended for use by nursing homes and other elderly care facilities to promote the use of cognitive abilities by elderly persons with memory loss, comprised of cards that contain questions and related prompts for discussion, cards that contain an array of potential answers to the questions, and board used by participants" and to amend the classification of those goods to International Class 10, and (2) that applicant had no *bona fide* intent to use the mark on the identified goods as of the application filing date under Trademark Act Section 1(b), 15 U.S.C. Section 1051(b). In a May 13, 2010, order, the Board granted Hasbro's motion for leave to file an amended notice of opposition, dismissed the Section 2(d) claim that was pleaded in the original notice of opposition as having been withdrawn without Creative's written consent,

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and set Creative's time in which to file an answer to the amended notice of opposition.

On May 27, 2010, prior to filing an answer to the amended notice of opposition, Creative filed a motion for summary judgment on its counterclaim of genericness, based in part on requests for admissions that it believed were admitted.⁴ On June 7, 2010, Hasbro filed a motion to accept its responses to Creative's requests for admissions, which, after a telephone conference between the parties' attorneys and the Board attorney assigned to this case, the Board granted in a June 8, 2010, order. In that order, the Board indicated that Hasbro's responses to Creative's requests for admission would be considered in the Board's decision on Creative's motion for summary judgment. Concurrently with Hasbro's brief in opposition to Creative's motion for summary judgment, Hasbro, on July 8, 2010, filed a cross-motion for summary judgment on its Section 18 claim for restriction of the goods in Creative's involved application, followed the next day by an amended cross-motion for summary judgment on the Section 18 claim. The cross-motion has been

⁴ In the Board's June 3, 2010 suspension order, the Board noted that Creative sought summary judgment on its counterclaim that was filed as part of its original answer, which is no longer its operative responsive pleading herein, and prior to the filing of an answer to the amended notice of opposition. The Board determined, however, that the filing of such motion was clear indicia that Creative does not intend to withdraw the counterclaim and therefore elected to consider Creative's summary judgment motion.

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fully briefed and will be decided based on the amended cross-motion.

As an initial matter, we are not persuaded by Creative's assertion that we should not consider Hasbro's cross-motion for summary judgment because the cross-motion was filed in contravention of the Board's June 3, 2010, suspension order. A party may respond to its adversary's motion for summary judgment with a cross-motion for summary judgment. See *Nestle Co. v. Joyva Corp.*, 227 USPQ 477, 478 n.4 (TTAB 1985); TBMP Section 528.03 (2d ed. rev. 2004).

In addition, Hasbro's reply brief in support of its cross-motion includes a page for the case heading, ten full pages of legal argument, and a page for the signature block. As such, it exceeds the ten-page limit for reply briefs in support of motions and therefore has received no consideration.⁵ See Trademark Rule 2.127(a); *Saint-Gobain Corp. v. Minnesota Mining and Mfg. Co.*, 66 USPQ2d 1220 (TTAB 2003).

Turning to the parties' cross-motions for summary judgment, the Board shall grant summary judgment where a movant shows that "there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law." Fed. R. Civ. P. 56(a). The evidence on

⁵ The refiled copy of the reply brief that Hasbro filed on September 1, 2010, will be treated as timely filed.

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summary judgment must be viewed in a light most favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. See *Lloyd's Food Products, Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993). The Board may not resolve disputes as to material facts; it may only ascertain whether any such disputes exist. See *id.*

Regarding Creative's motion for summary judgment on its counterclaim of genericness, the inquiry into whether or not a term is generic involves two determinations: (1) an identification of the genus of goods or services at issue; and (2) whether the term at issue is understood by the relevant public primarily to refer to that genus of goods or services. See *H. Marvin Ginn Corp. v. International Ass'n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 228 USPQ 528, 530 (Fed.Cir. 1986). After reviewing the parties' arguments and evidence,⁶ we find that there is, at minimum, a genuine dispute as to whether the relevant public understands the word MEMORY to refer to a type of card game or equipment for

⁶ To the extent that Creative relies upon the district court's July 31, 2007, decision on Hasbro's motion for a preliminary injunction in Case No. 1:06-cv-00262-S-DLM, that decision was vacated and ordered sealed in the stipulated final judgment in that case.

Contrary to Hasbro's assertions, the game book and dictionary excerpts (Exhibits 1-B through 1-F) upon which Creative relies are admissible as printed publications available to the general public. See Trademark Rule 2.122(e); TBMP Section 528.05(e).

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playing such card games. In view thereof, Creative's motion for summary judgment is denied.

We turn next to Hasbro's cross-motion for summary judgment on its Section 18 claim to restrict the identification of goods in Creative's involved application. Under Trademark Act Section 18, 15 U.S.C. Section 1068, the Board has equitable power to, in whole or in part, "restrict the goods or services identified in an application or registration," or to "otherwise restrict or rectify ... the registration of a registered mark." See also TBMP Section 309.03(d) (2d ed. rev. 2004). To prevail on a Section 18 claim, a plaintiff must establish that the proposed restriction will avoid a likelihood of confusion and that the defendant is not using the mark on the goods or services being deleted or "effectively excluded" from the registration. *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co.*, 34 USPQ2d 1266, 1271 (TTAB 1994).

The current identification in the involved application is "therapeutic game in the nature of a trivia game and a bingo game for engaging persons with memory loss consisting of game cards that contain answers to questions and calling cards that contain questions and information related thereto" in International Class 28. Based on Creative's responses to interrogatories, Hasbro seeks to restrict the

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identification of goods in Creative's involved application to:

Activity/ program for groups and for people with dementia, head trauma or stroke living in long term care facilities or attending adult day care centers and older adults with these cognitive impairments living at home and staff training programs related to the MEMORY MAGIC activity, marketed to long-term care facilities, adult day care centers, home health care agencies, psychiatric hospitals and units, and care givers of older adults with dementia, head trauma or stroke who live at home through trade show exhibits, direct marketing, and distributors of products to health and long term care industries.

Hasbro also seeks to amend the classification of such goods to International Class 10.

However, because the proposed restriction set forth in the cross-motion differs in several respects from the proposed restriction set forth in the amended notice of opposition, i.e., "therapeutic activity kit intended for use by nursing homes and other elderly care facilities to promote the use of cognitive abilities by elderly persons with memory loss, comprised of cards that contain questions and related prompts for discussion, cards that contain an array of potential answers to the questions, and board used by participants" in International Class 10, Hasbro is seeking entry of summary judgment on an unpleaded issue. See TBMP Section 528.07(a). Moreover, the proposed restriction in the cross-motion is impermissibly indefinite because it does not set forth the nature of the goods at

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issue, e.g., "a trivia game and a bingo game for engaging persons with memory loss consisting of game cards that contain answers to questions and calling cards that contain questions and information related thereto," as did both the identification that was published for opposition and the restriction that is proposed in the amended notice of opposition. See Trademark Rule 2.32(a)(6); TMEP Section 1402.01 (7th ed. 2010). Further, the proposed restriction in the cross-motion impermissibly expands the scope of the identification of goods by deleting the composition of the "activity/ program" at issue. See Trademark Rule 2.71(a); TMEP Section 1402.07. In any event, even if we were to take up the motion on its merits, we would find that there are, at a minimum, genuine disputes as to whether the proposed restriction would avoid a likelihood of confusion between the marks at issue,⁷ as to whether Creative uses or intends to use the mark on goods that would be effectively excluded from the identification, and as to whether the proposed

⁷ Although Hasbro contends that it uses its pleaded mark on children's games, the identification of goods in its pleaded Registration No. 2894970 is identified as "card games." Such "card games" are presumed to encompass all goods of the nature and type described, and those "card games" are presumed to travel in all channels of trade normal for those goods to all classes of prospective purchasers for those goods. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981).

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amended classification is appropriate.⁸ Based on the foregoing, Hasbro's cross-motion for summary judgment is denied.⁹

Proceedings herein are resumed. Creative is allowed until thirty days from the mailing date set forth in this order to file an answer to the amended notice of opposition. The parties are allowed until thirty days to serve responses to any outstanding written discovery requests. Discovery and testimony periods are reset as follows.

THE PERIOD FOR DISCOVERY TO CLOSE:	March 18, 2011
30-day testimony period for plaintiff in the opposition to close:	June 16, 2011
30-day testimony period for defendant in the opposition and as plaintiff in the counterclaim to close:	August 15, 2011

⁸ Hasbro's claim for restriction is based largely on its contention that the product sold under Creative's mark is not a game because it is not competitive. Although Creative's founder and CEO, Dr. Ronni Sterns, stated in a discovery deposition that Creative no longer calls the MEMORY MAGIC product a game, the product sample that Hasbro submitted in support of its motion includes "[g]ame [b]oards [and g]ame [c]ards."

⁹ The parties should note that the evidence submitted in connection with the motion/cross motion for summary judgment is of record only for consideration of those motions. To be considered at final hearing, any such evidence must be properly introduced in evidence during the appropriate trial period. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993); *Pet Inc. v. Bassetti*, 219 USPQ 911 (TTAB 1983); *Am. Meat Inst. v. Horace W. Longacre, Inc.*, 211 USPQ 712 (TTAB 1981).

In addition, the parties should not infer that the issues that we have identified as genuine disputes as to material facts are the only such issues remaining for trial.

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30-day testimony period for defendant
in the counterclaim and its rebuttal testimony
as plaintiff in the opposition to close: October 14, 2011

15-day rebuttal testimony period for plaintiff
in the counterclaim to close: November 28, 2011

Briefs shall be due as follows:
[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: January 27, 2012

Brief for defendant in the opposition and as
plaintiff in the counterclaim shall be due: February 26, 2012

Brief for defendant in the counterclaim and its reply
brief (if any) as plaintiff in the opposition
shall be due: March 27, 2012

Reply brief (if any) for plaintiff in the
counterclaim shall be due: April 11, 2012

In each instance, a copy of the transcript of testimony
together with copies of documentary exhibits, must be served
on the adverse party within thirty days after completion of
the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark
Rules 2.128(a) and (b). An oral hearing will be set only
upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have
a change of address, the Board should be so informed
promptly.