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

Proceeding	91179197
Party	Defendant BioWare Corp.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
Before the Trademark Trial and Appeal Board

IN RE: VUTEk, INC. v. BIOWARE CORP.

Trademark: BIOWARE CORP.

Opposer: VUTEk, Inc.

Applicant: BioWare Corp.

Opposition No. 91179197

Serial No. 76/636906

United States Patent and Trademark Office
Trademark Trial and Appeal Board
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APPLICANT BIOWARE CORP.'S REPLY TO PLAINTIFF'S OPPOSITION TO
APPLICANT'S MOTION TO DISMISS PURSUANT TO FED. R. CIV. P. 12(B)(6)

Pursuant to TBMP § 1.638 and Fed. R. Civ. P. 12(b)(6), Applicant BioWare Corp. (hereafter, "BioWare") hereby replies to the Opposer's opposition to Applicant's motion to dismiss the opposition to its pending application (the "Opposition") brought by Opposer VUTEK, Inc. (hereafter, "VUTEK") for the reasons set forth herein.

I. INTRODUCTION

VUTEk is attempting to divert attention away from its own deficient pleading by initially claiming BioWare's motion should be dismissed for improper service. VUTEk's counsel is misstating the rules, as is done elsewhere in the Opposition, in such a manner as to attempt to place BioWare in a bad light. In reality, BioWare's service of the Motion to Dismiss was both proper and timely.

The alleged merits of VUTEK's Opposition merely confirms the following facts: (1) VUTEk has failed to allege any statutory or judicially-cognizable grounds for denying the registration that BioWare requests; (2) VUTEk lacks standing to oppose BioWare's motion and (3) VUTEk should not be granted leave to amend its defective opposition, as doing so would be futile and merely allow VUTEk to continue its policy of harassing Applicant BioWare and causing an undue delay to these proceedings.

VUTEk alleges BioWare's motion to dismiss is an effort to mask some supposed ulterior motive. This is a rather bizarre allegation, in that it is VUTEk that has filed seriatim oppositions for registrations by BioWare of marks completely unrelated to any interest of VUTEk, including this one. VUTEk's Opposition is nothing more than a misguided attempt to conceal its own ulterior motive, one that is readily confirmed through its failure to demonstrate even token compliance with the requirements for standing and pleading a claim.

II. BIOWARE'S SERVICE OF ITS MOTION TO DISMISS WAS PROPERLY SERVED

VUTEk's allegation of improper service is founded on the premise that service was not made on Alex K. Grab specifically. VUTEk's Opposition misstates 37 C.F.R. § 2.119(b) as quoted in TBMP Rule § 113 as requiring service on a party's attorney of record before such a motion can be heard by the Board under TBMP Rule § 502.02(a). However, § 2.119(b) actually states: "Every paper filed in the Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties." (Emphasis added.) Clearly service on Greenberg Traurig LLP, which represents VUTEk before the Trademark Trial and Appeal Board, constitutes service upon the other party. It is telling that, despite the allegedly improper service, VUTEk's counsel was easily able to obtain the Motion to Dismiss as evidenced by the

similarities in his Opposition in this action and the Opposition to the BIOWARE/PANDEMIC STUDIOS mark prepared by Greenberg Traurig (Opposition No. 91177900).

III. ARGUMENT

In order to overcome the Motion to Dismiss, VUTEk must plead facts that demonstrate not only standing, but also a valid ground for denying registration. *Young v. AGB Corp.*, 47 U.S.P.Q. 2D (BNA) 1752, 1754 (TTAB 1998). VUTEk has failed to do either. The sole ground for VUTEk's Opposition to the instant registration application is that BioWare has alleged a likelihood of confusion with respect to a different mark which VUTEk is attempting to register in another proceeding, and VUTEk "believes" that BioWare "will likely argue that there is a likelihood of confusion" in that other proceeding, causing harm to VUTEk. Opposition p. 4. VUTEk's reliance on TBMP § 309.03(b) as support for its contention that this allegation is sufficient to confer standing is ill-taken and simply inapt. Moreover, as discussed, *infra*, VUTEk fails, utterly and completely, to state any ground under which BioWare's registration for BIOWARE CORP. may be denied and, as such, fails to state a claim.

A. VUTEk's Contention That It Has Standing Misstates the Applicable Legal Standard

Rule 309.03(b) applies if the applicant "has asserted a likelihood of confusion in another proceeding between the parties involving the same marks." (emphasis added). VUTEk conveniently ignores the latter portion of this rule. As VUTEk is well aware, at issue in the other proceeding is BioWare's opposition to VUTEk's registration of the mark "BIOWARE." The mark at issue in this proceeding is "BIOWARE CORP." VUTEk's attempt at creating a connection between the pending action and § 309.03(b) by stating that the two marks contain the

same “core term ‘BIOWARE’” (Opposition p. 3) is irrelevant. The two proceedings involve two distinct marks, rendering § 309.03(b) immaterial.

The two cases cited by § 309.03(b), *Tonka Corp v. Tonka Tools, Inc.*, 229 U.S.P.Q. 857 (TTAB 1986) and *M. Aron Corp. Remington Prod., Inc.*, 222 USPA 93 (TTAB 1984), clearly establish that the scope and limits of § 309.03(b) do not apply in the instant context. The petitioner in *Tonka* attempted to assert superior rights to the mark predicated upon abandonment and fraudulent renewal of the registration by the respondent. *Id.* at 858. Here, VUTEk is not alleging that it has superior rights to the mark – in fact VUTEk is not alleging any rights in the BIOWARE CORP. mark, nor could it.

Similarly, in *M. Aron* (which VUTEk quotes at length) the petitioner requested cancellation of the respondent’s registration based on petitioner’s superior rights to the identical mark. *M. Aron* at 94. As in *Tonka*, it was the same mark at issue, and not two marks with similar “core terms,” and, in each instance, the petitioner asserted its own superior rights to the mark. Thus, BioWare’s allegation of a likelihood of confusion in the separate proceeding in no way supports a finding of damages in this proceeding – BioWare has never alleged a likelihood of confusion with the mark at issue here and, of course, VUTEk doesn’t claim, nor can it claim, any rights in the BIOWARE CORP. mark. Contrary to VUTEk’s contention, TTAB § 309.03 is not “the beginning and the end of the analysis of BioWare’s motion.” Opposition p. 4. In fact, § 309.03 has nothing to do with BioWare’s motion.

B. VUTEK Has Neither a “Real Interest” in This Proceeding Nor a “Reasonable Basis” for its Belief That it Would Be Damaged

As Opposer VUTEK admits, standing in this proceeding requires that it allege, “a ‘real interest’ in the proceeding and must have a ‘reasonable’ basis for his belief of damage.” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). Here, VUTEK has met neither requirement.

1. VUTEK Does Not Have a Real Interest in the Proceedings

VUTEK’s claim of having a real interest in the proceedings is based on its contention that BioWare, if granted the registration, could use it tactically against VUTEK in other proceedings. As discussed at length in BioWare’s moving papers, the gaining of a procedural advantage in another proceeding is not considered damage within the meaning of Section 13 of the Lanham Act. *See, e.g., American Angus Ass’n v. Sysco Corp.*, 865 F. Supp 1180, 1182 (D.N.C. 1993). Thus, contrary to Opposer’s statement in its opposition, this is not the sort of “real interest” in the outcome and damages that the TTAB rules contemplate.

2. VUTEK’s Position is Completely Lacking in a Reasonable Basis for its Belief in Damages

VUTEK also fails to assert “a ‘reasonable’ basis for the belief of damage.” *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999). It is not surprising that VUTEK was unable to provide a factual basis for its belief it will suffer damages in its opposition as there simply is none. The only basis VUTEK has for believing it will suffer damage is the allegation that BioWare, if granted registration, is “likely” to use it against VUTEK. Standing under § 309.03(b) clearly demands more than VUTEK’s subjective and unsupported belief that BioWare might assert the instant registration against it at some indefinite time in the future. *See, Tonka* at 859 (“Petitioner has a real interest in seeking to cancel a registration that has been asserted, even

defensively, against it in a civil action in the U.S. District Court.”); *M. Aron Corp.* at 96 (“In our opinion, respondent’s attempt, as opposer in the opposition, to amend its notice of opposition to rely on its registration now sought to be cancelled herein is sufficient to show that petitioner herein, as applicant in the opposition, is not a mere intermeddler but rather has a real interest in cancelling the registration.”).

As VUTEk is unable to show either a real interest in the proceedings or a reasonable basis for its belief it will suffer damage, VUTEk is unable to show it has the standing to pursue its opposition to BioWare’s Motion to Dismiss.

3. VUTEk Fails to Allege Any Statutory or Judicially-Cognizable Basis
for Denial of BioWare’s Registration

VUTEk, in its Opposition, confuses the requirements for standing and those necessary to maintain an Opposition. As discussed, *supra*, to satisfy standing requirements VUTEk need only allege an objectively-reasonable belief that it will be damaged by the registration of BioWare’s BIOWARE CORP. mark (which, as shown, it has failed to do). *See*, TBMP § 309.03.

However, to maintain its opposition, VUTEk must also allege a statutory ground that would preclude registration being granted to BioWare. TBMP § 309.03(c) (“In addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation.”). Pursuant to § 309.03(c), a plaintiff may raise, “any available statutory ground for opposition . . . that negates the defendant’s right to registration.” *Id.*, *citations omitted*. VUTEk has failed utterly, both in its original Opposition to registration and the opposition to BioWare’s instant motion to allege any statutory or judicially-cognizable ground under which BioWare’s registration for BIOWARE CORP. may issue. *See, Young v. AGB Corp.*, 152 F.3d 1377, 1380 (Fed. Cir. 1998) (Discussing the requirements of § 309.03(c) in

the context of a cancellation proceeding), “Although cancellation is most often premised on the grounds listed in Section 2 of the Lanham Act . . . other grounds which negate entitlement to maintain a registration also exist in the Lanham Act.”), *citing, Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1924, 1031 (CCPA 1982) (entertaining a cancellation petition premised on abandonment); *accord, DC Comics and Marvel Characters, Inc. v. Onetech Computer Consulting, Inc.*, Opposition No. 91164511, 2005 TTAB LEXIS 480, 2; 76 U.S.P.Q.2d 1472 (TTAB 2005) (“The opposer need only show that (1) it has standing to maintain the proceeding, and (2) it has a valid statutory ground for denial of the registration sought.” [Emphasis added.]; *Central Mfg. Co. v. Board of Regents*, Opposition No. 91125818, 2005 TTAB LEXIS 444, 5-6 (TTAB 2005) (“The Board’s principal reviewing court has determined that the ‘valid ground’ for denying registration that must be alleged and ultimately proved by an opposer must be a ‘statutory ground which negates the appellant’s right to the subject registration.’”), *citing, Young, supra; Duramax Marine. LLC v. R. W. Fernstrum & Co.*, Opposition No. 91119899, 80 U.S.P.Q.2d 1780 (TTAB 2006) (“At the pleading stage, an opposer must allege facts in support of both standing and grounds for opposition.”). Instead, VUTEk relies only on § 309.03(b). Opposition, p. 2 (“Rule 309.09(b) specifically provides for damages claims based on facts asserted in VUTEk’s Opposition.”) As VUTEk is, no doubt aware, § 309.03(b) goes only to standing to assert an Opposition. Section 309.03(c) identifies the grounds that support an opposition (and creates an independent and additional requirement for bringing such an action). VUTEk’s failure to allege any statutory basis for denying registration establishes, clearly and unequivocally, the merits of BioWare’s proposed Motion to Dismiss Pursuant to Fed. R. Civ. P. 12(b)(6).

C. VUTEk Should be Denied Leave to Amend as its Own Admissions Render
Amendment Futile

The Board has broad discretion to decide such claims and may refuse to grant such leave where justice does not require it. *See* TBMP § 503.03. Specifically, leave to amend should not be granted where it will serve no useful purpose. *Pure Gold, Inc v. Syntex*, 221 U.S.P.Q. 151 (TTAB 1983). Furthermore, under the Federal Rules of Civil Procedure, such leave should be denied if: (1) it is asked for in bad faith; (2) would cause undue delay; (3) would prejudice the opposing party; (4) if the amendment would be futile; or (5) the moving party previously had the opportunity to amend the complaint. *See* Fed. R. Civ. P. 15(a); *United Assoc. of Journeymen & Apprentices, Etc v. GA Power Co.*, 684 F. 2d 721 (11th Cir. 1982); *Triplett v. Leflore County*, 712 F. 2d 444 (10th Cir. 1983).

In this instant case, granting VUTEk leave to amend its defective opposition would serve no useful purpose and is demonstrably futile. VUTEk admits that it need only plead, “any legal defect or deficiency in the application.” Opposition, p. 2. Not only has it failed to do so, but, indeed, it is affirmatively estopped from doing so. In its response to BioWare’s Opposition to VUTEk’s registration of the BIOWARE mark in Opposition No. 91174133, VUTEk has denied all potential legal grounds that could support an opposition to a Motion to Dismiss under the § 2 of the Lanham Act.¹

¹ *See*, BioWare’s Notice of Opposition, Exhibit B to the Tauger Decl., VUTEk’s Answer, Exhibit C to the Tauger Decl.

Specifically, VUTEk has:

(1) Denied that there is any likelihood of confusion under all applicable factors and criteria required by U.S. trademark law. Answer to Notice of Opposition, Affirmative Defenses, ¶ 2;

(2) Denied that the goods or services of the parties are related or compete. Answer to Notice of Opposition, Affirmative Defenses, ¶ 3;

(3) Asserted that the BIOWARE mark does not have the requisite secondary meaning to acquire distinctiveness. Answer to Notice of Opposition, Affirmative Defenses, ¶ 4;

(4) Denied that there is a likelihood of dilution under all applicable factors and criteria required by U.S. trademark and dilution law. Answer to Notice of Opposition, Affirmative Defenses, ¶ 5;

(5) Denied that the mark is famous under the requirements of U.S. trademark dilution law. Answer to Notice of Opposition, Affirmative Defenses, ¶ 6; and

(6) Asserted that third party use of the mark precludes any claim of dilution. Answer to Notice of Opposition, Affirmative Defenses, ¶ 9.

(7) Failed to allege superior rights in the BIOWARE mark under any theory, including abandonment, fraud on the Patent and Trademark Office, etc.

Thus, VUTEk's own admissions in the other proceeding render further amendments in its instant Opposition futile, as no conceivable statutory or judicially-cognizable grounds could be asserted that would support denial of BioWare's instant registration application. The instant

Opposition is nothing more than a fulfillment of VUTEk's threat to oppose everything BioWare does because BioWare had the temerity to oppose VUTEk's attempts to appropriate the BIOWARE mark.

In requesting leave to amend in its Opposition, VUTEk had the opportunity to demonstrate that such amendment would not be futile and a waste of both the Board's and BioWare's time and resources. It did not, for the simple reason that it could not. Any potential ground for denial of BioWare's instant registration is precluded by VUTEk's prior admissions.

IV. CONCLUSION

VUTEk's Opposition lacks the most fundamental requirements to be entertained by the Board. VUTEk fails to allege any cognizable legal ground for denying BioWare's pending application. VUTEk's attempts to cover this fact by claiming improper service are to no avail and contrary to law. Moreover, VUTEk completely fails to assert any basis for standing – it pleads no belief in cognizable damages nor a single fact that would render any such belief reasonable. As such, its Opposition pleading is fatally deficient. For the foregoing reasons, BioWare respectfully requests that VUTEk's Opposition be dismissed without leave to further amend pursuant to Fed. R. Civ. P.12(b)(6) and TBMP § 503.

Dated: December 19, 2007

Respectfully submitted,

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CERTIFICATE OF FILING

The undersigned hereby certifies that the foregoing APPLICANT BIOWARE CORP.'S
REPLY TO PLAINTIFF'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS
PURSUANT TO FED. R. CIV. P. 12(B)(6) was electronically filed with the U.S. Patent &
Trademark Office Trademark Trial and Appeal Board, on this 19th day of December, 2007.

/s/Paul N. Tauger

PROOF OF SERVICE

I am employed in the County of Los Angeles, State of California. I am over the age of 18 and not a party to the within action. My business address is 120 Broadway, Suite 300, Santa Monica, California 90401.

On December 19, 2007, I served the foregoing document, described as APPLICANT BIOWARE CORP.'S REPLY TO PLAINTIFF'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS PURSUANT TO FED.R.CIV.P. 12(B)(6), on each interested party in this action, as follows:

Alex Grab
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(BY FIRST CLASS MAIL) I placed a true copy (or original) of the foregoing document in a sealed envelope addressed to each interested party as set forth above. I sent such envelope, via U.S. mail at Bryan Cave LLP, Santa Monica, California. I am readily familiar with Bryan Cave LLP's practice for collection and processing of correspondence for mailing with the U.S. post office.

Executed on December 19, 2007, at Santa Monica, California.

(FEDERAL ONLY) I declare that I am employed in the office of a member of the bar of this Court at whose direction the service was made.

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

/s/ Alicia Moore
Alicia Moore