

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

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Mailed: May 4, 2011

Opposition No. 91196629

Gamelink, LLC

v.

Timothy P. Dunnigan

**Before Cataldo, Bergsman and Wolfson,
Administrative Trademark Judges.**

By the Board:

This proceeding is before the Board for consideration of applicant's motion (filed February 28, 2011) to dismiss the amended notice of opposition. The motion is fully briefed.¹

Background

Applicant seeks to register the mark GAMELINK and design, shown below, (GAME LINK disclaimed) for "entertainment services, namely, amusement arcades featuring console-based video game systems with multiple stations, each consisting of a large LCD television, leather chair and sound dome, for use in

¹ Opposer's April 7, 2011 filing appears to be a supplement or surreply to its brief in response to applicant's second motion to dismiss. As such, it is not provided for under Trademark Rule 2.127(a) and has been given no consideration.

individual and group game play, game tournaments and game leagues" in International Class 41.²



Opposer supports its causes of action by pleading ownership of the following registrations for the mark GAMELINK (standard characters):

- 1) Registration No. 2206576 for "electronic and online retailing services by means of a global computer network, featuring products for adults, namely, videos, CD-ROMs, films, books, rubber goods and adult toys" in International Class 35; and
- 2) Registration No. 3023336 for "on-line retail store services, computerized on-line ordering services, and wholesale ordering services in the field of entertainment goods namely videos, CDs, DVDs and order fulfillment services" in International Class 35, and "Video-on-demand transmission and streaming of audio and video materials on the Internet" in International Class 38.

On January 13, 2011, the Board denied applicant's motion to dismiss under Fed. R. Civ. P. 12(b)(6) with respect to dilution, and granted said motion with respect to the following grounds:

- 1) Priority and likelihood of confusion under Trademark Act Section 2(d),
- 2) deceptiveness under Section 2(a),
- 3) false suggestion of a connection under Section 2(a),
- 4) mere descriptiveness under Section 2(e)(1),

² Application Serial No. 77770614, filed June 29, 2009, based on use in commerce under Trademark Act Section 1(a), and asserting a date of first use of June 1, 2008, and date of first use in commerce of June 21, 2009.

- 5) deceptive misdescriptiveness under Section 2(e)(1),
- 6) fraud, and
- 7) genericness under Section 23.

The Board allowed opposer leave to amend its pleading, and opposer thereafter filed a timely amended pleading. Applicant now moves to dismiss the *amended* pleading under Fed. R. Civ. P. 12(b)(6).

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). See also TBMP § 503.02 (2d ed. rev. 2004).

Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. ___, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of inter partes proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads

factual content that allows the Board to draw a reasonable inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. The factual allegations "must be enough to raise a right to relief above the speculative level." See *Totes-Isotoner Corp. v. U.S.*, 594 F.3d 1346, 1354 (Fed. Cir. 2010).

For purposes of determining the motion, all of opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to opposer. The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e); see also *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

The Board now turns to the amended notice of opposition.³ Applicant does not challenge opposer's standing by way of its motion to dismiss; hence, opposer's standing is not in issue.

Priority and likelihood of confusion

To sufficiently state such a ground, opposer must allege that it is a prior user of its pleaded mark and that contemporaneous use of the parties' respective marks in

³ Opposer's amended notice of opposition does not re-plead these grounds: deceptiveness under Section 2(a), deceptive misdescriptiveness under Section 2(e)(1), and genericness under Section 23. Accordingly, they no longer form part of the pleaded grounds of opposition.

their respective goods and/or services would be likely to cause confusion, mistake or to deceive consumers. See *Hornblower & Weeks, Inc. v. Hornblower & Weeks, Inc.*, 60 USPQ2d 1733, 1735 (TTAB 2001).

In paragraph 4, opposer alleges that it has priority of use of the mark GAMELINK for the services identified in its two pleaded registrations, and in paragraph 8, it alleges that "the contemporaneous use of the Opposer's and of Applicant's respective marks for their respective goods and/or services online and in advertising, including Internet advertising, is likely to cause confusion, mistake or to deceive consumers" (amended notice of opposition, para. 8).

These allegations sufficiently set forth the elements of a priority and likelihood of confusion ground for opposition.

In view thereof, applicant's motion to dismiss with respect to this ground is denied.

False suggestion of a connection under Section 2(a)

A claim of false suggestion of a connection requires opposer to allege that 1) the mark is the same as or a close approximation of the name or identity of a person or institution, 2) the mark would be recognized as such, 3) the person or institution identified in the mark is not connected with the services performed by applicant under the mark, and 4) the fame or reputation of the named person or

institution is of such nature that a connection with such person or institution would be presumed when applicant's mark is used on its services. See *Buffet v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

Paragraphs 10 through 13 of the amended notice of opposition plead factual allegations that sufficiently set forth the elements of this ground.

In view thereof, applicant's motion to dismiss with respect to this ground is denied.

Mere descriptiveness under Section 2(e)(1)

A mark is unregistrable under Section 2(e)(1) if the mark as a whole merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant's specified goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Paragraphs 15 through 17 of the amended notice of opposition plead the core factual allegations relevant to this ground. In particular, opposer alleges that "Game Link is descriptive of a service that provides gaming consoles where a person may *link* into various electronic *games*" (amended notice of opposition, para. 16, emphasis in original), and that "Applicant's new identity (sic) of services includes the temporary ability to use an electronic video game. This means that a user is 'linked' into a video

game and can unlink therefrom" (amended notice of opposition, para. 17).

At the outset, we note that applicant has disclaimed the exclusive right to use the term "Game Link." Furthermore, applicant's mark consists of more than the wording GAME LINK; the mark includes a distinctive design element, and claims color as a feature of the mark. Opposer fails to set forth factual allegations asserting the manner in which the design element of applicant's mark and the mark *as a whole* merely describes an ingredient, quality, characteristic, function, feature, purpose or use of applicant's services. *Cf. In re 1800Mattress.com IP, LLC*, 92 USPQ2d 1682 (Fed. Cir. 2009). Moreover, it appears that such a claim would be futile, given the nature and elements of applicant's mark as a whole.

In view thereof, applicant's motion to dismiss with respect to this ground is granted with prejudice.

Fraud

Pleadings of fraud on the USPTO, governed by Fed. R. Civ. P. 9(b), must allege with particularity that an applicant knowingly made a false, material representation of fact in connection with an application for registration, with the intent to deceive the USPTO. *See In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

By way of paragraphs 18 through 27, opposer essentially asserts that applicant, in his response to the office action refusing registration under Section 2(d), did not literally respond to the refusal, or amend his identification of services, so as to state that he uses his mark on the internet in his business and in his advertising, and that applicant thereby led the examining attorney to believe that the parties' marks are used in dissimilar channels of trade. In particular, opposer alleges, inter alia, that applicant amended his identification of services "to make it appear as though there was *only* the brick-and-mortar (physical) location for his Game Link gaming parlor," that applicant "failed to mention again the TCP/IP and other Internet use and advertising of using the same channels of advertising as does Game Link, the Opposer" (amended notice of opposition, para. 23, emphasis in original), and that applicant "does not tell the PTO that he uses the Internet to advertise" (amended notice of opposition, para. 26).⁴

The allegation that applicant did not state that he uses his mark on the internet or online in the course of rendering the identified services and/or in the course of advertising said services does not constitute a material misrepresentation

⁴ Indeed, in its brief, opposer explains that its allegations are that applicant "hid that he uses the mark online extensively to advertise online," and "gave a falsely different Description of G/S to stress the arcade aspect, but again this belies the facts alleged that he does a lot of internet advertising" (opposer's brief, p. 6).

on which the USPTO relied in determining the registrability of the mark.

Moreover, applicant was not statutorily required to state in his identification of goods each and every manner or mode of use of his mark in his business and/or in advertising, and if applicant's mark ultimately registers, it will be registered only for the services identified. Accordingly, opposer's allegations that applicant did not designate that he uses his mark on the internet or online cannot form the basis for a claim of fraud on the USPTO.

In view thereof, applicant's motion to dismiss with respect to this ground is granted.

As a final matter, the Board notes applicant's argument, which is relevant to paragraph 1 of the amended notice of opposition. That paragraph reads:

1. Opposer GameLink, L.L.C. incorporates all statements made heretofore, and incorporates herein all statements made on the ESTTA form online.

Thus, opposer seeks to incorporate by reference, into its amended notice of opposition, matter on the ESTTA filing form that accompanied the original notice of opposition.

Specifically, applicant contends that the ESTTA form "consists of a rambling of facts, allegations, and unsupported legal conclusions to which Applicant cannot reasonably be expected to respond and which mixes together all different claims for

relief" (applicant's brief, p. 3), that "it appears that the Board already struck the statements in the ESTTA form by virtue of striking the preamble in the original Notice of Opposition, and that the ESTTA cover sheet "has not actually been served on Applicant" (applicant's brief, p. 4).

In general, Board practice at least contemplates giving consideration to allegations which are set forth in an amended pleading by way of incorporation by reference. See, e.g., *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1858 (Fed. Cir. 2000) (an amended pleading, if allowed, will supersede an earlier pleading, particularly if it is complete in itself and makes no reference to nor adoption of a prior complaint); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 n.10 (TTAB 2000) (Board noted an allegation in a prior pleading).

Here, in adjudicating the sufficiency of the original notice of opposition, the Board effectively struck for insufficiency the matter alleged by way of the "Other" section of the ESTTA filing form; such matter remains stricken for the same reasons, and because opposer did not serve applicant with the original ESTTA filing form. Thus, reconsideration of said matter on the original ESTTA filing form would alter neither the Board's adjudication of the first motion to dismiss, nor the determination herein of the second motion to dismiss. To be clear, said matter in the original notice of opposition was

previously and remains stricken, and applicant need not answer the allegations set forth therein.

To summarize, applicant's second motion to dismiss is granted in part and denied in part as indicated herein. Accordingly, the paragraphs listed under Count I (priority and likelihood of confusion under Section 2(d)), Count II (false suggestion of a connection under Section 2(a)), and Count V (dilution under Section 43(c))⁵ of the amended notice of opposition constitute the operative allegations in the amended pleading in this proceeding, and this opposition shall proceed with respect to these grounds.

Schedule

Proceedings are resumed. Applicant is allowed until thirty (30) days from the mailing date of this order in which to file an answer to the operative pleading. Conferencing, disclosure, discovery and trial dates are reset as follows:

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| Deadline for Discovery Conference | 6/30/2011 |
| Discovery Opens | 6/30/2011 |
| Initial Disclosures Due | 7/30/2011 |
| Expert Disclosures Due | 11/27/2011 |
| Discovery Closes | 12/27/2011 |
| Plaintiff's Pretrial Disclosures due | 2/10/2012 |

⁵ Applicant's challenge to the dilution claim as "so vague and ambiguous that Applicant cannot form a responsive pleading" (applicant's brief, p. 7) is without merit. In considering the first motion to dismiss, the Board found the dilution claim to be sufficient, and the claim in the amended pleading, which is nearly identical to the original, is also sufficient. To address applicant's concern that the paragraphs of this ground, and other grounds, consist of multiple sentences, applicant should admit or deny each sentence, as appropriate.

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| Plaintiff's 30-day Trial Period Ends | 3/26/2012 |
| Defendant's Pretrial Disclosures due | 4/10/2012 |
| Defendant's 30-day Trial Period Ends | 5/25/2012 |
| Plaintiff's Rebuttal Disclosures due | 6/9/2012 |
| Plaintiff's 15-day Rebuttal Period Ends | 7/9/2012 |

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.