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

Proceeding	91199922
Party	Defendant Nike, Inc.
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Submission	Motion to Dismiss - Rule 12(b)
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Date	07/28/2011
Attachments	NIKEs Reply & Second Motion to Dismiss.pdf (39 pages)(733888 bytes)

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

CHRISTOPHER A. McGRATH, Opposer,)	Opposition No. 91199922
v.)	Serial No. 85053714
NIKE, INC., Applicant.)	Mark: 

**APPLICANT’S RESPONSE TO OPPOSER’S MOTION TO AMEND/AMENDED
NOTICE OF OPPOSITION AND RENEWED MOTION TO DISMISS**

Applicant, NIKE, INC. (hereinafter “NIKE” or “Applicant”) herewith responds to Opposer’s Motion to Amend Pleading/Amended Pleading¹ filed on July 14, 2011 and renews herewith its Motion to Dismiss the proceeding pursuant to Rule 12(b)(6) of the Federal Rules of Civil Procedure.

For procedural clarity, NIKE notes that the first Notice of Opposition was filed by Opposer on May 22, 2011. On June 30, NIKE filed and served its first Motion to Dismiss pursuant to Rule 12(b)(6) for failure to state a claim upon which relief can be granted. On July 14, 2011, Opposer responded to NIKE’s first 12(b)(6) motion by electronically filing a Motion to Amend Pleading/Amended Pleading with the Board. Opposer did not include the required certificate of service with its Motion to Amend Pleading/Amended Pleading, although he did forward a copy of the filing to NIKE’s undersigned counsel via email.² In the event that the Board elects to accept Opposer’s Motion to Amend Pleading/Amended Pleading notwithstanding

¹ “Motion to Amend Pleading/Amended Pleading is the title used on the ESTTA cover sheet submitted by Opposer with its July 14, 2011 filing. The document itself uses the term “Revised Notice of Opposition” on p. 1.

² The parties do not have an agreement in place at this time for service by email, although NIKE served its motion by both email and First Class Mail. However, even if such a mutual agreement for service by email were in place, Opposer did not comply with the requirement for including a certificate of service with his filing.

the absence of the required certificate of service, then NIKE requests that the Board treat this filing as its reply brief for NIKE's first 12(b)(6) motion, its response to Opposer's Motion to Amend, and its renewed (second) motion pursuant to Rule 12(b)(6), this time directed to include the Amended Notice of Opposition. In the event that the Board declines to accept Opposer's Motion to Amend/Amended Notice of Opposition, then NIKE requests leave to file such further response as may be appropriate depending on the nature of the Order issued by the Board.

Because Opposer again has failed to allege facts which support (1) any statutory ground for opposing registration of NIKE's mark, and (2) that Opposer has standing, both Opposer's first Notice of Opposition and its Amended Notice of Opposition should be dismissed for failure to state a claim upon which relief can be granted. The grounds for the motion are as follows:

1. Statement of Facts

On June 3, 2010, NIKE filed application No. 85053714, pursuant to Section 1(b) of the Trademark Act (intent to use) for the following mark ("NIKE's Mark"):



The goods and services covered by NIKE's application are:

- **Class 018** - Bags, namely, all-purpose sports bags, tote bags, duffle bags, messenger bags, backpacks, purses, umbrellas, luggage, cosmetic and toiletry cases sold empty
- **Class 025** - Footwear; apparel, namely, pants, shorts, shirts, t-shirts, pullovers, sweat shirts, sweat pants, underwear, sports bras, dresses, skirts, sweaters, jackets, socks, sweatbands, gloves, belts, hosiery, armbands, coats, vests, headwear, namely, hats, caps; cleats for playing football, baseball, softball, golf, cricket
- **Class 028** - Sports balls; bags for sporting equipment, namely, balls; bats, namely, baseball, softball, cricket; gloves used in baseball, softball, golf; golf clubs, golf balls, golf club grips, golf bags, golf tees, head covers for golf clubs, golf ball markers; protective padding for playing baseball, football, hockey, softball, cricket, basketball; hockey sticks, baseball mitts, softball mitts, personal exercise mats, snowboards, skateboards, stumps for playing cricket
- **Class 035** - Retail store services in the field of apparel, headwear, footwear, bags of all kinds, accessories made of leather and imitation leather, umbrellas, sports

equipment, golf equipment, and accessories for all the aforesaid goods; advertising and marketing

NIKE's Mark was published for opposition on May 13, 2011 and this opposition was instituted on May 22, 2011.

Opposer, who alleges he is a citizen of the United Kingdom, filed Opposition No. 91199922 on the basis of alleged ownership of the following mark ("Opposer's Mark") (ANOP ¶ 2)³:

20XII The Honor of Sport™

and included a link to the website for the United Kingdom's Intellectual Property Office to identify the mark.

Opposer also alleges ownership of a United Kingdom registration, for Opposer's Mark for the following goods and services (ANOP ¶ 5) :

- **Class 25** - Clothing, footwear, headgear.
- **Class 35** - Advertising; dissemination of advertising matter via all media, in particular in the form of thematic messages centred on human values; publicity through sponsoring; business management; business administration; office functions; the organisation, operation and supervision of loyalty and incentive schemes; advertising services provided via the Internet; production of television and radio advertisements; promoting the goods and services of others by means of contractual agreements, in particular of sponsoring and licensing, enabling partners to gain additional notoriety and/or image and/or liking derived from those of cultural and sporting events, in particular international; promoting the goods and services of others by means of image transfer; rental of advertising space of all kinds and on all carriers, digital or not; administration of the participation of national teams to an international athletic competition, and promoting the support to said teams with the public and the concerned circles; accountancy; auctioneering; trade fairs; opinion polling; data processing; provision of business information.

In the Amended Notice of Opposition, Opposer stated that, "The Opposer also holds the trade name 20XII, in use in the United States since October 2007, and both the United States and

³ Citations to specific numbered paragraphs of the Amended Notice of Opposition will be identified as "ANOP ¶ __." Citations to the numbered paragraphs of the first Notice of Opposition, filed on May 22, 2011, will be identified as "NOP ¶ __."

elsewhere since January 2008, as will be shown below.” (ANOP ¶ 3). Opposer then explained that the claim for prior use of 20XII as a trade name in the United States was based on the purchase of certain domain names incorporating 20XII through a United States domain name registrar. (ANOP ¶¶ 8, 15 and 16). Specifically, Opposer states in paragraph 16 that “20XII and its various website extensions renew on a regular basis through GoDaddy.com – that is, the Opposer pays an American Company in American dollars to routinely register the trade name across various domain name extensions. *That is commercial trade in a trade name...* [emphasis added]” (ANOP ¶ 16).

Opposer also alleges that he has granted a worldwide trading license to McG Products Ltd. (“McG”) to use Opposer’s Mark for use in connection with an online treasure hunt, GoldenKeyQuest.com. (ANOP ¶¶ 2 and 21) As explained in the first Notice of Opposition, 20XII was licensed to McG "...to form a cryptic clue as part of an international treasure hunt, a global internet sports game called *Golden Key Quest...*”. (NOP ¶ 11) Details of how 20XII was used as a cryptic clue are set forth in the Amended Notice of Opposition. (ANOP ¶¶ 22-25)

2. Statement of Alleged Grounds for Opposition

Paragraph 7 of the first Notice of Opposition stated that the opposition was based on the following grounds:

- a) The U.S. Trademark Act (not limited to, but including a claim for injunctive relief as a result of dilution under section 43(c) [15 USC 1125(c)];
- b) Article 8 of the Paris Convention for the Protection of Industrial Property; and
- c) the following Case Law: FIRST NIAGARA INSURANCE BROKERS INC v. FIRST NIAGARA FINANCIAL GROUP INC: (<http://caselaw.findlaw.com/us-federal-circuit/1115048.html>).

In addition to listing the three grounds identified above, in the electronic cover sheet submitted with the Notice of Opposition, Opposer checked the box identifying “Trademark Act Section 2(d)” as a ground for the opposition.

The Amended Notice of Opposition appears to renew each of the above grounds as a basis for the Notice of Opposition. (See ANOP ¶¶ 10-13 for the Paris Convention/Article 8 Claim, ANOP ¶14 for the Section 2(d) claim, and ANOP ¶ 40-41 for the dilution claim.) Opposer also again asserts a variety of grounds not cognizable in an opposition proceeding, including wilful infringement and reliance on a registration for the trademark outside of the United States. (ANOP ¶¶ 5 and 35-39)

3. Argument

To survive a motion to dismiss under Rule 12(b)(6), “...a complaint must “state a claim to relief that is plausible on its face.”” TBMP §503.02, citing *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007) and *Ashcroft v. Iqbal*, 556 U.S. ___, 129 S.Ct. 1937 (2009). Opposer again has failed to plead facts which would support any of its claims for relief or provide a basis for standing. Because Opposer has failed to state a claim for relief that is plausible on its face, its opposition must be dismissed.

4. Opposer Again Has Failed to State a Claim Under Section 43(c)

In the Amended Notice of Opposition, Opposer asserts Section 43(c) of the Trademark Act (dilution) as a basis for the opposition (ANOP ¶¶ 40-41), but again fails to plead the necessary grounds for a dilution claim. Dilution claims must include an allegation that Opposer’s mark is famous and that it became famous before the constructive use date of the application being opposed. *Toro v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n. 9 (TTAB 2001); *Citigroup Inc. v. Capital City bank Group Inc.*, 94 USPQ2d 1645 (TTAB 2010), *aff’d* 98

USPQ2d 1253 (Fed. Cir. 2011). A dilution claim which fails to include an allegation that the opposer's mark at issue is famous is legally insufficient. *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001).

The first Notice of Opposition and the Amended Notice of Opposition contain no statement that Opposer's mark is famous, much less a statement that it was famous before NIKE's constructive use date. Further, given Opposer's admissions of limited use (e.g., via registration as a domain name or as a cryptic clue in an online game), as well as Opposer's statement in the first Notice of Opposition that its mark is "gathering notable fame," (NOP ¶ 11) it is apparent that Opposer cannot make a plausible assertion that it has a famous mark. The Board should dismiss Opposer's claim under Section 43(c).

5. Article 8 of the Paris Convention Does Not Provide a Valid Ground for Opposition

Opposer again asserts that it is entitled to relief under Article 8 of the Paris Convention (ANOP ¶¶ 9-13), which addresses protection for trade names. However, it is well settled that the Paris Convention is not self-executing and cannot provide an independent basis for an inter partes proceeding. *See, In re Dr. Matthias Rath*, 402 F.3d 1207, 1210, 74 USPQ2d 1174, 1176 (Fed Cir. 2005); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1591 (TTAB 2009); and *International Finance Corp. v. Bravo Co.*, 64 USPQ2d 1597, 1603 (TTAB 2002). Article 8 of the Paris Convention does not provide a statutory basis for Opposer's claim. Opposer's claim for relief under Article 8 of the Paris Convention must be dismissed for failure to state a claim.⁴

⁴ Section 44 of the Lanham Act, 15 U.S.C. §1126, implements the Paris Convention. Protection for trade names is included in Section 44(g), so the U.S. is in compliance with its Paris Convention obligations. However, Section 44(g) does not provide an independent cause of action, any more than Section 44(h) which mandates protection against unfair competition (Article 10*bis* of the Paris Convention), provides an independent cause of action. *See* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §29:25 (4th ed. 2005)

6. Opposer Again Has Failed to State a Claim Under Section 2(d)

Section 2(d) provides a basis for an opposition if the Applicant's mark "...so resembles a mark previously registered in the Office [PTO], or a *mark or trade name previously used in the United States* by another and not abandoned, *as to be likely*, when used on or in connection with the goods or services of the defendant, *to cause confusion, or to cause mistake, or to deceive*. [emphasis added]" TBMP §309.03(c)(1).

The requirements for asserting a claim under Section 2(d) are very specific. Not only must there be an allegation of prior registration or prior use of a trademark or trade name in the United States, there must be an allegation that applicant/defendant's mark also must be likely, when used in connection with the goods or services of the applicant/defendant, to cause confusion, or to cause mistake, or to deceive. ("It is well settled that '[p]riority of trademark rights in the United States depends solely upon prior use in the United States, not on priority of use anywhere in the world.'" *Aktieselskabet af 21. November 2001 v. Fame Jeans*, 77 USPQ2d 1861 (TTAB 2006), *citing* 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §29:02 (4th ed. 2005).)

While Opposer's first Notice of Opposition was vague on the grounds for its Section 2(d) claim, the Amended Notice of Opposition clarifies that the basis for its Section 2(d) claim of *prior* use of 20XII as a trade name⁵ is based on the following activities:

(1) Registration and renewal of various 20XII domain names through GoDaddy.com

(ANOP ¶¶ 8 and 15); and

(2) References to 20XII as a clue in an online game. (ANOP ¶¶ 21-26)

⁵ Opposer appears to misunderstand the terms trade name and trademark because he asserts in paragraph 11(c) of the Amended Notice of Opposition that, "Moreover, United States trademark rights at common law are established by using the mark in trade. The trade name became a mark by default."

Merely alleging prior use or registration of a domain name does not rise to the level of a claim of prior use of a trademark or trade name in the United States. As Professor McCarthy has noted, domain names are like street addresses or telephone numbers: "... every domain name serves the purely technological function of locating a website in cyberspace. However, a domain name does not become a trademark or service mark unless it is also used to identify and distinguish the source of goods or services. Out of the millions of domain names, probably only a small percentage also play the role of a trademark or a service mark." J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:17.50 (4th Ed. Updated June 2008).

In *Gamers, Inc. v. Game-Xpert, Inc.*, Opposition No. 91164969 (TTAB August 6, 2008),⁶ the Board expanded on Professor McCarthy's statements above, and explained the difference between relying on a trade name to establish priority in an inter partes dispute and a domain name:

[U]se as a trade name to establish priority is specifically enumerated in the statute: '...or a mark or trade name previously used in the United States...' 15 U.S.C. §1052(d). There is no equivalent provision for domain name registration or use; nor is a domain name, per se, similar to a trade name, it is more in the nature of a street address. Therefore, domain registration and use as a web address in and of themselves do not serve to establish priority. See *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 50 USPQ2d 1545, 1555 (9th Cir. 1999) (The mere registration of a term as a domain name does not establish any trademark rights.) *Gamers, supra*, slip op. at pp. 7-8.

In its Amended Notice of Opposition, Opposer again fails to plead sufficient facts to make a plausible claim that NIKE'S Mark is likely to cause confusion with Opposer's Mark. The only prior use that Opposer specifically identifies as having been made by its licensee, McG, is the alleged use of 20XII as "a cryptic clue as part of an international treasure hunt..." a type of "use" which qualifies neither as trademark or trade name use. (NOP ¶ 11) Opposer's

⁶ The *Gamers* case is cited pursuant to TBMP §101.03. A copy of the slip opinion is attached as Exhibit A to this Motion.

continued efforts in its Amended Notice of Opposition (ANOP ¶¶ 21-26) to explain the alleged uses of 20XII as a cryptic clue in an online game at GoldenKeyQuest.com likewise fail to demonstrate any basis for claiming either prior trademark or prior trade name use of 20XII of 20XII The Honor of Sport in the United States.

Opposer does make reference to one type of *subsequent* use of 20XII The Honor of Sport as a trademark, in connection with an online store set up through Firefox, which Opposer alleges was set up to allow it to sell clothing. However, as carefully documented by Opposer in the Amended Notice of Opposition (ANOP ¶¶ 43-50), the online store was set up four months *after* NIKE filed its application (and after Opposer had learned of NIKE's Mark, as described in paragraph 35 of the Amended Notice of Opposition). Thus, the alleged online store does not provide Opposer with any rights prior to NIKE's constructive use date. (Moreover, the online store, located at <http://www.20xii.logostore.uk.com>, appears to be targeted to an audience in the United Kingdom and does not establish use of 20XII or 20XII The Honor of Sport as a trademark or trade name in the United States.)

Even if the Board concludes that Opposer has asserted an economic interest that is impacted by Opposer's mark, (see *Young v. AGB Corp.*, 152 F.3d 1377, 1368, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998)), Opposer has failed to assert a valid claim for relief under Section 2(d) because it has failed to assert either prior use as a trade name or mark in the United States with goods or services that could plausibly support a claim for likelihood of confusion.

7. Additional Allegations in the Amended Notice of Opposition

In addition to the three grounds specifically identified in paragraph 7 of the first Notice of Opposition, Opposer again makes references in the amended notice of opposition to claims that are not the proper subject of an opposition proceeding.

In paragraphs 35-41 of the Amended Notice of Opposition, Opposer again alleges “wilful infringement” by NIKE. These averments again are not supported by fact or law. Most importantly, for purposes of this motion, it is well settled that the Board does not have jurisdiction to hear this type of claim in an opposition proceeding. See TBMP 102.01 and cases cited therein at n. 2, including *FirstHealth of the Carolinas Inc. v. CareFirst of Md. Inc.*, 479 F.3d 825, 81 USPQ2d 1919, 1921 (Fed. Cir. 2007) and *Person’s v. Christman*, 900 F.2d 1565, 1571, 14 USPQ2d 1477, 1481 (Fed. Cir. 1990). As such, if Opposer intends to include these allegations as grounds for the opposition, they are not within the jurisdiction of the Board, and should be dismissed.

Opposer also claims reliance on a United Kingdom registration for Opposer’s Mark (ANOP ¶ 5), but there is no statutory basis in the Trademark Act for opposing a mark based on a foreign registration. Rather, Section 2(d) of the Trademark Act requires that the prior registered mark be registered in the U.S. Patent & Trademark Office, not elsewhere in the world. As such, if Opposer intended to base its opposition on its United Kingdom registration, the Amended Notice of Opposition also must be dismissed for failure to state a claim on which relief can be granted.

8. Opposer Has Failed to Plead Facts Sufficient to Establish Standing

“In order to prove standing, the plaintiff must allege facts to show a ‘real interest’ in the proceeding and a ‘reasonable basis’ for its belief that it would suffer some kind of damage if the mark is registered.” TBMP §309.3(b) and cases cited therein at n. 2, including *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999). Opposer has failed to assert that it has a famous mark, has failed to assert reliance on a prior registration in the United States, and has failed to assert prior use of a trademark or trade name in the United States on goods or

services that would support a likelihood of confusion claim. As such, Opposer has pleaded “no reasonable basis for believing that it is damaged by the registration...” opposed herein. *General Healthcare v. Qashat*, 254 F.Supp.2d 193, 204 (D. MA. 2003), *aff’d on other grounds*, 364 F.3d 332, 70 USPQ2d 1566 (1st Cir. 2004). Opposer has failed to prove the necessary standing to support its notice of opposition, and the opposition should be dismissed.

9. Conclusion

For the reasons stated above, NIKE respectfully requests that both of its motions to dismiss this opposition for failure to state a claim pursuant to Rule 12(b) (6) Fed.R.Civ.P. be granted.⁷

Respectfully submitted,

Date: July 28, 2011

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Enclosure:

Exhibit A – Slip Opinion in *Gamers, Inc. v. Game-Xpert, Inc.*

⁷ NIKE notes that pursuant to the Board’s Order of July 11, 2011, proceedings currently are suspended pending determination of NIKE’s first 12(b)(6) motion. NIKE understands that if the Board denies its 12(b)(6) motions that the Board will re-set the time for it to answer the Notice of Opposition pursuant to TBMP §503.01

CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of July, 2011, a true and complete copy of the foregoing APPLICANT'S RESPONSE TO OPPOSER'S MOTION TO AMEND/AMENDED NOTICE OF OPPOSITION AND RENEWED MOTION TO DISMISS has been served on Opposer Christopher A. McGrath via First Class Mail, postage prepaid, and also by email, addressed as follows:

Mr. Christopher McGrath
McG Productions Ltd.
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Newport Pagnell, Milton Keynes,
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By: /Helen Hill Minsker/

EXHIBIT A

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
August 6, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Gamers, Inc.
v.
Game-Xpert, Inc.

Opposition No. 91164969
to application Serial No. 76553390
filed on October 3, 2003

Paul D. Heimann of Erickson & Sederstrom, P.C. for Gamers,
Inc.

William A. English of Vista IP Law Group LLP for Game-Xpert,
Inc.

Before Zervas, Kuhlke and Walsh, Administrative Trademark
Judges.

Opinion by Kuhlke, Administrative Trademark Judge:

Applicant, Game-Xpert, Inc., seeks registration of the
mark shown below for goods identified in the application as
"computerized on-line retail store and distributorship

services featuring computer game software" in International Class 35.¹



Opposer, Gamers, Inc., opposed registration of applicant's mark, on the grounds that, as used with applicant's services, the mark so resembles opposer's previously used marks GAMERS and GOGAMERS.COM for "the sale and distribution of computer video games" as to be likely to cause confusion, to cause mistake, or to deceive under Trademark Act Section 2(d), 15 U.S.C. 1052(d).

Applicant filed an answer by which it denied the salient allegations and asserted as affirmative defenses that: the term "Gamers" is "generic for the consumers who purchase Opposer's goods and services"; "Gamers" is "merely descriptive of Opposer's goods and services, and Opposer cannot demonstrate secondary meaning of the term 'Gamers'"; and "opposer has no common law rights in the terms 'gogamers.com' and 'gamers' because Opposer has not used these terms as trademarks."²

¹ Serial No. 76553390, filed on October 3, 2003. The application is based on a allegation of first use and use in commerce on December 31, 2001 under Trademark Act Section 1(a), 15 U.S.C. 1051(a).

² Applicant also asserts that it "has senior rights in the mark 'GOGAMER.COM' in all areas in which Game-Xpert has used the mark outside any limited geographical area in which Opposer may have engaged in business." This defense, addressing the parties'

THE RECORD

The evidence of record includes: the pleadings; the file of the opposed application; opposer's notice of reliance on applicant's responses to discovery requests; opposer's trial testimony of Dale J. Miller, opposer's owner; applicant's trial testimony of Ammar Adra, applicant's president and CEO, and Craig Steven Ferrante, an independent web developer hired by applicant; and applicant's notice of reliance upon various documents, including USPTO records and dictionary excerpts.³

In its brief, applicant objected to "any evidence submitted by Opposer that was not made of record" but applicant "nonetheless address[ed] such evidence in its arguments." Br. p. 6. Applicant does not specify which items of evidence to which this statement refers. Applicant also noted the following:

In addition, to the best of Applicant's knowledge and review of the TTAB electronic files for the present opposition, the exhibits entered during the deposition of Opposer's president, Dale Miller

possible geographic areas of use, is essentially an argument for concurrent use which is only available in a concurrent use proceeding and, therefore, has been given no further consideration. Trademark Rule 2.133(c), 37 C.F.R. 2.133(c).

³ Both parties submitted documents under notices of reliance that are not self-authenticating and as such are not proper matter for submission under a notice of reliance (e.g., documents produced in response to a request for production absent an admission identifying and authenticating the documents; and printouts from websites). However, inasmuch as neither party objected on this basis and, in fact, discussed these documents in their briefs, we find them to be stipulated into the record and consider them for whatever probative value they may have.

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("the Miller deposition"), were not filed with the TTAB in accordance with 37 C.F.R. §2.125(c), to which Applicant hereby objects.

Br. p. 7 (emphasis in original).

Opposer responds that:

Counsel for Opposer obtained the electronic file of the deposition from the court reporting firm in order to file it with the TTAB. Counsel filed that electronic file with the mistaken belief that he had done so with the exhibits attached to the deposition transcript. Opposer asks the TTAB to consider the evidence in spite of its omission from the filed deposition for the following reasons.

First, as Applicant acknowledged, Exhibit 2, attached to this Rebuttal Brief, is the only exhibit that was not made of record by Opposer in other submissions to the Board. Those exhibits that were made of record should be considered. Second...[t]here is no prejudice or surprise to Applicant associated with Exhibit 2. Applicant was aware that Opposer intended to use Exhibit 2 as it was introduced at the deposition. Counsel for Applicant had ample time to cross-examine Mr. Miller on Exhibit 2 and was even able to address the exhibit in Applicant's brief. Because there is no prejudice or surprise, and Applicant was afforded a full opportunity to examine and respond to Exhibit 2, the TTAB should consider it along with the other evidence in this case.

Reply Br. p. 1.

We first note, that applicant has not objected to the other manner in which some documents that comprise the exhibits to the Miller deposition were submitted, i.e., by notice of reliance. Further, applicant received these exhibits and applicant's attorney was afforded the opportunity to cross-examine the witness as to these exhibits while they were entered into the

record during the timely taking of Mr. Miller's testimony. These exhibits were entered into the record during testimony; the inadvertence in filing the deposition and exhibits with the Board does not remove them from the record. In view thereof, we have considered the exhibits introduced under the Miller testimony.⁴

STANDING

Opposer has sufficiently established that it has standing to bring this proceeding inasmuch as it has demonstrated a real interest in preventing registration of the proposed mark. See *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999); *Jewelers Vigilance Committee, Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987; *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982).

PRIORITY/LIKELIHOOD OF CONFUSION

Opposer is relying on its use of "GOGAMERS.COM" and "GAMERS" to establish common law rights and priority of use. "Under the rule of Otto Roth, a party opposing registration of a trademark due to a likelihood of

⁴ For the convenience of the Board, a Board paralegal contacted the attorneys for opposer and applicant to facilitate the forwarding of the testimony exhibits to have them in the

Opposition No. 91164969

confusion with his own unregistered term cannot prevail unless he shows that his term is distinctive of his goods, whether inherently or through the acquisition of secondary meaning or through 'whatever other type of use may have developed a trade identity.'" *Towers v. Advent Software Inc.*, 913 F.2d 942, 16 USPQ2d 1039, 1041 (Fed. Cir. 1990), citing, *Otto Roth & Co. v. Universal Food Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981).

Further, while a domain name may attain trademark status, its use as an address does not support trademark use. In *re Eilberg*, 49 USPQ2d 1959 (TTAB 1998). "When a domain name is used only to indicate an address on the Internet, the domain name is not functioning as a trademark...Domain names, like trade names, do not act as trademarks when they are used merely to identify a business entity; in order to infringe they must be used to identify the source of goods or services." *Lockheed Martin Corp. v. Network Solutions, Inc.*, 985 F. Supp. 949, 956, 44 USPQ2d 1865, 1871 (C.D.Cal. 1997). See also, *Data Concepts Inc. v. Digital Consulting Inc.*, 150 F.3d 620, 47 USPQ2d 1672, concurring opinion, *Merritt* (6th Cir. 1998); and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, §7:17.50 (4th ed. updated June 2008).

electronic file in the order in which they appeared during the deposition.

As noted in McCarthy on Trademarks and Unfair Competition a domain name:

...identifies a place on the Internet where a 'Web site' is located. In the same way that businesses sometimes desire to have a prestige business address, businesses want a prestige address in cyberspace that corresponds to the trade name of the company or to a company trademark. Like a street address or telephone number, every domain name serves the purely technological function of locating an Web site in cyberspace. However, a domain name does not become a trademark or service mark unless it is also used to identify and distinguish the source of goods or services. Out of the millions of domain names, probably only a small percentage also play the role of a trademark or service mark.

Id.

Of course establishing priority is different from establishing use to support registration. For example, while trade name usage is not sufficient to support an application for registration, it is sufficient to establish priority in an inter partes dispute. TuTorTape Laboratories, Inc. v. Halvorson, 155 USPQ 268 (TTAB 1967); 15 U.S.C. §2(d). However, use as a trade name to establish priority is specifically enumerated in the statute: "...or a mark or trade name previously used in the United States..." 15 U.S.C. §1052(d). There is no equivalent provision for domain name registration or use; nor is a domain name, per se, similar to a trade name, it is more in the nature of a street address. Therefore, domain registration and use as a web address in and of themselves

do not serve to establish priority. See Brookfield Communications Inc. v. West Coast Entertainment Corp., 174 F.3d 1036, 50 USPQ2d 1545, 1555 (9th Cir. 1999) (The mere registration of a term as a domain name does not establish any trademark rights).

Applicant's First Use

While applicant may rely on its filing date of October 3, 2003, applicant has submitted testimony and evidence to establish December 18, 2001 as its date of first use for its GOGAMER.COM logo. See TBMP §704.04 (2d ed. rev. 2004) and cases cited therein. Inasmuch as this date is earlier than the date of first use alleged in the application, December 31, 2001, applicant must prove this date by clear and convincing evidence. Stanspec B. v. American Chain & Cable Co., Inc., 531 F.2d 563, 189 USPQ 420, 424 n. 10 (CCPA 1976); Gor-Ray, Ltd. v. Garay & Co., 167 USPQ 694 (TTAB 1970).

We begin by finding that the term gogamer.com, while perhaps suggestive of the services inasmuch as "gamer" refers to the potential consumer, see discussion infra, and .com has no source identifying significance, the addition of "go" creates sufficient distinction to push GOGAMER.COM into the suggestive part of the spectrum. Opposer notes that "go" refers to the icon frequently used on the Internet to "go" to the next link or to initiate a search; however, we

find that, as used here, it evokes a more general impression of the statement or exclamation "go gamer."

Applicant registered gogamer.com as its domain name in 1999 and the website was up and running, offering games for sale, as of December 18, 2001. Adra Test. p. 16. From the beginning, applicant displayed gogamer.com both as a web address in the lower left hand corner and as a service mark in the stylization for which it seeks registration in the upper left hand corner of the website as shown below.



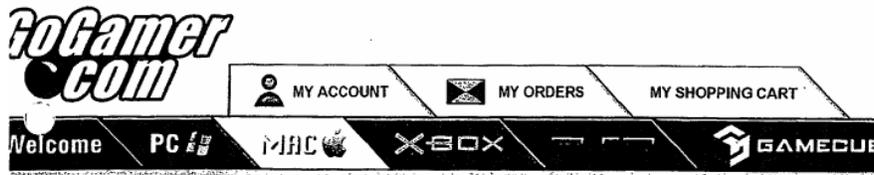
Ferrante Test. pp. 10-12 Exh. 2. (Mr. Ferrante testified that this screen shot is of a later version of the website from late 2002 to early 2003, but the gogamer.com logo was displayed like this in the December 18, 2001 version). The December 18, 2001 launch was announced by a press release on Inside Mac Games, a third-party web site that provides information about Mac games. Adra Test. p. 18, Exh. 12.

The announcement states:

The popular online gaming retailer Compuexpert has launched a new gaming store, GoGamer.com. In addition to snazzy new graphics, the new store features online order status, a wish list, and fast holiday shipping.

Starting in early 2002, applicant included thank you letters in its shipped orders to customers which prominently featured the GOGAMER.COM logo and from late 2002 applicant included various promotional items in its shipped orders, including door hangers, key chains, t-shirts, mouse pads, and calculators, all featuring the GOGAMER.COM logo.

Ferrante Test. pp. 20-23 Exhs. 4, 5, 6.



Gamer!

Thank you for your order and we hope you will spend many fun-filled hours gaming! Don't forget to **spread the word** to your family and friends because the more people you tell the less we have to advertise and that means **more money in your pocket!**

Do you want more great deals? Then **subscribe** to our 48 Hour Madness Mail where you will find some of the best deals imaginable! **Shipping?** We've got you covered there too! Get up to 3 games shipped via fast FedEx 2 Day Air for just \$5.99!

At GoGamer.com we value your privacy and we will do just that, keep it private.

No matter where you go you will never find a better deal than Gogamer.com!

Thank you once again for choosing GoGamer and we hope to see you soon for another pleasant shopping experience.



Based on the evidence of record, applicant has established, by clear and convincing evidence, December 18, 2001 as its date of first use of  as a service mark for online retail computer game store services. Thus, opposer must prove service mark rights prior to December 18, 2001 to establish its priority.

Opposer's Use

We first consider opposer's use of the term GOGAMERS.COM. Opposer's owner, Dale Miller, testified that opposer originally sought to register the domain name "gamers.com" inasmuch as GAMERS was the name of its "brick and mortar" stores, but it was already taken so opposer added the word "go" and registered the domain name

gogamers.com on January 29, 1998. Miller Test. p. 15, Exh. 2.

The screen shot of opposer's web page dated July 17, 1998 shows gogamers.com as the web address in the lower left hand corner and GAMERS in stylized form in large lettering across the top. Miller Test. p. 26 Exh. 6.

PlayStation

GAMERS
VIDEO GAMES & SYSTEMS

(((anna get games.....get to Gamers)))

WELCOME TO GAMERS

- Buys, Sells and Trades home video game items
- New, and Used ^{and are} products accessories available
- Tests and cleans all traded items
- 90-day replacement guarantee with all purchases
- Large selection! - Gamers will locate the item you want
- Mail order is available

FEATURE GAME

Duke 3D

The long awaited sequel popular combat game

HOME
Feature Game
Contact Us
Ready to go items
Store Locations
Links

EXHIBIT 6

Exhibit 6

Date 5-15-07

J. Pell, RPP, CRR, CSR, CCR

<http://www.gogamers.com/index-h.htm>

7/17/98

Opposer's use of gogamers.com eventually evolved into a stylized format displayed at the top of the web page as shown below in the screen shot of the website dated May 14, 2007 (Exh. 10).



Three earlier screen shots are depicted below. The first screen shot is dated August 10, 2005 the second is dated October 26, 2005 and the third is dated November 22, 2005. Exhs. 11, 19 and 12.

Gamers Inc. - Welcome

.....Home : Locations : Contact : The Digz

Welcome

Founded in 1993 with one store in Omaha, we've made our mark as your place for knowledgeable, kind staff with that hometown feel. With just a passion for games and a strive to treat the customer right, we've grown into eleven stores, a Corporate Office, eBay Operations, and a Repair facility, fully staffed with trained technicians.

So stop by one of our local stores and see for yourself, first hand, why you should...

....."Get in the game, and get to Gamers!"



Our eBay Account



IGN.com

5

⁵ Although not appearing here, the domain address gogamers.com is listed at the bottom of this page.



You are visitor 1879

Exhibit 19
 Date 5-15-07
 J. Peil, RPR, CRR, CSR, C

EXHIBIT F

http://www.gogamers.com/

10/26/200



Mr. Miller testified that he has no records to show versions of the website between July 17, 1998 and August 10, 2005. Miller Test. p. 93. Mr. Miller's testimony regarding

opposer's first use of the logo gogamers.com on the heading can be characterized, at best as ambiguous ("I can't remember the date I want to say 2001 maybe" Miller Test. p. 44), and is contradicted by the documentary evidence. Thus, based on the record, opposer began using GOGAMERS.COM in logo form as a source identifier on its website in November 2005, well after applicant's first use as a source identifier, see supra, and approximately eight months after opposer filed the opposition.

Further, as to sales from its online presence Mr. Miller testified:

Q. Okay. So does that give you a re- -- does that refresh your recollection as to when you were contemplating using that as an e-mail address?

A. Yeah. Yeah. He's got, yeah, GAMERS@GoGamers.com. That was initially, yeah, we would have on there - since we didn't have e-commerce set up at that time, customers could e-mail directly to that e-mail address, GAMERS@GoGamers.com, questions. They could request certain games. We could sell games just through e-mail. So that's what the - that initially was for.

Miller Test. pp. 21-22.

Q. How soon after that did you begin to actually sell products by virtue of the internet?

A. As I recall, it would be a couple of months later, probably the summer of '98.

...

Q. Do you still have a - web site for GoGamers.com?

A. Yeah, definitely.

Q. And so if someone were to type that in, they would be directed to your web site?

A. Yeah.

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Q. Okay. Have you used that web site address continuously since - from '98 up until the present date?

A. Yes.

Miller Test. pp. 22, 23.

A. We have - now we have e-commerce, so they can buy directly through the web site and pay in a secure site, whereas the other one, it had e-mail through GAMERS@GoGamers.com.

Q. Okay. When did that transaction take place where people were purchasing via e-mail as opposed to e-commerce?

A. I don't recall the date. It could be 2002, 2003.

...

Miller Test. pp. 43-44.

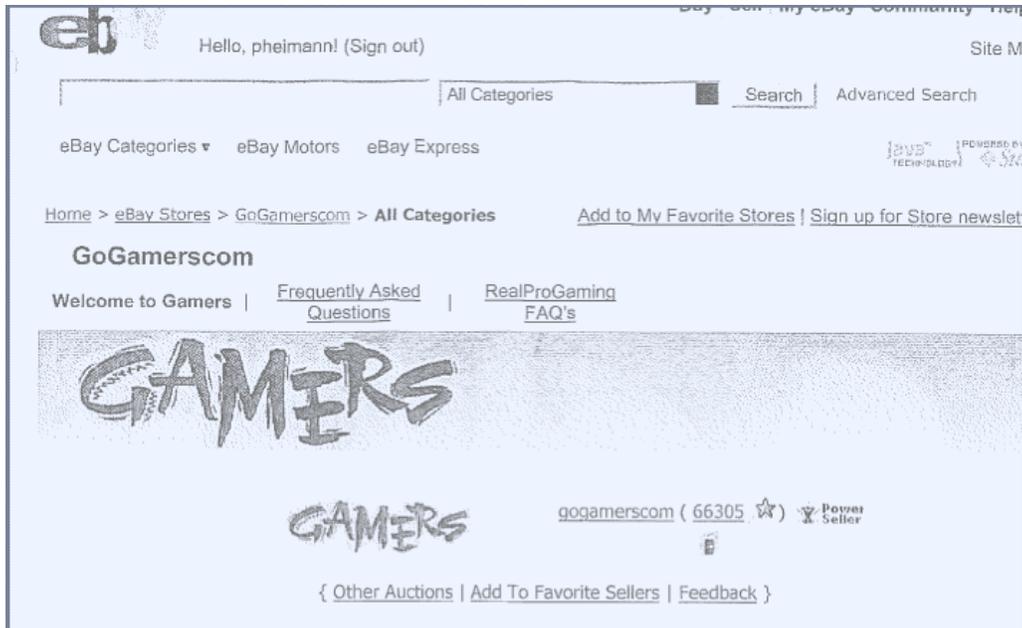
Thus, in order to purchase a product prior to 2002 or 2003 consumers would have to send an email to GAMERS at that email address, which further reinforces the finding that GOGAMERS.COM was not being used as a source identifier prior to December 2001.

Finally, although opposer testified on May 15, 2007 that *presently* the invoice shipped out with products ordered online from the website includes the gogamers.com logo, it is not clear when that began. Miller Test. p. 53. Although Mr. Miller testified that earlier invoices in 1999 included gogamers.com, based on the testimony it appears that it was used as a location device and not as a trademark. Miller Test. p. 32 ("We would have - when we'd print an invoice for a sale, we would list visit GoGamers.com for more deals or various other specials or sales"). This type of use is

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further corroborated by a 2005 invoice in the record. See Miller Test. Exh. 20 (October 11, 2005 packing slip that includes the GAMERS logo in large font and the following reference to an email address: "Looking for arcade machines? We've got plenty! Inquire at sales@gogamers.com").

Opposer also attempts to establish priority through its presence on eBay. Opposer initially testified that it began using the user ID "gogamerscom" sometime around "2000, 2001" for its eBay account. Miller Test. p. 33. However, this statement is not supported by the documentary evidence and was contradicted on cross examination. Opposer submitted a screen shot of its "store front" on eBay which is "a page or a combination of pages where a customer can see everything that, in this case, gogamerscom has for sale." Miller Test. p. 40.



Exh. 9.

These screen shots are dated May 13, 2007. The earliest screen shot of record is from November 7, 2005 (Exh. 14). The earlier screen shot also includes the greeting "Welcome

to Gamers" underneath the gogamerscom user id. There is no testimony or evidence to indicate the manner in which gogamerscom appeared prior to November 7, 2005. The following testimony on cross examination clarifies when gogamerscom was first registered as opposer's user id on eBay:

Q. Do you have a fair bit of experience dealing with eBay?

A. Yes.

Q. Do you know what this page is?

A. Yes. It's the user ID page.

...

Q. Okay. Now, do you see they use - under the - you know, it says across there, "eBay Member User ID History." And then there's another line across there, and then the final line, I mean, below that, sorry, it says user ID?

A. Yes.

Q. And do you see the word underneath that?

A. GoGamersCom? Is that what you're...

Q. Yes.

A. Yeah. Yes.

Q. Is that your user - the user ID that you used for your eBay store?

A. Yes.

Q. And what is - what's the date underneath that?

A. November of '02.

Q. So does this refresh your memory as far as when you started using GoGamersCom as your user ID?

A. Yeah, I guess so. I believe it was prior to that. And it could have been the - when we used GoGamers.com prior to that.

Q. Because you had - that's - you had stated earlier that your user name had changed on your eBay store for your user name; correct?

A. Yeah.

Q. Now, can you go to the next row underneath there, underneath where it says "GoGamersCom," do you see the asterisks and then @alltel.net?

A. Yes.

Q. You had stated earlier that that was your user ID at some point?

A. That - yeah. It - the e-mail address originally.

Q. So do you - do you know what the asterisks are for?

A. Well, I presume it's GAMERS@alltel.net, although there is enough asterisks for it to be GoGamersCom@alltel.net.

Q. And what was the effective date for that user ID?

A. March of 2000.

Q. At - does that refresh your memory as far as when you started your eBay store?

A. It seems to coincide, roughly.

...

Q. Okay. So to your recollection, what do you believe those asterisks would have been?

A. Well, I - as I've said, I - it could - it - I know at one point it was GAMERS@alltel.net. And I - I know at one point we - we wanted to use our web link, our web site whenever we could. So it could have been GoGamersCom@alltel.net. You know, exact dates I - I don't know. We're operating physical stores at the same time as well as trying to develop this new - new, I guess, virtual store. We worked on GoGamers.com prior to this, so it's - it's kind of difficult to say exact time when we started on it.

Miller Test. pp. 82-86 Exh. 14.

As applicant states:

Opposer provided no evidence that its User ID "gogamerscom" served as anything more than Opposer's eBay identification for allowing Opposer to log in and access eBay accounts, nor did Opposer provide evidence that Opposer's User ID identified Opposer as an eBay seller to an eBay purchaser. Instead, Applicant's Notice of Reliance, Exhibit 11, shows Opposer used "Gamers" in large design font in the center of Opposer's eBay sales page to identify Opposer as a seller to customers, while "gogamerscom" is in small text on a side of the sales page and not featured prominently to identify Opposer as the seller.

Br. p. 31.

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We add that, setting aside the question of whether use as a user ID on eBay can serve as service mark use, again the testimony regarding opposer's first use of gogamerscom is indefinite and the evidence of record points to November, 2002 as the start date for that user ID after applicant's December 18, 2001 date of first use.

Inasmuch as opposer has not established trademark rights in GOGAMERS.COM prior to applicant's first use of the GOGAMER.COM logo, the opposition based on this alleged trademark must fail. In view thereof, we do not reach the issue of likelihood of confusion as to these marks.

We now turn to consider opposer's assertion of service mark rights in the term GAMERS and its date of first use. Applicant argues that GAMERS is generic for opposer's services, because "gamers" is "commonly used to refer to the class of purchasers of Opposer's goods and services, i.e., individuals who play video and computer games." Br. p. 41.

"GAMER" is defined as "one who plays a game, especially a role-playing or computer game." The American Heritage Dictionary of the English Language (4th ed. 2006), Applicant's Notice of Reliance Exh. 1. Opposer does not dispute the meaning of "gamers" but argues that it is suggestive of opposer's services, or, at most, merely descriptive and has acquired distinctiveness.

The critical issue in determining genericness is whether members of the relevant public primarily use or understand the designation sought to be registered or that is already registered to refer to the genus or category of goods or services in question. *H. Marvin Ginn Corp. v. Int'l Ass. Of Fire Chiefs, inc.*, 782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In our analysis, we first identify the genus of goods or services at issue and then determine whether the term in issue is understood by the relevant public primarily to refer to that genus of goods or services. *Id.* In this case the genus is online retail sales of computer and video games. While there is evidence of record that the term GAMERS refers to potential customers of opposer's retail services, there is no evidence to support a finding that consumers would use GAMERS to refer to the retail sales of games for gamers. Thus, we find that, based on this record, GAMERS is not the generic term for opposer's services.

However, GAMERS, in the context of opposer's services, immediately conveys to potential purchasers a significant feature of the services, i.e., they are directed to gamers. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004); *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986). Therefore, GAMERS is merely descriptive of opposer's services.

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In view of the above, the term GAMERS is, at least, capable of acquiring source identifying significance for opposer's services. Thus, to establish priority, opposer must prove acquired distinctiveness prior to applicant's established first use date.

It is opposer's burden to establish acquired distinctiveness. See *Yamaha Int'l Corp. v. Hoshino Gakki Co. Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Id.* at 1008. Thus, a claim that opposer has been using the subject matter for a long period of substantially exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use); *In re Kalmbach Publishing Co.*, 14 USPQ2d 1490 (TTAB 1989); and *In re Gray Inc.*, 3 USPQ2d 1558, 1559 (TTAB 1987).

The amount and character of evidence required to establish acquired distinctiveness depends on the facts of each case, *Roux Laboratories, Inc. v. Clairol Inc.*, 427 F.2d 823, 166 USPQ 34 (CCPA 1970), and more evidence is required where a mark is so highly descriptive that purchasers seeing the matter in relation to the goods or services would be less likely to believe that it indicates source in any one party. See *In re Bongrain International Corp.*, 894 F.2d

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1316, 13 USPQ2d 1727 (Fed. Cir. 1990). Evidence of acquired distinctiveness can include the length and manner of use of the mark, the nature and extent of advertising and promotion, sales, and surveys. See *British Seagull Ltd. v. Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993). See also *Coach House Restaurant, Inc. v. Coach and Six Restaurant, Inc.*, 934 F.2d 1551, 19 USPQ2d 1401, 1406 (1991). However, a successful advertising campaign is not in itself necessarily enough to prove acquired distinctiveness. In *re Boston Beer Co. L.P.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999) (claim based on annual sales under the mark of approximately eighty-five million dollars, and annual advertising expenditures in excess of ten million dollars, not sufficient to establish acquired distinctiveness in view of highly descriptive nature of mark).

In support of its assertion of acquired distinctiveness, Mr. Miller testified that opposer opened its first GAMERS store on July 20, 1993. Miller Test. p. 8. Its first store was in Omaha, Nebraska and opposer now has ten stores in Nebraska and Iowa. Id. at 9. Opposer used GAMERS in signage outside the store. Opposer began use of GAMERS online in connection with its services selling video games through email and displaying GAMERS on its website beginning on July 17, 1998. Opposer has used GAMERS as its trade name since 1993. In addition, opposer has used GAMERS

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on its eBay store front. Opposer's present annual revenue is "around eight million" (id. at 45) and opposer has made sales to consumers in all fifty states. Id. at 48.

Given the highly descriptive nature of this term, the record in this case does not support a conclusion based on substantial evidence that opposer has acquired distinctiveness in connection with opposer's retail sales of computer and video games either online or in brick and mortar stores. While opposer testified that GAMERS was on signage outside the stores, there are no examples in the record or testimony to show how it was displayed. Further, although opposer's current sales are not insubstantial and it currently has a high sales volume on eBay, other than the first year in 1994 when it was not online, the testimony does not establish the level of annual sales leading up to December 18, 2001. Nor is there evidence of an extensive advertising campaign for its services under the term GAMERS. Further, although GAMERS has had an online presence since 1998, there is nothing in the record to show the extent to which potential purchasers have been exposed to it (e.g., the number of visitors to the website, the volume of sales) prior to December 18, 2001.

However, even if the record supports opposer's assertion of service mark rights in GAMERS, due to the highly descriptive nature of the term, we accord it very

little scope of protection in the field of retail sales of computer and video games. In view thereof, we find that the differences in sound, appearance, connotation and commercial impression between GAMERS and  are sufficient to distinguish the marks, even where, as here, the services and channels of trade are identical.

Inasmuch as opposer has not established prior service mark rights in the terms GOGAMERS.COM and GAMERS, and opposer's mark GAMERS is not confusingly similar to applicant's GOGAMER.COM logo mark, the notice of opposition must be dismissed.

Decision: The opposition is dismissed.