

ESTTA Tracking number: **ESTTA747556**

Filing date: **05/19/2016**

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

Proceeding	91204259
Party	Defendant VALHALLA GAME STUDIOS CO. LTD.
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Date	05/19/2016
Attachments	NoticeofAppeal.pdf(2144585 bytes)

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

In Re: Serial Nos. 77/948,333 and 77/948,895

Applicant's Marks: VALHALLA GAME STUDIOS,
VALHALLA GAME STUDIOS and Design

VALHALLA MOTION PICTURES, INC.,

Opposer,

v.

Opposition No. 91204259

VALHALLA GAME STUDIOS CO. LTD.,

Applicant.

NOTICE OF APPEAL TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

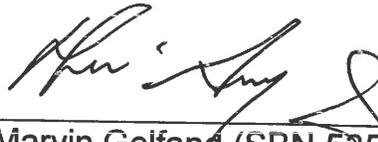
Valhalla Game Studios Co. Ltd. ("Applicant") hereby serves notice under 15 U.S.C. 1071(a) of its appeal to the Court of Appeals for the Federal Circuit from the decision of the Trademark Trial and Appeal Board dated March 24, 2016, in the above proceeding. A copy of the decision being appealed is attached.

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Respectfully submitted,

Dated: May 19, 2016



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Studios Co. Ltd.

CERTIFICATE OF MAILING

I hereby certify that this **NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT** is being deposited with the United States Postal Service on May 19, 2016, as "Priority Mail Express Post Office to Addressee" service under 37 CFR 1.10, postage prepaid, in an envelope addressed to the following:

Office of the General Counsel
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450


Denise Moreno

Express Mail Label Number

May 19, 2016
Date of Deposit

CERTIFICATE OF SERVICE

I hereby further certify that on May 19, 2016, a true and complete copy of the foregoing **NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT** has been served on Opposer by mailing said copy on May 19, 2016, via First Class Mail, postage prepaid to:

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Dated: May 19, 2016


Denise Moreno

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Hearing: November 13, 2015

Mailed:
March 24, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board
—

Valhalla Motion Pictures, Inc.
v.
Valhalla Game Studios Co. Ltd.

—
Opposition No. 91204259 (parent)
—

Valhalla Game Studios Co. Ltd.
v.
Valhalla Motion Pictures, Inc.

—
Opposition No. 91206662 (child)
—

Michael K. Grace and Pamela D. Deitchle of Grace + Grace LLP
for Valhalla Motion Pictures, Inc.

Marvin Gelfand of Weintraub Tobin Chediak Coleman Grodin Law Corporation
for Valhalla Game Studios Co. Ltd.

—
Before Richey, Deputy Chief Administrative Trademark Judge, Ritchie, and
Gorowitz, Administrative Trademark Judges.

Opinion by Gorowitz, Administrative Trademark Judge:

On March 12, 2012, Valhalla Motion Pictures, Inc. (“VMP”) opposed Valhalla
Game Studios Co. Ltd.’s (“VGS”) applications for the marks VALHALLA GAME



STUDIOS, in standard characters,¹ and (VALHALLA GAME STUDIOS & design)² for:

Computer game programs; computer game software; computer software, namely, game engine software for video game development and operation; video game software, in International Class 9;

Printed materials, namely, novels and series of fiction books and short stories featuring scenes and characters based on video games; series of computer game hint books, in International Class 16;

Positionable toy figures; toy action figures, in International Class 28; and

Design and development of computer game software and virtual reality software, in International Class 42.

VMP filed a single opposition against both of VGS' applications and alleged likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) on the basis of its prior use of the mark VALHALLA MOTION PICTURES & design and use of the marks VALHALLA TELEVISION & design and VALHALLA

¹ Application Serial No. 77948333 was filed on March 2, 2010, based on VGS' allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

² Application Serial No. 77948895 was filed on March 2, 2010, based on VGS' allegation of a *bona fide* intention to use the mark in commerce under Section 1(b) of the Trademark Act.

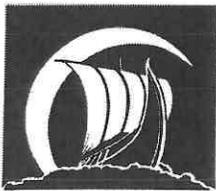
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ENTERTAINMENT & design. At the time that the opposition was filed, VMP owned



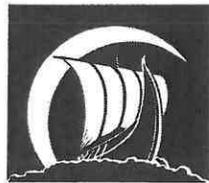
VALHALLA
MOTION PICTURES

three pending applications for the marks (“VALHALLA MOTION PICTURES & design”) for motion picture film production,³



VALHALLA
TELEVISION

(“VALHALLA TELEVISION & design”) for television show



VALHALLA
ENTERTAINMENT

production,⁴ and (“VAHALLA ENTERTAINMENT & design”) for motion picture film production and television show production; writing and editing scripts, teleplays and screenplays for others.⁵ All three applications were filed

³ Application Serial No. 85310106 was filed on May 2, 2011 and based on first use anywhere and first used in commerce as early as July 25, 1997.

⁴ Application Serial No. 85310085 was filed on May 2, 2011 and based VMP’s bona fide intent to use the mark in commerce, after which an allegation of use was filed asserting September 4, 2012 as the date of first use anywhere and first use in commerce.

⁵ Application Serial No. 85310089 was filed on May 2, 2011 based on first use and first use in commerce on October 31, 2010 for the services in International Class 41 and on a bona fide intent to use the mark in connection with the services in International Class 42.

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on May 2, 2011. VGS filed answers denying all salient allegations in the notices of opposition.

VMP's applications for the marks VALHALLA MOTION PICTURES & design⁶ and VALHALLA TELEVISION & design⁷ matured into registrations after VMP filed the opposition. Although not specifically pleaded, both of the underlying applications were listed on the ESTTA cover sheet and were treated by both parties as being of record. Accordingly, we deem the issue of ownership of the applications to have been tried by implied consent. Further, the registrations, which were introduced with a notice of reliance, are considered of record because they issued prior to VMP's testimony period. *See Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1563 n.6 (TTAB 2011).

VMP's application for the mark VALHALLA ENTERTAINMENT & design published for opposition on April 24, 2012. VGS opposed the application on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) claiming priority based on VGS' intent-to-use applications for the marks VALHALLA GAME STUDIOS in standard characters and VALHALLA GAME STUDIOS & design, which were filed on March 2, 2010.

VMP admitted most of the allegations in the notice, but denied that there was no confusion between VGS's marks and its marks, and that VGS was damaged by

⁶ Registration No 4212394 issued on September 25, 2012.

⁷ Registration No 4238523 issued on November 6, 2012.

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VMP's registration of the mark VALHALLA ENTERTAINMENT & design. VMP also asserted as affirmative defenses, the failure to state a claim and the VGS's lack of priority.

The parties filed a stipulated motion to consolidate the opposition proceedings, which was granted on December 17, 2012.

The matter was fully briefed and a hearing was held on November 13, 2015.

The Record.

The record includes the pleadings, and by operation of Trademark Rule 2.122(b), 37 CFR § 2.122(b), the application files of all of the opposed applications. In addition, the parties introduced the following evidence:

A. VMP's evidence.

1. Copies of VMP's registrations from the PTO database:

a. Registration No. 4212384 for the mark



VALHALLA
MOTION PICTURES for "motion picture
film production"

b. Registration No. 4238523 for the mark



VALHALLA
TELEVISION for television show
production.

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- VMP's First Notice of Reliance - 22 TTABVUE
- 2. Online magazine articles - VMP's Second Notice of Reliance - 22 TTABVUE.
- 3. Testimony of Ben Roberts, Vice President of Development for Alcon Entertainment (Roberts Test.) – 39 TTABVUE.
- 4. Testimony of Phillip Kobylanski, Creative Executive of Valhalla Entertainment (Kobylanski Test.) – 40 TTABVUE.
- 5. Testimony of Julie Thomson, Chief Financial Officer of Valhalla Entertainment (Thomson Test.) – 41 TTABVUE.
- 6. Testimony of Gale Ann Hurd (Hurd Test.) – 42 TTABVUE.
- 7. Webpages from VMP's website and third party websites – VMP's Third Notice of Reliance - 43 TTABVUE.
- 8. Articles from online publications – VMP's Fourth Notice of Reliance - 44 TTABVUE.
- 9. Articles from online publications– VMP's Fifth Notice of Reliance - 45 TTABVUE.
- 10. Article from MTV news online – VMP's Sixth Notice of Reliance - 46 TTABVUE.
- 11. Testimony of Phillip Kobylanski, Creative Executive of Valhalla Entertainment (Kobylanski Test. 2) – 50 TTABVUE.

B. VGS' evidence.

- 1. Testimony on Written Questions of Satoshi Kanematsu, Chief Executive Officer of Valhalla Game Studios (Kanematsu Test.) – 27 TTABVUE.
- 2. Testimony on Written Questions of Mitsuru Tsutsumi, – Officer of the International Division of Valhalla Game Studios (Tsutsumi Test.) – 27 TTABVUE
- 3. Various webpages - VGS' First Notice of Reliance– 31 TTABVUE.

4. Third-party registrations – VGS’ Second Notice of Reliance - 32 TTABVUE.
5. Third-party registrations for marks consisting of or containing the word VALHALLA - VGS’ Third Notice of Reliance – 33 TTABVUE.
6. Third-party registrations for marks consisting of or containing Viking ship designs - VGS’ Fourth Notice of Reliance – 34 TTABVUE.
7. VMP’s prior applications and registrations - VGS’ Fifth Notice of Reliance – 35 TTABVUE.
8. Third party registrations reflecting ownership by individual entities of services of both VGS and VMP - VGS’ Sixth Notice of Reliance – 36 TTABVUE.
9. Portions of the discovery depositions of: Gale Ann Hurd (Hurd Dep.), Kristopher Henigman (Henigman Dep.), Julie Thomson (Thomson Dep), and Ben Roberts (Roberts Dep.) – VGS’ Seventh Notice of Reliance 37 TTABVUE.
10. Online magazine articles and webpages – VGS’ Eighth Notice of Reliance - 38 TTABVUE.
11. Testimony of James B. Huntley (Huntley Test.) – 47 TTABVUE.
12. Webpages and video regarding Devil’s Third video game – VGS’ Ninth Notice of Reliance - 48 TTABVUE.
13. Videos from Youtube - VGS’ Tenth Notice of Reliance – 49 TTABVUE.

Evidentiary Objection.

VGS attached the declaration of Denise Moreno, a paralegal at VGS’ attorney’s office, as evidence with its reply brief in the child case. VMP objected to this evidence as being untimely. Evidentiary Objections to Reply Brief in Child Case. 58 TTABVUE

2. “Exhibits and other evidentiary materials attached to a party’s brief on the case

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can be given no consideration unless they were properly made of record during the time for taking testimony.” TBMP § 704.05 (b) (2015).

VGS argues that it was not submitting new evidence but instead was trying to clarify “the false statement in VMP’s briefs regarding its purported uses of its mark.” Response to VMP’s Evidentiary Objections to Reply Brief, 59 TTABVUE 2. VGS asserted that while VMP claimed that its first use of the VALHALLA ENTERTAINMENT & design mark was in connection with *The Wronged Man*, a television movie; VSP’s evidence shows that the mark actually used in connection with *The Wronged Man* was VALHALLA MOTION PICTURES. *Id.* at 2-3. VGS argues that it was

unaware that VMP would claim its use in *The Wronged Man* as first use in commerce of the mark VALHALLA ENTERTAINMENT. Though cited in VMP’s Statement of Use, testimony of VMP’s representatives presented conflicting testimony as to whether it was the VALHALLA MOTION PICTURES mark and not the VALHALLA ENTERTAINMENT mark, that was used in *The Wronged Man*. VGS assumed that VMP would correct this misrepresentation for the record, but this was not done, and VGS introduced this evidence solely for impeachment purposes.

Id. at 3. This argument is not persuasive. All of VMP’s evidence was introduced during its testimony periods. Therefore, VGS could have introduced the rebuttal or impeaching evidence during its testimony period. We give the declaration no consideration.

Standing.

VMP has properly made its registrations for the marks VALHALLA MOTION PICTURES and VALHALLA TELEVISION of record by notice of reliance with

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status and title copies from the USPTO database establishing that its registrations are subsisting and owned by VMP. Accordingly, VMP has established its standing in the parent action. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

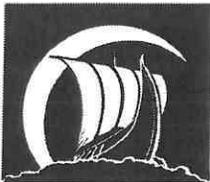
Both the opposition filed against VGS and VGS' allegations of prior rights establish that it has a personal stake in the outcome of the child action. Based thereon, we find that VGS has established its standing.

Parent Action.

We start our discussion with the parent case, the outcome of which affects how we analyze priority in the child case.

Priority.

VMP is the owner of pleaded Registration Nos. 4212384 for the mark



VALHALLA
MOTION PICTURES

for motion picture film production and 4238523 for the mark



VALHALLA
TELEVISION

for television show production. Opposer's ownership of these pleaded registrations removes priority as an issue with respect to motion picture film

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production and television show production. *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1169 (TTAB 2011), citing *King Candy, Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 82 USPQ 108 (CCPA 1974).

Likelihood of confusion.

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See also, In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). While we consider each factor for which there is evidence, the Board may focus its analysis on dispositive factors, such as similarity of the marks and relatedness of the goods and services. *Han Beauty Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001), *See also In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997).

1. Similarity or dissimilarity of marks.

We start our analysis with the first *du Pont* factor, the similarity of the marks, looking first at the similarity between VGS' mark VALHALLA GAME STUDIOS in standard characters and VMG's marks VALHALLA MOTION PICTURES & design, VALHALLA TELEVISION & design, and VALHALLA ENTERTAINMENT & design.

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005). . "The proper test is not a side-by-side comparison of the marks, but

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instead ‘whether the marks are sufficiently similar in terms of their commercial impression’ such that persons who encounter the marks would be likely to assume a connection between the parties.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012) (citation omitted).

While “the similarity or dissimilarity of the marks is determined based on the marks in their entireties, [in this case VGS’ mark VALHALLA GAME STUDIOS in standard characters], ... there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties.” *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985).

Further, in cases such as this where the mark being compared to VGS’ standard character mark is a composite mark comprising a design and words⁸, the word portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed. *See CBS Inc. v. Morrow*, 708 F.2d. 1579, 128 USPQ 198, 200 (Fed. Cir. 1983).

In the case of a composite mark containing both words and a design, the verbal portion of the mark is the one most likely to indicate the origin of the goods to which it is affixed.

In re Viterra Inc., 671 F3d 1358, 101 USPQ2d 1905 (Fed. Cir. 2012).

Accordingly, we look first at the verbal portions of the marks. The verbal portion of VMP’s marks are: VALHALLA MOTION PICTURES, VALHALLA TELEVISION, and VALHALLA ENTERTAINMENT (“VMP’s Marks”). The mark under

⁸ VMP’s Marks

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consideration, which is owned by VGS is the mark VALHALLA GAME STUDIO in standard characters. In each of these marks, VALHALLA, is the dominant portion, as the other terms in each of the marks (“MOTION PICTURE,” “TELEVISION,” “ENTERTAINMENT,” and “GAME STUDIOS”) are descriptive and disclaimed. This follows the general rule that “it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered,” *Presto Products Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) (Likelihood of confusion found between KIDWIPES and KID STUFF for pre-moistened disposable towelettes). *See also Palm Bay Imports Inc.*, 73 USPQ2d at 1692 (“Veuve” is the most prominent part of the mark VEUVE CLICQUOT because “Veuve” is the first word in the mark and the first word to appear on the label); *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (upon encountering the marks, consumers will first notice the identical lead word).

Reinforcing the dominance of the word VALHALLA is the descriptive nature of the other verbal elements in each of the marks, which are disclaimed: “MOTION PICTURE,” “TELEVISION” “ENTERTAINMENT” and “GAME STUDIOS.”⁹ When we compare the marks in their entirety, and give greater weight to the dominant element, we conclude that the marks are similar in appearance, sound, and meaning. *See Palm Bay Imports*, 73 USPQ2d at 1692 (affirming TTAB’s holding that contemporaneous use of appellant’s mark, VEUVE ROYALE, for sparkling wine, and appellee’s marks, VEUVE CLICQUOT and VEUVE CLICQUOT PONSARDIN, for

⁹ In this case, the literal portion is the entire mark.

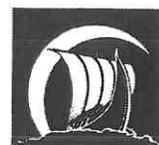
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champagne, is likely to cause confusion, noting that the presence of the “strong distinctive term [VEUVE] as the first word in both parties’ marks renders the marks similar, especially in light of the largely laudatory (and hence non-source identifying) significance of the word ROYALE”); *In re Chatam Int’l Inc.*, 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004) (“Viewed in their entirety with non-dominant features appropriately discounted, the marks [GASPAR’S ALE for beer and ale and JOSE GASPAR GOLD for tequila] become nearly identical.”); and *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (finding that even though applicant’s mark PACKARD TECHNOLOGIES (with “TECHNOLOGIES” disclaimed) does not incorporate every feature of opposer’s HEWLETT PACKARD marks, a similar overall commercial impression is created).

Similarly here, when we appropriately discount the non-dominant features, we find that the mark VALHALLA GAME STUDIO in standard characters is nearly identical to the literal and dominant portion of VMP’s marks VALHALLA MOTION PICTURES & design, VALHALLA TELEVISION & design, and VALHALLA ENTERTAINMENT & design. As such, when considering the similarity between VGS’ mark VALHALLA GAME STUDIO in standard characters and VMP’s marks, the first *du Pont* factor strongly supports a finding of likelihood of confusion.



We look next at VGS’ composite mark,  , noting that the design element does not distinguish the marks. The design element in VGS’s composite mark is a



Viking ship. VMP's marks also contain the depiction of a Viking ship:

VMP argues that “the overall commercial impressions [of its marks and VGS’ mark] are the same: an image of a Viking Ship cresting a wave at sea that is above text containing the key word ‘Valhalla.’” VMP’s Brief in parent case, 51 TTABVUE 16. VGS counters by asserting that “the analysis ignores the visual dissimilarities and the commercial impressions of the marks ... The only real similarity between the marks is the ‘Valhalla’ name and a ship, and both the names and ships differ in style.” VGS’ Brief in parent case, 53 TTABVUE 18. We find that the similarities outweigh any differences and therefore, marks are similar.

While there are, to be sure, specific differences in the two designs, it is well established that the test to be applied in determining likelihood of confusion is not whether the marks are distinguishable upon side-by-side comparison but rather whether they so resemble one another as to be likely to cause confusion, and this necessarily requires us to consider both the fallibility of memory over a period of time, and also the fact that the average purchaser retains a general rather than a specific impression of the many trademarks he encounters.

In re Mucky Duck Mustard Co., 6 USPQ2d 1467, 1468 (TTAB 1988). *See: Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975), and cases cited therein. Accordingly, when considering the similarity between VGS’ mark VALHALLA GAME STUDIO & design and VMP’s Marks, the first *du Pont* factor strongly supports a finding of likelihood of confusion.

2. Strength of the marks.

VGS asserts that “because VMP’s mark is not a strong mark known to consumers, it does not deserve any greater protection than any other registered mark.” This argument is not supported by the evidence. VMP has established use of its marks in connection with motion pictures,¹⁰ comic books,¹¹ and television shows,¹² as well as appearing on VMP’s website, Facebook page, and Twitter feeds.¹³ Gross ticket sales in the United States of Valhalla-branded motion pictures have been over five-hundred-million dollars (\$500,000,000.00).¹⁴ Thompson Test., 41 TTABVUE 18. Moreover, the dominant portion of VMP’s marks, VALHALLA, has no significance with respect to VMP’s transmedia¹⁵ entertainment goods and services, and as such is

¹⁰ The mark appeared in the title sequence of film, *Armageddon*. Hurd Test. 42 TTABVUE 15.

¹¹ *Id.* at 22 -23 and Exhibit 60 thereto (cover of comic book, *The Scourge*).

¹² The mark appears in each episode of the television series, *The Walking Dead*. *Id.* at 41-42.

¹³ Hurd Test. 42 TTABVUE 15.

¹⁴ While clearly establishing use, VMP’s evidence is not sufficient to establish that its marks are well-known.

¹⁵ “Transmedia” was defined in an article about the December, 2012 National Association of Broadcasters Show, by moderator, Henry Jenkins, Professor of Cinema and Media Studies at the University of Southern California, as: “Transmedia Storytelling represents a process by which narrative information is systematically dispersed across multiple media channels for the purposes of creating a unified and coordinated entertainment experience. Ideally each medium makes its own unique contribution to the unfolding story.” Transmedia Across Disciplines at National Association of Broadcasters | Wired Magazine, <http://www.transmedia-producer.org/transmedia-across-at-national-association-of-broadcasters-wired-magazine/>, VMP’s Second Notice of Reliance, 22 TTABVUE 16-17.

Gale Hurd’s testimony comports with this definition. She testified that “my name and subsequently Valhalla was [sic] so well identified with quality entertainment with a certain demographic that it made a great deal of sense to transition the storytelling into the

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an arbitrary mark. VGS further asserts that VMP's marks are not "known to consumers" because they "appear[] for a mere couple seconds [sic] in motion pictures and television shows, and [are] never the primary focus of the articles ... [and] [t]here is no potential for a likelihood of confusion because VMP's mark[s] [are] not even visible to consumers." VGS' Brief in the parent case, 52 TTABVUE 13 - 14. In addition to the evidence introduced by VMP, evidence introduced by VGS contradicts these assertions. Exhibits 1 – 3 of VGS' Tenth Notice of Reliance (49 TTABVUE), which are identified by VGS as Internet webpages and videos, clearly depict VMP's mark.

Further, and perhaps most important, VMP is not requesting any greater protection than other registrants. The *prima facie* rights that VMP acquired in both of its registrations are set forth in Section 7(b) of the Trademark Act:

A certificate of registration on the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Section 7(b) of the Trademark Act, 15 U.S.C. § 1057(b). A mark that resembles a *registered mark* so that it is likely, when used in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive, is refused

transmedia universe and extend it into comic books, video games, and Web series ..." Hurd Test., 42 TTABVUE 19.

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registration. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) (emphasis added). These are the rights owned by VMP, which are asserted in this opposition.

VGS also asserts that “there are other similarly registered marks incorporating the word ‘Valhalla’ for entertainment services besides VGS, weighing against the strength of VMP’s mark.” VGS’ Brief in parent case, 53 TTABVUE 15. However, VGS only refers to one registration for the mark V. Valhalla Knights for a video game company. *Id.* A single registration for a mark containing the word VALHALLA is not sufficient to establish that VMP’s arbitrary mark is weak. VGS also refers to other registrations for marks “incorporating the term ‘Valhalla’ ... spanning a wide range of goods and services, including:

clothing, gambling machines, cigars, cables, Danish ham, fitness facilities, alcohol, a gun firing range, art gallery, spa services, business consultation services, and real estate brokerage services.

Id., and VGS’ Third Notice of Reliance (33 TTABVUE). There is no evidence that the goods and services in these registrations are in the transmedia entertainment industry, as are both VMP’s services and VGS’ goods and services. *Cf. Juice Generation, Inc. v. GS Enters. LLC*, 794 F3d 1334, 115 USPQ2d 1671, 1674 (Fed. Cir. 2015). As such, these registrations do not affect the strength of VMP’s marks.

VGS has also introduced fifty-four registrations for marks including design elements identified as “Viking ships.” 54 TTABVUE. VGS argues that these registrations span

a wide variety of goods and services, including clothing, entertainment services, restaurants, hotels, cruise ships, travel services, machinery, business networking, special event planning, vodka, education, spices, capacitors,

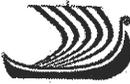
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lumber, wines, kitchen cabinetry, computer software, magnets, jewelry pins, books, stickers, glassware, toys and sporting goods, automobiles, health spas and business marketing consulting.

VGS Brief on parent case. 53 TTABVUE 15. What VGS fails to mention is that twenty-five of the registrations are owned by Viking River Cruises¹⁶, seventeen of the registrations are owned by fifteen different entities¹⁷ and the final eight registrations have been cancelled. None of the registrations include the word “Valhalla.” Moreover, the services identified by VGS as “entertainment services” are those offered by Viking River Cruises, which are generally organized for entertainment while on a cruise.

These are identified as:

Arranging, organizing and hosting social entertainment events; entertainment and education services in the nature of live dance and musical performances; entertainment information; entertainment services, namely, organizing and conducting parties, wine and food tastings, contests, stage shows, nightclub shows, variety and comedy shows, and theatrical productions and musicals; entertainment

¹⁶ Two of Viking River Cruises are for the design mark . The other twenty-three include the identical design and verbal portions containing the word VIKING.

¹⁷ Examples of the live registrations are: Reg. No. 4349688 - , Reg. Nos. 1140681

and 4161108 -



, Reg. No 4363690 -



, and Reg. No. 3954434 -



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services, namely, casino gaming; educational services, namely, conducting cooking classes, and lectures, and seminars in the fields of music, theatre, and film; video arcade services; libraries; in-cabin interactive television programming; health club services, namely, providing instruction, classes, and equipment in the field of physical exercise; organizing and hosting cultural and arts events; organization of exhibitions for cultural or educational purposes.

Registration No. 4354337.

As with the third party Valhalla marks introduced by VMP, there is no evidence that the goods and services in the registrations for marks consisting of or containing depictions of Viking boats are in the transmedia entertainment industry. *Cf. Juice Generation*, 115 USPQ2d at 1674. Moreover, the commercial impressions of these marks as viewed in their entireties are different from both VMP and VGS' marks. As such, these registrations do not affect the strength of VMP's marks.

Accordingly, the sixth *du Pont* factor favors a finding of likelihood of confusion.

3. Relationship between the goods and services.

Next, we consider the similarity or dissimilarity of the parties' goods and services. It is well established that in a proceeding such as this, the similarity of the goods and services must be determined on the basis of the goods and services as identified in the applications and registrations at issue. *See Canadian Imperial Bank of Commerce v. Wells Fargo Bank, NA*, 811 F.2d 1490, 1 USPQ2d 1813, 1814 (Fed. Cir. 1987). *See also Stone Lion Capital Partners, LP v. Lion Capital LLP*, 76 F.3d 1317, 110 USPQ2d 1157, 1161 (Fed. Cir. 2014); *Hewlett-Packard Co.*, 62 USPQ2d at 1004; *Octocom Sys., Inc. v. Houston Computers Servs. Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990).

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VGS' goods and services are identified as:

Computer game programs; computer game software; computer software, namely, game engine software for video game development and operation; video game software;

Printed materials, namely, novels and series of fiction books and short stories featuring scenes and characters based on video games; series of computer game hint books;

Positionable toy figures; toy action figures;

Design and development of computer game software and virtual reality software.

The services in VMP's registrations are identified as: "motion picture film production" (VALHALLA MOTION PICTURES & design), and "television production" (VALHALLA TELEVISION & design). The services in VMP's application for the mark VALHALLA ENTERTAINMENT & design are identified as: "motion picture film production and television show production; writing and editing scripts, teleplays and screenplays for others."

Further, when analyzing the similarity of the goods, it is not necessary that the products of the parties be similar or even competitive to support a finding of likelihood of confusion. Instead, likelihood of confusion can be found "if the respective products [and/or services] are related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that they emanate from the same source." *Coach Servs.*, 101 USPQ2d at 1722 .

Our concern is not the natural expansion of VMP's services into video games, but rather, whether the goods and services, as identified are related in some manner and/or if the circumstances surrounding their marketing are such that they could

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give rise to the mistaken belief that they emanate from the same source. We find that they are.

VMP's principal, Gale Ann Hurd, testified that video games are produced which are based on films and on the comic books from which the films were adapted. Hurd Test. 42 TTABVUE 25. For example, Valhalla produced the film *The Punisher* and its logo appeared in the title sequence from the film. "There was a video game created based on the film and the comic book from which it was adapted." *Id.* at 25. "Generally, in order for the game to be released in support of a film, they try to time the video game so that it releases either in concert with the release of the film or with the release of the DVD or at Christmas." *Id.* at 27. This testimony establishes a relationship between comic books, motion picture production and video game production, including video game development, the result of which is a likelihood that consumers will believe that the comic books, motion pictures and video games emanate from the same or a related source.

Applicant, VGS reinforced this relationship by introducing several registrations evidencing ownership of similar marks for goods and services either closely related or identical to both VMP's services and VGS' goods and services.¹⁸ Representative examples of the documents introduced by way of the notice of reliance are¹⁹:

1. Ten Registrations owned by Lucasfilm Ltd. – including:
 - Reg. No. 3759341 for the mark LUCASFILM ANIMATION & design for "pre-recorded CD-ROMs, compact discs, and DVDs featuring pre-

¹⁸ VGS' Sixth Notice of Reliance, 36 TTABVUE

¹⁹ Not all of the goods and/or services included in the registrations are listed in the examples.

recorded films, animation, games, music, computer game software and video game software; downloadable interactive entertainment software for playing computer games and video games; video game software and manuals sold as a unit; interactive video game programs; interactive computer game programs featuring science fiction, action, adventure, animation, drama, or music; interactive multimedia software; interactive multimedia game software and entertainment services in the field of film and television, namely, the creation, production of films, videos, animation, and computer generated images; animation production services.”

2. Seven registrations owned by Take-Two Interactive Software, Inc. – including:
 - Reg. No. 3905775 for the mark ROCKSTAR FILMS for “computer game software and programs; and entertainment services in the nature of a live-action and/or animated television program series”; and
 - Reg. No. 4037654 for the mark ROCKSTAR GAMES for “animated motion picture films featuring entertainment, namely, action, adventure, dramatic, comedic, children's and documentary themes; computer and video game software, and related programs videos, films and other multimedia materials, all featuring entertainment, other pre-recorded digital and electronic media in the field of live action programs, motion pictures, or animation; and entertainment services, namely, providing a website featuring use of non-downloadable computer and video games, audio-visual content, music, films, videos, television programs, animated series, and other multimedia materials, all non-downloadable and all in the field of computer games and video games; providing information, news and commentary in the field of computer games”

3. Eight registrations owned by Disney Enterprises, Inc. – including:
 - Reg. No. 3917336 for the mark WALT DISNEY for “audio and visual recordings, including recordings of motion picture films and television shows, featuring live action and animated entertainment for children; video game cartridges, discs and software featuring music, stories, games, and activities for children; computer game discs and software featuring music, stories, games, and activities for children; and comic books” ;
 - Reg. No. 4094327 for the mark DISNEY JR. for “production, presentation, distribution of television programs; production, presentation, distribution of sound and video recordings; entertainment information; production of entertainment shows and interactive programs in the field of children's entertainment for distribution via television, cable, satellite, audio and video media, and electronic means; production and provision of entertainment, current event news and information via communication and global computer networks; on-line entertainment services, namely, providing on-line computer games.”
4. Two registrations owned by Universal City Studios LLC:
 - Reg. No. 4601838 for the mark UNIVERSAL & design for: “production and distribution of television programs and motion pictures; television programming services; provision of on-demand video and television programs and motion pictures; provision of non-downloadable video, television programs and motion pictures; production and distribution of interactive, video and mobile games; entertainment services, namely, providing online games, web-based games, interactive games, video games and mobile games; amusement park services”; and
 - Reg. No. 4601839 for the mark UNIVERSAL & design for “production and distribution of television programs and motion pictures; television programming services; provision of on-

demand video and television programs and motion pictures; provision of non-downloadable video, television programs and motion pictures; production and distribution of interactive, video and mobile games; entertainment services, namely, providing online games, web-based games, interactive games, video games and mobile games; amusement park services.”

Cf. In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1786 (TTAB 1993) (third-party registrations may serve to suggest that the listed goods and/or services are of a type which may emanate from a single source.). Thus, we find that VGS’ video game software and the design and development thereof are closely related to VMP’s motion picture and television production services.

VMP has also established use of its marks in connection with comic books. For example, “VMP created the comic book *The Scourge* in partnership with Aspen Comics and VMP’s brand is on the cover of the comic book.” Hurd Test. 42 TTABVue 22-23. VGS’ applications also cover “printed materials, namely, novels and series of fiction books and short stories featuring scenes and characters based on video games; series of computer game hint books.” As discussed above, video games may be based on comic books. VGS’ fiction books and short stories featuring scenes and characters based on video games may involve the same or similar scenes and characters that are in comic books and are therefore related to comic books.

Accordingly, VGS’ fiction book and short stories are related to both VMP’s comic books and motion pictures created therefrom. VGS’ series of computer game hint books are also deemed related since likelihood of confusion must be found as to the entire class if there is likely to be confusion with respect to any item in the

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identification of goods for that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

While neither of the parties discussed the relationship between VMP's goods and services and VGS' positionable toy figures and toy action figures, they are related. Among the registrations introduced by VGS in its Sixth Notice of Reliance, 36 TTABVUE, are registrations owned by Disney Enterprises for the marks WALT DISNEY. Registration No. 3917336 covers goods including "audio and visual recordings, including recordings of motion picture films and television shows, featuring live action and animated entertainment for children; video game cartridges, discs and software featuring music, stories, games, and activities for children; computer game discs and software featuring music, stories, games, and activities for children; and comic books," and Registration No. 3930031 includes "toy action figures." These registrations are evidence that parties producing and selling both motion picture films/television shows and video games also sell toy action figures under the same mark.

Accordingly, we find that VGS' goods and services are related to VMP's goods and services and thus, the second *du Pont* factor favors a finding of likelihood of confusion.

4. Channels of Trade and Class of Purchaser.

There is an overlap in the channels of trade in which Applicant's goods and services and Registrant's goods and services travel. Applicant argues that the channels of trade are different in that "while VMP's products are sold at mainstream stores that sell DVDs, VGS's [sic] products are marketed to its target market, hard core gamers at video game specialty stores." VGS' asserted restrictions to its trade

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channels and customers are not reflected in its identification of goods or recitation of services. Absent any explicit restriction in the application or registration, “the goods [and services] are presumed to travel in all normal channels and to all prospective purchasers for the relevant goods.” *Coach Servs.*, 101 USPQ2d at 722. It is common knowledge that in addition to “video game specialty stores,” video games are sold in numerous venues, including electronics stores, e.g. Best Buy, department stores, e.g. Target, big box stores, e.g. Costco and on-line. Motion pictures are shown in movie theaters and on television. Copies of the motion pictures are sold in DVD format in the same venues that sell video games; electronics stores, e.g. Best Buy, department stores, e.g. Target, big box stores, e.g. Costco and on-line. Further video games and DVDs may be sold in the same departments in these stores. Therefore, the channels of trade may be the same.

VGS also asserts that the cost of its videos is high and thus the “purchasers are likely to be more discriminating and sophisticated.” VGS Brief in parent case, 53 TTABVUE 24. The identification of VGS’ goods does not restrict the subject matter of VGS’ video games, nor does it restrict the purchasers of such goods. As such, the goods as identified include simple and inexpensive video games. Similarly, VMP’s motion pictures and television programs may include inexpensive motion pictures and television programs.

Since neither party’s identification of goods or services is restricted, we must consider the sophistication of all potential consumers of television and motion pictures, including DVDs embodying such works and of all potential customers of

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video games. *See In re Bercut-Vandervoort & Co.*, 229 USPQ 763, 764 (TTAB 1986) (evidence that relevant goods are expensive wines sold to discriminating purchasers must be disregarded given the absence of any such restrictions in the application or registration). We consider the purchasers of both VMP and VGS' goods and services to exhibit the same level of sophistication. Moreover, the outcome is not changed even if we considered the purchasers of VGS' goods to be sophisticated since the fact that "the relevant class of purchasers may exercise care does not necessarily impose on that class the responsibility of distinguishing between similar marks for similar goods and services. Human memories even of discriminating purchasers are not infallible." *In re Research and Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986) (internal citation omitted).

Accordingly, the third and fourth *du Pont* factors favor a finding of likelihood of confusion.

5. Actual Confusion.

VGS' argument that there have been no known instances of actual confusion is not persuasive. The lack of evidence of actual confusion carries little weight. *J.C. Hall Co. v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435, 438 (CCPA 1965). Insofar as the absence of actual confusion is concerned, there is nothing in the record regarding the extent of use, if any, of VGS' marks. "Thus, we are unable to determine if there has been any meaningful opportunity for confusion to occur in the marketplace. In any event, the test is likelihood of confusion, not actual confusion,

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and, as often stated, it is unnecessary to show actual confusion in establishing likelihood of confusion.” *In re Big Pig Inc.*, 81 USPQ2d 1436, 1439-40 (TTAB 2006). *See also Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990). Thus, we find the seventh *du Pont* factor to be neutral.

6. Conclusion

Having considered all the evidence and argument on the relevant *du Pont* factors, whether specifically discussed herein or not, we conclude that the marks are very similar and the goods and services are closely related. Therefore, there is a likelihood of confusion between VMP’s use of the marks VALHALLA MOTION PICTURE & design, VALHALLA TELEVISION & design and VALHALLA ENTERTAINMENT & design for its goods and services and VGS’ use of the marks VALHALLA GAME STUDIOS in standard characters and with design for its goods and services.

Decision: The oppositions in the parent case, on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, are sustained. Applications, Serial No. 77948333 for the mark VALHALLA GAME STUDIOS and Serial No. 77948895 for



the mark  will be abandoned in due course.

Child Action.

As stated above, VGS opposed VMP’s application for the mark VALHALLA ENTERTAINMENT & design on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d) claiming priority based on VGS’ intent-

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to-use applications for the marks VALHALLA GAME STUDIOS in standard characters and VALHALLA GAME STUDIOS & design. Since the parent action is sustained, both of VGS' applications will be abandoned and VGS cannot rely thereon to establish any rights but must instead invoke common law rights.

VGS has pleaded that while there is no confusion between its marks and VMP's marks VALHALLA MOTION PICTURE[S] and VALHALLA TELEVISION, there is confusion with VALHALLA ENTERTAINMENT because "it is clear that Applicant's mark for VALHALLA ENTERTAINMENT is designed to subsume anything in the general entertainment industry of which games, toys and comic books are a part of." Notice of Opposition in Child Action ¶ 6, Opposition No. 91206662, 1 TTABVUE. Our determination of the similarity of the goods and services must be determined on the basis of the goods and services as identified in the applications and registrations at issue. *See Canadian Imperial Bank of Commerce* 1 USPQ2d at 1814 and *Stone Lion Capital Partners*, 110 USPQ2d at 1161. Therefore, the only goods and services at issue in the opposed application are: "motion picture film production and television show production; writing and editing scripts, teleplays and screenplays for other." Further, we have already determined that the mark VALHALLA ENTERTAINMENT & design is similar to VALHALLA GAME STUDIOS (both in standard characters and with design).

Therefore, the only issue to be decided in this opposition is priority. To establish common-law rights in a mark, a party must show that it engaged in services as a "regular and recurring activity associated with the mark." *Giersch v. Scripps*

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Networks Inc., 90 USPQ2d 1020, 1023 (TTAB 2009). Satoshi Kanematsu, VGS' Chief Executive Officer testified that the VGS marks first appeared "as a brand ...on [the] video game," *Devil's Third* at the E3 show in 2010²⁰ where VGS debuted a trailer of the game, which was announced at the show. Kanematsu Test. 27 TTABVUE 29. VGS did not submit any evidence establishing the extent of the use of the VGS marks at the E3 show, e.g. there is no testimony or other evidence regarding the booth in which the video game was debuted (was it VGS' own booth or a third party's booth?), the number of times the trailer was aired at the show and the number of consumers viewing the trailer. Mr. Kanematsu also testified that its mark was used on a trailer for the video game, *Devil's Third* at the E3 show in 2011 and was seen worldwide on YouTube. *Id.* at 29. Again, there is no testimony or other evidence establishing details of such use, most importantly, the number of viewers of the trailer at the show and on YouTube. Moreover, VGS did not establish the time period during which the trailer appeared on YouTube nor did it establish any actual sales of its game in the United States.²¹ Therefore, we do not find regular and recurring use of the mark necessary to establish a priority date by a preponderance of the evidence. *Giersch* , 90 USPQ2d at 1023.

To the contrary, VMP has established use of its VALHALLA ENTERTAINMENT & design mark. Phillip Kobylanski, Creative Executive of Valhalla Entertainment,

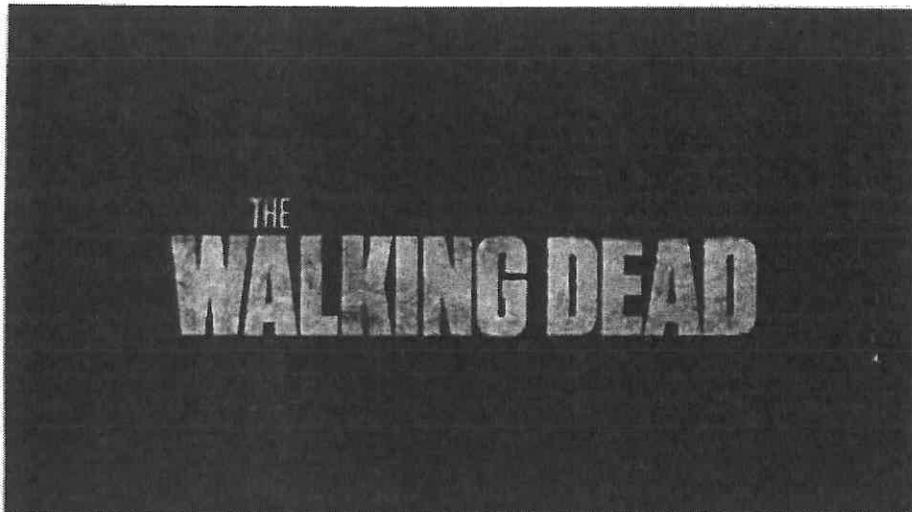
²⁰ The E3 show was held in June 2010. *Id.* at 34.

²¹ Mr. Kanematsu testified that the only "commercially" released products on which its mark appeared were t-shirts, Zippo cases, Valhalla flags, and iPhone cases. *Id.* However, he did not testify about when these uses were made, where these uses were made, the extent of such use and the reason for such use.

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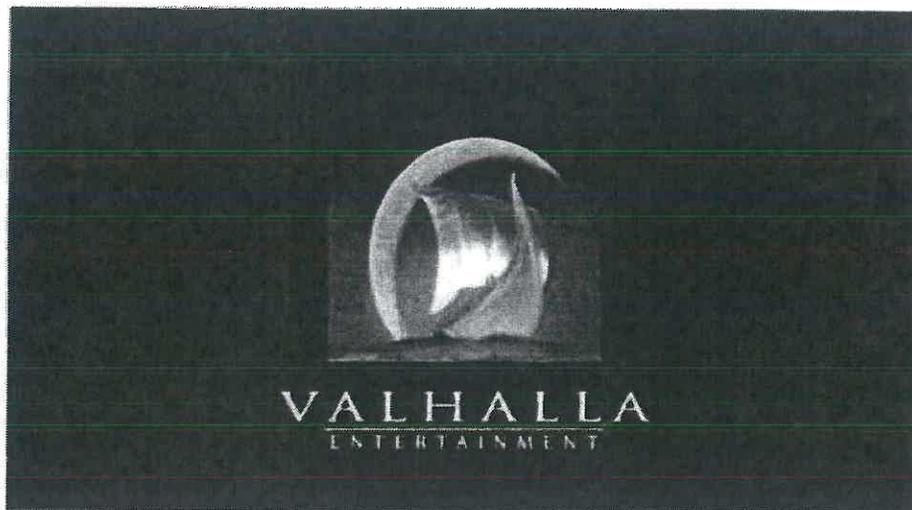
testified that he prepared a list of all of the products that his company or Gale Anne Hurd had worked on as well as the credits listed for each. Kobyolanski Test. 40 TTABVUE 52. The list, which was attached as Exhibit 51, included the following productions on which the Valhalla Entertainment logo appeared in the closing credits: (1) The television movie, *The Wronged Man*, which aired on January 17, 2010 and (2) The television services *The Walking Dead*, which first aired on October 31, 2010. *Id.* at 66. Mr. Kobyolanski introduced Exhibit 59 (set forth below), which consists of screen shots of the logo for *The Walking Dead* and the Valhalla Entertainment logo. *Id.* at 89.

The Walking Dead Season 1 (2010)



0004:55 (Episode I)

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01.0656 (Episode I)

Since VGS cannot establish priority, it cannot succeed in its opposition and therefore, the opposition must be dismissed.

Decision: The opposition in the child case, on the ground of likelihood of confusion under Section 2(d) of the Trademark Act, is dismissed.