

ESTTA Tracking number: **ESTTA462326**

Filing date: **03/16/2012**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Studio Moderna S.A.
Granted to Date of previous extension	03/18/2012
Address	Via Ferruccio Pelli 13 Lugano, CH-6900 SWITZERLAND
Attorney information	Mitchell P. Brook McKenna Long & Aldridge, LLP 600 West Broadway, Suite 2600 San Diego, CA 92101 UNITED STATES mbrook@mckennalong.com

Applicant Information

Application No	85319799	Publication date	09/20/2011
Opposition Filing Date	03/16/2012	Opposition Period Ends	03/18/2012
Applicant	Big Fish Games, Inc. Suite 200 333 Elliott Avenue West Seattle, WA 98119 UNITED STATES		

Goods/Services Affected by Opposition

<p>Class 009. All goods and services in the class are opposed, namely: Electronic game programs; computer game software; downloadable interactive computer, video, and electronic game software; downloadable computer game software and electronic game software for use on electronic and wireless communication devices; downloadable computer game software; computer and electronic game programs; CD Rom and DVD Rom discs featuring entertainment content in the nature of video games, video game hints, video game facts, music and stories; electronic strategy and instructional guides for computer and video games; audio and video recordings in the fields of computer and video games and video instruction and tutorials; downloadable multimedia file containing artwork, text, audio, video, games, and Internet Web links relating to computer and video games</p>
<p>Class 038. All goods and services in the class are opposed, namely: Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of games, online computer games, computer software games, video games and electronic game software, electronic media and entertainment media; Providing on-line chat rooms for social networking</p>
<p>Class 041. All goods and services in the class are opposed, namely: Entertainment services, namely, providing</p>

online interactive, computer, video and electronic games; non-downloadable computer games provided via a global computer network, mobile access computers, handheld game players and mobile telephones; providing a non-downloadable computer game that may be accessed network-wide by network users; providing information in the field of games, interactive games, electronic games, computer games and video games, via the internet; providing temporary use of non-downloadable online interactive games, electronic games, computer games or video games; providing a web site where users can post ratings, reviews, favorites and recommendations in the fields of games, interactive games, electronic games, computer games and video games; computer services, namely, providing online newsletters in the fields of games, online computer games, computer software games, video games and electronic game software via e-mail and the Internet

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3889206	Application Date	06/30/2005
Registration Date	12/14/2010	Foreign Priority Date	12/30/2004
Word Mark	BIGFISH		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 012. First use: Vehicles and apparatus for transport, namely, bicycles, unicycles, tandem bicycles, motorcycles, motorized scooters, all-terrain vehicles (ATV), automobiles, boats, motorized water scooters, personal watercraft, namely small powerboats; accessories for bicycles, namely, bicycle racks for vehicles, motorcycle and bicycle side cars, bicycle accessories, namely infant and child bicycle seats and child carrying trailers for use in transporting children while bicycling, safety pads, water bottle holders, luggage racks and compartments, baskets, saddlebags</p> <p>Class 028. First use: Games and playthings, namely, plush toys, board games, card games, dice games, toy vehicles, toy bicycles, toy cars, toy trucks, basketballs, baseballs, softballs, footballs and soccer balls; indoor cycling bikes, namely, stationary exercise bicycles; fitness and exercise equipment, namely, exercise weights and manually-operated exercise equipment; decorations for Christmas trees</p>		

U.S. Registration No.	3936214	Application Date	01/14/2009
Registration Date	03/29/2011	Foreign Priority Date	NONE
Word Mark	BIGFISH		

Design Mark	
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Description of Mark	NONE
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Goods/Services	<p>Class 035. First use: First Use: 2006/05/00 First Use In Commerce: 2008/09/24 On-line retail store services in the field of cycling, featuring bicycles; providing on-line advertising in the fields of bicycles and cycling; providing on-line consumer information regarding bicycles and cycling gear</p> <p>Class 041. First use: First Use: 2006/05/00 First Use In Commerce: 2008/09/24 Providing on-line information regarding cycling and bicycle racing, for entertainment, recreation or as a sport</p>
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U.S. Application No.	78811667	Application Date	02/09/2006
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Registration Date	NONE	Foreign Priority Date	08/12/2005
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Word Mark	BIGFISH
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Design Mark	
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Description of Mark	The mark consists of a stylized arc, which includes at one end a downward pointing triangular portion, and a dot situated beneath the arc near the that same end. The color red appears in the non-lettering stylized portion of the mark, including the stylized arc, which includes at one end a downward pointing triangular portion, and a dot.
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Goods/Services	<p>Class 012. First use: Vehicles and apparatus for transport, namely bicycles, motorcycles, unicycles, tandem bicycles, motorcycles, motorized scooters, all-terrain vehicles (ATV), automobiles; bicycle accessories, namely, infant and child bicycle seats and child carrying trailers for use in transporting children while bicycling, safety pads, water bottle holders, luggage racks and compartments, baskets, saddlebags</p> <p>Class 016. First use: Paper, cardboard and goods made from these materials; printed matter; bookbinding material; photographs; stationary; adhesives for stationary or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material (except apparatus); plastic materials for packaging; printers' type; printing blocks</p> <p>Class 028. First use: Games and playthings, namely, plush toys, board games, card games, dice</p>
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	games, toy vehicles, toy bicycles, toy cars, toy trucks, basketballs,baseballs, softballs, footballs and soccer balls; gymnastic, sporting articles and fitness equipment, namely, exercise weights and manually-operated exercise equipment; indoor cycling bikes namely, stationary exercise bicycles; decorations for Christmas trees
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Attachments	79020182#TMSN.jpeg (1 page)(bytes) 77649814#TMSN.jpeg (1 page)(bytes) 78811667#TMSN.jpeg (1 page)(bytes) Notice.PDF (12 pages)(159949 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Mitchell P. Brook/
Name	Mitchell P. Brook
Date	03/16/2012

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

In the Matter of Application Serial No. 85/319,799

BIG FISH

International Classes: 9, 38 and 41

Published in the *Official Gazette* of September 20, 2011

Studio Moderna SA,)	
)	
Opposer)	
)	Opposition No.: _____
v.)	
)	
)	
Big Fish Games, Inc.,)	
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Applicant.)	
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_____)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF OPPOSITION

Opposer Studio Moderna SA (“Studio Moderna” or “Opposer”), a Swiss corporation having an address at Via Ferruccio Pelli 13, Lugano, CH-6900, Switzerland, believes that it will be damaged by registration of the mark shown in Serial No. 85/319,799, and hereby opposes the same.

Applicant Big Fish Games, Inc.’s (“Applicant”) application for “BIG FISH” was filed on May 12, 2011. The goods and services identified include:

Electronic game programs; computer game software; downloadable interactive computer, video, and electronic game software; downloadable computer game software

and electronic game software for use on electronic and wireless communication devices; downloadable computer game software; computer and electronic game programs; CD Rom and DVD Rom discs featuring entertainment content in the nature of video games, video game hints, video game facts, music and stories; electronic strategy and instructional guides for computer and video games; audio and video recordings in the fields of computer and video games and video instruction and tutorials; downloadable multimedia file containing artwork, text, audio, video, games, and Internet Web links relating to computer and video games, in International Class 9;

Providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of games, online computer games, computer software games, video games and electronic game software, electronic media and entertainment media; Providing on-line chat rooms for social networking, in International Class 38; and

Entertainment services, namely, providing online interactive, computer, video and electronic games; non-downloadable computer games provided via a global computer network, mobile access computers, handheld game players and mobile telephones; providing a non-downloadable computer game that may be accessed network-wide by network users; providing information in the field of games, interactive games, electronic games, computer games and video games, via the internet; providing temporary use of non-downloadable online interactive games, electronic games, computer games or video games; providing a web site where users can post ratings, reviews, favorites and recommendations in the fields of games, interactive games, electronic games, computer games and video games; computer services, namely, providing online newsletters in the

fields of games, online computer games, computer software games, video games and electronic game software via e-mail and the Internet, in International Class 41.

The application was published for opposition in the Official Gazette on September 20, 2011.

GROUNDS FOR OPPOSITION

1. Opposer Studio Moderna is a developer and retailer of the renowned BIGFISH brand of cycling products, retail sites and associated on-line communities. Opposer has expended considerable resources towards establishing and protecting its valuable marks worldwide, and owns, among others, international trademark registrations covering the following countries: Albania, Belarus, Benelux, Bosnia and Herzegovina, Bulgaria, Croatia, Egypt, European Community, Georgia, Int'l Registration (numerous country designations, some listed here), Japan, Kazakhstan, South Korea, Macedonia, Moldova, Montenegro, Norway, Romania, Russia, Serbia, Singapore, Slovenia, Switzerland, Turkey, Ukraine, Uzbekistan and Vietnam. In the United States, Opposer has trademark priority as early as December 30, 2004. This use has been valid and continuous since the dates of first use and has not been abandoned.

2. Registrations. In the United States, Opposer is the owner of numerous trademark registrations, including among others the following:

a. U.S. Trademark Registration No. 3,889,206 for the mark "BIGFISH" in connection with vehicles and apparatus for transport, namely, bicycles, unicycles, tandem bicycles, motorcycles, motorized scooters, all-terrain vehicles (ATV), automobiles, boats, motorized water scooters, personal watercraft, namely small powerboats; accessories for bicycles, namely, bicycle racks for vehicles, motorcycle and bicycle side cars, bicycle accessories, namely infant and child bicycle seats and child carrying trailers for use in transporting children while bicycling, safety pads, water bottle holders, luggage racks and

compartments, baskets, saddlebags, in International Class 12; and, games and playthings, namely, plush toys, board games, card games, dice games, toy vehicles, toy bicycles, toy cars, toy trucks, basketballs, baseballs, softballs, footballs and soccer balls; indoor cycling bikes, namely, stationary exercise bicycles; fitness and exercise equipment, namely, exercise weights and manually-operated exercise equipment; decorations for Christmas trees, in International Class 28, which was filed June 30, 2005 and has a priority date of December 30, 2004 (copy of registration annexed as Exhibit A).

b. U.S. Registration No. 3,936,214 for the trademark “BigFish” in connection with On-line retail store services in the field of cycling, featuring bicycles; providing on-line advertising in the fields of bicycles and cycling; providing on-line consumer information regarding bicycles and cycling gear in International Class 35; and providing on-line information regarding cycling and bicycle racing, for entertainment, recreation or as a sport, in International Class 41, which was filed January 14, 2009, and recites a date of first use of May 2006 and a date of first use in commerce of September 24, 2008 (copy of registration annexed as Exhibit B);

Each of the above-identified registrations has a filing date that precedes May 12, 2011, the filing date of the Applicant’s application.

In addition, Opposer owns the following pending trademark application, also having a filing date that precedes May 12, 2011, the filing date of the Applicant’s application:

U.S. Trademark Application No. 78/811,667 for the mark “BIGFISH” (and design) in connection with: Vehicles and apparatus for transport, namely bicycles, motorcycles, unicycles, tandem bicycles, motorcycles, motorized scooters, all-terrain vehicles (ATV), automobiles; bicycle accessories, namely, infant and child bicycle seats and child

carrying trailers for use in transporting children while bicycling, safety pads, water bottle holders, luggage racks and compartments, baskets, saddlebags, in International Class 12; paper, cardboard and goods made from these materials; printed matter; bookbinding material; photographs; stationary; adhesives for stationary or household purposes; artists' materials; paint brushes; typewriters and office requisites (except furniture); instructional and teaching material(except apparatus); plastic materials for packaging; printers' type; printing blocks, in International Class 16; and games and playthings, namely, plush toys, board games, card games, dice games, toy vehicles, toy bicycles, toy cars, toy trucks, basketballs, baseballs, softballs, footballs and soccer balls; gymnastic, sporting articles and fitness equipment, namely, exercise weights and manually-operated exercise equipment; indoor cycling bikes namely, stationary exercise bicycles; decorations for Christmas trees in International Class 28.

3. Opposer's use in interstate commerce in connection with its BIGFISH marks is prior to the filing date of the United States Application Serial No. 85/319,799, which was filed on May 12, 2011 as an Intent-to-Use application.

4. Opposer's BIGFISH mark embodies extensive goodwill and consumer recognition built up by Opposer through substantial amounts of time and effort in advertising, promotion, and substantial sales of its products and services.

5. In view of the similar nature of the respective marks and the related nature of the goods and services of the parties, it is respectfully evident that Applicant's mark so resembles Opposer's mark as to be likely to cause confusion, or to cause mistake, or to deceive, or to falsely suggest an association with Opposer.

6. Moreover, other trademark application filings by Applicant indicate that its business plan may lead to further confusion of consumers or dilution or tarnishment of Opposer's BIGFISH trademark by using it in association with a variety of gambling terms, such as BIG FISH ROULETTE, BIG FISH BLACKJACK and BIG FISH CASINO, among others. The intended or unintended result of such a program would be to dilute Opposer's mark or otherwise confuse consumers by making Opposer's mark appear to be one of a single family of "Big Fish" products from a single source.

7. If Applicant is permitted to use and register Opposer's mark for its goods and services, as specified in the application herein opposed, the resulting likelihood of confusion, mistake, deception, dilution, tarnishment and/or false association will cause irreparable damage to the goodwill and consumer recognition that Opposer has built up in the BIGFISH mark. Registration of the BIG FISH mark by Applicant will seriously damage Opposer under Section 2(d) of the Trademark Act.

WHEREFORE, Studio Moderna prays that said Application Serial No. 85/319,799 be rejected, that no registration be issued thereon to Applicant, and that this opposition be sustained in favor of Studio Moderna.

The Commissioner is hereby authorized to charge our Deposit Account No. 50-2298 (McKenna Long & Aldridge LLP) for the Notice of Opposition filing fee (\$900.00) and for any

deficit in fees or to credit any overpayment thereto. Please address all correspondence to Mitchell P. Brook, Esq., c/o McKenna Long & Aldridge LLP, 600 West Broadway, Suite 2600, San Diego, California 92101.

Respectfully submitted,

Date: March 16, 2012

By:



Mitchell P. Brook
MCKENNA LONG & ALDRIDGE LLP
600 West Broadway, Suite 2600
San Diego, California 92101
Telephone: (619) 236-1414

Attorney for Opposers

101830641.1

**IN THE UNITED STATES PATENT AND TRADEMARK
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In the Matter of Application Serial No. 85/319,799

BIG FISH

International Classes: 9, 38 and 41

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OPPOSER EXHIBIT A

United States of America

United States Patent and Trademark Office

BIGFISH

Reg. No. 3,889,206

Registered Dec. 14, 2010

Int. Cls.: 12 and 28

TRADEMARK

PRINCIPAL REGISTER

STUDIO MODERNA SA
VIA FERRUCCIO PELLI 13
CH-6900 LUGANO
SWITZERLAND

FOR: VEHICLES AND APPARATUS FOR TRANSPORT, NAMELY, BICYCLES, UNICYCLES, TANDEM BICYCLES, MOTORCYCLES, MOTORIZED SCOOTERS, ALL-TERRAIN VEHICLES (ATV), AUTOMOBILES, BOATS, MOTORIZED WATER SCOOTERS, PERSONAL WATERCRAFT, NAMELY SMALL POWERBOATS; ACCESSORIES FOR BICYCLES, NAMELY, BICYCLE RACKS FOR VEHICLES, MOTORCYCLE AND BICYCLE SIDE CARS, BICYCLE ACCESSORIES, NAMELY INFANT AND CHILD BICYCLE SEATS AND CHILD CARRYING TRAILERS FOR USE IN TRANSPORTING CHILDREN WHILE BICYCLING, SAFETY PADS, WATER BOTTLE HOLDERS, LUGGAGE RACKS AND COMPARTMENTS, BASKETS, SADDLEBAGS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FOR: GAMES AND PLAYTHINGS, NAMELY, PLUSH TOYS, BOARD GAMES, CARD GAMES, DICE GAMES, TOY VEHICLES, TOY BICYCLES, TOY CARS, TOY TRUCKS, BASKETBALLS, BASEBALLS, SOFTBALLS, FOOTBALLS AND SOCCER BALLS; INDOOR CYCLING BIKES, NAMELY, STATIONARY EXERCISE BICYCLES; FITNESS AND EXERCISE EQUIPMENT, NAMELY, EXERCISE WEIGHTS AND MANUALLY-OPERATED EXERCISE EQUIPMENT; DECORATIONS FOR CHRISTMAS TREES, IN CLASS 28 (U.S. CLS. 22, 23, 38 AND 50).

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

PRIORITY DATE OF 12-30-2004 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION 0874950 DATED 6-30-2005, EXPIRES 6-30-2015.

SER. NO. 79-020,182, FILED 6-30-2005.

MAUREEN DALL, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

**IN THE UNITED STATES PATENT AND TRADEMARK
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In the Matter of Application Serial No. 85/319,799

BIG FISH

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_____)	

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

OPPOSER EXHIBIT B

United States of America

United States Patent and Trademark Office

BigFish

Reg. No. 3,936,214

Registered Mar. 29, 2011

Int. Cls.: 35 and 41

SERVICE MARK

PRINCIPAL REGISTER

STUDIO MODERNA SA (SWITZERLAND CORPORATION)
VIA PRETORIO 22
LUGANO, SWITZERLAND CH-6900

FOR: ON-LINE RETAIL STORE SERVICES IN THE FIELD OF CYCLING, FEATURING BICYCLES; PROVIDING ON-LINE ADVERTISING IN THE FIELDS OF BICYCLES AND CYCLING; PROVIDING ON-LINE CONSUMER INFORMATION REGARDING BICYCLES AND CYCLING GEAR, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 5-0-2006; IN COMMERCE 9-24-2008.

FOR: PROVIDING ON-LINE INFORMATION REGARDING CYCLING AND BICYCLE RACING, FOR ENTERTAINMENT, RECREATION OR AS A SPORT, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 5-0-2006; IN COMMERCE 9-24-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

SER. NO. 77-649,814, FILED 1-14-2009.

WENDY JUN, EXAMINING ATTORNEY



David J. Kybas

Director of the United States Patent and Trademark Office

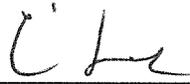
CERTIFICATE OF SERVICE

I hereby certify that I served a true copy of the foregoing NOTICE OF OPPOSITION to the following attorney via First-Class Mail at the postal address set forth below.

Tina M. Bondy, Esq.
Big Fish Games, Inc.
333 Elliot Ave. W. Suite 200
Seattle, WA 98119

Counsel for Applicant

Date: March 16, 2012

Signature: 

Eric L. Lane
MCKENNA LONG &
ALDRIDGE, LLP
600 West Broadway, Suite 2600
San Diego, California 92101