

ESTTA Tracking number: **ESTTA79888**

Filing date: **05/08/2006**

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

Proceeding	91170080
Party	Defendant Stephani, Scott P. Stephani, Scott P. 4593 N. Overland Rd. Oneida, WI 54155
Correspondence Address	STEPHANI, SCOTT P. 4593 N OVERLAND RD ONEIDA, WI 54155-9232
Submission	Motion to Dismiss - Rule 12(b)
Filer's Name	Owen Smigelski
Filer's e-mail	owen@skousenlaw.com
Signature	/Owen Smigelski/
Date	05/08/2006
Attachments	Motion to dismiss.pdf ( 11 pages )(24345 bytes ) Request for Judicial notice.pdf ( 10 pages )(97925 bytes )



NOTICE OF MOTION AND MOTION TO DISMISS FOR FAILURE TO STATE A  
CLAIM UPON WHICH RELIEF CAN BE GRANTED

PLEASE TAKE NOTICE THAT pursuant to Federal Rules of Civil Procedure 12(b)(6) and T.B.M.P 503, Applicant Scott P. Stephani ("Stephani") hereby does move the Trademark Trial and Appeal Board ("the Board") to dismiss the opposition with prejudice because Opposer Megatrax Production Music, Inc.'s ("Megatrax") Notice of Opposition fails to state a claim upon which relief can be granted, on the grounds that Megatrax failed to oppose Stephani's substantially identical mark for identical services (now registered).

MEMORANDUM OF POINTS AND AUTHORITIES IN SUPPORT  
OF MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM  
UPON WHICH RELIEF CAN BE GRANTED

I.

STATEMENT OF FACTS

On April 12, 2005, Mr. Stephani filed two applications for trademarks for the terms "MEGA MEDIA XCHANGE." The first was U.S. Trademark application 78/606847, which included the terms "MEGA MEDIA XCHANGE VIDEO GAMES • MOVIES • MUSIC • BOOKS" and Design. This application covered the following services:  
Retail store services and computerized on-line retail services featuring new and used audio, video and

electronic equipment, components and accessories,  
digital video discs, compact discs, video tapes, video  
games, video game consoles and accessories, video game  
strategy guides, books, comic books and audio books.

U.S.P.T.O Reg. 3,076,600 ("The '600 Registration").

On January 10, 2006, the 600 Registration was published for  
opposition. Significantly, no opposition was filed, and on April  
4, 2006, the U.S.P.T.O. granted Mr. Stephani a registration.  
The '600 Registration is valid and subsisting, and currently is  
used in commerce by Stephani. A true and accurate copy of the  
'600 Registration is attached to the Request for Judicial Notice  
as Exhibit A.

On April 12, 2005- the same day Mr. Stephani filed the '600  
registration- he also filed U.S. Trademark Application No.  
78/606,837 for "MEGA MEDIA XCHANGE" (the "'837 Application") for  
use with the following services:

Retail store services and computerized on-line retail  
services featuring new and used audio, video and  
electronic equipment, components and accessories,  
digital video discs, compact discs, video tapes, video  
games, video game consoles and accessories, video game  
strategy guides, books, comic books and audio books.

The '837 Application was published on January 10, 2006.  
Megatrax filed its opposition on January 31, 2006. See Notice of

Opposition, ¶ 1.

II.

ARGUMENT

A. THIS BOARD HAS AUTHORITY TO GRANT A MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED IN THIS INTER PARTIES PROCEEDING

In an inter parties proceeding, a responding party may assert the defense of failure to state a claim upon which relief can be granted by motion. FRCP 12(b)(6); T.B.M.P 503. Such motion tests the sufficiency of the claim or claims stated in the complaint. To withstand such a motion, the notice of opposition must establish that (1) the opposer has standing to maintain the proceeding, and (2) valid grounds exists for denying the registration sought. T.B.M.P. 503.02; Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 823 F.2d 490, 492, 2 U.S.P.Q.2d 2021, 2023 (Fed. Cir. 1987) (Holding that Opposer had pled sufficient allegation to withstand motion for summary judgment).

In resolving a motion to dismiss for failure to state a claim upon which relief can be granted, all of the opposer's well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the opposer. T.B.M.P. 503.02; Young v. AGB Corp., 152 F.3d 1377, 1380, 47 USPQ2d 1752, \_\_\_ (Fed. Cir. 1998). Nevertheless,

allegations in the complaint that contradict judicially noticeable facts are not entitled to be accepted as true.

An opposition can be dismissed for failure to state a claim only if it appears certain that the opposer is entitled to no relief under any set of facts that could be proved in support of the opposer's claim. T.B.M.P. 503.02. Under the Federal Rules of Civil Procedure, consideration of judicially noticeable facts, such as publically available records, does not convert a motion to dismiss to a motion for summary judgment. See F.R.C.P. 12(b); *Latimer v. Robinson*, 338 F.Supp.2d 841, (M.D.Tenn. 2004); *California ex rel. Lockyer v. Mirant Corp.*, 266 F.Supp.2d 1046 (N.D.Cal. 2003); *In re Wellbutrin SR/Zyban Antitrust Litigation*, 281 F.Supp.2d 751 (E.D.Pa. 2003).

B. MEGATRAX'S OPPOSITION SHOULD BE DISMISSED FOR FAILURE TO STATE A CLAIM UPON WHICH RELIEF CAN BE GRANTED

Even if all allegations contained in Megatrax's Notice of Opposition are accepted as true, the Board should grant Stephani's motion to dismiss for failure to state a claim. As will be shown herein, Megatrax failed to oppose Stephani's substantially identical mark for use with identical services, and as such cannot be harmed by the registration of another substantially identical mark for use with identical services.

1. MEGATRAX FAILED TO OPPOSE STEPHANI'S REGISTERED MARK THAT IS SUBSTANTIALLY IDENTICAL FOR IDENTICAL SERVICES

Megatrax allowed Stephani to register another substantially identical mark for identical services. As indicated in the Request for Judicial Notice enclosed herewith, the following information from U.S.P.T.O. publically available records are pertinent to the instant motion:

(a) Stephani is the true owner of U.S. Trademark Registration No. 3,076,600 for "MEGA MEDIA XCHANGE VIDEO GAMES • MOVIES • MUSIC • BOOKS" and Design ("`600 Registration");

(b) the `600 Registration was filed on April 15, 2005; and

(c) the `600 Registration covers the following services:

Retail store services and computerized on-line retail services featuring new and used audio, video and electronic equipment, components and accessories, digital video discs, compact discs, video tapes, video games, video game consoles and accessories, video game strategy guides, books, comic books and audio books.

The `600 Registration is valid and subsisting, and currently is used in commerce by Stephani. A true and accurate copy of the `600 Registration is attached to the Request for Judicial Notice as Exhibit A.

As indicated by Exhibit B attached to the Request for

Judicial Notice, the '600 Registration was published on January 10, 2006. As indicated by Exhibit C of the Request for Judicial Notice, the '837 Application was filed on April 12, 2005, and published on January 10, 2006.

As this information indicates, Stephani filed two trademark applications comprising the terms "MEGA MEDIA XCHANGE" on April 12, 2005. Both trademark applications were published on January 10, 2006. Megatrax filed a Notice of Opposition against the '837 Application, and failed to oppose the '600 Registration.

ii. MEGATRAX CANNOT BE INJURED BY THE SUBSEQUENT  
REGISTRATION OF A SUBSTANTIALLY IDENTICAL MARK FOR IDENTICAL  
SERVICES

An opposer cannot be "damaged" within the meaning of the Lanham Act § 13 by registration of a mark for services if the applicant owns an existing registration for the same or substantially identical mark for the same or substantially identical goods. *Morehouse Mfg. Corp v. J. Strickland & Co.*, 407 F.2d 881, 160 U.S.P.Q. 715 (C.C.P.A. 1969). As indicated above, Stephani owns the validly registered '600 Registration, which is a substantially identical mark for identical services. Megatrax failed to oppose the '600 Registration.

Where the marks comprising the existing registration and the opposed application are not identical, an opposer cannot be harmed by the subsequent registration if consumers would find the



marks "projecting the same image and symbolizing a single and continuing impression." *National Bakers Services, Inc. v. Hain Pure Food, Inc.*, 207 U.S.P.Q. 701, at 707 (T.T.A.B 1980). In *National Bakers v. Hain*, the Board allowed registration for the mark "HOLLYWOOD" based upon another registration for "HOLLYWOOD HEALTH FOODS." The Board found that consumers would find the same image and impression when viewing the two marks. *Id.* In the instant case, the main focus of the '600 Registration is the terms "MEGA MEDIA XCHANGE," which are written in a proportionally larger font that dominates the design of the mark. The additional terms "VIDEO GAMES • MOVIES • MUSIC • BOOKS," which are depicted below the words "MEGA MEDIA XCHANGE" in significantly smaller font, only further reinforce the notion of retail services relating to media products. When viewing the '600 Registration, attention is immediately focused on the words "MEGA MEDIA XCHANGE." Consumers, when viewing the two marks, would perceive the same image and impression between both of Stephani's marks, and thus Megatrax cannot be damaged by the registration of the '837 Application.

The Board has held that the addition of a design element to a mark still allows for the marks to be found substantially identical. A word mark and the design version of the same mark create the same commercial impression. *Continental Specialties Corp. v. Continental Connector Corp.*, 192 U.S.P.Q. 449, 451

(T.T.A.B. 1976). As the Board indicated in Continental:

"CONTINENTAL" per se creates the same psychological impression and makes the same commercial impact as do "CONTINENTAL" displayed against a background of interlocking [letters] ... Hence, "CONTINENTAL" per se is substantially identical to applicant's registered marks [comprising "CONTINENTAL" and design elements]

Id. at 452. Even with the additional design element of the '600 Registration, Stephani's two marks are substantially identical.

When compared side-by-side, the marks comprising the '600 Registration and the '837 Application are essentially identical. The focus of the majority of the '600 Registration is the terms "MEGA MEDIA XCHANGE," which are the exact same words comprising the '837 Application. Any differences in wording or design elements between the marks are de minimis. The marks are for identical services. The marks were filed and prosecuted concurrently. In light of the '600 Registration, Megatrax cannot be harmed by the additional registration of '837 Application.

III.

CONCLUSION

For all of the foregoing reasons, Stephani respectfully submits that Megatrax fails to state a claim under which relief can be granted. The Board should grant Stephani's motion to dismiss and allow Stephani's mark to proceed to registration.

Dated: May 8, 2006

Respectfully submitted,

SKOUSEN & SKOUSEN

A Professional Corporation

By: /Owen Smigelski/

Robert James Skousen  
Owen Smigelski  
Skousen & Skousen, APC  
12400 Wilshire Ave., Ste. 900  
Los Angeles, CA 90025  
(310) 277-0444  
Attorneys for Applicant,  
Scott P. Stephani

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the United States Patent and Trademark Office through ESTTA on

Date: May 8, 2006

Signature: /Owen Smigelski/  
Printed Name: Owen Smigelski

CERTIFICATE OF SERVICE

I hereby certify that on the 8<sup>th</sup> of May 2006, a true copy of the

foregoing Motion to Dismiss for Failure to State a Claim Upon Which Relief can be Granted was served on Opposer's Counsel by depositing a true and correct copy thereof in the United States main in a sealed envelope with postage thereon fully prepaid, addressed as follows:

Lucy B. Arant  
Mitchell Silberberg & Knupp LLP  
11377 W. Olympic Blvd.  
Los Angeles, CA 90064

Date: May 8, 2006

Signature: /Riann Stone/  
Printed Name: Riann Stone



3. The '600 Registration covers the following services:

Retail store services and computerized on-line retail services featuring new and used audio, video and electronic equipment, components and accessories, digital video discs, compact discs, video tapes, video games, video game consoles and accessories, video game strategy guides, books, comic books and audio books.

(See Exhibit A)

4. The '600 Registration was published for opposition on January 10, 2006. A copy of the Notice of Publication for the '600 Registration is attached hereto as Exhibit B.

5. Applicant filed U.S. Trademark Application No. 78/606,837 for "MEGA MEDIA XCHANGE" ("837 Application") on April 12, 2005. The and published the '837 Application on January 10, 2006. Attached herewith as Exhibit C is a printed copy of the TARR status report for the '837 Application.

DATED May 8, 2006

SKOUSEN & SKOUSEN

/Owen Smigelski/

Robert James Skousen  
Owen Smigelski  
Skousen & Skousen, APC  
12400 Wilshire Ave., Ste. 900  
Los Angeles, CA 90025  
(310) 277-0444  
Attorneys for Applicant,  
Scott P. Stephani

REQUEST FOR JUDICIAL NOTICE

Exhibit A

Int. Cl.: 35

Prior U.S. Cls.: 100, 101 and 102

United States Patent and Trademark Office

Reg. No. 3,076,600

Registered Apr. 4, 2006

SERVICE MARK  
PRINCIPAL REGISTER



STEPHANI, SCOTT P. (UNITED STATES INDIVIDUAL)

4593 N. OVERLAND RD.  
ONIDA, WI 54155

FOR: RETAIL STORE SERVICES AND COMPUTERIZED ON-LINE RETAIL SERVICES FEATURING NEW AND USED AUDIO, VIDEO AND ELECTRONIC EQUIPMENT, COMPONENTS AND ACCESSORIES, DIGITAL VIDEO DISCS, COMPACT DISCS, VIDEO TAPES, VIDEO GAMES, VIDEO GAME CONSOLES AND ACCESSORIES, VIDEO GAME STRATEGY GUIDES, BOOKS, COMIC

BOOKS AND AUDIO BOOKS, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FIRST USE 4-1-2005; IN COMMERCE 4-1-2005.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "MEDIA EXCHANGE VIDEO GAMES MOVIES MUSIC BOOKS", APART FROM THE MARK AS SHOWN.

SER. NO. 78-606,847, FILED 4-12-2005.

DAVID MURRAY, EXAMINING ATTORNEY



REQUEST FOR JUDICIAL NOTICE

Exhibit B



UNITED STATES PATENT AND TRADEMARK OFFICE

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, VA 22313-1451  
[www.uspto.gov](http://www.uspto.gov)

Dec 21, 2005

**NOTICE OF PUBLICATION UNDER 12(a)**

1. Serial No.:  
78/606,847
2. Mark:  
MEGA MEDIA XCHANGE VIDEO GAMES · MOVIES  
Etc. and design
3. International Class(es):  
35
4. Publication Date:  
Jan 10, 2006
5. Applicant:  
Stephani, Scott P.

The mark of the application identified appears to be entitled to registration. The mark will, in accordance with Section 12(a) of the Trademark Act of 1946, as amended, be published in the Official Gazette on the date indicated above for the purpose of opposition by any person who believes he will be damaged by the registration of the mark. If no opposition is filed within the time specified by Section 13(a) of the Statute or by rules 2.101 or 2.102 of the Trademark Rules, the Commissioner of Patents and Trademarks may issue a certificate of registration.

Copies of the trademark portion of the Official Gazette containing the publication of the mark may be obtained from:

The Superintendent of Documents  
U.S. Government Printing Office  
PO Box 371954  
Pittsburgh, PA 15250-7954  
Phone: 202-512-1800

By direction of the Commissioner.

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Correspondence Address:

STEPHANI, SCOTT P.  
4593 N OVERLAND RD  
ONEIDA, WI 54155-9232

TMP&I

REQUEST FOR JUDICIAL NOTICE

Exhibit C

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2006-05-08 17:37:42 ET

Serial Number: 78606837

Registration Number: (NOT AVAILABLE)

Mark

## Mega Media Xchange

(words only): MEGA MEDIA XCHANGE

Standard Character claim: Yes

Current Status: An opposition is now pending at the Trademark Trial and Appeal Board.

Date of Status: 2006-03-29

Filing Date: 2005-04-12

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 113

Attorney Assigned:  
MURRAY DAVID T Employee Location

Current Location: 650 -Publication And Issue Section

Date In Location: 2005-11-30

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### LAST APPLICANT(S)/OWNER(S) OF RECORD

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1. Stephani, Scott P.

Address:  
Stephani, Scott P.  
4593 N. Overland Rd.

Oneida, WI 54155  
United States  
Legal Entity Type: Individual  
Country of Citizenship: United States  
Phone Number: 920-217-4004

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### GOODS AND/OR SERVICES

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International Class: 035  
Class Status: Active  
Retail store services and computerized on-line retail services featuring new and used audio, video and electronic equipment, components and accessories, digital video discs, compact discs, video tapes, video games, video game consoles and accessories, video game strategy guides, books, comic books and audio books  
Basis: 1(a)  
First Use Date: 2005-04-01  
First Use in Commerce Date: 2005-04-01

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### ADDITIONAL INFORMATION

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Disclaimer: "MEDIA EXCHANGE"

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### MADRID PROTOCOL INFORMATION

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(NOT AVAILABLE)

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### PROSECUTION HISTORY

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2006-03-29 - Opposition instituted for Proceeding  
2006-02-08 - Opposition papers filed  
2006-01-10 - Published for opposition  
2005-12-21 - Notice of publication  
2005-11-22 - Law Office Publication Review Completed  
2005-11-18 - Assigned To LIE  
2005-11-16 - Approved for Pub - Principal Register (Initial exam)  
2005-11-16 - Teas/Email Correspondence Entered  
2005-11-13 - Communication received from applicant  
2005-11-13 - TEAS Response to Office Action Received

2005-11-10 - Combined Examiner's Amendment/Priority Action Entered

2005-11-10 - Examiner's Amendment/Priority Action E-Mailed

2005-11-10 - Examiners Amendment And/Or Priority Action - Completed

2005-11-09 - Case file assigned to examining attorney

2005-04-19 - New Application Entered In Tram

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CORRESPONDENCE INFORMATION

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Correspondent  
STEPHANI, SCOTT P.

4593 N OVERLAND RD  
ONEIDA, WI 54155-9232

Phone Number: 920-217-4004

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